

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

Mailed:  
July 25, 2008  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kidsart, Inc.

v.

KidzArt Texas, LLC

Opposition No. 91166639 against Serial No. 76581686  
Cancellation No. 92045114 against Reg. No. 2491627

David G. Bayles of Arent Fox, LLP for Kidsart, Inc.

Maria Crimi Speth for KidzArt Texas, LLC.

Before Hairston, Bucher and Mermelstein, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Defendant, KidzArt Texas, LLC, seeks registration on  
the Principal Register of the following mark:

**KIDZART**

for services recited as follows:

franchise services, namely offering technical  
assistance in the establishment and/or  
operation of educational programs and after-  
school enrichment programs, in International  
Class 35; and

educational services, namely conducting  
classes in the field of art and distributing

materials in connection therewith, in International Class 41.<sup>1</sup>

In addition, defendant owns a registration for the term **KIDZART** (*in standard character format*) for services recited as "educational services, namely, conducting classes in the field of art" in International Class 41.<sup>2</sup>

### **I. CLAIMS AND DEFENSES**

In the opposition and cancellation, plaintiff, Kidsart, Inc., alleges that long prior to defendant's use or filing dates of the above-noted application and registration, plaintiff adopted and continuously used the term **KIDSART**, which has acquired distinctiveness as a source-indicator for plaintiff's art instruction services. Plaintiff further alleges that defendant's above-noted mark so resembles plaintiff's previously-used designation as to be likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C.

§ 1052(d). In its answers, defendant denied the salient

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<sup>1</sup> Application Serial No. 76581686 was filed on March 17, 2004 based upon allegations of first use anywhere and first use in commerce for franchise services at least as early as July 2002 and allegations of first use anywhere and first use in commerce for the recited educational services at least as early as August 1997. Defendant claimed that the mark had acquired distinctiveness as a source indicator consistent with Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

allegations and asserted the affirmative defense of the genericness of plaintiff's alleged mark. In addition to denying this allegation, plaintiff was allowed to amend its claims to add the alternative claim that in the event we should find its claimed term, **KIDSART**, to be generic, we should find the same as to defendant's alleged mark, **KIDZART**. Defendant has denied this claim as well.

## **II. THE RECORD**

By operation of Trademark Rule 2.122, the record includes the pleadings and the files of the subject application [Serial No. 76581686] and registration [Reg. No. 2491627].

In addition, the parties have submitted trial testimony with related exhibits taken by each party of the following witnesses:

- (1) Trial Testimony taken January 5, 2007, and again on October 23, 2007, of Sher Warren, plaintiff's Vice President and Executive Director, with related exhibits;
- (2) Trial Testimony taken January 9, 2007 of Anjale Renee Armand Perrault, former manager

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<sup>2</sup> Registration No. 2491627 issued on the Supplemental Register on September 18, 2001; Section 8 affidavit (six-year) accepted.

of plaintiff's studios in Redondo Beach, California, and current part owner of Kidsart Redondo Beach, Inc., a licensee of the **KIDSART** designation and curriculum, with related exhibits;

- (3) Trial Testimony taken January 9, 2007 of Ellen Wesel, director of strategy and business development at Raytheon Corporation, and mother of a boy enrolled in plaintiff's Redondo Beach art class, with related exhibits; and
- (4) Trial Testimony taken January 9, 2007 of Diane M. Naletich, medical devices sales representative for Medicis Aesthetics and the mother of one of plaintiff's students and the Chair of the Arts and Music Advocacy at an elementary school and local PTA, with related exhibits.

In addition, the parties submitted various materials under notices of reliance:

- (1) Plaintiff's notice of reliance filed on June 27, 2007, comprising: (a) a copy of defendant's Registration No. 2491627 [**KIDZART**]; (b) Office actions from the United

States Patent and Trademark Office during the prosecution of three trademark applications (e.g., defendant's involved application, Serial No. 76581686 [KIDZART], plaintiff's Serial No. 76513638 [KIDSART],<sup>3</sup> defendant's now-abandoned Serial No. 78434787<sup>4</sup> and an application filed by an unrelated third party, Serial No. 79001179).<sup>5</sup>

- (2) Plaintiff's notice of reliance filed on June 27, 2007, consisting of defendant's responses to plaintiff's first set of Interrogatories;
- (3) Defendant's first Notice of Reliance on September 10, 2007, including photographs dated May 2007, from a Michaels Arts & Crafts store; plaintiff's responses to defendant's First Set of Requests for Admission,

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<sup>3</sup> Serial No. 76513638 was filed by Kidsart, Inc. on May 12, 2003, claiming first use anywhere at least as early as June 1, 1986 and first use in commerce at least as early as January 1, 2002.

<sup>4</sup> Serial No. 78434787 was filed by KidzArt Texas, LLC on June 14, 2004 in International Classes 35 and 41; expressly abandoned on February 1, 2005.



<sup>5</sup> Serial No. 79001179 was filed by Henkel KGaA for a variety of craft projects in International Class 16, 20 and 28.



plaintiff's Responses to defendant's First Set of Interrogatories, and documents filed with the Secretary of State of California by various KidsArt entities;

- (4) Defendant's Second Notice of Reliance, also filed on September 10, 2007, having 131 articles from printed publications; and
- (5) Plaintiff's notice of reliance filed on October 26, 2007, miscellaneous third-party registrations for marks including the word "Kid" or "Kids" in the mark and registered on the Principal Register, namely, **KIDSBOOKS, KID CUISINE, KIDSPY** and **SPY KIDS**.

### **III. PRELIMINARY MATTERS**

Both plaintiff and defendant have maintained objections to exhibits and testimony on various grounds. Where specific objections to evidence are not addressed below, we have nonetheless considered all these objections and have accorded only appropriate weight and probative value to the evidence in view of those objections.

Plaintiff objects to the admission of a variety of documents reflecting corporate filings with the Secretary of State, State of California, over a period of years, by

various KidsArt entities, on the basis that the notice of reliance for these documents fails to identify generally the relevance of the material being offered as required by 37 C.F.R. 2.122(e), and that the authenticity of the documents is not established under the Federal Rules of Evidence. On October 17, 2007, before the conclusion of the testimony periods, counsel for plaintiff informed counsel for defendant that the notice of reliance was deficient as to these documents, inviting defendant to correct the deficiency by filing an amended notice of reliance. Defendant never did so.

Defendant attached to its brief as Exhibit #1 a copy of a detailed email exchange between plaintiff's counsel and defendant's counsel, in which on October 11, 2007, defendant's counsel stated that the "... intended use/relevance of these documents was that third parties who are not affiliated and do not have the same principals use the Kids Art name." While attaching purported evidence to a brief on the merits is not a proper method of submitting evidence, we view this submission (Exhibit #1) as defendant's response to plaintiff's evidentiary objection. This email explanation is as detailed as would be appropriate in a Notice of Reliance, and the complaining party suffered no prejudice inasmuch as plaintiff was

advised in a timely manner by defendant as to the alleged relevance of the materials. To deny consideration of these public records now would be to elevate form over substance with respect to defendant's failure to state the relevance of the materials within the earlier notice of reliance. These documents are otherwise appropriate subject matter for a notice of reliance. Accordingly, we find these documents reflecting corporate filings with the California Secretary of State to be admissible. Moreover, on the merits, we fail to see any prejudice to plaintiff in having these proffered documents admitted into the record of this proceeding inasmuch as these third parties are plaintiff's licensees. According to testimony during this proceeding, this third-party usage of the **KIDSART** term is subject to plaintiff's control and such use inures to plaintiff's benefit.

Plaintiff also objects to the admission of two photographs that defendant submitted under stipulation pursuant to 37 C.F.R. § 2.123(b), arguing that they are irrelevant and immaterial. We disagree, accept them into the record and accord them the probative value to which they are entitled.<sup>6</sup>

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<sup>6</sup> We hasten to add that these photographs have limited probative value, but do appear to corroborate the usage seen in the 131 periodical articles defendant has made of record.

Plaintiff also objects to the admission of forty exhibits that were the subject of defendant's first set of requests for admission. Focusing particularly on exhibits 2 through 33, we note that these are web pages promoting a wide variety of "kids' art classes." Plaintiff denied all the salient requests for admission as to the content of these alleged Internet pages. Defendant argues that it is imperative that we review these exhibits to make sense of plaintiff's responses to defendant's first set of requests for admission.

We find that exhibits 2 through 33 are inadmissible because they do not meet the requirements of 37 C.F.R. 2.122(e). Internet postings are transitory in nature and they have not been properly authenticated by the testimony of person who downloaded the websites. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998) [excerpts from websites are admissible evidence to support a motion for summary judgment when the Internet information is supported by the declaration of the person who accessed and printed it] and Fed. R. Civ. P. 56(e). Individual web pages posted on the Internet cannot be considered the equivalent of printouts from a NEXIS or WestLaw search where printouts are the electronic equivalents of the printed publications. Accordingly, at trial, testimony itself is necessary to

support Internet postings. TBMP § 528.05(e) (2d ed. rev. 2004).

Given that these Internet pages are not independently admissible, we agree with plaintiff that "[defendant] is improperly trying to bootstrap into evidence, by means of requests for admission, documents for which there is no proper basis for admission." Plaintiff's reply brief, Appendix A at viii. Inasmuch as these were *denials* of a request for admission (and not "*admissions* to a request for admission"), they are clearly not admissible under Trademark Rule 2.120(j)(3)(1).

Exhibits 34 - 40 represent electronic versions of printed publications, and like the 131 exhibit tabs submitted under defendant's second Notice of Reliance, we admit these articles into the record and accord them the probative weight to which they are entitled.

Defendant objects to the admission of a number of third-party registrations (e.g., all on the Principal Register for marks having the word "Kid" or "Kids" in the mark and allegedly used in a context where children are the primary consumers of the goods or services) on the grounds that they are irrelevant and immaterial. However, although these registrations are not for marks used in connection with art instruction services for children, we admit this

evidence into the record and accord the registrations the probative weight to which they are entitled.

#### **IV. FACTUAL FINDINGS**

The record establishes all of the following facts in this case:

In June 1986, plaintiff started using the term **KIDSART** to promote art instruction services. Plaintiff has consistently promoted its services through newspaper and magazine advertisements, signs, flyers and word of mouth wherever it has studios, namely, Los Angeles County, San Francisco and the Seattle area. Plaintiff attributes the growth of its network of studios and its enrichment programs to distributing "thousands of flyers," participating in summer fairs, and benefiting from "word of mouth" recommendations. Plaintiff spent approximately \$60,000 for advertising from 1986 to 1997, and \$384,000 for advertising from 1997 to 2006. Unsolicited promotion has included several television news segments, an article in *The Los Angeles Times*, and a request from the International Visitors Council of Los Angeles for plaintiff to host visiting dignitaries from the Yokohama Museum of Art.

Plaintiff had a single studio in 1986. By January 2007, plaintiff had seventeen studios in California and one

in Washington State. Over the history of the company, total enrollment in plaintiff's studios has exceeded 250,000. In addition to providing art instruction services in its eighteen studios, since 1989, plaintiff has also offered enrichment programs involving much the same services, also offered in connection with the term, **KIDSART**. Over this time period, plaintiff has provided these services to more than 15,000 students through sixty-eight enrichment programs in twenty-eight different cities. As a result, plaintiff has a **KIDSART** presence, whether by studio or enrichment program, in forty-one different California cities and in one city in Washington. While pre-teens are clearly the primary target for plaintiff's art instruction services, at least some of its services have been explicitly provided to teens. In recent years, promotional materials have been explicit in pointing to programs for "kids ages 4 to adult," although adults have been a very small contingent, whether enrolled as art students themselves or participating as parents of children enrolled as students (e.g., "Mommy and Me" classes).

Plaintiff is a closely-held corporation substantially owned by Sheryl ("Sher") Warren, and her husband, Edward

Joel Warren.<sup>7</sup> Plaintiff's business model relies upon cross-ownership with other "KidsArt" corporations. Accordingly, Ms. Warren is a majority owner in many of the incorporated studios, and her daughter is a majority owner in the studios in Los Altos and Redondo Beach. Plaintiff controls the use of its alleged mark through licensing agreements and/or "shareholder agreements" with these entities. Plaintiff and its licensees have used the term "KidsArt" in the form of a trade name and as an alleged service mark.

The record shows that defendant has used its mark **KIDZART** since August 1997 (through its predecessor in interest).

## V. ANALYSIS

### A. Standing

Plaintiff'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 has 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

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<sup>7</sup> Their son evidently has a 3% share of the corporation. Warren testimony of October 23, 2007, p. 6.

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). Plaintiff has submitted substantial evidence of its use for years of the term "KidsArt." We consider this evidence as sufficient to establish plaintiff's interest and, therefore, standing in this proceeding.

In addition, we note that registration of plaintiff's pending application Serial No. 76513638 for KIDSART has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based upon defendant's KIDZART Registration No. 2491627,<sup>8</sup> and the Trademark Examining Attorney also referred to defendant's application Serial No. 76581686.<sup>9</sup> Hence, plaintiff's evidence of its pending trademark application,

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<sup>8</sup> Prosecution of this '638 application was correctly suspended pending the final disposition of the instant cancellation proceeding. TMEP § 716.02(a).

<sup>9</sup> Plaintiff's application Serial No. 76513638 was filed ten-months before defendant's involved application Serial No. 76581686. The best practice would have been for the Trademark Examining Attorney assigned to defendant's later-filed application to alert defendant to plaintiff's intervening, prior-filed, conflicting application despite the fact that defendant owns a registration of a mark that would be considered a bar to registration of plaintiff's earlier-filed application. 37 C.F.R. § 2.83; TMEP § 1208.01. This failure to follow the proper practice forced plaintiff to oppose a later-filed application, and presents the Board with several sets of "difficult facts" in the instant litigation. [See e.g., footnote 13]

and evidence that its application has been suspended pending resolution of the subject application demonstrates that plaintiff has a reasonable belief that it would be damaged by registration of defendant's mark, thus establishing its standing. See *Life Zone Inc. v. Middleman Group, Inc.*, [Opp. No. 91160999, slip Op. at 14 - 15], \_\_\_ USPQ2d \_\_\_ (TTAB July 15, 2008), citing to *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

**B. Is plaintiff's alleged common law mark distinctive?**

Plaintiff does not have a federal registration for the term **KIDSART**. A party opposing registration of another's trademark due to a likelihood of confusion with its own unregistered term cannot prevail unless it shows that its term is distinctive of its goods or services, whether inherently or through a demonstration of acquired distinctiveness. See *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43-45 (CCPA 1981). Inasmuch as defendant has claimed that plaintiff's designation is generic, a critical issue before us is whether **KIDSART** is inherently distinctive, and if not, whether plaintiff has demonstrated

that such term has acquired distinctiveness as a source indicator for plaintiff's services.

In making this determination, we turn first to the evidence submitted by defendant. Most significantly, defendant placed into the record 131 newspaper articles.

In making this determination, we turn first to the evidence submitted by defendant. Inasmuch as the first forty articles of the 131 newspaper articles that defendant placed into the record are representative of the balance of the articles, we have set out excerpts from each of these articles presented in the record in full [**emphasis** in printouts]:

HEADLINE: "They art the future children who want more exposure to the arts take in outside schooling"

"There is so much reward in teaching *kids art*," says [Suzanne] Henderson, whose husband, Dal, has a studio at the downtown Studios @ the Bus Barn, where all the kids in her classes show their art each May." Spotlight by Marty Berry, *Fresno Bee*, October 23, 2005 [defendant's articles tab #2].

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HEADLINE: "Pumpkin Fever"

"ArtHouse Kids: Day of the Dead art show and open house, featuring art by local artists and ArtHouse students ... ArtHouse *Kids Art* School and Gallery ... [www.arthousekids.com](http://www.arthousekids.com), *San Jose Mercury News* (CA), October 27, 2005 [defendant's articles tab #3].

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HEADLINE: "It's Happening In Niagara This Week"

NIAGARA FALLS:

"Free *Kids Art* Classes every Sunday from noon to 2 p.m. at Café Tu Tu Tango ... ." *Niagara This Week*, Section B, October 28, 2005 [defendant's articles tab #4].

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HEADLINE: "Young at Art"

"Adult artists are always looking at the works of children," he says, "They're looking at the freshness, the honesty, the spontaneity. That says, "Let's look at what we're doing when we're teaching *kids art*. ... ." *The Intelligencer* (WV); Features, Local Section, November 1, 2005 [defendant's articles tab #5].

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HEADLINE: "Drawing on desire to teach *kids art*:"

"With schools offering few classes, this instructor finds an alternate path" City by Ralph Montano, *The Sacramento Bee*, November 3, 2005 [defendant's articles tab #6].

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HEADLINE: "Calendar"

"Ongoing: *Kids' art* classes – Wednesday, 4–6 p.m. Grand Lake Neighborhood Center ... ." *Contra Costa Times* (Walnut Creek, CA), "Calendar" Section, November 4, 2005 [defendant's articles tab #7]; this entry is repeated on August 4, 2006/tab #9, August 18, 2006/tab #11, August 25, 2006/tab #17, September 1, 2006/tab #23.

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HEADLINE: "Weekly Entertainment Planner for July 13, 2006"

"DULUTH ART INSTITUTE offers these classes ...

*Kids Art* Camp: Passport to the World ..."

*Duluth News Tribute*; July 13, 2006, also available at 2006 WLNR 12054914 [defendant's articles tab #8].

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HEADLINE: "A Roundup of Regional Freebies"  
"FAMILY FUN FESTIVAL With marching bands, music acts, art workshops and more... There will be *kids' art* workshops, free health screenings, ... ." *The Baltimore Sun*, August 10, 2006, also available at 2006 WLNR 13907625 [defendant's articles tab #10].

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HEADLINE: "Auburn starts its engines — Annual [Auburn Cord Duesenberg] Festival is a celebration of community and classic cars"  
"*Kids Art* Tent Children ages 2 – 10 can enjoy storytelling, music and crafts ..." *Fort Wayne News Sentinel* (IN), August 23, 2006, also available at 2006 WLNR 14617127 [defendant's articles tab #12]; this entry is repeated on September 2, 2006/tab #25; this entry is similar to one in the *Fort Wayne Journal Gazette Weekender*, on August 25, 2006, also available at 2006 WLNR 14785497 [defendant's articles tab #18].

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HEADLINE: "Neighborhood News in Brief"  
"DELTONA – The *Kids Art* Class Show is on display at the Deltona Arts & Historical Center through Sept. 4." *Daytona News-Journal*, August 23, 2006, also available at 2006 WLNR 14730817 [defendant's articles tab #13].

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HEADLINE: "Entertainment > Eye Headlines"  
"PENINSULA Palo Alto Festival of the Arts. Featuring more than 300 artisans, Italian street painting, entertainment on three stages, California wines and microbrews, gourmet foods, *kids' art* studio..." *San Jose Mercury News*, August 24, 2006, also available at 2006 WLNR 14653682 [defendant's articles tab #14].

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HEADLINE: "A Roundup of Regional Freebies"  
"A DAY AT HARBOR EAST For an afternoon filled with music and art, visit the Harbor East Fine Arts and Music Festival Saturday... Festival-goers can also watch street performers, visit the *kids' art* and crafts area ... ." *The Baltimore Sun*, August 24,

2006, also available at 2006 WLNR 14753240 [defendant's articles tab #15].

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HEADLINE: "GO! For Kids"  
"ART: ONGOING"

*Kids' art*. 3:30-4:30 p.m. ongoing Mondays in four-week sessions at the Oldemeyer Center ... *Monterey County Herald* (CA), "Calendar" section, August 24, 2006, also available at 2006 WLNR 14653989 [defendant's articles tab #16]; this entry is repeated on August 27, 2006/tab #21, also available at 2006 WLNR 14840514; August 31, 2006/tab #22, also available at 2006 WLNR 15083255; September 3, 2006/tab #27; September 7, 2006/tab #28; Sept 14, 2006/tab #29; September 17, 2006/tab #31; September 21, 2006/tab #36; and October 1, 2006/tab #38.

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HEADLINE: "Out and About"  
"ETC." -- Around the World -- This journey will include historic film and photography, *kids' art*-making, Flamence and storytelling ... ." *South Florida Sun-Sentinel*, Lifestyle Section, August 26, 2006, also available at 2006 WLNR 14806535 [defendant's articles tab #19].

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HEADLINE: "Monthly State Travel Calendar: September"

"Jubilee Festival. Daphne. Fine arts and crafts, live local entertainment, *kids art*. Free. 9 a.m.-3 p.m. Sept. 9." *Birmingham News* (AL), Travel Section, August 27, 2006, also available at 2006 WLNR 15026544 [defendant's articles tab #20].

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HEADLINE: "You can rock out to country at two fall concerts"

"... [K]eeping the children of Hanover Park entertained shouldn't be a problem with all the *kids' art* programs that the park district offers." *Daily Herald* (Arlington Heights, IL), September 1, 2006, also available at 2006 WLNR 15502846 [defendant's articles tab #24].

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HEADLINE: "Fifth Annual International Route 66 -- Mother Road Festival highlights"

"Saturday, Sept. 23: Noon to 4 p.m.: *Kids Art* Station sponsored by the Springfield Area Arts Council on the Old State Capitol grounds." *Springfield State Journal-Register* (Springfield, IL), September 15, 2006, also available at 2006 WLNR 16249941 [defendant's articles tab #30].

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HEADLINE: "Young at Art"

"... You decide to fork out for some quality *kids' art* in a professional setting... Luckily, Tacoma offers quite a few options when it comes to art for young kids, and most go way beyond the finger-paint level .... *The News Tribune* (Tacoma, WA), September 19, 2006, also available at 2006 WLNR 16271819 [defendant's articles tab #32].

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HEADLINE: "Briefs: Bair foundation to hold foster parenting program"

"Gilcrease Museum ... will offer 'Crease *Kids Art* Series ... ." *Tulsa World*; Community Section, September 20, 2006, also available at 2006 WLNR 16382341 [defendant's articles tab #33].

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HEADLINE: "*KIDS ART* FESTIVAL SATURDAY"

"... The art festival is a place for youth to exhibit and sell their arts and crafts ... ." *Lexington Herald-Leader* (KY), Communities Section, September 20, 2006, also available at 2006 WLNR 16279981 [defendant's articles tab #34].

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HEADLINE: "75 Years of Plaza Art"

"The *Kids Art* Workshop featuring Wonderscope Live! And the American Century Investments Community Arts Experience are back for the fourth time ... ." *The Kansas City Star* (MO), September 21, 2006, also available at 2006 WLNR 16378147 [defendant's articles tab #35].

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HEADLINE: "This just in"

"Art Classes -- The Deltona Arts Center ... will offer the following art classes for youth beginning Oct. 3: *Kids Art*, 3:30 - 5:30 p.m. Tuesdays." *The Orlando Sentinel* (FL), October 1, 2006, also available at 2006 WLNR 16997063 [defendant's articles tab #39].

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HEADLINE: "Visual Arts"

"PARK UNIVERSITY, GRAHAM TYLER MEMORIAL CHAPEL: Pink Flamingoes: Art@Park' ... food for sale, free *kids art* activities..." *The Kansas City Star* (MO), October 5, 2006, also available at 2006 WLNR 17231872 [defendant's articles tab #40].

In some of these thirty-eight stories,<sup>10</sup> the highlighted words "kids art" in the context of "... teaching kids art ..." really means "teaching art to kids" [defendant's articles tabs ##2 and 6]. Other times it appears as a noun, representing a type of art work destined for one's refrigerator door [defendant's article tab #32]. Sometimes it stands alone, suggesting an activity [defendant's article tab #20]. However, as argued by plaintiff, it usually appears as an adjective, modifying nouns such as "school,"

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<sup>10</sup> The articles at tabs ## 1 and 37 were from foreign newspapers, and under the circumstances of this alleged service mark have very little probative value for purposes of descriptiveness in the U.S.A.

"studio," "classes," "program," "workshops," "tent," "camps," "area," "station," "series," "festival," or "activities." The majority of these entries appear in listings of weekend, family activities, often offered in conjunction with special festivals, celebrations of the visual arts, etc. The commonality lies in developing the artistic skills of children, exhibiting their art work and sometimes selling it to members of the public.

We find that the term "kids art" (or "kids' art") immediately conveys information about the nature of plaintiff's services, namely, that they offer art instruction services primarily to children. We are not persuaded by plaintiff's argument that one necessarily reaches a different result when taking out the space between the words, to create "KidsArt." Without a doubt, we find that plaintiff's alleged mark is merely descriptive under Section 2(e)(1).<sup>11</sup> While the record presented by defendant does not meet its high burden of demonstrating that this term is generic, we find that on the *Abercrombie & Fitch*<sup>12</sup>

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<sup>11</sup> This conclusion is also consistent with the way the United States Patent and Trademark Office has handled defendant's Registration No. 2491627 (Supplemental Register) and plaintiff's pending SN 76513638 (requiring a claim of acquired distinctiveness).

<sup>12</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976)

spectrum of distinctiveness of marks, upon adoption by plaintiff, this term was much closer to the "highly descriptive" end of the continuum than to the "merely suggestive" side.

Under the rule of *Otto Roth*, having determined that the term "Kidsart" is not inherently distinctive for plaintiff's art instruction services, we must review the record to determine whether or not plaintiff has demonstrated that the allegedly conflicting service mark has acquired distinctiveness as a source-indicator for its services. In this regard, we note that the evidentiary burden on the proponent of the term to demonstrate acquired distinctiveness varies directly with the degree of descriptiveness of the designation. *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990); and *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Through the testimony of Ms. Sheryl Warren and the exhibits attached thereto, it is clear that the alleged service mark and trade name, "KidsArt," has been in continuous use since July of 1986. This evidence has included articles having a byline as well as paid advertisements in local newspapers. The number of studios

using the alleged service mark and trade name in California has gone from a single studio up to the current range of fifteen to eighteen in different cities. The total spending on promotional activities in the dozen years between 1986 and 1997 was approximately \$60,000. In the ten years of 1997 to 2006, plaintiff committed \$384,000 to promotional expenditures.

Given that the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness, we find this evidence inadequate to demonstrate acquired distinctiveness for this highly descriptive matter in the context of art instruction services.

We do not question but that plaintiff expected that this term would distinguish its services from other service marks adopted and used by competitors in the field of art instruction services. On the other hand, having chosen a highly descriptive term as its service mark, plaintiff accepted the risk that this term may not, in fact, function as a source indicator for its services. See *In re The Standard Oil Company*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960) [**GUARANTEED STARTING** for winterizing automobile engines].

In this context, while we find that plaintiff's level of gross advertising expenditures may well have been

effective in drawing students to plaintiff's studios and enrichment programs, this evidence is in no way determinative of the success of this promotional effort in creating a source identifier. *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The primary evidence submitted with respect to plaintiff's customers' understanding of the term consists of the trial testimony of Ms. Wesel and of Ms. Naletich. Ms. Wesel is the mother of a boy enrolled in plaintiff's Redondo Beach art class, who based upon a conversation with a family friend in the grocery store, deduced that defendant (or another third party) was offering art instruction in a local synagogue under a designation phonetically identical to plaintiff's alleged mark. Similarly, Ms. Naletich is the mother of one of plaintiff's students who experienced confusion over a silent auction fund-raiser in 2005. In the weeks leading up to the auction, she understood from the auction chairperson that plaintiff had made a donation to the auction, when in fact it was defendant who had done so. Up until that point, upon hearing of art instruction called "Kids Art," she always thought of plaintiff's services. However, we find that this testimony is insufficient to establish that plaintiff's customers understand this term to identify the source of plaintiff's services.

As to plaintiff's arguments based upon Ms. Warren's testimony referencing specific vignettes of consumer recognition of plaintiff's designation, or instances of actual confusion with defendant's mark, we find that the existence of two people who may associate the term with plaintiff is simply insufficient for us to find that the term functions as a trademark for plaintiff's services. See *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988). As noted by defendant, several of these instances of purported, actual confusion mentioned by Ms. Warren are arguably illustrative of the use of "Kids' Art" generically, or even suggest consumer recognition for defendant's "KidzArt" designation.

Finally, these files contain no direct evidence indicating that the relevant consumers of such services have come to view the designation as plaintiff's source-identifying service mark. While there is certainly no requirement that cases involving "highly descriptive" marks must contain a properly designed and executed consumer survey, in reality, such would be much more compelling evidence than the opinions of two hand-picked persons that such a highly descriptive term indeed functions as a source-indicator.

Hence, taking into consideration the entire record herein, we find that plaintiff has failed to make a sufficient showing of acquired distinctiveness to support a likelihood of confusion determination against defendant.

Accordingly, under the rule of *Otto Roth*, on this record, plaintiff cannot prevail against defendant in either proceeding due to a likelihood of confusion with its own unregistered term.<sup>13</sup> Insofar as plaintiff's alternative claim is concerned, plaintiff put in no evidence to support its argument that respondent's **KIDZART** mark is generic; and as to plaintiff's argument that such mark is generic if plaintiff's own **KIDSART** designation is found to be generic, we have not found plaintiff's **KIDSART** term to be generic. To the extent that plaintiff also argues that defendant's **KIDZART** mark is descriptive, we note that defendant seeks registration of its **KIDZART** mark in

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<sup>13</sup> We are aware of the conundrum presented to plaintiff and to the United States Patent and Trademark Office by the posture of this dispute between these parties as a result of this decision. After weighing voluminous amount of documentary evidence contained in this extensive *inter partes* record, we have found that plaintiff failed to make a sufficient showing of acquired distinctiveness. Contrariwise, the involved Trademark Examining Attorney has accepted plaintiff's *ex parte* claims of acquired distinctiveness for **KIDSART** - a position not binding upon this Board. Yet, given our decision on acquired distinctiveness herein, we have no justification for making a determination as to the ultimate issue of likelihood of confusion.

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application Serial No. 76581686 under the provisions of Section 2(f) and its Registration No. 2491627 for the **KIDZART** mark issued on the Supplemental Register. Thus, defendant has conceded that its mark is merely descriptive.

*Decision:* The opposition is hereby dismissed and Serial No. 76581686 will proceed to issue in due course, while the petition to cancel Reg. No. 2491627 is hereby denied.