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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Zoological Society of San Diego, Inc. and Donald Borgen
v.
Helen Woodward Animal Center

Opposition No. 91156728
to application Serial No. 78145860
filed on July 19, 2002

Richard A. Clegg of Seltzer Caplan McMahon Vitek for The
Zoological Society of San Diego, Inc. and Donald Borgen.

Kristen E. Caverly of Henderson & Caverly LLP for Helen
Woodward Animal Center.

Before Hairston, Walters and Drost, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by the Helen Woodward
Animal Center (applicant) to register the mark CARS FOR
CRITTERS for services identified as "charitable fund
raising."¹

Registration has been opposed under Section 2(d) of the

¹ Application Serial No. 78145860, filed on July 19, 2002, which
alleges a date of first use anywhere and in commerce of November
30, 2000.

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Trademark Act by The Zoological Society of San Diego, Inc. (Zoo) and Donald Borgen (Borgen). In support of its claim of likelihood of confusion, the Zoo alleges that applicant's mark, when used in connection with applicant's services, so resembles the Zoo's previously used and registered marks CANS FOR CRITTERS for "fund raising for support of research and educational endeavors in connection with improving the health, wellbeing and breeding potential for near-extinct wildlife,"² and CELEBRATION FOR THE CRITTERS for "fund raising services for zoological activities,"³ as to be likely to cause confusion. In support of his claim of likelihood of confusion, Borgen alleges that applicant's mark, when used in connection with applicant's services, so resembles Borgen's previously used and registered mark CARS FOR PETS for "charitable fund raising in the area of donations of vehicles to be auctioned so that the proceeds can be used for animal shelters in the care and adoption placements of homeless animals,"⁴ as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of the likelihood of confusion claims.

² Registration No. 1,576,802 issued January 9, 1990; Sections 8 and 15 affidavits accepted and acknowledged, respectively.

³ Registration No. 2,320,780 issued February 22, 2000.

⁴ Registration No. 2,438,585 issued March 27, 2001.

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The record consists of the following: the pleadings; the file of the involved application; the testimony deposition of the Zoo's witness Joanne Leidenberger; the Zoo's notices of reliance on status and title copies of its pleaded registrations, and applicant's responses to the Zoo's interrogatories and requests for admissions; the testimony deposition of applicant's witness Renee Resko; and applicant's notice of reliance on third-party registrations of marks that include the term "CRITTER(S)", the Zoo's responses to applicant's interrogatories and requests for admissions, and a dictionary excerpt for the term "critter."

Briefs have been filed, but an oral hearing was not requested.

The Parties

Joanne Leidenberger, associate director of development for the Zoo, testified that the Zoo operates both the San Diego Zoo and the San Diego Wild Animal Park. Ms. Leidenberger stated that the Zoo launched the CANS FOR CRITTERS fund raising program in 1981. The program is focused primarily on elementary schools and scout troops. The children (with the help of their parents) collect aluminum cans for recycling and take them to their school or scouting location. The collected cans are then taken to a recycling center and redeemed for cash. Schools typically have assemblies to kick off the CANS FOR CRITTERS program

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each year and the Zoo sometimes takes animals to the assemblies. Students receive incentives based on the number of cans they donate. Classrooms within a given school compete against each other and schools compete against other schools.

Each donor drive lasts for several months. The drive is conducted in the San Diego area with approximately 20 schools and 250-300 scout troops participating. During each drive, banners are hung at the participating schools, boxes for collecting the cans are placed at or near school entrances, and flyers are distributed to the students. All of these materials bear the CANS FOR CRITTERS mark. At the end of the donor drive, a check is given to the Zoo as a donation for its Center for Reproduction of Endangered Species. The donor drive culminates with a program at the San Diego Zoo, with awards being presented to the top collectors.

The children who participate in the program receive t-shirts with the CANS FOR CRITTERS mark and various other items (pens, rulers, etc.) that display the mark. Children from scout troops also receive patches with the CANS FOR CRITTERS mark. The Zoo advertises its CANS FOR CRITTERS program in its "ZOONOOZ" publication and at its website. The program has been featured on local television and radio

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and since its inception has generated approximately one-half million dollars.

Insofar as the CELEBRATION FOR THE CRITTERS mark is concerned, Ms. Leidenberger testified that the Zoo has used this mark since 1981 in connection with an annual fundraising event to benefit the Center for Reproduction of Endangered Species. It is a ticketed, single event each year, featuring food, beverages and musical entertainment with approximately 3000 attendees. The Zoo advertises the event at its website and in its "ZOONOOZ" publication, on the radio, and in local newspapers. Ms. Leidenberger testified that she was not aware of any instances of actual confusion involving the Zoo's and applicant's marks.

We have no information about Borgen because he did not take testimony or submit any other evidence in this case.

Renee Resko, applicant's director of development, testified that applicant's animal center is located in San Diego County, California. In addition to being a no-kill animal shelter, applicant also provides other animal-related programs, e.g., it has a "therapeutic" horseback riding program for persons with disabilities, a pet outreach program for people confined to institutions, and a traveling classroom known as the "Animobile," that goes to schools throughout San Diego County. Applicant began using the CARS FOR CRITTERS mark in 2000 in connection with its vehicle

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donation program. Applicant has advertised its CARS FOR CRITTERS program at its website and in its newsletter, and in local newspapers and the "San Diego Parent" magazine. Since the program's inception, it has generated approximately \$200,000. Ms. Resko, like the Zoo's witness, testified that she is unaware of any instances of confusion.

Standing and Priority

Because the Zoo has made of record certified copies showing status and title of its pleaded registrations, and because its likelihood of confusion claim is not without merit, we find that the Zoo has established its standing to oppose registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Further, because the Zoo has made its pleaded registrations of record, its priority is not an issue in this case with the marks and services identified therein. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

However, Borgen did not make of record a copy of his pleaded registration; neither did Borgen take testimony or submit any other evidence on his behalf. Having failed to do so, we find that Borgen has no standing in this proceeding.

Accordingly, the only issue to be decided is whether the Zoo has established that a likelihood of confusion exists.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. duPont 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 any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. 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).

Considering first the services of the parties, it is the Zoo's position that they must be considered legally identical because the "charitable fund raising" services identified in applicant's application are broad enough to encompass the specific fund raising services described in the Zoo's registrations.

Applicant, however, argues that the parties' fund raising services are different because they are directed to

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different causes; that is, the Zoo raises funds for near-extinct wildlife and zoological activities, whereas applicant raises funds for domestic animals. Further, applicant argues that the Zoo's CANS FOR CRITTERS program, in particular, is directed to school children whereas applicant's CARS FOR CRITTERS program is directed to adults.

It is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the identification of goods or services set forth in opposer's registrations vis-à-vis the identification of services in applicant's application, regardless of what the evidence may show as to the specific nature of the parties' goods or services. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1738 (Fed. Cir. 1990); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Because the identification of services in applicant's application reads "charitable fund raising," without any limitations as to the nature or purpose thereof, we must presume for purposes herein that applicant uses its mark for all types of fund raising activities, including the types in the Zoo's registrations, that is, for the support of research and educational endeavors in connection with improving the health, wellbeing and breeding potential for near-extinct wildlife and for zoological activities.

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Further, in the absence of any limitations in applicant's application and the Zoo's registrations, we must presume for purposes herein that applicant and the Zoo conduct their fund raising in all the usual manners and target all the usual classes of potential donors. In other words, for purposes of our likelihood of confusion analysis, we must presume that the parties' fund raising services are identical and that the manners of fund raising (e.g., radio, television, and newspaper advertising) and classes of potential donors (e.g., the general public) are the same.

Turning then to the marks, we must determine whether the Zoo's marks and applicant's mark, when compared in their entireties are similar or dissimilar, in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods and/or services offered under the

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respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Also, we note that "when marks would appear on virtually identical goods or services, the degree of similarity 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 (Fed. Cir. 1992).

We compare first the Zoo's mark CANS FOR CRITTERS and applicant's mark CARS FOR CRITTERS. These marks are nearly identical in terms of appearance; the only difference being a single letter. Further, the marks CANS FOR CRITTERS and CARS FOR CRITTERS sound very similar, particularly in view of the shared phrase FOR CRITTERS. In addition, we find that the marks have a strong similarity in connotation in that both marks connote the donation of an item "for critters." Accordingly, we find that the marks have similar commercial impressions. Even though people will likely note the difference between CANS and CARS, because the marks are used on legally identical services, they are likely to believe that the marks are variants of each other, and that they identify services emanating from the same source.

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Further, we find that the Zoo's mark CELEBRATION FOR THE CRITTERS and applicant's mark CARS FOR CRITTERS are similar. Due to the shared words FOR (THE) CRITTERS, the marks are similar in appearance and sound. Further, the marks are similar in connotation in that both marks connote an event/donated item "for (the) critters." Accordingly, we find that the marks have similar commercial impressions. Again, even though people will likely note the difference between a CELEBRATION and CARS, because the marks are used on legally identical services, they are likely to believe that these marks are variants of each other, and that they identify services emanating from the same source. Donors aware of the CELEBRATION FOR THE CRITTERS mark, as well as the Zoo's CANS FOR CRITTERS mark, who then encounter the mark CARS FOR CRITTERS, also for charitable fund raising, are likely to conclude that these services are associated in some way.

Several arguments made by applicant require comment. Applicant argues that marks consisting of or containing the term CRITTER(S) are weak marks that are therefore entitled to only a limited scope of protection. In support of its argument, applicant submitted a large number of third-party registrations of marks that include the term CRITTER(S). In addition, applicant introduced during the testimony deposition of its witness, Renee Resko, Internet printouts

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showing third-party uses of "Cans for Critters," "Cash for Critters," and "Cans 4 Critters" in connection with charitable fund raising.

Third-party registrations are not evidence of use of the marks shown therein, nor are they proof that consumers are familiar with the marks. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1992). Moreover, a review of the third-party registrations shows that none cover charitable fund raising services. Third-party registrations may, however, be relied on to show that a word common to each of the marks has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). In this case, they show that CRITTER(S) has a descriptive connotation indicating "[a] domestic animal" or "[a] living creature." The American Heritage Dictionary of the English Language (2d ed. 1982). However, this does not help distinguish applicant's mark from the Zoo's marks. The term CRITTERS, as used in both parties' marks, conveys virtually the same descriptive significance and the additional wording in the respective marks does not change the commercial impression of the marks. Here, applicant's mark CARS FOR CRITTERS is still very similar to the Zoo's

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marks CANS FOR CRITTERS and CELEBRATION FOR THE CRITTERS in appearance, sound, connotation and commercial impression.

Insofar as the Internet printouts are concerned, the Board has in the past, in likelihood of confusion cases, given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the involved mark to demonstrate that confusion is not, in reality, likely to occur. See, e.g., *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB 1987). The justification, of course, is that the presence in marks of common elements extensively used by others unrelated as to source may cause purchasers not to rely upon such elements as source indicators, but to look to other elements as a means of distinguishing the source of the services. In this case, however, the evidence provided by applicant, through the testimony of Ms. Resko, is not sufficient to show that the public has had such widespread exposure. It consists simply of Internet printouts, and there is no information as to the length of time or extent of these third-party uses such that we can ascertain their impact on the public.

Further, applicant argues that confusion is unlikely because it and the Zoo always use their respective names in connection with their fundraising activities and therefore people will always know to which charity they are donating.

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It is common knowledge that many charitable contributions are made by members of the public, who are not particularly sophisticated. Moreover, there are many levels of charitable contributions and levels of attention paid by contributors to the nature of the receiving charity and what affiliations it may or may not have. In short, we are not persuaded by applicant's argument that confusion is unlikely.

In addition, applicant points out that neither it nor the Zoo is aware of any instances of actual confusion between their respective marks. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associated Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). The fact that there is no evidence of actual confusion does not persuade us to find that confusion is not likely. Evidence of actual confusion is not a prerequisite for finding likelihood of confusion. Moreover, it is well recognized that evidence of actual confusion is difficult to obtain. Given this, as well as the relatively small amount of money (approximately \$200,000) applicant has generated with its vehicle donation program and the limited time in which applicant has used its mark, the lack of evidence of actual confusion does not show that confusion is not likely to occur.

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Also, applicant argues that it adopted its mark in good faith. Although an intent to deliberately trade on the mark of another is strong evidence of a likelihood of confusion, since it is presumed that such an intention is successful, the converse is not true, i.e., good faith adoption does not necessarily mean that confusion is not likely.

Finally, we note that applicant, in its brief, has offered to amend the identification of services in its application to "charitable fund raising, namely raising funds through donation of vehicles, boats and RVs, for use in promoting education regarding domestic animals and for the care and maintenance of domestic animals." Apart from the fact that such an amendment should have been made prior to trial (See TBMP Section 514.03 and cases therein), we note that the Zoo has not consented thereto. Moreover, we decline to accept the amendment because it would not avoid a likelihood of confusion in this case. As we have already found, applicant's CARS FOR CRITTERS mark is similar to the Zoo's CELEBRATION FOR THE CRITTERS mark. The Zoo's CELEBRATION FOR THE CRITTERS mark covers fund raising services for zoological activities. We judicially notice that the word "zoological" is defined as "[o]f or relating

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to animals and animal life.”⁵ We must presume, therefore, that the Zoo’s fund raising services are for all types of animals and animal life, including domestic animals. Thus, the Zoo’s fund raising services for zoological activities offered under the mark CELEBRATION FOR THE CRITTERS would still overlap with the services in applicant’s proposed identification, i.e., charitable fund raising, namely raising funds through donation of vehicles, boats and RVs, for use in promoting education regarding domestic animals and for the care and maintenance of domestic animals.

We conclude that persons familiar with opposer’s CANS FOR CRITTERS mark for fund raising for support of research and educational endeavors in connection with improving the health, wellbeing and breeding potential for near-extinct wildlife and/or CELEBRATION FOR THE CRITTERS mark for fund raising services for zoological activities, would be likely to believe, upon encountering applicant’s CARS FOR CRITTERS mark for charitable fund raising, that such services emanate from, or are sponsored by or affiliated with the same source.

It is well established that one who adopts a mark similar to the mark of another for the same or closely

⁵ The American Heritage Dictionary of the English Language (4th ed. 2000).

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related goods or services does so at its own peril, and to the extent that we have any doubt as to likelihood of confusion, we must resolve that doubt against the newcomer and in favor of the prior registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: Borgen's opposition is dismissed; and the Zoo's opposition is sustained.