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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Danjaq, LLC

v.

Jason & Jean Products Inc.

Opposition No. 120,980
against Application Serial No. 75/725,874,
filed June 11, 1999;
and Cancellation No. 31,532
against Registration No. 2,374,963,
issued August 8, 2000

Christopher N. Bolinger of Brinks Hofer Gilson & Lione for Danjaq, LLC.

Chin H. Kim *pro se* for Jason & Jean Products Inc.

Before Simms, Hohein and Holtzman, Administrative Trademark Judges:

Opinion by Simms:

Danjaq, LLC (opposer), a Delaware limited liability company, has opposed the application of Jason & Jean Products Inc. (applicant), a New York corporation, to

register the mark 007 HAIR WEAVING BOND ("HAIR WEAVING BOND" disclaimed) for adhesives for attaching artificial hair pieces.[1] Opposer also filed a petition to cancel applicant's Registration No. 2,374,963, issued August 8, 2000, covering the mark 007 WEAVING BOND ("WEAVING BOND" disclaimed) for the same goods. On August 3, 2001, these proceedings were consolidated. We shall refer to the parties as "opposer" and "applicant," respectively.

Opposer has filed a motion for summary judgment, arguing that there are no genuine issues of material fact and that opposer is entitled to judgment on the issue of likelihood of confusion. Applicant has opposed the motion and also moved for summary judgment. Before discussing the motions, we shall briefly discuss the pleadings.

In the pleadings in both cases, opposer has alleged that applicant's marks so resemble opposer's previously used and registered marks (shown below):

[1] Application Serial No. 75/725,874, filed June 11, 1999, based upon applicant's allegations of use since March 6, 1998.

JAMES BOND 007

for a broad range of goods and services including cosmetics and colognes, as to be likely to cause confusion, to cause mistake or to deceive.[2] Opposer asserts that it and its predecessors have used these marks since 1962; that these marks have been extensively used and promoted and have become famous throughout the world; and that applicant, by adopting a slanted appearance of the number 007 in the mark 007 HAIR WEAVING BOND, has the clear intent of trading off the goodwill of opposer's marks. Opposer also pleaded that applicant's marks dilute the distinctive quality of opposer's famous marks under Section 43(c) of the Act, but this ground is not the subject of opposer's motion for summary judgment. With its pleadings, opposer has submitted status and title copies of its pleaded registrations.

In its answers, applicant has, among other things, denied the allegations of opposer's pleadings. Applicant

[2] Registration No. 1,739,332, issued December 15, 1992, partial Sections 8 and 15 affidavit accepted and acknowledged, respectively; and Registration No. 1,737,876, issued December 8, 1992, partial Sections 8 and 15 affidavit accepted and acknowledged, respectively. Each of these registrations originally issued for goods in 8 classes.

has also listed various third-party registrations containing words unrelated to the marks in these proceedings, such AMERICAN, BEAUTY, NEW YORK, HOLIDAY, CRAZY, WORLD and KING, apparently to show the existence on the register of a number of marks all containing similar terms.

While applicant seeks to register the mark shown in one line-—007 HAIR WEAVING BOND-—the mark as actually used appears as follows:

In its motion, opposer argues that confusion is likely because of the similarities of the parties' marks, the strength and fame of its 007 marks, the similarity of parties' goods, the variety of goods on which opposer uses its marks, and the bad faith of applicant evidenced by applicant's actual knowledge of opposer's marks as well as the prominent appearance in slanted format of the number

007 in at least one of its marks.[3] It is opposer's position that the use of opposer's marks on a wide variety of collateral products has conditioned the public to expect a variety of seemingly unrelated products to come from the same source.

With its motion opposer submitted a declaration of its Chief Operating Officer, David S. Pope, stating that 19 films in the Bond/007 series have been produced since 1962 and that this series of films is one of the most successful motion picture franchises in history. Mr. Pope further states that since 1962 opposer and its predecessors have used the 007 and JAMES BOND marks on a wide variety of goods as part of an extensive licensing and merchandising program associated with the marketing and distribution of the Bond/007 series of films. Mr. Pope indicates that the marks have been licensed and used in connection with such goods as clothing, video games, posters, computer software, cigarette lighters, coffee mugs, calendars, wristwatches, colognes, perfumes, shampoo, soap, razors, jewelry, stationary, sunglasses and other products. According to Mr. Pope, since 1962 opposer, its predecessors, licensees and distributors have achieved sales in the United States

[3] In one of applicant's discovery responses (No. 24), submitted by opposer as an exhibit to its motion, applicant's president admits knowledge of the Bond series of motion pictures but states that the "motion picture was not the reason for creating the trademark."

of goods and services under the marks of over $900 million while spending over $200 million in advertising and promotion. Mr. Pope states that consumers readily recognize the 007 marks and identify them with goods and services related to the Bond/007 films. Opposer has submitted photographs of its marks on such goods as shampoo (BOND 007 and design), cologne (JAMES BOND 007 and design), bath soap (BOND 007 and design) and after shave (007).

In opposition to opposer's motion and in support of its own motion, applicant argues that the marks are entirely different in "text and sound" and that they do not so resemble each other as to be likely to cause confusion.[4] Applicant has also referred to and attached several third-party registrations which include the letters 007 for such goods as laboratory equipment (007), electric fans (MODEL 007) and computer software (ID-007), apparently to show "weakness" of opposer's marks. Applicant has also referred to and attached electronic copies of unrelated third-party registrations all containing various words such as ELIZABETH, PERFUME, AMERICA, NEW YORK, BEAUTY, and HOLLYWOOD, apparently in an attempt to show that various

[4] Opposer has moved to strike applicant's brief on the basis that it was not filed within 20 days of service of opposer's motion. The motion is denied. Trademark Rule 2.127(e)(1) provides for a 30-day period for response to a motion for summary judgment. Applicant's response was timely filed.

marks containing the same word co-exist on the register for related goods.

Summary judgment is an appropriate method for disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if a reasonable finder of fact could resolve the matter on the evidence of record in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). However, the evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant’s favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

After careful consideration of this record on summary judgment and the arguments of the parties, we agree with

opposer that there are no genuine issues of material fact and that judgment should be entered in opposer's favor.

First, priority is not an issue in this case in view of opposer's submission of status and title copies of its pleaded registrations. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In the opposition, these registrations eliminate the issue of priority, and in the cancellation proceeding, the registrations' filing dates long precede the filing date of the registration sought to be cancelled. In this regard, we have held that, in the absence of testimony or other evidence relating to the dates of first use of the respective marks of the parties,[5] priority lies with the petitioner where the record reveals that the registration of its pleaded mark shows not only that the registration is subsisting and owned by the petitioner, but also that the filing date of the application which matured into such registration is earlier than the filing date of the application which resulted in the respondent's involved registration for its mark. See, e.g., *Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423,

[5] We note that opposer's declaration does not indicate when opposer started using its marks in connection with cosmetics such as hair lotions and shampoos or, for that matter, any of the collateral goods listed in the registrations.

1428-29 (TTAB 1993) at n. 13; and *American Standard Inc. v. AQM Corp.,* 208 USPQ 840, 841-42 (TTAB 1980).

With respect to the marks, applicant's marks 007 WEAVING BOND and 007 HAIR WEAVING BOND share obvious similarities in sound, appearance and connotation with opposer's marks. In this regard, while it is well settled that it is improper to dissect a mark (*In re Shell Oil Co.,* 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993)), it is also true that more or less weight may be given to a particular feature of a mark for rational reasons. *In re National Data Corporation,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties.") Here, all wording has been disclaimed in applicant's marks and these descriptive or generic words describe or name applicant's product rather than indicate source. Less weight to those words may be given in the likelihood-of-confusion analysis. Applicant's marks and opposer's marks, especially the 007 and design mark, share the dominant portion 007. Since applicant's marks are in typed form, we must consider all reasonable manners in which applicant could depict the 007 portion of

its marks, including the slanted format used by opposer. Applicant could, and in fact does, display its marks (at least the mark 007 HAIR WEAVING BOND) in this format, thereby further increasing the marks' similarity. In addition, as opposer has pointed out, applicant's marks also contain the word "BOND," which, although descriptive or generic in the context in which applicant uses this word, is nevertheless a play on the name BOND in opposer's mark and tends to bolster an association with opposer. There is no genuine issue that the respective marks are similar.

Concerning the goods, applicant's hair-piece adhesives, while specifically different from opposer's products, are related to such products as hair lotions and shampoos listed in opposer's registration of the 007 and design mark.[6] These products are all used for the care of or appearance of the hair and are sufficiently related such that they would likely be attributed to the same source if they bear very similar marks. Also, opposer's cologne and toilet water, listed in opposer's registration for the mark

[6] The Class 3 goods in opposer's 007 and design registration include such goods as "toilet, body, and facial soaps; perfumes, colognes, toilet water, gel and foam shaving creams, shaving lotions and creams, body and face powders, cosmetics; namely, lip creams, lipsticks, eye shadow, mascara; nail polish, nail polish remover, body, face, hair lotions, creams, and oils; sun creams and lotions, hair shampoo, personal deodorants, bath oils, dentifrices." In the JAMES BOND 007 and design registration, all Class 3 goods but colognes and toilet water have been deleted.

JAMES BOND 007 and design, are cosmetic products related to applicant's hair-piece adhesives. In this regard, we note that applicant indicates in its response (No. 2) to opposer's interrogatories, submitted as an exhibit by opposer, that applicant also makes and distributes "hair care products, fragrances, lip balms and hair sundries." These products, apparently offered under different marks, are very similar to those on which opposer uses and has registered its marks. This fact helps demonstrate that fragrances, such as colognes and toilet water, as well as hair-piece adhesives may, and in fact do, come from the same source. Moreover, we note that applicant has offered no evidence or argument on this factor. Applicant has, therefore, not raised a genuine issue of fact concerning the relatedness of the goods.

We also agree with opposer that its 007 marks have achieved substantial recognition and fame. Applicant has not submitted any evidence showing that there is a genuine issue concerning the fame of opposer's marks.[7] As opposer has argued, "fame of the prior mark… plays a dominant role

[7] The copies of the third-party registrations do not create a factual dispute. The registrations which contain the number 007 are for completely unrelated goods, such as electric fans and laboratory equipment, and do not show that there is no likelihood of confusion involving opposer's cosmetic products and applicant's adhesives for hair pieces. The third-party registrations for completely different marks, such as ELIZABETH, AMERICA, and HOLLYWOOD, are also irrelevant.

in cases featuring a famous or strong mark." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Applicant had a duty to avoid using confusingly similar marks.

Furthermore, the fact that opposer also sells a wide variety of goods under its marks encourages potential purchasers to believe that applicant's goods may also come from, or be licensed or sponsored by, opposer.

Finally, the fact that opposer's hair care products and applicant's hair-piece adhesives are relatively inexpensive items that would not likely be purchased with a great deal of care is another factor in opposer's favor.

Since other factors, including the fame of opposer's marks, clearly support a finding of likelihood of confusion, even if there is a genuine issue as to applicant's bad faith, such is simply not material because, if resolved in applicant's favor, there still exists a likelihood of confusion when applicant's marks are used in connection with its hair-piece adhesives.

Because applicant's response has presented no evidence creating a factual dispute but only conclusory assertions of no likelihood of confusion, summary judgment in favor of

opposer is warranted. Applicant's motion for summary judgment is denied; opposer's motion for summary judgment is granted; the opposition is sustained and registration to applicant is refused; the petition for cancellation is granted; and Registration No. 2,374,963 will be cancelled in due course.