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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86746413
Applicant	THE PET SAVERS FOUNDATION, INC.
Applied for Mark	NO KILL WORLD
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of: The Pet Savers Foundation, Inc. Serial No.: 86/746,413 Filed: August 17, 2015 Trademark: NO KILL WORLD	)))))))	Law Office 108 Trademark Attorney: Christina M. Riepel

Applicant's Appeal Brief

Introduction

Pursuant to a Notice of Appeal filed on August 29, 2016, Applicant has appealed the examiner's final refusal of the mark NO KILL WORLD in classes 36 and 45 (classes 35 and 44 have been allowed) on the basis that there is a likelihood of confusion with Registration Number 4,192,653 for the mark NKN NO KILL NATION + design.

Relevant Facts

Applicant's latest recitation of services in classes 36 and 45 reads as follows:

Class 36:

CHARITABLE FUND RAISING

Class 45:

ANIMAL ADOPTION SERVICES, NAMELY, ARRANGING FOR RESCUED ANIMALS AND DOGS AND CATS FROM SHELTERS TO BE PLACED IN HOMES

The services in Registration Number 4192653 read as follows:

Class 36:

Charitable services, namely, raising money for animal welfare organizations through promotions and/or incentives

Class 39:

Providing a website featuring information on animal rescue services

Record On Appeal

The record consists of USPTO database excerpts showing dilution of the terms NO KILL, NATION and WORLD, including 12 composite attachments to Applicant's Request for Reconsideration filed on August 29, 2016, each containing numerous copies of registrations from the USPTO database. This evidence is submitted pursuant to guidelines set forth in TMEP Section 710.03 as "the complete electronic equivalent" of registration copies (i.e., "complete printouts taken from the USPTO's Trademark database").

Applicant also notes that in its Response to Office Action filed on December 18, 2015, Applicant attached the "index" of USPTO database results with various search parameters. However, as the search for the term NATION yielded 5391 "hits"; the same search limited to class 36 yielded 3696 results; the search for the term WORLD yielded 42,303 hits; and that same search limited to class 36 yielded 28,777 results, it was impractical to submit each individual record. On the other hand, while these indexes are not officially part of the record, Applicant does believe it will be useful for this Board to see those large numbers, which serve as a backdrop to the evidence which has been made a part of the official record: hundreds of active registrations from the USPTO database containing marks including WORLD or NATION.

The examiner's evidence attempting to show the common use and descriptive nature of NO KILL consists of attachments to the office action issued on December 17, 2015. These attachments include excerpts from *Wikipedia* and *Slate,* as well as screen shots from websites of animal rescue providers using the term NO KILL to describe how the entities "provide services intended to avoid the killing of healthy or treatable animals" (quoted from the examiner's initial office action).

Finally, in the examiner's September 19, 2016 denial of Applicant's Request for Reconsideration, the examiner attached listings from *Charity Evaluators* and *Charity Navigator.*

Applicant's Argument

Applicant respectfully disagrees with the examiner's refusal to register for the following reasons:

1- The terms NATION and WORLD have weak trademark significance because they are used and registered often, and as a result, marks containing either word are entitled to a very narrow scope of protection.

2- The phrase NO KILL is descriptive (as indicated by the examiner's evidence and disclaimer requirement), is used often, and would have no source indicating function among the public.

3- The marks of the parties are distinguishable in sight, sound and meaning (especially since the dominant portion of the registered mark is NKN + design).

1. NATION and WORLD have weak trademark significance

As shown in Applicant's initial Response to Office Action, a PTO search for the term NATION yields **5391** "hits." This same search limited to class 36 still yields **3696** records. A search for WORLD yields **42,303** hits. Even when that search is limited to class 36, there are **28,777** hits. While some of these marks no longer are active registrations, at one time they co-existed on the PTO register.

Applicant concedes that all of the above-mentioned listings and the indexes are not part of the record, but submits the statistics anyway to give the Board an idea about the unusually large number of marks on file containing those terms. However, even though it would be impractical to have made all these marks part of the record, in its Request for Reconsideration, Applicant did attach admissible evidence showing active registrations containing the terms NATION or WORLD in the specific field of concern in this appeal, "charitable services."

More specifically, attachments 3-7 in Applicant's Request for Reconsideration show **147** records for marks containing the word NATION specifically used in connection with "charitable services." Attachments 8-12 show **933** records for marks containing the word WORLD specifically used in connection with "charitable services." To reiterate, these search parameters were not for the words NATION or WORLD in general, or even those words in class 36 generally. Instead, these searches sought marks containing NATION or WORLD in connection with charitable services, the main area of use focused upon by the examiner. In addition, *all* of these marks are "LIVE," so the attachments do not contain any abandoned or cancelled marks (though to some extent those also would be relevant, because they would show that at one time, some individuals or entities used NATION or WORLD in conjunction with charitable services).

Based on this dilution alone, the threshold question must be answered: *if all of these marks containing NATION* or *WORLD for charitable services have co-existed for so many years, and the only elements the marks here have in common are the words NO KILL, then why should*

Applicant's mark containing WORLD suddenly be rejected based on a mark containing NATION?

An examiner (and this Board) should not allow a mark based on dilution alone. However, such dilution is a key factor in analyzing whether a likelihood of confusion exists, and should not be overlooked or ignored when comparing two marks. More specifically, when wording is diluted, each mark must be considered relatively weak. As a result, the scope of protection for each mark is extremely narrow, and slight differences take on greater significance. As stated in *Baf Industries, v. Pro-Specialties, Inc.*, 206 USPQ 166, 175 (TTAB 1980), third party registrations containing similar marks,

> . . . are relevant to show that a particular mark has been adopted and registered by so many different products embraced by said field that a registration of the mark in that trade is entitled to a narrow or restricted scope of protection.

Also see *Puma v. Superaga, S.p.a.*, 204 USPQ 688, 691 (TTAB 1980) (narrow scope of protection for sneaker designs due to common usage).

The proliferation of marks containing the terms "NATION" or "WORLD" tends to indicate that at some point in time different entities have selected and used these terms in connection with a wide range of goods and services. This conclusion about selection and use is accurate despite the TTAB's frequent holdings that third party registrations are not "probative of use." While registrations may not prove the extent of use, or if there is current use, the filing of applications and Section 8 affidavits does establish that the marks were in use at those times and to a degree more than mere token use. Also see *Spraying Systems Co. v. Delavan, Inc.*, 19 USPQ2d 1121, 1125 (N.D.Ill. 1991) and *In re Dayco Products-Eagle Motive, Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988).

In *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ 1404, 1406 (TTAB 1988), where the TTAB acknowledged that third party registrations were not determinative of likelihood of confusion, but went on to state the following:

> Third party registrations are, however, . . . competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the U.S. Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a

whole; and that therefore the inclusion of the (common element) in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity.

In the Red Carpet opposition proceeding, the issue was whether a likelihood of confusion existed between two marks which contained five-sided designs of a house. The applicant made of record several registrations for five-sided designs. The TTAB deemed these registrations relevant to show common usage in the real estate trade. The presence of that common element in the marks of the opposer and applicant were insufficient to support a finding of likelihood of confusion because the remaining features of the marks were sufficiently different.

In short, the terms WORLD and NATION are diluted and weak, and distinctions in Applicant's mark should be sufficient to negate a likelihood of confusion.

2- <u>NO KILL has little or no trademark significance</u>

The only portion the marks have in common are the words NO KILL. However, these words are highly descriptive and have little or no trademark significance. Evidence supporting this conclusion comes from various sources:

a) The examiner has required a disclaimer of NO KILL, which Applicant has entered. A disclaimer is an acknowledgment that a term is descriptive, and that no one party may obtain exclusive rights in that term.

b) In the initial office action dated December 17, 2015, the Examiner attached substantial evidence showing that the words NO KILL are "commonly used in connection with similar services to refer to animal rescue services," and concluded that based on such widespread use, the term NO KILL "merely describes" a feature of the services.

c) Attachments 1-2 to Applicant's Request for Reconsideration consists of marks containing the term NO KILL, including the following:

NO KILL SHELTER
NO KILL LOUISVILLE,
NO KILL WORLD
NO KILL NATION
NO KILL ADVOCACY CENTER
NO KILL CONFERENCE
WAYSIDE WAIFS A NO KILL SHELTER
DOGS AND CATS FOREVER, INC NO KILL ANIMAL SHELTER

The fact that some of the marks never issued to registration or were abandoned/cancelled does not negate that the term NO KILL is prevalent in the world of animal shelters and charities raising money for those shelters, and therefore is a descriptive term with little trademark significance..

Stated in real world terms, relevant "consumers" who encounter NO KILL will look to

other portions of these marks to distinguish between two different "brands" of services. In this case, "looking to other portions of the marks" involves a comparison between the words NATION and WORLD, *and* the overall commercial impression created by Registrant's mark where the dominant feature is *not* the word NATION (see below for a more detailed discussion).

3- <u>Marks are distinguishable due to distinct suffixes and other factors</u>

In light of the weakness of the term NO KILL, the remaining elements of these marks take on greater significance. As a preliminary matter, if this Board reviews the cited registration carefully, it will notice that the dominant feature of the mark is the acronym NKN shown in a fairly unique design. The words NO KILL NATION are listed in the PTO database as one of the "literal" portions of this mark, *but* in the actual mark, that phrase is barely noticeable (i.e., the stylized letters NKN in a design is *four to five times larger* than the words NO KILL NATION which are barely visible). That different presentation, which diminishes the impact of the words NO KILL NATION, alone distinguishes Registrant's mark from NO KILL WORLD.

In addition, there is *absolutely no similarity* between NATION and WORLD in sight, sound or meaning. The terms are spelled and spoken differently, and have completely different appearances. Moreover, despite both terms being vague "geographic" indicators, "nation" is a country, the people of that country, and other aspects of a specific place. WORLD refers to the entire planet or universe, and is not synonymous or close to similar in meaning to NATION. In short, the only similarity between the marks is the presence of NO KILL, a highly diluted term used by many different entities.

There are many cases where slight variations in marks (certainly less than appear here) have created different commercial impressions, and no likelihood of confusion was found to exist. As a few examples:

In *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982), the Court held that a one letter difference between "BOSTON SEA PARTY" and "BOSTON TEA PARTY" was enough to negate confusion because the marks had distinct meanings.

In a Trademark Trial and Appeal Board decision, no likelihood of confusion was found between "PAYOT" and "PEYOTE" because despite a difference in only two letters, and a similarity in appearance and sound, the word had different meanings. One was an English word, the other a surname. One was familiar, the other was unfamiliar. *Payot v. Southwestern Classics*, 3 USPQ2d 1601 (TTAB 1987). Also see *In re Champion Oil Co.*, 1 USPQ2d 1920 (TTAB 1986) ("TOP FORMULA 16" V. "FORMULA 1").

Finally, there is much case law involving marks that were almost identical in a literal sense, but because of a difference in overall images conjured up by the marks, no likelihood of confusion was found. See *In re Best Products Company, Inc.*, 231 USPQ 988 (TTAB 1986) ("JEWELERS' BEST" v. "BEST JEWELRY"); *Bank of America National Trust and Savings Association v. American National Bank of St. Joseph*, 201 1 USPQ 942 (TTAB 1978)

("BANKAMERICA" v. "AMERIBANC"); and *Carlisle Chemical Works, Inc. v. Hardman and Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110 (CCPA 1970) ("COZIRC" v. "ZIRCO").

In this case, the only term common to both marks is NO KILL. That is not sufficient to refuse registration.

Conclusion

The only element the marks of the parties have in common are the words NO KILL, a term that everyone agrees is commonly used and descriptive. Therefore, consumers will look to other elements to distinguish between the two marks being compared here. Due to dilution, the words NATION and WORLD are entitled to a very narrow scope of protection, and differences take on greater significance. As these terms are different in sight, sound and meaning, *and* the dominant portion of the Registrant's mark is the NKN + design element, then there is no reason to believe consumers are likely to be confused.

Based on the above, Applicant respectfully requests that this Board reverse the examiner's refusal to register, and order that this application be forward for publication.

Respectfully submitted,

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