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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Playboy Enterprises International, Inc.
v.
Diane Dickson dba Bunny

Cancellation No. 92047717
to Registration No. 3115637
issued on July 18, 2006

William T. McGrath of Davis McGrath for Playboy Enterprises International, Inc.

Mark Murphy Henry of Henry Law Firm for Diane Dickson dba Bunny.

Before Seeherman, Walters and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Playboy Enterprises International, Inc. filed its petition to cancel the registration of Diane Dickson dba Bunny for the mark BUNNY for "handbags, all purpose carrying bags, tote bags, traveling bags, shoulder bags, clutch purses, all-purpose athletic bags, backpacks, wallets, coin purses and cosmetic bags sold empty," in International Class 18, and "dresses, skirts, pants, tops, shirts, t-shirts,

blouses, sweaters, vests, sleepwear, lingerie, pajamas, bathrobes, bathing suits, beach cover-ups, caps, hats, bandanas, scarves, coats, jackets, rainwear and gloves," in International Class 25.¹

As the first ground for the petition, petitioner asserts that respondent's mark, when applied to respondent's goods, so resembles petitioner's previously used and registered marks shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Petitioner alleges, inter alia, that it is an international multimedia entertainment company; that it owns a family of famous BUNNY marks, including its famous rabbit's head design mark²; that it uses and has registered these marks in connection with a wide range of goods and services; that it has used its rabbit's head design mark in connection with clothing and footwear in International Class 25 since at least 1959, and in connection with goods in International Class 18 since at least 1969; and that its marks are famous.

In its amended petition to cancel, petitioner adds the assertion that the registration is invalid, i.e., void ab initio, because respondent had not used her mark on each of

¹ Registration No. 3115637, issued July 18, 2006. The underlying application was filed on September 23, 2003, alleging, in connection with both classes, first use as of June 30, 2001, and first use in commerce as of October 31, 2002.

² Petitioner did not pursue this allegation in its brief and, thus, we consider the question of whether petitioner has established a family of

the goods identified in the underlying use-based application as of the application filing date.³

In its second amended petition, petitioner adds its claim of ownership of three additional registrations, to conform to the evidence it had submitted.⁴

Respondent, in her answer to the amended petition, denied the salient allegations of the claims. Respondent made several assertions as affirmative defenses. However, respondent submitted no testimony or other evidence and did not submit a brief on the case. We find respondent's defenses of laches and acquiescence, estoppel, and unclean hands are unavailing. We have given no consideration to the legal efficacy, relevance or merits of these various defenses.

BUNNY marks to be waived. Moreover, such a finding is not necessary to our decision.

³ In its brief, petitioner argues, for the first time, that respondent committed fraud on the USPTO in connection with her allegations of use in the underlying application. However, the amended petition contains no allegation of fraud, which must be pled with particularity; nor can we consider from this record that the issue has been tried by express or implied consent. Therefore, we have considered only the question of whether respondent had made use of her mark on fewer than all of the goods identified in her used-based application as of the filing date.

In its pleading, petitioner also asserts dilution under Trademark Act §43(c), 15 U.S.C. 1125(c). However, petitioner did not pursue this ground in its brief and, therefore, we find petitioner's dilution claim has been waived and we have given it no consideration.

⁴ The Board, in its order of February 19, 2010, accepted the second amended petition and deemed respondent's answer to the first amended petition as responsive to the second amended petition as well.

The Record

The record consists in part of the pleadings and the file of the involved registration. At trial, petitioner submitted its notice of reliance on printouts from the Office's TARR electronic database for its pleaded registrations, which show that the registrations are currently registered and that they are owned by petitioner. See Trademark Rule 2.122(d)(1), 37 C.F.R. §2.122(d)(1).

Petitioner also submitted the testimony depositions of Judy Kawal, petitioner's senior director of business management, and Michele McCoy, petitioner's senior intellectual property counsel, both with accompanying exhibits. Respondent submitted no evidence at trial and only petitioner filed a brief on the case.

The registrations owned and made of record by petitioner are as follows:

Registration No. (issue date/status)	Mark	Goods/Services
0728889 (3/20/1962; renewed; Section 15 affidavit acknowledged)		"ties and men's and women's shirts," in International Class 25
0810555 (6/28/1966; renewed; Section 15 affidavit acknowledged)	BUNNY	"operating establishments which feature food, drink, and entertainment," in International Class 42
0871553 (6/24/1969; renewed; Section 15 affidavit acknowledged)		"billfolds and card cases," in International Class 3

		
1192561 (3/23/1982; renewed; Section 15 affidavit acknowledged)		"Footwear," in International Class 25
1908471 (8/1/1995; renewed; Section 15 affidavit acknowledged)		"tote bags, suitcases and garment bags for travel," in International Class 18
3194099 (1/2/2007)		"Bathrobes; Beachwear; Belts; Coats; Dresses; Footwear; Headwear; Hosiery; Jackets; Jogging suits; Lingerie; Loungewear; Neckwear; Pants; Shirts; Shorts; Skirts; Sleepwear; Socks; Stockings; Sweaters; Swim wear; T-shirts; Tops; Undergarments," in International Class 25
3375883 (1/29/2008)		"On-line ordering services featuring perfumes, colognes, toiletries, essential oils, cosmetics, personal care products, nutritional supplements, optical products,

	<p>"The mark consists of a 'Rabbit head' with bow tie facing left."</p>	<p>eyeglasses, sunglasses, spectacles, CDs, DVDs and videos, games and toys, audio equipment, jewelry, horological and chronometric instruments and apparatus, clocks, watches, books, magazines, posters, printed matter, publications, calendars, leather goods, wallets, handbags, purses, trunks and traveling bags, umbrellas, household or kitchen utensils and containers, barware, kitchenware, glassware, porcelain and earthenware, home accessories, textiles and textile goods, bed and table covers, bar accessories, sporting goods, electronics, candy and confections, musical instruments, footwear, headgear, fashion accessories, articles of clothing, lingerie, shoes, scarves, bed and bath accessories, sex toys, furniture, collectors items, energy drinks, smokers articles, tobacco, tobacco products, cigars, cigarettes and lighters," in International Class 35</p>
<p>3592968 (3/17/2009)</p>		<p>"caps, hats, visors, slippers, boxer briefs, underwear, sleepwear, lingerie,</p>

	 <p>"The mark consists of a three dimensional bunny costume worn by a woman used as a point of sale display. The costume includes a corseted bodice, bunny ears worn on the head, a bunny tail on the back of the bodice, a name tag on the front of the bodice, wrist cuffs and a bow tie collar. The dotted outline of a woman is not a part of the mark but is merely intended to show the position of the costume."</p>	<p>robes, jackets, pullovers, shirts, t-shirts, shorts, pants, jeans, loungewear, neckwear, swimwear, socks and footwear," in International Class 25</p>
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Factual Findings

Petitioner began its business with the publication of *Playboy Magazine* in December 1953. The magazine has been published continuously to the present and the Bunny logo, as shown below, has appeared on most covers and inside most publications.



The current monthly magazine circulation in the United States is approximately 2.6 million copies. In the year preceding trial alone, one in ten U.S. men between the ages of 18 and 34 read the magazine and its adult audience in the United States is more than 10 million readers.

Petitioner began using the word BUNNY in connection with its goods and services in the 1960's and the Bunny logo is regularly referred to by petitioner, consumers and the media as "the Bunny" or "the Playboy Bunny."

Petitioner's marks pertaining to bunnies are the Bunny logo, the word mark BUNNY, and the Bunny costume, which is used both as a two-dimensional drawing of a woman in the costume and as an actual costume on a model or "Playboy Bunny." In addition to its magazine, petitioner has used the Bunny logo mark since the 1960's in connection with nightclubs and related entertainment services.

Petitioner began using the Bunny logo as a mark on products as early as the 1950's, the first product being cuff links. Petitioner began its licensing program for the use of its marks in connection with a wide variety of products in the 1970's. A 1976 product catalog included use of the Bunny logo on various clothing items, key chains, barware, puzzles, playing cards, decals and mugs. Petitioner's witness, Judy Kawal, testified that petitioner has expanded its licensing program to use its Bunny logo on

a wide variety of consumer goods, including each of the items identified in its registrations herein and in connection with each of the items listed in respondent's registration. She testified, further, that the catalogs in 1976 included hats, ties, scarves, T-shirts and tank tops, all with the Bunny logo thereon.

Petitioner sells its branded products through approximately 2000 retail businesses in the United States, some of which are its own stores and others are third-party stores such as Bloomingdales, Henri Bendel, Spencer's and K-Mart. It also sells its branded products online through its own websites, shop.playboy.com and ShopTheBunny.com, and through third-party licensees' websites. Petitioner's websites receive approximately 300,000 new visitors each month.

Petitioner uses the Bunny logo in connection with various services such as videos, games and other entertainment offered on its website, television programming and mobile phone downloads. One current program featuring both the word mark BUNNY and the Bunny logo is petitioner's *Rock the Bunny*, featuring up-and-coming bands.

In addition to its own advertising, petitioner receives substantial numbers of references to its Bunny logo in various media such as magazines, newspapers, television and movies. For example, the Bunny logo has appeared in product

placements in the show *Sex and the City*; and in an article in *Rolling Stone Magazine* featuring "American icons," which included the Bunny logo. Also, numerous celebrities have been photographed in clothing that shows the Bunny logo; and a recent movie by Sony entitled *The Bunny House*, about a former Playboy Bunny who supervises a college sorority, features the Bunny logo, the word mark BUNNY and the Bunny costume.

Regarding respondent, petitioner's witness, Michele McCoy, testified that petitioner conducted an investigation into the extent of respondent's use of her mark on the goods listed in her registration. Using archived and current websites pages, it reviewed respondent's website and third-party websites selling respondent's goods. Petitioner sent copies of the documents it reviewed to respondent. Ms. McCoy testified that, in response to petitioner's request for production of information, documents, hangtags, etc. for each and every product on which respondent uses and has ever used her trademark, respondent produced a copy of the above-noted documents that petitioner had previously sent to respondent.

The sampling of respondent's website includes monthly snapshots for July through December 2003; and sample snapshots of respondent's website and a third-party website offering respondent's goods during the years 2004 through

2007. These excerpts show some but not all of the goods identified in both classes in respondent's registration. The website excerpts that predate the filing date of respondent's underlying application show or refer to very few of the items identified in the underlying application. In fact, these excerpts picture only handbags, clutches, and what appear to be either wallets and/or coin purses; the excerpts identify totes; and the excerpts contain a statement identifying respondent's goods as follows: "bunny is a collection of lifestyle accessories with a focus on handbags and small leather goods."

Respondent subsequently supplemented this production with what appear to be product photos and excerpts from publications; copies of several invoices from 2002 and 2003; and copies of one 2002 check and one 2003 check from third parties to respondent. The publications and photos are insufficiently clear or identifiable to be of any probative value. The nature of most of the goods identified in the invoices is unclear as the products are identified by shorthand, for example "jelly," "squid," and "PEBCHBK." The checks are not connected in any way with any products and, thus, are of no probative value.

Analysis

Standing

Because petitioner has properly made its pleaded registrations of record, we find that petitioner has established its standing in this cancellation proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

Next, we must determine whether petitioner or respondent has priority. In a cancellation proceeding, priority is an issue even though a petitioner owns a registration. *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (The "Board has taken the position, in essence, that the registrations of each party offset each other; that petitioner as a plaintiff, must, in the first instance, establish prior rights in the same or similar mark ... Of course, petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date"). Cf. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In this case, the earliest date upon which respondent may rely is the filing date of her underlying application, i.e., September 23, 2003. Five of petitioner's established registrations (nos. 0728889, 0810555, 0871553, 1192561 and

1908471) registered long before that filing date.

Therefore, petitioner has established its priority.

The applications underlying petitioner's remaining three established registrations (nos. 3194099, 3375883 and 3592968) were filed, respectively, on March 24, 2006, August 23, 2007 and November 8, 2004 - all subsequent to the filing date of respondent's underlying application.

Petitioner has established that the marks in these three registrations were in use at the time of trial in connection with each of the goods and services listed in the respective registrations. However, with the exception of the use of the Bunny logo on headwear, neckwear and T-shirts since at least 1976, petitioner did not establish that the marks in these three registrations were in use in connection with the respectively identified goods prior to the filing date of respondent's underlying application. Thus, neither these three registrations, nor, with the noted exception, the common law use of these marks in connection with the identified goods, has been considered in determining petitioner's priority.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du*

Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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 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 Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We begin by noting that we have conducted our analysis of likelihood of confusion by focusing on, in addition to petitioner's established common law use of its Bunny logo in connection with headwear, neckwear and T-shirts since 1976, only petitioner's two most relevant registrations for which petitioner has established priority, i.e., Nos. 0728889 and 0871553 for the Bunny logo.

Considering, first, the goods of the parties, we observe that there is a substantial overlap in the goods identified in both classes in the respective registrations.

Respondent's identified "tops, shirts, T-shirts and blouses" are essentially the same as petitioner's "men's and women's shirts" in its Registration No. 0728889 for the Bunny logo; and respondent's "wallets and coin purses" are either the same as or closely related to petitioner's "billfolds and card cases" in Registration No. 0871553 for the Bunny logo. Additionally, petitioner established its prior common law use of its Bunny logo on headwear, neckwear and T-shirts, which goods are the same as or closely related to respondent's "T-shirts," "caps," "hats," and scarves." Thus, petitioner has previously used or registered its bunny logo mark in connection with several goods that are identical or closely related to several goods identified in respondent's registration.

Because likelihood of confusion must be found if there is likely to be confusion with respect to any item that is the same as or related to any of petitioner's goods, petitioner need show only that at least one of the goods identified in each class in respondent's registration is the same as or related to petitioner's previously used goods and/or the goods identified in its two registrations under consideration herein. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Petitioner has made this showing.

Further, both parties' identifications of goods are broadly worded, without any limitations as to channels of

trade or classes of purchasers. We must presume that the goods of respondent and petitioner are sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and class of purchasers of the parties' goods are the same. Moreover, the evidence establishes that both parties sell their goods to the general public via, at least, the Internet.

Therefore, we conclude that the parties' goods, trade channels and classes of purchasers are either the same or closely related. These factors weigh strongly in petitioner's favor.

Turning to the marks, we note that the vast majority of the evidence submitted by petitioner pertains to its so-called Bunny logo. The evidence shows that petitioner, the press and the public refer to the logo as a bunny, rather than as a rabbit or some other moniker. Additionally, the website for petitioner's e-commerce website is "ShopTheBunny.com." Moreover, a picture and the word that describes the picture often have the same effect and must be treated as legal equivalents. *Rousch Bakery Products Co., Inc. v. Ridlen*, 203 USPQ 1086 (TTAB 1979). Thus, we find that petitioner's design mark of a "Bunny" head is

equivalent to the word mark BUNNY and will be perceived as such by relevant consumers.

Therefore, we find that respondent's word mark and petitioner's Bunny logo are substantially similar in connotation and commercial impression. This factor also weighs in petitioner's favor.

Due to our findings that the parties' marks are substantially similar and that several of their respective goods are identical or closely related with the same trade channels and purchasers, we further find that respondent's mark used for her goods is likely to cause confusion with petitioner's mark. In view thereof, it is unnecessary for us to consider whether the *du Pont* factor of fame would also favor petitioner.

In conclusion, we find that in view of the substantial similarity in the commercial impressions of respondent's mark, BUNNY, and petitioner's Bunny logo, their contemporaneous use on the identical and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Respondent's Use of her Mark

Petitioner conducted research to determine whether or the extent to which respondent was using her mark in connection with all of the goods identified in her registration and sent the results of its research to

respondent. During discovery, petitioner asked respondent to produce all documents pertaining to the use of her trademark on each and every item identified in her registration. In addition to the previously discussed non-probative material, respondent simply returned to petitioner copies of the same research material that petitioner had previously sent to respondent with her Bates stamp thereon. Petitioner submitted at trial copies of the documents it had submitted to respondent and of the copies that respondent had returned to petitioner.

This evidence does not show use of respondent's mark on all of the goods identified in both classes in her registration either prior to the filing of her underlying application or thereafter. Clearly, petitioner has made a prima facie case that respondent had not used her mark in connection with all of the goods identified in her registration at the time she filed the underlying application based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a). Respondent has taken no action to contradict the accuracy or probative value of petitioner's showing.

Therefore, based on this evidence, we must conclude that, as of the filing date of the underlying use-based application, the only goods identified in the application

upon which the mark was in use were handbags, tote bags, clutch bags, wallets, and coin purses.

Contrary to petitioner's contention, the application/registration as a whole is not void ab initio due to respondent's use of her mark on less than all of the identified goods in the absence of fraud, which petitioner did not plead or establish. Rather, the application and registration are void only as to the identified goods upon which respondent did not have use as of the filing date. *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696 (TTAB 2006). The goods for which the application/registration are void and which must be deleted from the registration are all of the goods in International Class 25 and the following goods in International Class 18: all-purpose carrying bags, traveling bags, shoulder bags, all-purpose athletic bags, backpacks, and cosmetic bags.

However, the petition to cancel the registration as a whole has been granted on the ground of priority and likelihood of confusion. Therefore, the partial cancellation based on non-use as discussed herein will only become effective should respondent prevail on appeal on the ground of priority and likelihood of confusion.

Decision: The petition to cancel is granted.