

This Opinion is Not a
Precedent of the TTAB

Mailed: April 21, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Me and the Mouse Travel, LLC
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Serial No. 76717725

Paul M. Denk
for Me and the Mouse Travel, LLC.

Deborah Meiners, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Kuhlke, Lykos and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Me and the Mouse Travel, LLC (“Applicant”) seeks registration on the Principal Register of the mark Me and The Mouse Travel and design, as amended:¹

¹Applicant’s original drawing of the mark, which is set forth below, depicted a white gloved hand with three fingers and a thumb and black lines on the glove:





for:

travel agency services, in the planning and arranging of travel and tours, in International Class 39.²

Registration was refused under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that the proposed mark consists of or includes matter which falsely suggests a connection with Disney Enterprises, Inc. (“Disney”).³ Specifically that Applicant’s mark when used for “travel agency services, in the planning and

² Application Serial No. 76717725 was filed on March 17, 2015, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The word “travel” has been disclaimed. According to Applicant, the amended drawing depicts an ungloved white hand and no lines. As we view the amended drawing, it depicts either an ungloved white hand or a white gloved hand, in either case with four fingers and a thumb and no lines. Because Applicant and the Examining Attorney do not appear to agree whether the hand in the amended drawing is gloved or ungloved, we will simply refer to it *infra* as a “white hand.” The Examining Attorney’s conclusion that the amendment was non-material because the commercial impressions of the original mark and the amended mark remain the same is not before us on appeal.

³ “Disney” refers to all of the “Disney” entities, including “Disney Enterprises” and “The Walt Disney Company.”

arranging of travel and tours” falsely suggests a connection with Disney within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), because it includes the phrase “The Mouse” and the depiction of a black arm and a white hand. When the refusal was made final, Applicant appealed.

I. False Suggestion of a Connection.

Section 2(a) prohibits the registration of any mark that, *inter alia*, consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols. To establish that a proposed mark falsely suggests a connection with a person or an institution, it is the Examining Attorney’s burden to show:

(1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;

(2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;

(3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and

(4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant’s goods or services, a connection with the person or institution would be presumed.

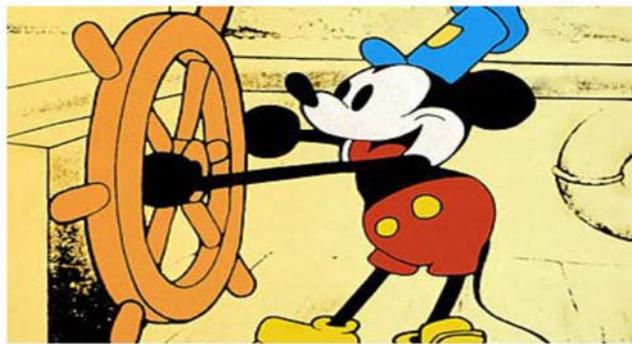
In re Pedersen, 109 USPQ2d 1185, 1188-89 (TTAB 2013); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used by the Board to determine the existence of a false connection).

The requirement that the challenged registration be a “close approximation” of the identity of the target person or institution is more stringent than “reasonably understood as referring to’ opposer’s identity” which may be sufficient for the disparagement bar. *Bos. Red Sox v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). The similarity required for a “close approximation” is similar to that required for likelihood of confusion under Section 2(d). *Bos. Red Sox v. Sherman*, 88 USPQ2d at 1593 (No § 2(a) false connection or § 2(d) likelihood of confusion bars against SEX ROD in lettering the same as Opposer’s RED SOX baseball team.); *Bos. Athletic Ass’n v. Velocity, LLC*, 117 USPQ2d 1492, 1495 (TTAB 2015) (MARATHON MONDAY for wearing apparel did not falsely suggest a connection with the promoters of the Boston Marathon, noting that several other entities used the designation. “It has not been shown that MARATHON MONDAY is a recognized name of the commercial entity responsible for the Boston Marathon.”). See J. McCarthy, 3 McCarthy on Trademarks and Unfair Competition § 19.76 (4th ed. rev. Mar. 2017). See also *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, (Fed. Cir 2012); *Application of Ferrero*, 479 F.2d 1395, 178 USPQ 167, 168 (CCPA 1973) (“The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source.”).

The Examining Attorney asserts that “the applied-for mark contains a design element that is a close approximation of a portion of the character Mickey Mouse and also contains the wording ‘Mouse.’ ... and the applied-for mark points uniquely and

unmistakably to Disney because of the Applicant's use of a portion of Disney's most recognizable character for travel-related services." Brief, 7 TTABVUE 5.

To support the argument, the Examining Attorney submitted a number of articles discussing the Mickey Mouse character ("Mickey"). Mickey was created in 1928;⁴ the short film, *Steamboat Willie*, released on November 18, 1928 was considered Mickey's debut.⁵ Depicted below is Mickey as he appeared in *Steamboat Willie*:



Everett

Mickey Mouse in *Steamboat Willie*, 1928.

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In 1935 Mickey received his first makeover. He was given "a pear-shaped body, pupils, white gloves and a shortened nose, to make him cuter."⁷ Representative samples of depictions of the character, after the makeover, include:

⁴ June 27, 2015 Office Action and the following exhibits:

Mickey Mouse, Wikipedia en.wikipedia.org, *Id.* at 8.

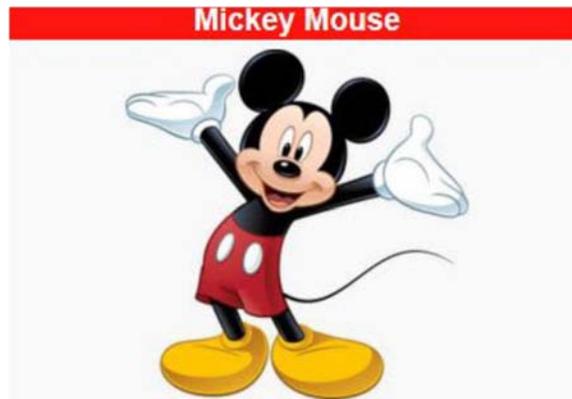
Soraya Roberts, Mickey Mouse's birthday has Walt Disney's most famous cartoon rodent turning 82, N.Y. Daily News, November 18, 2010, www.nydailynews.com, *Id.* at 20;

Claire Suddath, A Brief History of Mickey Mouse, Time, November 18, 2008 content.time.com, *Id.* at 24.

⁵ Mickey Mouse, Wikipedia en.wikipedia.org, June 27, 2015 Office Action, p. 7.

⁶ Claire Suddath, A Brief History of Mickey Mouse, Time, November 18, 2008 content.time.com, *Id.* at 24.

⁷ *Id.* at 25.



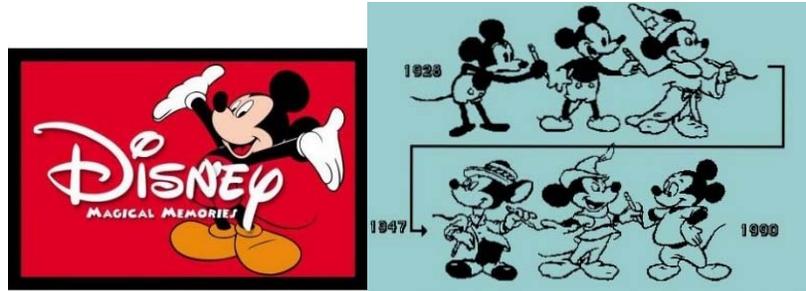
“Each of Mickey’s hands has only three fingers and a thumb ... Mickey was first given white gloves as a way of contrasting his naturally black hands against his black body”⁸;



Disney Junior Webpage⁹;

⁸ Mickey Mouse, Wikipedia en.wikipedia.org, June 27, 2015 Office Action, pp. 5, 7.

⁹ Disney Junior, disneyjunior.disney.com/mickey-mouseclubhouse, June 27, 2015 Office Action, p. 2.



The Evolution of Mickey_Mouse¹⁰; and



The Making of Mickey¹¹.

Public comments or statements made about Mickey include:

- He is “the official mascot of The Walt Disney Company”;¹²
- “Mickey Mouse’s global fame has made him both a symbol of The Walt Disney Company and of the United States itself”;¹³
- “Walt Disney’s most famous cartoon creation turned 82 on Thursday”;¹⁴ and

¹⁰ The Evolution of Mickey, Disney-2006.tripod.com, June 27, 2015 Office Action, pp. 29-30.

¹¹ *Id.* at 31.

¹² Mickey Mouse, Wikipedia en.wikipedia.org, June 27, 2015 Office Action, p. 5.

¹³ *Id.* at 13.

¹⁴ Soraya Roberts, Mickey Mouse’s birthday has Walt Disney’s most famous cartoon rodent turning 82, N.Y. Daily News, November 18, 2010, www.nydailynews.com (*Id.* at 20).

- “Sure Mickey hasn’t had a movie in two years (his last one went direct to video), but his cheerful face remains one of the most recognizable images in the world, even beating out Santa Claus.”¹⁵

The Examining Attorney also attached the results of a Google Image search.¹⁶ We consider these images to have limited probative value, just as Google word search result summaries have limited value. *Cf. In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 (TTAB 2013) n.4 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007)) (truncated search results are of limited probative value because they do not show use of the term as a heading, link or content on a website, and there is insufficient text to show the context within which the term is used). These displays of image search results are of limited value because they do not show the sources of the images and therefore do not establish the extent of consumer exposure to these images.

The probative evidence establishes both that Disney is a well-known company and that Mickey is a famous character and mark. Moreover, the evidence establishes that Mickey Mouse is so well-recognized as a symbol of the company that the cartoon character’s image qualifies as an “identity” of Disney within the meaning afforded that term by the relevant precedents. *See Univ. of Notre Dame*, 217 USPQ at 509. *Cf. Bos. Athletic Ass’n v. Velocity* 117 USPQ2d at 1496 (“[a] nickname or an informal

¹⁵ Claire Suddath, [A Brief History of Mickey Mouse](#), Time, November 18, 2008 content.time.com, June 27, 2015 Office Action p. 24.

¹⁶ January 30, 2016 Office Action pp. 4-9.

reference, even one created by the public, can qualify as an entity's 'identity,' thereby giving rise to a protectable interest.”).

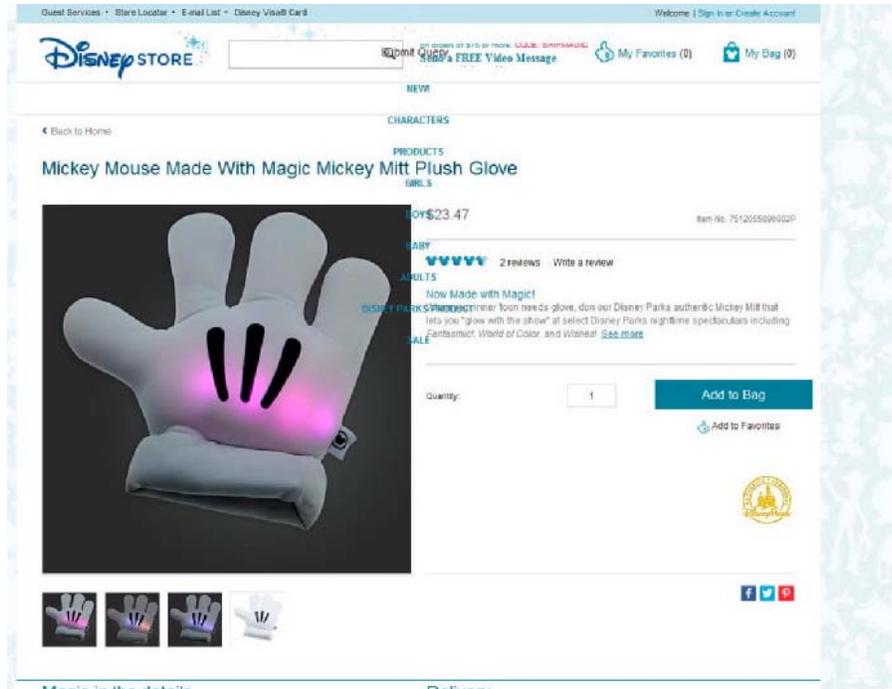
Notwithstanding this finding, the evidence is insufficient to establish that the applied-for mark is a close approximation of Disney's Mickey Mouse cartoon character or that it points unmistakably to Disney. At the outset, we acknowledge that an applicant may be subject to a Section 2(a) refusal by taking only a portion of another's identity, if that portion is a significant or key element of the identity. *See, e.g., In re Julie White*, 73 USPQ2d 1713, 1719 (TTAB 2004) (by appropriating “APACHE” from the full official names of Apache Native American Indian tribes, applicant took a key element of the tribes' identities). However, we note that Applicant's mark incorporates the term “The Mouse” not “Mickey Mouse.”

Mickey is described as “an anthropomorphic mouse who typically wears red shorts, large yellow shoes and white gloves.”¹⁷ One significant feature of Mickey is that he has only three fingers and a thumb.¹⁸ At the Disney Store, Disney sells merchandise depicting three fingers and a thumb encased in a white glove, which it calls Mickey Mouse Made With Magic Mickey Mitt Plush Glove.¹⁹

¹⁷ Mickey Mouse, Wikipedia en.wikipedia.org, June 27, 2015 Office Action, p. 5.

¹⁸ *Id.*, at 7.

¹⁹ Mickey Mouse Made With Magic Mickey Mitt Plush Glove, Disney Store, www.disneystore.com/ear-hats-more-accessories-mickey-mouse-made-with-magic-mickey-mitt-plush-glove, January 20, 2016 Office Action, p. 2.



In the drawing filed with the application, the white gloved hand in the mark also had three fingers and a thumb. Applicant amended the drawing to add an additional finger, which also differentiates the mark from the Disney character. Further, the evidence establishes that Mickey is not the only cartoon character with white gloves. Specifically, evidence introduced by the Examining Attorney supports the conclusion that “[t]he use of white gloves would prove to be an influential design for cartoon characters, particularly with later Disney characters, but also with non-Disney characters such as Bugs Bunny, Woody Woodpecker, and Mario.”²⁰ Thus, this record does not support a finding that characteristics of the Mickey Mouse figure are so well-known that the depiction of a narrow arm a with a white-gloved hand would be

²⁰ Exhibit to Office Action dated June 27, 2015, Mickey Mouse, Wikipedia en.wikipedia.org (TSDR 5, 7).

recognized as being unique to a body part of the Mickey character, versus that of another cartoon character or some other arbitrary figure.

Accordingly, we find that this record does not establish that Applicant's mark is a close approximation of the Mickey Mouse cartoon character and, therefore, that the mark does not point uniquely and unmistakably to the identity of Disney.

Because the Examining Attorney has failed to prove the first two elements of the test, ((1) that the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution and (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution) the false suggestion refusal under Section 2(a) necessarily fails.

II. Consent from Disney.

In view of our determination that the record does not establish that the proposed mark is a close approximation of or points uniquely to Disney, it is not necessary to discuss other arguments presented on appeal. However, for the sake of completeness, we address Applicant's argument in support of registration based on Disney's purported consent.

We begin by noting that Applicant affirmatively argues that there is no connection between it and Disney. However, in the context of a Section 2(a) refusal, evidence of "consent" would be relevant to the third factor "the person or institution named by the mark is not connected with the activities performed by the applicant under the mark." Whether considered as part of the third factor or as a general consent, the evidence fails to establish that there is a connection or consent sufficient to obviate

this refusal. In support of its argument for registration, Applicant relies on an email string consisting of communications between Applicant's principal, Elizabeth Hollman and purported Disney employees (Pamela and Jennifer L. Livingston) from February 14, 2012 through March 22, 2012, which include:²¹

- The February 14, 2012 email from Elizabeth Hollman²² to Pamela²³
 - “Hi Pamela! – Thank you for taking a look at my logo- If there is anything you see that Disney won't approve- could you please let me know! ...”
- The February 14, 2012 from Jennifer L. Livingston²⁴ to Elizabeth²⁵
 - “Hi Elizabeth, Per our legal department, they said the logo was fine.”

- The February 22, 2012 – from Elizabeth Hollman to Jennifer Livingston
 - “Hi Jennifer- I wanted to let you know that my logo submission is still not being approved on the Disney's [sic] online post office. Could you help me with this? ...”
- The March 16, 2012 – from Jennifer Livingston to Elizabeth Hollman
 - “Hi Elizabeth, You should no longer have any challenges. We've given them all of the information from our legal department.
- The March 16, 2012 – from Elizabeth Hollman to Jennifer Livingston

²¹ Exhibit to Response dated Mar. 8, 2016 (TSDR 3-6).

²² From elizabeth@meandthemouse.com.

²³ To wdpr.fl.inside sales @ disney.com.

²⁴ From Jennifer.L.Livingston@disney.com

²⁵ This email appears within the string. It does not include the recipient's email address.

- “Thanks Jennifer for taking care of this- I am going to try to resubmit the logo again this afternoon ...”

These communications are not sufficient to create a connection under the third factor and do not constitute consent to register. First, “a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of [A]pplicant’s services would be necessary to entitle the [A]pplicant to register the involved mark.” *In re Sloppy Joe’s International Inc.*, 43 USPQ2d 1350, 1354 (TTAB 1997). Second, while the email communications may indicate that Disney has approved Applicant’s use of the applied-for mark in some particular manner, the email string does not reveal whether Disney’s purported consent, if it exists, extends to all uses that would be encompassed by Applicant’s identification of services; and does not include any reference from Disney approving Applicant’s *registration* of the mark.

III. Conclusion.

The Examining Attorney has not made a prima facie showing that the mark falsely suggests a connection with Disney Enterprises, Inc. As fully discussed, *supra*, the record is insufficient to make the showing and thus, we find that Applicant’s mark does not falsely suggest a connection with Disney Enterprises, Inc.²⁶

Decision: The refusal to register Applicant’s mark for “travel agency services, in the planning and arranging of travel and tours” is reversed.

²⁶ This is not to say that we might not reach a different result on a different record adduced in an inter partes proceeding.