

<p>This Opinion Is Not a Precedent of the TTAB</p>

Hearing: September 25, 2019

Mailed: June 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Disney Enterprises, Inc.
v.
United Trademark Holdings, Inc.

Opposition Nos. 91221648 and 91224985¹

David M. Kelly, Linda K. McLeod and Kelu Sullivan of Kelly IP, LLP for Disney Enterprises, Inc.


Erik M. Pelton of Erik M. Pelton & Associates PLLC for United Trademark Holdings, Inc.

Before Cataldo, Shaw and Dunn, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, United Trademark Holdings, Inc., applied for registration on the Principal Register of the marks:

¹ On March 10, 2016, the Board issued an order, 13 TTABVUE, granting Opposer's February 9, 2016 motion to consolidate these proceedings. 12 TTABVUE. In this decision, we will refer to the pleadings, trial record, briefs and other filings and orders in parent Opposition No. 91221648 unless otherwise noted.

² and TEEN TINKER BELL (in standard characters),³ both identifying “dolls” in International Class 28.

Opposer, Disney Enterprises, Inc., has opposed registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of priority and likelihood of confusion with its pleaded marks.⁴ Opposer pleaded ownership of more than thirty registrations, including the following:

TINKER BELL (issued in standard characters on the Principal Register) identifying, as amended, “dolls; mechanical toys” in Class 28;⁵

TINKERBELL (issued in typed form⁶ on the Principal Register) identifying “dolls and doll accessories,” in Class 28;⁷

² Application Serial No. 85833851 was filed on January 28, 2013 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of use of the mark in commerce in connection with the goods since January 1, 2013. The application includes the following description of the mark and color claim: “The mark consists of the stylized text ‘Teen Tink’ with a design of a crown above it.” “Color is not claimed as a feature of the mark.”

³ Application Serial No. 86533016 was filed on February 12, 2015 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s claim of a bona fide intent to use the mark in commerce in connection with the goods.

⁴ 1 TTABVUE.

Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to non-confidential parts of the record include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

⁵ Reg. No. 3636910 issued on June 9, 2009. First Renewal. 30 TTABVUE 17-19.

⁶ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks.”).

⁷ Reg. No. 1736777 issued on December 1, 1992. Second Renewal. 30 TTABVUE 75-84.

TINK (issued in typed form on the Principal Register) identifying “hats; caps; pajamas; sweat pants; shirts; t-shirts,” in Class 25;⁸

TINK (issued in standard characters on the Principal Register) identifying various goods in Classes 16, 20, 21 and 30;⁹ and

TINK (issued in typed form on the Principal Register) identifying various goods in Classes 14, 18 and 25.¹⁰

Applicant, in its answer, denied the salient allegations in the notice of opposition.¹¹ The Board presumes the parties’ familiarity with the procedural history of this proceeding.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application files.

In addition, Opposer submitted the following testimony and evidence:

- Testimony Declaration of Katherine James, Director of Business Affairs for Disney Parks, Experiences, and Consumer Products (formerly Director of Business Affairs for Disney Consumer Products & Interactive Media) (“James I”) and exhibits thereto.¹²

⁸ Reg. No. 3561526 issued on January 13, 2009. First Renewal. 30 TTABVUE 278-83.

⁹ Reg. No. 3851671 issued on September 21, 2010. Section 8 affidavit accepted; Section 15 affidavit acknowledged. (Section 9 reminder mailed September 21, 2019). 30 TTABVUE 285-90.

¹⁰ Reg. No. 3734512 issued on January 5, 2010. Section 8 affidavit accepted; Section 15 affidavit acknowledged. (Section 9 reminder mailed January 5, 2019). 30 TTABVUE 292-99.

¹¹ 4 TTABVUE. On October 19, 2015, the Board issued an order, 9 TTABVUE, granting in part Opposer’s motion to strike Applicant’s affirmative defenses, at 5 TTABVUE, and striking the affirmative defenses raised in paragraphs 28-32 and 40-42 of Applicant’s answer. The remainder of the “affirmative defenses” asserted in the answer serve as amplifications of Applicant’s denials, and have been so construed.

¹² 40-42 TTABVUE; 44-49 TTABVUE; 51-59 TTABVUE. Unredacted versions of Ms. James’ testimony declaration and exhibits 10 and 19 thereto, containing confidential information, are located at 39, 44 and 50 TTABVUE and are not visible to the public.

- Notice of Reliance No. 1, filed February 20, 2018, consisting of status and title copies of U.S. Trademark Registrations for Opposer's TINKER BELL & TINK Marks.¹³
- Corrected Notice of Reliance No. 2, filed February 21, 2018, consisting of representative samples of unsolicited media attention in national publications and television transcripts available to the general public showing, inter alia, the nature and extent of the public's exposure to the TINKER BELL & TINK Marks.¹⁴
- Notice of Reliance No. 3, filed February 21, 2018, consisting of various internet printouts showing descriptive and generic use of "teen" and "teenage" for dolls, and a book entitled *Teen Dolls* by Patricia R. Smith.¹⁵
- Notice of Reliance No. 4, filed February 20, 2018, consisting of the application filings from trademark registrations owned by Applicant and representative internet website pages identifying or referring to Applicant's goods as "Disney" products.¹⁶
- Notice of Reliance No. 5, filed February 21, 2018, consisting of copies of books and plays entitled: *Tinker Bell an Evolution*; *Disney A to Z: The Official Encyclopedia*; *Peter and Wendy*, and *Peter Pan or The Boy Who Would Not Grow Up (play)*.¹⁷
- Notice of Reliance No. 6, filed February 20, 2018, consisting of representative samples from Internet websites for various retailers displaying Applicant's goods.¹⁸

Applicant submitted the following evidence:

- Notice of Reliance No. 1, dated May 18, 2018, consisting of third-party registration certificates for trademarks that contain or comprise of the terms TINKER, TINK or TINKER BELL for various goods and services,

¹³ 30 TTABVUE. We do not rely upon Opposer's pleaded registrations that have been cancelled during the course of this proceeding.

¹⁴ 33 TTABVUE.

¹⁵ 34 TTABVUE.

¹⁶ 31 TTABVUE.

¹⁷ 35-38 TTABVUE.

¹⁸ 32 TTABVUE.

and Applicant's trademark registration certificates for various character marks and TEEN marks.¹⁹

- Notice of Reliance No. 2, dated May 18, 2018, consisting of printed publications of the following works: *The Little White Bird* by J.M. Barrie, published in 1898; *Peter Pan in Kensington Garden* by J.M. Barrie, published in 1906; *Peter Pan (Peter and Wendy)* by J.M. Barrie, published in 1911 (see Exhibit 3C); *Peter Pan* by James M. Barrie, published in 1904; and *Peter Pan (A Bonnie Book)* by Samuel Lowe Company; based on the play by J.M. Barrie.²⁰
- Notice of Reliance No. 3, dated May 18, 2018, consisting of internet materials that depict goods and services containing the terms TINKER BELL or TINK, excerpts from the book *Peter and Wendy*, and articles about *Peter Pan* intellectual property rights.²¹
- Notice of Reliance No. 4, dated May 18, 2018, consisting of portions of Disney's pleaded registration files, namely the most recently filed specimens of use provided by Disney in each of its pleaded registrations.²²
- Notice of Reliance No. 5, dated May 18, 2018, consisting of final decisions from courts in cases involving trademarks and public domain works.²³
- Notice of Reliance No. 6, dated May 18, 2018, consisting of printed publications that discuss trademarks in character names, public domain works, and rights attached to copyrighted works that entered the public domain.²⁴
- Notice of Reliance No. 7, dated May 18, 2018, consisting of official records of trademark registration certificates owned by Disney and specimens of use submitted therewith.²⁵

¹⁹ 62 TTABVUE.

²⁰ 63 TTABVUE.

²¹ 64 TTABVUE.

²² 65 TTABVUE.

²³ 66 TTABVUE.

²⁴ 67 TTABVUE.

²⁵ 68 TTABVUE.

Opposer submitted the following rebuttal testimony and evidence:

- Rebuttal Declaration of Katherine James, Director of Business Affairs for Disney Parks, Experiences, and Consumer Products (“James II”) and exhibits thereto.²⁶
- Rebuttal Notice of Reliance No. 1, filed December 3, 2018, consisting of the complete application file history for Applicant’s U.S. Trademark Application Serial No. 87690863 for the mark RAPUNZEL.²⁷

II. Background

“Tinker Bell” originally appeared as a character in several works by J.M. Barrie, including the play *Peter Pan*, and the novels *Peter and Wendy*, *The Little White Bird* and *Peter Pan in Kensington Gardens*.²⁸ The play *Peter Pan* was first performed in 1904 and later published in 1928.²⁹ As Walt Disney stated in 1953, “It couldn’t be ignored that the play has earned its place among the world’s theatrical masterpieces with steady patronage through half a century since its first showing at the Duke of York Theatre in London in 1904.”³⁰ In the original play, Tinker Bell was depicted as a beam of light and musical bells and chimes.³¹ In the book *Peter and Wendy*, Tinker Bell is described as a “fairy girl gowned in a skeleton leaf.”³²

²⁶ 75 TTABVUE. Unredacted versions of Ms. James’ testimony declaration and exhibits thereto, containing confidential information, are located at 74 TTABVUE and are not visible to the public.

²⁷ 73 TTABVUE.

²⁸ 63 TTABVUE.

²⁹ 63 TTABVUE.

³⁰ 41 TTABVUE 254.

³¹ James Declaration, 40 TTABVUE 7.

³² 40 TTABVUE 7.

In 1939, Opposer's predecessors in interest acquired exclusive rights to "make, reproduce, and exhibit animated cartoon motion pictures and engage in merchandising activities related thereto," based upon the play *Peter Pan* and related "Peter Pan" works originally created by J.M. Barrie.³³ In 1953, after twelve years of development and numerous revisions, Opposer's predecessors in interest released the animated *Peter Pan* motion picture, featuring a revised Tinker Bell as a major character.³⁴ Again, in the words of Walt Disney:

Tiny Tinker Bell also is a definite transformation for the screen. She is a completely feminine person, jealous and vixenish, in place of the disembodied fairy she has always been on stage, represented only by a beam of light. I believe you're going to like Tinker Bell. We fell in love with her here at the studio.³⁵

Opposer's predecessors in interest reimagined the character of Tinker Bell into a "graceful and gorgeous" creature, the size of Peter Pan's thumb but possessing "the miniature proportions of a beauty contest winner and pin-up favorite."³⁶

In 2013, Applicant launched its Fairy Tale High collection of dolls depicting "public domain characters from well-known fairy tales, including Snow White, Rapunzel, Belle, Sleeping Beauty, Little Mermaid, Alice in Wonderland, Tinker Bell and Cinderella."³⁷ The dolls are reimagined as teenagers with cellphones,

³³ 40 TTABVUE 6.

³⁴ 40 TTABVUE 7.

³⁵ 41 TTABVUE 255.

³⁶ 41 TTABVUE 257.

³⁷ Applicant's brief, 82 TTABVUE 11.

contemporary hairstyles and designer clothing.³⁸ Applicant “has kept some crucial, defining elements of the public domain characters, but added trendy, marketable features (i.e., non-traditional colored streaks in the hair, funky leggings, colorful makeup, and fashion-forward accessories.)”³⁹ Applicant asserts “[b]y re-imagining and re-styling the public domain Tinker Bell as TEEN TINKER BELL and TEEN TINK, [Applicant] has been able to create its own version of J.M Barrie’s *Peter Pan*’s Tinker Bell.”⁴⁰

III. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a “real interest” in the proceeding and a “reasonable” basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Opposer’s standing in this proceeding is established by its live pleaded registrations, which the record shows to be valid and subsisting, and owned by

³⁸ 82 TTABVUE 10.

³⁹ 82 TTABVUE 11.

⁴⁰ 82 TTABVUE 12.

Opposer.⁴¹ *Cunningham*, 55 USPQ2d at 1844; *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012).

IV. Priority

Because Opposer's pleaded registrations are of record, priority is not an issue with respect to the goods or services identified in those registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). "[E]ach case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973) (internal citations removed).

⁴¹ 30 TTABVUE.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1375, 1380 (Fed. Cir. 2002)).

A. Focus on pleaded Registration No. 3636910.

We will focus our likelihood of confusion analysis on the mark TINKER BELL, in Opposer’s pleaded Reg. No. 3636910 (‘910 Reg.) identifying “dolls; mechanical toys,” because when that mark is considered vis-à-vis the applied-for mark and identified goods, it is that mark and goods that are most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

B. The nature and similarity or dissimilarity of the goods, the established, likely-to-continue trade channels, and the classes of purchasers.

We now consider the second and third *DuPont* factors, the similarity or dissimilarity of the parties’ goods and the parties’ established, likely-to-continue

trade channels. The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant’s goods, identified as “dolls” in both involved applications, are identical to the “dolls” identified in Opposer’s ’910 Reg. Put another way, the goods in Opposer’s ’910 Reg. subsume and are identical in part to Applicant’s goods.

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567). Inasmuch as the “dolls” identified in the involved applications and the ’910 Reg. are identical, we must presume that the channels of trade and classes of purchasers for these goods are the same. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

In view thereof, the *DuPont* factors regarding, in this case, the identity of the goods, channels of trade, and classes of purchasers strongly favor a finding of a likelihood of confusion.

C. The strength of Opposer’s TINKER BELL mark.

In determining the strength of a mark, we consider both its inherent or conceptual strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India*, 80 USPQ2d at 1899. For purposes of analysis of likelihood of confusion, a mark’s renown “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). The proper standard is the mark’s “renown within a specific product market,” *id.*, and “is determined from the viewpoint of consumers of like products,” *id.* at 1735, and not from the viewpoint of the general public.

1. Inherent or Conceptual Strength of TINKER BELL

“In order to determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-

arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). Applicant argues:⁴²

There is no evidence of record that the term TINKER BELL is inherently distinctive. Longman Dictionary defines the term “TINKERBELL” as “a fairy ...who helps Peter Pan in the play and book Peter Pan by J.M. Barrie,” and indicates that “[s]he talks to Peter Pan by making bell-like sounds.”⁴³ Similarly, Your Dictionary defines the term “TINKERBELL” as “[a]nything whose existence of power depends on the faith of believers,” and lists the origin of the term as “a fairy in J M Barrie’s *Peter Pan*.”⁴⁴ Macmillan Dictionary echoes a[n] analogous [sentiment] that the term “TINKERBELL” is “used to refer to ideas that lack substance or validity and require unquestioning support: named after the character in J M Barrie’s Peter Pan who returned from near death because of the audience’s belief in her.”⁴⁵ Likewise, the term TINKER BELL is not coined or arbitrary; in fact, its definition refers to the public domain character featured in J.M. Barrie’s 1911 novel. Its presence in scores of third-party registrations and third-party uses in the field of dolls and other related toys demonstrates that it is highly suggestive of a public domain character. In fact, for a doll that depicts the public domain character Tinker Bell, the name TINKER BELL or TINK is highly suggestive in that it names and describes the character depicted.⁴⁶

Applicant relies on a non-precedential ex parte decision by this tribunal involving its application to register the mark ZOMBIE CINDERELLA for dolls in support of its contention.⁴⁷ See *In re United Trademark Holdings, Inc.*, Serial No. 85706113 (“For such goods [dolls], the term CINDERELLA in Registrant’s mark would be, at a

⁴² The Board grants Applicant’s request for judicial notice of the submitted dictionary definitions, all retrieved by Applicant on May 15, 2019. See, e.g., *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018).

⁴³ Definition retrieved from Longman Dictionary of Contemporary English, ldoceonline.com.

⁴⁴ Definition retrieved from Your Dictionary, yourdictionary.com.

⁴⁵ Definition retrieved MacMillan Dictionary, macmillandictionary.com.

⁴⁶ 82 TTABVUE 27.

⁴⁷ *Id.*

minimum, highly suggestive of the goods.”). Although parties may cite to non-precedential decisions, the Board does not encourage the practice. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011); *see also In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (parties may cite to non-precedential decisions, but they are not binding on the Board and because they have no precedential effect, the Board generally will not discuss them in other decisions). We add, nonetheless, that the record in that case showed that numerous dolls depicting the character CINDERELLA were offered in the market by entities unrelated to the owner of the cited registration (Opposer herein). As discussed below, the record in the case before us does not support such a finding.

The facts in this case may further be distinguished from the facts presented in *In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796 (TTAB 2017), in which the Board affirmed the examining attorney’s refusal of registration of the applicant’s (Applicant herein) mark LITTLE MERMAID for dolls on the basis of mere descriptiveness. In that decision, the Board found:

[A] fictional public domain character like the Little Mermaid of the Hans Christian Anderson fairy tale is not necessarily linked to a specific commercial entity and may be presented in various embodiments because prospective purchasers expect dolls labeled as LITTLE MERMAID to represent the fairy tale character and, thus, describes the purpose or function of the goods (i.e., to represent the Little Mermaid of the fairy tale).

In re United Trademark Holdings, Inc., 122 USPQ2d at 1799. In the case before us, as discussed above, Opposer secured acquired exclusive rights to “make, reproduce, and exhibit animated cartoon motion pictures and engage in

merchandising activities related” to the works of J.M. Barrie, featuring the character TINKER BELL.⁴⁸ Thus, in this case Opposer has demonstrated a proprietary interest in the theatrical and literary works from which TINKER BELL is derived.

We note, however, that even in the event Opposer had not demonstrated such an interest, the above decisions are ex parte determinations in which Opposer was not a party. In the case before us, Opposer has pleaded and proven that it owns approximately thirty registrations for TINKER BELL marks, including the '910 Reg. Contrary to Applicant's arguments, Opposer's TINKER BELL mark in the '910 Reg. is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Tea Bd. of India*, 80 USPQ2d at 1889. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register shall be prima facie evidence of the validity of the registrations, of Opposer's ownership of the marks and its exclusive right to use the marks in connection with the goods or services identified in the certificates. Inasmuch as Applicant has not counterclaimed to cancel any of Opposer's pleaded registrations, the validity of Opposer's '910 Reg. remains unchallenged.⁴⁹ Given

⁴⁸ 40 TTABVUE 6.

⁴⁹ In its brief (82 TTABVUE 18 n.5, 24 n.6) Applicant asserts that it is not attempting to collaterally attack the validity of the pleaded registrations, but merely argues that they are “entitled to only a narrow scope of protection due to the highly suggestive and diluted nature of the shared terms in connection with the relevant goods.” *Id.* We so construe Applicant's arguments.

our limited jurisdiction, we will consider Applicant's arguments and evidence regarding the presence of the character TINKER BELL in the public domain solely in the context of Opposer's claim of likelihood of confusion.

As discussed *infra*, there is no question on this record that TINKER BELL refers to a fairy originally created by J.M. Barrie in approximately 1904, reimagined by Opposer's predecessors in interest in 1953 after twelve years of revisions, and sought to be reimagined by Applicant in 2013. There is also no question that the dolls identified by Opposer's TINKER BELL mark depict the character of the same name, as reimagined by Opposer and its predecessors in interest. *Cf. In re Carlson Dolls Co.*, 31 USPQ2d 1319, 1320 (TTAB 1994) (MARTHA WASHINGTON merely descriptive of dolls portraying the historical individual Martha Washington.).

In addition, "evidence of third-party registrations [for the same or similar goods or services] is relevant to 'show the sense in which a mark is used in ordinary parlance,' ... that is, some segment that is common to both parties' marks may have 'a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.'" *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason)); *see also In re*

I-Coat Co., LLC, 126 USPQ2d 1730, 1735 (TTAB 2018) (third-party registrations can be used to demonstrate that a term may have a commonly accepted meaning); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011) (third-party registrations indicate term CLASSIC has suggestive meaning as applied to tobacco products).

Applicant introduced copies of third-party registrations printed from the USPTO Trademark Status and Document Retrieval system (TSDR) for TINKER BELL, TINKER and TINK marks applied to a variety of goods and services.⁵⁰

These include:

1. Reg. No. 2479251 for the mark TINKERBELLE identifying live plants, namely, lilacs;
2. Reg. No. 2529105 for the mark TINK identifying various computer programs, educational and research services in the fields of information and knowledge management;
3. Reg. No. 3982945 for the mark TINK'S identifying scent eliminating laundry detergent, soap and dryer sheets for use with hunting and outdoor activities;
4. Reg. No. 4547764 for the mark TINK'S identifying compact discs and DVDs in the field of hunting;⁵¹
5. Reg. No. 4670408 for the mark TINK identifying live musical performances by a performing artist;
6. Reg. No. 5425938 for the mark TINKERBELL identifying laboratory apparatus;

⁵⁰ 62 TTABVue 5-24. All marks are presented in typed or standard characters unless otherwise shown.

⁵¹ Reg. Nos. 3982945 and 4547764 are owned by the same entity.

7. Reg. No. 3700023 for the mark TINKER identifying computer game software;
8. Reg. No. 368132 for the mark PICKLED TINK identifying electronic and mail order catalog services featuring maternity clothing and adult jewelry;
9. Reg. No. 3741020 for the mark CAMP TINK identifying wellness assessments, routines, maintenance schedules and counseling;
10. Reg. No. 3998707 for the mark TINKER identifying various telecommunications services;
11. Reg. No. 3620842 for the mark SMITH & TINKER identifying video game software, various media featuring fantasy characters and handheld units for playing electronic games;
12. Reg. No. 3442528 for the mark TASK TINKERS identifying various electronic media and entertainment services in the field of children's entertainment and education;
13. Reg. No. 3257957 for the mark WICKED TINKERS identifying various audio and video media featuring music and visual entertainment;
14. Reg. No. 4030966 for the mark TINKER TABLES identifying tables;
15. Reg. No. 4591304 for the mark TINKSKY identifying various items of clothing;
16. Reg. No. 4514477 for the mark TINKERSPHERE identifying online retail hobby store services;
17. Reg. No. 4710527 for the mark THE LAST TINKER identifying various electronic and computer goods; toys including toy figurines; and entertainment services featuring video games and information related thereto; and

18. Reg. No. 4692373 for the mark TINKER TIN identifying travel trailer rental.

The above registrations tend to show that third parties have registered marks including the terms TINKER BELL, TINKER or TINK for various goods and services. Only five of these registrations recite goods and services that are directed toward children and include toys, but none identifies dolls. As a result, this evidence has limited probative value in our consideration of the strength of Opposer's TINKER BELL mark. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (third-party registrations relating to goods different from and unrelated to the goods at issue "cannot be indicative of descriptive or suggestive connotations").

On this record, we find Opposer's inherently distinctive TINKER BELL mark to be highly suggestive of the dolls identified thereby, primarily inasmuch as the dolls depict the character TINKER BELL.

2. Commercial Strength of Opposer's TINKER BELL Mark

Commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India*, 80 USPQ2d at 1899. We consider the extent of commercial strength or weakness in the marketplace under the fifth and sixth *DuPont* factors, "fame of the prior mark (sales, advertising, length of use)" and "the number and nature of similar marks in use on similar goods." *DuPont*, 177 USPQ at 567. The fifth *DuPont* factor (fame) examines the extent to which the public perceives the mark as indicating a single source of origin. Conversely, the sixth factor, "the number and nature of similar marks in use on similar goods," mitigates against

a mark's potential recognition by considering whether, because of widespread third-party use of similar marks in the marketplace, "customers have been educated to distinguish between different such marks on the bases of minute distinctions." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Commercial strength may be measured "by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014). It is considered from the perspective of "the class of customers and potential customers" of the relevant goods, in this case purchasers and potential purchasers of dolls. *Palm Bay*, 73 USPQ2d at 1695 (The relevant consuming public consists of the "class of customers and potential customers of a product or service, not the general public"); *see also Joseph Phelps*, 122 USPQ2d at 1734 (focusing on "the class of customers and potential customers of a product or service, and not the general public.").

Opposer's testimony and evidence establish that Opposer first released the animated motion picture *Peter Pan* in 1953, reimagining TINKER BELL as a major character and recasting her as a feminine figure with a distinct personality.⁵² Since that time, Opposer has franchised TINKER BELL as a Disney Fairy and she has appeared in eight additional movies, as well as a television broadcast and short film.⁵³

⁵² James Decl. 40 TTABVUE 6-11.

⁵³ 40 TTABVUE 7-11.

Opposer has featured TINKER BELL live at its resorts, and on numerous types of merchandise, Opposer's television programs and cable channels, website, physical store locations and its TINKER BELL half marathon.⁵⁴ Opposer further has introduced examples of its marketing and advertising for goods under the TINKER BELL mark and screenshots from the TINKER BELL Facebook page.⁵⁵

Particularly with regard to dolls, Opposer's testimony and evidence establishes that Opposer has offered for sale TINKER BELL dolls since 1994.⁵⁶ Opposer's "TINKER BELL is depicted as a fairy-like female figure with blond-hair, blue eyes, green dress, wand, and often resembling a teen or with a teenage appearance and physique"⁵⁷ as shown below:⁵⁸

⁵⁴ 40 TTABVUE 12-19.

⁵⁵ 40 TTABVUE 32; ⁵⁷ TTABVUE 4-27.

⁵⁶ 40 TTABVUE 19.

⁵⁷ *Id.*

⁵⁸ 46 TTABVUE 31-44.



Opposer has introduced confidential testimony and evidence regarding its sales related to various goods under its TINKER BELL mark. These numbers are substantial. Opposer also introduced evidence of awards and unsolicited news articles in various media discussing TINKER BELL and her status as a “famous” and “iconic” brand and character, whose more recent accolades include a 2010 star on the Hollywood Walk of Fame, a 2008 appearance in Madame Tussauds Wax Museum, and selection in 2009 as an honorary United Nations Ambassador of Green to promote environmental initiatives.⁵⁹

Applicant, on the other hand, argues that Opposer’s TINKER BELL mark is “commercially weak and diluted as a result of widespread third-party use in

⁵⁹ 40 TTABVUE 19; 33 TTABVUE 1-515.

connection with various goods relating to the Tinker Bell character, including dolls and comparable toy goods.”⁶⁰ In support of this contention, Applicant submitted “20 third-party uses of the terms TINKER BELL and TINK in connection with dolls and other related toy products.”⁶¹ However, Opposer counters that it

[E]stablished through the rebuttal testimony of Katherine James that 9 of UTH’s 20 Internet images (4(A), 4(D), 4(E), 4(G), 4(H), 4(I), 4(J), 4(K) and 4(L)) identify products that are authorized or licensed by *Disney*. (75 TTABVUE 4-7.) Disney also showed that Internet image 4(Q) is no longer accessible, so neither the Board nor consumers can access or review the information on this page. (*Id.* at 8.) In addition, 5 of the remaining 10 Internet images (4(B), 4(M), 4(R), 4(T), and 4(V)) show unrelated goods and services, including a news article about a Saturday Night Live skit, custom tapestries, adult party planning services, candles, customizable bobbleheads with human faces, and crochet patterns. (*Id.* at 9-13.) Internet image 4(S) displays a “collectible” doll from 1991, which appears to be manufactured by a Chinese company and there is no evidence that this product has been or is available in the U.S. (*Id.* at 11.) Further, the remaining 3 Internet images 4(N), 4(O), and 4(W) actually show two of the same doll costume and a figurine that appears to show unauthorized use of copyrights owned by Disney. (*Id.* at 11-13.)⁶²

On this record, Applicant’s evidence does not support its contention that Opposer’s TINKER BELL mark is subject to widespread third-party use in connection with dolls and related toys. However, Opposer’s testimony and evidence of media exposure, revenues and marketing for goods under its TINKER BELL mark fail to indicate the extent to which these activities and revenues pertain to dolls. Opposer’s evidence indicates that the character TINKER BELL as reimagined by Opposer and its

⁶⁰ 82 TTABVUE 34.

⁶¹ 82 TTABVUE 34-37; 64 TTABVUE 1-104.

⁶² Opposer’s rebuttal brief, 87 TTABVUE 13; James Rebuttal Declaration, 75 TTABVUE 1-151.


predecessors enjoys widespread recognition and iconic status. However, the record is unclear as to whether TINKER BELL's notoriety extends to Opposer's dolls. Further, Opposer's evidence lacks the context useful for us to determine the extent of the commercial impact made by the impressions or whether the amounts stated are significant in the industry compared to Opposer's numerous other character dolls, such as its Disney Princess dolls, or dolls produced by third parties. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("[S]ome context in which to place raw statistics is reasonable"); *cf. Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1480 (TTAB 2016) (probative value of sales revenue figures quantified as doses sold is diminished by the fact that the amount is just a raw number without context as to applicant's market share or whether this amount is significant in the industry).

As discussed above, Opposer's TINKER BELL mark is inherently distinctive, albeit highly suggestive. Opposer's testimony and evidence related to the notoriety and even iconic status of the character TINKER BELL does not, on this record, demonstrate that the mark TINKER BELL is iconic or "famous" as applied to dolls. Considering both inherent and commercial strength, we find Opposer's mark TINKER BELL, as applied to dolls, is entitled to an ordinary scope of protection on the spectrum of "very strong to very weak." *Joseph Phelps*, 122 USPQ2d at 1734 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1059 ("The commercial strength of Petitioner's TAO mark outweighs any conceptual weakness.").

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

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d at 1812; accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721).

Opposer’s mark is TINKER BELL in standard characters. Applicant’s marks are

TEEN TINKER BELL in standard characters and 

To state the obvious, Applicant’s TEEN TINKER BELL mark fully encompasses Opposer’s TINKER BELL mark. As a result the marks are highly similar in appearance and sound. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *See e.g., Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner). Applicant argues that its marks begin with the word

“TEEN” which is most likely to be remembered due to its position as the first word thereof. *See, e.g., Palm Bay*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the wine label.). Here, however, Applicant seeks to avoid a finding of likelihood of confusion by appropriating the entirety of a registered mark and adding a suggestive term to it. *Cf. In re Denisi*, 225 USPQ 624 (TTAB 1985); *State Historical Socy of Wis. v. Ringling Bros.-Barnum Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976). Applicant acknowledges that its dolls depict TINKER BELL as a teenager or adolescent.⁶³ As a result, the term “TEEN” in Applicant’s TEEN TINKER BELL mark is at best suggestive of a feature or characteristic of Applicant’s goods, and reinforces that the wording TINKER BELL identifies a female character.

The marks are also similar in connotation. Opposer’s TINKER BELL mark connotes the character originally conceived by J.M. Barrie and reimaged by Opposer. As applied to Opposer’s dolls, its TINKER BELL mark immediately suggests the “graceful and gorgeous” creature, as sketched and re-sketched by Opposer’s predecessors, the size of Peter Pan’s thumb but possessing “the miniature proportions of a beauty contest winner and pin-up favorite.”⁶⁴ We find no support for Applicant’s argument that consumers will interpret Opposer’s TINKER BELL mark to “directly refer to the well-known fairy tale character Tinker Bell and evoke classic images of a small pixie fairy, covered in a green skeleton leaf and sprinkling fairy

⁶³ 82 TTABVUE 21.

⁶⁴ 41 TTABVUE 257.

dust”⁶⁵ and “will immediately be reminded of the public domain character who represents children’s imaginations and hope.”⁶⁶ As discussed above, Opposer’s TINKER BELL dolls do not depict the fairy as imagined by J.M. Barrie, but rather Opposer’s reimagining of TINKER BELL as an attractive, feminine creature, a diminutive pin-up. We find that connotation to be closely related to the connotation created by Applicant’s TEEN TINKER BELL mark, evoking the same beautiful character in her adolescent, teen years. In other words, TEEN TINKER BELL connotes Opposer’s TINKER BELL at a particular part of her life, namely, at adolescence not unlike that experienced by a teenaged girl. As a result, we find the marks to be more similar than dissimilar, and to convey similar commercial impressions overall.



Applicant’s mark is only somewhat similar to Opposer’s TINKER BELL mark in appearance and sound. However, because Opposer’s mark is displayed in standard characters, it may appear in any size or font, including a



stylized font identical to that in which Applicant’s mark appears. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Viterro Inc.*, 671 F.3d 1358, 101

⁶⁵ 82 TTABVUE 21.

⁶⁶ 82 TTABVUE 21.

USPQ2d 1905, 1909-11 (Fed. Cir. 2012). We must consider all reasonable presentations of Opposer's TINKER BELL mark including in the same stylization found in Applicant's mark. *See Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); *Cunningham*, 55 USPQ2d at 1847-48.

The marks are more similar in meaning or connotation inasmuch as "TINK" refers in shorthand to TINKER BELL. Applicant acknowledges that "J.M. Barrie also interchangeably uses the names Tinker Bell and Tink throughout the novel to refer to Tinker Bell."⁶⁷ As discussed above, Applicant's mark connotes TINKER BELL as an adolescent teenager, but nonetheless connotes the same character.

We further do not discount the presence of the tiara design in Applicant's mark. We note nonetheless that the tiara design is relatively small and less significant than the wording in creating the overall commercial impression conveyed thereby. It is settled that where, as here, a mark is comprised of both words and a design, the words are normally accorded greater weight, in part because consumers are likely to remember and use the word(s) to request the services. *In re Viterro Inc.*, 101 USPQ2d at 1911 ("[T]he verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) ("[I]f one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services" and "because applicant's mark shares with registrant's mark that

⁶⁷ 82 TTABVUE 14; 63 TTABVUE 24, 25, 84.

element responsible for creating its overall commercial impression, the marks are confusingly similar”).

We find that this general principle is applicable here. In Applicant’s



mark, TEEN TINK is the only literal element, and appears prominently below the design, essentially creating a frame for the wording and drawing additional attention thereto. Those interested in Applicant’s dolls would rely on the wording TEEN TINK which more clearly identifies a source of goods than the tiara design and would also be used to refer to the mark when spoken.



Based upon the foregoing, we find Applicant’s mark is more similar to than dissimilar from Opposer’s TINKER BELL mark in appearance, sound and connotation and, overall creates a similar commercial impression. The marks again appear to be variations of each other that nonetheless suggest a single source, identifying dolls representing the character TINKER BELL.

Finally, we note that, “[w]hen marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *See Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994); *see also ECI Division of E-Systems, Inc. v. Envtl. Commc’ns Inc.*, 207 USPQ 443, 449 (TTAB 1980).

In view thereof, the *DuPont* factor regarding the similarity of the marks favors a finding of a likelihood of confusion.

E. The variety of goods or services on which a mark is or is not used.

The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used. *DuPont*, 177 USPQ at 567. “If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *Shannon DeVivo v. Celeste Ortiz*, 2020 USPQ2d 10153, *15 (TTAB 2020); *See also*, e.g., *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014) (“[C]onsumers who may be familiar with various products in the [Opposer’s] product line, when confronted with applicant’s mark, would be likely to view the goods marked therewith as additional products from [Opposer]. One of the circumstances mentioned in the ninth *DuPont* factor is the variety of goods on which a prior mark is used.”).

Opposer argues:

[I]t is undisputed that Disney has used and registered its TINKER BELL & TINK Marks on a wide range of products and services, including films, television programs, amusement parks, dolls, toys, clothing, bags, jewelry, books, DVD and video recordings. ... As shown above, consumers understand and are accustomed to Disney’s long history of offering and licensing a wide variety of products and services tied to its famous films and character franchises. ... Indeed, Disney owns 30+ trademark registrations for its TINKER BELL & TINK Marks covering a wide variety of goods and services.⁶⁸

⁶⁸ 79 TTABVUE 39. Internal citations omitted. Opposer presented these arguments in further support of its position that the parties’ goods are related.

[Opposer's] witness testified that for decades the company has produced films, television programs, and amusement park attractions launching its character brands, including its TINKER BELL & TINK Marks. ... [Opposer] also engages in extensive licensing and merchandising under its character brands, including for toys and dolls, to maximize and reinforce public exposure to its character brands that originated from films. ... Thus, consumers are accustomed to and have an expectation that dolls are a common type of licensed merchandise tied to characters from films.⁶⁹

Opposer has introduced evidence that it has re-released its animated *Peter Pan* film in theaters on five occasions and on various media for personal purchase; and has also released the sequel *Peter Pan 2: Return to Neverland*.⁷⁰ Opposer's website includes excerpts from these films, character highlights, games and links to purchase products bearing, inter alia, the TINKER BELL mark.⁷¹ In 2006, Opposer created a new franchise featuring the TINKER BELL character and a new set of Disney Fairies, and released numerous books, six full length films, a television special and an additional short film all starring TINKER BELL.⁷² TINKER BELL also appears in person at Opposer's theme parks, at the TINKER BELL half-marathon, and in *Disney on Ice* programs.⁷³ The character and name TINKER BELL also appear on a wide variety of children's and adult clothing, jewelry, toys, glasses, mugs, figurines, pictures and prints and other gift items in addition to dolls.⁷⁴

⁶⁹ 79 TTABVUE 40.

⁷⁰ 40 TTABVUE 7.

⁷¹ 40 TTABVUE 7; 42 TTABVUE 4-5.

⁷² 42 TTABVUE 6, 36-41.

⁷³ 40 TTABVUE 8-17.

⁷⁴ 51 TTABVUE 4-145.

We therefore find that consumers are accustomed to encounter Opposer's TINKER BELL mark on a wide variety of goods and services, and are likely to view Applicant's teen-themed dolls as additional products from Opposer's line of products and services. The ninth *DuPont* factor thus favors a finding of likelihood of confusion.

F. Conditions under which sales are made, that is, “impulse” vs. careful, sophisticated purchasing.

This *DuPont* factor examines the conditions under which, and to whom, sales are made. Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.

As identified, the parties' “dolls” are not limited in any manner as to their purchasers, conditions of sale or price. We therefore must presume that both parties' dolls are available at all price points to all consumers, including ordinary consumers who may purchase dolls on impulse or otherwise not exercise a great deal of care in their purchasing decisions, in addition to more discerning purchasers and collectors. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000) (must focus on identifications, regardless of any actual marketplace evidence of “the particular channels of trade, or the class of purchasers to which sales of the goods or services are directed”); *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016); *see also Stone Lion*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”).

In addition, we must presume that the parties' goods include dolls available at modest prices that may be subject to casual purchase.⁷⁵ "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (citations omitted). Furthermore, there is nothing in the record to suggest that purchasers of dolls are more discriminating than the average consumer. The conditions of sale and nature of the prospective consumers therefore favor finding a likelihood of confusion.

G. Actual confusion

The seventh *DuPont* factor is the "nature and extent of any actual confusion, while the eighth *DuPont* factor considers the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *DuPont*, 177 USPQ at 567.

In its decision on remand from the Federal Circuit's decision in *In re Guild Mortg. Co.*, 129 USPQ2d 1160, the Board recently held that the eighth *DuPont* factor "requires us to look at actual market conditions, to the extent there is evidence of such conditions of record." *In re Guild Mortg.*, 2020 USPQ2d 10279, *15 (TTAB 2020). Evidence of actual confusion "is too important to be established by means of an inference, unsupported by corroborating evidence." *Toys "R" Us, Inc. v. Lamps R Us*,

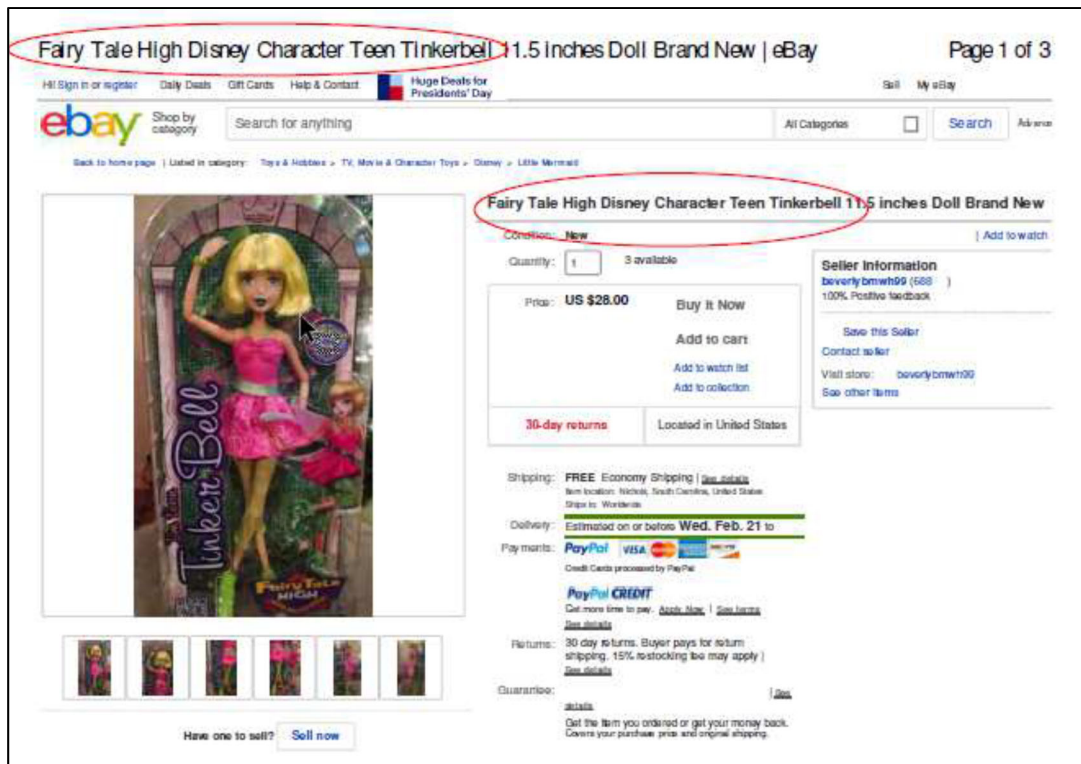
⁷⁵ Evidence of record indicates that, at time of trial, Opposer's dolls are available at \$26.95 and Applicant's dolls are available at \$19.55-\$37.59. 41 TTABVUE 162, 174; 32 TTABVUE 6-8.

219 USPQ 340, 346 (TTAB 1983). It further is well-established that mere inquiry regarding whether there is a relationship between the parties is not evidence of confusion. *See, e.g., Couch/Braunsdorf Affinity*, 110 USPQ2d at 1479 (inquiry is not evidence of confusion because the inquiry indicates that the prospective customer had a reason to suspect that there were two different companies).

Opposer argues:

In this case, UTH's bad-faith pattern of filing and using marks encompassing Disney brands, including but not limited to UTH's TEEN TINKER BELL & TEEN TINK Marks, has resulted in actual confusion. Disney submitted evidence that consumers and mainstream websites have mistakenly identified and referred to UTH's dolls, including those offered under UTH's TEEN TINKER BELL & TEEN TINK Marks, as "Disney dolls" and "Disney" brands. [31 TTABVUE.] Further, at least one major retailer used Disney's logo on the same page offering UTH's dolls as shown below. [*Id.*] Among others, Pinterest, Facebook, eBay, Kmart.com, and YahooShopping.com have similarly, mistakenly referred to and identified UTH's dolls as "Disney Dolls" or "Disney Character," including the representative examples below. [31 TTABVUE 81-118.]⁷⁶

⁷⁶ Opposer's brief; 79 TTABVUE 54.



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Applicant argues:

Disney submitted a small number of documents, attempting to demonstrate actual confusion. [79 TTABVUE 54-55.] The screenshots, however, do not demonstrate sales confusion. Rather, the evidence shows how Disney has attempted to take a character out of the public domain. Moreover, the Facebook screenshot on page 47 of Disney's Brief does not indicate that the individual who posted the photograph was a U.S. consumer or purchased the doll from the U.S. [79 TTABVUE 55.] The screenshot from Pinterest also lacks any probative value as a U.S. consumer cannot purchase anything from the website, and the K-Mart screenshot does not show the price or indicate a way for a consumer to purchase the product. *Id.* As a result, none of the screenshots show actual confusion or are probative as they do not show sales confusion and the seventh *DuPont* factor weighs against a finding of a likelihood of confusion.⁷⁸

⁷⁷ 31 TTABVUE 96; 79 TTABVUE 55.

⁷⁸ 82 TTABVUE 43.

We find no support for Applicant's contentions that Opposer's evidence supporting its claim of actual confusion shows that Opposer has attempted to take the character of TINKER BELL out of the public domain. Nonetheless, the internet postings, while admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), also constitute hearsay and may not be relied upon for the truth of the matters asserted therein. Fed. R. Evid. 801(c); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010); Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 704.08 (June 2019) ("Even if properly made of record, however ... internet printouts would only be probative of what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters.").

On its face, this evidence shows a modest number of third-party vendors and resellers on such internet platforms as eBay, Pinterest, K Mart, Sears and Yahoo have referred to Applicant's teen fairy tale princess dolls, including dolls under its involved marks, as a "Disney Character" or "Disney Fairy Tale High" dolls or otherwise indicated that they are Disney products or advertised them in connection with Disney products.⁷⁹ There is little evidence of record as to the extent to which Applicant has advertised or promoted its marks at issue or how many customers it has attracted since the launch of its Fairy Tale High line of dolls in 2013. The length of time during which there has been concurrent use is also relatively short, i.e., approximately six years at time of trial. Thus, the extent to which there has been an opportunity for

⁷⁹ 31 TTABVue 82-83, 88-89, 96-97, 99-112, 115-116, 118.

actual confusion to occur appears limited. *DuPont*, 177 USPQ at 567. Accordingly, the seventh and eighth *DuPont* factors are neutral.⁸⁰

H. Applicant's intent in adopting its marks.

Under the thirteenth *DuPont* factor, evidence of an applicant's bad faith adoption of its mark is relevant to our likelihood of confusion analysis. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1553 (TTAB 2012); *L.C. Licensing Inc. v. Cary Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008) (bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion). Establishing bad faith requires a showing, by a preponderance of the evidence, that the applicant intentionally sought to trade on the goodwill or reputation associated with an opposer's mark. *See also J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion."); *Tea Bd. of India*, 80 USPQ2d at 1902.

Opposer argues:

UTH filed two applications to register the TEEN TINKER BELL & TEEN TINK Marks—which encompass the entirety of Disney's TINKER BELL & TINK Marks and cover identical goods—after 65 years of development and investment in these marks by Disney. It is no coincidence that UTH filed applications for both of Disney's well-known TINKER BELL & TINK Marks—UTH did so to take advantage of the fame and brand-recognition of Disney's iconic TINKER BELL & TINK Marks. In fact, UTH has a bad-faith pattern of filing numerous

⁸⁰ We note nonetheless that the test under Section 2(d) is not actual confusion but likelihood of confusion. It is not necessary to show instances of actual confusion to establish likelihood of confusion. *Herbko Int'l. v. Kappa Books*, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990).

trademark applications and using marks encompassing Disney brands, attempting to trade-off of the release of Disney's popular films and successful character merchandising. UTH has sought registration of numerous marks following the release of Disney's well-known films and character franchises offered under the same brands.⁸¹

Applicant argues:

Such an assertion, however, lacks merit as UTH is not attempting to 'take advantage of the fame and brand-recognition' of Disney's marks, but rather is attempting to create an entirely new, protectable version of a beloved public domain character by changing the storyline and adding new traits and facts to the Tinker Bell character.⁸²

Applicant further argues that by recasting TINKER BELL in her adolescence, it is "merely attempting to make use of a public domain character in a different light, not trade off any alleged fame"⁸³ of Opposer's marks.

After careful review of the evidence of record, we conclude that Opposer has not provided sufficient support for its assertion that Applicant adopted its marks in bad faith. The facts of this case are distinguishable from *L.C. Licensing*, upon which Opposer relies in support of its position. In *L.C. Licensing*, the applicant's principal officer was unable to "explain why he has tried to register two urban lifestyle clothing brands for custom automotive accessories," *Id.* at 1891, leading the Board to conclude that the applicant intended "to trade off of opposer's ENCYE mark." *Id.* In this case, Applicant has explained its intention to base its line of dolls on fairy tale characters assertedly from the public domain, reimagined as trendy, contemporary teenagers.

⁸¹ Opposer's trial brief, 79 TTABVUE 52.

⁸² 82 TTABVUE 42.

⁸³ *Id.* at 43.

This is a far more plausible explanation than “I don’t know” provided by the applicant in *L.C. Licensing, Id.* Opposer further relies upon *L’Oreal S.A. and L’Oreal USA, Inc. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012), in which the Board found the “applicant had a history and pattern of filing intent-to-use applications for a disparate range of products for which he has no industry-relevant experience, and where the applied-for marks are identical to some of the best known, previously registered marks in the country.” *L’Oreal*, 102 USPQ2d at 1441. Again, in the case presently before us, Applicant does not seek to wholly appropriate the trademarks of numerous third parties for a variety of items. In short, Applicant has provided a plausible explanation as to why it adopted involved marks. Certainly, Applicant was aware of Opposer and its marks at the time it filed the involved applications, and its dolls are more evocative of Opposer’s reimagining of TINKER BELL than the character originally created by J.M. Barrie and depicted in his original play and stories. The record also reflects Applicant’s filing of applications for other fairy tale characters whose names are also subjects of Opposer’s marks.⁸⁴ However, Opposer’s evidence falls short of demonstrating Applicant’s bad faith adoption of the involved marks.

Accordingly, this *DuPont* factor is neutral.

I. Summary

Because the marks are similar, the goods are identical and we must presume that the goods are offered in the same channels of trade and to the same classes of consumers and may be subject to impulse purchase, we find that the applied-for mark

⁸⁴ 31 TTABVUE.

used in connection with Applicant's recited goods is likely to cause confusion with Opposer's previously used and registered mark. We find on this record that Opposer's TINKER BELL mark is entitled to a normal scope of protection, and that Opposer has demonstrated that it offers a wide variety of goods and services under its TINKER BELL mark such that Applicant's goods may be viewed as an additional product line of Opposer.

Decision: The notice of opposition is sustained on the ground of priority and likelihood of confusion with the mark in Registration No. 3636910 and registration to Applicant of both involved applications is refused.