

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Oral Hearing: April 26, 2012 Mailed: September 26, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Mattel, Inc.  
v.  
S.W. Fantasies, Inc.

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Opposition No. 91170977

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Edward T. Colbert and William M. Merone of Kenyon & Kenyon  
LLP

Erik M. Pelton of Erik M. Pelton & Associates, PLLC

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Before Holtzman, Taylor, and Shaw, Administrative Trademark  
Judges.

Opinion by Shaw, Administrative Trademark Judge:

S.W. Fantasies, Inc. ("applicant") has filed an application to register on the Principal Register the mark BARBIE GRIFFIN, in standard character format, for "Entertainment services, namely, providing a web site featuring photographs, video presentations, and information about a model; adult entertainment services, namely, providing a web site featuring photographs, video

presentations and information about a model; entertainment services, namely, live appearances by a model" in International Class 41.<sup>1</sup>

Registration has been opposed by Mattel, Inc. ("opposer") on the grounds of (1) priority and likelihood of confusion, and (2) dilution.

Opposer, in its notice of opposition, specifically alleges that since as early as 1958, it has continuously used in interstate commerce BARBIE and marks containing BARBIE as trademarks for toys and other goods and services; that it is the owner of a family of BARBIE marks; and that it has promoted and sold its toys and other goods and services under the BARBIE marks, for the most part, prior to any alleged use by applicant of its applied-for mark. Opposer further alleges that as a result of its use, promotion and advertizing of its BARBIE marks, BARBIE has become well known to the trade and to the public, and has accordingly acquired significant good will; and, therefore, applicant's use of its BARBIE GRIFFIN mark will "dilute" or "lessen the distinctiveness of opposer's BARBIE marks." Opposer also alleges that applicant's BARBIE GRIFFIN mark so resembles its previously used, and not abandoned, BARBIE

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<sup>1</sup> Serial. No. 78584251, filed March 10, 2005, claiming first use of the mark in commerce and anywhere as early as April 2003.

marks as to be likely, when applied to applicant's listed services, to cause confusion, mistake or deception. Opposer alleges that it owns the "famous trademark BARBIE in many different formats," however, opposer does not allege that the BARBIE marks became "famous" within the meaning of 15 U.S.C. § 1125(c) prior to applicant's adoption of its BARBIE GRIFFIN mark.

Opposer alleged ownership and prior use of seventy trademark and service mark registrations comprising the term BARBIE, in part or in whole. For purposes of this opposition, we focus on the following three registrations for BARBIE marks because these marks are the closest to applicant's mark and cover services that, when considered vis-à-vis the applied-for mark and identified services, are most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Group Ltd.*, 93 U.S.P.Q.2d 1243, 1245 (TTAB 2010). To the extent that there would be confusion with these registrations, it would serve little purpose to consider the other registrations. And if there is no likelihood of confusion with these registrations, there would similarly be no likelihood of confusion with the other registrations.

- Registration No. 2151953 for the mark BARBIE, in typed form, for, *inter alia*, "providing information over a global computer network featuring games,

stories, directories for toys and games, toy collectibles, and chat sessions," in International Class 42;<sup>2</sup>

- Registration No. 2495195 for the mark BARBIE, in typed form, for, *inter alia*, "providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children," in International Class 41;<sup>3</sup> and
- Registration No. 2588845 for the mark BARBIE, in typed form, for, "entertainment services, namely, live appearances by a costumed character," in International Class 41.<sup>4</sup>

Applicant, in its answer, denied the essential allegations of the notice of opposition.

### **The Record**

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR § 2.122(b). In addition, the parties introduced the following testimony and evidence by stipulation.

#### **A. Opposer's evidence.**

1. Declaration of Elizabeth Grampp, the Director of BARBIE Collector Marketing at Mattel, with attached exhibits.
2. First and second declarations of William Lehner, an Administrative Assistant with the law firm of Kenyon & Kenyon, with attached exhibits.
3. Opposer's First Notice of Reliance comprising:
  - a. Copies of selected registrations for various BARBIE marks (Exhibits A1-A77), pursuant to Trademark Rule

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<sup>2</sup> Issued April 21, 1998; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

<sup>3</sup> Issued October 9, 2001; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

<sup>4</sup> Issued July 7, 2002; Section 8 affidavit accepted.

- 2.122(d)(2), printed from the electronic database of the U.S. Patent and Trademark Office showing the current status of and title to the registrations;
- b. Certain printed third-party publications (Exhibits 1-79), pursuant to Rule 122(e), purporting "to show the fame of Mattel's BARBIE mark among the general public;" and
  - c. Copies of reported judicial decisions (exhibits 80-87), pursuant to Rule 122(e), purporting to "reference the fame of the BARBIE mark or . . . represent[ing] judicial findings by the federal courts that the BARBIE mark is famous."

***B. Applicant's evidence.***

Applicant filed a First Notice of Reliance comprising:

- a. Third party registrations, pursuant to Trademark Rule 2.122(e);
- b. Excerpts from the official records of the U.S. Census Bureau purporting to show "the frequency of certain names in the United States," pursuant to Trademark Rule 2.122(e) (Applicant's NOR at 2);
- c. Definitions of certain words according to *dictionary.com* and *Merriam Webster's Dictionary*, pursuant to Trademark Rule 2.122(e);
- d. Excerpts from two baby name books, pursuant to Trademark Rule 2.122(e);
- e. An image from Opposer's website, pursuant to Trademark Rule 2.122(e); and
- f. Certain interrogatory responses and admissions produced by opposer, pursuant to Trademark Rule 2.122(j).

**Preliminary Issues**

***Motions to Strike***

On June 9, 2010, the Board deferred until final decision consideration of applicant's first motion to strike testimony evidence comprising publications,

published judicial decisions, and 24 of 77 trademark registrations. On June 6, 2011, the Board also deferred until final decision consideration of applicant's second motion to strike testimony evidence comprising several declarations and/or attached exhibits. We now consider these.

***Applicant's First Motion to Strike***

Applicant's First Motion to Strike objects to third-party printed publications purportedly attesting to the fame of the BARBIE marks as well as to judicial decisions purporting to show the fame of the BARBIE marks and submitted by opposer pursuant to a notice of reliance under Rule 122(e). Applicant also objects to twenty-four trademark registrations for BARBIE marks owned by opposer which were submitted pursuant to a notice of reliance under Rule 122(d)(2). Applicant argues that the publications, judicial decisions, and trademarks registrations should be stricken because none of them were "produced or identified [by opposer] in response to Applicant's discovery requests seeking evidence of fame." *Applicant's First Motion to Strike at 11.*

In response, opposer argues that it "was under no obligation to respond to these improper requests and produce its trial evidence, especially as [it] had not

decided prior to trial on what it would rely to establish 'fame.'" *Opposer's Response to First Motion to Strike at*

5. Moreover, opposer consistently objected in its discovery responses to applicant's requests stating that, *inter alia*, (1) the requests were overbroad and unduly burdensome; (2) the requests called for legal conclusions; (3) the documents sought were irrelevant; (4) the documents sought were privileged, subject to the work product doctrine or confidential in nature prior to entry of a suitable protective agreement; (5) the documents sought were in the public record and equally available to applicant; (6) responsive documents would be produced at a mutually agreeable time and place; and/or (7) that requests for information regarding witnesses and experts or documents upon which opposer intended to rely on during this proceeding were premature or were beyond the scope of material required by Trademark Office rules. *Opposer's Responses to Applicant's First Set of Interrogatories and Opposer's Responses to Applicant's First Request for Production of Documents and Things*. Opposer also points out that applicant never filed a motion to compel in response to opposer's numerous and repeated objections to the discovery requests.

Finally, regarding the twenty-four additional registrations identified in the Notice of Reliance, opposer states that it is "not relying on those twenty-four additional registrations to establish a cause of action for confusion or dilution under Section 2 . . . . Instead, [it] is offering these additional registrations as evidence of the fame of the marks that were pled, as they constitute further proof of how, for how long, and with what goods and services Mattel has used its BARBIE and BARBIE-formative marks over the years." *Opposer's Opposition to Applicant's Motion to Strike Opposer's Testimony Evidence* at 9 (emphasis in original).<sup>5</sup>

We overrule the objections to this evidence and deny the motion to strike the evidence from the record. Opposer in no way led applicant to believe that no documents or evidence satisfied applicant's discovery requests. Rather, a number of opposer's responses were simply objections to the scope and breadth applicant's requests. Opposer did not state that no relevant documents were in its possession or control. If applicant was unsatisfied with opposer's failure to produce any documents in response to its request, under the Board's rules it was incumbent upon

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<sup>5</sup> In light of opposer's statement, we limited our review of these twenty-four registrations to the purpose opposer identifies.



applicant to file a timely motion to compel. Applicant, having failed to do so, has waived its right to object to such testimony and evidence on the ground that it was not produced during discovery. See *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1719 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); and *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue the requested material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). In part, it was applicant's own broadly worded requests and subsequent inaction following opposer's repeated objections that prevented applicant from obtaining opposer's evidence prior to trial. Under these circumstances, applicant cannot assert prejudice.

***Applicant's Second Motion to Strike***

Applicant's Second Motion to Strike objects to the Grampp and first Lehner declarations and attached exhibits<sup>6</sup> for the following reasons:

1. Portions of the Grampp declaration and exhibits as improperly withheld from discovery, as hearsay, as lacking foundation, as not based on the declarant's personal knowledge, and without evidentiary support; and
2. Portions of the first Lehner declaration and exhibits as withheld from discovery, and as hearsay.

Inasmuch as applicant did not file a motion to compel in response to opposer's failure to produce any documents, as discussed above, we find that the Grampp and First Lehner declarations and exhibits were not improperly withheld from discovery. Accordingly, applicant's objections to the Grampp and First Lehner Declarations and exhibits on these grounds are overruled. *See H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d at 1719.

Applicant's remaining objections to the Grampp and First Lehner declarations and exhibits on the grounds of hearsay, lacking foundation, not based on the declarant's

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<sup>6</sup> *Applicant's Second Motion to Strike* at 1. Since we do not address opposer's unpleaded claims of no bona fide intent to use the mark, abandonment, and fraud, we do not need to consider applicant's objections to the Kesicki and Watts declarations on these grounds. The second Lehner declaration is discussed *infra*.

personal knowledge, and lack of evidentiary support are, for the most part, equally unpersuasive.

As to the Grampp declaration we find that applicant's objections to Ms. Grampp's testimony are without merit. Ms. Grampp testified that she had the requisite knowledge supporting the statements made and that she was familiar with the business records, financial information, brand history, and marketing and promotion of the BARBIE brand. *Cf., Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 USPQ2d 1315, 1317 (Fed. Cir. 2010).

As to the survey information (exhibits M and N to the Grampp declaration) applicant's objection that the surveys lack foundation is overruled in part. The Grampp declaration identified the surveys as annual tracking surveys conducted in the ordinary course of business and the 2009 US Boys and Girls Tracking Study (Exhibit N) provides ample description of the survey methodology. Therefore, we have considered it. However, we note that the Total Unaided Awareness survey (exhibit M) lacks any discussion of methodology and we have not considered this survey.

As to any hearsay objections regarding the remaining exhibits attached to these declarations, we find that the involved documents are being offered only for "what they

show on their face," not for the truth of the statements contained therein. TBMP § 704.08(c) (3d ed. 2012). We have considered them for whatever probative value they may have.

### **Standing**

Opposer has shown through the TESS printouts made of record that it is the owner of the pleaded registrations and that the registrations are valid and subsisting. Because opposer's registrations are of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

### **Priority**

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the mark and the products covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

### **Likelihood of Confusion**

Opposer asserts likelihood of confusion under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Opposer alleges that applicant's mark when used in connection with applicant's services so resembles opposer's previously used

and registered BARBIE marks, as to be likely to cause confusion.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Moreover, it is the opposer's burden to establish facts sufficient to support the conclusion that confusion, mistake, or deception is likely. *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir 2012).

***A. The fame of opposer's marks.***

This *du Pont* factor requires us to consider the fame of opposer's marks. Fame, if it exists, can play a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir.

2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In this regard, the Court of Appeals for the Federal Circuit has stated the following: [T]here is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in certain circumstances to prove fame of a mark, raw numbers alone may be misleading. The context surrounding the raw

statistics may be necessary (e.g., the substantiality of the sales or advertising figures as compared to those providing comparable products or services). *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer introduced evidence of the following to establish the fame of its mark:

1. Opposer began using the BARBIE mark on dolls on March 9, 1959;<sup>7</sup>
2. More than one billion BARBIE dolls have been sold over the past 50 years in over 150 countries.<sup>8</sup>
3. Opposer sells BARBIE dolls that have been specifically designed to appeal to the adult collector market.<sup>9</sup>
4. Opposer also sells a variety of goods and services under the BARBIE brand. Each year opposer offers "roughly 3,000 different BARBIE branded products."<sup>10</sup>
5. Opposer uses the BARBIE marks in connection with entertainment services and has released fifteen animated BARBIE movies in the previous ten years.<sup>11</sup>

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<sup>7</sup> Grampp declaration, para. 8.

<sup>8</sup> *Id.*, para. 10

<sup>9</sup> *Id.*, para. 13.

<sup>10</sup> *Id.*, para. 16.

<sup>11</sup> *Id.*, para. 20.

6. Total annual sales under the BARBIE brand are more than two billion dollars, of which, more than half comes from sales other than toys.<sup>12</sup>
7. BARBIE branded products are sold in many forms of retail outlets, including dollar stores, grocery stores, drug stores, mass market retailers, department stores, and specialty boutiques.<sup>13</sup>
8. Each year, opposer spends "tens of millions of dollars" promoting the BARBIE brand through advertising and promotional events.<sup>14</sup>
9. Opposer's BARBIE products have been the subject of newspaper and magazine articles which refer to the fame of the BARBIE character. The following excerpts are representative of the publicity opposer's BARBIE doll has received:<sup>15</sup>
  - Buffalo News, Susan Martin, *Barbie Beautiful at 50*, March 8, 2009, stating BARBIE is an "iconic fashion doll;"
  - Los Angeles Times, Emili Vesilind, *Under Her Spell*, March 8, 2009, stating that BARBIE is "the most iconic plastic female of all time;"
  - Boston Herald, Raakhee P. Mirchandani, *The Shopper; Barbie Goes Uptown with Designer Dolls*, July 18, 2004, stating that "Barbie is the ultimate fashion icon;"
  - Los Angeles Times, Leslie Earnest, *Good Old Barbie*, May 1, 1997, stating that BARBIE is a "world-famous name;"
  - Cleveland Plain Dealer, Bryon Lars, April 11, 1996, noting that a fashion designer considers BARBIE to be "a celebrity even more famous than Madonna;"

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<sup>12</sup> *Id.*, para. 21. Ms. Grampp did not specify whether her testimony referred to sales limited to the United States or to worldwide sales.

<sup>13</sup> *Id.*, para. 22.

<sup>14</sup> *Id.*, para. 23. Ms. Grampp did not specify whether her testimony referred to advertising and promotional events limited to the United States or to worldwide sales.

<sup>15</sup> Opposer's first notice of reliance, Exhibits A3, A4, A9, A46, A52, A67, and A73.



- The New York Times, Robert Plunket, *Age Cannot Wither Her, Nor Custom Stale*, April 18, 1993, stating that BARBIE is "right up there with Elvis;" and
  - The New York Times, Alice Kahn, *A Onetime Bimbo Becomes a Muse*, September 29, 1991, stating "She is Barbie, needing only one name, like Madonna or Elvis or Picasso . . . [an] icon of American womanhood."
10. Six federal court decisions finding, *inter alia*, that BARBIE brand dolls are famous for purposes of dilution. The following excerpts are representative of the findings of the courts:
- "The Court concludes that—by any measure—the world-known BARBIE is a 'famous' trademark under the Federal Anti-Dilution Act;"<sup>16</sup>
  - "The Court finds that, by any measure of the above factors which have been set forth by the Federal Trademark Dilution Act, the trademark BARBIE is both 'distinctive' and 'famous' for purposes of Section 1125(d);" <sup>17</sup> and
  - "[BARBIE] remains a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond. With Barbie, Mattel created not just a toy but a cultural icon."<sup>18</sup>

Based on this record, we have no doubt that opposer's BARBIE marks are famous for purposes of likelihood of confusion; therefore, they are entitled to a broad scope of protection. This factor favors opposer.

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<sup>16</sup> *Mattel Inc. v. Jcom Inc.*, 48 USPQ2d 1467, 1470 (S.D.N.Y. 1998).

<sup>17</sup> *Mattel Inc. v. Internet Dimensions Inc.*, 55 USPQ2d 1620, 1622-23 (S.D.N.Y. 2000).

<sup>18</sup> *Mattel Inc. v. MCA Records Inc.*, 63 USPQ2d 1715, 1717, 1721 (9th Cir. 2002).

***B. Similarity or dissimilarity of the services described in the application and registrations, the channels of trade, and classes of consumers.***

This *du Pont* factor requires us to determine the similarity or dissimilarity of the services as identified in applicant's application and in the cited registrations, respectively. Under the third *du Pont* factor we also determine the similarity or dissimilarity of the trade channels in which and the purchasers to whom the respective services would be marketed.

To review, opposer's services, as identified in the three registrations most similar to applicant's, are:

"providing information over a global computer network featuring games, stories, directories for toys and games, toy collectibles, and chat sessions," in International Class 42;

"providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children," in International Class 41; and

"entertainment services, namely, live appearances by a costumed character," in International Class 41.

Applicant's services are identified as:

"Entertainment services, namely, providing a web site featuring photographs, video presentations, and information about a model; adult entertainment services, namely, providing a web site featuring photographs, video presentations and information about a model; entertainment services, namely, live appearances by a model" in International Class 41.

At the outset, we note that some of applicant's services are not limited to "adult entertainment services." Accordingly, applicant's argument that there is "no evidence that adult modeling services and toy doll related goods and services are sold under circumstances likely to give rise to the mistaken belief that the products emanate from the same source" is simply beside the point. Applicant's Br. at 45. It is well-settled that we must determine likelihood of confusion based on the services as they are identified in the application.

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, we must presume that applicant's website services and live appearances by a model are not limited to consumers seeking only adult entertainment but are marketed and available to all consumers regardless of age, gender, or other attributes.

Regarding the website services, both opposer's and applicant's websites appear to provide information relating

to the person or character named in the mark.<sup>19</sup> That is, opposer's websites offer information, games, stories, directories, and chat sessions about its BARBIE character and applicant's website site offers information, photographs, and video presentations about the personality known as BARBIE GRIFFIN. Thus, both websites are similar in the sense that they are providing the same type of biographical information and supplemental material about their respective characters. Although those characters may in fact have very different attributes and audiences, any such differences are not reflected in the identification of services. Accordingly, we find that applicant's website entertainment services are closely related to opposer's website entertainment and information services.

In the absence of any limitations as to channels of trade or purchasers, we also must presume that these closely-related services would be marketed in the same trade channels and to the same classes of purchasers. See *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Turning to the entertainment services comprising live appearances by a "costumed character" or a "model," we find

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<sup>19</sup> Grampp declaration, exhibit K and L; applicant's specimen of use, March 10, 2005.

these services are very closely related. The only difference between the services is the language "costumed character" in opposer's registration and "model" in applicant's application. Both services involve live appearances by individuals and presumably differ only in the persona and clothing of the entertainer. Given that the record shows that opposer's BARBIE character is regarded as a "fashion icon" known for modeling clothes and representing any number of female roles,<sup>20</sup> we find that the similarity of the wording "costumed character" and "model" suggests that these services are very closely related.

These factors favor opposer.

***C. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.***

We next consider the similarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The test, under this *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services

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<sup>20</sup> *Opposer's First Notice of Reliance*, Exhibits A1-A77.

offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). While we must consider the marks in their entirety, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Opposer's marks consist entirely of the word BARBIE in typed form. Applicant's mark consists entirely of the words BARBIE GRIFFIN in standard characters and incorporates opposer's BARBIE mark in its entirety. We cannot say that one term in applicant's mark dominates over the other but rather that the full name BARBIE GRIFFIN will be taken as a whole. That being said, the first part of applicant's mark is identical to the entirety of opposer's mark. *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("there are also similarities between them in that both start with the term 'KID' a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser

and remembered"); *Palm Bay Imports*, 73 USPQ2d at 1692 ("The presence of [a] strong distinctive term as the first word in both parties' marks renders the marks similar.").

With regard to connotation, both are names and would be perceived as such. The argument that the marks are distinct because BARBIE GRIFFIN refers to a specific individual is not persuasive. BARBIE by itself also could be perceived as referring to a specific individual. Consumers, when presented with the identical or closely-related services under the respective BARBIE and BARBIE GRIFFIN marks, are likely to perceive these two marks as the same name with one being the shortened form of the other. *In Re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (ML is likely to be perceived as a shortened version of ML MARK LEES). This is especially likely if consumers do not know that opposer's BARBIE character has a different last name because, as applicant notes, "none of the marks in the BARBIE registrations . . . join the BARBIE mark with a surname." Applicant's Br. at 47. Put another way, if consumers are not used to seeing opposer's BARBIE linked to a last name, these consumers, upon seeing advertisements for live appearances for BARBIE GRIFFIN might assume that the performances featured opposer's BARBIE. Thus, although applicant's mark includes

the term GRIFFIN, when we compare the marks in their entirety we find that on the whole they are similar in appearance, sound, connotation and commercial impression and that the additional wording in applicant's mark is not sufficient to distinguish the marks when used in connection with related services. This factor favors opposer.

***D. Remaining du Pont factors***

We have considered the remaining arguments and evidence put forth by applicant but in light of the fame of opposer's mark, the similarity of the services, and the similarity of the marks we find these arguments unpersuasive. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("The likelihood of confusion analysis considers all *du Pont* factors for which there is evidence of record but 'may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.'").

***E. Balancing the factors.***

On balance, the relevant *du Pont* factors weigh heavily in favor of a finding of likelihood of confusion. We conclude that consumers familiar with opposer's famous BARBIE mark and services, upon encountering applicant's mark BARBIE GRIFFIN for closely-related services, would be



likely to believe that the services originate from or are associated with or sponsored by the same entity.

In light of our finding on the issue of likelihood of confusion, we find it unnecessary to reach the issue of dilution as well as applicant's objections to opposer's dilution pleading and related evidence, namely, the Watts, Kesicki, and second Lehner declarations. *See Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1572 (TTAB 2007).

**Decision:** Opposition No. 91170977 is sustained.