

**THIS OPINION  
IS NOT A PRECEDENT  
OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Lykos

Mailed: January 28, 2010

Opposition No. 91185105

Mignon Fogarty, Inc. and  
Macmillan Holdings, LLC

v.

Joel Avery

Before Walters, Grendel and Bergsman, Administrative  
Trademark Judges.

By the Board:

On September 11, 2007, Joel Avery ("applicant") applied to register the mark THE GRAMMAR GIRLS for "educational services, namely, conducting programs in the field of grammar" in International Class 41.<sup>1</sup> Mignon Fogarty, Inc., ("MFI") together with its licensee Macmillan Holdings, LLC ("Macmillan") (collectively referred to as "opposers") have opposed registration on the grounds that applicant's applied-for mark so resembles opposers' previously used GRAMMAR GIRL mark that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act. In the notice of opposition, opposers pleaded prior common-law use of the GRAMMAR GIRL mark,

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<sup>1</sup> Application Serial No. 77277106, alleging a bona fide intent to use the mark in commerce. The term "GRAMMAR" is disclaimed.

specifically that "[s]ince July 2006, MFI has offered podcasts for download under the name GRAMMER GIRL" featuring "short, friendly tips to improve your writing . . ." (Notice of Opposition, Para. No. 1); that on "on September 7, 2007, MFI, together with its licensee Macmillian, launched an online network of downloadable audio snippets dubbed Quick and Dirty Tips, featuring GRAMMAR GIRL brand downloads and information," (Notice of Opposition, Para. No. 2); that in "March 2007, the use of the GRAMMAR GIRL mark was expanded to downloadable audio books," (Notice of Opposition, Para. No. 8); that "[o]n September 7, 2007, [o]pposers launched an online network of downloadable audio snippets . . . featuring GRAMMAR GIRL brand downloads and information," (Notice of Opposition, Para. No. 12); and that MFI has provided educational services under the mark (Notice of Opposition, Para. No. 13).

In his answer, applicant denied the salient allegations contained in the notice opposition and asserted various affirmative defenses, including that applicant's applied-for mark is intended to be used solely in connection with his "The Grammar Crew" registered mark and related marks. (Affirmative Defenses, Para. No. 33).

This case now comes before the Board for consideration of opposers' motion for summary judgment on their Section 2(d) claim. The parties have fully briefed the motion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional

evidence showing the existence of a genuine issue of material fact for trial.

In general, a plaintiff moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks and/or the owner of registration(s) of its pleaded mark or marks; and (3) contemporaneous use of the parties' respective marks on their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

Based on the submissions of the parties, we find that opposers have met their burden of demonstrating that there are no genuine issues of material fact, and that opposers are entitled to judgment as a matter of law.

A. **Standing**

With regard to whether opposers have standing to maintain this proceeding, we note that applicant has not challenged opposers' standing to oppose the involved application. As discussed in more detail below, we find that the evidence of both MFI and Macmillan's prior use of the GRAMMAR GIRL mark sufficient to establish their standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

B. **Priority**

We turn next to the question of whether there is a genuine issue of material fact regarding opposers' asserted priority of use. To establish priority on a claim brought under Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. Because owners of unregistered marks are not entitled to the presumptions established by statute under Trademark Act Section 7(b), to prevail, it is opposers' burden to demonstrate the absence of a genuine issue of material fact regarding the use of their mark prior to September 11, 2007 (the filing and constructive use date of applicant's mark). See Trademark Act §§ 2(d) and 7(c); see also, e.g., *Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

To establish prior use, MFI has submitted the Declaration of Mignon Fogarty, President of Mignon Fogarty, Inc. (hereinafter referred to as the "Fogarty Declaration") with documentary evidence attached thereto. Applicant does not dispute the following statements in the Fogarty Declaration:

-Commencing July 2006, prior to the September 11, 2007 filing date of applicant's application, MFI began using the GRAMMAR GIRL mark to identify a podcast available through the website qdnow.com and the Itunes store offering tips on writing and grammar as well as an online blog comprised of a transcript of that day's

podcast episode (Fogarty Declaration, Para. Nos. 6-7, 11-13, Exhibits D and E);

-Commencing March 2007, MFI expanded use of the GRAMMAR GIRL mark to a series of downloadable audio books (Fogarty Declaration, Para. No. 16); and

-On or about April 18, 2007, MFI commenced use of the GRAMMAR GIRL mark in connection with an e-mail newsletter featuring grammar tips (Fogarty Declaration, Para. No. 25, Exhibit I).

Macmillan, in turn, has submitted the Declaration of Richard Rhorer, Director of Digital Business Development at Macmillan, (hereinafter referred to as the "Rhorer Declaration") as evidence of its prior use of the GRAMMAR GIRLS mark as MFI's licensee. Applicant does not dispute the following statements in the Rhorer Declaration:

-On or about January 27, 2007, MFI entered into a licensing agreement with Macmillan granting to Macmillan an exclusive license to use the GRAMMAR GIRL mark in connection with all digital, book, and audiobook goods and services (Fogarty Declaration, Para. No. 15 (Rhorer Declaration, Para. Nos. 7 and 8);

-Macmillan's licensing and use of the GRAMMAR GIRL mark commenced in January 2007 and has been continuous since that date (Rhorer Declaration., Para. No. 8);

-On or about July 27, 2007, MFI together with its licensee Macmillan commenced use of a CD-ROM version of the GRAMMAR GIRL podcast (Fogarty Declaration, Para. No. 17, Exhibit F);

-On September 7, 2007, MFI and Macmillian redesigned qdnow.com and relaunched the website as quickanddirtytips.com containing an online network of downloadable audio snippets featuring GRAMMAR GIRL brand products and services, including the podcast and blog; approximately 2.5 million podcasts are downloaded each month from the quickanddirtytips.com website and the iTunes store (Fogarty Declaration, Para. Nos. 18 - 22, Exhibit G); and

-Macmillan has spent several years and significant financial resources promoting the GRAMMAR GIRL mark in connection with podcast, audiobook, website, and blog services as well as CD-ROMs, printed works and e-mail newsletters (Rhorer Declaration, Para. Nos. 9-19, 21).

It is undisputed that applicant filed his intent-to-use application on September 11, 2007 and has not presented any evidence of use of the mark THE GRAMMAR GIRLS prior to the filing date. Thus, opposers have established that no genuine issue of material fact exists that they have prior use of the GRAMMAR GIRL mark in connection with podcasts, blogs, e-mail newsletters, audiobooks, and CD-ROMs featuring grammar tips.

C. **Likelihood of Confusion**

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.<sup>2</sup>

(i). *Similarity of the Parties' Marks*

With respect to the similarity of the marks, we look to

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<sup>2</sup> Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

the marks in their entireties as to appearance, sound, connotation and commercial impression. 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 their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the perception and recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

There is no genuine issue of material fact that the marks at issue are virtually identical. Applicant's THE GRAMMAR GIRLS mark consists merely of a plural form of opposers' GRAMMAR GIRL mark, with the addition of the article "the." This *du Pont* factor favors a finding of likelihood of confusion.

We note applicant's argument that opposers have not objected to applicant's registration of his GRAMMAR CREW series of marks (e.g. THE GRAMMAR KING, THE GRAMMAR QUEEN). Applicant, however, has not submitted copies of these registrations, and therefore his mere assertion that these registrations exist does not raise a genuine issue. In addition, applicant's contention that he intends to use his



mark only in connection with his GRAMMAR CREW marks is unavailing since his applied-for mark consists solely of the mark THE GRAMMAR GIRLS.

Likewise, applicant's mention of third party uses of the involved mark on two other websites does not raise a genuine issue of material fact because applicant has failed to properly introduce evidence thereof for consideration by the Board. In any event, even if applicant had submitted copies of the alleged registrations, such evidence would be of no avail to applicant because the issue in this case is whether the particular mark applicant now seeks to register is likely to cause confusion

(ii). *Similarity of the Parties' Services*

Turning next to the similarity of the services, where, as here, opposers are relying upon common law use of their mark, consideration of the question of likelihood of confusion must be confined to the specific services on which the mark has been used, as disclosed by the evidence, without the benefit of those presumptions ordinarily allowed a registration under Trademark Act Section 7(b). See *Asplundh Tree Expert Company v. Defibrator Fiberboard Aktiebolag*, 208 USPQ 954, 959 (TTAB 1980).<sup>3</sup>

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<sup>3</sup> This same principle applies to our analysis of the specific trade channels and actual purchasers or potential purchasers. *Id.*

With regard to the second *du Pont* factor, i.e., the similarity or dissimilarity and nature of the goods and services, it is well established that the goods and services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1432 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

As noted above, opposers have established prior use of their mark in connection with podcasts, blogs, e-mail newsletters, audiobooks and CD-ROMs featuring grammar tips. Although applicant has expressed an intent not to use his mark in connection with podcasts, the recitation of services

in his application -- "educational services, namely, conducting programs in the field of grammar" -- is sufficiently broad to include podcasts as well as opposers' other proven mechanisms of delivering their services. Declaration of Joel Avery (hereinafter referred to as "Avery Declaration"), Para. No. 7. Both opposers' and applicant's services relate to the same subject matter -- teaching grammar. Only the medium is different. Consequently, this factor favors opposers in finding a likelihood of confusion.

(iii). *Channels of Trade*

There is no genuine issue of material fact that applicant intends to market and use the same channels of trade for his services as opposers. The evidence of common law use submitted by opposers establishes that the primary trade channel for marketing and distributing opposers' services is the Internet. Applicant admits that he currently offers educational services on his website thegrammarcrew.com under other service marks, and that he intends to use this site and the Internet as the main trade channel for marketing his educational services under the mark THE GRAMMAR GIRLS. See Opposers' Requests for Admissions, Adm. No. 4; Applicant's Response to Opposers' Interrogatory Nos. 5 and 7. This factor weighs in favor of finding a likelihood of confusion.

(iv). *Classes of Purchasers*

In addition, it is undisputed that opposers' podcast listeners range from school age children to professional adults. See Fogarty Declaration, Para No. 57. Applicant admits his intent to market the services to both children and adults. See Opposers' Request for Admissions, Adm. Nos. 12, 13, and 15. As such, there is no genuine issue of material fact that the buyer conditions for the parties' services are identical. These factors also favor opposers.

(v). *Lack of Actual Confusion*

Lastly, we note applicant's argument of lack of actual confusion. We find, however, that in this case, the absence of actual confusion is not sufficient to raise a genuine issue of material fact because applicant has admitted that he has not yet commenced use of his applied-for mark. Opposers' Requests for Admissions, Adm. Nos. 2 and 3; Avery Declaration Para. No. 7.

We have concentrated our discussion on the *du Pont* factors which the parties have discussed and/or on which we have evidence. To the extent that any other factors are applicable, we must treat them as neutral.

Inasmuch as opposers have demonstrated that there is no genuine issue of material fact and that they are entitled to judgment as a matter of law on their Section 2(d) claim, opposers' motion for summary judgment is granted; the

opposition is sustained, and registration of applicant's mark is refused.