

Hearing:
August 21, 2008

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
December 2, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Black Dog Tavern Company, Inc.

v.

Joseph J. Juras

Oppositions Nos. 91152364 and 91153557
against Serial Nos. 75510968 and 75518819

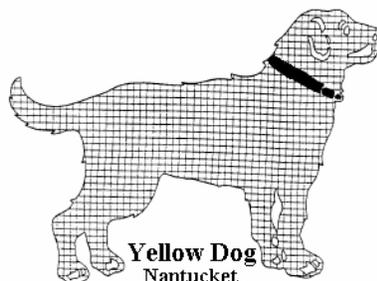
Emily LaPointe of The Black Dog Tavern Company, Inc., and
John L. Welch of Lowrie, Lando & Anastasi, LLP for The
Black Dog Tavern Company, Inc.

Daniel T. Earle and James E. Shlesinger of Shlesinger
Arkwright & Garvey LLP for Joseph J. Juras.

Before Bucher, Walsh and Mermelstein, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Joseph J. Juras seeks registration on the Principal
Register of the mark **YELLOW DOG NANTUCKET** (*in standard
character format*) for "clothing, namely, t-shirts,
sweatshirts, pants, sweatpants, caps, hats, socks,
underwear, boxer-shorts, visors, and jackets" in
International Class 25; and for the following mark:



for goods, as amended, ultimately limited to "T-Shirts" in International Class 25.¹

In this consolidated proceeding, The Black Dog Tavern Company, Inc. has opposed both applications filed by Mr. Juras on the ground of priority of use and likelihood of confusion, alleging that applicant's marks, when used in connection with the recited goods, so resemble its word mark **THE BLACK DOG** and its standing black dog design mark, both shown in the registrations listed below, as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d):

THE BLACK DOG	for "restaurant and bakery shop services" in International Class 42; ²
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¹ Application Serial No. 75510968 was filed on June 30, 1998 based upon applicant's claims of first use anywhere and first use in commerce at least as early as July 3, 1997. Applicant does not claim rights to the word "Nantucket" apart from the mark as shown. This application inadvertently issued on May 31, 2005 as Reg. No. 2956378, but was cancelled because the instant opposition had been timely filed with the Trademark Trial and Appeal Board.

Application Serial No. 75518819 was filed on July 9, 1998 based upon applicant's claims of first use anywhere and first use in commerce at least as early as July 3, 1997. Applicant does not claim rights to the word "Nantucket" apart from the mark as shown. The mark is lined for the color yellow and color is claimed as a feature of the mark.

² Registration No. 1559349 issued on October 3, 1989; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for "restaurant and bakery shop services" in International Class 42;³

THE BLACK DOG

for "tinned cookies and bakery goods" in International Class 30;⁴



for "clothing, namely, hats, t-shirts, sweatshirts and shorts" in International Class 25;⁵

THE BLACK DOG

for "printed matter, namely catalogues published periodically featuring clothing, food, jewelry, toys and gift items" in International Class 16;⁶

THE BLACK DOG

for "wine" in International Class 33;⁷



for "jewelry, namely, pins, charms, pendants; wall clocks" in International Class 14;⁸

THE BLACK DOG

for "clothing, namely, hats, t-shirts, sweaters, vests, polo shirts, chambray shirts, denim shirts, tank tops, jackets, pants, dresses, skirts, pajamas, belts, boxer shorts, and aprons; children's

³ Registration No. 1561546 issued on October 17, 1989; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁴ Registration No. 1593194 issued on April 24, 1990; renewed.

⁵ Registration No. 1620023 issued on October 30, 1990; renewed.

⁶ Registration No. 1882153 issued on March 7, 1995; renewed.

⁷ Registration No. 2000492 issued on September 17, 1996; renewed.

⁸ Registration No. 2393737 issued on October 10, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

	rompers, onesies, sweatshirts, t-shirts, sweatshirts, hats, shorts and jackets" in International Class 25; ⁹
THE BLACK DOG	for "tote bags; all-purpose field bags; carry-on bags; duffle bags; umbrellas; insulated picnic bags; pet equipment, namely, pet coats, pet leashes, and pet collars" in International Class 18; ¹⁰
THE BLACK DOG	for "mugs; pet bowls; water bottles sold empty; ice buckets" in International Class 21; ¹¹
THE BLACK DOG	for "stuffed toy dogs; golf balls; plastic flying discs" in International Class 28; ¹²
	for "china dishes; mugs; pet bowls; water bottles sold empty; beverage glassware; ice buckets; and coasters, not of paper or of table linen" in International Class 21; ¹³

⁹ Registration No. 2393742 issued on October 10, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁰ Registration No. 2396057 issued on October 17, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹¹ Registration No. 2396058 issued on October 17, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹² Registration No. 2396059 issued on October 17, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹³ Registration No. 2398106 issued on October 24, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

	for "tote bags; all-purpose field bags; carry-on bags; duffle bags; umbrellas; insulated picnic bags; pet equipment, namely, pet coats, pet leashes, and pet collars" in International Class 18; ¹⁴
	for "playing cards" in International Class 16; ¹⁵
	for "stuffed toy dogs; golf balls" in International Class 28; ¹⁶
	for "beach towels; golf towels; burgees and flags made of cloth; tablecloths; placemats and napkins made of textiles; dish towels; oven mitts; and bandanas" in International Class 24; ¹⁷
THE BLACK DOG	for "beach towels; golf towels; burgees and flags made of cloth; tablecloths; placemats and napkins made of textiles; dish towels; oven mitts; and bandanas" in Int. Cl. 24; ¹⁸

¹⁴ Registration No. 2398107 issued on October 24, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁵ Registration No. 2408614 issued on November 28, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁶ Registration No. 2410612 issued on December 5, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁷ Registration No. 2436745 issued on March 20, 2001; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁸ Registration No. 2436746 issued on March 20, 2001; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for "rugs and doormats" in International Class 27;¹⁹

THE BLACK DOG

for "rugs and doormats" in International Class 27;²⁰

The Black Dog

for "clothing, namely, hats, t-shirts, sweaters, vests, polo shirts, chambray shirts, denim shirts, tank tops, jackets, pants, dresses, skirts, pajamas, belts, boxer shorts, bathing suits and aprons; children's rompers, children's underwear, sweatshirts, t-shirts, sweatshirts, hats, shorts, and jackets" in International Class 25;²¹

THE BLACK DOG

for "retail store services in the field of clothing and general merchandise; online and catalog ordering services in the field of clothing and general merchandise" in International Class 35;²²



for "retail store services in the field of clothing and general merchandise; online and catalog ordering services in the field of clothing and general merchandise" in International Class 35;²³

THE BLACK DOG

for "cocoa" in International Class 30;²⁴

¹⁹ Registration No. 2487428 issued on September 11, 2001; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²⁰ Registration No. 2487429 issued on September 11, 2001; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²¹ Registration No. 2842709 issued on May 18, 2004.

²² Registration No. 3005863 issued on October 11, 2005.

²³ Registration No. 3008791 issued on October 25, 2005.

²⁴ Registration No. 3014309 issued on November 15, 2005.

THE BLACK DOG



for "coffee" in Int. Class 30;²⁵ and
for "coffee" in International Class 30;²⁶

The record is also replete with images supporting opposer's allegations of common law usage, over the years, of composite marks consisting of various combinations of these registered marks in connection with clothing, housewares, toys, gifts and other merchandise, as well as in connection with retail store services, online and catalog ordering services, and restaurant and bakery shop services.



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Opposer also claims that Mr. Juras committed fraud on the United States Patent and Trademark Office in the filing of these applications.

²⁵ Registration No. 3085458 issued on April 25, 2006.

²⁶ Registration No. 3090049 issued on May 9, 2006.

²⁷ Opposer's web pages, "The General Store," from 2002.

²⁸ Douglas Dep. March 27, 2007, Exhibit 5.

²⁹ Douglas Dep. March 27, 2007, at 23 - 28; Exhibit 8.

Applicant, in his answers, denied all the essential allegations of these claims.

The parties have fully briefed the issues in these oppositions, and counsel for both parties appeared before this panel of the Board at an oral hearing held at the United States Patent and Trademark Office on August 21, 2008.

I. THE RECORD

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the records of these combined proceedings include the pleadings and the files of the involved applications.

The records also include the following evidence:

A. Opposer's Evidence

1. The testimony deposition taken March 27, 2007 of Robert S. Douglas, Jr., with accompanying exhibits, including opposer's registrations. Mr. Douglas is the son of the founder of opposer, and serves currently as opposer's Chief Executive Officer.
2. Opposer's March 30, 2007 Notice of Reliance, having the transcript of the discovery deposition of applicant, Joseph J. Juras, taken October 18, 2006, with Exhibits 1-6; applicant's supplemental

answers nos. 19-20 to opposer's first set of interrogatories to applicant; and applicant's responses, nos. 11-40 to opposer's request to applicant for admissions;

3. Opposer's November 2, 2007 rebuttal testimony transcript of Robert S. Douglas Jr. with opposer's accompanying Exhibits 1-2; and
4. Opposer's November 13, 2007 Notice of Reliance, having a letter from the Office of the Commissioner for Trademarks dated October 21, 2005 with an attached Cancellation Order; reference to Cape Cod and Islands from Wikipedia; pages from *INSIDERS' GUIDE, CAPE COD AND THE ISLANDS*; Massachusetts Registry of Motor Vehicles; a reference to "Cape Cod and the Islands" in *NATIONMASTER-ENCYCLOPEDIA*; and reference to "The Black Dog" from Wikipedia.

B. Applicant's Evidence

1. Applicant's Notice of Reliance filing on July 31, 2007 having one hundred eighty-one third-party registrations; a copy of applicant's U.S. Registration No. 2485108; and opposer's responses to interrogatory nos. 8 and 18, and supplemental responses to interrogatory nos. 9 and 10; and

2. Applicant's July 26, 2007 deposition of Joseph J. Juras, with Applicant's Exhibits 1-81, through Notice of Filing of Testimonial Transcript, dated February 21, 2008.

II. PRELIMINARY MATTERS:

Applicant objects to five separate items submitted under opposer's rebuttal Notice of Reliance of November 13, 2007, alleging that these items comprise improper rebuttal evidence. Rather than serving as proper rebuttal evidence, applicant argues that this evidence is merely submitted in order to strengthen opposer's case-in-chief, and hence, should be stricken from the record.

We find that opposer appropriately placed this rebuttal evidence into the record in order to demonstrate for anyone who may not know from the geography of Massachusetts the proximity of Nantucket to Martha's Vineyard and other locations on the Cape having one of opposer's general store locations. Mr. Juras testified that he had never heard of opposer or its marks in spite of having lived and worked in Nantucket. He then argues in his brief that Martha's Vineyard and Nantucket are "separate islands with two separate names, that do not sound or look alike." (Applicant's Brief at 26). Because applicant has attempted to create a sense of distance between Nantucket and Martha's Vineyard, rebuttal

evidence going to the proximity of Nantucket to Martha's Vineyard is appropriate.

Having determined that this general subject area is appropriate for rebuttal evidence, we look further at applicant's objections to the reliability of the reliability of Wikipedia website evidence. The *NATIONMASTER-ENCYCLOPEDIA'S* reference to "Cape Cod and the Islands"³⁰ suffers from the same complaint that applicant lodged against "Cape Cod and Islands"³¹ from the Wikipedia website. While we have in the past noted the inherent problems regarding the reliability of purported evidence drawn from wiki-type sites, we find that these two articles merely corroborates information already

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Geography

"... To the south [of Cape Cod] lie Nantucket Sound; Nantucket and Martha's Vineyard (both large islands) ..."

Tourism

Although Cape Cod is inhabited all year round, it experiences a tourist explosion each summer between Memorial Day and Labor Day, as the New England cold gives way to a brief but comfortable summer. Many businesses are specifically targeted to the visitors, and close during the "off-season" (roughly 8 to 9 months per year) ..."

Islands off Cape Cod

Like Cape Cod itself, the islands off Cape Cod have turned from being natural, whaling, and trading areas to resort destinations, attracting old wealthy families, and prosperous tourists alike. The islands include Nantucket and Martha's Vineyard ... Several prominent families have established compounds or estates on the larger islands, making these Cape Cod offshore islands some of the wealthiest resorts in the Northeast, yet they retain much of the early merchant trading and whaling culture."

<http://www.nationmaster.com/encyclopedia/Cape-Cod-and-Islands>.

³¹

http://en.wikipedia.org/wiki/Cape_Cod_and_Islands

in the record³² or sources on which we can take judicial notice, such as the *Columbia Encyclopedia* (Sixth Edition),³³ or even opposer's *INSIDERS' GUIDE®*, *CAPE COD AND THE ISLANDS*, The Globe Pequot Press (6th Edition 2004). A copy of what appears to be this book's frontispiece is a map showing the geographical proximity of (1) the Cape, (2) Martha's Vineyard, and (3) Nantucket.



Later entries of shopping and restaurants located on the Cape and the Islands list and describe several of opposer's retail locations in Martha's Vineyard, Falmouth, etc.

³² It is clear that Martha's Vineyard and Nantucket are neighboring, well-known resort and vacation islands that along with Cape Cod are often referred to as "The Cape and the Islands "or" Cape Cod and the Islands

"Nantucket is approximately ten miles to the southeast and [this region] is often referred to on maps and charts as Cape Cod and the islands. Both islands are famous destinations, summer destinations.").

(Testimonial Deposition of Robert S. Douglas, Jr. on March 27, 2007 at 14.

³³ **Martha's Vineyard:** SE Mass., separated from the Elizabeth Islands and Cape Cod by Vineyard and Nantucket sounds ... In the late 1800s the island, with its harbors, beaches, and scenic attractions, developed into a summer resort.

<http://www.bartleby.com/65/ma/MarthasV.html>

Nantucket: SE Mass., lying c.25 mi (40 km) S of Cape Cod, from which it is separated by Nantucket Sound. Muskeget Channel is located between Nantucket and Martha's Vineyard to the west... Nantucket was a major whaling port until the decline of the industry (c.1850), and it later developed into a well-known resort and artists' colony...

<http://www.bartleby.com/65/na/Nantucke.html>



The Massachusetts Registry of Motor Vehicles issues license plates demonstrating that "Cape Cod & Islands" are often considered together.³⁴

This information, contained in these websites, is "not subject to reasonable dispute" and is "capable of accurate and ready determination." See Fed. R. Evid. 201(b).

We turn then to applicant's final objection, namely an entry from Wikipedia for "The Black Dog" Tavern Company, Inc.:

The Black Dog

From Wikipedia, the free encyclopedia

The Black Dog is a restaurant and tavern in Vineyard Haven on the island of Martha's Vineyard. The restaurant became well known for its souvenir t-shirts, featuring its logo of the eponymous black dog. They subsequently expanded to sell other products with the same logo.

The Black Dog t-shirts became well-known during the 90s as photographs of celebrities wearing the shirts began appearing in national publications. For example, a photograph of then-President Bill Clinton jogging while wearing one was distributed by national wire services.

Marketing at The Black Dog was effective. During the early 90s, the merchandise was only sold at the Martha's Vineyard location. Only a limited number of people were allowed in the store at one time, so lines formed down the wooden fenced ramp that ran from the front door. While waiting in line, visitors were given catalogs to browse. Nowadays, the merchandise is also available at "mainland" Cape Cod and Newport "Black Dog" stores as well as online.³⁵

³⁴ <http://www.mass.gov/rmv/express/cape.htm>

³⁵ http://en.wikipedia.org/wiki/The_Black_Dog

Applicant questions in particular the reliability of this information, inasmuch as this wiki entry had last been modified only eight days before opposer's Notice of Reliance was filed. While this entry draws on many of the same public source citations used herein, and there is really nothing in this entry that is not otherwise corroborated elsewhere in the record, we acknowledge that applicant had no opportunity to rebut the specific conclusions (e.g., opinion of the author as to the success of opposer's marketing, the renown of opposer's T-shirts, etc.) in this wiki entry. Accordingly, we have not considered the contents of this article in reaching our decision herein.

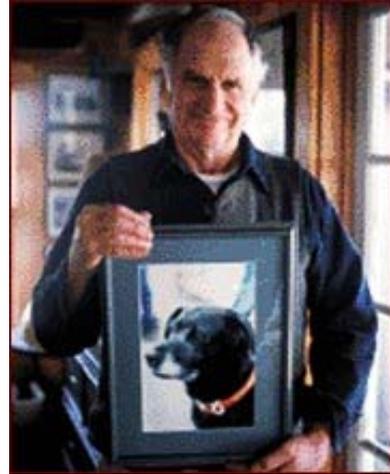
III. *FACTUAL FINDINGS*

The record establishes the following facts in this case.

Opposer -- The Black Dog Tavern Company, Inc.

Captain Robert Douglas, Sr. founded The Black Dog

Tavern Company on Martha's Vineyard, Massachusetts. He named the company and the tavern after his pet Labrador-boxer mix "Black Dog." Since January 1971, opposer has used its standing dog design and THE BLACK DOG marks for restaurant and bakery shop services.



Soon thereafter, opposer began using these marks for a wide range of retail store, gift and clothing items. The single-page Black Dog retail mailer of 1987 soon gave way to The Black Dog Catalogue. By 1992, it was necessary to build a new Black Dog General Store, opening in 1993. What began as a restaurant and bakery business in 1971 has over the past two decades blossomed into a most successful retail and dining services company, identified by opposer's signature marks. Opposer sells the many clothing and gift items listed above under its marks nationally through its printed catalog,³⁷ on its www.theblackdog.com website (launched in the year 2000),³⁸ and at its seventeen retail stores in Massachusetts, Rhode Island, Maine and

³⁶ Douglas Dep. March 27, 2007, Exhibit 5; <https://www.theblackdog.com/OurFamily.aspx> as accessed by opposer on March 26, 2007.

³⁷ Douglas Dep. March 27, 2007, at 29 - 50.

³⁸ Douglas Dep. March 27, 2007, at 24,

Connecticut -- including a store in Nantucket, Massachusetts.³⁹ As we will see in more detail later, opposer's marks have enjoyed substantial exposure in the media and have become well-known to the general public. While the dollar volume of its sales of retail products has overtaken its dining services, opposer continues to offer dining services at The Black Dog Tavern and at its bakeries in Vineyard Haven, Massachusetts.



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³⁹ Douglas Dep. March 27, 2007, at 21 - 22, 26 - 27, 82.

⁴⁰ Douglas Dep. March 27, 2007, Exhibit 5; <https://www.theblackdog.com/Cafe.aspx> and <https://www.theblackdog.com/Bakery.aspx> as accessed by opposer on March 26, 2007.

Applicant -- Joseph J. Juras

Mr. Juras adopted his **YELLOW DOG NANTUCKET** mark and applied it to T-Shirts, claiming to have sold a dozen shirts in Nantucket in the summer of 1997. He filed the two involved applications a year later. Since that time, applicant claims to have sold a large volume of T-shirts throughout the United States, and alleges expansion (since around 1999) into other items of clothing, such as caps, visors, sweatshirts, hats, socks, pants, shorts and boxer shorts. Applicant sells his merchandise over the Internet at www.yellowdognantucket.com. The website's "Yellow Dog Store" offers clothing items such as caps, shirts and visors, a large oval sticker, a beach bag, coffee, wine, a large sign showing a standing yellow dog, a children's book about the Yellow Dog of Nantucket, etc.⁴² However, other than his often vague and sometimes contradictory testimony,⁴³ applicant's initial invoice for twelve shirts⁴⁴ and his

⁴¹ Douglas Dep. March 27, 2007, Exhibit 5; <https://www.theblackdog.com/Cafe.aspx> as accessed by opposer on March 26, 2007.

⁴² Juras Dep. July 26, 2007, at 11 - 26.

⁴³ Compare the contents of the July 26, 2007 testimony deposition of Joseph J. Juras with the discovery deposition of Joseph J. Juras, taken October 18, 2006, at 11 - 88.

⁴⁴ Juras Dep. July 26, 2007, Exhibit 1.

demonstration of a presence on the Internet⁴⁵ comprise the strongest evidence he has produced in this proceeding to support the conclusion that he is operating an ongoing, commercially-viable retail business.

IV. ANALYSIS

A. Standing

Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer has submitted evidence of its ownership of its various registrations for **THE BLACK DOG** and the dog design covering a wide range of goods and services, including clothing items, as well as proof of its common law usage of the **THE BLACK DOG** and the dog design marks. This evidence

⁴⁵ Juras Dep. July 26, 2007, Exhibit 11.

is sufficient to establish opposer's interest and, therefore, standing, in this proceeding.

B. Priority

Because opposer has established that it owns valid and subsisting registrations of its pleaded marks, priority is not an issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

As to opposer's common law use of its marks in connection with a variety of goods and services, including clothing items, opposer has demonstrated use at least as early as the summer of 1989.⁴⁶ This date precedes applicant's filing date (June 30, 1998) or any other date on which applicant can rely based on its testimony of record. In light of this evidence, we award priority to opposer herein.

C. Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination must be based upon our analysis of all of the probative

⁴⁶ Douglas Dep. March 27, 2007, Exhibit 8A (cover of Summer 1989 catalog).

facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Commercial strength of opposer's marks

If proved, the renown of the prior mark plays a dominant role in the likelihood of confusion analysis. *Bose Corp. v. QSC Audio Prod. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Vieve Clicquot*

Ponsardin Maison Fondée En 1722, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

With significant sales, extensive advertising and continuous use of Opposer's marks for almost thirty years for dining services and over two decades on a wide range of merchandise, and given the ongoing, favorable publicity opposer's services and products have received, we find that opposer's marks have achieved a degree of fame, and serve as strong indicators of source for Opposer's products and services. Specifically, the record shows that:



- Opposer has advertised extensively in a wide range of publications including *Audubon*, *Better Homes and Gardens*, *Bon Appetit*, *The Boston Globe*, *Esquire*, *House and Garden*, *Martha Stewart Living*, *The New York Times*, *The New Yorker*, *Rolling Stone Magazine* and *The Wall Street Journal*;⁴⁸

⁴⁷ Douglas Dep. March 27, 2007, Exhibit 3F (Martha's Vineyard Chamber of Commerce flier of 1977).

⁴⁸ Douglas Dep. March 27, 2007, at 66 - 67; Exhibit 12.

- sales of this "Vineyard conglomerate" from 1987 to 2006 were approximately \$150 million;⁴⁹
- during this same period, opposer spent more than \$15 million in promotional expenditures;⁵⁰
- In 2006 alone, Opposer mailed out approximately 378,000 of its catalogues;⁵¹
- Opposer has been recognized in numerous publications including *The Boston Globe*, *The New York Times*, *USA Today* and *The Washington Post*, which said:



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“...What the Lacoste alligator shirt was to the 1970s, and Ralph Lauren’s polo pony to the ‘80s, the Black Dog threatens to become to the ‘90s”⁵³

⁴⁹ Douglas Dep. March 27, 2007, at 72.

⁵⁰ Douglas Dep. March 27, 2007, at 71 - 72.

⁵¹ Douglas Dep. March 27, 2007, at 50.

⁵² Douglas Dep. March 27, 2007, Exhibit 2A (“Legend of The Black Dog”).

⁵³ Douglas Dep. March 27, 2007, Exhibit 14I (“Martha’s Vineyard, Putting On the Dog,” *The Washington Post*, August 31, 1994, article on front page of Style section at C1).

The Boston Globe Magazine

JULY 23, 1995

Putting on the dog 17

The Black Dog has become an unofficial logo on Martha's Vineyard and an antifashion statement elsewhere.

By John Budris



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- Photographs and articles have shown that celebrities, including former President Bill Clinton,⁵⁵ and household names such as Brooke Shields,⁵⁶ Matthew Perry,⁵⁷ Tom Welling,⁵⁸ Billy Joel, Henry Winkler and Spike Lee have been known to wear merchandise featuring prominently

⁵⁴ Douglas Dep. March 27, 2007, Exhibit 14F.

⁵⁵ Douglas Dep. March 27, 2007, Exhibit 15A.

⁵⁶ Douglas Dep. March 27, 2007, Exhibit 15B.

⁵⁷ Douglas Dep. March 27, 2007, Exhibit 15C.

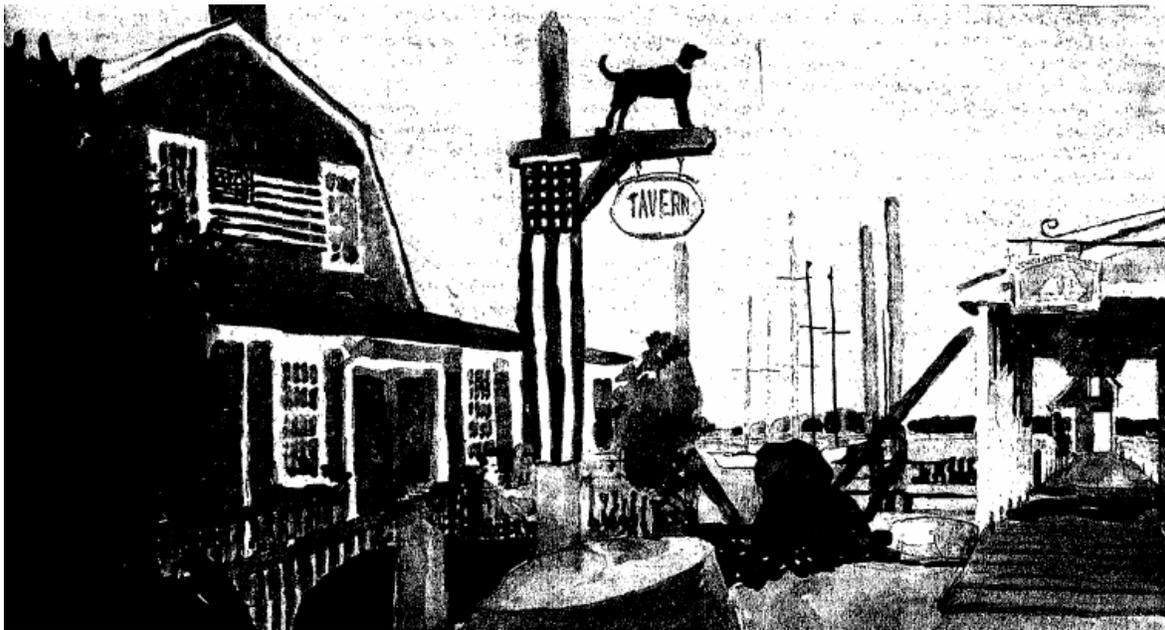
⁵⁸ Douglas Dep. March 27, 2007, Exhibit 15D.

the silhouette of a standing Labrador-boxer mix
and/or the words, **THE BLACK DOG**.⁵⁹

Based on the totality of this record, we find that
opposer has created a most successful marketing strategy for
its brand. Robert L. Bowden's book of watercolors entitled
"On Martha's Vineyard," depicting scenes from this popular
island destination⁶⁰ includes "The Black Dog Tavern" with an
insightful quotation:

*27. THE BLACK DOG TAVERN
2002, watercolor, 16½" x 10½"*

T*he famous Black Dog.
Is there anything more to be said?*



Inasmuch as the word "famous" is a term-of-art in the
field of trademark law, we do not find it necessary to adopt

⁵⁹ Douglas Dep. March 27, 2007, at 20, 83 - 84.

⁶⁰ Douglas Dep. March 27, 2007, Exhibit 16C.

Bowden's exact characterization, but we do find that opposer's brand is well-known for dining services and retail merchandise in the area of Cape Cod and the islands, and has managed to develop a following among trend-setters coast-to-coast. Opposer's T-Shirt with the silhouette of a standing lab is the item featured most prominently on its website and in its catalogues, and is the item often worn by celebrities that catches the photographers' lenses. Composite marks consisting of combinations of the standing dog design, the words **THE BLACK DOG**, and "Martha's Vineyard," "Nantucket," or other place names having opposer's general stores, all blended together with opposer's New England aura, reinforce the connection between this imagery and The Black Dog Tavern Company of Martha's Vineyard.

Accordingly, with respect to the commercial strength of opposer's marks - that is, the degree of renown **THE BLACK DOG**, the standing dog design, as well as their combination, often in conjunction with references to popular vacation spots on the Cape and the islands, may have acquired on the basis of opposer's use and promotion - we conclude that opposer's signature marks comprise well-known, commercially-strong marks as applied to restaurant services and collateral merchandise, including specifically T-shirts.

Hence, this factor strongly favors a finding of likelihood of confusion.

The goods and services

The goods as identified by the respective applications⁶¹ and registrations are identical in part, and otherwise, are all closely related. As seen on the parties' respective websites, both opposer and applicant are promoting many of the same types of goods, i.e., items usually marketed to tourists on a summer beach vacation.

Hence, this *du Pont* factor favors the position of opposer herein. And of course, when marks would appear on virtually identical goods, the degree of similarity in the marks necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. V. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700-01 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

Trade channels and Conditions of sale

Considering the parties' respective goods and services as identified in the applications and cited registrations,

⁶¹ In Application Serial No. 75510968, the identical goods to opposer's registrations include t-shirts, sweatshirts, pants, sweatpants, caps, hats, boxer-shorts and jackets. Opposer has demonstrated common law usage of its marks on socks and visors. In Application Serial No. 75518819, the goods in common are limited to T-shirts.

Registrant's most relevant registrations are Reg. Nos. 1620023, 2393742, 2842709, 3005863 and 3008791.

it is clear that they are all offered to the same classes of ordinary purchasers - members of the general public. The common goods, such as T-shirts, are inexpensive clothing items often purchased on vacation as a souvenir. Under these circumstances, they are not the type of goods typically investigated thoroughly before purchase, resulting in an impulse transaction involving ordinary care, at best. Confusion under these circumstances is not likely to be dispelled (if at all) until after the decision to purchase. Accordingly, we conclude that the conditions of purchase are such that they would in no way diminish the likelihood of confusion in this case.

Based on testimony⁶² and even a computer generated map made a part of the record,⁶³ applicant sells his T-shirts and other clothing items at the Sunken Ship, a store within blocks of opposer's general store in Nantucket.⁶⁴ Tourists to the Cape and the islands - including those who may have wandered into the Sunken Ship selling **YELLOW DOG NANTUCKET** T-shirts - are likely to have seen **THE BLACK DOG** marks on T-Shirts, on The Black Dog Tavern, on one of opposer's seventeen general stores, and would have already drawn a

⁶² Douglas Dep. March 27, 2007, at 89 - 91.

⁶³ Douglas Dep. March 27, 2007, Exhibit 21.

⁶⁴ Douglas Dep. March 27, 2007, at 89 - 91.

connection between this prominent standing dog and opposer's dining services and extensive merchandising operations. Moreover, based upon the identical goods identified by applicant and by opposer, and where neither identification has any limitations as to channels of trade, we must presume that the respective goods will necessarily move through the same trade channels to the same classes of purchasers.

In addition to brick-and-mortar stores, both opposer⁶⁵ and applicant⁶⁶ promote their merchandise online, and offer these items for sale over the Internet. To the extent that applicant is actually conducting an ongoing business, his website would appear to be applicant's primary means for selling his T-shirts and other items of clothing.

Hence, whether one considers the online market or the island tourists and residents, these products share exactly the same channels of trade.

Accordingly, we find that these related *du Pont* factors favor the position of opposer herein.

The marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc.* 73 USPQ2d at 1692.

⁶⁵ Douglas Dep. March 27, 2007, Exhibit 5.

⁶⁶ Douglas Dep. March 27, 2007, Exhibit 18.

Furthermore, we note 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.* 23 USPQ2d at 1700-01. As noted above, the goods in this case are identical.

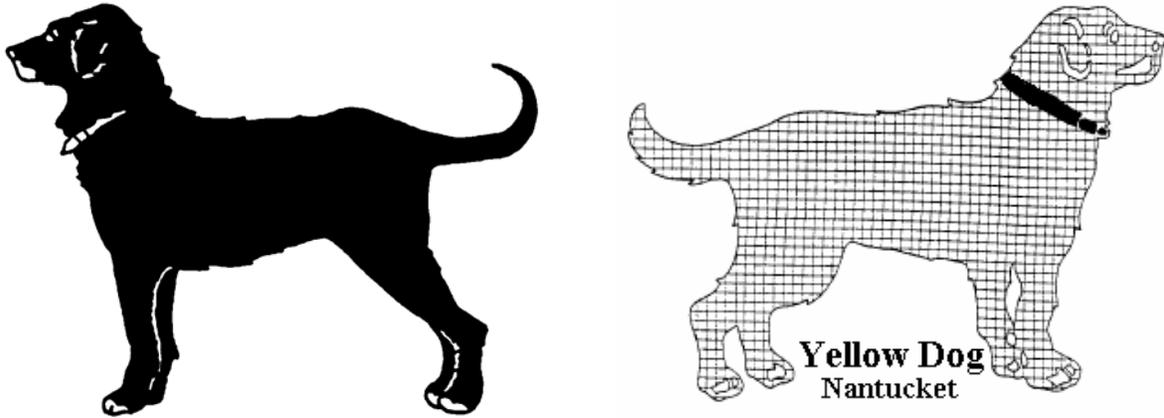
As to the degree of similarity between the two involved word marks alone (i.e., opposer's **THE BLACK DOG** versus applicant's **YELLOW DOG NANTUCKET**⁶⁷) - but for the fact that opposer's mark is so well known - we would find this factor to be a close call. Absent the renown of opposer's enterprise, the mere presence of the common word "Dog" within a composite mark applied to clothing and gift items available in tourist-heavy locations may well not prove sufficient to support a finding of likelihood of confusion herein. However, we are not limited to this comparison.

Additionally, as to the differences in the appearance of the design marks, applicant argues that:

The differences between Applicant's marks and Opposer's marks are simple and clear. The only similarity between the marks is ... the fact that both designs show a realistic depiction of a dog.

⁶⁷ Although we do note that in reality, applicant often shortens the wording within the textual portions of his website, referring repeatedly to merely "the Yellow Dog."

It is true that opposer's standing dog faces to the left in the images shown on the registrations reviewed above, while applicant's standing dog faces to the right. It is also true that applicant's dog is heavier than opposer's dog, having a thicker coat, creating larger legs, tail, neck and head. Inasmuch as none of opposer's design mark registrations claim color, opposer is free to give its black dog "a coat of many colors," and the legal significance of this registered image is in the silhouette design.⁶⁸



Of course, a side-by-side comparison of the marks is not the test we employ inasmuch as we must assume that potential purchasers may encounter opposer's marks in one context at a given time and applicant's marks separately in a different context at a later time. This circumstance enhances the likelihood of confusion. Hence, in our

⁶⁸ Furthermore, it seems from the evidence of record that opposer used images of its standing dog in a range of colors prior to applicant's adoption of his mark. See Douglas Dep. March 27, 2007, at 28; Exhibits 8G, 8H, 8I, 8J and 8L.

comparison of the marks at issue, we must take into account the fallibility of human memory and strictly avoid a simplistic side-by-side comparison. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

As to appearance, opposer argues as follows:

Opposer's Dog Design depicts a Labrador-like standing dog in profile with its head up and its tail curved upward. The dog wears a collar. Touches of white are on the dog's muzzle and paws. Applicant's design mark also shows a Labrador-like standing dog in profile with its head tilted at an angle similar to that of the Opposer's Dog Design. Applicant's dog is wearing a collar and also has white on its muzzle and paws.

Applicant appears to use his standing dog design with the wording, "Yellow Dog Nantucket" (green T-Shirt below at right) as in SN 75518819, and at times, without the wording (cap below at right). In either case, what is most remarkable is the striking similarity in appearance of two labs assuming a quite similar posture:



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Additionally, as we have seen, in actual practice, opposer also uses its dog facing right, from usages over the years in opposer's catalogue and online



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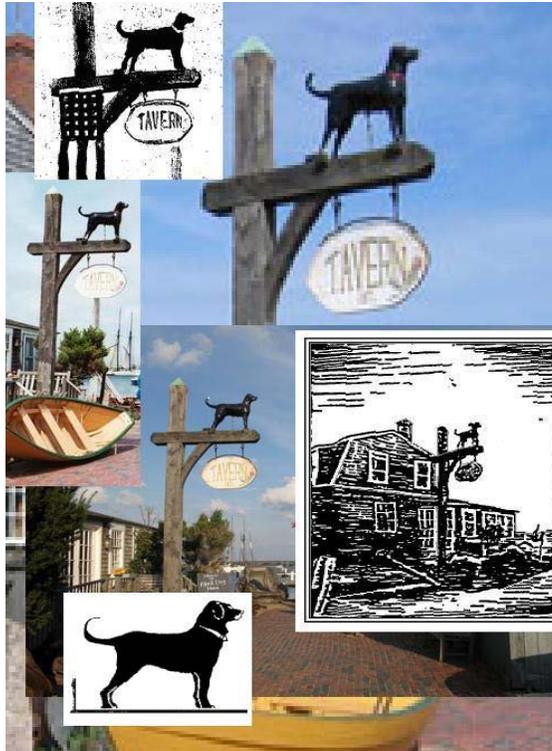
store, to the many popular images of the iconic sign for the Black Dog Tavern as seen when facing Vineyard Haven Harbor:

⁶⁹ https://www.theblackdog.com/images/product_images/full/L095.jpg?1174935405437 as accessed by opposer on March 26, 2007.

⁷⁰ Douglas Dep. March 27, 2007, Exhibit 18B, *Yellow Dog Vintage T-shirt in long-sleeve*
The Yellow Dog Vintage wash T-shirt in long-sleeve.
A very soft t-shirt!
List Price: \$21.99
<http://yellowdognantucket.com/item.html?UCIDs=595338&PRID=973625>
as accessed by opposer on March 26, 2007.

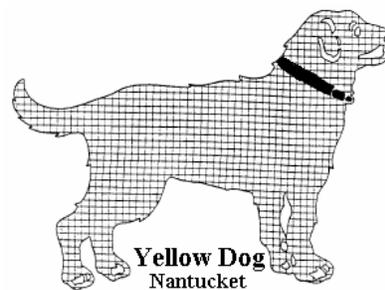
⁷¹ Douglas Dep. March 27, 2007, Exhibit 18B, *Yellow Dog Visor*
List Price: \$23.99
Yellow Dog Visor. 100% garment washed cotton with the Yellow Dog on the front.
<http://yellowdognantucket.com/item.html?UCIDs=595338&PRID=910471>
as accessed by opposer on March 26, 2007.

⁷² Opposer's web pages, "The General Store," from 2002.



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Incorporating the word portions of the marks, applicant argues that the word portion of its composite mark "is relatively small, fitting between the legs" of applicant's standing dog, while opposer's wording is relatively large, extending the full length of opposer's standing dog design.



⁷³ Douglas Dep. March 27, 2007, Exhibit 2A, 5, 14J, 16A and 16C. <https://www.theblackdog.com/Tavern.aspx>

Again, the test is not a side-by-side comparison. On the other hand, when afforded this side-by-side comparison, the accumulated points of similarities in appearance and commercial impression are quite remarkable, including the general size and style of fonts employed in the wording positioned beneath the respective standing dog images.

Hence, based upon the entire record herein - with the various combinations of dog silhouettes, the word "DOG," font choices, listing popular localities in the Cape and the islands, precisely the same placement on T-shirts and other identical items of clothing, and especially in light of the renown of opposer's marks in connection with T-shirts on the Cape and the islands - we find that the degree of similarity in commercial impressions with applicant's composite mark is strongest when comparing opposer's common law composite mark as used above, as opposed to singling out the similarities of any two registered marks. *See e.g., Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992).

In this context, we agree with opposer that applicant has adopted a mark strikingly similar in connotation and commercial impression to opposer's previously used marks. Accordingly, the confusing similarity of the marks is a factor that strongly favors a finding of likelihood of confusion in this case.

Third-Party Registrations

Applicant, in his testimony, notice of reliance and appeal brief, repeatedly emphasizes a dozen third-party registrations containing the words "Black Dog" (or "Black Dawg"), some also including a depiction of a black dog. These marks were registered in connection with a wide variety of goods (e.g., newspaper columns, CD's, books, gun cases, motorcycles and beer) and services (e.g., computer, hunting, yoga studio, online accounting, custom motorcycle manufacturing, car wash, motion picture production, and asphalt repair), listed below in the order in which the registrations issued. In the case of many of these registrations, applicant also demonstrated a presence by the third-party registrant on the Internet:

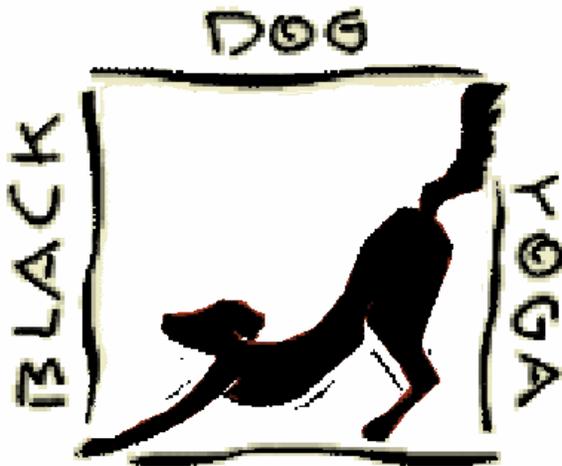
BLACK DOG

for "news column featuring newsworthy information included in a newspaper" in International Class 16; "computer services, namely, providing on-line news column featuring newsworthy information included in a newspaper" in International Class 42;⁷⁴

⁷⁴ Registration No. 2545597 issued to Associated Newspapers Limited, a U.K. corporation on March 12, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for "hunting guide services,
dog training" in
International Class 41;⁷⁵



for a "yoga studio" in
International Class 41;⁷⁶

⁷⁵ Registration No. 2676517 issued on January 21, 2003; Section 8 affidavit (six-year) accepted. No claim is made to the words "Black Dog Hunting Club & Training Kennels" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 96.

⁷⁶ Registration No. 2693501 issued on March 4, 2003. No claim is made to the word "Yoga" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 92.



for "gun cases" in International Class 13;⁷⁷

BLACK DOG

for "providing software application services to others, namely industry specific accounting software systems via a global communications computer network" in International Class 42;⁷⁸

BLACK DOG CHOPPERS

for "originally manufactured and custom built motorcycles" in International Class 12;⁷⁹



for "custom manufacturing and customizing of motorcycles" in International Class 40;⁸⁰

⁷⁷ Registration No. 2810720 issued on February 3, 2004.

⁷⁸ Registration No. 2890120 issued on September 28, 2004.

⁷⁹ Registration No. 3049708 issued on January 24, 2006. No claim is made to the word "Choppers" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 90.

⁸⁰ Registration No. 3049711 issued on January 24, 2006. No claim is made to the words "Custom Cycles," "Pittsburgh Pennsylvania," "Hand Built," "Built By," And "Custom Choppers" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 90.



**BLACK DOG
& LEVENTHAL
PUBLISHERS**

for "pre-recorded compact discs and cd-roms featuring fiction and non-fiction books, reference books, literary works, music, written and spoken poetry, cartoons, artwork, historical content, and instruction in the field of the arts" in International Class 9; "books, namely, fiction books featuring a wide range of subject matter; non-fiction books on a variety of topics, reference books on a variety of topics; books featuring photography, art, cooking, architecture, humor, and instructional and teaching materials for children; librettos; illustrated and picture-based books" in International Class 16;⁸¹

SPANISH PEAKS BLACK DOG ALE

for "malt beverages, namely, brewed malt-based alcoholic beverage in the nature of a beer" in International Class 32;⁸²

⁸¹ Registration No. 3095002 issued on May 23, 2006. No claim is made to the word "Publishers" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 97.

⁸² Registration No. 3135367 issued on August 29, 2006. No claim is made to the word "Ale" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 89.



for "malt beverages, namely, brewed malt-based alcoholic beverage in the nature of a beer" in International Class 32;⁸³



for "car wash services" in International Class 37;⁸⁴

BLACK DOG FILMS

for "entertainment services, namely, the production and distribution of general entertainment, comedy, drama, documentary, educational and variety television programs and motion pictures" in Int. Class 41;⁸⁵

⁸³ Registration No. 3179699 issued on December 5, 2006. No claim is made to the word "Ale" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 89.

⁸⁴ Registration No. 3207441 issued on February 13, 2007. No claim is made to the words "Car Wash" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 94.

⁸⁵ Registration No. 3238904 issued on May 8, 2007. No claim is made to the word "Films" apart from the mark as shown.

BLACK DAWG Sealcoat

for "asphalt repair, maintenance, sealing and parking lot striping" in International Class 37.⁸⁶

Although applicant has shown that some of these registrants have a presence on the Internet, we still cannot be sure if these marks are known to an appreciable number of consumers within the relevant purchasing public.

Nonetheless, we conclude that entrepreneurs in a variety of fields have adopted the idea of a black dog, and often, it seems, indications of a beloved pet Labrador, for their source identifier. Applicant takes the position that in light of these third-party registrations, opposer is saddled with a weak, diluted mark entitled to a narrow scope of protection. We disagree. We find that these specific goods and services are not closely-related to opposer's claimed goods or services, and are not related at all to applicant's T-Shirts and other clothing items. Despite opposer's having introduced into the record articles that refer to opposer as "legendary," "trendy," "famous," "recognized world-wide," etc., opposer understands correctly that it is not entitled to trademark rights *in gross* in the words THE BLACK DOG

⁸⁶ Registration No. 3245570 issued on May 22, 2007. No claim is made to the word "Sealcoat" apart from the mark as shown. Applicant also located this registrant's presence on the Internet. See Footnote 88.

and/or to every image of a black lab that would preclude the registration to another of the same or a similar mark in connection with virtually any goods or services. On the other hand, the record demonstrates that opposer has successfully pursued legal actions against third-parties.

Furthermore, while we have found that the commercial impression of applicant's dog imagery is strikingly similar to opposer's standing dog image, most of these third-party, "black dog" images are quite different from either the opposer's or the applicant's design marks.

Finally, applicant has also placed into the record copies of more than 150 other third-party registrations having the word "Dog," "Dogs," "Dawg," "Dawgs," etc., somewhere within the composite mark. All these registrations include, *inter alia*, goods in the clothing class. Although applicant has also located some of these same marks on the Internet, again, we cannot be sure if these marks are known to an appreciable number of consumers within the relevant purchasing public. Certainly, few businesses of any size are currently without a web presence. Moreover, we find that the third-party registered marks are different as to sound, appearance, meaning and commercial impression from both opposer's marks and applicant's marks.

In addition to third-party registrations, applicant has placed into the record the following third-party usages of the terms "Black Dog" or "Black Dawg" drawn from Internet sites. As to these uses, applicant has no indication of the nature and extent of the actual uses of these marks, and has testified that he has neither knowledge nor evidence of whether these marks are generally known to the relevant purchasing public. The final one of these third-party usages identified by applicant - a usage that would otherwise be somewhat difficult for opposer to explain away - is actually a licensee of opposer.⁸⁷

<p>BLACK DAWG SEALCOAT</p>	<p>for an asphalt product in New Hampshire⁸⁸ for an amber ale brewed in Montana, and related merchandise⁸⁹</p>	<p>SPANISH PEAKS BLACK DOG ALE</p>
<p>BLACK DOG CHOPPER</p>	<p>for hand-built custom chopped motorcycles in Pittsburgh, PA ⁹⁰ for a remodeling company⁹¹</p>	

⁸⁷ Douglas Dep., November 2, 2007, entire transcript, Exhibits 1 - 2.

⁸⁸ <http://www.blackdawgsealcoat.com/>; Applicant's Exhibit 18.

⁸⁹ <http://www.blackdogales.com/>; Applicant's Exhibit 19.

⁹⁰ <http://www.blackdogcustomcycles.com/>; Applicant's Exhibit 20.

⁹¹ <http://www.blackdogbuilders.com/>; Applicant's Exhibits 28 and 30.

<p>BLACK DOG YOGA</p>	<p>for a yoga studio in Sherman Oaks, CA⁹² for software services⁹³</p>	<p>blackdogsoft.com</p>
<p>BLACK DOG CAR WASH</p>	<p>for four car washes in SE NH⁹⁴ for a bed and breakfast in Estes Park, CO⁹⁵</p>	<p>BLACK DOG INN</p>
	<p>for a hunting club in Arkansas⁹⁶ an imprint of Workman Publishing Company located in NYC, having moderately-priced cooking, history, and other non-fiction books⁹⁷</p>	<p>Black Dog & Leventhal</p>
<p>black dog design</p>	<p>for a graphic design studio⁹⁸ used by an Idaho manufacturer of magazine parts for military rifles⁹⁹</p>	<p>BLACK DOG MACHINE</p>

⁹² <http://www.blackdogyoga.net/>; Applicant's Exhibit 25.

⁹³ <http://www.blackdogsoft.com/>

⁹⁴ <http://blackdogcarwash.stores.yahoo.net/>; Applicant's Exhibit 21.

⁹⁵ <http://www.blackdoginn.com/>; Applicant's Exhibit 36.

⁹⁶ <http://www.blackdoghuntingclub.com/>; Applicant's Exhibit 29.

⁹⁷ <http://www.blackdogandleventhal.com/>; Applicant's Exhibit 24.

⁹⁸ <http://www.black-dog-design.com/>; Applicant's Exhibits 31 and 33.

⁹⁹ Applicant's Exhibit 22.

	<p>for a swimming club in the Twin Cities, MN¹⁰⁰</p> <p>for a studio that does wedding and other formal photography¹⁰¹</p>	
	<p>for a coffee and wine bar in St. Paul, MN¹⁰²</p> <p>for specialty online marketing and event promotion company¹⁰³</p>	
	<p>for cycling apparel¹⁰⁴</p> <p>for a semi-dry red table wine; Château Morrisette is opposer's licensee in Floyd County, VA.¹⁰⁵</p>	

Other marks that applicant located with an Internet search having the words "dog," "dogs," or "dawg" but not the modifying word, "Black," as used in connection with goods such as human and canine clothing are also of little

¹⁰⁰ <http://blackdog.swimteamsystems.com/>; Applicant's Exhibit 38.

¹⁰¹ <http://www.blackdogstudios.com/kds/index.html>; Applicant's Exhibit 34.

¹⁰² <http://www.blackdogstpaul.com/>; Applicant's Exhibit 35.

¹⁰³ <http://www.blackdogpromotions.com/>; Applicant's Exhibit 37.

¹⁰⁴ www.blackdogbikes.com/; Applicant's Exhibit 26.

¹⁰⁵ <http://www.chateaumorrisette.com/>; Applicant's Exhibit 23.

relevance in determining the appropriate scope of protection to be provided for opposer:

	for dog-themed tees/tops from "In the company of Dogs" ¹⁰⁶	
	for hats ¹⁰⁸	
	for performance apparel ¹¹⁰	
	for dog clothing ¹¹¹	

¹⁰⁶ <http://www.inthecompanyofdogs.com/>; Applicant's Exhibit 53.

¹⁰⁷ <http://www.hsssrf.com/billabong-bad-dog-corduroy-shorts-12500.html>; Applicant's Exhibit 58.

¹⁰⁸ <http://www.fataldog.com/>; Registration No. 3206095.

¹⁰⁹ <http://www.alphadog.us/> or <http://www.alphadog.tv/>; Applicant's Exhibit 59.

¹¹⁰ <http://estore.websitepros.com/1016950/StoreFront.bok>; Registration No. 3216378; Applicant's Exhibit 57.

¹¹¹ <http://www.funnylittledog.com/>; Registration No. 2970452; Applicant's Exhibit 62.

 <p>Lucky Dog Mens T-Shirt</p>	<p>for merchandise sold to promote the Lucky Dog Music Hall in Worcester, MA¹¹²</p>	
	<p>for underwear¹¹⁴ for eyeglasses¹¹⁵</p>	<p>Dirty Dog Eyewear and Stuff of Australia</p>
		<p>for a dog bakery in Austin, TX that also sells dog toys and gifts¹¹⁶</p>
		<p>Old Dog Clothing 6822 Phillips Place Ct Charlotte, NC 28210¹¹⁷</p>

Clearly modifiers like "fatal," "wormy," "groovy," "old," "speed," or "funny" create such different

¹¹² <http://www.luckydogmusic.com/merchandise.html>; Applicant's Exhibit 56.

¹¹³ <http://www.wormydog.com/index.php>; Registration No. 2955048; Applicant's Exhibit 63.

¹¹⁴ <http://www.reddogsportswear.com/products.html>; Registration No. 2622372; Applicant's Exhibit 67.

¹¹⁵ Applicant's Exhibit 68.

¹¹⁶ <http://www.groovydog.com/>; Applicant's Exhibit 60.

¹¹⁷ Applicant's Exhibit 64.

connotations and commercial impressions from both opposer's and applicant's marks as to be of little more than passing interest. Opposer's arbitrary, strong, well-known mark as applied to its multi-million dollar merchandising enterprise anchored in a dining services business is not weakened or diluted by such different marks - most of which also happen to be antithetical to opposer's brand image.

In the category of random Internet usages that offer no threat to opposer, applicant listed two "Dog" marks having very different connotations and commercial impressions, originating from individuals who make shirts available through the online services of Cafepress.com:

cafepress™ [Cart & Checkout](#) | [Help](#) | [Order Status](#) | [Shop Home](#) | Currency: USD ▼

 **Davis Dog™** Shop

[Home](#) [Bio](#) [Gallery](#) [Postcards](#) [Shop](#) [Fun](#) [Contact](#)

» [T-Shirts, Sweatshirts, Etc ...](#)
» [Hats, Mugs & Other Stuff](#)
» [Art Prints](#)

Welcome to Davis Dog's world. Bold lines, bright colors, easy smiles. Simple images loaded with personality. You never know exactly what's lurking in the shadows ... or behind those live eyes. Check out the great Davis Dog t-shirts, fine art prints and other fun items. Remember ... if you purchase enough Davis Dog stuff, you will become fabulously famous and wealthy, the hole in the ozone layer will close and world peace will reign.

[T-Shirts, Sweatshirts, Etc ...](#) [Hats, Mugs & Other Stuff](#) [Art Prints](#)

Davis Dog™ 118

¹¹⁸ Applicant's Exhibit 65; Registration No. 2773568;
<http://www.cafepress.com/cp/store.aspx?s=davisdog.0>



Lucky Dog Racing Shop



This is the official store of the Lucky Dog Racing League!

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In a similar vein, applicant testified to his having discovered the existence of *Salty Dog Café* apparel,¹²⁰ *Angry Dog* stencil silk screen by Dayna Gedney,¹²¹ *Earth Dog* apparel,¹²² *Sea Dog* Brewing Company,¹²³ *FogDog* merchandise,¹²⁴ *Biff ... the Dog* apparel,¹²⁵ *Wet Dog* Designs,¹²⁶ *Two Dog Island* apparel,¹²⁷ *Planet Dog* apparel,¹²⁸ *White Dog Café* apparel,¹²⁹

¹¹⁹ Applicant's Exhibit 54; <http://shop.cafepress.com/lucky-dog-racing>.

¹²⁰ <http://www.saltydog.com/>; Applicant's Exhibit 48.

¹²¹ <http://www.indyish.com/angry-dog>; Applicant's Exhibit 79.

¹²² <http://www.earthdog.com/>; Applicant's Exhibit 78.

¹²³ http://secure.seadogbrewing.com/shop_wears.html; Applicant's Exhibit 76.

¹²⁴ <http://www.fogdog.com/home/index.jsp>; Applicant's Exhibit 75.

¹²⁵ <http://www.biffthedog.com/>; Registration No. 2942350; Applicant's Exhibit 74.

¹²⁶ <http://www.wetdog.com/>; Applicant's Exhibit 73.

¹²⁷ <http://www.twodogisland.com/>; Registration No. 2048365; Applicant's Exhibit 72.

¹²⁸ <http://www.planetdog.com/home/>; Registration Nos. 2490661 and 2490662; Applicant's Exhibit 71.

¹²⁹ Applicant's Exhibit 70.

Blue Dog Café apparel,¹³⁰ **UpDog** brand apparel,¹³¹ **Give a Dog a Home** shirt (for sale on eBay),¹³² **Lazy Dog Adventure Club** apparel,¹³³ and a **Pink Dog** cap.¹³⁴

Applicant also submitted photographs he allegedly took in Nantucket around 2000, including of the **Sun Dog** store,¹³⁵ a T-shirt showing a hand-drawn "**Vineyard Dog/ Martha's Vineyard**" dog,¹³⁶ **The Bad Dog Nantucket**,¹³⁷ a crude, image of a black dog,¹³⁸ image of a "guard dog,"¹³⁹ and a tall, thin, standing black dog.¹⁴⁰ We cannot be sure what all these various photographs may actually represent, but the testimony of Robert S. Douglas, Jr. - considered in

¹³⁰ Applicant's Exhibit 80.

¹³¹ Applicant's Exhibit 66; Registration No. 2856738.

¹³² Applicant's Exhibit 52.

¹³³ <http://www.lazydogadventure.com/>; Applicant's Exhibit 50.

¹³⁴ Applicant's Exhibit 47; Registration No. 3234287.

¹³⁵ Applicant's Exhibit 43.

¹³⁶ Applicant's Exhibit 42.

¹³⁷ Applicant's Exhibit 39; See also opposer's Douglas Dep. March 27, 2007, Exhibit 14I, "Martha's Vineyard, Putting On the Dog," *The Washington Post*, August 31, 1994: "So this summer rival stores offer the Lazy Dog (a sleeping hound), Mad Dog (a snarling shepherd) and the Bad Dog (a squatting dog about to do his doggy business)"

¹³⁸ *Id.*; applicant's Exhibit 40.

¹³⁹ Applicant's Exhibit 41.

¹⁴⁰ Applicant's Exhibit 45.

connection with various articles in the record - alludes to an ongoing problem opposer has faced over the years (both prior to and subsequent to applicant's adoption of his mark) with knock-offs designed to profit from opposer's goodwill.

Accordingly, in spite of a plethora of documents applicant has placed into the record, we find that the purported evidence of actual third-party uses and/or registrations fails to show that opposer's marks are weak for restaurant services, and even less so for its collateral merchandise such as T-shirts.

Absence of actual confusion

Applicant argues that the apparent absence of evidence of actual confusion indicates that there is no likelihood of confusion here. Again, opposer disagrees noting that the absence of actual confusion, by itself, does not mean that there is no likelihood of confusion, and that the circumstances present here explain the lack of such evidence.

We agree with opposer. First, we note that the absence of actual confusion does not necessarily lead to the conclusion that there is no likelihood of confusion. In this case, it is unclear whether there has been a true opportunity for confusion. As noted above, the record is most sparse in documenting the level of applicant's sales.

Consequently, the absence of actual confusion with regard to sales is meaningless in light of the very limited evidence of applicant's sales on this record.

Accordingly, we conclude that this factor is neutral in assessing the likelihood of confusion in this case

Bad Faith

Opposer has also argued vehemently throughout the prosecution of these opposition proceedings that applicant adopted his **YELLOW DOG NANTUCKET** marks in bad faith:

To top off his fictionalized account of his business, Juras claims that he never heard of Opposer or Opposer's marks prior to starting his business and that he has never seen Opposer's website at any time ... These claims are utterly ludicrous. It requires one to believe that it was sheer coincidence that Juras chose a mark that includes a dog design that is virtually identical to Opposer's design, that Juras just happened to select the exact same, distinctive Caslon Antique font that Opposer uses, that he by mere chance included the name NANTUCKET – along with Martha's Vineyard, one of the two, neighboring, popular tourist islands off Cape Cod – as part of his mark, and that serendipitously his rare venture into advertising comprised a brochure that is a knock-off of the images in Opposer's catalogs.

The only rational conclusion is that Juras adopted his marks in a deliberate attempt to trade off Opposer's goodwill. Juras's copying of Opposer's marks, font, advertising, and overall aesthetic, coupled with his inability to produce evidence that he has a legitimate business as well as his inability to explain why he adopted his marks

indicates that Juras adopted his marks in bad faith...

Obviously, Applicant Juras will say anything – regardless of whether he is under oath and sworn to tell the truth – rather than admit that his “growing business” is a hollow and illegitimate figment of his imagination.

Opposer’s reply brief, at 4 – 5.

Given the way in which most of the relevant *du Pont* factors reviewed above favor a finding of a likelihood of confusion, it is not necessary for us to find applicant guilty of bad faith in order to conclude that there is clearly a likelihood of confusion herein. Nonetheless, in light of the renown of opposer’s marks, applicant’s professed interests in images of dogs, his years of formal education and professed business acumen, and his having lived in Nantucket for one or more high-tourist seasons, we find that his claimed ignorance of opposer’s well-known enterprise and branding success prior to adopting his marks and filing the involved applications strains credulity. As a newcomer, under this set of circumstances, applicant had a duty to select a mark that would not give rise to a likelihood of confusion. e.g., *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191, 200-01 (TTAB 1979).

Conclusion on Likelihood of Confusion:

After careful consideration of all of the evidence of record in this case related to the *du Pont* factors, we conclude that opposer has established its claim of likelihood of confusion under Trademark Act § 2(d).

In addition to its ownership of a large number of federal registrations, opposer has established common law rights in **THE BLACK DOG**, the standing dog image, the use of both of these with localities such as Martha's Vineyard, in connection with T-Shirts and other items of clothing, restaurant, bakery shop and other food and dining services, etc., and that such use began long prior to the filing date of the subject applications, and that such use has been continuous.

Applicant's marks are highly similar to opposer's marks. Given the fact that opposer's marks are well-known for its dining services and its collateral merchandise, consumers are likely to assume that applicant's **YELLOW DOG NANTUCKET** T-shirts and other clothing items are sponsored by or otherwise connected with opposer. *Turner Entm't Co. v. Nelson*, 38 USPQ2d 1942 (TTAB 1996).

Accordingly, we conclude that the use of applicant's marks would clearly give rise to a likelihood of confusion in view of opposer's previously-used and registered marks.

Fraud on the United States Patent and Trademark Office

Opposer also alleges that applicant has committed fraud on the Office in connection with the filing of both of these use-based applications. Specifically, opposer points to the fact that upon filing these applications in mid-1998, applicant falsely stated that both his marks were in use on eleven enumerated items of clothing, when in fact it is now clear that neither mark was then in use on ten of the eleven items listed. Accordingly, based on what it characterizes as applicant's blatantly and knowingly making false statement in Juras' Jurat, opposer has asked us to declare both applications void *ab initio*.

By contrast, applicant argues that despite what were admittedly misstatements made under oath, he never had intent to commit a fraud on the United States Patent and Trademark Office.

However, in light of our sustaining both oppositions based upon a likelihood of confusion, we find that it is not necessary to reach this issue in these proceedings.

Decision: The oppositions are hereby sustained pursuant to Section 2(d) of the Lanham Act, and registration to applicant is denied as to both applications.