

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

4/3/02

Hearing:
January 10, 2002

Paper No. 42
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Houghton Mifflin Company, Inc.

v.

George M. Tabb

Opposition No. 110,282
to application Serial No. 75/241,060
filed on February 13, 1997

Francine Miller, Mary Donovan and Marya Lenn Yee of
Donovan & Yee LLP for Houghton Mifflin Company, Inc.

Andrew E. Krents, Esq. for George M. Tabb.

Before Hanak, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

George M. Tabb has filed an application to register
the mark FURIOUS GEORGE for "film, video and audio
recordings featuring musical entertainment" in Class 9
and

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"entertainment services, namely, live performances by a musical band" in Class 41.¹

Houghton Mifflin Company, Inc. has filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act.² In the notice of opposition, opposer alleges, inter alia, that opposer is the owner of the world famous trademark and character CURIOUS GEORGE; that the first book of the CURIOUS GEORGE series was published in 1941, followed by six more books written by Margret and H.A. Rey and subsequently 28 more books were added to the series; that the mark CURIOUS GEORGE has additionally been used, both directly and under license, for a wide variety of goods and services; that opposer is the owner of registrations for the mark CURIOUS GEORGE and CURIOUS GEORGE and design for a variety of goods and services;³ that applicant's FURIOUS GEORGE mark is

¹ Serial No. 75/241,060, filed February 13, 1997, setting forth a first use date for the Class 9 goods of September 1, 1995 and for the Class 41 services of January 1, 1995 and a first use in commerce date for the Class 9 goods of September 1, 1995 and for the Class 41 services of January 5, 1995.

² Although not pleaded in the notice of opposition, opposer, in its brief, also argued the ground of dilution. In view of the testimony taken on this issue during the deposition of Maire Gorman, we consider the pleadings to be so amended and the issue to be before us as one tried by the implied consent of the parties under FRCP 15(b).

³ Opposer's pleaded registrations are:

virtually identical to opposer's mark and the marks are being used on the same and/or closely related goods and services; and that applicant's use and registration of FURIOUS GEORGE is likely to create confusion and deceive purchasers into believing that applicant's goods and

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- 1) Registration No. 1,288,789, issued August 7, 1984, for the mark CURIOUS GEORGE for "entertainment services, namely, a television series for children"; Section 8 and 15 affidavits accepted and acknowledged, respectively;
 - 2) Registration No. 1,292,195, issued August 28, 1984, for the mark CURIOUS GEORGE for "a series of books for children; coloring books" in Class 16 and "stuffed animals and equipment sold as a unit for playing a board game" in Class 28, Section 8 & 15 affidavits accepted and acknowledged, respectively;
 - 3) Registration No. 1,409,558, issued September 16, 1986, for the mark CURIOUS GEORGE for "children's wearing apparel, namely, footwear, sleepwear, robes, earmuffs, and boys and girls knit tops," Section 8 affidavit accepted;
 - 4) Registration No. 1,440,497, issued May 26, 1987, for the mark CURIOUS GEORGE and design for "production and distribution of television programming and motion picture films," Section 8 accepted; and
 - 5) Registration No. 2,074,846, issued July 1, 1997, for the mark CURIOUS GEORGE for "prerecorded video cassettes and prerecorded audio cassettes for use in telling children's stories."

Opposer's pleaded applications which have since matured into registrations are:

- 1) Registration No. 2,281,854, issued September 28, 1999, for the mark CURIOUS GEORGE for "balloons; bean bags; fabric dolls; fabric infant toys; jack-in-the-box; jumping jacks; mechanical action toys; musical toys, toy kits containing interchangeable design stickers; jigsaw puzzles; manipulative puzzles, toy banks and toy vehicles"; and
- 2) Registration No. 2,155,103, issued May 5, 1998, for the mark CURIOUS GEORGE for "computer programs and multimedia software recorded on CD-ROM, all for use in telling children's stories and inspiring children to create their own versions."

services originate with or are in some way sponsored or authorized by, or associated with opposer.

Applicant, in his answer, has denied most of the salient allegations of the notice of opposition, although admitting that "applicant's wordmark bears some similarity to Opposer's wordmark" and that "Applicant was and is aware of the wordmark CURIOUS GEORGE." As affirmative defenses applicant asserts his First Amendment rights "in providing his musical group with a name that enables such group to express itself" and the fair use defense, available to applicant under copyright law, "as a product parodist."

The Record

The record consists of the file of the involved application; opposer's trial testimony deposition, with accompanying exhibits, of Maire Gorman, Vice President, Director of Merchandise Licensing and Special Markets of opposer;⁴ certified status and title copies of opposer's

⁴ The deposition transcript has been designated as confidential. However, opposer has attached as an appendix to its brief a compilation of the record which is not designated as confidential and which contains the same deposition testimony. Accordingly, opposer has waived its claim of confidentiality for the deposition contents.

pleaded registrations made of record by notice of reliance;⁵

the discovery deposition of George Tabb, with accompanying exhibits, made of record by opposer by notice of reliance; and copies of newspaper and magazines articles regarding the character Curious George and his creators made of record by opposer by notice of reliance.⁶

Both parties filed briefs, but applicant waived his right to attend the oral hearing and only opposer participated in the hearing.

The Parties

Opposer published the first *Curious George* book in 1941, followed by the six additional books of the original series written by Margret and H.A. Rey in the 1950s and 1960s. All of the seven original books have been published continuously since their initial

⁵ We note that while opposer only pleaded ownership of five registrations and two applications which later became registrations in the notice of opposition, eight registrations have been submitted by notice of reliance. Inasmuch as applicant has failed to object thereto, the eighth registration, Registration No. 2,363,138 is also considered as being of record. This registration issued June 27, 2000 for the mark CURIOUS GEORGE for various goods, (e.g., backpacks and wallets) in Class 18.

⁶ Applicant's notices of reliance have been stricken from the record by the Board's order of January 24, 2001 as being filed outside applicant's testimony period. Opposer's notice of reliance upon the discovery deposition of a non-party has been stricken by the same Board order as not falling within any of the exceptions listed in Trademark Rule 2.120(j).

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publication date. Additional books derived from an animated film series have also been published.

Opposer has used the CURIOUS GEORGE mark in many other media forms, in addition to books. Video and live film versions have been produced, as well as audio tapes, audio cassettes, and CD-ROMs. Book club editions have been published of the books, along with translations into many foreign languages. Opposer's retail customers range from large chain stores such as Barnes & Noble and Musicland to small independent retailers. More of its customers buy CURIOUS GEORGE books than any other book opposer sells. The ultimate consumers of these products consist of parents of small children, librarians, educators, and "anyone who's got children in their life." (Gorman deposition, p. 96.)

Opposer became the owner of the Curious George character in the early 1990s and began a licensing program for the character and mark in 1994. Over the years the licensing program has expanded to include merchandise ranging from wearing apparel to stationery items to plush toys; opposer has over 115 active licensees including such entities as Gund, Sony and Mattel. This merchandise is sold in all types of retail stores, from Target and K-mart to specialty chains such

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as Barnes & Noble, Borders and Tower Records to independent book stores and specialty retail stores. Opposer exercises strict quality control over the manner of use of the CURIOUS GEORGE mark and character by its licensees and reviews every product at various stages to assure that opposer's qualifications and standards have been met. Opposer is very concerned with maintaining the wholesome image that the Curious George character portrays. Opposer also licenses the Curous George character for various types of live performances, licenses costumes for use by others and distributes a party kit to retail stores, librarians and teachers who are interested in hosting a Curious George party.

Over the years, more than 12 million copies of the CURIOUS GEORGE books have been sold in the United States, with worldwide sales of over 20 million copies in 12 languages. Gross sales over the past five years (1995-2000) totaled \$60 million. In addition, the gross sales from other CURIOUS GEORGE licensed merchandise for the years 1996-1999 was between \$160-\$170 million. From 1993-1998 opposer itself spent more than \$500,000 in advertising and promoting the CURIOUS GEORGE series. Additional advertising expenditures are made both by the licensing agents and the licensees themselves. There

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also has been substantial media coverage over the years of the Curious George character and the various CURIIOUS GEORGE products, such as the highly touted educational CD-ROMs.

Applicant, George Tabb, has played in the punk rock band FURIOUS GEORGE since 1995 or 1996. The band has put out two CDs, the first one an extended-play three songs entitled *Furious George Goes Ape!*, the second one a full album entitled *Furious George Gets a Record!*. Applicant designed the covers for each of the CDs and on both used a yellow background, red FURIOUS GEORGE tube lettering, and a picture of a monkey. The FURIOUS GEORGE mark is also used on various promotional items which are either sold or given away by the band, including T-shirts, buttons and patches. The typical audience for the band's shows runs from persons in their late teens through their early 40s.

The Opposition

Priority is not an issue here in view of opposer's submission of certified status and title copies of its pleaded registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer's witness Maire Gorman has testified to the publication of the original series of

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CURIOUS GEORGE books well prior to applicant's filing of his application, the earliest date to which applicant is entitled.

Turning to the issue of likelihood of confusion, we take under consideration all of the *du Pont* factors which are relevant under the present circumstances and for which there is evidence of record. See *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking first to the similarity or dissimilarity of the respective marks, we find that, when viewed in their entirety as they must be, the marks CURIOUS GEORGE and FURIOUS GEORGE are highly similar in both appearance and sound. Not only do the marks share the common term GEORGE, but also there is only one letter difference between the terms CURIOUS and FURIOUS. While there is an obvious difference in connotation between CURIOUS and FURIOUS, we do not find this distinction sufficient to obviate the strong likelihood of confusion of the two marks. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1895 (Fed. Cir. 2000) (Board must consider the similarity or dissimilarity of the marks in their entirety with respect to appearance, sound and connotation, not simply difference in connotation between FIDO LAY and FRITO-LAY).

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But in the present case there are additional reasons for finding the overall commercial impressions created by the marks to be highly similar. The similarity in trade dress between applicant's manner of use of his FURIOUS GEORGE mark and opposer's use of the CURIOUS GEORGE mark cannot be overlooked. As stated in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992), citing *Specialty Brands, Inc. v. Coffee Beans Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984):

Ordinarily, for a word mark we do not look to the trade dress, which can be changed at any time. [Citation omitted] But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar impression.

Opposer has made a comparison of the cover of its book *Curious George and the Dinosaur* and the cover of applicant's CD entitled *Furious George Goes Ape!*. From this it is blatantly clear that applicant uses the same yellow background as opposer, the same red color for the title as opposer and the same style of lettering. The monkeys depicted on both look very similar, both are tailless, both have hair on the same portions of their bodies. Only the sunglasses and leather jacket distinguish the monkey of FURIOUS GEORGE from the more wholesome CURIOUS GEORGE. In addition, "the Man in the

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Yellow Hat," a familiar character in the CURIOUS GEORGE series, is included on applicant's CD cover. While applicant testified that he chose the yellow and red colorings because they "went well" together, we can only conclude that this obvious similarity in trade dress for the display of the marks of opposer and applicant would lead to the creation of highly similar overall commercial impressions for the marks.

Turning next to the goods and services involved, we note at the outset that both opposer and applicant use their marks on audio and video recordings. The content of applicant's recordings is identified simply as "musical entertainment"; there is nothing that would limit this music to the punk rock compositions of "rage and irony" of which applicant contends his recordings consist. The issue of likelihood of confusion must be determined based on an analysis of the mark as used in connection with the goods and services recited in applicant's application vis-à-vis the goods and services recited in opposer's registrations, rather than what any evidence may show the actual goods and services to be. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). The

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recordings of both parties must be viewed, as identified, as covering musical entertainment in general.

Applicant's mark is also used in connection with entertainment services in the nature of live performances by a band; opposer's mark is registered for use in connection with a television series and motion picture films. Opposer has established common law use of its mark in connection with live stage performances and appearance of the Curious George character throughout the United States. We find these uses more than sufficient to consider the goods and services of the parties closely related.

Furthermore, there are no restrictions in the goods or services as identified in applicant's application or opposer's registrations as to the channels of trade. Because there are no such limitations, it must be presumed that the goods and services of each would be offered in all the normal channels of trade for goods and services of this nature and to the normal class of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank, supra*. Thus, it must be presumed that applicant's recordings would be sold at all the normal retail outlets for such goods. Opposer's recordings would be sold at the same outlets and thus be available to the same

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purchasers. Applicant argued that his goods are not actually offered at any of the national retailers at which opposer's goods are found, with the exception of Tower Records. Thus, even applicant acknowledged that the goods of both parties are, in fact, sold in at least one similar set of retail stores. Moreover, a clear distinction cannot be drawn between the consumers of punk rock music and the consumers of children's recordings, as applicant would urge. Even consumers of punk rock may fall within the general category of "anyone who's got children in their life" and thus could, at times, be in the market for children's recordings as well.

In addition, we note that insofar as the goods of opposer and applicant are concerned, both fall within the range of being relatively inexpensive. Ms. Gorman testified that the average price for a CURIOUS GEORGE product would be \$12-15; Mr. Tabb testified that his CDs and other promotional items have been sold for \$10 or less. When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of this type typically exercise a lesser standard of purchasing care. See *Recot Inc. v. M.C. Becton, supra*.

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Next we turn to a significant factor in the present case, the fame of the prior mark, namely opposer's mark CURIOUS GEORGE. As stated by our principal reviewing court in *Kenner Parker Toys v. Rose Art Industries, Inc.*, *supra*, in its consideration of the fame of the prior mark:

[A] mark with extensive public recognition and renown deserves and receives more legal protection than

an obscure or weak mark.

Achieving fame for a mark in the marketplace where

countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner,

but

the consumers who rely on the symbols to identify the

source of a desired product.

We find the record here fully substantiates the fame which opposer's CURIOUS GEORGE mark has achieved. The many years of use of the mark (since the early 1940s), the wide variety of goods and services to which use of the mark has been expanded, the high level of sales over the years and the broad media coverage of the Curious George character all point to the extensive public recognition and renown of the mark. The CURIOUS GEORGE books, the associated goods such as audio or video recordings or CD-ROMs bearing this mark, as well as the

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many licensed merchandise items, be they plush toys or wearing apparel, have all been shown to fall within the gambit of this fame.

As emphasized by the court in its recent decision in *Recot, Inc. v. M.C. Becton, supra*, the fame of the prior mark, when found to exist, must play a dominant role in the process of balancing the relevant *du Pont* factors. Thus it is that famous marks enjoy a wide latitude of legal protection. This broader protection is accorded because the marks are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* at 54 USPQ2d 1897. In line with this reasoning, we find that opposer's famous CURIOUS GEORGE mark may well be called to mind when purchasers encounter applicant's FURIOUS GEORGE mark, particularly in view of the highly similar visual and aural characteristics of the marks and of the manner in which the FURIOUS GEORGE mark is presented to the public. We are convinced that the broader scope of protection to be accorded to a famous mark should extend to encompass the mark of another which is being used for highly similar goods and services and which creates a commercial impression very similar to that of the famous mark.

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Opposer has also raised an additional factor for our consideration, specifically the intent of applicant in adopting his FURIOUS GEORGE mark. It is true that applicant has admitted his familiarity with the CURIOUS GEORGE books from his childhood days. It is also true that applicant has designed the covers of the band's CDs such that they contain elements highly similar to the trade dress used by opposer. On the other hand, applicant has testified that the name FURIOUS GEORGE originates from the fact that his name is George; that as a child he was called "Furious George"; and that the mark personifies the music he plays which is "angry and screaming."

On balance, we cannot unequivocally say that applicant has intentionally chosen his mark to trade on the good will associated with opposer's mark. But we would be quick to point out that the lack of evidence of bad faith is but one factor in our analysis of likelihood of confusion and the absence of any such evidence clearly does not avoid a holding of likelihood of confusion. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889 (Fed. Cir. 1991); *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

Every other factor which we have considered here falls strongly in opposer's favor. The overall similarity in commercial impression of the marks, the close relationship of the goods and services, the identity in channels of trade, the similarity in type of purchase and type of purchasers, all weigh heavily on the side of opposer. If there were any doubt on the issue of likelihood of confusion, which there is not, our decision would be strengthened by the court's statement in *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.*, *supra* at 1456, citing *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989), that

[T]here is "no excuse for even approaching the well-known trademark of a competitor ... and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous... ."

Accordingly, we find that opposer has clearly established a likelihood of confusion from the contemporaneous use of the marks CURIOUS GEORGE and FURIOUS GEORGE with the goods and services of the respective parties.⁷

Applicant's argument that opposer is attempting to extend the copyright protection of its literary property

⁷ In view of our determination on the issue of likelihood of confusion, we find no need to consider opposer's further claim of dilution.

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rights is misdirected. Opposer is relying upon its trademark rights, as evidenced by its pleaded registrations and its established common law rights, in this proceeding. Applicant is seeking to register his mark, which under the provisions of Section 2(d) of the Trademark Act is barred if his mark is likely to cause confusion with a mark "registered in the Patent and Trademark Office" or with a mark "previously used in the United States by another." Opposer is relying upon its rights established under this section of the Trademark Act to oppose applicant's registration of his mark, not any rights under copyright law, which are entirely irrelevant to this proceeding.

Applicant further argues his right to the registration of a parodic mark in that applicant has a First Amendment right to commercially exploit literary characters in a parodic way.

In the first place, as discussed above, we are not dealing here with opposer's rights in its literary characters but rather its established trademark rights in the trademark CURIOUS GEORGE. Moreover, any claim which applicant may make to the use of his FURIOUS GEORGE mark as a parody will not be considered as a "defense" but rather simply as another factor which is relevant to our

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analysis of likelihood of confusion. See *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 USPQ2d 1737 (5th Cir 1998); *Dr. Seuss Enterprises L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 42 USPQ2d 1184 (9th Cir. 1997). As stated by the Board in *Columbia Pictures Industries, Inc. v. Miller*, 211 USPQ 816, 820 (TTAB 1981):

The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use

conflicts with the prior use and/or registration of the substantially same mark by another.

See also *Anheuser-Busch Inc. v. The Florist's Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993) (applicant's argument that THIS BUD'S FOR YOU when used with fresh-cut flowers would be viewed as a parody of opposer's mark THIS BUD'S FOR YOU for beer is not persuasive when evidence shows that use of the slogan will do more than merely conjure up in the minds of potential purchasers opposer's use of the slogan; instead purchasers are likely to believe that applicant's flowers are being offered under the sponsorship of opposer).

We are convinced in the present case, however, that applicant is not even using his mark FURIOUS GEORGE in a manner intended to parody opposer's CURIOUS GEORGE mark.

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As stated in 5 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 31:153 (4th ed. 2001):

[I]f defendant appropriates a trademarked symbol such as a word or picture, not to parody the product or company symbolized by the trademark, but only as a prominent means to satirize and poke fun at something else in society, this is not "parody" of a trademark.

Here the evidence of record points to the use of the FURIOUS GEORGE mark in connection with applicant's "angry and screaming" punk rock music, regardless of topic. In his answer applicant describes himself as a "product parodist" in general and from the titles of songs in his albums it would appear that this self-proclaimed "parodist" role is directed to many subjects, the titles including such as "betty crocker, punk rocker," "prozac defense," and "burger king is dead." In fact, applicant has specifically denied any association of the name FURIOUS GEORGE with other than his music as a "furious" person named George and has denied any intentional appropriation of the CURIOUS GEORGE trade dress, testifying, for example, that the colors red and yellow "went well" with each other. Thus, applicant has clearly failed to present evidence which supports any claim of parody of opposer's CURIOUS GEORGE mark. We need not consider this as a relevant factor in our analysis of likelihood of confusion.

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Decision: The opposition is sustained and registration is refused to applicant.