

This Opinion is Not a  
Precedent of the TTAB

Hearing: November 12, 2020

Mailed: January 8, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Melissa & Doug, LLC*  
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Serial No. 87915069  
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Wendy E. Miller of Wissing Miller LLP,  
for Melissa & Doug, LLC

Katherine M. DuBray, Trademark Examining Attorney, Law Office 118,  
Michael W. Baird, Managing Attorney.

—  
Before Kuhlke, Lynch and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Melissa & Doug, LLC (“Applicant”) seeks registration on the Principal Register of



the background design

(“Proposed

Mark”) for the following goods and services based on a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f):<sup>1</sup>

- “Children’s books, calendars, maps, chalk boards for school and home use, dry erase writing boards, printed responsibility charts, weather display boards, pens, pencils, modeling clay, chalk, erasers, glue for stationery or household use, arts and craft paint kits, paint brushes, stencils, rubber stamps, paper, children’s activity books; magnetic learning display boards consisting of calendars, maps, chalk boards for school and home use, dry erase writing boards, printed responsibility charts and weather display boards; stickers; markers; crayons; coloring books; writing pads of paper; writing pads of paper containing pre-printed illustrations to decorate; educational material in the nature of laminated paper placemats for developing educational skills; children’s coloring sets consisting of paper, coloring books, crayons, markers and pencils; writing implements containing invisible ink; hobby craft kits comprising stickers and paper substrates with pre-printed illustrations to decorate; hobby craft kits containing paper, cardstock and paper-backed foam pieces for decorating; temporary tattoo transfers; arts and crafts paper kits; arts and craft clay kits; arts and crafts kits containing paper, fabric, pre-cut and pre-printed cardstock-backed and paper-backed foam pieces, crayons, markers, pencils, rubber stamps, stickers, stencils, coloring books, toy beads, glue for household use, and temporary tattoo transfers; arts and crafts decoupage paper kits; children’s activity books featuring hidden images which are revealed with the application of water; hobby craft kits containing a paper substrate displaying a pattern or image with a scratchable opaque layer for scraping off in a desired design to reveal portions of the pattern or image; hobby craft kits containing paint, paint brushes and sponges, paper, fabric, felt, tape, clay molds for clay, glue, stickers, stencils, beads, hook and loop fasteners, paper-backed foam pieces, paper and cardstock preprinted with images for decorating, adhesive paper substrates, substrates with transferrable foil layers, string and toy looms; hobby craft kits containing stickers, beads, glue, paper, paperbacked foam pieces, and adhesive paper substrates with a film surface having a glitter effect; hobby craft kits containing adhesive paper substrates and decorative foil sheets” in International Class 16; and
- “Jigsaw puzzles; toy vehicles; dominos; marbles; bowling pins and balls; toy building blocks; toy construction blocks; toy pattern blocks; toy alphabet and

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<sup>1</sup> Application Serial No. 87915069; filed May 10, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use and first use in commerce on September 30, 2003 for the goods in International Classes 16 and 28, and first use and first use in commerce on May 6, 2008 for the services in International Class 35. Applicant asserted a claim of acquired distinctiveness in its March 27, 2019 Office Action Response, TSDR 4.

number blocks; toy beads; puppets; toy musical instruments; jump ropes; yo-yos; spinning tops; construction toys; toy model vehicles and related accessories sold as a unit; children's multiple activity toys; chess sets; checker sets; action-type target games; magic tricks; pull toys; magnetic toy figures in the shape of letters and numbers; memory and brain teaser board games; manipulative puzzle and construction games containing latches, locks and laces; hobby craft sets for making wooden toy vehicles; toy animals; role-playing kits for play consisting of toy kitchens, toy tool benches, toy barns, toy castles, toy parking garages and toy horse stables; toy food items and toy utensils for preparing food, sold as a unit; toy abacuses; toy pounding benches; toy cobbler benches; shape sorting toys; toy boats; inset puzzles; floor puzzles; children's educational games for developing fine motor, cognitive and counting skills; children's educational games for developing memory and dexterity; dice games; memory games; manipulative games; parlor games; building games; card games; wooden toys in the shape of animals, flowers and buildings; toy accessories, namely, toy mobile phones, toy handbags, toy sunglasses and toy key chains; balls in the nature of children's toys, namely, kickballs, toy sports balls and plush balls; toy figures; butterfly nets; play tunnels; play tents; play houses and toy accessories therefor; toy food items; toy cooking utensils; toy kitchen appliances; toy shopping carts; sand toys; toy tools; dolls; doll furniture; doll accessories; doll houses and furnishings; plush toys; toy looms; hobby craft kits for making toy clothing, dolls, doll clothing, toy figures, toy vehicles, toy jewelry, toy hair accessories, toy picture frames, toy decorative and Christmas tree ornaments, toy stained glass sculptures, toy jewelry and trinket boxes, keepsake boxes, toy mirrors, toy magic wands, toy tiaras, toy clothing, toy wallets, toy key rings, and decorative toy landscapes and scenery in the nature of animal habitats, fairy tale scenes, dinosaur habitats and undersea habitats; toy scale model hobby craft kits; toy 3-d eyeglasses; hobby craft kits containing a transparent or translucent substrate with a scratchable opaque layer for modification by the user to create simulated toy stained glass sculptures; toy garden tools; toy binoculars; toy magnifying glasses; toy flashlights" in International Class 28; and

- "Online retail store services featuring books, arts and crafts materials, arts and crafts kits, hobby craft kits, stationery, toys, games, puzzles, dolls, costumes, juvenile furniture and rugs" in International Class 35.

The application includes the following description of the mark:

The mark consists of a red oval with a white border. The broken lines inside the oval are not part of the mark, but serve only to show the location of a logo, without regard for the color or the characters which comprise the logo. The broken lines around the periphery of the oval are

not part of the mark, but serve only to identify the perimeter of the white border.

The colors red and white are claimed as features of the mark.

The Trademark Examining Attorney refused registration under Sections 1, 2, and 45 of the Trademark Act,<sup>2</sup> U.S.C. §§ 1051-52 and 1127, on the ground that the Proposed Mark fails to function as a trademark because the Proposed Mark is nondistinctive for Applicant's goods and services and has not acquired distinctiveness.<sup>3</sup> When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied Applicant's request for reconsideration,<sup>4</sup> and the appeal resumed. The case is fully briefed. An oral hearing was held on November 12, 2020.

We affirm the refusal to register.

## **I. Evidence**

### **A. Applicant's Evidence**

In support of its claim of acquired distinctiveness, Applicant submitted:

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<sup>2</sup> The Office also should have cited Section 3 of the Trademark Act, 15 U.S.C. § 1053, as a basis for refusal because Section 3 concerns services, which also are covered by the involved application.

<sup>3</sup> The Office initially refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and required amendments to the description of the mark and color claim. September 9, 2018 Office Action, TSDR 2-5. The Section 2(d) refusal was withdrawn, October 1, 2018 Office Action, TSDR 1, and Applicant satisfactorily amended the description of the mark and color claim. October 24, 2019 Final Office Action, TSDR 1.

<sup>4</sup> After Applicant requested reconsideration, the application was reassigned to Examining Attorney Katherine DuBray who handled the appeal.

- A declaration from Christopher G. Myers, Director, Supply Chain for Applicant, and exhibits thereto consisting of:<sup>5</sup>
  - Printouts from Applicant’s website displaying the Proposed Mark, with the wording “Melissa and Doug” within the oval, in the top left-hand-corner of each page and on the featured products;
  - Excerpts from Applicant’s product pages on Amazon.com displaying the Proposed Mark, with the wording “Melissa and Doug” within the oval;
  - Printouts from third-party retail websites featuring Applicant’s goods bearing the Proposed Mark, with the wording “Melissa and Doug” within the oval, including pages from the websites of Walmart, Target, and Bed Bath & Beyond;
  - Photographs from brick-and-mortar retail store aisles showing the Proposed Mark, with the wording “Melissa and Doug” within the oval, on Applicant’s products and point-of-sale-displays; and
  - Printouts from Applicant’s Instagram, Twitter and Facebook social media accounts showing the Proposed Mark, with the wording

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<sup>5</sup> March 27, 2019 Office Action Response, TSDR 8-36.

Applicant attached to its appeal brief a supplemental declaration from Mr. Myers “to clarify the record” regarding the number of units Applicant has sold in the United States. Applicant’s Brief, 8 TTABVue 8, n.4. Applicant has explained that Mr. Myers’ original declaration cited the number of units Applicant has sold worldwide.

We have not considered Mr. Myers’ supplemental declaration. The record should be complete before an appeal is filed. Trademark Rule 2.142(d), 37 C.F.R. § 2.142. If Applicant wished to “clarify” the record, it should have filed a request for remand.

“Melissa and Doug” within the oval, displayed as Applicant’s profile picture.

- 31 consumer declarations;<sup>6</sup> and
- The declaration of Wendy E. Miller, Applicant’s counsel,<sup>7</sup> accompanied by copies of certificates of registration issued to Applicant for the mark



(“Composite Mark”)<sup>8</sup> and the mark



## **B. The Examining Attorneys’ Evidence**

The Examining Attorneys submitted:

- printouts from third-party websites for oval packaging labels;<sup>10</sup>
- the Merriam-Webster online dictionary definition for the word “logo”;<sup>11</sup>
- a printout from a third-party website selling “Coca-Cola parody” products;<sup>12</sup>

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<sup>6</sup> August 21, 2019 Office Action Response, TSDR 11-41.

<sup>7</sup> January 13, 2020 Request for Reconsideration, TSDR 19-21.

<sup>8</sup> Registration No. 5736859 for goods in International Class 16 substantially identical to the goods identified in the involved application. The mark is described as “the words ‘Melissa & Doug’ in white text on a red oval background with a white border.” January 13, 2020 Request for Reconsideration, TSDR 22-23.

<sup>9</sup> Registration Nos. 3203307 and 5736832 for, among other things, goods and services in International Classes 16, 28 and 35 that overlap with the goods and services identified in the involved application. The mark is described as “the words ‘Melissa & Doug’ inside an oval.” *Id.* at 24-26.

<sup>10</sup> April 24, 2019 Office Action, TSDR 5-14; October 24, 2019 Office Action, TSDR 15-16.

<sup>11</sup> October 24, 2019 Office Action, TSDR 7-11.

<sup>12</sup> *Id.* at TSDR 12-14.

- Printouts from a website showing the following sign:



- Third-party registrations for marks incorporating oval designs.<sup>14</sup>

## II. Applicable Law

Where, as here, an applicant seeks to register a background design that is used in connection with a word mark, that background design may be registered as a trademark only if it creates a commercial impression separate and apart from the word mark in conjunction with which it is used. *In re Anton/Bauer Inc.*, 1381 (TTAB 1988); *see also In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215 (TTAB 1998). “If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark (i.e., without proof of secondary meaning); if it is not inherently distinctive, such proof is essential.” *In re Anton/Bauer Inc.*, 7 USPQ2d at 1381 (citing *In re E.J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958)); *see also In re Benetton Grp. S.p.A.*, 48 USPQ2d at 1215. Generally, “common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background

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<sup>13</sup> *Id.* at 17-43.

<sup>14</sup> February 26, 2020 Denial of Request for Reconsideration, TSDR 5-55.

design alone.” *In re Benetton Grp. S.p.A.*, 48 USPQ2d at 1215-16; *see also In re Am. Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002).

Applicant claims that the Proposed Mark has acquired distinctiveness under Section 2(f) of the Trademark Act so we need not consider whether the mark is inherently distinctive. *See, e.g., Yamaha Int’l v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact.”). Matter that is not inherently distinctive may be registered on the Principal Register if it “has become distinctive of applicant’s goods [or services] in commerce.” 15 U.S.C. § 1052(f).

To establish secondary meaning, or acquired distinctiveness, in a background design such as the Proposed Mark, Applicant must show that the Proposed Mark has come to serve as an indication of origin separate and apart from the wording with which it appears. *See In re Raytheon Co.*, 202 USPQ 317, 319-20 (TTAB 1979). “Distinctiveness means that the primary significance of the design[] in this field of products [and services] is as [a] designation[] of source rather than as [a] mere background[] to the presentation of applicant’s word mark.” *Anton/Bauer Inc.*, 7 USPQ2d at 1383. Applicant bears the burden of establishing a prima facie case of acquired distinctiveness. *Yamaha Int’l*, 6 USPQ2d at 1004 (“When registration is sought under Section 2(f), the board publishes the mark for opposition when it is satisfied that the applicant has presented a prima facie case of acquired

distinctiveness.”); *see also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (burden on applicant to show acquired distinctiveness); *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, \*10 (TTAB 2019) (same). The amount and character of the evidence required to establish acquired distinctiveness depends on the facts of each case and the degree of non-distinctiveness of the proposed mark. *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017); *see also Yamaha Int’l*, 6 USPQ2d at 1008; *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010) (“The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case.”). Here, Applicant has a heavy burden to show acquired distinctiveness because the Proposed Mark, consisting of a common geometric shape in the colors red and white and serving as a background carrier for the word mark MELISSA & DOUG, is not the type of mark likely to be perceived as a source identifier. *See, e.g., Yamaha Int’l*, 6 USPQ2d at 1008; *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1073 (TTAB 2018); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1316-17 (TTAB 2011).

In determining whether Applicant’s mark has acquired distinctiveness, we consider the following factors: (1) association of the proposed mark with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media

coverage of the product embodying the mark. *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); *see also In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018) (acknowledging the six factors the Federal Circuit has identified “to be considered in assessing whether a mark has acquired distinctiveness”). We consider all of the Section 2(f) evidence of record as a whole; no single fact is determinative. *Converse*, 128 USPQ2d at 1546 (“All six factors are to be weighed together in determining the existence of secondary meaning.”) *In re SnoWizard*, 129 USPQ2d at 1005.

### **III. Analysis**

#### **A. Applicant’s Goods**

We first assess whether Applicant has proven acquired distinctiveness in the Proposed Mark for Applicant’s goods. There is evidence regarding each of the acquired distinctiveness factors set forth above, except the sixth factor regarding unsolicited media coverage.

##### **1. Factor One: Association of the Proposed Mark with a Particular Source by Actual Purchasers**

Applicant did not submit survey evidence<sup>15</sup> but did submit 31 consumer declarations obtained on July 19, 2019 from visitors to “the FAO Schwartz toy store located in Rockefeller Center, in New York City.”<sup>16</sup> Applicant’s attorney, Wendy Miller, averred that she and her assistant “engaged visitors in a brief conversation to

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<sup>15</sup> The Examining Attorney’s criticisms of the declarations on the basis that they are survey evidence is misplaced.

<sup>16</sup> August 21, 2019 Office Action Response, TSDR 11-41.

determine whether they [were] purchasers of applicant's goods, and if so, whether they purchase[d] applicant's goods primarily online or at retail stores"; that "qualified witnesses were handed" either a declaration "for consumers who usually purchase applicant's goods online" or a declaration for "consumers who usually purchase applicant's goods at retail stores"; that the declarations "contained blanks for the witness to fill [in] by hand"; and that the declarants were "directed to read and indicate an understanding of each statement" in the declaration. The declarations were completed by persons from 17 states<sup>17</sup> and the District of Columbia, reflecting some geographic diversity among declarants. *Cf. In re Lorillard Licensing*, 99 USPQ2d at 1319 (criticizing consumer declarations because there was no indication whether the declarants were all from the same city or whether they were geographically diverse).

Each declarant averred as follows:

- I purchase toys, books, and crafts for children.
- I am familiar with Melissa & Doug and I have purchased their products.
- I have been asked to react to the Logo shown below:



- I recognize this Logo. I see it on Melissa & Doug's products and signs.

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<sup>17</sup> The states are Alabama, California, Colorado, Florida, Georgia, Hawaii, Illinois, Iowa, Kansas, Maryland, Massachusetts, Mississippi, New Jersey, New York, Ohio, Pennsylvania, and Tennessee.

- I usually see the words ‘Melissa & Doug’ inside the logo. However, I don’t need to see those words to recognize the Logo.
- Whenever I see the Logo on a product, I know that I’m purchasing a product from Melissa & Doug.


Each declarant also completed blank spaces in the form regarding: (i) the capacity in which he/she purchases Applicant’s products: 24 declarants identified themselves as parents, 2 as grandparents, 1 as a parent and teacher, 1 as a parent and great aunt, 1 as an aunt and teacher, 1 as a teacher, and 1 as an aunt; and (ii) the retail outlets through which he/she “usually purchases” Applicant’s goods, e.g., Target, Amazon, independent toy stores.

The declarations would have been more probative if the declarants had identified how often they purchase Applicant’s goods, but we can infer from the information that the declarants did provide and the fact that Applicant obtained the declarations from visitors to a toy store that the declarants have a certain level of familiarity with Applicant and its products. *Cf. In re Benetton Grp. S.p.A.*, 48 USPQ2d at 1217 (“finding it difficult to gauge the probative value” of the statements of 23 declarants because the record lacked “some basic background information about the individuals and their experience with applicant”); *In re EBSCO Indus. Inc.*, 41 USPQ2d 1913, 1916 (TTAB 1996) (applicant seeking to register a fishing lure configuration submitted consumer declarations, but the declarants did not specify why or how they were familiar with fishing lures). We further agree with Applicant’s assertion that requiring the declarants to write in information about themselves and the stores through which they have purchased Applicant’s goods “individualize[d] their

testimony and engage[d] them to read the statements contained in the declaration”<sup>18</sup> making the declarations more reliable. Indeed, a few declarants added comments emphasizing their agreement with the form statements in the declaration as shown in the examples below:<sup>19</sup>

4.	I have been asked to react to the Logo shown below:
	
5.	I recognize this Logo. I see it on Melissa & Doug’s products and signs. <i>yes</i>
6.	I usually see the words “Melissa & Doug” inside the logo. However, I don’t need to see those words to recognize the Logo. <i>yes</i>
7.	When I shop for products online, I can immediately recognize the Logo, even when the computer screen is too small to make out any words inside. <i>yes</i>
8.	Whenever I see the Logo on a product, I know that I’m purchasing a product from Melissa & Doug. <i>yes</i>

and

3.	I have been asked to react to the Logo shown below:
	
4.	I recognize this Logo. I see it on Melissa & Doug’s products and signs. <i>yes!</i>

The circumstances under which the declarations were obtained and each declarant’s active participation in completing the form support that the declarants

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<sup>18</sup> January 13, 2020 Request for Reconsideration, TSDR 19-20, Miller Declaration, ¶ 3.

<sup>19</sup> August 21, 2019 Office Action Response, TSDR 17 and 24.

engaged in some deliberation and understood the statements in the declaration before signing. Accordingly, while 31 declarants is a small number of relevant consumers, we find the declarations clear, reliable and probative of consumer perception, albeit on a limited basis.

## 2. Factor Two: Length, Degree, and Exclusivity of Applicant's Use

Applicant submitted the declaration of Christopher G. Myers, Applicant's Director, Supply Chain, who avers that: (i) Applicant "is one of the leading manufacturers and sellers of toys and creative play sets in the United States and worldwide ... well known ... for its innovative and high quality products";<sup>20</sup> (ii) Applicant "sells a wide range of toys and creative play sets," both online and through brick-and-mortar retail outlets;<sup>21</sup> (iii) "on each product [Applicant] prominently displays the [Proposed] Mark as the background part of a composite which includes the term 'Melissa & Doug' in white script";<sup>22</sup> (iv) Applicant also displays the Proposed Mark on point of sale displays;<sup>23</sup> (v) Applicant "started selling goods which display the [Proposed] Mark in the United States on September 30, 2003, and has been using the [Proposed] Mark on those good continuously and substantially exclusively in U.S. commerce through the present date;"<sup>24</sup> and (vi) "[i]n each year from 2014-2018,

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<sup>20</sup> March 27, 2019 Office Action Response, TSDR 8, Myers Declaration, ¶ 2.

<sup>21</sup> *Id.* at 8-9, ¶¶ 2, 4 and 5.

<sup>22</sup> *Id.* at 8, ¶ 2.

<sup>23</sup> *Id.* at 9, ¶ 4. The Proposed Mark is not used alone on Applicant's point-of-sale displays, but rather appears as part of the Composite Mark just as it is displayed on Applicant's products.

<sup>24</sup> *Id.* at 10-11, ¶ 9.

[Applicant] sold more than 100 million units which display the trademark, with annual sales averaging more than \$300 million.”<sup>25</sup>

For more than sixteen years Applicant has prominently and consistently displayed the Proposed Mark as part of its Composite Mark



on each of its products as well as at points of purchase as shown in the examples below.

Printout from Amazon.com:<sup>26</sup>

The image is a screenshot of an Amazon product page for the Melissa & Doug 'Turn & Tell Clock'. The page layout includes a header with company information, a product image, a description, and a list of features. Two yellow arrows are pointing to specific elements: one points to the Melissa & Doug logo in the top right corner, and the other points to the product image of the clock. The product image shows a colorful wooden clock with large red numbers and a digital display. The text on the page describes the clock's features and benefits for children's learning.

From classic wooden toys to creative crafts for every age, Melissa & Doug's timeless products educate and enrich in a way that's as natural as playtime itself.

Since their company's founding 25 years ago, Melissa and Doug have been committed to making exceptional children's products, with a focus on hands-on creative play and superior customer service.

With their recognizable red-oval logo, Melissa and Doug put their names on every product they make—a symbol of their commitment to quality, attention to detail, and dedication to improving playtime for families around the world.

[View larger](#)

**Product Description:**

Perfect for kids who are ready to learn to tell time, this sturdy wooden learning clock features hands that rotate with a gentle click, marking off the minutes as they go. The detailed clock face has large red numbers to match the hour hand, small blue numbers to match the minute hand, and a segmented color disk to help kids visualize "quarter past" and "half past." As children move the hands to change the analog time, a self-adjusting digital clock allows them to check their time-telling skills against an easy-to-read numeric equivalent—or slide the shutter closed to hide the "answer" from view.

**Features:**

- Kid-powered learning clock
- Sturdy "time cards" slot in the top for time-matching activities.
- Hideaway digital "clock" automatically changes to match the analog time shown.
- Hands move independently—perfect for learning and teaching time.
- Promotes hand-eye coordination and concepts of time; encourages abstract thinking, explorative play, and independent learning

[View larger](#)

<sup>25</sup> *Id.* The cited number of units sold is worldwide, Appeal Brief, 8 TTABVue 8, n.4, but we keep in mind that Applicant is a U.S. company based in Wilton, Connecticut.

<sup>26</sup> March 27, 2020 Office Action Response, TSDR 19, Myers Declaration, Exhibit B.

Photograph of an “[e]xemplary brick-and-mortar store aisle”:<sup>27</sup>



<sup>27</sup> *Id.* at TSDR 29, Exhibit D. We have cropped extraneous matter from the photo.

Applicant's consistent, prominent and extensive use of the Composite Mark



for more than sixteen years provides some support that consumers may recognize Applicant's red and white oval background design as a source identifier for Applicant's goods separate and apart from the MELISSA & DOUG word mark. *See In re Raytheon Co.*, 202 USPQ at 319-20 (finding oval background design had acquired distinctiveness as a mark for applicant's "electron tubes" separate and apart from the word mark RAYTHEON, superimposed in the center of the oval design based, in part, on "more than 45 million electron tubes bearing the composite mark 'Raytheon' and design" sold between 1967 and 1976). It is important to note, however, that Applicant has shown no use of the Proposed Mark separate and apart from the Composite Mark. *In re Hillerich & Bradsby Co.*, 304 F.2d 287, 97 USPQ 451, 452-53 (CCPA 1953) (fact that oval design "enjoyed long and extensive usage in connection with other registered word trade marks" did not support finding of acquired distinctiveness; "on the contrary [such evidence] would appear to make the applicant's task more difficult").

Turning to whether Applicant's use of the Proposed Mark has been substantially exclusive, Mr. Myers averred that Applicant has been making substantially exclusive use of the Proposed Mark in the U.S. for Applicant's goods since 2003 and that Applicant has "not encountered any other seller of toys and creative play sets who

uses a configuration which [is] similar to the Mark.”<sup>28</sup> The Examining Attorney cites 17 third-party registrations<sup>29</sup> as “weigh[ing] against Applicant’s claim of ‘substantially exclusive use’” and “demonstrat[ing] that third parties claim ownership of marks containing the applied-for red oval, used as a similar background carrier.”<sup>30</sup> But there is no evidence that any of the third-party registered marks are in use. The registrations themselves are not proof that consumers are familiar with the registered marks or that the marks have been “so used as to affect the mind of the purchasing public[.]” *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 342-43 (CCPA 1978) (“A registration does not *inherently* evidence” whether the public actually has been exposed to a mark); *see also TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1117 (TTAB 2018) (“Third-party registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them”). Without evidence of actual use, we cannot ascertain whether the registered marks are inconsequential or infringing or whether they are being used in a way that contradicts Applicant’s assertion that it is making substantially exclusive use of the Proposed Mark.<sup>31</sup> *L.D.*

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<sup>28</sup> March 27, 2019 Office Action Response, TSDR 10-11, Myers Declaration, ¶¶ 8-9.

<sup>29</sup> The Examining Attorney also submitted a less than five year old registration that issued based on a foreign registration (Registration No. 5757721) and one intent-to-use application (Serial No. 88502500). February 26, 2020 Request for Reconsideration Denial, TSDR 33-38. This evidence has limited probative value. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009) (registrations issued based on foreign registrations and intent-to-use applications “are not even necessarily evidence of a serious intent to use the marks shown therein in the United States”).

<sup>30</sup> 11 TTABVUE 8.

<sup>31</sup> The oval labels, “danger” sign, and Coca-Cola “parodies” the Examining Attorney submitted are not related to the goods and services for which Applicant seeks registration, and therefore, have little, if any, probative value. *Cf. In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994) (evidence of acquired distinctiveness must

*Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999) (inconsequential or infringing third-party use “does not necessarily invalidate the applicant’s claim” of substantially exclusive use).

Moreover, not all of the cited marks are pertinent. Only marks that are identical or “substantially similar” to the mark sought to be registered are relevant. *Converse*, 128 USPQ2d at 1547 (“Although we agree with the ITC that evidence of the use of similar but not identical trade dress may inform the secondary-meaning analysis, we think such uses must be substantially similar to the asserted mark”). The following three marks are substantially similar to Applicant’s mark because they consist of red and white ovals with word marks confined to inside the ovals and they cover some of the same goods as the involved application:<sup>32</sup>



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The following marks also are worth noting:<sup>34</sup>

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“relate to the specific [goods or] services set forth in the application, and the specific mark for which registration is sought”).

<sup>32</sup> February 26, 2020 Denial of Request for Reconsideration, TSDR 27-29 and 39-43.

During the hearing, Applicant acknowledged that the mark for which it seeks registration is not broad enough to encompass lettering that would extend outside the interior red oval portion of the Proposed Mark.

<sup>33</sup> The application for this mark matured to registration after the commencement of this appeal.

<sup>34</sup> *Id.* at 30-32 and 50-52.



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The remaining registered marks contain additional matter or colors or cover distinguishable goods such that we do not find them “substantially similar” to the Proposed Mark.

The cited third-party marks are relevant to the conceptual strength of the Proposed Mark and reinforce our conclusion that the Proposed Mark is not the type of mark likely to be perceived as a source indicator, and therefore, Applicant’s burden to establish acquired distinctiveness is quite high. *Cf. In re Pacer Tech.*, 333 F.3d 1348, 67 USPQ2d 1629, 1630-32 (Fed. Cir. 2003) (finding 11 design patents, some of which were owned by applicant’s competitor, prima facie evidence that applicant’s adhesive container cap design was not inherently distinctive; Patent and Trademark Office did not have “to show that the patented designs were actually used in the relevant marketplace as part of its prima facie case”). But the registered marks do not demonstrate that the Proposed Mark is not in substantially exclusive use.

In sum, Applicant’s length, degree, and substantial exclusivity of use<sup>36</sup> provides some support for Applicant’s claim of acquired distinctiveness, but the fact that the

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<sup>35</sup> The drawing of the mark is lined for the color red. The registration issued based on a foreign registration, but it has been renewed. February 26, 2020 Denial of Request for Reconsideration, TSDR 5-7.

<sup>36</sup> The record includes some allegedly infringing third-party uses discussed below, but we do not have enough information about such uses to find that they invalidate Applicant’s claim of substantially exclusive use.

Proposed Mark is always displayed as part of the Composite Mark



and never as a standalone mark, lessens the probative value of this evidence. *In re Hillerich & Bradsby Co.*, 97 USPQ at 452-53.

### 3. Factor 3: Amount and Manner of Advertising

Applicant goods “are promoted and sold by major national retailers” such as Walmart, Target, Bed Bath & Beyond, and Amazon,<sup>37</sup> as well as independent toy stores. As shown in the examples on pages 15 and 16 above, the Composite Mark



appears prominently on Applicant’s goods and point-of-sale displays. Indeed, in the brick-and-mortar example, consumers are bombarded with images of the Composite Mark as it is prominently displayed on all of Applicant’s goods and point-of-sale materials. As discussed, such extensive and prominent use may suggest that consumers recognize the Proposed Mark as a source indicator separate and apart from the MELISSA & DOUG word mark. *Cf. In re Lorillard Licensing*, 99 USPQ2d at 1317-18 (sample advertisements did not show “consistent use of orange text on a green background that would show that this color combination is functioning as a trademark”).

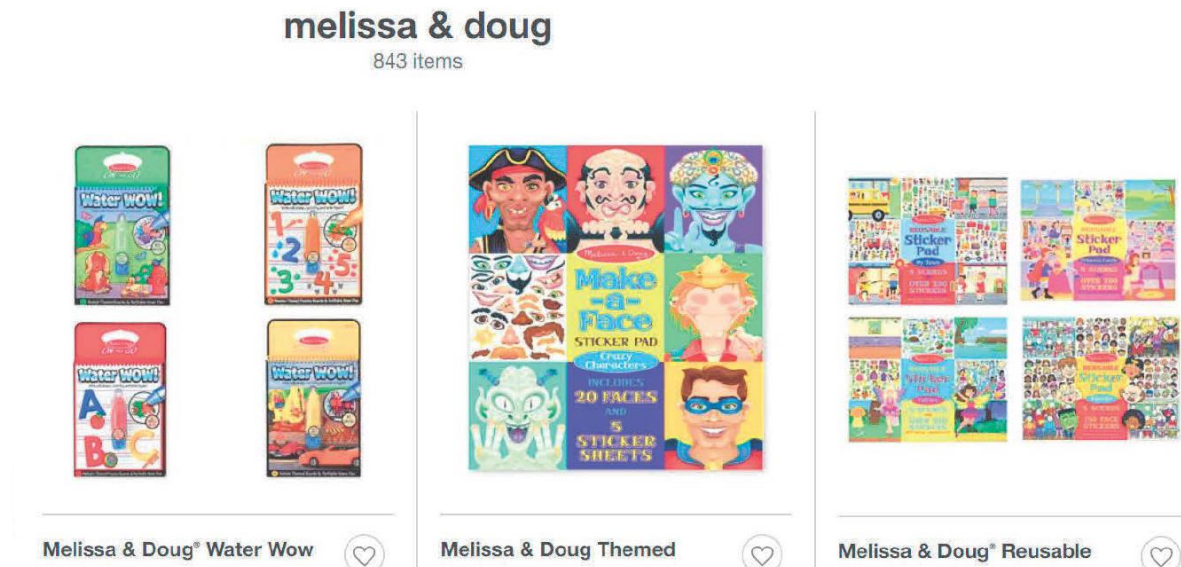
We are not persuaded, however, by Applicant’s argument that consumers must rely on the Proposed Mark as a source identifier because the MELISSA & DOUG

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<sup>37</sup> March 27, 2019 Office Action Response, TSDR 9, Myers Declaration, ¶¶ 4-5.



word mark is not always visible in the Composite Mark . In the brick-and-mortar example of record, the point-of-sale signage is so large that the MELISSA & DOUG word mark would be easily discernable even from a distance. Moreover, while the record includes a few examples from the Internet where the MELISSA & DOUG word mark is not visible in the Composite Mark, the MELISSA & DOUG word mark is otherwise prominently displayed as shown in the example from Target.com below:<sup>38</sup>



<sup>38</sup> *Id.* at TSDR 31, Myers Declaration, Exhibit E-1.

Applicant further claims that it has engaged in “robust social media promotion.”<sup>39</sup>



Applicant uses the Composite Mark as its profile picture on Instagram where Applicant has 146,000 followers, on Twitter where it has 35,000 followers, and on Facebook where it has 320,000 followers.<sup>40</sup> Applicant, however, has failed to supply important information such as when Applicant started promoting on social media with the Proposed Mark, how many posts it has made, and how frequently it posts content. In addition, the number of Applicant’s social media followers is disproportionately small compared to Applicant’s sales volume. That is, when we consider Applicant’s high volume of sales, Applicant’s number of social media followers is not that impressive. In addition, the social media promotion always includes the wording “Melissa & Doug” as part of the logo presented.

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<sup>39</sup> Appeal Brief, 8 TTABVUE 8.

<sup>40</sup> March 27, 2019 Office Action Response, TSDR 10, Myers Declaration, ¶ 6 (“Each day, thousands of people see the icon when visiting [Applicant’s] social media pages.”); *see also id.* at TSDR 34-36, Exhibit F.

We have not considered the modified social media statistics (8 TTABVUE 9), including the number of posts to Instagram and Facebook “likes,” that Applicant included in its appeal brief because this evidence is not of record.

We also are not persuaded by Applicant's assertion that it "has specifically alerted consumers to the logo Mark as an indicator of source, separately from the Composite, in the following point-of-sale statement":<sup>41</sup>

With their recognizable red-oval logo, Melissa and Doug put their names on every product they make – a symbol of their commitment to quality, attention to detail, and dedication to improving playtime for families around the world.

The statement begins by pointing out the red oval design subject to the involved application, but makes clear that its "red-oval logo" includes "Melissa and Doug put[ting] their names on every product." Thus, the red oval is not the focus of the statement. Rather, the statement highlights the Composite Mark and the importance of the names Melissa & Doug as "a symbol" of Applicant's high quality products. *See In re Hillerich & Bradsby Co.*, 97 USPQ at 453 (applicant's "principal emphasis" in advertising was not in the standalone oval design sought to be registered, but in "the oval in connection with the 'Louisville Slugger' bat, i.e., the 'Louisville Slugger oval'"); *see also Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 95 USPQ2d 1333, 1349 (5<sup>th</sup> Cir. 2010) ("advertising attempted to attract customers using marks other than the Star Symbol" sought to be protected). In addition, Applicant has not indicated when it started using this statement, and consumers may not even notice it because, as shown in the record, the statement appears as part of a larger text. Below is the most conspicuous example:<sup>42</sup>

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<sup>41</sup> Appeal Brief, 8 TTABVue 8; *see also* March 27, 2019 Office Action Response, TSDR 9 and 16-28, Myers Declaration, ¶ 3 and Exhibits B and C.

<sup>42</sup> March 27, 2019 Office Action Response, TSDR 28; *see also id.* at 16-22, 25-26.



200 Wood Block Set in Use A timeless playroom staple

For a child, there are few greater joys than simply building a tower and knocking it down . . . or creating a castle, stable, highway, or house filled with imagination. This colorful unit block set has materials for endless creative building projects: 200 solid-wood blocks in nine shapes and four vibrant colors. The abundance of materials lets children execute their building ideas without restriction, and are great for collaboration and group play, too: It's easier to be generous with hundreds of blocks to share! The open-ended nature of block play is perfectly suited to the way children play and learn best, letting imagination and natural curiosity lead the way. Children can experiment with form and function as they create stronger, taller, wackier structures, or create amazing play scenes with characters and narratives. The bright colors and variety of shapes in this big set add to the fun by adding a punch of color and polished form to towers, arches, ramps, and more. There is no limit to the ways kids can play and build!

An exciting way to learn

The nine shapes in the set relate to each other mathematically: Two triangles make up a square; two squares equal one small rectangle; a small rectangle and a square equal a long rectangle . . . and so on. Children don't need to have any math knowledge before they begin, but as they play they'll begin to make observations about equivalencies and differences, draw conclusions and make estimates, and play with counting and matching—all of which lays the groundwork for later math skills. Physical skills are boosted as well: The action of lifting and placing blocks to build a tower builds strength, fine motor skills, gross motor skills, and hand-eye coordination. This set is designed on a smaller scale that fits little hands perfectly, allowing for a secure grasp that builds confidence as little ones build and play.

About Melissa & Doug

Melissa & Doug toys are designed to fuel imagination, inspire exploration, and encourage the natural curiosity that leads to a lifetime of learning! From classic wooden toys to creative crafts for every age, Melissa & Doug's timeless products educate and enrich in a way that's as natural as playtime itself. Since their company's founding 25 years ago, Melissa and Doug have been committed to making exceptional children's products, with a focus on hands-on creative play and superior customer service. With their recognizable red-oval logo, Melissa and Doug put their names on every product they make—a symbol of their commitment to quality, attention to detail, and dedication to improving playtime for families around the world.

**Product Description** 200-piece wooden block set Assorted colors: red, yellow, blue, and green 9 different shapes Sort them, stack them, knock them down! Promotes hand-eye coordination, color and shape recognition, counting and sorting, and spatial relationships. This 200-piece set takes the blah out of blocks, especially for kids who create best with lots of pieces, lots of color, and lots of space. Kids (those 3- to 7-years-old) will not be hindered by a lack of material for their castles, bridges, fortresses, towers, and houses. There is an abundance of sizes and shapes, including a greater proportion of squares and triangles—the foundation of any building project. The lightweight, wooden pieces are coated with shiny, nontoxic enamel paint (red, yellow, blue, and green) that resists chipping. The box, however, is not as resistant. It has a carrying handle, but grownups should find a more rugged storage container for so many blocks, which are bound to otherwise end up all over the house. —Diane Beall

Finally, Applicant did not submit any advertising figures, instead explaining that it “does not advertise its goods through traditional television or print media.”<sup>43</sup> Even though Applicant does not advertise through traditional means, we expect that it would have some expenditures related to marketing on social media and in the “major national retailers” through which it sells its goods. Advertising expenditures, particularly related to any “look-for” advertising, would be important where, as here, Applicant seeks to register a mark that is so inherently non-distinctive. *In re Benetton Grp. S.p.A.*, 48 USPQ2d at 1216 (noting Applicant’s failure to provide advertising expenses in support of its claim of acquired distinctiveness in a green rectangle background design for clothing).

In sum, Applicant has shown extensive and prominent use of the Proposed Mark,

but always as part of its Composite Mark



conspicuously featuring “Melissa & Doug”, rather than as a standalone mark, and Applicant’s advertising and marketing evidence is otherwise lacking.

#### 4. Amount of Sales and Number of Customers

Applicant’s annual sales worldwide are substantial. Given that Applicant is a U.S. company based in Wilton, Connecticut and the record reflects that Applicant sells its products through national retail outlets and U.S. websites, we infer that Applicant’s U.S. sales are also impressive. But because the Proposed Mark is always displayed

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<sup>43</sup> Appeal Brief, 8 TTABVUE 9.

on Applicant's products as part of the Composite Mark, the probative value of Applicant's sales figures is limited to some degree. *In re Hillerich & Bradsby Co.*, 97 USPQ at 452, 454 (finding oval design for baseball and softballs had not acquired distinctiveness despite the commercial success of applicant's products where the oval design was consistently used in connection with word marks).

#### 5. Intentional Copying

Applicant asserts that foreign third-parties are intentionally copying the Proposed Mark to trade off of its goodwill. Applicant's attorney averred:

Overseas factories are advertising and importing toys which bear a confusingly similar mark, and selling those toys directly to consumers through unregulated marketplaces such as Amazon.com. The imported goods display applicant's background Mark with the words 'Colouring & Drawing' in place of the words 'Melissa & Doug' in applicant's composite mark, using the same white script.<sup>44</sup>

The table below shows Applicant's products and the alleged infringing uses:<sup>45</sup>

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<sup>44</sup> January 13, 2020 Request for Reconsideration, TSDR at 20-21, Miller Declaration, ¶ 6.

<sup>45</sup> *Id.* at TSDR 21.

Applicant's Products	Alleged Infringing Products
 <p>The packaging for 'Water Wow! VEHICLE WATER-REVEAL PAD' is yellow and black. It features the 'Melissa &amp; Doug ON the GO' logo. The main title 'Water Wow!' is in large, colorful letters. Below it, it says 'Color with Water, Let it Dry and Color it Again!'. The illustration shows various vehicles like a yellow excavator, a red motorcycle, and an orange sports car. A large water pen is shown in the center. A circular inset shows a train being colored. A 'NO MESS!' badge is present. At the bottom, it says 'Vehicle-Themed Boards &amp; Refillable Water Pen'.</p>	 <p>The packaging for 'Magic Water Drawing Book' is yellow and blue. It features the 'Melissa &amp; Doug Coloring &amp; Drawing' logo. The main title 'Magic Water Drawing Book' is in a bubbly font. Below it, it says 'Coloring &amp; Drawing'. The illustration shows various vehicles like a purple car, a yellow excavator, and a red train. A large water pen is shown in the center. A circular inset shows a train being colored. A 'NO MESS!' badge is present. At the bottom, it says 'Vehicle-Themed Boards &amp; Refillable Water Pen'.</p>
 <p>The packaging for 'Water Wow! SPLASH CARDS!' is red and white. It features the 'Melissa &amp; Doug ON the GO' logo. The main title 'Water Wow!' is in large, colorful letters. Below it, it says 'Color with Water, Let it Dry and Color it Again!'. The illustration shows various letters (Aa, Bb, Cc, Dd, Ee) on cards. A large water pen is shown in the center. A circular inset shows a letter card being colored. A 'NO MESS!' badge is present. At the bottom, it says 'Reusable Alphabet Flash Cards 1 Refillable Water Pen &amp; Card Clip'.</p>	 <p>The packaging for 'MAGIC WATER DRAWING BOOK' is green and blue. It features the 'Melissa &amp; Doug Coloring &amp; Drawing' logo. The main title 'MAGIC WATER DRAWING BOOK' is in a bubbly font. Below it, it says 'Coloring &amp; Drawing'. The illustration shows various farm animals like a cow, a chicken, and a pig. A large water pen is shown in the center. A circular inset shows a cow being colored. A 'No Mess!' badge is present. At the bottom, it says '4 Farm Animals-Themed Boards &amp; Refillable Water Pen'.</p>

Applicant explains that it “is seeking to register the Mark for reasons including that similar goods are being imported into the United States and sold on open

marketplaces such as Amazon.com. Many of the imports are sold to consumers directly from an overseas factory, or through aliased foreign sellers.”<sup>46</sup> While Applicant’s interest in enforcement efforts is understandable, we do not find the alleged third-party copying supports that the Proposed Mark has acquired distinctiveness. As shown in the examples in the top row,<sup>47</sup> the foreign product replicates additional elements of Applicant’s overall trade dress such as the yellow color scheme, similar font styles, the spiral notebook design, and the train,<sup>48</sup> tractor, car, road, construction site, and grass designs. Accordingly, we cannot conclude that the alleged copier believed consumers would perceive the Proposed Mark as a source identifier on its own. *In re Fantasia Distrib., Inc.*, 120 USPQ2d 1137, 1145-46 (TTAB 2016) (“Because the copying in this instance is not limited to the diamond pattern alone, it does not show that the copier perceived the diamond pattern by itself as a source indicator or believed that consumers would rely on the diamond pattern as an indicator of the source of the goods.”). Indeed, the fact that the alleged infringing product has a similar overall look and feel to Applicant’s product suggests the opposite. Meanwhile, the products in the second row appear to be specifically

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<sup>46</sup> Appeal Brief, 8 TTAVUE 6.

<sup>47</sup> There appear to be differences in the product examples in the bottom row that account for the differences in the products’ overall trade dress. The foreign product is a color-by-water book with a farm animal theme while Applicant’s product is a color-by-water alphabet flashcard book featuring animals generally.

<sup>48</sup> The train designs are nearly identical.

different, which would explain why the overall look and feel is not similar as in the examples in the first row.<sup>49</sup>

For these reasons, we do not find the alleged infringing uses persuasive on the issue of acquired distinctiveness.

#### 6. Considering the Factors as a Whole

Considering all of the Section 2(f) evidence as a whole, we find that Applicant has failed to meet its burden of establishing that the Proposed Mark has acquired distinctiveness as a source identifier for Applicant's goods. The consumer declarations are probative, but 31 declarants is a small number, and not necessarily representative of the relevant consuming public. Further, while the record supports that Applicant has made long, extensive and substantially exclusive use of the



Composite Mark and also has realized impressive sales, the probative value of this evidence is limited by the fact that Applicant always uses the Proposed Mark as part of the Composite Mark. *See In re Hillerich & Bradsby Co.*, 97 USPQ at 453 (advertising focused on “the oval in connection with the ‘Louisville Slugger’ bat, i.e., the ‘Louisville Slugger oval’”); *see also Amazing Spaces*, 95 USPQ2d at 1349 (no secondary meaning where star symbol “was almost invariably used not as a stand-alone mark” but rather as an “integral part of several marks”). Indeed, the “look for” advertising Applicant points to calls consumer attention to the

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<sup>49</sup> Both products are water pens and paper, but Applicant's product consists of animal and letter flash cards while the foreign products is a farm-animals themed board.

MELISSA & DOUG portion of the Composite Mark as opposed to the background design comprising the Proposed Mark. Where, as here, the Proposed Mark is so inherently non-distinctive, Applicant's failure to use or promote the Proposed Mark separate and apart from the Composite Mark is significant. The record also lacks important information regarding Applicant's promotional activities, and the third-party "infringing" uses are not particularly probative because the allegedly infringing products contain more similarities than just the Proposed Mark. On this record, we cannot find that consumers would view the Proposed Mark as an indication of origin separate and apart from the wording with which it appears.

In sum, given the Proposed Mark is comprised of a common oval shape and the colors red and white, and Applicant uses the Proposed Mark exclusively as a carrier for the word mark MELISSA & DOUG, we find that more is needed to establish acquired distinctiveness. *Cf. In re Haggard Co.*, 217 USPQ 81, 84 (TTAB 1982) (finding black swatch design "something more than a common geometric shape" that had acquired distinctiveness).

#### **B. Online Retail Stores Services**

The record includes very little evidence regarding Applicant's use of the Proposed Mark for online retail store services. Applicant submitted printouts from its online retail store showing the Proposed Mark prominently displayed as part of Applicant's Composite Mark in the upper left-hand corner of each page and on the featured

products.<sup>50</sup> However, there is no evidence regarding how long Applicant has used the Proposed Mark for online retail store services, the extent of promotion of the Proposed Mark in connection with online retail store services, or associated advertising expenses. Nor has Applicant broken down sales made through its online store. The declarations Applicant submitted address consumer recognition of the Proposed Mark for Applicant's goods. Only one consumer indicated that she purchased Applicant's goods through Applicant's online store.<sup>51</sup>

Based on this record, we simply cannot find that the Proposed Mark has acquired distinctiveness as a source identifier for Applicant's online retail store services.

#### **IV. Conclusion**

Applicant has not established a prima facie case that the Proposed Mark has acquired distinctiveness for Applicant's goods or services.

**Decision:** The refusal to register the Proposed Mark under Sections 1, 2, 3 and 45 of the Trademark Act, U.S.C. §§ 1051-53 and 1127, is affirmed.

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<sup>50</sup> March 27, 2019 Office Action Response, TSDR 8 and 12-15, Myers Declaration, ¶ 2 and Exhibit A.

<sup>51</sup> August 21, 2019 Office Action Response, TSDR 14.