

Mailed:
September 30, 2004

This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Archie Comic Publications, Inc.
v.
Chaoyang Baolansi Meticulous & Chemical Co., Ltd.

Opposition No. 91111889
to application Serial No. 75214476
filed on December 17, 1996

Charles W. Grimes and Edmund J. Ferdinand, III of Grimes & Battersby, LLP for Archie Comic Publications, Inc.

Diane M. Reed, Jeffrey L. Van Hoosear and Michael K. Friedland of Knobbe, Martens, Olson & Bear, LLP for Chaoyang Baolansi Meticulous & Chemical Co., Ltd.

Before Simms, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Chaoyang Baolansi Meticulous & Chemical Co., Ltd.
[hereinafter applicant] has applied to register the mark
ARCHÉ, in a stylized form of lettering, on the Principal
Register for goods identified as "cosmetics, namely, skin
cream, hair pomades, beauty masks, face powder, rouge,
lipstick, cotton puffs for cosmetic use, eyeshadow, nail
polish, suntanning cream, hair waving lotion, hair spray,

perfume, facial cleansers, hair mousse, talcum powder, hair shampoo, and hair conditioner," in Class 3. The application is based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), through applicant's ownership of a registration of the mark for the identified goods in its home country of China. The mark's stylization is shown below:

Arché

The Pleadings and Record

Archie Comic Publications, Inc. [hereinafter opposer] has opposed the application and issuance of a registration to applicant. The notice of opposition asserts a claim that opposer, commencing on November 12, 1942, has continuously used the mark ARCHIE "for a wide variety of goods and services." Opposer also asserts that it has registered this mark for "comic magazines, joke book magazines and [a] comic magazine series"; that it has registered various other marks featuring the term ARCHIE or ARCHIES; and that it and its licensees have used the various registered marks for a wide variety of goods. Finally, opposer asserts that its marks and applicant's mark are confusingly similar; that the parties' respective goods and services are related or applicant's goods are within "a natural zone of expansion for Opposer"; and that concurrent use of the respective

marks would result in a likelihood of confusion among consumers, or they would mistakenly believe that applicant's goods were somehow connected to opposer, as by authorization, sponsorship, through licensing or by similar arrangement.

Applicant expressly or effectively denied all of the allegations of the notice of opposition, except that it admitted opposer's ownership of Registration No. 1,595,220 for ARCHIE for "boats" in Class 12.

At trial opposer introduced the testimony and related exhibits of its vice president and director of circulation, Fred Mausser, a notice of reliance on 11 of its registrations,¹ and a notice of reliance on pages excerpted from printed publications. Applicant did not attend opposer's testimony deposition and did not present any evidence of its own.

¹ The registrations listed in the notice of reliance include three which were not pleaded in the notice of opposition: Registration No. 598225 for the mark ARCHIE'S GIRLS BETTY & VERONICA; Registration No. 2314951 for the mark ARCHIE'S; and Registration No. 2341591 for the mark ARCHIE & Design. While an adverse party generally can object to introduction of registrations not pleaded, failure to object may lead to consideration of the registrations. See Sports Authority Michigan Inc. v. PC Authority Inc., 63 USPQ2d 1782, 1789 (TTAB 2001). In this case, applicant did not object to opposer's introduction of the registrations that were not previously pleaded. However, as discussed later herein, opposer has clearly and specifically stated that it relies on only three of its pleaded and introduced registrations for likelihood of confusion purposes.

Summary of Arguments

In its brief, opposer specifically states that, for the purpose of determining whether there is a likelihood of confusion, it will rely on only three of the registrations it has made of record: Registration No. 909,609 for ARCHIE [typed] for "comic magazines, joke book magazines, and comic magazine series" in Class 16, issued March 9, 1971; Registration No. 403,372 for ARCHIE COMICS [stylized; with disclaimer of "comics"] for "magazine published quarterly" in Class 16, issued September 21, 1943 under the Trademark Act of 1905 and republished under the Trademark Act of 1946 on July 12, 1949; and Registration No. 1,966,659 for ARCHIE & design for "comic magazines" in Class 16, issued April 9, 1996).² The latter two marks are shown below:



Opposer also argues that its licensing efforts include licensing ARCHIE for "personal care products" in the past; that it has an active, continuing licensing program; and that cosmetics are within the natural zone of expansion for its licensing program. In addition, opposer asserts that

² Opposer explains that its other registrations were introduced "for purposes of confirming that [opposer] has licensed the ARCHIE mark for use in connection with entertainment properties and licensed goods and services." Brief, p. 13.

its marks are famous and that fame plays a dominant role in the likelihood of confusion analysis; that the similarity of its marks and applicant's mark in appearance outweighs slight differences in sound or meaning; that comic books and cosmetics are sold in the same stores to unsophisticated purchasers; that there is no evidence of third-party uses of ARCHIE marks; and that there is evidence of opposer's aggressive pursuit of unauthorized third-party uses.

Applicant, in its brief, states that it accepts opposer's assertion that the "consuming public" associates the ARCHIE mark with the Archie character, opposer's comic books and entertainment properties. Brief, p. 7. Applicant also acknowledges opposer's products or licensed products include not only comic magazines, animated television shows featuring ARCHIE cartoon characters, live action movies and videos of the same, but also include "entertainment merchandise such as t-shirts, apparel, books, watches, gift and novelty items, toys and games." Id.

However, applicant notes that the evidence introduced by opposer to show that opposer has licensed its ARCHIE mark for a shaving kit actually establishes that this was a toy, and the shaving cream can was sold empty; and applicant notes that the evidence asserted to show licensed use of the ARCHIE mark on or in conjunction with hair clips are from the single year 1990. Applicant also asserts that there is

Opposition No. 91111889

no evidence of record that opposer or any other comic book company actually sells or licenses any kind of cosmetic product. Finally, applicant asserts that there is nothing in the record to establish that cosmetics would be within the natural zone of expansion for opposer, including no evidence that opposer or any other comic book company actually sells, or licenses for sale, any kind of cosmetic product.

As for the respective marks, applicant asserts that they sound different and the accent symbol in applicant's mark is important. Applicant accepts opposer's contention that the connotation of opposer's marks is of its comic book character named "Archie," and asserts that while there is nothing in the record regarding the connotation of applicant's mark, it does not follow that the connotation is the same as opposer's marks.

In its reply brief, opposer argues that applicant has not contested opposer's evidence of the fame of its marks and the Board can therefore treat the silence as an admission of fame. Opposer also asserts that it is proper for the Board to focus on the parties' respective marks having the common formative "Arch" without violating the rule that marks are not to be dissected but are to be compared in their entireties. Further, opposer asserts that there is nothing in the record on the sound or meaning of

applicant's mark and, at best, the similarity or lack thereof in terms of the meanings of the marks is a neutral factor.

Opposer's History and Commercial Activities

As noted above, applicant's application is based on Section 44 of the Trademark Act and does not claim that applicant's mark has been used in commerce. In addition, applicant presented no evidence during trial. Thus, the likelihood of confusion analysis requires consideration of the application alone and the evidence opposer has made of record. We briefly summarize the evidence concerning opposer.

Based on the numerous printed publications of record, it is clear that comic book industry observers and even more mainstream media consider opposer's ARCHIE comic book to have been very successful and long lasting in the comic book field. See, for example, opposer's notice of reliance on printed publications, particularly, the Official Overstreet Comic Book Price Guide, and the Chicago Sun-Times article of August 23, 2000; see also, exhibits 114-15 and 117-121 to the deposition of opposer's witness Fred Mausser.

The success of the ARCHIE comic book has spawned various other spin-off titles in the comic book field (see Mausser exhs. 1-25), as well as related entertainment ventures, such as animated television shows, movies, books,

Opposition No. 91111889

and musical ventures (Mausser dep. pp. 46-47 and exhs. 50-55). Further, opposer has licensed numerous ARCHIE comic-themed products, including mailing packs/envelopes and ID tags for luggage, a toy shaving kit, trading cards, dolls and clothes therefor, lunchboxes, wallets, shoulder bags/fanny packs, a board game, a puzzle, paper cups/plates/tablecloth, toy flying disc, and toy cars (Mausser exhs. 70-86). Similar products are available via the archiecomics.com website (Mausser exhs. 42-43). Opposer has also engaged in promotions with restaurants, whereby, for example, McDonald's has distributed ARCHIE comic-themed Happy Meals (Mausser exh. 84), and The Ruby Restaurant Group has sold ARCHIE comic-themed kids' meals (Mausser exh. 87); and at least one restaurant has utilized an ARCHIE comic-themed menu (Mausser exh. 113).

Opposer's ARCHIE comic publication is reported to have sold at the rate of approximately 6 million a month during the years immediately following its launch in 1942, but over the decades many titles have come and gone and opposer now distributes approximately 800,000 comics a month, including ARCHIE-themed comics and others such as Sabrina the Teenage Witch and Sonic the Hedgehog (Chicago Sun-Times article submitted by Notice of Reliance, Mausser exhs. 29-32 and 121; Mausser dep. p. 39).

Though ARCHIE musical ventures were at their peak in the late 1960s and early 1970s, opposer has negotiated to revive an ARCHIE performing group, a television series and perhaps a Broadway musical; future restaurant promotions also are possible (Mausser dep. pp. 57 and 75 and exhs. 119(a) and 120). Opposer's witness also testified that cosmetics would be within a zone of expansion for opposer's licensing efforts (Mausser dep. p. 57), though in contrast to current negotiations regarding entertainment and restaurant deals, he did not testify as to any current investigation of cosmetics licensing opportunities.

As to the overall size of opposer's various business ventures, it has been reported to be a small business with a large brand. See Notice of Reliance on Printed Publications, BusinessWeek, August 13, 2001 ("...it's a \$15 million, 23-person outfit with modest digs"). The record is clear that opposer's comic books and entertainment products have received unsolicited media attention, particularly on the occasion of the 50th and 60th anniversaries of the launching of the first ARCHIE comic book (Mausser exhs. 114-15, 119(a), 120, and opposer's Notice of Reliance on Printed Publications).

As to classes of consumers for opposer's comic books, opposer has testified that, of subscribers, approximately 75 percent or more are between the ages of 6 and 14 and 55

percent are female, while 45 percent are male (Mausser dep. pp. 85-86 and exh. 131).³ Opposer sells comic books by subscription, through mass merchandisers such as Wal-Mart, supermarket chains, drugstore chains, and bookstore chains (Mausser dep. pp. 28-30).

Analysis and Decision

Priority is not an issue in this case, in view of opposer's introduction of status and title copies of its pleaded registrations, showing that they are valid and owned by opposer. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995). In addition, the registrations and remainder of the record clearly establish opposer's standing. Thus, all that is to be resolved is whether a likelihood of confusion exists.

We analyze the issue of likelihood of confusion using the factors that were articulated in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

³ Mausser exhs. 29-32 show that the vast majority of opposer's comic book sales are off the shelf sales in various outlets and only a small percentage are by subscription.

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted).

In many cases, two key, although not exclusive, considerations are the similarities or differences between the marks and the similarities or differences of the goods and services. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks").

The similarity or dissimilarity of the marks is assessed by comparing the marks as to appearance, sound, connotation and commercial impression. Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). Moreover, it is well-settled that marks, when compared, must be considered in their entirety, not simply to determine what points they have in common or in which they may differ. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Nonetheless, "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 consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, opposer has specifically stated its reliance on its rights attendant to three registered marks, and has chosen not to rely on other registrations (or on any common law rights it may have based on use of one or more marks). Because the goods listed in each of these three registrations are essentially identical ("comic magazines, joke book magazines, and comic magazine series," "magazine published quarterly," and "comic magazines") we consider first the involved goods.

When we compare opposer's identified Class 16 goods with those of applicant ("cosmetics, namely, skin cream, hair pomades, beauty masks, face powder, rouge, lipstick, cotton puffs for cosmetic use, eyeshadow, nail polish, suntanning cream, hair waving lotion, hair spray, perfume, facial cleansers, hair mousse, talcum powder, hair shampoo, and hair conditioner," in Class 3), we find them completely dissimilar. They are not competitive. They are not complementary. Opposer has not shown that it is customary or typical for publishers of magazines and comic books to also produce a wide variety of cosmetic products. In short,

opposer has not shown that these products have any innate relationship whatsoever.

Opposer's theory why the goods should be considered related, for likelihood of confusion purposes, stems from its licensing of ARCHIE comics-themed products for a wide range of products and services. We agree with applicant, however, that the record shows these are primarily toys, games, novelty items, and the types of collateral merchandise one would see licensed in conjunction with a successful entertainment venture, and opposer has shown no evidence of any attempt to bridge the gap from its current or past licensing efforts to cosmetics.⁴ Unlike Turner Entertainment Co. v. Nelson, 38 USPQ2d 1942 (TTAB 1996), wherein the opposer had licensed GILLIGAN'S ISLAND for beach towels and beach bags, and the theme of the GILLIGAN'S ISLAND television show meant that suntan oil and lotion, sunblock and similar products were "logical tie-in products" for opposer, in this case we see no logical tie-in between cosmetics and either a major thematic element of opposer's ARCHIE comics or previously licensed products.

On this last point, i.e., whether cosmetics would be a logical extension of opposer's past licensing efforts, we

⁴ We note, too, that it appears from the record that opposer's licensing efforts have perhaps been more extensive in the past than they are at present, except for testimony and exhibits regarding current efforts to license more entertainment products and services and perhaps a restaurant.

note Mausser exh. 68. This is a document comprising five pages titled "List of Items ACP [opposer, Archie Comic Publications] Has," one page titled "Miscellaneous Additional Items That Archie Management Recalls," and one page titled "Supplemental List of ACP Goods/Services." On the last page - the Supplemental List - there appear the following items: "Three-piece vanity set," "Lipstick," "Nail tips," and "Body mist." However, none of the pages of exhibit 68 bears a date or any indication when or by whom it might have been prepared; nor do they indicate the basis for the information on the lists, which are all in different typefaces and do not appear to have been prepared at the same time. Moreover, the Mausser testimony introducing the exhibit is vague and does not provide any information that would bolster its probative value. In regard to exhibits 68 and 69, the witness testified: "One looks like an internal document and [the] other one was probably produced to counsel or something like that, but it's a listing of some of the merchandise we have had over the years." (Mausser dep. p. 58). The witness was not asked about the "Supplemental List" or any specific items listed thereon. In addition, while the "List of Items ACP Has" and list of "Miscellaneous Additional Items That Archie Management Recalls" generally list dates when licensed items were produced and/or names of licensees or manufacturers, the

"Supplemental List" does not. We accord little probative value to the Supplemental List in the absence of more specific testimony about the basis for its creation and in the absence of any corroborating evidence that would support a claim of production of Archie comic-themed vanity sets, lipsticks, nail tips and body mists.⁵ Finally, we note that, unlike the GILLIGAN'S ISLAND case, wherein the opposer's mark and the applicant's mark were identical, in this case the marks are different.

Considering the marks, we begin by noting that two of the three marks on which opposer relies are stylized and one includes the word "COMICS" and the other includes the image of "Archie" himself. We find that neither of these two marks looks like applicant's mark or creates a commercial impression anything like applicant's mark. These two ARCHIE marks (one because it contains the word "COMICS" and the other because it contains a drawing of a comic book character) have the commercial impression of a comic book or strip named after or featuring a character named "ARCHIE." The commercial impression of applicant's mark, on the other hand, is that of a foreign term, particularly because of the

⁵ It is curious that this list includes such general entries as "comic books" and "toys" and then such specific entries as "lipstick" and "nail tips." Moreover, while Mr. Mausser was specifically asked whether cosmetics would be within the zone of expansion for opposer's licensing efforts, he was never asked whether cosmetics were part of past licensing efforts.

accent mark. As to the appearance of these two marks of opposer, we agree with applicant that the testimony of its witness that the consumers would overlook the letter "i" in "ARCHIE" is self-serving and entitled to little weight. Even if applicant's mark might be spoken by some consumers in a manner similar to opposer's marks, we find the dissimilarity in sight and commercial impression more significant.

Turning to opposer's third pleaded and relied on mark, ARCHIE in typed form, again we find the commercial impression different from applicant's ARCHÉ (stylized) mark. Moreover, we put little stock in opposer's argument that because this mark is registered in typed form, it could choose to utilize the mark in any typeface, including a typeface similar to that employed by applicant. If opposer used a similar typeface for its comic books, there would be no likelihood of confusion because of the different commercial impressions and differences between comic books and cosmetics, i.e., the theoretical possibility of use of similar typefaces would not create a likelihood of confusion. In regard to opposer's possible licensing of the typed mark ARCHIE for use on or in conjunction with cosmetics, we agree with applicant that it is, on this record, highly unlikely that such a licensed use would be allowed in a type face similar to applicant's and with no

other indication that the licensed products were affiliated with the opposer's comic books and characters. The record is quite clear that virtually all licensed uses allowed by opposer involve creating strong associations with its comic books and characters. Moreover, any possible fame attributable to opposer's marks would only attach to use of the marks on licensed products if the method of use was such as to immediately call to mind opposer's well-known comic books and characters.

In short, based on the dissimilarity of the identified goods, the lack of evidence showing any capacity of opposer to bridge the gap with its licensing program to cosmetics, and the dissimilarities in the marks, we find that there is no more than a mere theoretical possibility of confusion. We would not find otherwise even if we agreed with opposer that its marks should, on this record, be considered famous.

We agree with opposer that fame, when established, is an important factor in the likelihood of confusion analysis, but we do not find sufficient evidence in this record that opposer's mark could be considered famous for anything other than comic books. Moreover, on this record, we conclude only that the marks are well known for comic books. Accordingly, fame is not a dispositive factor in this case.⁶

⁶ We disagree with opposer's contention that applicant, by not mounting a more vigorous defense, has conceded the fame factor, any more than it has conceded similarity of the marks or goods.

Opposition No. 91111889

Finally, opposer places great weight on its assertion that its comic books are sold in some of the same types of stores (mass merchandisers, supermarkets, and drug store chains) that would be likely channels of trade for applicant's products, and on its contention that both its comic books and applicant's cosmetics could be low-priced items bought by unsophisticated girls under the age of 15. Opposer has put nothing in the record to establish what percentage of girls 6-14 who subscribe to comic books also are potential purchasers of cosmetics. In addition, it is clear that comic books and cosmetics are not the types of items that would be marketed in the same way or in the same locations in the retailers opposer discusses. Interstate Brands Corporation v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 152-53 (CCPA 1978), citing Federated Foods, Inc., d.b.a. Hy-Top Products Division v. Fort Howard Paper Company, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Decision: The opposition is dismissed.