

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Family Images, Inc.

Serial No. 75/143,885

Bernard K. Kleinke of Higgs, Fletcher & Mack LLP for Family Images, Inc.

Elliot S. Robinson III, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Cissel and Walters, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 24, 1996, applicant filed the above-referenced application to register the mark shown below

on the Principal Register for "providing customized videos for others." The application was based on applicant's claim of use of the mark in interstate commerce since May 20, 1996.

In addition to raising several informalities, the Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark, when used in connection with the services specified in the application, so resembles the mark "THE FAMILY STORIES COMPANY," which is registered¹ for "videotape production of keepsake videos," that confusion is likely.

When the refusal was made final, applicant filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing, so we have resolved the appeal based on the written record and arguments.

We hold that confusion is likely because the marks are similar and the services set forth in the application are essentially the same.

We note at the outset of our discussion that when marks are used in connection with identical services, "the degree of similarity (between the marks) necessary to

¹ Reg. No. 1,958,472, issued to Roy Kamin, an individual, on February 27, 1996.

support a conclusion of likely confusion declines."

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The marks in the instant case create similar commercial impressions because the dominant part of each mark is the term "FAMILY STORIES." In the cited registered mark, "THE FAMILY STORIES COMPANY," the words "THE" and "COMPANY" have little, if any, source identifying significance. When the mark is considered in its entirety, it is the remaining term, "FAMILY STORIES," which creates the commercial impression of the mark. "FAMILY STORIES" is the part of this mark which would be recalled and used to refer to or recommend the services the registrant renders under this mark.

The same term, "family stories," is also the dominant element in the mark the applicant seeks to register. We have considered both the registered mark and applicant's mark in their entireties, and thus, in the mark sought to be registered, we have not ignored the presence of the camera design or the additional suggestive phrase, "Celebrating family heritage," but "family stories" plays a greater role in creating the commercial impression of this mark. It is shown in much larger letters than the other phrase which is shown below it, and its presentation in

white letters on a large black rectangular background further emphasizes the term "family stories." As with the cited registered mark, the phrase "family stories" is the part of the mark that people are more likely to remember and to use in referring to the mark or in recommending the services of the applicant to prospective purchasers. The term has the same suggestive connotation in connection with these services that the registered mark does. It suggests that the videos concern the stories of families. Because both of these marks are dominated by the same suggestive element, which has the same suggestive connotation with respect to the services of both applicant and the registrant, the use of these two marks in connection with the same or closely related services is likely to cause confusion.

When the services set forth in the application and registration, respectively, are considered, it is clear that they are either the same or closely related, overlapping activities. The registration specifies the service of the registrant as "videotape production of keepsake videos." While this wording may be somewhat stilted because of the use of both of the words "videotape" and "videos," it is nonetheless clear that the activity identified by registrant's mark is the production of videos

as keepsakes. Applicant has identified its service as "providing customized videos for others." Although the wording is slightly different from that used in the cited registration, it is clear that the services of both applicant and registrant are essentially the same, making video recordings for their clients. Applicant's "customized videos" could include the "keepsake" type of videos produced under the registered mark. That applicant uses the word "providing," whereas registrant used the word "production," does not appear to indicate a significant difference between the services. The producer of these products obviously provides them to its clients.

Applicant argues that confusion is not likely because the term "FAMILY STORIES" is weak in source-identifying significance as a result of being part of several third-party registered marks. In light of that, applicant contends that the design features and other words in its mark are sufficient to distinguish its mark from the other marks which include either "FAMILY STORIES" or "FAMILY STORY." Further, applicant argues that its services are different from those of the registrant, which applicant characterizes as "mass producing large quantities of videotapes," and that the trade channels for such services are necessarily different as well.

Applicant's first argument fails for several reasons. To begin with, it fails for lack of proof. The third-party registrations upon which the argument that registrant's mark is weak is based were not submitted by applicant until print-outs were filed with applicant's reply brief. The record on appeal, however, ordinarily closes with the filing of the Notice of Appeal. Applicant did not submit the third-party registration information until it submitted its reply brief. Moreover, even if applicant had timely submitted proper evidence of these registrations, such evidence would not constitute evidence of use of the marks shown therein, and therefore would not be evidence that the use and promotion of the marks has been so extensive that people are aware of them. Accordingly, the third-party registrations could not be the basis for the Board to conclude that the public is so familiar with marks consisting of or including either the term "FAMILY STORY" or the term "FAMILY STORIES" for keepsake videos, or, for that matter, any kind of videos, that other elements of such marks are the basis for consumers to distinguish among the marks used on these products. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Applicant's argument attempting to distinguish its services from the services set forth in the cited registration is likewise not supported by the record. The services in the application and registration, respectively, must be compared based on the ways they are identified in the application and registration, without restrictions or limitations that are not reflected therein. In re Elbaum, 211 USPQ 639 (TTAB 1981). Our conclusion that the services are essentially the same is based on the plain meanings of the respective recitations. To speculate that registrant is a mass producer of goods which travel in different channels of trade to different consumers for different uses may not be inconsistent with the way the services are stated in the registration, but registrant's services could just as easily be encompassed within the services identified in the application.

In summary, the marks of the parties are similar because they both create similar commercial impressions. Both are dominated by the same suggestive term, and both are used in connection with essentially the same service. Under these circumstances, confusion is plainly likely.

Ser No. 143885

Accordingly, the refusal to register is affirmed.

R. L. Simms

R. F. Cissel

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board

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