

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

6/4/02

Paper No. 48
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Viacom International Inc.

v.

Amy Schrier

Opposition Nos. 113,801 and 114,029

Barbara A. Solomon and Patrick T. Perkins of Fross
Zelnick Lehrman & Zissu, P.C. for Viacom International
Inc.

Robert S. Weisbein of Darby & Darby, P.C. for Amy
Schrier.

Before Chapman, Wendel and Drost, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Viacom International Inc. (a Delaware corporation)
has opposed two applications filed on May 1, 1998, owned
by Amy Schrier (an individual residing in New York City),
both to register the mark BLUE on the Principal Register.

Application Serial No. 75/477,979 (the subject of
Opposition No. 113,801) is for goods amended to read
"publications, namely, magazines and newsletters in the
fields of adventure, travel, sports and contemporary

Opposition Nos. 113801 and 114029

lifestyles" in International Class 16. This application is based on applicant's claimed date of first use and first use in commerce of June 1997.

Application Serial No. 75/477,901 (the subject of Opposition No. 114,029) is for services amended to read "entertainment services in the nature of a series of television shows featuring sporting events, travel and adventure, and a series of educational programs featuring outdoor activities for broadcast and cable television; organizing and conducting sporting events" in International Class 41. This application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

As grounds for opposition, opposer made essentially the same allegations in its two notices of opposition, namely, that through its wholly owned division MTV Networks, opposer operates the cable programming service Nickelodeon; the Nickelodeon program service features programming geared to children, teens, young adults, and their parents; that Nickelodeon is the leading children's television programming service in the United States; that one of the shows aired on Nickelodeon is "Blue's Clues," which first aired in September 1996, and it is "an interactive television show geared to preschoolers and

Opposition Nos. 113801 and 114029

their parents featuring Blue, an animated puppy, and her human friend, Steve"; that "together, Blue and Steve invite their audience to be part of their every day adventures and to help solve puzzles" (paragraph 2); that the "Blue's Clues" show is among the highest rated television shows and has been shown continuously since September 1996, airing nationally 12 times a week; that as a result of the popularity of the television show, the BLUE'S CLUES mark has been used by opposer and its licensees for a wide variety of goods and services, including, home videos and software, magazines, plush toys, stickers and paper decorations; that opposer owns Registration No. 2,131,092 for the mark BLUE'S CLUES for "entertainment in the nature of an on-going television series in the field of preschool animated/live action programs"¹; that opposer owns application Serial No. 75/016,500 for the mark BLUE'S CLUES for printed matter including magazines and books, for which a notice of allowance has issued, and upon registration thereof, "[opposer] will have a constructive use and priority date of November 8, 1995²; that opposer's "[BLUE'S CLUES] mark

¹ Registration No. 2,131,029, issued January 20, 1998.

² Opposer pled its pending application only in Opposition No. 113,801, which is the opposition against applicant's use-based application for goods in the publications field. However, these

Opposition Nos. 113801 and 114029

has acquired enormous value and has become well known to the consuming public and trade..." (paragraph 8 and 7, respectively, in the two notices of opposition); and that

two proceedings were consolidated pursuant to Fed. R. Civ. P. 42(a) by Board order dated May 30, 2000.

Opposition Nos. 113801 and 114029

applicant's mark, when used on or in connection with her goods and services, so resembles opposer's previously used and registered mark, BLUE'S CLUES, as to be likely to cause confusion, mistake, or deception in contravention of Section 2(d) of the Trademark Act.

In applicant's answer filed in Opposition No. 113,801 (involving applicant's use-based application for goods) she denies the salient allegations of the notices of opposition, and raises affirmative defenses by stating "The Notice of Opposition is barred by equity under theories of laches, estoppel, and acquiescence."³

In her answer filed in Opposition No. 114,029 (involving her application for services based on her assertion of a bona fide intention to use the mark in commerce) she admits that the filing date of her application is subsequent to (i) opposer's claimed first use date, (ii) opposer's filing date for its service mark, and (iii) opposer's registration date of its Registration No. 2,131,092, but she otherwise denies the salient allegations of the notice of opposition.

³ Inasmuch as applicant offered no evidence on any affirmative defense and did not raise any affirmative defense in her brief on the case, we consider the affirmative defense(s) to have been waived by applicant.

Opposition Nos. 113801 and 114029

As noted above, opposer's motion to consolidate the two oppositions was granted, and the Board consolidated the proceedings in a May 30, 2000 order.

The record consists of the pleadings (in both oppositions); the files of the two opposed applications; opposer's notice of reliance under Trademark Rule 2.122(e) on (i) a status and title copy of its pleaded Registration No. 2,131,029⁴, and (ii) photocopies of articles from industry periodicals and mainstream publications in general circulation; applicant's notice of reliance under Trademark Rule 2.122(e) on (i) status and title copies of numerous third-party registrations which include the word BLUE as part of the mark, and (ii) printouts of two stories retrieved from the Lexis/Nexis database alleged to be from "the mainstream press in general circulation"⁵; and opposer's rebuttal notice of reliance on certain testimony exhibits offered under

⁴ See Trademark Rule 2.122(d)(2).

⁵ Both articles are from wire services ("Business Wire" and "PR Newswire"). Evidence from proprietary news services is not presumed to have circulated among the general public, and therefore its probative value is limited. There is no indication that the wire service articles were ever published. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1555 n. 6 (TTAB 1987).

Opposition Nos. 113801 and 114029

Trademark Rule 2.123(e)(2); the testimony, with exhibits, of the following persons offered by opposer⁶:

- (1) Leigh Anne Brodsky, senior vice president of consumer products for Nickelodeon;
- (2) Janice Burgess, vice president of Nick, Jr. at Nickelodeon (taken by opposer on December 15, 2000);
- (3) Daniel Sullivan, general manager and senior vice president of Nickelodeon Magazine Group; and
- (4) Amy Schrier, applicant (taken by opposer pursuant to a subpoena on December 18, 2000);

and the testimony, with exhibits, of the following persons offered by applicant:

- (1) Amy Schrier (taken by applicant on January 25, 2001);
- (2) Janice Burgess, vice president of Nick, Jr. at Nickelodeon (taken by applicant pursuant to a subpoena on February 16, 2001);
- (3) Earl Humphrey, a principal in Berkeley Hill Media LLC;

⁶ Portions of the trial testimony of some of the witnesses were submitted as "confidential" and opposer filed its entire trial brief marked "Highly Confidential-Attorneys' Eyes Only To Be Filed Under Seal" (emphasis in original). Although neither applicant's brief nor opposer's reply brief are marked as confidential, nonetheless, the Board has exercised discretion in discussing evidence originally submitted as confidential.

Opposition Nos. 113801 and 114029

(4) Sharon Markowitz, senior vice president of licensing in the Consumer Products Division of Saban Entertainment; and

(5) Ian H. Ibarra, a paralegal at applicant's attorneys' law firm.

Both parties filed briefs⁷ on the consolidated case⁸, and neither party requested an oral hearing.

Evidentiary Matters

Applicant has objected to three separate matters of evidence in these consolidated cases.⁹ First, applicant renewed her objection to opposer's "use of and reliance on the term 'blue' and the 'blue' character to show any likelihood of confusion" and moved to strike "all references to the Blue character in the deposition testimony and in [opposer's] brief." (Brief, pp. 6 and 8.) Applicant contends that opposer did not specify the BLUE character and name as a ground for the oppositions; that an unpleaded claim can only be considered if the

⁷ Opposer attached a status and title copy of its second registration, Registration No. 2,416,016 issued December 26, 2000, to its brief on the case. The admissibility of this registration will be fully discussed later in this decision.

⁸ Applicant's motion (filed July 19, 2001) to extend her time to file a brief on the case, and opposer's motion (filed August 30, 2001) to extend its time to file a reply brief are both granted.

⁹ While opposer raised some objections during the depositions of witnesses, it failed to preserve any such objections because opposer did not raise them in its brief on the case. See TBMP §718.04.

Opposition Nos. 113801 and 114029

pleading is amended to include the additional ground(s) or if it was tried by express or implied consent of the parties; that opposer never moved to amend its pleadings, and applicant consistently objected during testimony to this matter; and that therefore, opposer is limited to its BLUE'S CLUES mark pleaded in the notices of opposition.

Opposer argues that from the outset of these proceedings it was clear that opposer intended to place the BLUE character at issue in these proceedings, including a reference to the animated puppy character in paragraph 2 of both notices of opposition; that opposer's pleading gave applicant sufficient "fair notice" that opposer was relying on rights in the BLUE character; that it is obvious that the title BLUE'S CLUES refers to the BLUE character; that during testimony depositions applicant made only "vague and unspecified objections-on differing grounds, including 'hearsay' and 'relevancy'" (opposer's brief, p. 6); that properly and timely taken evidence is not stricken but substantive objections are considered in evaluating the probative value of the evidence; and that the Board cannot ignore evidence which is relevant to the issue of likelihood of confusion.

Opposition Nos. 113801 and 114029

Of course, it is true (and applicant agrees) that Section 2(d) of the Trademark Act provides for opposition to an applicant's application for registration based not only upon registered marks, but also upon the prior use of unregistered marks. However, these unregistered marks must be properly pled or tried by the parties.

In these two consolidated oppositions, a reasonable and fair reading of the notices of opposition, shows that opposer did not plead rights in any mark except BLUE'S CLUES. It is true that opposer made a single reference to the character BLUE in paragraph 2 of each notice of opposition wherein opposer refers to its television show BLUE'S CLUES as "featuring Blue, an animated puppy, and her human friend Steve. Together, Blue and Steve invite their audience to be part of their everyday adventures and to help solve puzzles." However, throughout the pleadings opposer refers to only one mark, BLUE'S CLUES. For example, "the Blue's Clues program is identified by the mark BLUE'S CLUES which appears in print and television advertising" -- paragraph 4; "as a result of Opposer's exclusive use and promotion of its BLUE'S CLUES mark, the mark has acquired enormous value and has become well known..." -- paragraphs 8 and 7 in the oppositions, respectively; "the BLUE'S CLUES mark is exclusively

Opposition Nos. 113801 and 114029

associated with Opposer..." -- paragraphs 16 and 15 in the oppositions, respectively; and "Applicant's mark BLUE is highly related in sound, appearance, meaning and commercial impression to Opposer's BLUE'S CLUES mark..." -- paragraphs 17 and 16 in the oppositions, respectively.

Opposer plead only one mark--BLUE'S CLUES. Its glancing reference to "Blue" as an animated puppy character in the BLUE'S CLUES television show cannot be read to be a pleading of separate rights in the word mark "Blue" as the name of the character. By that logic, opposer would also have separately plead rights in the name "Steve."

Opposer certainly knew of its own marks and if it intended to assert rights in any mark other than BLUE'S CLUES (registered or common law), it was obligated to either properly plead such marks, or move to amend its pleadings or try such issues with the consent of applicant. There is no pleading of rights in any mark except BLUE'S CLUES; opposer did not move to amend its pleadings to include any additional mark(s); and the record is clear that applicant did not consent to trial of any such additional marks. To allow opposer to interject use of the unregistered term "BLUE" or the "Blue" character name into this case would be patently

Opposition Nos. 113801 and 114029

unfair to applicant. See *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994); *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454-1455 (TTAB 1998); and *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884-1885 (TTAB 1993). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:24 (4th ed. 2001).

Opposer's argument that all evidence of record must be considered in determining likelihood of confusion and the case cited in support thereof, begs the question of whether the evidence should be allowed into the record. Obviously, evidence not properly of record cannot be considered in determining the issues before the Board. See generally, the Federal Rules of Evidence, for example, Rules 103, 104 and 403.

Accordingly, the Board sustains applicant's objections to opposer's use of the term "BLUE" and the "Blue" character name to establish likelihood of confusion. Our likelihood of confusion analysis will be limited to a consideration of applicant's mark BLUE and opposer's mark BLUE'S CLUES. That is, we have considered only opposer's pleaded and proven mark BLUE'S CLUES for purposes of determining the likelihood of confusion issue

Opposition Nos. 113801 and 114029

in these two oppositions, and we will not compare applicant's mark with any other mark of opposer.¹⁰

To the extent applicant requested that opposer's reference to the BLUE character be stricken from opposer's brief, that request is denied. First, applicant did not enumerate any specific statements by opposer or any specific page numbers. Second, as explained more thoroughly later in this decision, the Board does not generally strike matter from briefs on the case.

Second, applicant moved to strike opposer's Registration No. 2,416,016 (issued December 26, 2000, for the mark BLUE'S CLUES for "note paper and loose leaf paper, informational magazines and books on the topics of television and entertainment, decals"). Applicant contends that opposer did not properly and timely introduce the registration into the record under the Trademark Rules.

¹⁰ Even if we had considered opposer's asserted claim of common law rights in the mark BLUE, any such rights would be limited to the specific goods and/or services on which opposer proved use; and opposer must also establish that any common law marks are either inherently distinctive or have acquired distinctiveness, which was not done in this case. See *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Opposition Nos. 113801 and 114029

We overrule applicant's objection to this registration. Opposer pleaded the underlying intent-to-use application in one of the notices of opposition, and even pleaded that a notice of allowance had issued thereon. Thus, there is no question that applicant had fair notice of opposer's claim of rights in the mark BLUE'S CLUES for the involved goods. Moreover, the registration issued just after the closing date of opposer's testimony period, which was December 22, 2000. While opposer could have filed a motion to reopen its testimony period solely to introduce a status and title copy of the registration, or opposer could perhaps have attempted to introduce it during opposer's rebuttal testimony period, it seems plausible in this consolidated case that applicant would have contested either scenario. In addition, we note that in applicant's own brief on the case (p. 4), she states that "The oppositions were grounded solely on the two registrations for BLUE'S CLUES, in classes 16 and 41 respectively. (pleading paragraph omitted) Any other registrations, pending applications or common law rights Opposer mentions are not the subject of this proceeding, ..." Thus, even applicant recognizes the grounds for the oppositions include both of opposer's Registration Nos. 2,131,029 and

Opposition Nos. 113801 and 114029

2,416,016. Finally, the predecessor court of our primary reviewing court stated in the case of Hollister Incorporated v. Downey, 565 F.2d 1208, 196 USPQ 118, 120 (CCPA 1977) "under the circumstances of this case, the board could have set a time for Hollister to obtain and file proof of title. A flexible, not mechanical, approach was warranted under these circumstances..." Cf. Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1711 (Fed. Cir. 1991).

We find that the current status and title copy of opposer's Registration No. 2,416,016 prepared by the USPTO and attached to opposer's brief on the case is properly considered of record herein.¹¹

Third, applicant moved to strike eight specific statements in opposer's brief, as well as opposer's exhibit No. 3 (a copy of an article from the June 12, 1998 issue of "Entertainment Weekly"), contending that this material constitutes quotes from newspaper and magazine articles and it is hearsay, uncorroborated by testimony; and that

¹¹ Applicant (on page 4 of her brief) separately objected to a comment in opposer's brief (at page 9) that it owns nine registrations and several additional pending applications. Inasmuch as any such registrations or applications were neither pleaded nor proven by opposer, this comment in opposer's brief is irrelevant to these consolidated cases.

Opposition Nos. 113801 and 114029

opposer is attempting to use various mainstream printed publications to show the truth of the matter asserted therein. The Board does not generally strike statements/arguments in a brief, but we will consider a party's objections and any improper portion(s) of a brief will be disregarded. See TBMP §540. This objection generally relates more to the probative value of the evidence than the admissibility thereof. Opposer's exhibit No. 3 was timely and properly introduced and it will not be stricken, but will be considered for whatever probative value it may have. Applicant's motion to strike eight statements from opposer's brief, and opposer's exhibit No. 3 is denied. See TBMP §708. We hasten to add that the printed publications introduced in this consolidated case will be considered only for appropriate purposes.

The Parties

Applicant, Amy Schrier, is the founder of the magazine "BLUE," and she is the president and CEO of Blue Media Ventures LLC, which publishes the magazine. Around October 1996 she, as owner of the trademark, entered into a long-term license agreement with Blue Media Ventures LLC.

Opposition Nos. 113801 and 114029

While working for an English language publication in Hong Kong in 1994, applicant worked on the concept of an adventure, sports and travel lifestyle magazine to fill a void in that area. It would include action sports, integration with nature, adventure/travel to out-of-the-ordinary destinations, environmental responsibility, top-notch writing and photography. After working on the concept and the business for two years, Blue Media Ventures LLC was established in 1996. In May 1996 the mark BLUE was selected as innovative and a name which served the objective of having the name defined through the magazine and not having the magazine defined by a descriptive name. Specifically, BLUE was intended to connote a sense of outdoors (blue sky, blue sea, blue planet), adventurous pursuits, and a sense of freedom.

The first press release announcing applicant's magazine was sent out in June 1996, with follow up promotional activities (including sending mailings, distributing media kits, attending trade fairs, printing subscription brochures); and the first issue of applicant's magazine, BLUE, was published in July 1997. Approximately 100,000 copies of the premier issue were distributed to bookstore chains, such as Barnes & Noble and B. Dalton, and other such national newsstand

Opposition Nos. 113801 and 114029

distribution; specialty retail outlets such as small, independent stores focused on outdoor recreation and sports; and music stores such as Tower Records and Books. It was also distributed through the limited early subscriptions and to complimentary promotion lists.

A media research study of the readership of applicant's magazine, showed that the readers are predominately male, college graduates, between the ages of 25-49 and about 65% are single.

Applicant's magazine has received much press coverage in both print and broadcast media, including stories in "The New York Times," "USA Today," "Vogue Magazine," and on CNN, FOX and MSNBC; and it has won a variety of editorial, design, and photography awards, including, Life Magazine Best Photos of the Year.

Applicant's annual advertising and promotional costs were submitted as confidential and thus cannot be stated with specificity. However, suffice it to say that these costs have grown from a five-figure number in 1997 to a seven-figure number in 2000. The annual revenues (also confidential) for this magazine grew from a six-figure number in 1997 to a seven-figure number in 2000. The magazine is published six times a year, with a circulation for each issue of about 175,000.

Opposition Nos. 113801 and 114029

The magazine, BLUE, is advertised through direct mailings, urban postings on city streets, and a website was launched in 1998 and revamped and re-launched in January 2000. Applicant attends trade fairs for the purpose of selling advertising in the magazine, and applicant advertises the magazine on the Internet.

Amy Schrier testified that there are plans to produce a television program covering the same genre of adventure, travel and sports (e.g., heliskiing in Alaska, sand boarding in Morocco); and that there are no plans to develop programs targeted to children. (The documentation of these plans was submitted as confidential. See e.g., Opposer's Exhibit No. 7.)

Opposer, Viacom International Inc., owns and operates the Nickleodeon television network for children, offering television programming services and a variety of licensed products. One of opposer's children's shows is BLUE'S CLUES which premiered in September 1996. It is a play-along, interactive television show for children 2-5 years old. BLUE'S CLUES has aired weekly since September 1996, and by December 15, 2000 (the date of the first testimony deposition of Janice Burgess, vice president of Nick, Jr.) 67 episodes had aired on the Nickelodeon channel. Each episode has a theme, such as, "Treasure

Opposition Nos. 113801 and 114029

Hunt" or "Birthday Party." In September 2000, the show began airing on the CBS network on Saturday morning. Also, a live touring show was started in early 2000.

BLUE'S CLUES is one of the top-rated children's television shows, with over 14 million viewers each week, mostly preschool children and women between the ages of 18-49.

Opposer advertises the BLUE'S CLUES television show through parenting and television publications, such as "Parents," "People," and "TV Guide"; targeting preschool 2-5 year old children, their parents and family (e.g., grandparents, older siblings) and caregivers of young children. It also runs advertisements on television, including on its Nickelodeon channel.

The show BLUE'S CLUES is the most successful licensing property of Nickelodeon, with about 1000 licensees. The licensed products include, toys, CDs, story books, activity books, coloring books, videos, stationery, apparel and home furnishings. Retail sales for BLUE'S CLUES merchandise grew from about \$100-150 million in 1998, to \$600-650 million in 1999, and to an estimated \$1.2 billion in 2000. About 5% to 10% of the total retail sales comprise publications. Opposer also markets (particularly the apparel and stationery items)

Opposition Nos. 113801 and 114029

to kids ages 10 through early teen years. Opposer budgeted about \$2 million dollars for advertising Nickelodeon's various retail products in 2000, but opposer was uncertain as to what percentage of that budget was for advertising BLUE'S CLUES products, other than a "large percentage." (Brodsky dep., p. 36.)

The show BLUE'S CLUES has won awards (e.g., Parent's Choice), and has been nominated for Emmy awards, and the show has received much media attention as evidenced by reviews of and/or stories about the television show in "The New York Times," "Chicago Sun-Times," "The Sunday Oklahoman," "Minneapolis Star-Tribune," "TV Newsday" and "TV Guide."

In addition to the television show and the licensing of numerous products related thereto, opposer, through its Nickelodeon magazine unit, also publishes various magazines. The "Nickelodeon" and "Nick, Jr." magazines are general publications not limited to Nickelodeon properties, but rather including stories about artists such as *NSYNC. "Nick, Jr." is a magazine for preschool children and their parents. It was first published in October 1999, and is published six times a year; being distributed in preschool and daycare centers, and by subscription and on newsstands. In 1999 about 300,000

Opposition Nos. 113801 and 114029

copies were distributed and in 2000 it grew to 500,000 copies, with a projection of 600,000 copies for 2001. The majority of the magazines are distributed to preschool and daycare centers, for example, for the year 2000, of the 500,000 distributed, 300,000 went to preschool and day care centers, 175,000 were distributed by subscription, and about 25,000 were on newsstands.

"Nick, Jr." magazine includes an insert of a smaller pull-out magazine called "Noodle," which, according to Mr. Sullivan (dep., p. 23) has "adventure activities, mystery... puzzles." Frequently, the cover of "Nick, Jr." magazine features some reference to BLUE'S CLUES because BLUE'S CLUES is the number one property that is part of the Nick, Jr. brand. (Sullivan dep., 14.) Sometimes the cover of the pull-out insert magazine, "Noodle," features BLUE'S CLUES.

In addition, opposer has published two issues of a "Blue's Clues Magazine," and a third issue is planned. This magazine is targeted to the parents of preschoolers. (Sullivan dep., p. 11.) The first issue (1998) was sold to a sponsor, Campbell's Soup Company, and distributed through day care centers as part of a promotion with Campbell's whereby people bought a certain amount of soup, responded to an offer, and then received a copy of

Opposition Nos. 113801 and 114029

the "Blue's Clues Magazine." Opposer printed approximately 500,000 copies, with 200,000 distributed by opposer directly to day care centers, and the remainder were sent to Campbell's. The second "Blue's Clues Magazine" (1999) was sponsored by Sears, with the same distribution numbers. Neither Campbell's nor Sears reported to opposer how many copies they actually distributed to the public. There are plans for a third issue on safety which will be sponsored and distributed by Ford Motor Company.

Standing

Opposer's standing is established by the status and title copies of its pleaded registrations; and moreover, applicant did not contest opposer's standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 1307, 55 USPQ2d 1842 (Fed. Cir. 2000).

Priority

In view of opposer's ownership of valid and subsisting registrations for the mark BLUE'S CLUES, the issue of priority does not arise in these opposition proceedings. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 275 n. 6 (CCPA

Opposition Nos. 113801 and 114029

1972). Moreover, the record shows that opposer used its mark BLUE'S CLUES for the goods and services recited in its registrations prior to both the filing date of applicant's intent-to-use application for entertainment services (May 1, 1998) and applicant's first use of her mark BLUE for magazines in 1997. Applicant did not contest opposer's priority.

Likelihood of Confusion

Our determination of this issue is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below. See *Cunningham v. Laser Golf Corp.*, *supra*, at 1844-1845.

The first du Pont factor we consider is the similarity or dissimilarity of the marks in their entities as to appearance, sound, connotation and commercial impression. Here applicant's mark is the word BLUE alone, and opposer's mark is BLUE'S CLUES. Clearly, the term "BLUE'S" in opposer's mark is in the possessive form indicating that there is some person or thing named

Opposition Nos. 113801 and 114029

"Blue" (in this case an animated puppy.) Opposer's mark consists of rhyming words, and obviously applicant's does not as it is a single term. The fact that two marks share some common letters or even a common word (in this case "blue") does not necessarily mean that the marks as a whole project the same image or impression. See *Olay Company, Inc. v. Avon Products, Inc.*, 178 USPQ 502 (TTAB 1973).

Besides the obvious differences in sound and appearance, there are also differences in connotation and commercial impression. Opposer's mark BLUE'S CLUES connotes that there is a person or thing named "Blue" and that it has some "clues." It connotes a mystery through some entity named "Blue," and that this entity has "clues" or will provide some of her "clues." Applicant's mark, consisting solely of the word BLUE, conveys the well-known and commonly understood meaning of the word "blue," relating to the color blue.¹²

Opposer's argument that "Opposer's BLUE'S CLUES mark and Applicant's proposed BLUE mark are virtually

¹² Of course, the word "blue" has several other English meanings including depressed, aristocratic or indecent. We take judicial notice of The American Heritage Dictionary (1976), in which some of the definitions of "blue" include "1. of the color blue... 5.a. gloomy, depressed... 8. aristocratic... 9. indecent, risqué...." However, the first listed definition relates to the color blue.

Opposition Nos. 113801 and 114029

identical" (brief, p. 17) is simply not accurate. We also disagree with opposer's contention that the word "Blue" as part of the first word "BLUE'S" in opposer's mark "BLUE'S CLUES" is the "dominant feature" of opposer's mark. (Brief, p. 18.) The nature of opposer's mark is such that we find neither "BLUE'S" nor "CLUES" is a dominant feature; rather, the mark is best understood with the words together.

We find that applicant's mark BLUE is dissimilar in sound, appearance, meaning and commercial impression from opposer's mark BLUE'S CLUES. In this consolidated case, the dissimilarities between the marks, especially when considered on balance with the other du Pont factors discussed infra, are significant. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998).

The second du Pont factor for our consideration is the similarity or dissimilarity and nature of the goods or services as described in an application or registration. Applicant has applied to register her mark for "publications, namely, magazines and newsletters in the fields of adventure, travel, sports and contemporary lifestyles," and "entertainment services in the nature of a series of television shows featuring sporting events,

Opposition Nos. 113801 and 114029

travel and adventure, and a series of educational programs featuring outdoor activities for broadcast and cable television; organizing and conducting sporting events."

Opposer owns registrations for "note paper and loose leaf paper, informational magazines and books on the topics of television and entertainment, decals," and "entertainment in the nature of an on-going television series in the field of preschool animated/live action programs."

There is no question that opposer's television series is limited to a "preschool animated/live action" program, and applicant's proposed television series are both limited by the identification as one "featuring sporting events, travel and adventure" and another series on "educational programs featuring outdoor activities." An animated television show for children under five years of age is clearly limited to that specific type of television show. It cannot and does not encompass all types of television series programs. A reasonable reading of the parties' respective identifications of entertainment services shows that by their plain meaning these identified services do not overlap. Opposer's witness, Ms. Burgess, did testify that in one BLUE'S

Opposition Nos. 113801 and 114029

CLUES episode the puppy "Blue" played in a baseball game, and that the puppy has traveled "to the jungle," "the farm," "the supermarket," and the like. (First Burgess dep., pp. 38-42.) However, she also testified that she did not think there were any other instances of sporting events, and that the "travel" is to places real and imaginary appropriate for young children. While opposer's animated/live action show for preschool age children involves such travel and sports as discussed above, we do not agree with opposer that its identified television series is encompassed within applicant's identified services. Even applicant's "educational programs featuring outdoor activities" must be read in the context of the entire identification of services; and when so read, it does not encompass opposer's preschool animated/live action show.

Likewise, with the parties' respective publications, opposer's "informational magazines and books" are specifically limited to the "topics of television and entertainment," and applicant's "magazines and newsletters" are specifically limited to "the fields of adventure, travel, sports and contemporary lifestyles." While both parties offer magazines, the subjects of the parties' respective magazines are clearly separate and

Opposition Nos. 113801 and 114029

distinct as identified in the application and registration. That is, these descriptions of goods are specific and do not overlap.

Opposer's position again is that applicant's identification of goods encompasses the subject matter of opposer's identification of goods. This is not supported by the record. Opposer's witness, Mr. Sullivan, testified that opposer's "Nick, Jr." and "Noodle" magazines include stories on sports, travel and adventure, but he acknowledged that the stories involved travel to a make believe beach, or "Car Cards" which are removable and are intended to provide activities for children while traveling. Opposer's testimony from Mr. Sullivan regarding the two issues of "Blue's Clues Magazine" which have been published clearly relate specifically to opposer's BLUE'S CLUES show for preschool children. Again limiting our consideration of the goods, as we must, to the identifications thereof in the involved applications and registrations, we find that the parties' respective publications, as identified, are not overlapping. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Applicant's identifications of goods

Opposition Nos. 113801 and 114029

cannot reasonably be read to include magazines for or topics related to preschool children.

We acknowledge that the relatedness of the parties' publications (as identified) is not as clearly distinct from one another as the entertainment services (as identified, and where opposer produces an animated/live action show for preschool children), but nonetheless, we find the topics of the respective publications are sufficiently specified (topics of television and entertainment in opposer's identification, and adventure, travel and contemporary lifestyles in applicant's identification) to indicate that the goods do not overlap. Adventure and travel is not all encompassing and would not include the topics of television and entertainment. The fact that there may be television shows on virtually any topic does not make a magazine on "television and entertainment" one which covers all possible topics of television shows. The terms "television and entertainment" in that context relate to the entertainment industry generally. Moreover, the words "adventure," "travel" and "sports" in the context of a magazine and television show for preschool age children is not the same as "adventure," "travel" and "sports" in the context of a contemporary lifestyle

Opposition Nos. 113801 and 114029

magazine and television show. Consumers may seek and purchase an entertainment magazine and an adventure magazine, and would be well aware of the differences between same.

Although the parties offer (or intend to offer) similar goods and services in that both involve magazines and television shows generally, the identifications of both parties' goods and services are limited such that the dissimilarities and the nature of the respective goods and services is evident there from. (Compare, for example, two parties who both offer "computer programs" generally, but, both identifications are clearly limited to specify the nature and purpose of each party's computer program.)

These respective television shows and publications, as identified, indicate that the parties are moving in different directions on differing topics. That is, from the identifications of goods and services, it is clear that the parties' television shows and magazines involve material of completely different natures. Opposer's reading of the involved identifications of goods and

Opposition Nos. 113801 and 114029

services is an unreasonable reading of the plain meaning of these identifications.¹³

We turn to a consideration of the parties' respective trade channels and the conditions of sale. Opposer's television show airs on cable and on a commercial network, and it is restricted as identified as being directed to preschool children. Opposer has established that while the majority of viewers are preschool children, the parents or caregivers of those children may watch the show as well. Applicant has not yet commenced use of her mark for a television show (or for any of her specified entertainment services, including "organizing and conducting sporting events").

Opposer's "Blue's Clues Magazine" was published twice and distributed in part by opposer (about 200,000 copies directly to daycare centers), and 300,000 copies were sent to Campbell's or Sears as sponsors of the first and second issues, respectively. Opposer received no reports from either sponsor as to how many copies were actually distributed to children and their parents or

¹³ Opposer's argument concerning "spin-off" television shows increasing the likelihood of confusion is misplaced in this consolidated case.

Opposer's contention that it is entitled to a natural scope of expansion is not established in the record of this case, keeping in mind that opposer's only pleaded and proven mark is BLUE'S

Opposition Nos. 113801 and 114029

caregivers by the respective sponsor of that issue (Campbell's or Sears). Its other publications, "Nick, Jr." magazine with the "Noodle" magazine insert, is distributed mainly through preschool and daycare centers, with some sales through subscription, and a few sold on newsstands. (In 2000, of the 500,000 magazines distributed, 300,000 were through preschool and daycare centers, 175,000 were by subscription, and 25,000 were on newsstands in supermarkets, mass retailers, and bookstores.) Applicant's magazine is distributed 80% by subscription, 11% through bookstores (such as Barnes & Noble, and B. Dalton) and specialty retail stores (such as those focused on outdoor recreation and adventure travel products), and 9% through national newsstands.

Aside from the "preschool" limitation in opposer's identification of services, the parties' identifications of goods and services are not otherwise limited specifically to state that the goods or services are or would be offered only to a certain class of purchasers or through specific channels of trade. Thus, the parties' magazines could be sold through the same channels of trade. Likewise, the television shows of the respective parties would be offered on cable and broadcast channels.

CLUES. See Electronic Data Systems Corp. v. EDSA Micro Corp.,

Opposition Nos. 113801 and 114029

While these involved goods and services are certainly not expensive, we point out that opposer's television shows are specifically limited to preschool animated/live action programs, and we are of the opinion that parents are likely to exercise care in selecting magazines and television shows for their young children. That is, parents will not approach the selection of television shows and magazines for their children lightly, especially as to preschool children. Thus, these are not impulse purchases. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

Turning to the du Pont factor of the fame of the prior mark, we find that the testimony and evidence establishes that opposer's mark, BLUE'S CLUES, is famous. Opposer's television show for preschoolers has aired weekly since September 1996, and has millions of viewers--preschool age children as well as their parents or caregivers. While opposer has published only two issues of "Blue's Clues Magazine," opposer frequently features BLUE'S CLUES on and in its other publications, which it has distributed and sold by the millions. For the year 2000 opposer had retail sales of licensed BLUE'S CLUES

232 USPQ2d 1460, 1463-1464 (TTAB 1992).

Opposition Nos. 113801 and 114029

merchandise over \$1 billion. Opposer has received extensive publicity for its television show since 1996. All of the above supports our finding that opposer's mark BLUE'S CLUES is famous. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). This factor entitles opposer to a broad scope of protection. However, a finding of fame is not the end of the analysis. Rather, we consider fame as a dominant factor, but we must balance all of the relevant du Pont factors, giving each its appropriate weight. See *Cunningham v. Laser Golf*, supra.

Another relevant du Pont factor for consideration in this consolidated case is the number and nature of similar marks in use on similar goods and/or services. Applicant submitted the testimony of three witnesses regarding third-party uses of marks including the term BLUE, and a notice of reliance on over twenty third-party registrations, all of which include the term BLUE.

With regard to the third-party registrations, such registrations are not evidence of use in the marketplace or that the public is familiar with them, and we have not considered them with regard to the strength of opposer's mark. However, third-party registrations may nonetheless be relevant in evaluating the issue of likelihood of

Opposition Nos. 113801 and 114029

confusion. As the Court of Appeals for the Federal Circuit stated in the case of *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992):

Under *Du Pont*, "[t]he number and nature of similar marks in use on similar goods" is a factor that must be considered in determining likelihood of confusion. 476 F.2d at 1361, 177 USPQ at 567 (factor 6). Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them. ...") (Italics emphasis in original.)

The third-party registrations of record herein, while given "little weight" are nevertheless "relevant when evaluating likelihood of confusion." Some examples of the third-party registrations (all owned by different entities) include THE BLUE SKY PRESS (Registration No. 1,841,335 for "series of children's books"); BLUE BUG (Registration No. 1,648,115 for "series of children's books"); BLUE RIBBON (Registration No. 1,380,407 for

Opposition Nos. 113801 and 114029

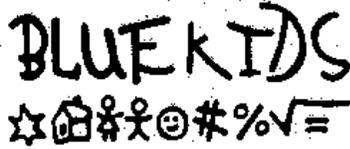
"series of educationally oriented books for promotion of reading skills"); BLUE MOON (Registration No. 1,517,179 for "fiction books"); BLUE SHIELD (Registration No. 1,510,107 for, inter alia, "educational books"); BLUE PLANET (Registration No. 1,774,972 for, inter alia, "motion picture film featuring environmental and ecological topics" and "printed publications and books pertaining to picture books concerning the earth and the environment"); BLUE ANGEL PRODUCTIONS (Registration No. 1,634,432 for "entertainment services, namely production of musical shows"); BLUE ZOO MUSIC (Registration No. 2,006,651 for "prerecorded audio cassettes, compact discs, and video cassettes featuring musical performances"); the mark shown below



(Registration Nos. 1,325,694 and 1,328,722 for a variety of stationery items and publications (including "comic books") and a variety of toys and games); BLUE BIRD (Registration No. 2,300,718 for various items of children's clothing); BLUE NEWS (Registration No. 1,866,454 for various items of children's clothing); and

Opposition Nos. 113801 and 114029

the mark shown below



(Registration No. 1,772,432 for a variety of children's clothing).

In addition to the evidence of third-party registrations, applicant submitted the testimony of Earl Humphrey, a principal of Berkeley Hill Media LLC, which owns currently valid and subsisting Registration No. 2,139,325 for the mark shown below



for various goods and services including posters, newsletters on games and video productions, and television and radio programming. Berkeley Hill Media, LLC has used its BLUE BEETLE and design mark continuously since 1994, especially for the production of three videos titled "Let's Go Fly a Helicopter," "Let's Go See The Big Work Trucks," and "Let's Go See The Big Ships"; and its intended primary audience is children between the ages of two and ten. Its videos are not television programs but

Opposition Nos. 113801 and 114029

they have appeared on television on the PBS stations. The purchasers of these videos are parents, family members and the children themselves. The record shows that Berkeley Hill Media LLC's sales have not been large in either volume or dollars.

Another third-party witness is Sharon Markowitz, senior vice president of licensing at Saban Entertainment (Saban), consumer products division. Saban owns the currently valid and subsisting Registration No. 2,117,153 for the mark BLUE RANGER for "toy action figures, miniature play figures, plush toys and video game cassettes," and the mark has been continuously used on those products since 1993. BLUE RANGER is one of Saban's POWER RANGERS characters, the others currently being RED RANGER, GREEN RANGER, PINK RANGER and YELLOW RANGER. Saban uses the mark BLUE RANGER in connection with numerous other goods and services, other than the registered goods, specifically including a television series, a movie, live shows, magazines, clothing, and home furnishings. The target audience is boys from ages 6-11 for the show, and a younger audience (from age 2 up) for the merchandise such as the action figures. BLUE RANGER products are sold both as a part of the POWER RANGERS group and independently. POWER RANGERS is

Opposition Nos. 113801 and 114029

Saban's most successful franchise; and Saban engages in cross promotional deals with fast food chains such as McDonald's and promotions to highlight the POWER RANGERS including BLUE RANGER with stores such as Toys R Us. There have been nine iterations of the POWER RANGERS shows since their inception in 1993, and the BLUE RANGER has been included in all nine. The POWER RANGERS television series including the BLUE RANGER, has been on television since 1993; and the record is clear that it has achieved significant success.

Ian Ibarra, a paralegal at applicant's attorneys' law firm, conducted searches on the IMDb Internet Movie Database for movies, TV movies or TV series including the term "blue" or "blues," and he testified regarding the results of his searches. While there was much matter contained therein not relevant to this consolidated case, there were references to shows such as NYPD BLUE, BLUE VELVET, and THE BLUE ANGELS.

Applicant's evidence of third-party uses establishes that the word BLUE is hardly a unique term for goods and services that are the same or related to opposer's. Therefore, it becomes reasonable to infer that purchasers have become conditioned to expect different sources even when the goods and services are sufficiently related to

Opposition Nos. 113801 and 114029

be attributable to one source. See National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). As stated above, the basis for such an inference has been established in this consolidated case. The purchasing public will not assume that all television shows including the word "BLUE" in the title (or in opposer's show the word "BLUE'S") are part of the BLUE'S CLUES television series owned by opposer. That is, there is evidence of significant use of marks which include the term "BLUE" (one of which is well known in its own right BLUE RANGER of the POWER RANGERS) in television and movies, and to a lesser degree but nonetheless still a sufficient degree with regard to publications.

The Board has in the past given weight to credible and probative evidence of significant and unrestrained use by third parties of marks containing elements in common with the mark which is the subject of the opposition on grounds of likelihood of confusion to demonstrate that confusion is not, in fact, likely. See Hilson Research Inc. v. Society For Human Resource Management, 27 USPQ2d 1423, 1431 (TTAB 1993), citing Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445, 1462 (TTAB 1986, amended 1987). In

Opposition Nos. 113801 and 114029

the consolidated case now before us, applicant's evidence of third-party uses of marks including the term "BLUE" for relevant goods and services is substantial, and opposer has not countered that it has challenged (successfully or unsuccessfully) many of the registered and used third-party marks.

We turn next to the du Pont factors relating to actual confusion. The issue of actual confusion is not relevant with regard to applicant's application for her identified entertainment services because that application is based on her asserted intention to use the mark, and the record shows that applicant has not yet commenced use of the mark BLUE in connection with her identified entertainment services.

With regard to applicant's publication "in the fields of adventure, travel, sports and contemporary lifestyles," there has been a relatively short period of simultaneous use of the mark BLUE on her publication (first issue published in 1997) and BLUE'S CLUES used in connection with opposer's television series "in the field of preschool animated/live action programs" (first aired in 1996) and used on opposer's magazines and books "on the topics of television and entertainment" (first issue published in 1998). However, we note that in the

Opposition Nos. 113801 and 114029

relatively short time of simultaneous use of the parties' respective marks, opposer's mark BLUE'S CLUES has received extensive exposure for its television show, and has achieved some success with its "Nick, Jr." and "Noodle" magazines, plus large distribution to daycare centers of its two sponsored issues of "Blue's Clue Magazine"; and applicant's magazine sold under the mark BLUE, has had a circulation in the six figure numbers; all of this without any instances of actual confusion.

Finally, we consider the du Pont factor on the extent of potential confusion, i.e., whether *de minimis* or substantial. The record before us shows that there is at most a *de minimis* chance that consumers would confuse the source of opposer's services and goods and applicant's goods.¹⁴

As applicant points out, there must be shown more than a mere possibility of confusion; instead, there must be demonstrated a probability or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ

Opposition Nos. 113801 and 114029

43 (CCPA 1969) as follows: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. In this consolidated case, it is our belief that the possibility or likelihood of confusion is remote.

Upon balancing all of the relevant du Pont factors in this consolidated case, and giving each relevant factor the appropriate weight (including giving significant weight to the fame of opposer's mark BLUE'S CLUES), we firmly believe that confusion is unlikely in each of these consolidated opposition proceedings. See *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992), *aff'd*, *unpub'd*, but appearing at 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993).

¹⁴ This factor is neutral with respect to applicant's services because applicant has not commenced use of her mark in connection with her identified entertainment services.

Decision: The oppositions are dismissed.¹⁵

¹⁵ We have found in favor of applicant, but we will address one matter which applicant raised for the first time in her brief on the case. Specifically, if the Board had found a likelihood of confusion, then applicant "invited" the Board to exercise its discretion under Section 18 of the Trademark Act and restrict applicant's identifications of goods and/or services "to conform to commercial realities." (Brief, p. 22.) If applicant sought amendments to the identifications of goods or services in her own involved applications, she should have filed timely and proper proposed amendments thereto. See TBMP §514. Applicant did not seek to amend the identification of goods or services in her involved applications during these opposition proceedings. If, on the other hand, applicant sought a restriction to the identifications of goods or services in opposer's registrations pursuant to Section 18 of the Trademark Act, she would have had to file a counterclaim for partial cancellation. See TBMP §§311 and 319. Applicant did not seek to counterclaim with regard to opposer's registrations (and she does not appear to be asking that opposer's identifications be restricted--only that her own be restricted, if necessary). Applicant's request need not be reached because we have found in her favor on the issue of likelihood of confusion. But, applicant is specifically advised that this request was inappropriate and incorrect under the law.