

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Hearing:
August 10, 2005

Mailed:
December 16, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

MARS, INCORPORATED¹
v.
DAN-DEE INTERNATIONAL LIMITED

Opposition No. 91121237
to Application Serial No. 75598641

Timothy J. Kelly of Fitzpatrick, Cella, Harper & Scinto for
Mars, Incorporated

Marc J. Jason and Neil M. Zipkin of Amster, Rothstein &
Ebenstein LLP for Dan-Dee International Ltd.

Before Hohein, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Mars, Incorporated (opposer) has opposed the
application of Dan-Dee International Limited (applicant),
filed on December 2, 1998, to register PEDIGREE PETS, in
standard-character form, on the Principal Register for
"stuffed toys for children and adults" in International
Class 28. In the application, applicant claims both first

¹ Kal Kan Foods Inc. ("Kal Kan") filed this proceeding. On April
22, 2004, the Board granted its motion to substitute Mars,
Incorporated as opposer in view of the merger of Kal Kan into
Mars, Incorporated and the assignment of all Kal Kan's rights
asserted in this proceeding to Mars, Incorporated.

use and first use in commerce in January 1991. The Board held an oral hearing in this case on August 10, 2005.

The Claims and Defenses

Opposer asserted both likelihood of confusion and dilution as grounds for opposition. Specifically, opposer asserts that applicant's PEDIGREE PETS mark for stuffed toys is likely to be confused with and dilutive of its PEDIGREE mark which it had both used previously and registered previously for pet food and other products including "dolls and toy animals."

In its answer applicant denied the essential allegations in the notice of opposition. Applicant also asserted certain "affirmative defenses." The first three affirmative defenses applicant asserts -- no actual confusion, no similarity between the marks, and different channels of trade -- are not "affirmative" defenses. We will consider the arguments set forth in those defenses in our consideration of the likelihood of confusion claim. Applicant's fourth and fifth affirmative defenses attack the validity of and opposer's ownership of U.S. Reg. No. 611390 which opposer relies upon, but applicant failed either to assert a counterclaim for cancellation of the registration or to provide evidence to contradict opposer's evidence of its ownership of the registration. Consequently, as we explain more fully below, we reject these defenses. See

Food Specialty Co., Inc. v. Standard Products Company, Inc.,
406 F.2d 1397, 161 USPQ 46 (CCPA 1969).

The Record

The record consists of the pleadings, the application file, opposer's trial testimony from Alice Nathanson and rebuttal testimony from Michael Ciorciari, each with related exhibits, opposer's notice of reliance with status and title copies of certain pleaded registrations owned by opposer and opposer's notice of reliance on certain of opposer's interrogatory responses offered under Trademark Rule 2.120(j)(5) in response to applicant's allegedly incomplete submission by notice of reliance on certain of opposer's responses to interrogatories, as well as applicant's testimony of Gary H. Holcomb, with related exhibits.

Factual Background

Mr. Holcomb provided relevant background regarding applicant. Applicant has manufactured plush toys for about thirty years. Applicant is "the largest plush toy manufacturer in the world." Applicant sells the goods at issue here through discount general merchandise chains, discount club stores, drug and grocery chains and specialty stores. Mr. Holcomb further explains that the products actually sold under the PEDIGREE PETS mark are, "an assortment of stuffed toy dogs and cats for children and adults" varying in size from seven to twelve inches. The

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products have a "realistic look" and call to mind "various dog and cat pedigrees." Through Mr. Holcomb's testimony applicant has demonstrated that it first used the PEDIGREE PETS mark in commerce in December of 1989. Applicant also provided evidence establishing continuous use of the mark since that time.²

Ms. Nathanson provided relevant background regarding opposer. Opposer is a leading provider of pet food, related pet products and collateral products. Opposer's predecessor began use of the PEDIGREE mark on pet food in 1930. Kal Kan, opposer's immediate predecessor, acquired the PEDIGREE mark in 1985 and began its own sales of products under the PEDIGREE mark in 1986. Opposer sells its products through discount general merchandise chains, discount club stores, grocery chains, convenience stores and specialty pet-supply stores. The sales under the PEDIGREE mark have been substantial since Kal Kan acquired the mark.³ Opposer's advertising and promotional efforts related to the mark have been varied and the related expenditures have been substantial. The evidence indicates that pet food accounts

² Applicant has provided detailed financial data concerning its sales under a claim of confidentiality. It is unnecessary to refer to any of the confidential information for purposes of this opinion.

³ Opposer also has provided detailed financial data concerning its sales, advertising and promotions through Ms. Nathanson's testimony under a claim of confidentiality. Here too it is unnecessary to refer to any of the confidential information for purposes of this opinion.

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for virtually all of the sales and that pet food is the focus of the advertising and promotional efforts and expenditures related to the PEDIGREE mark.

Opposer also has used the PEDIGREE mark on a wide range of pet products and "collateral" products, including: dog collars, leashes, pet food storage containers, dog carriers, aprons, bandanas, towels, luggage tags and straps, pens, director's chairs, spray bottles, travel mugs, umbrellas, t-shirts, warm-up suits, key chains, pins, toy figures, coloring books, and other items. Ms. Nathanson also indicated that opposer used the PEDIGREE mark on a range of children's toys, including dog and puppy figures representing different dog breeds, trading cards featuring various dog breeds, miniature balls, and other items. Most notably Ms. Nathanson indicated that the PEDIGREE mark was used on stuffed toy dogs, also referred to as "pound puppies."⁴

As mentioned above, opposer has also submitted into evidence status and title copies of its registrations for the PEDIGREE mark and variants of the PEDIGREE mark for pet food and other products. First and foremost, opposer

⁴ Applicant argues that these products were never sold, but merely distributed to customers free of charge. The Trademark Act does not require a sale to establish use of a mark in commerce; the goods may be ". . . sold or transported in commerce." Trademark Act § 45, 15 U.S.C. 1127 (emphasis provided).

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furnished a copy of pleaded Reg. No. 611390, issued August 30, 1955, for the PEDIGREE mark, in standard-character form, for "dolls and toy animals" in International Class 28. This active registration, now owned by opposer, was assigned to Kal Kan, opposer's immediate predecessor, in 1998.⁵

Opposer provided status and title copies of the following additional active registrations it now owns under its notice of reliance:

Reg. No. 284342, issued June 23, 1931, for PEDIGREE, as show here, for "canned dog food";



Reg. No. 1386983, issued March 18, 1986, for PEDIGREE, in standard-character form, for "pet food";

Reg. No. 1574846, issued January 2, 1990, for PEDIGREE, as show here, for "wall calendars sold by mail order featuring large color photographs of various breeds of dogs";



⁵ Applicant points out that opposer acquired Reg. No. 611390 after applicant began use of PEDIGREE PETS. This fact is irrelevant; opposer, as assignee, succeeds to all rights related to the registration.

Reg. No. 1631808, issued January 15, 1991, for PEDIGREE, as shown here, for "pet food";



Reg. No. 1679350, issued March 17, 1992, for PEDIGREE, as shown here, for "periodically published journal pertaining to health care of pets";



Reg. No. 2482566, issued August 28, 2001, for PEDIGREE, in standard-character form, for "journal, books and printed instructional and teaching materials featuring information on toys, games, play things, baby and children's goods, bicycles, tricycles, gymnastic and sporting articles, mounted and unmounted photographs; modeling compounds; arts and crafts paint kits; crayons and chinks; and plastic, iron-on transfers"; and for "games and playthings, namely, board games, ball games, educational board games, gymnastic equipment, namely, vaulting horses, and sporting articles, namely, hockey sticks, baseball bats, baseball gloves and sports balls";

Reg. No. 1834853, issued May 3, 1994, for PEDIGREE, as shown here, for "pet food";



Reg. No. 2008533, issued October 15, 1996, for PEDIGREE BREEDER FORUM, in standard-character form, for "periodically published journal relating to the health care of pets"; and

Reg. No. 2511306, issued November 27, 2001 for PEDIGREE PARK, in standard-character form, for "pet supplies, namely, rawhide chews, animal leashes and collars."⁶

Priority

Priority is not at issue in this proceeding. As opposer states in its reply brief in response to applicant's priority argument, "The obvious hole in this argument, and one that should end the matter, is that Opposer has made of record a PEDIGREE registration (Reg. No. 611390) for goods that encompass the goods set forth in the application." Opposer has, in fact, established its priority simply by pleading and making a status and title copy of Reg. No. 611390 of record showing that the registration is active and that opposer is the owner. King Candy Co. v. Eunice King's

⁶ With its notice of reliance, opposer included five registrations listed here which it did not reference in its pleadings, Reg. Nos. 1631808, 1679350, 1834853, 2008533 and 2511306. Applicant did not object and referred to opposer's registrations as a group in its argument. Therefore, we conclude that the case was tried as to these registrations by consent. However, we emphasize that these five registrations were not necessary for purposes of our decision here.

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Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In fact, the registration opposer relies on here issued in 1955, long prior to both applicant's filing date and its date of first use.⁷

In its answer applicant, as noted above, applicant includes certain "affirmative defenses" to attack opposer's registration (611390) for PEDIGREE for goods encompassing those set forth in the opposed application. Specifically, applicant's FOURTH AFFIRMATIVE DFENSE states that, "Upon information and belief, Registration No. 611,390 was abandoned prior to its assignment to opposer," and applicant's FIFTH AFFIRMATIVE DEFENSE states that, "Upon information and belief, opposer was not a bona fide purchaser of or successor to the rights, title and interest in Registration No. 611,390." Applicant does not offer any argument or evidence in support of these allegations.⁸ At the oral hearing applicant stated that it was not challenging either opposer's ownership of this or any other

⁷ For purposes of establishing priority in this proceeding, it is not necessary that this or any of the other registrations opposer relies upon predate applicant's filing date or first use date. King Candy Co. v. Eunice King's Kitchen, Inc., 182 USPQ at 110.

⁸ During the Nathanson testimony applicant attempted to cross examine the witness regarding Reg. No. 611390. Opposer noted its objection on the ground that the witness had not testified on direct examination with regard to the registration, and therefore, it was not proper subject matter for cross examination. The objection was proper and we sustain it. Nonetheless, even if we had overruled the objection, applicant failed to elicit any testimony in the cross examination following the noted objection which would invalidate the registration.

registration opposer is relying on or the validity of this or any other registration opposer is relying on.

Most importantly, as noted above, as Judge Rich observed in the Food Specialty case cited above, "We think it sufficient merely to point out that the validity of the registration of a mark may be tested only by a cancellation proceeding." Food Specialty Co., Inc. v. Standard Products Company, Inc., 161 USPQ at 46. Applicant has not done so here through a counterclaim or through a separate petition to cancel. Nor has applicant presented any evidence to contradict opposer's evidence that it is the owner of Reg. No. 611390. Accordingly, opposer's registration for the PEDIGREE mark for "dolls and toy animals," as well as the other registrations it relies on, are entitled to the presumption of validity provided for in Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

Our discussion of likelihood of confusion, which follows, will focus on Reg. No. 611390 because the registration covers goods identical to those identified in the opposed application.

Likelihood of Confusion

The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors we may consider in determining likelihood of confusion. We must determine the issue of likelihood of

confusion case by case based on the evidence of record relating to the factors. In re Majestic Distilling Co., 315 F.3rd 1301, 65 USPQ2d 1201, 1203-04 (Fed. Cir. 2003). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the parties. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

The Goods and Channels of Trade

Regarding the goods, the focus of our inquiry must be the goods as identified in the registration opposer relies upon and the goods identified in the opposed application. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). Applicant's goods are identified as "stuffed toys for children and adults." Opposer's goods are identified as "dolls and toy animals."⁹ The goods in both the application and registration logically include stuffed toy animals for children and adults. Therefore the goods, as identified, are identical. In fact, the evidence shows that the actual goods of both parties include stuffed toy animals for children and adults.

⁹ As noted above, our discussion will focus on Reg. No. 611390 which identifies these goods.

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Applicant also argues that the channels of trade for the parties' products are distinct. Specifically, applicant states that, "Opposr's goods are sold in pet stores and the pet food areas of supermarkets and the like. Dan-Dee's goods are sold in the plush toy departments of stores." Here also, in evaluating the channels of trade, we must consider the goods as described in the application and registration and, in the absence of any restrictions in the channels of trade in either, assume that they travel in all trade channels appropriate for the goods. CBS Inc. v. Morrow, 218 USPQ at 199; In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). Because both the application and registration include identical goods, and because no trade-channel restrictions are specified in either, we conclude that the channels of trade for the goods of applicant and opposer are identical.

Finally with regard to the goods, opposer argues that the goods are inexpensive and that purchasers would exercise a lower degree of care in purchasing them, leading to a greater likelihood of confusion. Applicant has not addressed this point directly. Based on the record with regard to the goods, we conclude that the goods at issue here are inexpensive and that purchasers would generally exercise a lower degree of care in selecting such goods. Thus the nature of the goods would enhance the likelihood of

confusion. While this factor favors opposer, it is by no means necessary to reach our overall conclusion regarding the likelihood of confusion.

The Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Furthermore, we note our determination that the goods of the parties are identical and that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

Applicant's discussion of the marks is minimal and devoted nearly exclusively to the differences in the presentation of the marks as used on the parties' labels and packaging. However, both the opposed application and the principal registration relied upon by opposer (Reg. No. 611390) present the marks in standard-character form. Therefore, we must consider, and we have considered, the standard-character form of both marks for purposes of this proceeding. In considering the standard-character form, we

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must assume that the marks may be presented in any reasonable manner of display. In re Melville Corp., 18 USPQ2D at 1387-88. Therefore, in this case, where both marks are in standard-character form, we must assume that both parties' marks could be presented in the same form. In fact, the examples of the displays applicant includes in its brief show the word portions of the marks, PEDIGREE and PEDIGREE PETS, to be quite similar in display. This illustrates that the marks could be displayed in similar or even identical fashion.

Appearance - While there is a difference between the marks PEDIGREE and PEDIGREE PETS, as noted by applicant, we believe that the marks are highly similar in appearance. Opposer's entire mark is PEDIGREE. Applicant merely adds PETS to form applicant's mark. In this case as in many others, the first term in the mark is most important in evaluating similarity. Palm Bay Imports, Inc. v. Veuve Clicquot, 73 USPQ2d at 1690. See also Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1897 (TTAB 1998) ("It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

Furthermore, as we noted above, applicant indicates that its "stuffed toys for children and adults" include stuffed dogs and cats with a realistic look. In discussing the product concept, Mr. Holcomb states that, "The

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philosophy was to make a specific pedigree and every executive wanted the pedigree to be the same as their pet." Thus, "pet" is a highly suggestive as used in applicant's mark. While we are obligated to view the marks overall, and we have, it is appropriate to consider the relative impact of distinct elements within a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). In this case, "PETS" is highly suggestive and insufficient to distinguish the marks in appearance or otherwise.

Sound - As to sound, here too the inclusion of "PETS" in applicant's mark is insufficient to distinguish the marks.

Connotation - The marks are also highly similar in connotation. Both marks convey the idea that the goods relate to breeds of animals, in particular, pets. Therefore, we conclude that the marks are highly similar in connotation.

Commercial Impression - The marks are also highly similar in their overall commercial impression for essentially the same reasons that we conclude that they are similar in connotation. Because both marks are in standard-character form, there is no element, other than the words, which can contribute to the commercial impression. The goods of the parties are also identical; this precludes any variation in either connotation or commercial impression

resulting from differences in the goods. As a result, the commercial impressions of the marks are highly similar.

Accordingly, we conclude that the marks of the parties are highly similar.

Strength and Fame of Opposer's Mark

Opposer has argued that its PEDIGREE mark is not only strong but famous. Applicant, on the other hand, argues that opposer's PEDIGREE mark is weak.

Opposer's evidence of the strength and fame of its mark consists principally of sales figures roughly from 1989 through 2003 and advertising and promotional expenditures from a similar period with numerous examples of a wide range of advertisements and promotions. The sales, advertising and promotional figures relate nearly exclusively to pet food. The obvious focus of the advertising and promotional activities is also pet food. The record undoubtedly establishes that the PEDIGREE mark has achieved a degree of renown for the period covered by the evidence with respect to pet food. That renown would entitle opposer to claim a broader scope of protection than would otherwise apply for its mark. Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Under the circumstances, it is reasonable to conclude that the scope of protection for the PEDIGREE

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mark used on pet food would extend to such collateral goods as "stuffed toys for children and adults" which resemble certain breeds of pets. We thus conclude that the fame factor favors opposer. However, we hasten to add that the conclusion we draw here with regard to the fame factor is by no means necessary in reaching our overall conclusion regarding likelihood of confusion in view of the conclusions we have stated with regard to the goods and the marks.

Opposer has also asserted that, "There is no evidence of third party registrations or ongoing use of record in this proceeding."¹⁰ Applicant argues that, "Notwithstanding that the PEDIGREE mark may be commercially strong in the pet food and pet product market due to strong sales and extensive advertising expenditures, Opposer's PEDIGREE mark is not strong in the area of plush toys and stuffed animals for children and adults."

As to applicant's assertion that opposer's use of its PEDIGREE mark in the plush toy field is limited, the only support applicant offers to establish that the PEDIGREE mark is weak are references to nine alleged third-party registrations for marks which include PEDIGREE, all for goods other than pet food, pet products or toys of any kind. In its reply brief, opposer has objected to this evidence on

¹⁰ Opposer has also provided some examples of its efforts to police its rights in the PEDIGREE mark which tends to support its contention that the mark is strong.

the grounds that the registrations were not made of record during applicant's testimony period. In fact, applicant never made copies of the registrations of record; rather, applicant merely provided a list of the registrations in the text of its brief with limited information as to each. We have not considered this evidence because it is both untimely and not in acceptable form.¹¹ Thus there is nothing in the record to contradict opposer's evidence that its PEDIGREE mark is strong and well known. Accordingly, based on the entire record, we conclude that opposr's PEDIGREE mark is both strong and well known.

Actual Confusion

Applicant also argues that there has been no actual confusion between the PEDIGREE and PEDIGREE PETS marks over the nearly fourteen years they have allegedly coexisted. In asserting so applicant relies on its own witness as well as Ms. Nathanson's testimony that neither is aware of any actual confusion. Indeed, there is no evidence in the record of actual confusion. However, while applicant asserts that the two products have coexisted in the marketplace for approximately fourteen years, the record does not indicate that there has been a true opportunity for actual confusion, for example, as a result of the marketing

¹¹ See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230, 1231-32 (TTAB 1992) and additional authorities cited in TBMP § 704.03(b)(1)(B) (2d ed. 2004)

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of products, specifically both parties' plush or stuffed toy animals, under the marks in the same geographic areas and through the same channels of trade. The testimony of opposer's rebuttal witness, Mr. Ciorciari, has some relevance here. He testified that he was unable to locate applicant's products in ten Wal-Mart stores in the New York metropolitan area in spite of applicant's testimony that its products were then being sold in every Wal-Mart store.

The Federal Circuit has taken a skeptical view of statements asserting the absence of actual confusion stating that, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted) . . ." Majestic, 65 USPQ2d at 1205. See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Also, we agree with opposer's observation that the products at issue here are inexpensive and that it is reasonable to conclude that consumers are unlikely to report instances of confusion as to such inexpensive products. In re Sunmarks Inc., 32 USPQ2d 1470, 1473 (TTAB 1994). Accordingly, we conclude that the "actual confusion" factor is neutral in this case.

In conclusion, we have considered all evidence of record in this case bearing on the du Pont factors and

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conclude that there is a likelihood of confusion between opposer's mark and applicant's mark. In reaching this conclusion we attach primary importance to the high degree of similarity between the marks and the fact that the goods of the parties are identical.

Dilution

Opposer also asserts dilution as a ground for opposition. In view of our decision to sustain the opposition on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim.

Decision: The opposition is sustained on the ground of likelihood of confusion and registration is refused.