

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
July 15, 2004

Hearing:
May 12, 2004

Paper No. 15
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Medusa Film S.p.A.

Serial No. 76350858

James V. Costigan of Hedman & Costigan, P.C. for Medusa Film S.p.A.

Josette M. Beverly, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Seeherman, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On December 14, 2001, applicant filed the above-captioned application seeking registration on the Principal Register of the mark MEDUSA EMOTION PICTURE (in typed form) for various goods and services in Classes 9, 16, 35, 38 and

41.¹ Applicant has voluntarily disclaimed the exclusive right to use EMOTION PICTURE apart from the mark as shown.

¹ The application is based on applicant's asserted bona fide intention to use the mark in commerce, pursuant to Trademark Act Section 1(b), 15 U.S.C. §1051(b), and on applicant's ownership of Italian Registration No. 00855327, pursuant to Trademark Act Section 44(e), 15 U.S.C. §1126(e). The goods and services identified in the application (as amended) are as follows:

Cinematographic film; television sets; decoders for television sets namely devices for visualizing special TV transmissions; radios; radio and audio tape recorders; radio transmitters; radio-telephones; compact discs featuring music; compact disc players for music; cd-rom and audio cassettes featuring music; video tapes containing works of fiction namely movies, TV movies; video tape recorders; photographic cameras; telecameras; cinematographic cameras; spectacles; stereo amplifiers; computer operating programs; computers; computer printers; modems; facsimile machines; telephone sets namely telephones and telephone answering machines, in **International Class 9;**

Books about art; books about cinema; books about history; books about geography; books about sports; fiction-books; poetry books; dictionaries; newspaper comic strips; newspaper cartoons; periodicals about cinema; periodicals about history; periodicals about sport; periodicals about geography; periodicals about computers; periodicals of fiction; mail order catalogs featuring video cassettes and DVDs containing works of fiction and documentaries; CDs, audio cassettes and cd-roms featuring music, books about cinema, fiction-books; periodicals about cinema and television; photographs; envelopes; letter paper; self-adhesive address labels; posters; visiting cards; diaries, in **International Class 16;**

Dissemination of advertising matter; business consultation; public relations and market research services, and direction of cinema-halls on behalf of others, in **International Class 35;**

Activity consisting of television broadcasting and television program transmission; an activity consisting of cable television transmission; an activity in the field of electronic transmission of

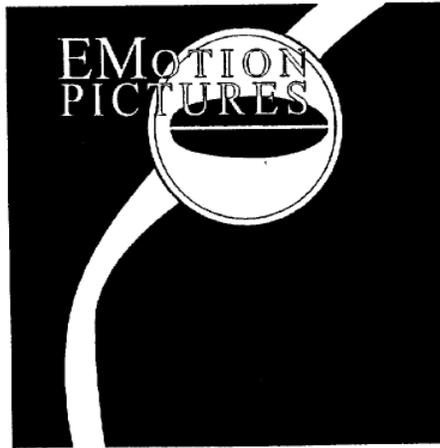
At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark as to the Class 9 goods and the Class 41 services identified in the application.² See *supra* at footnote 1. The ground for

data and documents via computer terminals; an activity consisting of computer aided recording storage and subsequent transmission of voice and image messages through electronic mail and provider services; internet provider services, in **International Class 38**; and

Writing television and radio program scripts; television and cinema motion picture production and distribution of television and cinema motion pictures for others; music production services; film editing, namely, print negative film cutting; radio and cinema studio rental; cinema studios; direction of cinema-halls, namely, activity consisting of choosing films to be shown, on own behalf or on behalf of others, in cinema-halls; video record and cinema motion picture hire; rental of sound recordings; show production and performances; theater performances; publication of books, magazines and music; modeling for artists; live musical and song performances; discotheques; motion picture film production; motion picture song production; motion picture theaters; cinema theaters; organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, flea markets, ethnic dances and the like; organizing exhibitions for cinema amateurs; conducting workshops and seminars about motion pictures, in **International Class 41**.

² No refusal was made as to the goods and services in Classes 16, 35 and 38. We note that applicant's counsel, in applicant's June 12, 2003 notice of appeal, authorized and requested that its Deposit Account be charged in the sum of five hundred dollars for "the appeal fee." Because the final refusal at issue on appeal pertains only to two classes, not five, the proper appeal fee was two hundred dollars. See Trademark Rule 2.6(a)(18). The Board accordingly shall process a credit to counsel's Deposit Account in the sum of three hundred dollars.

the refusal to register is that applicant's mark so resembles the mark depicted below,



previously registered³ (with a disclaimer of PICTURES) for Class 41 services recited in the registration as "motion picture film and video tape production services in the areas of corporate training films, original narrative films for broadcast on network and cable, and feature-length motion pictures," as to be likely, when used on or in connection with the Class 9 goods and the Class 41 services identified in applicant's application, to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

³ Registration No. 2365987, issued July 11, 2000 on the Principal Register. The registration includes the following "Description of Mark" statement: "The mark consists of the wording 'Emotion pictures' with the fanciful design of a strip of film with a projection camera lens."

Applicant and the Trademark Examining Attorney filed main appeal briefs, but applicant filed no reply brief. An oral hearing was held at which applicant's counsel and the Trademark Examining Attorney presented arguments.⁴ We affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The second *du Pont* evidentiary factor requires us to consider evidence pertaining to "the similarity or dissimilarity and nature of the goods or services as described" in the applicant's application and in the cited

⁴ The Trademark Examining Attorney identified on page 1 of this order submitted the appeal brief and appeared at the oral hearing. A different Trademark Examining Attorney handled the application prior to appeal.

registration. It is not necessary that the respective goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

We find that the Class 41 services broadly recited in the cited registration as "motion picture film and video tape production services in the areas of corporate training films, original narrative films for broadcast on network and cable, and feature-length motion pictures," are legally identical to the Class 41 services broadly recited in applicant's application as "television and cinema motion picture production" and "motion picture film production."

We also find that the registrant's recited services are similar and related (even if not identical) to the Class 9 goods identified in applicant's application as "video tapes containing works of fiction namely movies, TV movies." The legal identity and/or similarity and relatedness of the respective goods and services is apparent from the wording of applicant's and registrant's respective identifications of goods and/or services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Applicant's counsel conceded as much at the oral hearing in this case. Thus, we find that the second *du Pont* evidentiary factor weighs in favor of a finding of likelihood of confusion.⁵

Given the legal identity and/or similarity of registrant's services and the above-referenced goods and services of applicant, and the absence of any restrictions

⁵ If a likelihood of confusion is found to exist as to any of the Class 9 goods or Class 41 services listed in applicant's application, then refusal of registration as to all of the Class 9 goods and Class 41 services identified in the application is proper. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Shunk Manufacturing Company v. Tarrant Manufacturing Company*, 137 USPQ 881 (CCPA 1963); *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 411 n.7 (TTAB 1986); and *In re Alfred Dunhill Ltd.*, 224 USPQ 501 (TTAB 1984). Thus, we need not and do not decide whether a likelihood of confusion exists with respect to applicant's Class 9 goods other than "video tapes containing works of fiction namely movies, TV movies," or with respect to applicant's Class 41 services other than "television and cinema motion picture production" and "motion picture film production."

or limitations in registrant's and applicant's identifications of goods and/or services, we also find that the trade channels and classes of purchasers for these respective goods and services are the same or similar. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We also find that the purchasers of these goods and services are normal consumers, television watchers and movie-goers, who would exercise only normal care in deciding to purchase the goods and/or services. These facts weigh in favor of a finding of likelihood of confusion.

We next must determine whether applicant's mark and the cited registered mark, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be

considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods and services, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

We begin by finding that the dominant feature in the commercial impression created by the cited registered mark is the wording in the mark, i.e., EMOTION PICTURES. In many cases, it is the wording in the mark which has a greater source-indicating impact on the purchaser, because often it is the wording which the purchaser is more likely to use to refer to the goods or services sold under the mark. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). We find that this is such a case, for the following reasons.

First, we find that the wording in registrant's mark, EMOTION PICTURES, is highly distinctive and that it thus

serves a strong source-indicating function.⁶

Notwithstanding registrant's disclaimer of PICTURES, we find that EMOTION PICTURES is a cleverly-constructed (and arguably unitary) phrase. It transforms a term which is generic as applied to the registrant's services, i.e., "motion pictures," into a witty and memorable double entendre which suggests both motion pictures themselves and the emotions that such motion pictures can evoke in the audience. Applicant argues that because motion pictures can evoke emotions, EMOTION PICTURES is "descriptive" of registrant's (and applicant's) services.⁷ In making this argument, applicant either fails to appreciate or ignores the obvious double entendre nature of the phrase.

⁶ This case thus is distinguishable from *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990), a case upon which applicant places great reliance. In that case, the literal portion of the mark was highly descriptive of the goods. The design element of the mark therefore was found to contribute relatively more to the mark's commercial impression.

⁷ To the extent that applicant is arguing that the wording EMOTION or EMOTION PICTURES in the cited registered mark is merely descriptive and that the mark therefore should not have been registered without a disclaimer of that wording, we note that, aside from its unpersuasiveness, such argument constitutes an impermissible attack on the validity of the cited registration which cannot be entertained in the context of this ex parte proceeding. See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re C.F. Hathaway Company*, 190 USPQ 343 (TTAB 1976); TMEP §1207.01(d)(iv). Also, applicant's voluntary disclaimer (in its own application) of the wording EMOTION PICTURES is not evidence that this phrase is merely descriptive, nor does it have any effect on our likelihood of confusion analysis. See *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991); TMEP §1213.01(c).

Second, although we cannot and do not ignore the design element in the cited registered mark, we find that it contributes relatively less to the mark's commercial impression than does the wording in the mark. The design element is highly stylized, almost abstract.⁸ It is not easy to verbalize, or even to understand, just what it is that the design depicts and what it means. Purchasers, who utilize the mark as a means of identifying and distinguishing the source of the services, will more readily perceive, understand and recall the wording EMOTION PICTURES than they will the design element. The design element serves as a decorative (albeit evocative) background for that wording.

For these reasons, we find that it is the wording in the cited registered mark which plays the greater source-indicating role in the mark's commercial impression, and we therefore accord to it greater weight in our comparison of applicant's and registrant's marks. See *In re National Data Corp.*, *supra*.

⁸ As noted above, the "Description of Mark" statement in the registration states that the non-literal portion of the mark depicts "a fanciful design of a strip of film with a projection camera lens." Of course, purchasers viewing the mark are not privy to this statement in the registration, and they therefore will not be aided by it in their efforts to perceive or understand what it is that the mark depicts.

Turning now to that comparison, we find that applicant's mark is identical to the cited registered mark in terms of appearance, sound and connotation to the extent that both marks include the phrase EMOTION PICTURE(S). The marks are visually dissimilar to the extent that the cited registered mark includes a design element, and applicant's mark includes the house mark MEDUSA. Likewise, the presence of the word MEDUSA in applicant's mark renders the marks non-identical in terms of pronunciation and connotation.

Viewing the marks in their entirety, we find that the similarity between the marks which arises from the presence in both marks of the distinctive, double entendre phrase EMOTION PICTURE(S) outweighs the points of dissimilarity between the marks. First, the fact that applicant's mark uses the singular PICTURE while registrant's mark uses the plural PICTURES does not serve to distinguish the marks' overall commercial impressions in any meaningful way. Second, as discussed above, the design element in the cited registered mark is subordinate to the wording EMOTION PICTURES in the overall commercial impression of the mark; it plays more of a background role in the mark's commercial impression. Although we do not ignore the design element, we find that its presence in the

registered mark does not suffice to distinguish the two marks when they are viewed in their entireties. Purchasers encountering goods and services sold under marks which both include the distinctive wording EMOTION PICTURE(S) are likely to mistakenly assume that a source connection exists, even if one of the marks has the design element and the other does not.

Finally, we find that applicant's inclusion in its mark of the house mark MEDUSA does not eliminate the confusing similarity between the marks which arises from the presence in both marks of the distinctive wording EMOTION PICTURE(S). The addition of a house mark or trade name to one of two otherwise confusingly similar marks generally does not serve to avoid a likelihood of confusion between them, except (1) where there are other recognizable and significant differences between the marks, such that the addition of the house mark is enough to render the marks as a whole distinguishable, or (2) where the wording which is common to both marks is merely descriptive of the goods or services, or is otherwise lacking in source-indicating significance. See *In re Hill-Behan Lumber Company*, 201 USPQ 246 (TTAB 1978); *Envirotech Corporation v. National Service Industries, Inc.*, 197 USPQ 292 (TTAB 1977); *In re C.F. Hathaway Company*, 190 USPQ 343 (TTAB

1976); see also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition at §23:43 (4th ed. June 2001).

Neither exception applies in this case. As discussed above, the differences between the marks (i.e., the singular PICTURE versus the plural PICTURES, and the presence of the design element in the registered mark) are not so significant in themselves that the addition of the house mark renders the marks as a whole distinguishable. Likewise, as discussed above, the wording EMOTION PICTURE(S) in the two marks is not descriptive but rather is distinctive; applicant's addition of its house mark to this distinctive wording does not distinguish the marks as a whole.⁹

For these reasons, we find that applicant's mark is more similar than dissimilar to the cited registered mark. Applicant's mark certainly is sufficiently similar to the cited registered mark that source confusion is likely to result from the use of these marks on the identical and closely related goods and services involved herein. See

⁹ Applicant argues that its mark, unlike the cited registered mark, connotes the "emotion picture" of a particular individual, i.e., Medusa. We find this argument to be wholly unpersuasive. Applicant's mark is MEDUSA EMOTION PICTURE, not the possessive-form MEDUSA'S EMOTION PICTURE. Moreover, it is highly unlikely that consumers would assume that there is an actual person (unflatteringly) named Medusa who possesses or is the source of the "emotion picture," much less that it is the mythical gorgon herself who possesses or is the source of the "emotion picture."

Century 21 Real Estate Corp. v. Century Life of America,
supra.

Applicant argues that there is no evidence that the cited registered mark is famous, and that, by contrast, its own MEDUSA mark and name are famous. While evidence establishing the fame of the prior registered mark would weigh heavily in support of a finding of likelihood of confusion, the absence of such evidence does not weigh against a finding of likelihood of confusion. Moreover, the fame of the cited registered mark is usually not a factor in an ex parte case such as this; evidence of such fame (i.e., sales and advertising figures) is not readily available to the Trademark Examining Attorney. Finally, applicant's assertion that its own mark is famous is not supported by the record, and any such fame would be irrelevant to our likelihood of confusion determination in any event. The fifth *du Pont* factor requires consideration of evidence pertaining to "the fame of the prior mark," which in the context of an ex parte case means the fame of the cited registered mark.

Applicant also contends that it "conducted a preliminary search of the USPTO online databases and found 204 current registrations which employ the term EMOTION in various international classes." Applicant did not make any

such registrations of record, but the Trademark Examining Attorney has not objected on this basis and in fact has presented argument as to the import of the existence of such registrations. We thus shall assume that applicant is correct in its assertion that there are 204 current registrations of marks which employ some form of the word EMOTION.

However, we are not persuaded by this "evidence" that EMOTION is a weak or diluted term as applied to the goods and services at issue here, or that the cited registered mark therefore should be accorded a narrow scope of protection, as applicant argues. Third-party registrations are not evidence that the marks are currently in use or that the public is aware of them, and they therefore are of no probative value under the sixth *du Pont* evidentiary factor (i.e., "the number and nature of similar marks in use on similar goods"). See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Moreover, because none of the alleged third-party registrations is of record, we do not know what the registered marks are or what the goods and services identified in the registrations are. Thus, we cannot conclude that EMOTION is so highly suggestive of the goods

and services involved herein that the cited registration should be accorded a narrow scope of protection.

In any event, the alleged existence of these third-party registrations which employ the word EMOTION is beside the point in this case. Whatever suggestive significance the word EMOTION, by itself, might have as applied to motion pictures, it is the highly distinctive double entendre EMOTION PICTURE(S), not just the word EMOTION, that is at issue in this case. Thus, we disagree with applicant's contention that the word EMOTION is "the only common element" of applicant's mark and the cited registered mark. Rather, the two marks share the distinctive and unitary phrase EMOTION PICTURE(S). Indeed, it appears on this record that applicant's mark and the cited registered mark are the only marks which use this distinctive double entendre. This fact weighs in favor of, not against, a finding of likelihood of confusion.

Having considered all of the evidence of record pertaining to the relevant *du Pont* evidentiary factors, we conclude that applicant's mark so resembles the cited registered mark as to be likely, when used on or in connection with the Class 9 goods identified in applicant's application as "video tapes containing works of fiction namely movies, TV movies" and the Class 41 services recited

Ser. No. 76350858

in applicant's application as "television and cinema motion picture production" and "motion picture film production," to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Decision: The Section 2(d) refusal of registration as to Classes 9 and 41 is affirmed. However, the application shall proceed to publication in the Official Gazette as to the goods and services in Classes 16, 35 and 38.