

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
June 2, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Playboy Enterprises International, Inc.

v.

Adam Bennett

Opposition No. 91173441  
to application Serial No. 78721862  
filed on September 27, 2006

Philip A. Jones of Brinks Hofer Gilson & Lione for Playboy  
Enterprises International, Inc.

Adam Bennett, *pro se*.

Before Quinn, Bergsman and Wellington, Administrative  
Trademark Judges.

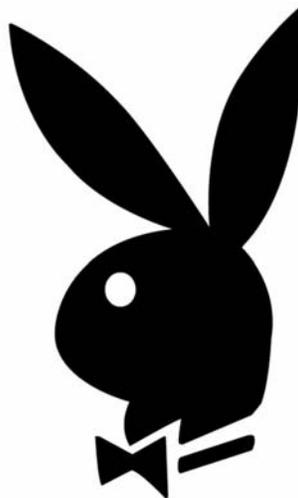
Opinion by Bergsman, Administrative Trademark Judge:

Adam Bennett filed an intent-to-use application to register the mark PLAYERSANDBUNNIES and design, shown below, for "entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials," in Class 41 (Serial No. 78721862).



Applicant described the design element of the mark as “a hand with pinky and index finger pointed in a horn symbol with thumb middle finger and ring finger joining together.”

Playboy Enterprises International, Inc. opposed the registration of applicant’s mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), and dilution under Section 43(c) of the Trademark Act of 1946, 15 U.S.C. §1125(c). Opposer claimed ownership of 16 registrations for rabbit head designs (shown below) with and without literal elements.



The most pertinent registrations are set forth below:

Registration No.	Goods/services
2839937	Entertainment services, namely, providing a website featuring photographs, videos, film clips, and other multimedia materials.
3112931	Entertainment services, namely, providing adult programming via wireless services.
1393913	Pre-recorded video cassettes.
0643926	Monthly magazine.
1918754	Pre-recorded CD-ROMs featuring personal interviews and photographs.
2638318 for the mark  .com	Entertainment services, namely, providing an online database available via the internet, featuring news related to sports, music, television, theater, and the entertainment industry; non-downloadable photographs; online reviews of movies, books, music, and computer games; and casino services.
2713287 for the mark 	Subscription webcasting services featuring images of female models and video footage.
3076053 for the mark 	Entertainment services, namely, providing video programming, production, and distribution services.

Opposer also claimed ownership of the marks BUNNY for "operating establishments which feature food, drink, and

entertainment,"<sup>1</sup> and PLAYBOY BUNNY for "casino and nightclub services."<sup>2</sup>

In his answer, applicant admitted the following:<sup>3</sup>

1. For more than 50 years, opposer has marketed its rabbit head design in connection with a wide variety of goods and services;
2. Opposer's ownership of its pleaded registrations;
3. Opposer's rabbit head design trademarks are famous when used in connection with the goods and services identified in opposer's pleaded registrations;
4. Opposer is the owner of Registration No. 0819555 for the mark BUNNY for operating establishments which feature food, drink, and entertainment; and,
5. Opposer has marketed "the Playboy BUNNY" for a variety of goods and services.

Applicant denied the remaining allegations in the notice of opposition.

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<sup>1</sup> Registration No. 0810555, issued June 28, 1966; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

<sup>2</sup> Serial No. 78516279, filed November 12, 2004.

<sup>3</sup> In many instances, applicant essentially repeated opposer's allegations and claimed that applicant does not engage in the referenced activity or own the referenced trademarks. Fed. R. Civ. P. 8(d) provides that an allegation in a complaint is admitted when it is not denied. In view of the manner in which applicant responded, we construe his failure to specifically deny the allegations in the notice of opposition as admissions.

Opposer introduced testimony and filed a brief.<sup>4</sup> Applicant did not introduce any testimony or evidence, and he did not file a brief.

#### The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. Opposer also introduced the following evidence:

1. The testimony deposition of applicant as an adverse witness, with attached exhibits;
2. The testimony deposition of Scott G. Stephen, the executive vice president of operations for Playboy Entertainment, with attached exhibits; and,
3. The testimony deposition of Michelle McCoy, trademark counsel for opposer, with attached exhibits, including copies of opposer's pleaded registrations prepared by the Office showing their current status and current ownership by opposer.

#### Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc.*

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<sup>4</sup> Because opposer presented no argument regarding dilution in its brief, we deem opposer to have waived its pleaded ground of dilution, and we have given it no consideration.

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*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. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

#### Likelihood Of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the facts in evidence that are 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, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

##### 1. Fame.

We turn first to the factor of fame because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark . . . casts a long shadow which competitors must

avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In addition to his admission in the answer that opposer's rabbit head design is a famous trademark, applicant testified that opposer's rabbit head design is a famous trademark.

Q. In your view, the Playboy mark is well known; isn't that correct?

A. As stated earlier, I believe that I said that, yes.

Q. Okay. And the rabbit head design and bunny marks are also well known, correct?

A. As stated earlier, yes.

Q. In fact, you consider the Playboy rabbit head design and bunny marks to be famous, isn't that true?

A. Yeah, yeah, I would say so.<sup>5</sup>

Moreover, opposer introduced other evidence to demonstrate that its rabbit head design is famous. For example, opposer introduced several news articles referring

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<sup>5</sup> Bennett Dep., p. 44. Earlier, Mr. Bennett agreed that "lots of people in American have seen [opposer's] rabbit head design." Bennett Dep., pp. 11-12.

to the rabbit head design as a famous trademark, including the following magazine articles:<sup>6</sup>

1. *Rolling Stone* magazine (May 15, 2003) identified opposer's rabbit head design as an "American Icon."<sup>7</sup>

2. In an *AdWeek* magazine article (October 23, 2006) about opposer, the author, Alec Foege, wrote that "[p]ersistent and creative marketing efforts have made the Playboy bunny logo a global icon and put branded products in more than 100 countries. In an era of plummeting circulation, Hefner's brainchild remains a role model for magazines of all stripes, which are waking up to brand extension as a means of survival."<sup>8</sup>

3. *BrandMarketing* magazine (Spring 1999) recognized opposer's rabbit head design as one of "One Hundred That Changed America."<sup>9</sup> The magazine article notes that early on Playboy established its "ubiquitous rabbit-head-with-a-bowtie logo."

In view of the foregoing, opposer has established that its rabbit head design trademark is famous and thus entitled to a broad scope of protection.

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<sup>6</sup> The probative value of the news articles is that they show how the third parties perceive opposer's mark.

<sup>7</sup> McCoy Dep., Exhibit 69.

<sup>8</sup> McCoy Dep., Exhibit 70.

<sup>9</sup> McCoy Dep., Exhibit 71.

B. The similarity or dissimilarity and nature of the goods as described in the application and registration.

The services identified in applicant's application are "entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials."

Opposer has registered its rabbit head design for "entertainment services, namely, providing a website featuring photographs, videos, film clips, and other multimedia materials" (Registration No. 2839937) and "entertainment services, namely, providing an online database available via the internet, featuring news related to sports, music, television, theater, and the entertainment industry; non-downloadable photographs; online reviews of movies, books, music, and computer games; and casino services " (Registration No. 2638318). Opposer's services are essentially identical to applicant's services.

C. The similarity or dissimilarity of established, likely-to-continue trade channels and buyers to whom sales are made.

Given the virtual identity of the services identified by the parties and the absence of any trade channel restrictions in either party's description of services, we must presume that their entertainment services provided through the Internet would be marketed in the same channels of trade, to the same classes of purchasers. *Genesco Inc. v. Martz*, 66 USPQ2d 1260 1268 (TTAB 2003) ("Given the in-

part identical and in-part related nature of the parties' goods, and the lack of any trade restrictions in the identifications thereof as to channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"); *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1450 (TTAB 1987).

Because the question of registrability of an applicant's mark must be decided on the basis of the identification of services set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's services, the particular channels of trade or the class of purchasers to whom sales are directed, we cannot give any consideration to applicant's testimony that applicant's services and opposer's services move in different channels of trade and appeal to different classes of consumers.<sup>10</sup> *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940

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<sup>10</sup> Applicant testified that opposer's services are geared to white, older males fanaticizing about young blondes. Bennett Dep., pp. 37-38.

(Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

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

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the services are essentially identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI*

*Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

The design element of applicant's mark is similar in appearance to opposer's rabbit head design. The marks are displayed below.



The design element of applicant's mark resembles a rabbit head. Both designs have the head oriented to the left, the ears raised, a white circle or oval forming the eye, and a bowtie. Applicant's use of the term PLAYERSANDBUNNIES calls to mind opposer's marks PLAYBOY and BUNNY that reinforce the conceptual similarity with opposer's rabbit head design mark.<sup>11</sup>

In view of the fame of opposer's rabbit head design trademarks, the visual similarity of the designs is sufficient to create a likelihood of confusion when the

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<sup>11</sup> Opposer's evidence includes extensive testimony regarding its use of the marks PLAYBOY, BUNNY, and PLAYBOY BUNNY. For example, virtually all of opposer's advertising for the rabbit head logo is used in conjunction with the mark PLAYBOY.

marks are used in connection with essentially identical services.

E. Applicant's bad faith.

Evidence of applicant's bad faith adoption of his mark is a relevant likelihood of confusion factor. *L.C. Licensing, Inc. v. Cary Berman*, \_\_\_ USPQ2d \_\_\_ (TTAB Opposition No. 91162330, March 19, 2008).

Applicant testified that the design element of his mark is "clip art" drawn by a freelance artist from the United Kingdom.<sup>12</sup> Applicant put the term PLAYERSANDBUNNIES under the design.<sup>13</sup> He adopted the term "PLAYERSANDBUNNIES" to engender the commercial impression of people who are "players" - - someone who seeks out all of life's pleasures - - and "bunnies" - - people who party.<sup>14</sup>

Q. I guess I don't understand how players and bunnies fit together into a concept. Could you explain that better to me?

A. I guess it's people out here that are, like, doing things to - - I guess people that makes things happen and people that just participate. Bunnies are the participators. Players are the people that make it happen.<sup>15</sup>

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Q. Could you explain to me how this design fits into the players and bunnies concept?

A. This design started off in Houston. We have a signal that we do.

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<sup>12</sup> Bennett Dep., p. 24.

<sup>13</sup> Bennett Dep., p. 25.

<sup>14</sup> Bennett Dep., pp. 20-21.

<sup>15</sup> *Id.*

Q. Okay. But how does it - - how does it refer to the term "players"?

A. It's really just - - it's a logo. I mean, it's no, like - - it's nothing magical about it. It's a hand signal that we do in Houston. It's the "H" symbol. We do this in Houston (demonstrating).<sup>16</sup>

Applicant also testified that he was aware of the PLAYBOY mark and opposer's rabbit design prior to filing his application.<sup>17</sup> In fact, applicant testified "Playboy is synonymous with Hugh Hefner," the founder of Playboy.<sup>18</sup> In this regard, applicant posted the name "Hughston Hefner" next to applicant's mark in applicant's MySpace page."<sup>19</sup>

Q. And then looking to the right, it says, quote "Hughston Hefner," H-u-g-h-s-t-o-n, H-e-f-n-e-r. Do you see that?

A. Yes.

Q. Did you put that there?

A. It's a moniker, yeah.

Q. Where do you use that moniker?

A. Just on there.

Q. You use it on your MySpace communications?

A. Yeah.

Q. Do you use that moniker anywhere else?

A. No.

Q. And Hughston Hefner is not your real name, correct?

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<sup>16</sup> Bennett Dep., p. 22.

<sup>17</sup> Bennett Dep., pp. 10-11.

<sup>18</sup> Bennett Dep. p. 11.

<sup>19</sup> Bennett Dep., Exhibit 7.

A. No.<sup>20</sup>

Applicant's testimony regarding the adoption of his mark is not credible. First, applicant admits that opposer's rabbit design is famous and that applicant knew about opposer's marks prior to filing his application. In addition, applicant testified that Hugh Hefner, opposer's founder, is synonymous with opposer and yet applicant used the name "Hughston Hefner" in connection with applicant's mark on his MySpace page. The use of the name "Hughston Hefner" in connection with applicant's mark draws a connection with opposer.

Second, applicant's mark was clearly created to draw a connection with opposer by virtue of the bowtie and white oval forming an eye. Those similarities are more than just a coincidence. Moreover, applicant's explanation of how the design element fits into applicant's "players and bunnies" concept (*i.e.*, "It's a hand signal that we do in Houston") strains credulity.

This likelihood of confusion factor of bad faith is resolved in favor of finding a likelihood of confusion.

F. Balancing the factors.

In balancing the evidence of record as it applies to the likelihood of confusion factors, we conclude that there is a likelihood of confusion. The marks of the parties are

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<sup>20</sup> Bennett Dep., pp. 46-47.

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similar, the services are essentially identical, the channels of trade and classes of consumers are the same, and applicant acted in bad faith when he adopted his mark. If prospective purchasers were to encounter applicant's mark used in connection with "entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials," they would likely believe that these services emanated from, were sponsored by, or were associated with opposer.

Decision: The opposition is sustained and registration to applicant is refused.