

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Playboy Enterprises International, Inc.

Serial No. 86745640

Marcella Ballard, Kristen S. Ruisi and Maria R. Sinatra of Venable LLP,
for Playboy Enterprises International, Inc.

Kevin G. Crennan, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Zervas, Ritchie and Greenbaum,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Playboy Enterprises International, Inc. (“Applicant”) seeks registration on the



Principal Register of the mark

for the following International

Class 41 services:

Entertainment services, namely, providing online video games; Entertainment services, namely, providing temporary use of non-downloadable video games; Production of video and computer game software; Providing a web site through which people locate information about tournaments, events, and competitions in the video game field; Entertainment services, namely, conducting contests; Arranging and conducting nightclub entertainment events; Arranging and conducting special events for social entertainment purposes; Arranging, organizing, conducting, and hosting social entertainment events, Entertainment services, namely, a continuing program about the gaming industry accessible by means video, web-based applications, mobile phone applications, and computer networks.¹

The Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on (i) Registration No. 4749039 ("the '039 registration") for the standard character mark **GND** (registered June 2, 2015) for "provision of Internet website featuring news and information relating to current affairs, business, sports and entertainment" in International Class 41; and (ii) Registration No. 4782818 ("the '818 registration") for the standard character mark **GND NEWS** (registered July 28, 2015) for "provision of Internet website featuring news and information relating to business" in International Class 35 and "provision of Internet website featuring news and information relating to current affairs, sports and entertainment" in International Class 41. The two registrations issued to the same owner.

¹ Application Serial No. 86745640, filed on September 2, 2015, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intention to use the mark in commerce. The mark is described as consisting of "a cross formation with four pentagon shaped arrows pointing towards the center which forms an x shape. The top arrow contains an image of a rabbit head design with a bow tie, the left arrow contains the letter 'G', the bottom arrow contains the letter 'N' and the right arrow contains the letter 'D.'"

After the Examining Attorney made the refusal final, Applicant appealed to the Board and requested reconsideration. The Examining Attorney denied the request for reconsideration. The appeal resumed and both Applicant and the Examining Attorney filed briefs.

I. Preliminary Issue

Applicant submitted about one-hundred pages of material with its appeal brief, much of which appears to have been previously submitted. We do not consider any of this material. The record in the application should be complete prior to the filing of an appeal, and it is not necessary to attach as exhibits to a brief evidence that is already in the application because the appeal brief is associated with the application. *See* Trademark Rule 2.142(d), 37 C.F.R. §2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) §§1203.02, 1207.01 (June 2017). We have, of course, considered the evidence properly made of record prior to the filing of the appeal.

II. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he

fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

A. The Marks

We compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered in connection with the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). The average purchaser is a member of the general public.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. Vv. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). In fact, 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 the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat'l Data Corp.*, 224 USPQ at 751.

We focus our analysis on the ‘039 registration for the standard character mark GND, because it is the most similar, and thus if we find confusion likely between that cited mark and Applicant’s mark, we need not consider the likelihood of confusion between Applicant’s mark and the mark of the ‘818 registration, while if we find no likelihood of confusion between Applicant’s mark and the mark in the ‘039 registration, we would not find confusion between Applicant’s mark and the mark in

the '818 registration. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Applicant contends that the marks are dissimilar; and that “[u]nlike the cited registrations, the Applicant’s mark evokes the unique image of video gaming in conjunction with the Applicant, Playboy’s, RABBIT HEAD DESIGN. The arrangement of the pentagon shaped arrows to form an x shape in the Applicant’s mark immediately evokes video gaming as the directional pads of various video game controllers have overwhelmingly had similar ‘x shape’ designs.”² In addition, Applicant states:

Moreover, the Applicant’s other registered trademarks, and association with the phrase “Girls Next Door” allows the letters “G,” “N” and “D,” when paired with the iconic PLAYBOY RABBIT HEAD DESIGN to call to mind a vastly different meaning than the cited registrations. The acronym “GND” is common slang for “girl next door.” PLAYBOY and its iconic RABBIT HEAD DESIGN have been associated with the phrase “girl next door” since PLAYBOY’s inception in 1953, and the phrase has become so closely associated with PLAYBOY that the Applicant has registered and maintained Registration No. 3704353 (THE GIRLS NEXT DOOR in Class 41), and Registration No. 3332339 (THE GIRLS NEXT DOOR in Class 16) since 2009, and 2007, respectively. As a result, use of the letters “G,” “N,” and “D” when utilized by the Applicant, in conjunction with the Applicant’s RABBIT HEAD DESIGN, call to mind the Applicant’s history and its association with the phrase “Girl Next Door.” The cited registrations do not evoke similar images and as a result, have a unique commercial impression that is unlikely to be confused with the Applicant’s mark.³

² Applicant’s brief at 8, 7 TTABVUE 9.

³ *Id.* at 9-10, 7 TTABVUE 10-11.

For support, Applicant submitted a definition of “GND” from urbandictionary.com,⁴ defined as “girl next door.”

Our primary reviewing court, the Federal Circuit, stated in *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990):

More dominant features will, of course, weigh heavier in the overall impression of a mark. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed.Cir.1983). There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. *See Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (improper to ignore portion of composite mark).

The marks differ in that the rabbit head design, the four pentagon-shaped arrows and the X formed by the four pentagon-shaped arrows do not appear in the registrant’s mark, and there is no visual association with video game controllers. Despite these differences, the marks are similar because they share the same letters “G,” “N,” and “D,” and these letters can be read in the same order as they appear in registrant’s mark. We find that purchasers will give more weight to the letters than the design elements in considering the mark in its entirety, because the letters are large in size, the pentagon-shaped arrows function as a background for each letter, and the “rabbit head design” is not likely to be articulated verbally in this mark. (Applicant has not indicated how its mark in its entirety, or the rabbit head design

⁴ July 28, 2017 Office Action, TSDR 33-34. Page references to the application record refer to the PDF version of the Trademark Status and Document Retrieval System (TSDR).

alone, would be articulated.) Further, the keys are arranged so that an “X” is formed in the center, but this “X” is a feature that appears only after study of the design and would not be immediately noticeable to the average purchaser.

“GND” is unpronounceable as a recognized word; and, as stated, the keys and the “rabbit head design” would not be pronounced. Further, (i) because the marks share the same letters, they are similar in appearance; and (ii) because the shared letters can be articulated in the same order, they are similar in commercial impression. In this regard, we consider that “it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words, or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely.” *Crystal Corp. v. Manhattan Chemical Mfg. Co.*, 75 F.2d 506, 25 USPQ 5, 6, (CCPA 1935). *See also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §23:33 (5th ed. 2017) (“Arbitrary arrangements of letters have generally been given a wide scope of protection, based on the premise that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words, figures, phrases, or syllables.”).

We are not persuaded by Applicant’s attempts to associate “GND” with “girl next door,” even if (i) it has registrations for GIRL NEXT DOOR, (ii) it has used the “rabbit head design,” and (iii) “PLAYBOY and its iconic RABBIT HEAD DESIGN have been associated with the phrase ‘girl next door’ since PLAYBOY’s inception in 1953, and the phrase has become so closely associated with PLAYBOY.”⁵ An authoritative

⁵ Applicant’s brief at 9-10, 7 TTABVUE 10-11.

dictionary defines “gnd” as an abbreviation for “ground” with no mention of “girl next door.” See online version of the Merriam-Webster Dictionary.⁶ The Acronym Finder entry for “GND” submitted by the Examining Attorney also identifies “Ground” as the first ranked meaning, with “Girl Next Door” as the second ranked meaning.⁷ “Girl next door” in the urbandictionary.com is identified as “guy slang”⁸ without any reference to Applicant. Another definition in the same dictionary (urbandictionary.com) submitted by Applicant defines “gnd” as “Good Night Dick.” There is no indication in urbandictionary.com as to which definition is the primary definition; we note that the “Good Night Dick” submission to urbandictionary.com is dated August 23, 2014 while the “girl next door” submissions are dated in 2006 and 2007.

Moreover, the record reflects that Applicant itself is not using “GND” with its mark to mean “girl next door.” See the following webpage from <http://www.playboy.com/series/gamer-next-door:>⁹

⁶ <https://www.merriam-webster.com/dictionary/gnd>. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁷ February 1, 2017 Office Action, TSDR 8, from <https://www.acronymfinder.com/GND.html>. Several other meanings of “GND” appear in this reference.

⁸ July 28, 2017 Req. for Recon., TSDR 33-34.

⁹ July 28, 2017 Req. for Recon., TSDR 91.

 **Gamer Next Door**



Watch Pam and Smosh Games' Matt Sohinki Go Derp Level on 'Overwatch'

In this installment of Gamer Next Door, Pam Horton goes head to head with Matt Sohinki of Smosh Games to discover the most effective tactic for the Blizzard title Overwatch. Will Sohinki's "pro level" (also known as the "try hard technique") carry the day, or will Pam prevail with her "derp level"? Watch the video and find...

by Gamer Next Door

<http://www.playboy.com/series/gamer-next-door>

7/26/2017

Evidently, Applicant intends the letters "G," "N" and "D" to be read in the order reflected in registrant's mark, and as meaning "Gamer Next Door," not "girl next door."

As for Applicant's representation that the "rabbit head design" is iconic, and presumably would be readily recognized by purchasers and associated with Applicant and not registrant, Applicant has not demonstrated any notoriety of that design. But even if the "rabbit head design" is iconic, and consumers perceive the "rabbit head

design” as a house mark and GND as a service mark, likely of confusion as to sponsorship or affiliation would still exist; “[i]n general, use of a house mark does not obviate confusion.” *General Mills Inc. v. Fage Dairy Processing Ind. SA*, 100 USPQ2d 1584, 1601 (TTAB 2011) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010)). Indeed this could engender reverse confusion with the mark in the cited registration. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“The term ‘reverse confusion’ has been used to describe the situation where a significantly larger or prominent newcomer ‘saturates the market’ with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services.” (citations omitted)).

In sum, we find Applicant’s mark considered as a whole to be more similar than dissimilar to registrant’s mark and resolve the *du Pont* factor regarding the similarity of the marks in favor finding a likelihood of confusion.

B. The Services, Trade Channels and Purchasers

Our determination of the similarity of the services is based upon the recitations of services in the application and in the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The services do not have to be identical or even competitive for confusion to be likely. “[L]ikelihood of confusion can be found ‘if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate

from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The services listed in the ‘039 application are “provision of Internet website featuring news and information relating to current affairs, business, sports and entertainment” and the cited registration includes “providing a web site through which people locate information about tournaments, events, and competitions in the video game field.” These services are overlapping because both Applicant and registrant are providing a website, and registrant’s entertainment information may include information about tournaments, events, and competitions in the video game field. Furthermore, as to the overlapping services identified in the application and in the ‘039 registration, we must assume that the purchasers and channels of trade for such services would also overlap. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (“absent restrictions in the application and registration, [related] goods and services are presumed to travel in the same channels of trade to the same class of purchasers”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”).

Applicant’s recitation of services also includes “entertainment services, namely, a continuing program about the gaming industry accessible by means video, web-based applications, mobile phone applications, and computer networks.” As identified, the content of Applicant’s continuing program may be identical to the content of

registrant's website, i.e., information about tournaments, events and competitions in the video game field (a form of entertainment),¹⁰ with both offered via the Internet. These services are highly similar.

In addition, the Examining Attorney submitted third-party commercial webpages demonstrating both Applicant's and registrant's services offered under the same mark. *See*, for example:

- <http://ign.com/moview> offering a website featuring entertainment information, specifically about movies, as well as a continuing program about video games ("Max and Brian bring you the best moments of the week with Up at Noon Live, every Thursday at 12PM PT");¹¹
- <http://www.gamespot.com/news/> offers a website featuring entertainment information regarding video games, and video game event information;¹²
- <https://marvel.com> offers online, non-downloadable video game and a website featuring entertainment news in the fields of comics, television, movies, and video games;¹³ and
- <http://z100.iheart.com> offers social entertainment events in the nature of an "after-work singles party" and entertainment news, specifically about music.¹⁴

The Examining Attorney also submitted approximately two dozen third-party marks registered for use in connection with the same or similar services as those of identified in the '039 application and the cited registration. This evidence

¹⁰ See December 21, 2015 Office Action, TSDR 7 ("Video games are entertainment.").

¹¹ Feb. 1, 2017 Office Action, TSDR 9-10.

¹² Feb. 1, 2017 Office Action, TSDR 11-12.

¹³ Feb. 1, 2017 Office Action, TSDR 13-15.

¹⁴ Feb. 1, 2017 Office Action, TSDR 21-22.

demonstrates that the services listed therein are of a kind that may emanate from a single source under a single mark. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d at 1432 (“The use-based, third-party registrations . . . also have probative value to the extent that they serve to suggest that the goods [and services] listed therein are of a kind which may emanate from a single source under a single mark.”); *In re Albert Trostel & Sons*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). *See*, for example:

Registration No. 4834679 for the mark MACHINIMA for “Providing a website featuring entertainment information where users can view videos and content; entertainment and educational services, namely, production, distribution and presentation of videos and multimedia content regarding electronic video gaming ...; entertainment services, namely, providing videos and multimedia content regarding electronic video gaming, video game cinema ...; entertainment, namely, arranging and conducting on-line contests; entertainment services, namely, providing online computer games and video games”;¹⁵

Registration No. 4203468 for the mark AVR MUSIC for “dance and night club services; entertainment information; arranging and conducting night club entertainment events”;¹⁶

Registration No. 4461049 for the mark BEI MAEJOR for video game software production services and providing entertainment information over the Internet;¹⁷ and

Registration No. 4826556 for the mark VINO ARTIST for “arranging, organizing, conducting and hosting social entertainment events; Information and advisory services regarding all of the aforesaid services, including

¹⁵ Dec. 21, 2015 Office Action, TSDR 28-33.

¹⁶ Dec. 21, 2015 Office Action, TSDR 20-21.

¹⁷ Dec. 21, 2015 Office Action, TSDR 22-24.

information and advice provided electronically, including on a website.”¹⁸

Applicant argues that “the cited registrations reference ‘entertainment’ fleetingly,” and that we “should not ‘simply lump the services of [applicant] and [registrant] under the heading of . . . entertainment and, on that basis alone, find that the parties engage in confusingly similar services,” citing *Harlem Wizards Entm’t Basketball, Inc. v. NBA Props, Inc.*, 952 F. Supp. 1084, 1095 (D. N.J. 1997).¹⁹ *Harlem Wizards* is inapposite because it concerned a common law trademark and not the Trademark Act Section 7, 15 U.S.C. §1057, presumptions that flow from an existing registration, including the exclusive right to use a registered mark in connection with the services specified the certificate of registration. We must consider registrant’s services as described in the registration and cannot read limitations into those services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Servs. Inc.*, 16 USPQ2d at 1788. If the cited registration describes services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all services of the type described, that they move in all channels of trade normal for these services, and that they are

¹⁸ Dec. 21, 2015 Office Action, TSDR 31-32.

¹⁹ Applicant’s brief at 5-6, 7 TTABVUE 6-7.

available to all classes of purchasers for the described services. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).²⁰

Applicant also argues that “Applicant and the cited registrations do not compete for the same customers because the Applicant’s services are targeted to individuals who are interested in video gaming, and events focused on video gaming, while the cited registrations’ services are targeted to individuals interested in mainstream news.”²¹ This argument is not persuasive because not all of Applicant’s services are limited to video gaming, and because registrant’s services as described in the registration may also concern video games as entertainment.

We therefore find the services to be overlapping in part and otherwise related, and the purchasers and trade channels to be the same, and resolve these *du Pont* factors in favor of a finding of likelihood of confusion.

C. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The services at issue are overlapping and otherwise related. For those overlapping services, we presume that the services move through the same trade channels to the same classes of customers, and note that “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970

²⁰ The proper remedy for an applicant to limit the scope of a registrant’s identified services is via an inter partes proceeding seeking partial cancellation or restriction pursuant to Section 18 of the Trademark Act, 15 U.S.C. § 1068.

²¹ Applicant’s brief at 7, 7 TTABVUE 8.

F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Many of the non-overlapping services move through the same Internet trade channels. Applicant's and registrant's marks, considered as a whole, are similar, and Applicant has not established any weakness in registrant's mark.²² We therefore conclude that Applicant's mark for its services is likely to cause confusion with the registrant's mark for its services.

Decision: The refusal to register under Section 2(d) is affirmed.

²² The two third-party registrations incorporating GND submitted with the July 28, 2017 Req. for Recon, TSDR 2-5, are for unrelated services and hence are not persuasive of any weakness of registrant's mark. The third such registration submitted by Applicant is for an entirely unrelated mark.