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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re KidVid, Inc.

Serial No. 75/710,402

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110 (Chris A.F. Pedersen, Managing Attorney).

Before Chapman, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 16, 1999, KidVid, Inc. (applicant) filed an application to register the mark "... A LITTLE GENIUS IN THE MAKING" (in typed form) for goods ultimately identified as a "series of audio and video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes

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depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children" in International Class 9.¹

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark "LITTLE GENIUS" (in typed form) for:

Musical sound recordings and musical video recordings in International Class 9

Children's books, baby books, children's activity books, calendars, sheet music, song books, picture books, decals, bumper stickers, paper cake decorations, greeting cards, flash cards, playing cards, trading cards, disposable diapers, children's encyclopedias, printed teaching materials for teaching youth development skills, life skills, and problem solving, stickers, temporary tattoos, and wrapping paper in International Class 16.²

When the refusal was made final³, applicant filed this appeal.

The examining attorney argues that the marks "... A LITTLE GENIUS IN THE MAKING" and "LITTLE GENIUS" are highly similar and that the letter "a" "has little or no trademark

¹ Serial No. 75/710,402. The application contains an allegation of a bona fide intention to use the mark in commerce.

² Registration No. 2,372,130, issued August 1, 2000.

³ The examining attorney also cited a second registration of the same owner for the same mark for goods in International Classes 25 and 28 (Registration No. 2,344,760). The examining attorney subsequently withdrew the citation of this registration.

significance. The terms 'IN THE MAKING' comprise subordinate matter since the dominant portion[s] of the marks are the terms LITTLE GENIUS." Brief at 6. The examining attorney also found that both applicant's and registrant's goods include musical sound recordings, and that while applicant has limited its musical sound recordings to those for developing children's intellect, "registrant's musical recordings could also be for improving intellectual development." Brief at 7-8. The examining attorney determined that because "these items are identical, the goods are likely to be sold in the same stores and move in the same channels of trade." Brief at 8. Therefore, the examining attorney held that there is a likelihood of confusion.

Applicant's position is that the "addition of the words 'in the making' to the LITTLE GENIUS mark renders its mark distinguishable from registrant's mark because the LITTLE GENIUS mark is highly suggestive of educational products for children." Brief at 3. In addition, applicant argues that the Office has often "approved identical and nearly identical marks for registration, even where the categories of goods and services are arguably related." Brief at 5. Another point applicant makes is that its mark is a "slogan to further identify the product

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of applicant, already registered as BRAINY BABY." Brief at 6.

We affirm.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The first factor we consider is a comparison of applicant's mark with the mark in the registration cited by the examining attorney as the basis of the refusal to register. In this case, applicant's mark is the slogan "... A LITTLE GENIUS IN THE MAKING," while registrant's mark consists of the words "LITTLE GENIUS." Obviously, both marks contain the same words "Little Genius." In addition, applicant has taken the entire registered mark and added other matter to it. The question becomes whether this additional matter changes the commercial impression. Applicant adds an ellipse and the indefinite article before the words and the phrase "in the making" after the shared words. The addition of the ellipse and the indefinite article does not significantly change the pronunciation,

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appearance, meaning, or commercial impression of the mark. The Court of Customs and Patent Appeals held that the addition of a hyphen and another digit did not eliminate the similarity of marks. See Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("The addition of the extra 6 and the hyphen has already been held not to avoid likelihood of confusion, and in the absence of some other apparent significance for the term 6-66 we find this conclusion inescapable"). Similarly, the addition of the phrase "in the making" adds little to distinguish the marks because the phrase refers back and emphasizes the "little genius" portion of the mark. Therefore, the words "Little Genius" would dominate applicant's mark and, of course, it is the entire registered mark. These marks have obvious similarities in appearance, sound, meaning, and commercial impression. When the marks are viewed in their entireties, we find that they are very similar. In re Dixie Restaurants, 105 F.3d 1405, 1407, 41 USPQ 1357, 1534 (Fed. Cir. 1993) (THE DELTA CAFE and design held confusingly similar to the word DELTA; more weight given to common dominant word DELTA).

Regarding the goods, we find that they are at least in part overlapping. Applicant's goods include "prerecorded videotapes, compact discs, and audio cassettes

containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children." Registrant's goods include "musical sound recordings and musical video recordings." Both applicant's and registrant's goods include musical video and audio recordings. While applicant's identification of goods recites that its goods are used for the development of infants and children, there is nothing that would preclude registrant's recordings from also being used for the same purpose. Thus, there is no legal difference between the goods on this point. We must consider the goods as they are described in the identification of goods in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). We also do not

read limitations into the identification of goods.

Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). When we view the goods as they are described in the application and registration, they are in part virtually identical, i.e., musical sound and video recordings.

Inasmuch as applicant's and registrant's goods include musical video and sound recordings that could be marketed to parents to encourage child development, the channels of trade and potential purchasers would also be very similar, if not identical.

Because the marks are used, at least in part, on highly similar if not identical goods, there is a greater likelihood that when similar marks are used in this situation, confusion will be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines"). In this case, we conclude that when

prospective customers familiar with registrant's "LITTLE GENIUS" musical sound and video recordings encounter applicant's "... A LITTLE GENIUS IN THE MAKING" prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children, they are likely to believe that, at a minimum, there is some association between the sources of these goods.

In response to applicant's other arguments, we note that inasmuch as the examining attorney did not need to show that registrant's mark was famous, the lack of evidence of fame is not significant. Majestic Distilling, 65 USPQ2d at 1205 (citation omitted) ("Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous"). Similarly, the fact that applicant may be using the mark "... A LITTLE GENIUS IN THE MAKING" as a slogan with its mark "BRAINY BABY" does not mean that there is no likelihood of confusion. Applicant has not sought registration of the

combined marks, but instead it seeks registration of the slogan alone. As such, applicant is not restricted from using the slogan alone or in combination with other marks. "Ordinarily, for a word mark, we do not look to the trade dress, which can be changed at any time." Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Accord Squirtco, 216 USPQ at 939 (By seeking registration for a mark in a typed drawing, a difference in type style with the registrant's mark "cannot legally be asserted by that party" since the style of the typed mark can be changed at any time).

Applicant also included two third-party registrations for the marks LIL GENIUS and design for electronic calculators and SAPIENTINO ("Little Genius" in Italian) for educational games along with other registrations combining the word "Genius" with different words and designs for a variety of goods and services. The registration of similar marks for different goods and the fact that one word in the mark is the subject of other registrations are hardly significant. These registrations do not show that applicant's mark should be registered when the goods are virtually the same and the marks are very similar. While third-party registrations may be used to demonstrate that a

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portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar registration. In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988).⁴

Decision: The Examining Attorney's refusal to register applicant's mark on the ground that if it is used on the goods identified in the application it is likely to cause confusion with the mark in the cited registration under Section 2(d) of the Trademark Act is affirmed.

⁴ To the extent that applicant refers to other registrations in its appeal brief that are not of record, we do not consider them as they have been untimely referenced and copies of the registrations were not submitted. 37 CFR § 2.142(d). See also In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983)("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"). Moreover, we note that references to the registration of different marks for different goods and services do not show that there is no likelihood of confusion in this case.