

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
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4/3/02

Hearing:
January 10, 2002

Paper No. 42
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Houghton Mifflin Company, Inc.

v.

George M. Tabb

Opposition No. 110,282
to application Serial No. 75/241,060
filed on February 13, 1997

Francine Miller, Mary Donovan and Marya Lenn Yee of
Donovan & Yee LLP for Houghton Mifflin Company, Inc.

Andrew E. Krents, Esq. for George M. Tabb.

Before Hanak, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

George M. Tabb has filed an application to register
the mark FURIOUS GEORGE for "film, video and audio
recordings featuring musical entertainment" in Class 9
and

"entertainment services, namely, live performances by a musical band" in Class 41.¹

Houghton Mifflin Company, Inc. has filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act.² In the notice of opposition, opposer alleges, inter alia, that opposer is the owner of the world famous trademark and character CURIOUS GEORGE; that the first book of the CURIOUS GEORGE series was published in 1941, followed by six more books written by Margret and H.A. Rey and subsequently 28 more books were added to the series; that the mark CURIOUS GEORGE has additionally been used, both directly and under license, for a wide variety of goods and services; that opposer is the owner of registrations for the mark CURIOUS GEORGE and CURIOUS GEORGE and design for a variety of goods and services;³ that applicant's FURIOUS GEORGE mark is

¹ Serial No. 75/241,060, filed February 13, 1997, setting forth a first use date for the Class 9 goods of September 1, 1995 and for the Class 41 services of January 1, 1995 and a first use in commerce date for the Class 9 goods of September 1, 1995 and for the Class 41 services of January 5, 1995.

² Although not pleaded in the notice of opposition, opposer, in its brief, also argued the ground of dilution. In view of the testimony taken on this issue during the deposition of Maire Gorman, we consider the pleadings to be so amended and the issue to be before us as one tried by the implied consent of the parties under FRCP 15(b).

³ Opposer's pleaded registrations are:

virtually identical to opposer's mark and the marks are being used on the same and/or closely related goods and services; and that applicant's use and registration of FURIOUS GEORGE is likely to create confusion and deceive purchasers into believing that applicant's goods and

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- 1) Registration No. 1,288,789, issued August 7, 1984, for the mark CURIOS GEORGE for "entertainment services, namely, a television series for children"; Section 8 and 15 affidavits accepted and acknowledged, respectively;
 - 2) Registration No. 1,292,195, issued August 28, 1984, for the mark CURIOS GEORGE for "a series of books for children; coloring books" in Class 16 and "stuffed animals and equipment sold as a unit for playing a board game" in Class 28, Section 8 & 15 affidavits accepted and acknowledged, respectively;
 - 3) Registration No. 1,409,558, issued September 16, 1986, for the mark CURIOS GEORGE for "children's wearing apparel, namely, footwear, sleepwear, robes, earmuffs, and boys and girls knit tops," Section 8 affidavit accepted;
 - 4) Registration No. 1,440,497, issued May 26, 1987, for the mark CURIOS GEORGE and design for "production and distribution of television programming and motion picture films," Section 8 accepted; and
 - 5) Registration No. 2,074,846, issued July 1, 1997, for the mark CURIOS GEORGE for "prerecorded video cassettes and prerecorded audio cassettes for use in telling children's stories."

Opposer's pleaded applications which have since matured into registrations are:

- 1) Registration No. 2,281,854, issued September 28, 1999, for the mark CURIOS GEORGE for "balloons; bean bags; fabric dolls; fabric infant toys; jack-in-the-box; jumping jacks; mechanical action toys; musical toys, toy kits containing interchangeable design stickers; jigsaw puzzles; manipulative puzzles, toy banks and toy vehicles"; and
- 2) Registration No. 2,155,103, issued May 5, 1998, for the mark CURIOS GEORGE for "computer programs and multimedia software recorded on CD-ROM, all for use in telling children's stories and inspiring children to create their own versions."

services originate with or are in some way sponsored or authorized by, or associated with opposer.

Applicant, in his answer, has denied most of the salient allegations of the notice of opposition, although admitting that "applicant's wordmark bears some similarity to Opposer's wordmark" and that "Applicant was and is aware of the wordmark CURIOUS GEORGE." As affirmative defenses applicant asserts his First Amendment rights "in providing his musical group with a name that enables such group to express itself" and the fair use defense, available to applicant under copyright law, "as a product parodist."

The Record

The record consists of the file of the involved application; opposer's trial testimony deposition, with accompanying exhibits, of Maire Gorman, Vice President, Director of Merchandise Licensing and Special Markets of opposer;⁴ certified status and title copies of opposer's

⁴ The deposition transcript has been designated as confidential. However, opposer has attached as an appendix to its brief a compilation of the record which is not designated as confidential and which contains the same deposition testimony. Accordingly, opposer has waived its claim of confidentiality for the deposition contents.

pleaded registrations made of record by notice of reliance;⁵

the discovery deposition of George Tabb, with accompanying exhibits, made of record by opposer by notice of reliance; and copies of newspaper and magazines articles regarding the character Curious George and his creators made of record by opposer by notice of reliance.⁶

Both parties filed briefs, but applicant waived his right to attend the oral hearing and only opposer participated in the hearing.

The Parties

Opposer published the first *Curious George* book in 1941, followed by the six additional books of the original series written by Margret and H.A. Rey in the 1950s and 1960s. All of the seven original books have been published continuously since their initial

⁵ We note that while opposer only pleaded ownership of five registrations and two applications which later became registrations in the notice of opposition, eight registrations have been submitted by notice of reliance. Inasmuch as applicant has failed to object thereto, the eighth registration, Registration No. 2,363,138 is also considered as being of record. This registration issued June 27, 2000 for the mark CURIOUS GEORGE for various goods, (e.g., backpacks and wallets) in Class 18.

⁶ Applicant's notices of reliance have been stricken from the record by the Board's order of January 24, 2001 as being filed outside applicant's testimony period. Opposer's notice of reliance upon the discovery deposition of a non-party has been stricken by the same Board order as not falling within any of the exceptions listed in Trademark Rule 2.120(j).



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