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Subject: U.S. TRADEMARK APPLICATION NO. 86048207 - PUP SCOUTS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86048207 MARK: PUP SCOUTS	
CORRESPONDENT ADDRESS: MATTHEW H. SWYERS THE TRADEMARK COMPANY 344 MAPLE AVE W STE 151 VIENNA, VA 22180-5612	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: PUP SCOUTS, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS: mswyers@thetrademarkcompany.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the applied-for standard character mark PUP SCOUTS on the grounds of a likelihood of confusion under Trademark Act

Section 2(d), 15 U.S.C. Section 1052(d) with U.S. Registration Nos. 3501260, 3501263, 3501265, and 3501266.

FACTS

On August 26, 2013, applicant filed a use based collective membership application for the standard character mark PUP SCOUTS “To indicate membership in an organization for pets and their human counterparts.”

On December 23, 2013, registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) based on a likelihood of confusion with U.S. Registration Nos. 3501260, 3501263, 3501265, and 3501266, and a disclaimer was required of the term PUP. The cited registrations are as follows:

DOG SCOUTS OF AMERICA in standard character (Reg. No. 3501260) for (in part) “Association services, namely, promoting the interests of pets and pets parents through the promotion of responsible pet parenting and ownership and through educating people about the care and training of their dogs and the importance of the human/canine bond”

DOG SCOUTS OF AMERICA in standard character (Reg. No. 3501263) for “Providing live and on-line educational services, namely, classes, seminars and camps in the fields of responsible pet parenting and ownership; dog training services, conducting seminars on dog training and dog care, conducting dog training; dog training camps; and providing on-line educational information in the field of dog care and training”

DOG SCOUTS OF AMERICA DOG SCOUTS and design of dog (Registration Nos. 3501265 and 3501266) for respectively, “Providing live and on-line educational services, namely, classes, seminars and camps in the fields of responsible pet parenting and ownership; dog training services, conducting seminars on dog training and dog care, conducting dog training; dog training camps; and providing on-line educational information in the field of dog care and training” and for (in part) “Association services, namely, promoting the interests of pets and pets parents through the promotion of responsible pet parenting and ownership and through educating people about the care and training of their dogs and the importance of the human/canine bond”

Applicant submitted a response on June 17, 2014 traversing the refusal and agreeing to the disclaimer. The examining attorney issued a final refusal under Trademark Act, Section 2(d) on July 11, 2014. The applicant filed a notice of appeal on August 4, 2014 and submitted an appeal brief on October 3, 2014, which was forwarded to the examining attorney on October 10, 2014.

ISSUE

The only issue on appeal is whether applicant's mark PUP SCOUTS, when used on or in connection with the identified membership mark in the application, so resembles the DOG SCOUTS OF AMERICA marks in standard character form and with design in the above cited U.S. Registrations as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act, Section 2(d); 15 U.S.C. Section 1052(d).

ARGUMENT

I. APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT'S MARKS AND THE SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION EXISTS UNDER SECTION 2(D) OF THE TRADEMARK ACT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. THE TWO MARKS SHARE IDENTICAL WORDING AND CONVEY THE SAME OVERALL COMMERCIAL IMPRESSION

The marks of the applicant and registrant convey the same overall commercial impression because they are comprised of the identical term SCOUT combined with a word that refers to a canine animal. In the Office action of December 23, 2013, the examining attorney submitted a dictionary definition of PUP. A PUP is defined as “a young dog.” See previously attached evidence from *Webster’s New World College Dictionary*, found online at the following:

<http://www.yourdictionary.com/pup#websters>

Therefore, inasmuch as the definition of the term PUP is encompassed by the meaning of the term DOG, the commercial impression of the wording PUP SCOUTS is essentially the same as that of the wording DOG SCOUTS.

Turning next to the addition of the wording OF AMERICA and the design of the dog in the registered marks, it is the position of the examining attorney that the addition fails to obviate the fact that the overall commercial impressions of the marks are the same. The wording OF AMERICA is geographically descriptive and has been disclaimed in the registrations. The design of the dog merely mirrors and reinforces the meaning of the word DOG.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when

determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Furthermore, with regard to the word portions of a mark, disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

The applicant argues that consumers are more likely to focus on the first word, prefix or syllable in the marks. It asserts that since the term PUP refers to puppies or young canines, the marks are not identical. Therefore, the marks differ in connotation and appearance. Applicant's brief pgs. 10-11.

The applicant's argument is unpersuasive for the following reasons. First, it is contradicted by the dictionary definition of PUP submitted by the examining attorney, which unequivocally establishes that a PUP is a dog, albeit a young dog. Second, the applicant ignores or fails to properly give weight to the fact that both marks share the arbitrary word SCOUTS. Finally, the applicant is basically arguing that because the marks are not identical in every respect, the marks *per se* cannot be confused by consumers. However, this is not the standard applied in a Trademark Act, Section 2(d) analysis.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

B. THE REGISTRANT'S SERVICES, CHANNELS OF TRADE AND CLASS OF CONSUMERS ARE HIGHLY RELATED TO THE SERVICES OF THE APPLICANT

With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v.*

Lion Capital LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registrations have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that applicant’s membership organization and registrant’s services travel in all normal channels of trade, and are available to the same class of purchasers. Furthermore, the application uses broad wording to describe the membership organization and this wording is presumed to encompass all organizations of the type described, including those in registrant’s more narrow identification.

Specifically, the applicant’s mark is used to indicate membership in an organization for pets and their human counterparts. The registrant’s services are for pets and pet parents. Since pets are animals owned by humans, the human counterparts of pets are the owners of the pets. Owners of pets are obviously “pet parents.” Therefore, the class of consumers is identical. The applicant’s identification

does not describe either the particular type of organization or the purpose of the organization. Thus, the applicant's organization is presumed to include an association that promotes all the various issues and provides all the educational services and information listed in the registrations.

In the Office action of December 23, 2013, the examining attorney submitted webpages from the websites of the applicant and registrant clarifying the nature of the services and establishing the close relationship of applicant's membership organization and registrant's services. The registrant's webpages feature information about becoming a member and the benefits of membership, including information about joining and running a "troop." Likewise, the applicant's webpages include information about joining a member troop and about various related educational projects and meetings. Based on the evidence, it appears that the applicant's membership and registrant's services are offered in connection to a "scouting" organization akin to the Boy Scouts and/or Girl Scouts, where dogs and their owners join member troops, learn about and discuss relevant dog related issues, promote the relationship between dogs and their owners, and earn merit badges. The evidence submitted in the prior Office action is as follows:

1) Registrant's webpages with relevant excerpts

<http://dogscouts.org/find-a-troop/>

("Join DSA! Annual DSA membership dues need to be renewed 1 year from date of initial membership...your membership card will be mailed to you." Links to other parts of registrant's website are entitled "Find a Troop" and "Merit Badges")

<http://dogscouts.org/join-dsa/>

("Find a Troop...Contact a Troop Leader")

2) Applicant's webpages with relevant excerpts

<http://www.pupscoutsandparents.org/>

(Links to other parts of the website are entitled "Badges/Patches" and "Troop Location;" "We are a group that encourages interaction between pups and parents...you can get busy working on various badges, patches...We are here to help you work...with a troop")

<http://www.pupscoutsusa.com/about-us.html>

("...Training and Manners became very important badges" List of activities of organization are entitled "Training," "Grooming," "Help others," "Teach others that one's pets are family")

The applicant does not appear to dispute the fact that the registrant's services and applicant's membership organization are extremely similar, if not identical, in general nature and function (e.g. dog and dog owners join troops, engage in various educational activities, promote dog and dog owner issues, earn merit badges, etc.). Instead, its arguments attempt to differentiate the services by restricting the geographic scope and marketing channels of the registrant's services.

The applicant argues in its brief that the channels of trade are different because the organization associated with the PUP SCOUTS mark "is currently available through local events where troops are located, as well as through social media outlets," and that it "offers franchised use of the PUP SCOUTS name for retail sales." Applicant's brief pg. 11. In contrast, the applicant claims that the registrant's services are "offered exclusively to consumers located in Michigan and Texas." Applicant's brief pg. 11.

Moreover, applicant states that the registrant's "merit badges and bandanas are not available on a retail website, but rather via purchase through the DOG SCOUTS organization." Applicant's brief pg. 11. In support of these claims, the applicant submitted an affidavit from the applicant Kay Lorinc in its communication of June 17, 2014.

The applicant also asserts that the services are marketed differently. It states that its services bearing the PUP SCOUTS mark are "marketed primarily through the Pup Scouts handbook, cable television and radio commercials, Spanish language television channels, German language television channels, events such as "Tea Pawty with the pawrents," and "Mutts and Martinis," trade shows, Oscar Swag bags, websites blogs, social media, partnerships, brochures banner ads, newsletters, advertisements on restaurant menus, and on Craigslist," whereas, the registrant's marks, while also marketed on a website, are targeted towards potential members located in Michigan and Texas. Applicant's brief pg. 12.

Furthermore, applicant argues that the registrant does not "appear to advertise through a handbook, cable television and radio commercials, Spanish language television channels, German language television channels, events such (Tea Pawty with the pawrents, Mutts and Martinis), trade shows, Oscar Swag bags, websites blogs, social media, partnerships, brochures banner ads, newsletters, advertisements on restaurant menus, or on Craigslist." Applicant's brief pg. 12. Again, the applicant relies on the statements made in the affidavit of Kay Lornic. Although not referenced by the applicant in its brief, it also submitted webpages from the websites of the applicant and registrant in its June 17, 2014 response that purportedly support the statements made in the affidavit. See Exhibits A and B in the Office Response of June 7, 2014.

As set forth earlier, it is well-settled case law that with respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Accordingly, insofar as the identification of services in the registration does not contain a restriction on geographical scope or marketing channels, the applicant's arguments limiting the registrant's services are not legally permissible.

Moreover, it should be noted that the applicant's affidavit is unreliable, that the affidavit along with the applicant's evidence contradict applicant's arguments, and that the applicant's evidence actually *supports* a likelihood of confusion finding.

First, the registrant's homepage submitted by the applicant states the following (emphasis added): "DSA is for people and dogs of all ages. We are a group of people ***all across the nation*** that come together to learn new things, socialize, and help in the community with our dogs." *See* Applicant's Exhibit B. This statement appears to contradict applicant's assertion that the scope of registrant's services is limited to two states. Second, both webpages of the applicant and registrant unequivocally indicate that earning merit badges are a feature of the organizations. *See* Applicant's Exhibits A and B. This supports the evidence submitted by the examining attorney illustrating the similarity between applicant's

membership organization and registrant's services. Third, the applicant makes the following admissions in its affidavit: "...the PUP SCOUTS mark is used in connection with an **organization for pet owners**," Applicant's Affidavit pg.1; "We also offer services and products that support our membership...[that] include...**patches, badges...training services** for those that want their dogs to be models..." Applicant's Affidavit pg. 1-2. These statements indicate how applicant's membership organization and registrant's services identical or nearly identical in terms of nature and purpose. Lastly, the affidavit is comprised of unreliable unilateral statements unsupported by evidence that are merely based on a single individual's personal belief and knowledge. The preface to all the claims made in the affidavit states "I state the following based upon my *own knowledge*." Applicant's Affidavit pg. 1.

The applicant's final argument is that the class of consumers is sophisticated. The basis for this claim is grounded on applicant's statement in its affidavit that "Applicant's membership services offered in connection with the PUP SCOUTS mark are designed to attract a very specific consumer, namely, those interested in honoring their pets by means of participating in collective group with other pet owners. In contrast, it can only be assumed that the DOG SCOUTS OF AMERICA mark is used to attract those seeking education, certification and training for dogs and dog owners." Applicant's brief pg. 12-13; See Affidavit pg. 3. In the affidavit it states that these statements originate from applicant's personal experience with its business and clients. See Affidavit pg. 3.

It is the examining attorney's position that these statements fail to prove that the class of consumers is sophisticated, and they are irrelevant to the issue of consumer sophistication. It appears the applicant's memberships and registrant's services are available to *anyone* who is a pet owner and has a desire to be a part of a dog "scouting" organization, including for example, children. No specialized or technical

knowledge is required to become a member of applicant's organization or to avail oneself of the registrant's services.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

CONCLUSION

For the foregoing reasons, the Trademark Examining Attorney respectfully submits that the refusal to register under Trademark Act, Section 2(d), 15 U.S.C. Section 1052(d) because the applicant's mark, when used in conjunction with the identified services, so resembles the mark in U.S. Registration Nos. 3501260, 3501263, 3501265, and 3501266 as to be likely to cause confusion, to cause mistake, or to deceive, should be affirmed.

Respectfully submitted,

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