Not citable as precedent

Paper No. 16
EWH/HLJ

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Christine D. Funcik
v.
B. Dazzle, Inc.

Cancellation No. 24,983

Christine D. Funcik, pro se.

Carole F. Barrett of Severson & Werson for B. Dazzle, Inc.

Before Simms, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

On April 8, 1996 Christine D. Funcik (petitioner) filed a petition to cancel Registration No. 1,926,429 owned by B. Dazzle, Inc. (respondent). This registration -- which issued on October 10, 1995 -– is for the mark KIDS ON THE GO "for children's activity books." The registration was based on an intent-to-use application which was filed on December 13, 1993. At the request of the Examining Attorney, respondent disclaimed the exclusive right to use KIDS apart from the mark in its entirety.

The sole ground for the petition is petitioner's contention that in 1991 she began using the identical mark KIDS ON THE GO for books, and that the "use of the trademark KIDS ON THE GO by two similar companies [petitioner and respondent] is likely to cause confusion, to cause mistake, or to deceive." (Petition paragraphs 1d and 2a).

Respondent filed an answer which, among other things, denied the allegations of paragraphs 1d and 2a of the petition for cancellation. In addition, the answer set forth the affirmative defense of laches.

Both parties filed briefs. Neither party requested an oral hearing.

The record in this case consists of the notarized statements of petitioner Christine D. Funcik (dated December 5, 1996); petitioner's former partner Diane Owens (dated December 5, 1996); (and respondent's executive vice-president, Marshall P. Gavin (two statements, one dated January 31, 1997 and a second dated dated March 14, 1997). In their briefs, both parties have treated these notarized statements (and their accompanying exhibits) as constituting the evidentiary record in this case. While these notarized statements are not the same as affidavits (see Trademark Rule 2.123b), because the parties have considered said notarized statements and accompanying exhibits as

constituting the evidentiary record in this case, we will do likewise.

At the outset, one issue should be clarified. In its answer, respondent denied the following allegation contained in paragraph ld of the petition for cancellation: "Use of the trademark KIDS ON THE GO by two similar companies [petitioner and respondent] is likely to cause confusion, to cause mistake, or to deceive." However, in its brief respondent never argued that the contemporaneous use of the phrase KIDS ON THE GO by both parties for children's books is not likely to cause confusion. Instead, respondent in its brief argued that (1) petitioner failed to establish prior rights to the mark KIDS ON THE GO, and that (2) petitioner's "claim is barred by the doctrine of laches." (Respondent's brief pages 3-4). Thus, it appears that the parties are now in agreement that the contemptoraneous use of the identical mark KIDS ON THE GO in connection with legally identical children's books would result in a likelihood of confusion. We use the term "legally identical" because the identification of goods in respondent's registration (children's activity books) is broad enough to include the types of books sold by petitioner under the identical mark. In any event, we find that use of the identical mark KIDS ON THE GO for legally identical children's books is likely to result in confusion.

We now turn to the real issue in this case, namely, priority of use. Respondent's constructive first use date is December 13, 1993, the filing date of its intent-to-use application which matured into Registration No. 1,926,429. Through her notarized statement, Ms. Funcik established that she first published a children's book under the mark KIDS ON THE GO in June 1991, and that the first interstate sale of a copy of said book occurred on July 21, 1991. The full title of said first book is "KIDS ON THE GO in the Charleston area." A complete copy of this first book was attached as exhibit 1 to Ms. Funcik's notarized statement. The first paragraph of the preface to this work accurately describes it as follows: "Whether you are in Charleston [South Carolina] for a day or a lifetime, this book will tell you about places to take your children. This is not a sales tool for businesses nor is it a comprehensive list of all places you can take children. It is an honest, objective description of selected parks, attractions and businesses which we (and our children!) have personally experienced and feel are worthwhile." Ms. Funcik attached to her notarized statement as exhibit 4 a copy of Certificate of Copyright Registration issued by the Copyright Office for the work entitled "KIDS ON THE GO in the Charleston area." The Certificate of Copyright Registration has an effective date of registration of June 30, 1991.

The record reflects that petitioner's Charleston version of her KIDS ON THE GO books were published in three editions with a total of seven printings. The first edition had printings in June 1991, July 1991 and August l991. The second edition had printings in March 1993 and June 1993. Finally, the third edition had printings in April 1995 and March 1996. Petitioner made of record as exhibits 1-3 complete copies of the following versions of her KIDS ON THE GO children's books for the Charleston area: (1) first edition, first printing (June 1991) entitled "KIDS ON THE GO in the Charleston area"; (2) first edition, second printing (August 1991) entitled "KIDS ON THE GO The Charleston area guide to Great Places to Take Kids"; and (3) third edition, second printing (March 1996) entitled "KIDS ON THE GO The Charleston area guide to Great Places to take Kids." Photocopies of the covers of these three versions are attached to this opinion as exhibits 1-3. As is readily apparent, the covers of these different printings and editions are varied. However, each displays the mark KIDS ON THE GO. Not only are the covers different, but more importantly, the contents are different. As might be expected, the differences between the first edition printed in June 1991 (exhibit 1) and the first edition printed in August 1991 (exhibit 2) are minimal given the fact that the two printings were only two months apart. Obliviously, one

would not expect significant changes occurring in children's activities during this short time span. Nevertheless, even in these two printings, we note that there are a number of differences in the discount coupons appearing at the end of both printings. For example, the June 1991 printing includes a coupon for a free sundae from the MCDONALD'S restaurant chain. The August 1991 printing does not contain this coupon but rather contains a coupon for a free dessert from the BURGER KING restaurant chain. Moreover, the final page of the August 1991 printing is an order form "to order more copies of KIDS ON THE GO." The June 1991 printing of KIDS ON THE GO lacks this order form.

When one compares the March 1996 printing of the third edition (exhibit 3) with the June 1991 and August 1991 printings of the first edition, there are very significant differences. Numerous activities have been deleted and numerous others have been added.

In 1994, petitioner entered into licensing agreements with different entities in Houston, Texas and Denver, Colorado to publish a series of KIDS ON THE GO activity books for those respective geographic areas. There were three printings of the Houston version of KIDS ON THE GO in July 1995, November 1995 and June 1996. As of the close of the trial in this case, there was one printing of the Denver version of KIDS ON THE GO in August 1996. Attached to this

opinion are photocopies of the covers of the November 1995 printing of the Houston edition of KIDS ON THE GO and the August 1996 printing of the Denver version of KIDS ON THE GO.

As previously noted, respondent's constructive first use date of the mark KIDS ON THE GO is December 13, 1993, the date respondent filed its intent-to-use application which matured into Registration No. 1,926,429. It is respondent's position that petitioner "cannot establish priority of use for her book title [KIDS ON THE GO] unless she can show use as part of a series [of books] or secondary meaning, prior to [respondent's] first use date of December 13, 1993." (Respondent's brief page 2, emphasis added).

We find that prior to December 13, 1993, petitioner had published and sold in interstate commerce a series of children's activity books for the Charleston, South Carolina area under the mark KIDS ON THE GO. That is to say, prior to December 1993, petitioner had published not only the first edition of KIDS ON THE GO with printings in June 1991, July 1991 and August 1991, but also the second edition of KIDS ON THE GO with printings in March 1993 and June 1993. As previously noted, not only did the covers of the various editions and printings vary, but in addition, the contents varied. This constitutes a series of books. Obviously, the two editions and various printings of petitioner's KIDS ON

THE GO activity books which appeared prior to December 1993 share a number of similarities. However, by definition, this is what a series is. A "series" as it pertains to books is defined as "a number of things produced as a related group; set, as of books or television programs, related in subject, format, etc." Webster's New World Dictionary (2d ed. 19970). Moreover, we note that respondent appears to concede that petitioner had established a series of KIDS ON THE GO activity books once her licensees commenced using the mark in connection with the Houston and Denver versions of KIDS ON THE GO. See respondent's brief page 3, footnote 3. However, respondent notes in footnote 3 that the license agreements for the Houston and Denver versions of KIDS ON THE GO were not executed until 1994 and that "accordingly, [petitioner] has offered no evidence that [her] KIDS ON THE GO was used on a series of books prior to [respondent's] first use date" of December 13, 1993. In order to constitute a series, petitioner's books pre-dating December 13, 1993 need not feature different geographic locations. Prior to December 13, 1993, petitioner had produced five different books (with different covers and different contents) describing children's activities in the Charleston area. This series of five different books were published and sold under the mark KIDS ON THE GO. Thus, prior to respondent's

constructive first use date of December 13, 1993, petitioner had established trademark rights in KIDS ON THE GO for a series of books featuring children's activities in the Charleston, South Carolina area. Accordingly, priority of use rests in favor of petitioner.

Moreover, it should be made clear that respondent has never contended that the mark KIDS ON THE GO is descriptive of children's activity books. Indeed, respondent obtained a registration of this identical mark for children's activity books without any objection by the Examining Attorney that the mark was descriptive of said books. As previously noted, Examining Attorney merely required that respondent disclaim the exclusive right to the term KIDS. In this regard, we note that at page 2 of its brief, respondent quotes the following language from Professor McCarthy's treatise: "Thus, unlike ordinary marks, literary titles of single works which are inherently distinctive are not accorded immediate protection, absent proof of secondary meaning and consumer recognition." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 10:2 at page 10-5 (4th ed. 1998) (emphasis added). In this case, petitioner need not establish that her mark KIDS ON THE GO acquired consumer recognition prior to respondent's constructive first use date of December 13, 1993, because petitioner has proven that prior to December 13 1993 she

used the inherently distinctive mark KIDS ON THE GO not simply in connection with a single book, but rather in connection with a series of books.

Finally, we turn to a consideration of respondent's argument that petitioner's "claim is barred by the doctrine laches." (Respondent's brief page 3). We note that it is respondent's contention that petitioner "has had actual or constructive knowledge of defendant's use and registration since at least December 13, 1993." (Respondent's brief page 3). With regard to constructive notice, the critical date is not the application filing date, but rather the date the "application for registration was published for opposition." NCTA v. American Cinema Editors, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Thus, in this case, constructive notice runs not from December 13, 1993 but rather from the publication date of November 8, 1994. The notarized statement of petitioner establishes that she did not have actual knowledge of respondent's then pending application until December 1994, and that promptly thereafter she repeatedly telephoned respondent regarding respondent's infringement and wrote to respondent in a letter dated December 22, 1994 in an effort to work with respondent "in finding a win/win solution to our name conflict." (Petitioner's statement paragraph 9 and exhibit 10). Indeed, respondent even acknowledges at page 3 of its

brief that petitioner contacted respondent in December 1994, as shown by the following sentence taken from respondent's brief: "Plaintiff [petitioner] has had actual or constructive knowledge of defendant's [respondent's] use and registration since at least December 13, 1993, yet waited an entire year [December 1994] before contacting defendant [respondent]." As previously noted, there is absolutely no evidence that petitioner had actual knowledge of respondent's filing of its application in December 1993. To the contrary, petitioner has stated that she had no actual knowledge until December 1994. Moreover, as noted, constructive notice runs not from the application filing date of December 13, 1993 but rather from the publication dated of November 8, 1994.

In light of the forgoing, there was no delay whatsoever on the part of petitioner in making protest to respondent regarding respondent's infringement of petitioner's mark KIDS ON THE GO. Respondent's use of the mark KIDS ON THE GO subsequent to December 1994 was at respondent's own peril. Accordingly, respondent's laches defense is without merit.

Decision: The petition for cancellation is granted,

and Registration No. 1,926,429 will be cancelled in due course.

R. L. Simms

E. W. Hanak

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial and
Appeal Board