

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF TTAB JULY 14, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Times Mirror Magazines, Inc.

Serial No. 75/467,010

Avis Frazier-Thomas for Times Mirror Magazines, Inc.

Hannah M. Fisher, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hohein, Hairston and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Times Mirror Magazine, Inc. has filed an application
to register the mark THE SPORTING NEWS FANTASY HOCKEY
CHALLENGE for "role playing games, namely, providing sports
fans with a format wherein they are able to draft
individual professional players from the field of hockey

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and compete with these selected individuals in fictitious playoff and championship games."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark FANTASY HOCKEY for "computer game programs and board games."² Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

As background, we note that in the initial Office action the Examining Attorney made the requirement that applicant enter disclaimers of the terms SPORTING and FANTASY HOCKEY CHALLENGE. As support for her position, the Examining Attorney attached copies of extracts from a "sports database" showing use of the term "fantasy hockey" in "a generic manner" by third parties. These extracts from three newspaper sources each contain general references to "fantasy hockey leagues." In response to this requirement, applicant amended its application to one seeking registration under Section 2(f) and submitted a declaration in support of its claim of acquired

¹ Serial No. 75/467,010, filed April 13, 1998, claiming a first use date and a first use in commerce date of January 31, 1993. The application has been amended to one seeking registration under the provisions of Section 2(f).

² Registration No. 1,850,365, issued August 16, 1994. A disclaimer has been made of the word HOCKEY.

distinctiveness based on use of the mark since January 31, 1993. The Examining Attorney accepted the evidence of acquired distinctiveness and withdraw the disclaimer requirement.

In the initial Office action, the Examining Attorney also made a refusal under Section 2(d). It is that refusal which is now before us. The Examining Attorney maintains that applicant has "improperly attempted to appropriate registrant's mark." She argues that the general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks by merely adding a house mark or descriptive or suggestive matter is controlling here. In her view, applicant has simply added its house mark THE SPORTING NEWS and the descriptive term CHALLENGE to registrant's mark FANTASY HOCKEY. Any claim of fame by applicant for its house mark is considered irrelevant to the applicability of this general principle.

As for the goods involved, she points out that both marks are being used on games involving the same sport, hockey. She argues that any difference in specific form is unimportant, since games today are often available in a variety of media, albeit as cards, a board, a computer diskette, or the global computer network.

Applicant contends that we must look not just to the general rule set forth by the Examining Attorney, but also to the exceptions which have been made thereto, namely:

- (1) if the marks in their entireties convey significantly different commercial impressions; and/or
- (2) if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source due to its mere descriptiveness or the commonness of its use.

Applicant maintains that both of these exceptions are applicable here.

First, applicant argues that the mark THE SPORTING NEWS FANTASY HOCKEY CHALLENGE in its entirety creates a distinct commercial impression from that of the registered mark FANTASY HOCKEY, in view of the additional presence in applicant's mark of its previously registered mark THE SPORTING NEWS³ and of the term CHALLENGE. Second, applicant argues that the term "fantasy hockey" is highly descriptive, as evidenced by the extracts made of record by the Examining Attorney, and thus registrant's mark is so limited in trademark significance that the addition of both applicant's registered mark THE SPORTING NEWS and the term CHALLENGE would negate any likelihood of confusion.

³ In its application applicant has claimed ownership of five registrations for the mark THE SPORTING NEWS and variations thereof. Each registration contains a claim of acquired distinctiveness under Section 2(f) as to THE SPORTING NEWS.

While it is a general rule that the addition of a trade name or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion, an exception has been made in those cases where there are some recognizable differences between the assertedly conflicting product marks, so that the addition to one of a trade name or house mark or other such matter may be sufficient to render the marks as a whole distinguishable and thus to avoid confusion. See *In re Avnet, Inc.*, 195 USPQ 185 (TTAB 1977) and the cases cited therein.

Here, there are obvious differences in appearance and sound between registrant's mark FANTASY HOCKEY and the product mark portion of applicant's mark, FANTASY HOCKEY CHALLENGE. The additional term CHALLENGE in applicant's mark clearly refers to the competitive nature of applicant's role playing games, i.e., that sports fans are provided with a format in which they compete with others after selecting their team of professional hockey players. Registrant's mark contains no such indication of competition nor does registrant's identification of its goods as "computer game programs and board games," although inclusive of role playing games, infer any such competitive nature.

Furthermore, we cannot ignore the fact that the term "fantasy hockey" has been demonstrated by the evidence made of record by the Examining Attorney to be descriptive, at least in certain contexts. In addition, applicant has amended its application to one seeking registration under Section 2(f) and submitted evidence of acquired distinctiveness to overcome the requirement for a disclaimer, *inter alia*, of the term "fantasy hockey," as used in its mark.⁴

It is true that we cannot entertain any arguments that the cited mark FANTASY HOCKEY is merely descriptive, as used by registrant in connection with its computer and board games, this being an impermissible attack on the validity of the registration. See *In re C. F. Hathaway Co.*, 190 USPQ 343 (TTAB 1976) and the cases cited therein. Consequently, we cannot concur with applicant's reliance upon *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984), wherein both product marks had been adjudged or acknowledged to be merely descriptive.

Nonetheless, we can and do view the evidence of record and applicant's acquiescence with the disclaimer

⁴ The Examining Attorney notes in her brief that applicant, after amending its application to Section 2(f), did not further disclaim "fantasy hockey," as should be done for generic wording. Applicant was never required to enter such a disclaimer and no inferences whatsoever can be drawn from its failure to do so.

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requirement as indications of the highly suggestive nature of the mark FANTASY HOCKEY when used in connection with any type of sports game. Taking this inherent suggestiveness in conjunction with the specific differences between the registrant's mark FANTASY HOCKEY and the product mark portion of applicant's mark FANTASY HOCKEY CHALLENGE, we find the addition of the house mark THE SPORTING NEWS sufficient to render the marks as a whole distinguishable and thus to avoid confusion. We find this dissimilarity in marks sufficient to avoid confusion, despite the use of both marks on games involving hockey. See MarCon v. Avon, 4 USPQ2d 1474 (TTAB 1987) [addition of house mark AVON to suggestive term SILKEN sufficient to distinguish applicant's mark AVON SILKEN SOAP for body soap from opposer's mark SILK for hair and skin care products].

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

G. D. Hohein

P. T. Hairston

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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