

4/19/01

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

TJQ

Opposition No. 115,881

Playmore Inc., Publishers
and Waldman Publishing
Corp.

v.

John H. Bertholl

Before Cissel, Quinn and Wendel, Administrative Trademark
Judges.

By the Board:

An application was filed by John H. Bertholl to
register the mark PLAYMORE for "card games."¹

An opposition was filed jointly by Playmore Inc.,
Publishers and Waldman Publishing Corp. As grounds for
opposition under Section 2(d) of the Trademark Act, opposers
assert that applicant's mark, when applied to applicant's
goods, so resembles the previously used trademarks/trade
names PLAYMORE, PLAYMORE/WALDMAN and PLAYMORE/WALDMAN and
design for children's books and card games as to be likely
to cause confusion.

¹ Application Serial No. 75/541,465, filed August 24, 1998,
alleging first use anywhere on May 3, 1998, and first use in
commerce on July 17, 1998.

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Applicant filed an answer which did not comply with Fed. R. Civ. P. 8(b). After so informed by the Board, applicant filed an answer, in compliance with the rule, wherein applicant denied the salient allegations of likelihood of confusion. Trial dates were scheduled.

This case now comes up on opposers' motion for summary judgment filed on the eve of the opening of trial. Opposers claim that there are no genuine issues of material fact remaining for trial regarding priority and likelihood of confusion, and that they are entitled to judgment in their favor. In support of their motion, opposers submitted the declarations of Jon Horwich, president of Playmore Inc., Publishers, and Jason A. Zweig, one of opposers' attorneys. The declarations are accompanied by related exhibits.

Applicant has filed an untimely brief and exhibits in opposition to the motion for summary judgment. Also offered in opposition to opposers' motion is an even later-filed declaration of Mr. Bertholl.

Before turning to the merits of summary judgment in this case, we address the matter of applicant's untimely submissions. Opposers, in a reply brief, have objected to applicant's first submission on the basis of untimeliness, but also go on to reply on the merits.

Although the parties have argued this point based on the old rule requiring a response to a motion for summary

judgment within fifteen days, it should be noted that the rule was amended on October 9, 1998. Trademark Rule 2.127(e)(1) now provides that a brief in response to a motion for summary judgment must be filed within 30 days from the date of service of the motion. Even under this longer time, however, applicant's response, filed January 17, 2001, was still fifteen days late.² The declaration filed on March 13, 2001 was therefore seventy days late.

Given the untimeliness of applicant's submissions, we decline to consider them. We will not deem, however, opposers' motion as conceded pursuant to Trademark Rule 2.127(a), but rather we will consider it on the merits.³

The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of

² Opposers' motion was filed by Express Mail on December 1, 2000, thereby making applicant's response due, as provided by Rule 1.7, on January 2, 2001.

³ We hasten to add that applicant's submissions, even if considered, would not change the result in this case. That is to say, the evidence furnished by applicant does not raise a genuine issue of material fact for trial.

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material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1989). The record must be viewed in the light most favorable to the nonmoving party, and all factual inferences must be drawn in favor of the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a threshold matter, we find that there are no genuine issues of material fact regarding the joint opposers' standing in this case. Mr. Horwich's declaration with exhibits, including the certified copy of opposers' jointly owned registration of the mark PLAYMORE/WALDMAN for "juvenile books" (Registration No. 2,375,138, issued August 8, 2000), clearly establishes opposers' real interest in the outcome of this proceeding and a reasonable basis of their belief of damage grounded on a claim of likelihood of confusion which is not wholly without merit. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

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We likewise find the absence of a genuine issue of material fact as to opposers' priority of use. In view of opposers' ownership of a valid and subsisting registration of the mark PLAYMORE/WALDMAN covering children's books, opposers' priority of this mark is established as a matter of law. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, not only does Mr. Horwich's declaration establish prior use of opposers' other marks (and trade name PLAYMORE INC.) in connection with children's books, but Mr. Horwich's statements regarding prior use of opposers' marks PLAYMORE, PLAYMORE/WALDMAN and PLAYMORE/WALDMAN and design logo on children's card games stand unrebutted by any contravening evidence. An opposer is entitled to rely not only upon its mark and usage as shown in its registration, but also upon any unregistered usage that it can prove. *Burger Chef Systems, Inc. v. Burger Man, Inc.*, 492 F.2d 1398, 181 USPQ 168 (CCPA 1974). In sum, opposers have demonstrated priority of all of their marks in connection with children's books and children's card games.

We now turn to likelihood of confusion. In determining the issue of likelihood of confusion and, in this case, whether there is any genuine issue of material fact relating to the ultimate legal question, we must consider those of the thirteen evidentiary factors listed in *In re E. I.*

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duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) which are pertinent. In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Opposers submitted the declaration of Jon Horwich, president of Playmore Inc., Publishers which, according to Mr. Horwich, is commonly known as "Playmore." The declaration is accompanied by supporting exhibits, most particularly those showing uses of opposers' pleaded marks in connection with children's books and children's card games. Mr. Horwich stated that from 1942 through 1966, Playmore operated as a wholesaler and distributor of toys under the trade name "Playmore Inc.," and that in 1966, Playmore changed the primary focus of its business to the publication and distribution of children's books. In 1972, Playmore entered into a joint and exclusive business arrangement with Waldman Publishing Corp. ("Waldman") whereby Waldman is responsible for developing children's books and card games, and Playmore is responsible for marketing them. Playmore and Waldman's relationship is an exclusive one, and neither company develops or markets any product independently of the other. Since 1972, Playmore/Waldman have published thousands of different book

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titles, of which hundreds of millions have been sold. Playmore's trade name (PLAYMORE INC.) has appeared on the inside title page and/or on the back cover of all books published by Playmore/Waldman. Since 1997, the mark PLAYMORE/WALDMAN has appeared on the spines of all of their new books except where size does not permit it, and the logo shown below has also appeared on the covers of their new books.

Mr. Horwich goes on to state that in 1987, opposers expanded their product line to include children's card games. According to Mr. Horwich, this expansion was natural and is consistent with the common practice of other publishing companies (such as Golden Books, Scholastic and McGraw-Hill) that market both children's books and card games. Since 1987, Playmore/Waldman have produced about 35 different card games for children, and have sold more than 100 million card games worldwide. Playmore's trade name and the logo reproduced above appears on the box of every card game. Opposers' children's books and card games are distributed for sale to major discount chain stores, to wholesalers in the book and game industries and to

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independent retail stores such as Toys R Us, Wal-Mart and Kay Bee. Opposers' goods are sold in every state and throughout the world where English is commonly spoken. The books and card games are often sold in cabinets, supplied by opposers (each year over 15,000 worldwide), which prominently display the mark PLAYMORE on the front of each cabinet.

Opposers produce, market and distribute approximately 100 million units of product worldwide each year, of which 13 million units represent children's card games. Gross revenues in 1997-1999 exceeded \$72 million, of which over \$10 million is attributable to children's games.

Opposers spend millions of dollars each year in advertising and promotional activities. Opposers distribute over 15,000 catalogs worldwide each year, they appear at major trade shows, and they place advertisements in various printed media.

We find that there are no genuine issues of material fact remaining for trial, and that opposers are entitled to judgment as a matter of law on their claim of likelihood of confusion.

As to the goods, we must compare opposers' children's books and children's card games with applicant's "card games." In making this comparison, the identification recited in the involved application controls, and this

identification is broad enough to encompass card games of all types, including children's card games. See: Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, the parties' goods are, at least in part, legally identical, and are assumed to move in the same channels of trade to the same classes of purchasers. See: Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Likewise, given that applicant's identification of goods must be broadly construed to encompass children's card games, we find that these goods are related to opposers' children's books. As shown by opposers' evidence, children's books and children's card games are sold in the same stores and are marketed to the same classes of purchasers.⁴ See: Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 202 USPQ 100 (CCPA 1979)[use of LI'L TINKER and design for children's books and of TINKERTOY for games is likely to cause confusion; games and children's books all have a common marketing environment, being sold generally in toy stores

⁴ Contrary to the gist of some of applicant's arguments (if even considered), the fact that children's books (International Class 16) and card games (International Class 28) are placed in different classes is of no moment in deciding the issue of likelihood of confusion. The classification system was created for the convenience of the Office rather than to serve as evidence of the relatedness of the goods. See: National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1216 n. 5 (TTAB 1990).

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and toy departments of retail stores to the same purchasers]; and *The Instructo Corp. v. Parents' Magazine Enterprises, Inc.*, 178 USPQ 62 (TTAB 1973)[use of A STEPPING-STONE BOOK ("BOOK" disclaimed) for books and STEPPING STONES for children's games is likely to cause confusion; children's books and children's games would be available for purchase in the same retail store, and purchasers would assume that such goods originate with a single source if sold under similar marks].

Another factor regarding the goods herein is that they are inexpensive and, thus, are likely to be the subjects of impulse purchases. This factor increases the likelihood of confusion between the marks.

With respect to the marks, opposers' mark PLAYMORE (and trade name PLAYMORE INC.) is identical to applicant's mark PLAYMORE. Further, we find that opposers' marks PLAYMORE/WALDMAN and PLAYMORE/WALDMAN and design are similar to applicant's mark PLAYMORE in terms of appearance, sound and overall commercial impression. The "PLAYMORE" portion of opposers' marks is the first portion of these marks, and is the portion most likely to be remembered by purchasers. The addition of WALDMAN and/or the design feature in opposers' marks does not serve to sufficiently distinguish these marks from applicant's mark. In finding that the marks are similar, we note that the record is devoid of any

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evidence of any third-party uses or registrations of PLAYMORE or similar marks in the fields of children's books and card games. We have also kept in mind the normal fallibility of human memory over time and the fact that purchasers retain a general, rather than specific, impression of trademarks encountered in the marketplace.

For the above reasons, we conclude that there are no genuine issues of material fact remaining for trial and that opposers are entitled to judgment as a matter of law. Consumers familiar with opposers' marks PLAYMORE, PLAYMORE/WALDMAN and PLAYMORE/WALDMAN and design previously used on children's books and children's card games would be likely to believe, upon encountering applicant's mark PLAYMORE on card games, that the goods originate with or are somehow associated with or sponsored by the same entity. Accordingly, opposers' motion for summary judgment is granted.

Judgment is entered against applicant, the opposition is sustained and registration to applicant is refused.