

## US: TRADE MARKS



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## TTAB expands protection for famous marks

In January, in *Weider Publications LLC v D&D Beauty Care Company LLC*, the US Patent and Trademark Office's Trademark Trial and Appeal Board (TTAB) issued a precedential decision which granted a broad range of protection for a mark determined to be famous. D&D Beauty had filed an application seeking to register the mark Shapes for use in connection with a range of beauty-related services. Weider Publications opposed registration of the mark claiming, among other things, a likelihood of confusion with its federal trade mark registrations for the mark Shape covering print and digital magazines in the field of health and fitness.

As a first step in the likelihood of confusion analysis, the TTAB drew the conclusion that Weider Publication's Shape mark was famous based on the continuous use of the mark for over 30 years and an overall audience for the magazine across all platforms of approximately 6 million people a month. The determination that the Shape mark was famous was particularly important because of the impact that fame has in comparing the goods and services under the marks at issue.

The TTAB noted that a determination as to whether a likelihood of confusion exists does not require that the goods and services be similar or even competitive for that matter. Instead, all that is required is that the respective goods and services of the parties be "related in some manner and/or the conditions and activities surrounding the marketing of the goods and/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 source". As it relates to a famous magazine, the TTAB held that the services offered by a defendant could be deemed related to a

plaintiff's magazine if the defendant's services are "of a type normally featured in the plaintiff's magazine and/or there is some type of advertising tie-in between the goods or services of the defendant and those featured in the magazine".

In this connection, the TTAB noted that the record demonstrated that approximately 30% of the advertising in each issue of Shape magazine is for beauty and fashion related products and services, that Weider Publications has cross-promoted its Shape magazine with spa operators and that the magazine features significant beauty-related content. In addition, the TTAB found that both parties market their products towards the same broad base of potential consumers, namely, women within essentially the same age span. Therefore, the TTAB held there to be a likelihood of confusion between the marks and sustained the opposition against D&D Beauty's trade mark application.

This decision is particularly noteworthy as it allowed the owner of a famous mark a broader ability to object to registration by a third party of the identical mark based on the relatedness of the goods and services that the respective parties offer. Parties contemplating the use of a particular mark would, therefore, be wise to evaluate whether such mark is famous in another product or service category prior to adopting it and attempting to register it in a different category.