

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 13, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Disney Enterprises, Inc.¹

v.

The Short Sport(s) Co.

Opposition No. 103,575
to application Serial No. 74/733,405
filed on September 25, 1995

Julia Anne Matheson of Finnegan, Henderson, Farabow, Garrett
& Dunner, L.L.P. for Disney Enterprises, Inc.

The Short Sport(s) Co., pro se.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

¹ The opposition was filed in the name of The Walt Disney Company. During the course of the opposition Disney Enterprises, Inc. filed a notice of reliance stating that it was formerly known as The Walt Disney Company, and Patent and Trademark Office records reflect that The Walt Disney Company filed a certificate of merger, changing its name to Disney Enterprises, Inc., on February 9, 1996 with the Office of the Secretary of State of Delaware. Accordingly, Disney Enterprises, Inc. has been substituted as the name of the opposer in this proceeding.

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Disney Enterprises, Inc., by change of name from The Walt Disney Company, has opposed the application of The Short Sport(s) Co. to register THE MAGIC SWINGDOM as a trademark for "prerecorded video cassettes, namely sports training videos featuring animated and live characters for instructional purposes."² As grounds for opposition, opposer has alleged that it produces live-action and animated feature films and television programs, many of which feature its animated characters; that it produces interactive computer products geared at education and entertainment for children, adults and families, and offers online computer services; that it operates theme parks worldwide and directs substantial merchandising and licensing operations for its characters and various product lines; that its DISNEYLAND theme park in Anaheim, California has been identified by its nickname DISNEY'S MAGIC KINGDOM since the park's inception in 1955; that it also operates the MAGIC KINGDOM park at Walt Disney World in Florida; that it has used the mark MAGIC KINGDOM for a variety of goods and services associated with its theme parks since at least as early as December 31, 1955, and the mark has become famous and synonymous with opposer and its goods and services; that it is the owner of registrations for MAGIC KINGDOM for educational and entertainment services rendered

² Application Serial No. 74/733,905, filed September 25, 1995,

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in a theme park and for MAGIC KINGDOM CLUB for membership in a club operated by opposer; and that applicant's applied-for mark so resembles opposer's mark MAGIC KINGDOM as to be likely, when applied to applicant's identified goods, to cause confusion or mistake or to deceive; and that because of the fame of opposer's MAGIC KINGDOM mark and its reputation for animation and entertainment, persons familiar with opposer and the MAGIC KINGDOM will be misled into believing that applicant's goods are sponsored by or otherwise associated with opposer.

In its answer applicant denied the salient allegations of the notice of opposition, and has asserted, as affirmative defenses, acquiescence and weakness of opposer's mark. Applicant also asserted as a counterclaim that opposer's pleaded registrations should be canceled; however, applicant did not submit the required cancellation fee and the counterclaim was never instituted.

The record includes the pleadings; the file of the opposed application; the testimonial declarations, with exhibits, of opposer's witnesses Robert E. Chmiel, Robert S. Tieman, Kevin R. Weickel and Teresa H. Miguel, and of applicant's witness, Anthony L. Gordon.³ Opposer also

and asserting a bona fide intention to use the mark in commerce.

³ Although no written stipulation that the parties could testify by way of testimonial declarations was submitted, it is clear that the parties have so stipulated. Accordingly, the testimonial declarations form part of the record. The parties

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submitted, under notice of reliance, status and title copies of its pleaded registrations⁴; articles taken from various printed publications referring to the golf facilities at Walt Disney World; and applicant's answers to certain of opposer's interrogatories.

Only opposer filed a brief.⁵ However, the testimonial declaration of Anthony L. Gordon, applicant's president, is, to a large extent, argument. Because applicant is appearing pro se, we have treated the declaration to be in the nature of a brief. Opposer, of course, is not prejudiced by this, since it prepared and filed its brief well after the submission of Mr. Gordon's declaration. An oral hearing was not requested.

Before we discuss the evidence in support of opposer's case, we note that there has been some confusion with respect to the company name of opposer. This is due in

should note, for future reference, that with the recent amendments to the Trademark Rules of Practice, effective October 9, 1998, Trademark Rule 2.123(b) now provides that if parties wish to stipulate that the testimony of a witness may be submitted in the form of an affidavit, it must be done by written agreement.

⁴ Registration No. 938,314, issued July 18, 1972, for MAGIC KINGDOM CLUB for "indicating membership in applicant", Section 8 affidavit accepted, Section 15 affidavit received, renewed; Registration No. 1,072,396, issued August 30, 1977, for MAGIC KINGDOM for "educational and entertainment services rendered in a theme park," Section 8 affidavit accepted, Section 15 affidavit received, renewed.

⁵ Opposer's uncontested motion to extend briefing dates, filed July 15, 1998, is granted.

large part to opposer's merely inserting the name Disney Enterprises, Inc. in its motion to extend filed July 18, 1997, without any explanation as to why this name was used. Opposer is advised that it would have been far better if it had filed a motion to substitute, and provided information about the filing of the merger and change of name certificate. However, as we stated in footnote 1, supra, PTO records show that a certification from the Delaware Secretary of State was recorded with this agency, showing that The Walt Disney Company filed a certificate of merger changing its name to Disney Enterprises, Inc. on February 9, 1996.

We also note that opposer's witnesses are not identified as employees of Disney Enterprises, Inc. Rather, Mr. Chmiel states that he is employed by Disney Online, Mr. Tieman is an employee of The Walt Disney Company,⁶ Ms. Miguel is an employee of Walt Disney Attractions, Inc., and

⁶ Although The Walt Disney Company was the name of the opposer at the time of the filing of the opposition, that company name change was effective February 9, 1996. Mr. Tieman did not sign his declaration until February 3, 1998; therefore, it is unclear whether he is an employee of opposer and is referring to his former company name, or he is an employee of another company which subsequently formed under the name The Walt Disney Company. In this connection, we note that applicant's witness, Mr. Gordon, has submitted as an exhibit what he asserts to be a copy of a Dun & Bradstreet listing of "companies related to opposer," declaration, p.4, which show Disney Enterprises Inc. to be a subsidiary of "Walt Disney Co (Inc)." The Dun & Bradstreet document, however, is undated, and may simply reflect the situation prior to the merger and change of name reflected in the Delaware Secretary of State certificate.

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Mr. Weickel is employed by Walt Disney World Co. It would have been far better if opposer had elicited testimony from these witnesses reflecting how their employers are affiliated with opposer; however, it is clear from their declarations that the activities relating to the MAGIC KINGDOM mark refer to opposer's mark MAGIC KINGDOM. See **Somerset Distilling Inc. v. Speymalt Whiskey Distributors Ltd.**, 14 USPQ2d 1539 (TTAB 1989). The relationship between the companies is further confirmed by the Dun & Bradstreet report submitted with the testimony of applicant's witness. Thus, we view the evidence submitted by opposer with respect to the activities of the various Disney companies as reflecting a general use of the mark MAGIC KINGDOM. See also, **West Florida Seafood Inc. v. Jet Restaurants Inc.**, 31 F.3d 1122, 31 USPQ2d 1660 (Fed Cir. 1994); **In re Wella A.G.**, 787 F.2d 1549, 229 USPQ 274 (Fed. Cir. 1986); **Transamerica Financial Corporation v. Trans-America Collections, Inc.**, 197 USPQ 43 (TTAB 1977).

Opposer's evidence shows that since 1955, when opposer's DISNEYLAND theme park opened in Anaheim, California, the park has been identified by the nickname DISNEY'S MAGIC KINGDOM, and by 1957 the term MAGIC KINGDOM was being used in travel brochures. In 1957 opposer formed THE MAGIC KINGDOM CLUB, membership in which was made available to employees in participating organizations in

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business, industry and the military, and which afforded member employees certain discounts and other benefits not available to the general public. By 1980, the MAGIC KINGDOM CLUB reached as many as 34 million member employees nationwide.

In 1971 opposer opened a second MAGIC KINGDOM theme park at its Walt Disney World resort in Florida. Opposer has submitted the first ticket book from Walt Disney World, which features the name THE MAGIC KINGDOM.

Each year each of the MAGIC KINGDOM parks attracts millions of visitors of every age, and from every region of the country. Since the parks have opened, they have each attracted over a hundred million visitors. Opposer has also expended "hundreds of millions of dollars" to advertise and promote its MAGIC KINGDOM destinations. Tieman declaration, p. 4.

Opposer has sold a range of souvenir merchandise featuring the term MAGIC KINGDOM, including guide books; recordings; apparel such as T-shirts, golf shirts, sweat shirts and baseball caps; postcards and video cassettes. Sales of such goods have been made since as least as early as 1993, with guide books sold since 1955, recordings sold since 1956, and video cassettes sold as early as 1992. The exhibits submitted as examples of such use show a record album cover entitled "Walt Disney takes you to Disneyland,"

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with the word "Disneyland" featured in the largest type. Below that is the subheading, "A MUSICAL TOUR of the MAGIC KINGDOM," with "Magic Kingdom" shown in all capital letters on a separate line. Another record album cover shows, as its apparent title, "A Musical Souvenir of Walt Disney World's Magic Kingdom." The guidebook, which bears the mark WALT DISNEY WORLD on its cover, contains a page depicting a picture of three cartoon characters, with the words THE MAGIC KINGDOM featured prominently at the top.

Current examples of use on merchandised products show prominent trademark use of MAGIC KINGDOM on golf shirts, T-shirts, baseball caps, bibs, children's T-shirts, stationery, pens, picture frames, lunch bags, key chains and Christmas ornaments. Many of these products also feature cartoon characters.

Opposer's MAGIC KINGDOM videos feature many of opposer's popular characters, along with the music, parades and attractions of the MAGIC KINGDOM parks. Opposer has sold more than 230,000 videos, representing over \$7.7 million in sales. The most recent version of the MAGIC KINGDOM video is available at Disney retail locations for \$19.95. Its cover shows the words MAGIC KINGDOM in large letters, with MAGIC at the top of a picture of a castle, and KINGDOM at the bottom. In much smaller letters, and in a different, cursive type font, the words "a day at the"

appear above the word MAGIC. The spine of the box has the words "a day at the" in small letters in cursive font, followed by the words MAGIC KINGDOM in large block-type letters. The videos are intended to appeal to viewers of every age group, and are purchased by MAGIC KINGDOM visitors from every region of the country.

Opposer's Walt Disney World Resort, which is the location of its Florida MAGIC KINGDOM park, has five championship golf courses, and opposer has produced a number of brochures featuring the golfing attractions at the Walt Disney World Resort.⁷

Opposer's courses host several events for junior golfers. As part of the annual PGA Tour event held at Walt Disney World, opposer and the PGA team conduct a junior golf

⁷ Opposer's witness Kevin Weickel testified that an article (actually, a "Special Advertisement Section") entitled "The Magic Linkdom" and featuring the resort's golf courses, appeared in the February 1994 issue of "Golf Magazine," prior to the September 1995 filing date of applicant's intent-to-use application. Applicant takes issue with the date of that article, pointing out that the exhibit itself is undated, and that the 1994 date testified to by Mr. Weickel is contradicted by information in the article coupled with Mr. Weickel's own testimony. Specifically, one of the articles in that section, which was written by Mr. Weickel himself, describes him as the "head professional" at Walt Disney World's golf courses, but in Mr. Weickel's declaration he states that he became the Head Golf Professional in October 1997, prior to which he was a golf teaching professional. Opposer has given no explanation for this discrepancy. In view thereof, we have not considered the article to have been in existence prior to the filing of applicant's application or the bringing of this opposition proceeding. Moreover, opposer never pleaded use of THE MAGIC LINKDOM as a trademark in its notice of opposition, and it is clear from Mr. Gordon's declaration that applicant never agreed to try this issue. Thus, to the extent that opposer has attempted to rely on trademark rights in THE MAGIC LINKDOM, a

clinic. Opposer also sponsors the American Junior Golf Association Rolex Championship, hosts the Florida State Junior Golf Association Championships, runs a Summer Junior Golf Camp, and conducts a Golf Awareness Day for Juniors. Opposer also offers instructional programs for golfers of all ages, including young people. As part of its golf instruction programs, golfers can arrange to have their golf game videotaped and critiqued by Disney's instructors, with the students receiving a copy of the videotape at the conclusion of the training program.

Applicant's witness, Anthony Gordon, is the president of applicant. He testified that the mark MAGIC SWINGDOM was chosen to show the concept of the applicant's instructional video: "a magical place (whether real or not) where children are instructed in a unique way to swing in this video a golf club." Declaration, p. 2. Although the application was based on an intention to use the mark, applicant has, in fact, sold the video. The box for the cassette shows a costumed person called "Will Tell-em," and cartoon figures of a bird and squirrel. One of applicant's promotional materials also features these cartoon figures, while another is a photograph of the costumed "Will Tell-Em" with three children, and the legend "Sing. Swing and Laugh as you Learn the Game of Golf!" appearing under the words THE MAGIC

likelihood of confusion ground based on such mark has not been

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SWINGDOM, which are shown the most prominently. The cartoon bird is depicted in the upper corner.

Before turning to opposer's grounds for opposition, we must address applicant's affirmative defense of acquiescence.⁸ The evidence submitted by applicant indicates that on July 2, 1996 applicant sent a letter to Michael Eisner at "Walt Disney Co." referring to a tape entitled "The Magic Swingdom" which applicant sent on June 20, 1996. In view of the request for an extension of time to oppose filed by opposer on July 12, 1996, followed by the opposition itself, opposer undertook no affirmative act which would logically indicate to applicant that opposer had no objection to applicant's use of THE MAGIC SWINGDOM trademark.

Applicant has asserted a claim of laches in its "brief." Specifically, applicant has alleged that opposer would have been aware of applicant's application, because of opposer's asserted use of watch services, from the time applicant filed its application on September 25, 1995, but that opposer raised no concern to applicant until opposer filed a request for extension of time to file a notice of opposition on July 12, 1996. This claim is without merit.

considered.

⁸ The pleaded affirmative defense that opposer's mark is weak is not an affirmative defense, but goes to the issue of likelihood of confusion.

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In terms of an opposition proceeding, which protests the issuance of a registration, laches does not begin to run until the application for registration is published for opposition. **National Cable Television Association, Inc. v. American Cinema Editors, Inc.**, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). In this case, applicant's mark was published for opposition on June 18, 1996, and opposer filed a request for extension to oppose the application on July 12, 1996 and an opposition on October 16, 1996.

Accordingly, we find no merit in applicant's affirmative defenses.

This brings us to the ground of priority and likelihood of confusion upon which opposer has brought this proceeding. Priority is not in issue because opposer's pleaded registrations for MAGIC KINGDOM and MAGIC KINGDOM CLUB have been made of record. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence establishes use of the mark MAGIC KINGDOM for, inter alia, theme park services, apparel, video cassettes and records since prior to the filing of applicant's intent-to-use application on September 25, 1995, which is the earliest date on which applicant is entitled to rely.

With respect to the issue of likelihood of confusion, we have, in making this determination, considered all

factors, as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), which are relevant to this record.

Turning first to the marks, there are obvious similarities between MAGIC KINGDOM and THE MAGIC SWINGDOM. Applicant's mark not only begins with (the commonly used article THE has no source-identifying significance) the identical word MAGIC of opposer's mark, but SWINGDOM rhymes with KINGDOM. Thus, the marks as a whole have phonetic and visual similarities. Moreover, SWINGDOM, which is not a word, is clearly a play on or reference to the word KINGDOM. Applicant, in fact, describes MAGIC SWINGDOM as a magical place where children are instructed to swing a golf club; MAGIC KINGDOM also has the connotation of a magical place.

Applicant has argued that opposer's mark is weak because other similar trademarks have been registered, and that no one should be accorded exclusive rights to the suffix "dom." However, the registrations which applicant has made of record--MAGIC and design, "THE SWING DOCTOR," and THE MAGIC SCHOOL BUS--are very different from the mark MAGIC KINGDOM or, for that matter, THE MAGIC SWINGDOM. Moreover, the similarity which we find between the marks is not based on the element "DOM," but on the marks as a whole, as indicated above.

In fact, not only has applicant failed to show that MAGIC KINGDOM is a weak mark but, on the contrary, the evidence shows that MAGIC KINGDOM is a famous mark. MAGIC KINGDOM has been in use since at least 1957 in connection with entertainment services in the nature of a theme park, and opposer's MAGIC KINGDOM parks have existed in both California and Florida since 1971. Opposer's evidence states that the parks have attracted over one hundred million visitors,⁹ and that it has expended hundreds of million of dollars to advertise its two MAGIC KINGDOM destinations. Although it would have been more effective for opposer to have provided more specific information about its advertising efforts, we can still ascertain from the materials that have been submitted that the mark has been promoted in travel brochures, destination guides, and the like. In addition, opposer has sold a video featuring the MAGIC KINGDOM parks which in effect is a promotional tool. Over 230,000 of these videos, totaling more than \$7,700,000, have been sold.

Fame plays a dominant role in cases featuring a famous or strong mark. **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir.

⁹ We regard the reference to over one hundred million visitors to reflect the number of admissions to the parks. Nonetheless, even assuming that some of the attendees may be repeat visitors, the overall number of people visiting the parks is clearly extremely large.

1992). Famous or strong marks enjoy a wide latitude of legal protection. Id.

With that in mind, we turn to a consideration of the parties' goods and services. Applicant has pointed out that its goods are specifically different from the services identified in opposer's registrations for MAGIC KINGDOM and MAGIC KINGDOM CLUB, and that opposer has not provided any evidence of registrations for these marks in Class 9, the class covering applicant's video cassette. However, in order to support a finding a likelihood of confusion it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

In this case, opposer has shown that, in addition to using the mark MAGIC KINGDOM for its theme park entertainment services, it has also established prior use of

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the mark on a variety of merchandised items, including sports apparel such as golf shirts and baseball caps; video cassettes featuring the theme park; guide books on the parks; and recordings featuring musical highlights from the parks. In addition, opposer has expanded its use of the mark to such varied items as baby bibs, picture frames, pens, stationery and keychains. Moreover, cartoon characters are often featured along with the trademark MAGIC KINGDOM. In addition, although these services are not rendered under the mark MAGIC KINGDOM, opposer offers golf and golf-related goods and services at the Walt Disney World Resort, where its Florida MAGIC KINGDOM theme park is located, and brochures for the golfing activities include references to the MAGIC KINGDOM theme park. These golfing activities include golf lessons, and in particular, lessons in which the student is videotaped and is given the video cassette. Further, opposer markets animated movies and cartoons on video cassettes, as shown by Exhibit 7, submitted by applicant itself as part of Mr. Gordon's testimonial declaration.

Because of the range of opposer's activities, and the goods and services on which it uses its MAGIC KINGDOM mark, we find that applicant's use of THE MAGIC SWINGDOM for "prerecorded video cassettes, namely sports training videos featuring animated and live characters for instructional

purposes" is likely to cause confusion. In particular, opposer has shown that it markets video cassettes and is engaged in golfing activities, and that it provides video cassettes of students as part of its golf training programs. These goods and services, taken together, are extremely similar to applicant's sports training videos, which at this point feature training in the sport of golf. Moreover, opposer has shown that it continues to expand its use of the MAGIC KINGDOM mark to a variety of goods and, because of its involvement with golf courses and golf training, consumers might well assume, upon seeing THE MAGIC SWINGDOM for golf instructional videos, that opposer had expanded its business to market such goods. This is particularly true because applicant's training videos feature animated characters, and opposer's videos cassettes include animated movies and cartoons, and its MAGIC KINGDOM mark is frequently used on goods in close proximity to cartoon characters.

We also note that applicant's video was designed for young children, and the videos are purchased by parents and grandparents for their children and grandchildren. Opposer's goods and services are designed for, and are purchased by, people of every age group, and it is apparent from this record that many of opposer's products are for use by children. Thus, we must consider the parties' goods and services to be sold to the same classes of consumers.

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We note that opposer's goods appear to be sold, and its services offered, only at its own theme parks and resort and through its own retail stores, while applicant indicates that it intends to market and sell its goods through "television, radio, motion pictures, retail stores, and any new market that would present itself." Response to Interrogatory No. 11. Although the parties' goods and services would not be offered in the same places, the number of people who visit opposer's MAGIC KINGDOM theme parks is so overwhelming that we must consider them to include a sizable number of people in the United States. These same people, i.e., the general public, are likely to encounter applicant's goods in retail stores and other places applicant may advertise and sell its products, given the widespread manner of distribution that applicant describes.

Applicant's mark THE MAGIC SWINGDOM, when used on golf instructional videos, suggests training in how to use a golf club. Because of the fame of opposer's MAGIC KINGDOM mark, people encountering applicant's video cassettes are likely to regard THE MAGIC SWINGDOM as a variant of opposer's famous mark.

Accordingly, we find that applicant's use of THE MAGIC SWINGDOM for "prerecorded video cassettes, namely sports training videos featuring animated and live characters for instructional purposes" is likely to cause confusion with

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opposer's MAGIC KINGDOM mark, as used for its theme park entertainment services and related merchandising items.

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Decision: The opposition is sustained.

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board