

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
August 28, 2014

Mailed:
October 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re United Trademark Holdings, Inc.

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Serial No. 85706113

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

David A. Hoffman, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Rogers, Chief Administrative Trademark Judge, and Kuhlke and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

United Trademark Holdings, Inc. (“Applicant”) has filed an application to register on the Principal Register the mark ZOMBIE CINDERELLA in standard characters for “dolls.”¹ The Trademark Examining Attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used in connection with Applicant’s goods, so resembles the

¹ Application Serial No. 85706113, filed August 17, 2012 under Trademark Act § 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s *bona fide* intent to use the mark in commerce.

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registered mark shown below as to be likely to cause confusion, or to cause mistake, or to deceive.



The cited mark is registered for goods in International Classes 9, 14, 16, 18, 21, 24, 25, and 28. Most relevant, for purposes of the Examining Attorney's refusal, are the goods in Class 28, which are "toys, namely, plush toys, action figures, dolls, soft sculpture toys, stuffed toys."²

When the refusal was made final, Applicant filed a request for reconsideration and a notice of appeal. After the Examining Attorney denied the request for reconsideration, this appeal resumed. Applicant and the Examining Attorney have filed briefs and Applicant has filed a reply brief. Oral argument was heard on August 28, 2014.

1. Evidentiary matters.

(a) The Examining Attorney, in his brief, requests that the Board take judicial notice of specimens of use filed by Applicant in connection with the

² Registration No. 3057988, issued February 7, 2006; Section 8 affidavit accepted.

applications underlying two registrations of Applicant, namely, Reg. Nos. 4463715 and 4475860. The Examining Attorney states that these specimens show Applicant's actual manner of use of the term ZOMBIE on product packaging for goods "which are all part of the same line of goods."³ The Examining Attorney argues that judicial notice is appropriate because the specimens were not available prior to the time of appeal. The record indicates that Applicant filed its notice of appeal in this case on October 25, 2013; the Examining Attorney does not state the date as of which the specimens of use were filed and thereby became available to the public and to the Examining Attorney. Although the Examining Attorney states that copies of the specimens are attached to his brief, no such copies are in the record.

Applicant argues that "while the fact that the specimens exist may not be subject to dispute, the affect [*sic*] of those specimens on the issues in this appeal is a subject of reasonable dispute."⁴ Applicant argues that in order to introduce such new evidence after the filing of Applicant's appeal, the Examining Attorney should have filed a request for remand. *See* 37 C.F.R. § 2.142(d); TBMP § 1207.02.

Under Fed. R. Evid. 201, "The [Board] may judicially notice a fact that is not subject to reasonable dispute because it: (1) is generally known within the [Board's] territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned."

³ Examining Attorney's brief, 14 TTABVUE 14.

⁴ Applicant's reply brief, 16 TTABVUE 5.

In an appropriate case, the Board will take judicial notice of a relevant fact that is not subject to reasonable dispute. *See, e.g., In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). However, “it is well settled that the Board does not take judicial notice of USPTO records.” *UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009), *citing Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987). *See also In re Sela Products, LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013). The statements and evidence included in a registration file do not constitute facts “not subject to reasonable dispute.” Accordingly, Applicant’s objection is well taken and we will not take judicial notice of the referenced specimens.⁵

(b) The Examining Attorney also suggests that the Board should take judicial notice of the fame of the name “Walt Disney” and of The Disney Company, which has been identified in an online encyclopedia as “one of the world’s largest entertainment conglomerates.”⁶ The issue of fame is generally an unsuitable subject of judicial notice. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because we accord a wide latitude of legal protection to famous marks. For that reason, in trial cases we require that fame be clearly proven by competent evidence. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). The same reasoning also applies in an appeal from an Examining Attorney’s refusal. We note also that the relevant factor in a *du*

⁵ We add that even if we considered the specimens, they would, at most, be evidence of one possible means of use of the involved mark and we would not be able to conclude that they evidence the applicant’s likely or preferred method of use of the involved mark.

⁶ Examining Attorney’s brief, 14 TTABVUE 16.

Pont analysis is the fame of the mark, not the fame of the registrant. In this case, the name “Walt Disney” is not the mark at issue; moreover, the Registrant, according to USPTO records, is not “The Disney Company.” Accordingly, we decline to take judicial notice, as the Examining Attorney requests, of the fame of the name “Walt Disney” or of “The Disney Company.”

2. Refusal under Section 2(d).

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 issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In the present case, Applicant and the Examining Attorney have presented evidence and arguments relating to certain public policy considerations; the nature and number of similar marks in use on similar goods; the conceptual weakness of the term CINDERELLA; and the commercial weakness of the term CINDERELLA.

(a) The goods.

Addressing first the goods of Applicant and Registrant, we find that they are identical. The application identifies only “dolls” as the goods on which Applicant intends to use the mark. The cited registration covers, among other goods, “toys, namely, ... dolls ...” We also note that other goods of Registrant, such as “plush

toys, action figures, [and] stuffed toys” may be considered types of “dolls” and are similar to dolls in that they are similar toys. In any event, we need not find that Applicant’s goods are commercially related to each of Registrant’s goods; in the context of likelihood of confusion, it is sufficient if relatedness is established between any item within a particular class in the application and any item in the registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of the goods at issue weighs in favor of a finding of likelihood of confusion.

(b) Trade channels and Classes of Consumers.

As Applicant’s goods are identical to some of Registrant’s goods, we must presume that such goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of trade channels favors a finding of likelihood of

confusion. So, too does the factor relating to the buyers to whom sales are or will be made.

(c) The marks.

We next consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In comparing the marks, we are mindful that where, as here, the goods are 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); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). We consider each mark in its entirety. The Examining Attorney correctly notes that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). However, additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions or the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is descriptive or diluted. *See, e.g., Citigroup Inc. v.*

Capital City Bank Group, Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (CAPITAL CITY BANK not confusingly similar to CITIBANK due in part to the frequent use of “City Bank” in the banking industry); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (THE RITZ KIDS creates different commercial impression from RITZ).

Before we compare the marks in their entirety, we will address several arguments raised by Applicant relating to the term CINDERELLA, which is the term that is shared by the two marks at issue.

(i) The “conceptual weakness” of CINDERELLA in Registrant’s mark.

Applicant has demonstrated that the well-known narrative known in English as the story of “Cinderella,” involving a beautiful young lady, her antagonistic stepsisters, a fairy godmother, a ball, a prince, and a pair of glass slippers, has been known to the public since at least as early as 1697, when a version was published by Charles Perrault.⁷ The narrative may have earlier origins and, since 1697, it has been retold in many forms. With respect to the cited registered mark, Applicant argues as follows:

The term shared between the marks, “CINDERELLA,” has little or no source-identifying significance because it is highly suggestive of the well-known fairytale character whose likeness is featured in the ... goods for the cited registration. ... Because the fairytale is a well-known classic, consumers encountering the term ‘CINDERELLA’ in the cited registration will immediately expect the cited goods to feature the character Cinderella. ...

⁷ Entry for “Cinderella” from <wikipedia.com>, Applicant’s response of March 7, 2013 at 31-41; and “Cinderella; or, The Little Glass Slipper,” by Charles Perrault, Applicant’s request for reconsideration of October 25, 2013 at 19.

[U]pon encountering the cited mark, consumers will immediately know that the cited goods feature a depiction of the Cinderella character.... As a result of the term's widespread public domain use in connection with a princess, "CINDERELLA" is conceptually weak and entitled to only a narrow scope of protection when used in connection with goods that depict a version of the public domain character Cinderella.⁸

The evidence shows that the fairytale character Cinderella is an established part of our cultural fabric and enjoys extremely widespread public recognition. The record also shows, as we discuss further below, that this cultural figure has had an impact in the commercial field of dolls, and that many dolls that depict the character Cinderella have been offered in the market by unrelated businesses. We find that, for a doll that depicts the fairytale character Cinderella, the term "Cinderella" is, at a minimum, highly suggestive of the doll in that it names the fairytale character depicted. As such, it has limited power to function as a source indicator.

As part of our analysis, we must presume that the goods of Registrant and Applicant encompass all goods of the types identified in the registration and the application, which would include dolls that depict the character Cinderella. *See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958). For such goods, the term CINDERELLA in Registrant's

⁸ Applicant's brief, 12 TTABVUE 18-19.

mark would be, at a minimum, highly suggestive of the goods. Accordingly, we agree with Applicant that the component CINDERELLA, as it appears in Registrant's mark, is entitled to a limited scope of protection.

(ii) The “commercial weakness” of CINDERELLA in Registrant's mark.

Applicant contends that the term CINDERELLA is commercially weak and diluted because of third-party use of the term in the marketplace. Applicant has made of record a number of third-party registrations of marks that include the term CINDERELLA, as well as information regarding nine third-party uses of CINDERELLA in connection with dolls and related toys.

The third-party registrations relate to goods and services different from and unrelated to the goods at issue in this case, such as cleaning services, slot machines, and medical services. Such registrations cannot demonstrate that a term is commercially weak or diluted in the field of dolls or toys. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). The relevant factor, for purposes of our analysis, is “The number and nature of similar marks in use *on similar goods*.” *In re E.I. du Pont de Nemours*, 177 USPQ at 567 (emphasis added). Further, absent evidence that the marks are in actual use, third-party registrations demonstrate little or nothing as to the commercial weakness of a term because they do not demonstrate that the marks are *in use* on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria*

La Michoacana Inc., 98 USPQ2d 1921, 1934 (TTAB 2011), *pending review*, 11-cv-1623 (D.D.C.).

The evidence of marketplace use of CINDERELLA in connection with dolls consists of nine examples of dolls that depict the fairytale character Cinderella. For example, the product called “Dolly Pockets Cinderella Doll” is a rag doll having pockets in her apron for holding smaller dolls representing “Pumpkin,” Prince,” and “Godmother.”⁹ The doll offered as Cinderella “by Madame Alexander” is described as one of a series of “new versions of storybook favorites.”¹⁰ The product called “Fairy Tale High Cinderella Fashion Doll” is apparently a product of Applicant.¹¹ It is marketed as a depiction of Cinderella as a high-schooler: the packaging states, “I’m teen Cinderella” and the advertisement states, “Fairy Tale High features a collection of beautifully designed ... dolls wearing fashion-forward clothes ... while paying homage to her fairy tale heritage.” Other “Cinderella dolls” offered under the trademarks GREEN TREE, ALMA’S DESIGNS, MGA, BARBIE, PENNY BRITE, and LEARNING CURVE¹² also clearly depict Cinderella.

Applicant argues that this evidence shows that the source-indicating power of the designation CINDERELLA in Registrant’s mark is weak. We agree that this

⁹ Ex. L., Applicant’s request for reconsideration of October 25, 2013 at 31.

¹⁰ Ex. K, *id.* at 29.

¹¹ Ex. J, *id.* at 27. The record indicates that Applicant owns Reg. No. 4264759 for the mark FAIRY TALE HIGH for “dolls.” Office Action of November 19, 2013 at 27-28.

¹² Exhs. M, N, O, P, Q, and R, Applicant’s request for reconsideration of October 25, 2013 at 32-43.

evidence demonstrates that the designation CINDERELLA has diminished source-indicating power for dolls that depict the character Cinderella.

(iii) Comparing the marks as a whole.

We turn now to consider the marks as a whole in terms of their appearance, sound, meaning and overall commercial impression. The Examining Attorney, in support of his refusal, points to the fact that both marks share the term CINDERELLA; argues that CINDERELLA is the dominant term of Registrant's mark because "it is twice, if not three times as large in font size" as the other wording in the mark (WALT DISNEY'S);¹³ that addition of a trade name like WALT DISNEY'S "does little, if anything, to create a commercial impression apart from the essence of the dominant term CINDERELLA";¹⁴ that CINDERELLA is also the dominant portion of Applicant's mark because "it is clear that ZOMBIE is not arbitrary in relation to zombie-themed dolls"; and that "the addition of a highly suggestive term to the dominant portion of an existing [registered mark] will not avoid confusion."¹⁵

The record shows that a "zombie" is a "human ... who is held to have died and been supernaturally reanimated."¹⁶ The archetype of the "zombie" has been widely popularized in recent years through successful motion pictures such as *Night of the*

¹³ Examining Attorney's brief, 14 TTABVUE 7.

¹⁴ *Id.* at 16-17.

¹⁵ *Id.* at 8-9.

¹⁶ Definition from <merriam-webster.com/dictionary>, Ex. C, Applicant's response of March 7, 2013 at 43.

Living Dead, *Dawn of the Dead*, and *Shaun of the Dead*, television shows such as *The Walking Dead*, and books such as *Pride and Prejudice and Zombies*.¹⁷

The Examining Attorney, to support his contention that ZOMBIE is not arbitrary with respect to dolls, has made of record evidence showing numerous dolls depicting zombies.¹⁸ Although such dolls take many forms, they are characterized almost universally by eyes having a blank or unnerving stare. Other common characteristics are a blood-stained mouth and signs of bodily decomposition.



The record shows that, in the marketplace, the word “zombie” is used as an adjective to describe dolls that depict zombies. *E.g.*, “My son loves this zombie plush”;¹⁹ “10 Incredibly Great Zombie Toys”;²⁰ “zombie action figure”;²¹ “zombie toy line”;²² “zombie toys.”²³ They are also sometimes referred to as “zombie dolls.”²⁴

Applicant, for its part, argues with respect to the cited registered mark that its “stylized wording, [] distinctive design, and the house mark WALT

¹⁷ See Office Action of November 19, 2013 at 5-8, 9-11, and 17-19.

¹⁸ Office Action of April 25, 2013 at 13-16, 22-25, 31-34, 40-52, 64-75.

¹⁹ *Id.* at 45; 49-50.

²⁰ *Id.* at 64.

²¹ *Id.* at 65.

²² *Id.* at 70.

²³ *Id.* at 71, 73, 75.

²⁴ *Id.* at 14.

DISNEY'S....” distinguish it in appearance from Applicant’s standard character mark.²⁵ Applicant argues that the two marks “sound nothing alike because they begin with different sounds (‘zom’ versus ‘walt’) and contain different numbers of syllables (6 versus 7).”²⁶ Applicant also argues that “the rare Z sound” gives special emphasis to the word ZOMBIE in Applicant’s mark.²⁷

With respect to the meaning and commercial impression of the marks at issue, Applicant argues that the combination of the term ZOMBIE with CINDERELLA has a transformative effect:

Applicant’s mark juxtaposes the grotesqueness of a monster commonly portrayed in horror films with the beauty and innocence of a classic fairytale princess, giving it a unique and incongruous meaning and overall commercial impression.²⁸

This odd combination of horror and fantasy creates a cognitive dissonance in the minds of consumers and results in a feeling of disequilibrium.²⁹

In contrast, Applicant argues, “the [registered] mark’s overall commercial impression conjures a classic and innocent portrayal of the public domain fairytale character Cinderella.”³⁰

²⁵ Applicant’s brief, 12 TTABVUE 15.

²⁶ *Id.* at 16.

²⁷ Applicant’s reply brief, 16 TTABVUE 8.

²⁸ Applicant’s brief, 12 TTABVUE 14.

²⁹ *Id.* at 18. *See also* Applicant’s reply brief, 16 TTABVUE 8-9: “Applicant’s ZOMBIE CINDERELLA mark combines concepts from horror and fantasy that are seldom mixed, namely a blood-thirsty undead supernatural monster crossed with a classic fairytale princess. The result is an incongruous composite, which creates a distinctive commercial impression.”

³⁰ Applicant’s brief, 12 TTABVUE 17.

We do not find CINDERELLA to be the dominant component of the cited registered mark, because its suggestive qualities undermine its source-indicating power. The designation WALT DISNEY'S, despite its smaller lettering style, is, for registration purposes, inherently distinctive and its possessive form emphasizes the weakness of the term CINDERALLA, indicating it is Registrant's version of the character as opposed to another's version. The design element of the cited mark, also, may function, for juvenile customers, as a stronger source indicator than the term CINDERELLA, because it depicts a specific version of Cinderella that is associated with the Walt Disney animated film "Cinderella."³¹

With respect to Applicant's mark, considering the significance that the word "zombie" has in the marketplace for toys, we find that the term ZOMBIE, as it appears in Applicant's mark, would have little distinctiveness as a source indicator as applied to dolls that depict zombies, because its primary function in that case would be to describe a feature of the goods. The same can be said of the term CINDERELLA, if Applicant were to apply it to dolls depicting Cinderella (or Cinderella as a zombie).³² We do, however, agree with Applicant that the combination of ZOMBIE with CINDERELLA creates a unitary mark with an incongruous impression. Both terms are widely known and understood by the

³¹ Applicant's response of March 7, 2013 at 19-29 (Ex. A: Wikipedia entry for "Cinderella (1950 film)").

³² Apparently, Applicant would not be the first company to issue a doll that depicts a well-known fictional character as a zombie. The record contains references to a "Zombie Santa" doll, a "Zombie Spider-Man" action figure, and zombie versions of Hulk, Captain America, and G.I. Joe. Office Action of April 25, 2013 at 64-68.

public, and their individual meanings in the marketplace are so different as to be virtually irreconcilable.

Considering both marks in their entireties, ZOMBIE CINDERELLA and WALT DISNEY'S CINDERELLA (and design), we acknowledge some similarity in appearance, sound, and meaning that arises from the shared use of the term CINDERELLA. However, in this case we find that the house mark WALT DISNEY'S and the design element in the registered mark, and the term ZOMBIE in applicant's mark, constitute significant differences between the marks, because of the weakness of the term CINDERELLA. "[W]here ... the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to the assertedly conflicting product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable." *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (citations omitted). *See also Citigroup Inc. v. Capital City Bank Group, Inc.*, 98 USPQ2d at 1261. Most importantly, we find the connotation and commercial impression of the two marks to be substantially different. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d at 1356-57. We are persuaded by Applicant's contention that the mark ZOMBIE CINDERELLA creates a "cognitive dissonance," involving an uneasy mixture of innocence and horror. By contrast, the registered mark creates an impression of prettiness and goodness. Even if such marks were used on identical goods, these distinct commercial impressions would be distinguishable.

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We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In view of the different commercial impressions of the marks at issue, we find no likelihood of confusion as to source.

Decision: The refusal to register is reversed.