

**THIS OPINION IS NOT A
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rita Abraham and Jesco Imports, Inc.

v.

David O'Neill

Opposition No. 91115853
against Serial No. 75327229

Robert W. Dickerson of Jones Day for Rita Abraham and
Jesco Imports, Inc.

Thomas Y. Auner for David O'Neill.

Before Bucher, Grendel and Taylor, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

David O'Neill, a U.S. citizen and resident of
Springfield, Missouri, seeks registration on the Principal
Register of the following mark:



for goods identified in the application as "household or kitchen utensils and containers, namely, cookie jars, plates, bowls, cups and glasses" in Int. Class 21.¹

Rita Abraham, at the time of filing of the opposition, a U.S. citizen and resident of New York, and Jesco Imports, Inc., a California corporation, have opposed registration, asserting that applicant's mark, when used in connection with applicant's goods, so resembles marks previously used and registered by opposers, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Specifically, Ms. Abraham alleged in the Notice of Opposition that she is the owner of the following, incontestable federal trademark registrations:²

¹ Application Serial No. 75327229 was filed on June 17, 1997 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Applicant disclaims the word "Kewpie" apart from the mark as shown, and states that the "name shown on the mark does not identify a living individual."

² According to the records of the United States Patent and Trademark Office, several of opposer's earlier pleaded registrations (and others simply referenced during prosecution) are no longer subsisting, such as Registration No. 0707169 for KEWPIE, "Backfile, Cancelled or expired"; Registration No. 0776119 for KEWPIE KLOTHES, expired Sec. 9; Registration No. 0895918 for KEWPIE ♡ GAL, expired Sec. 9; Registration No. 1800922 for KEWPIE ♡ GAL, cancelled Sec. 8; Registration No. 1546532 for KEWPIE GOES ..., cancelled Sec. 8; and Registration No. 1546534 for KEWPIE KARDS, cancelled Sec. 8.

KEWPIE for "nursery furniture and furnishings, namely; comforter, fabric wall hangings, sheets, hooded towels, washcloths, and tablecloths" in International Class 24;³

KEWPIE for "dolls" in International Class 28;⁴

Moreover, Jesco Imports, Inc., as Ms. Abraham's exclusive licensee, alleges that since 1989 it has marketed itself, or licensed others to market, a variety of **KEWPIE**-related goods including dolls and other toys, figurines, sleepwear, jewelry, etc., where all the listed products involved a doll, or collateral products containing images of a "doll face that is reminiscent of the child-like figure first created by Rose O'Neill years ago, and for which Rose O'Neill is famous." (Notice of Opposition, ¶ 6).

³ Registration No. 1406785 issued to Rita Abraham on August 26, 1986 based on an application filed on June 27, 1984. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. According to the records of the Assignment Division of the United States Patent and Trademark Office, this registration was assigned to Jesco Imports, Inc. (subsequent to the filing of this opposition) as of October 11, 2002, Reel 2620, Frame 0815.

⁴ Registration No. 1543698 issued on June 13, 1989 based on an application filed on November 30, 1987. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. According to the records of the Assignment Division of the United States Patent and Trademark Office, this registration too was assigned to Jesco Imports, Inc. as of October 11, 2002, Reel 2620, Frame 0815.

On January 21, 2000, applicant filed his answer to the notice of opposition, denying all the salient allegations of the notice of opposition and arguing a number of affirmative defenses. Additionally, applicant counterclaimed to cancel the registrations pleaded by opposers, arguing that opposers are not the rightful successors in interest to the rights in the **KEWPIE** marks, that opposers have fraudulently represented their ownership rights in the **KEWPIE** marks, and finally, that the term "Kewpie" has long been the generic name of dolls, figurines and pictures featuring Rose O'Neill's artwork. Opposers denied all the salient allegations of the counterclaims and interposed their own affirmative defenses thereto.

The Record

By operation of the rules, the record includes the pleadings of both parties and the file of the opposed application. In support of their case, opposers made of record the testimony of Mary Barela-Kallen, a retired licensing agent having a decade of collaboration with opposers, taken on August 23, 2004, along with opposers' exhibits 1 and 2; the testimony of James E. Skahill,

president and owner of Jesco Imports, Inc., taken on September 9, 2004, along with opposers' exhibits 3 through 37; and applicant's response to opposers' first set of interrogatories and first request for production of documents. Applicant's case included his own testimony taken on October 12 & 20, 2004, along with applicant's exhibits 1 through 84 and opposers' exhibits 38 through 47; the testimony of James E. Skahill, president and owner of Jesco Imports, Inc., taken on October 20, 2004, along with applicant's exhibits 85 through 148; and opposers' responses to applicant's first set of interrogatories.

Factual Findings

Rose O'Neill

Rose O'Neill (1874-1944), a prominent suffragette, illustrator, sculptor, designer, novelist, poet and artist at the beginning of the twentieth century, published the first images of her "Kewpie" characters in 1909, referring to them as little cupids. The instant popularity of these nude, chubby and saucy characters, each with an oversized head having side-glancing eyes and a wry top-



knot, and often, a small set of wings on their backs, grew out of their appearances world-wide in magazine cartoons and short stories. The phenomenon quickly led to dolls and figurines made of ceramic, celluloid, bisque or porcelain, initially manufactured in Germany by Geo. Borgfeldt & Co. of New York and sold the world over. Joseph Kallus was hired by Rose O'Neill and Borgfeldt to sculpt many of the first Kewpie dolls. With the U.S. embargo on Germany during World War I, production was returned to the U.S., and Kallus later founded Cameo Doll Products Company in 1925. (Testimony of James E. Skahill on September 9, 2004, hereinafter, "Skahill I.," p. 22.) When Mr. Kallus died in 1982, his rights, and those of Cameo Doll Company, passed to his daughter, Rita Abraham.



The extensive record in this case demonstrates that Ms. Rose O'Neill vigorously pursued a variety of intellectual property protections for her creative works, in the form of copyrights, design patents and trademarks. At the height of the Kewpie popularity, the demand to manufacture commercial items bearing the Kewpie likeness resulted in the marketing of comic strips, figurines,

dolls, books, lamps, dishes, postcards, jewelry and various other lines of products.

Opposers

According to an agreement dated November 1, 1947, Paul E. O'Neill, nephew of Rose O'Neill and administrator of her estate, transferred to Joseph Kallus "whatever rights or interest by way of copyright, patent or trademark the estate of said Rose O'Neill may have in said characters known as Kewpie and Scootles" and "grants, sells, transfers and assigns to [Kallus] all of the rights, title and interest of [Rose O'Neill], whether acquired by common law, copyright, patent or trademark to the cartoons or characters known as Kewpie and Scootles, and also the sole and exclusive right to reproduce those characters ... [in cartoons, etc]." (See Jesco Exhibit 4, Bates J01753).

Within three months of Kallus' death in 1982, his sole heir, Rita Abraham, executed an exclusive licensing agreement with Jesco Imports, Inc. As noted earlier (see footnotes 3 and 4, *supra*), the two subsisting **KEWPIE** trademark registrations that had issued to Ms. Rita Abraham in the 1980's were assigned to Jesco in 2002.

Applicant

Applicant, David O'Neill, is the great nephew of Rose O'Neill. He was born in 1939 and received his first Kewpie doll from Rose O'Neill when he was a year old.

(Testimony of David O'Neill, October 12, 2004, hereinafter "O'Neill I," at pp. 3, 5). After collecting Kewpie-related items for more than thirty years, applicant had amassed a collection of more than 20,000 Kewpie-related items, of which more than 1400 different items are displayed in his building in Springfield, Missouri.

(Testimony of O'Neill I, at pp. 5, 24, 26 & 27). He is a member of various regional Rose O'Neill clubs, has conducted extensive research on his great aunt, Rose O'Neill, and her Kewpie creations, and has authored four books focused on her art, her Kewpie artwork, products, etc. (Testimony of O'Neill I., p. 17, 18, 19-21). David O'Neill is also a director of the Rose O'Neill Foundation, formed to preserve the O'Neill family's original artwork created by Rose O'Neill, and to preserve her history. Finally, since 1997, he has also been named as the personal representative of the Estate of Rose O'Neill.

Preliminary matters

One of applicant's counterclaims was that opposers' trademark registrations should be cancelled because of opposers' fraudulent conduct. (Counterclaim ¶ 5). Although documents applicant has placed into the record contain allegations of fraud on the part of Joseph Kallus, and particularly in connection with his several copyright applications, the alleged misconduct seems largely unrelated to opposers' trademark rights. Moreover, applicant's briefs fail to press the fraud claim, so we assume it has been dropped from this proceeding.

Standing

Opposers must prove at trial their alleged standing to file this complaint. Ms. Abraham⁵ and Jesco alleged and then proved at trial a real commercial interest, as well as a reasonable basis for the belief that opposers would be damaged by the registration of applicant's mark.

Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Opposers have presented evidence of the

⁵ During briefing of the case, a parenthetical note suggested Ms. Abraham was now deceased. Hence, although the record is not clear as to the continuing interest of Ms. Abraham (or her estate), there is no reason to believe that Jesco Imports, Inc. does not continue to have such standing.

ownership and validity of their pleaded registrations for the mark **KEWPIE**.

Applicant's standing to cancel the pleaded registrations is inherent in his position as defendant in the original opposition proceeding. See Ohio State University v. Ohio University, 51 USPQ2d 1289, 1293 (TTAB 1999); Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); Syntex (U.S.A.) Inc. v. E. R. Squibb & Sons Inc., 14 USPQ2d 1879, 1881 (TTAB 1990); and Bankamerica Corp. v. Invest America, 5 USPQ2d 1076, 1078 (TTAB 1987); General Mills, Inc. v. Natures Way Products, 202 USPQ 840, 841 (TTAB 1979) [counterclaimant's position as defendant in the opposition gives it a personal stake in the controversy]; and TBMP § 309.03(b) (2d ed. 2004).

Applicant's Remaining Counterclaims

Issue as to the possible Genericness of "Kewpie"

Inasmuch as opposers have several federal registrations of the mark **KEWPIE**, this creates a strong presumption that the term is not generic, and applicant bears the burden of overcoming this presumption. Yet, as noted by opposers, applicant devotes but a single page in

his final brief to the claim of genericness. (Applicant's appeal brief, spanning pp. 22 and 23).

Based upon this extensive record, it seems clear that there are prospective customers of dolls⁶ who want to purchase a **KEWPIE** doll of the sort marketed by opposers and having historical origins with the artistry of Rose O'Neill. However, it is improper to base a finding of genericness on claims of "purchaser motivation."

Certainly, cancelling a registration merely because an aspect of the goods or services is "an important ingredient in the commercial success of the product" would be at odds with legal precedent,⁷ including that of the predecessor to our primary reviewing court. See In re Penthouse International Ltd., 565 F.2d 679, 682-83, 195 USPQ 698, 700-01 (CCPA 1977). In an oft-quoted concurring decision, the late Judge Nies warned that we must avoid "... an esoteric and extraneous inquiry focusing on what motivates the purchasing public to buy particular

⁶ This section focuses primarily on the '698 registration for dolls as that is the class of goods for which applicant's claim of genericness would be strongest.

⁷ See Ives Laboratories v. Darby Drug Co., 601 F.2d 631, 643, 202 USPQ 548, 557 (2nd Cir. 1979) (quoting Pagliero v. Wallace China Co., 198 F.2d 339, 343, 95 USPQ 45, 48 (9th Cir. 1962)); Truck Equipment Service Co. v. Fruehauf Corp., 536 F.2d 1210, 1217-18, 191 USPQ 79, 85-86 (8th Cir. 1976), cert. denied, 429 U.S. 861.

goods" See In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 404 (CCPA 1982), J. Nies, concurring [Drawings of Superman, Batman, and Joker as trademarks for toy dolls].⁸ As she noted, "The principle that a trademark

⁸ In re DC Comics, Inc., J. Nies, concurring, *supra*, at 404-405:

" ... The reason the public is motivated to buy the product, whether because of quality, particular features, source, pleasing design, association with other goods, price, durability, taste, or prestige of ownership, is of concern to market researchers but is legally immaterial to the issue of whether a particular designation is generic. Thus, the board's reliance on its conclusion that purchasers want appellant's dolls 'and would simply not be satisfied' with any others is misplaced. This rationale ignores the reality that the primary objective of purchasers is to obtain particular goods, not to seek out particular sources or producers, as such. Motivation does not change a descriptive term that has acquired distinctiveness or any arbitrary word, name, symbol or device into a generic designation. The correct inquiry is whether the public no longer associates what was a trademark with that single source.

Similarly, that purchasers call for a particular product by the name given it by its producer or source does not negate its function as a mark. Such a given name is a proper name, like the name of an individual, not a generic name, so long as the public uses it to identify a product of a single source. It is the normal way the public uses a mark which is applied by a manufacturer or a merchant to a particular product, and, as indicated, trademark concepts do not require the condemnation of normal commercial language. Trademark law merely condemns the use of that language in a way which deprives purchasers of their expectations and deprives businesses of the goodwill which they have built up by providing satisfactory goods and services. For the same reason, that a trademark is well known does not make it a "common" descriptive name. "Common," like "generic," states a conclusion that the claimed mark is, or has become, part of the vernacular, that it is indefinite, and does not function as a proper name of a particular producer's goods"

must indicate 'source' and not 'goods' does not condemn single product word marks" Accordingly, in dismissing a finding of genericness based on alleged purchaser motivation, we note the statutory amendment to the Lanham Act in the wake of the Ninth Circuit's often-derided Anti-Monopoly decision.⁹ Hence, we cannot rely on purchaser motivation, as that concept was employed in Anti-Monopoly, given the amendments to Section 14 of the Lanham Act.¹⁰

Rather, we must rely on the primary significance of the registered mark to the relevant public. Our primary reviewing court has stated:

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry: First, what

⁹ See Anti-Monopoly Inc. v. General Mills Fun Group Inc., 684 F.2d 1326, 216 USPQ 588 (9th Cir. 1982), cert. denied, 103 S.Ct. 1234 (1983) [MONOPOLY for popular real estate board game was held generic as no special test was applicable to "unique" goods situations, and consumer motivation of product over source (as measured by surveys) was critical, rather than overall consumer understanding].

¹⁰ See Section 14(3) of The Trademark Act of 1946 as Amended, 15 U.S.C. §1064(3), Nov. 8, 1984, 98 Stat. 3335]:

" ... A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used."

is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) [citations omitted].

Under the first part of the Ginn two-part genericness test, we find that the genus of goods or services at issue in this case is "dolls" - the goods identified in opposer's involved registration. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ["Thus, a proper genericness inquiry focuses on the description of [goods or] services set forth in the certificate of registration."].

Under the second part of the Ginn test, we find, for the reasons discussed below, that applicant has failed to establish that the **KEWPIE** mark of opposers' registrations is understood by the relevant public primarily to refer to the genus of goods at issue, i.e., "dolls."

Evidence of the public's understanding (under the second part of the Ginn test) may come from direct testimony of consumers, consumer surveys, dictionary listings, or from generic usage in newspapers and other

publications. See Magic Wand Inc., *supra*, 19 USPQ2d at 1553; In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

In this counterclaim, it is applicant's burden to demonstrate genericness. Magic Wand, *supra* at 641-42. The Court of Appeals for the Federal Circuit has also indicated that a finding of genericness requires "a *substantial showing*, that the matter is in fact generic" and that such showing "must be based on clear evidence of generic use." In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1997).

Applicant submitted no testimony of consumers, no consumer surveys and no newspaper articles. The only evidence in this case of the types enumerated in Magic Wand that applicant has submitted to support his claim that the word "Kewpie" is generic consists of a single dictionary definition and seemingly generic usage in an unrelated copyright case in which the court described a product as having a "kewpie doll" appearance.

The single dictionary entry that applicant provides says that the word "Kewpie" was "Originally a trademark."¹¹ This suggests that the editors of THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE had concluded that this term was once a trademark but had suffered from "genericide."¹² However, a single dictionary definition cannot be conclusive on the issue of genericness "if for no other reason than that this would endow editors of such works with the power to destroy trademarks merely by defining them generically." In re Minnetonka, Inc., 212 USPQ 772, 778 (TTAB 1981); quoted in 2 J. McCarthy, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Section 12:13 at page 12-28 (4th ed. 2003).¹³

Moreover, in the instant case, this single suggestion of genericide is easily offset by opposers' evidence that

¹¹ **Kewpie**, n. A small, fat-cheeked, wide-eyed doll with a curl of hair on top of the head. [Originally a trademark] THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fourth Edition 2000).

¹² In propounding this theory, applicant analogizes the instant situation to the devolution of the word "Escalator."

¹³ See also "Dictionary entries also reflect lexicographical judgment and editing which may distort a word's meaning or importance. 'A Court accepting a dictionary entry at face value is in effect adopting the lexicographical judgment as its own, even though such a judgment might be based on printed matter which, if offered in evidence, would not be controlling'."

1 Jerome Gilson, TRADEMARK PROTECTION AND PRACTICE, § 2.02 at 2-35 (1992), cited in Berner International Corp. v. Mars Sales Co., 987 F.2d 975, 26 USPQ2d 1044, 1050 (3rd Cir. 1993).

other dictionaries continue to refer to "Kewpie" as a trademark for dolls.¹⁴

Additionally, applicant places a great deal of emphasis on what appears to be a single generic usage by a federal appeals court judge in Durham Industries Inc. v. Tomy Corporation, 630 F.2d 905, 208 USPQ 10 (2d Cir. 1980). We recognize that on its face, this opinion (dealing with a totally different copyright issue) uses the term "kewpie" to refer to a particular but non-proprietary style of dolls. However, we agree with opposers that this sole reference to a particular doll as having a "kewpie-doll" appearance was an off-hand remark in a case that did not involve the trademark **KEWPIE** in any sense. We find it plausible that even a federal jurist may have been less than precise in the court's language in selecting this registered trademark as a descriptor of dolls, particularly when that court panel was focused on substantive matters unrelated to whether this term continues to serve as a source indicator. Moreover, given

¹⁴ For example, in WEBSTER'S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE, (2nd ed. 1996), the entry for the word "**Kewpie**" appears as "Trademark. a brand name for a small, very plump doll with a topknot, usually made of plaster or celluloid"; "**Kewpie:** trademark - used for a small chubby doll with a topknot of hair" WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY (9th ed. 1990).

the limited circulation of such opinions among members of the public (unlike articles of general circulation enumerated in Magic Wand, *supra*), a single occurrence in that legal opinion will have little impact upon the public's understanding of the term "Kewpie."

Finally, we agree with opposers that the totality of the record, including some of applicant's own actions, belie this conclusion: applicant initially filed the involved application without a disclaimer of the word "Kewpie"; applicant testified that he acknowledges that KEWPIE is an incontestable, registered trademark owned by opposers; applicant co-authored a book in which he acknowledged that KEWPIE is a trademark owned by opposers; applicant acknowledged that Rose O'Neill herself considered KEWPIE to be a trademark; this conclusion is consistent with applicant's actions throughout his relationship with Mr. Kitagawa - the representative of a Japanese company whom applicant has licensed to sell products in Japan under the trademark ROSE O'NEILL KEWPIE, (Testimony of O'Neill I, pp. 147 to 149), the fact that the trademark KEWPIE has been registered numerous times not only in the United States, but in Canada, Europe and Asia, and the clear recognition over more than twenty-five years

by major corporations in several industries that KEWPIE has trademark significance in relation to a wide array of products, and that opposers own those continuing trademark rights.¹⁵

Against this type of indication of opposers' rights grounded in continuous usage in the marketplace and their federal registrations, a single dictionary definition and an off-hand court comment are *de minimis* evidence of genericness. They certainly do not comprise the substantial showing based on clear evidence of generic usage that is applicant's burden herein. Accordingly, in answering the second prong of the Ginn genericness inquiry as to how "Kewpie" is understood by the relevant public, this record contains very few examples of where this term is used in a generic manner. Accordingly, applicant's genericness counterclaim is dismissed as to both of

¹⁵ The posture of this case, dealing with opposers' opposition to the registrability of applicant's involved mark and applicant's counterclaims does not require us to comment on those contexts in which applicant is entitled to use the **KEWPIE** trademark as part of valid historical references in a manner that is not likely to confuse prospective customers.

opposers' subsisting registrations.¹⁶

Disputed ownership

The record reveals decades of simmering intellectual property disputes between, on the one hand, familial relations of Kewpie-creator, Rose O'Neill, and, on the other hand, Joseph Kallus, his heirs and assigns. Applicant argues that opposers "have grossly misstated the effect of the 1947 agreement between Paul O'Neill and Joseph Kallus contained in Jesco Exhibit 4." He argues that the grant language in this agreement focuses on copyright-related properties for a limited term of fifteen years. He contends that the record shows that Joseph Kallus quit making royalty payments under the agreement after the fifteen-year term expired. (Applicant's Exhibits 33 and 34). Furthermore, applicant argues that the 1962 assignment document (Jesco Exhibit 5) is simply an acknowledgement of the 1947 agreement.

Opposers contend that applicant has mischaracterized the totality of the 1947 agreement. Opposers point to the

¹⁶ If the counterclaim fails on the genericness claim as used in connection with dolls in International Class 28, then we find such counterclaim must fail, *a fortiori*, as to the **KEWPIE** registration for the goods in International Class 24. According to pictures in the record, this second incontestable registration covers goods having images reminiscent of Rose O'Neill's artwork.

actual terms of the agreement to argue that it was much more than a license of copyright interests for a limited period of time. Rather, opposers contend that this broad grant of intellectual property rights clearly included, *inter alia*, all the trademark rights that Rose O'Neill and then her Estate had in the **KEWPIE** characters, and that it was an assignment of all these intellectual property rights for all time. According to opposers, "There is no reversion-of-rights language, and Applicant's attempt to read such a reversion into that assignment agreement is similarly baseless." (Opposers' brief, p. 10). We agree with opposers, and find that these documents, on their face, resulted in an outright transfer of the trademark rights of Rose O'Neill's Estate to Joseph Kallus.

In any event, while opposers point out that their demonstrated chain of title in the **KEWPIE** trademark rights back to Rose O'Neill's Estate adds value to their rights, such chain of title "is not a *sine qua non* as to" their trademark rights. Rather, opposers argue that the strength of their claims lies with their unchallenged ownership of incontestable registrations, combined with the extensive, documented use of this trademark, by opposers and their predecessors, which use is continuous

and dates back to the 1940's. Again, we agree with opposers. We find that opposers are the owners of the mark, and we dismiss applicant's "non-ownership" counterclaim.

Accordingly, we dismiss applicant's counterclaim as to all the claimed grounds.

Opposers' Likelihood of Confusion claim

Priority

Even if we agreed with applicant, and were to find a weak link in Joseph Kallus' alleged receipt of trademark rights from Rose O'Neill's Estate, that would not have been the final word on the question of priority in this proceeding. Opposers have established their ownership of a valid and subsisting registration for the mark **KEWPIE** for dolls, as well as a second registration for household products made of fabric materials. Therefore, having dismissed applicant's counterclaim for cancellation of opposers' registrations, we find that priority is not at issue in view of opposer's ownership of their pleaded registrations. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995). In any event, opposers

demonstration of long and continuous use of the **KEWPIE** trademark establishes actual prior use vis-à-vis applicant's application filing date, which is the earliest date upon which applicant can rely for priority purposes. Either way, opposers' showing is clearly sufficient to defeat the contingent constructive use date of applicant's recently-filed intent-to-use application.

Likelihood of Confusion

Turning now to the issue of likelihood of confusion, our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In

re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks

We consider first the du Pont factor that focuses on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In making this determination, our focus should be placed on the recollection of the average consumer who normally retains a general rather than a specific impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). While we must consider the marks in their entirety, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) [CASH MANAGEMENT ACCOUNT found confusingly similar to THE CASH MANAGEMENT EXCHANGE].

In looking at applicant's mark, we agree with opposers that the dominant portion of applicant's mark is the word **KEWPIE** consisting of large, upper-case letters.



As was the case with the artistic signature she used during her lifetime, the "Rose O'Neill" portion of this composite is so heavily stylized as to compromise somewhat its legibility - with its extreme, broad-pen flourishes descending from small, heavy, hand-drawn letters.¹⁷

In addition to this visual assessment of applicant's composite mark, as seen below in our discussion of the inherent strength and renown of opposers' mark as applied to dolls and doll accessories, the word **KEWPIE** has to be considered to be a fairly strong source indicator. Accordingly, based upon this record as a whole, there can be no question but that the dominant and most distinctive portion of applicant's applied-for mark is the term "Kewpie." And, of course, as to the "KEWPIE" portion of applicant's mark, this is identical to the entirety of opposers' previously used and registered mark, **KEWPIE**.

¹⁷ While we do not go as far as opposers in characterizing this signature as "largely indecipherable," the "Rose O'Neill" portion of applicant's proposed mark certainly takes more effort to "decipher" than is the case with the "KEWPIE" portion.

Hence, the respective marks convey the same connotations and commercial impressions.

Moreover, to the extent that we consider opposers' alleged common law rights by examining closely the ways in which opposers and their licensees have used the entire, three-word term "Rose O'Neill KEWPIE," it seems that opposers even have priority in the actual usage of this identical combination of term as well.



18

The
Rose O'Neill
Kewpie

COLLECTION ¹⁹

Rose O'Neill's Original Kewpie® circa 1912 ²⁰

Rose O'Neill Kewpies
Under license from JESCO
1999 ²¹

Fame of KEWPIE mark

Although opposers have provided detailed sales information for the record under a claim of

¹⁸ Front of hangtag used on a doll distributed by E.J. Toy Company to Cracker Barrel gift shops under license from Jesco, Jesco Ex. 25, Bates J01876. Additionally, the packaging contains repeated presentations of "Rose O'Neill's Original Kewpie," Bates J01869 - 74.

¹⁹ Packaging for Kewpie Ice Skating Figurine, licensed to Enesco Corporation, 1995, Jesco Ex. 23, Bates J01887.

²⁰ Flier for Kewpie® Baby, Goldberger Doll Mfg. Co., Inc., Jesco Exhibits 26 and 28, Bates J01877, J01879-80, 83, 86, & 88.

²¹ Back of hangtag used on a doll made by the German Doll Company under license with Jesco, Jesco Exhibits 24, Bates J01779.

confidentiality, we can safely note that the record shows hundreds of thousands of dollars in royalty payments to Rita Abraham in the years between 1983 and 2001. (Jesco Exhibit 30). The record shows that during part of the decade of the 1990's alone, just two of Jesco's licensees combined, Enesco and Goldberger, marketed "Rose O'Neill's Original Kewpie® dolls" having a wholesale value in excess of four million dollars. (Jesco Exhibit 29).

Opposer has submitted information on the volume of Jesco's own catalogues sent to wholesalers and retailers in the toy and gift industry, details about Jesco's presence and that of its licensees at national toy fairs and trade shows, and has included copies of **KEWPIE** advertisements in the catalogues of various doll manufacturers and toy distributors.

However, according to the testimony of opposers' witnesses, the major promotional efforts of the **KEWPIE** brand are undertaken by opposers' licensees, and according to exhibits in the record, have included more than a dozen hourly shows on the QVC shopping network, more than three-hundred television spots placed by Rose Art that reached 70% of the population in the United States, full page color advertisement by the MBI Danbury Mint in periodicals

like Parade magazine, and advertisements distributed to consumers of both mass marketing chains and nationwide toy outlets, placed by companies such as Wal-Mart, K-Mart, Kaybee Toys and JCPenney.

Both applicant and opposers have referred to the storied history of **KEWPIE** dolls and related products spanning almost a century. When one considers the explosive popularity of **KEWPIE** dolls in the early part of the twentieth century (e.g., 1912 - 1920), their continuing popularity as playthings and as collectors' items, the fact that opposers and their predecessors have been continuously marketing **KEWPIE** items over the past sixty years, with a special focus on the volume of sales shown in this record to have taken place over the past fifteen years, we find that **KEWPIE** dolls have clearly achieved some degree of renown in the relevant markets.

Strength of marks

While applicant has attempted to demonstrate the weakness of the **KEWPIE** mark, we find, to the contrary, that this is a strong mark. It is a term that Rose O'Neill coined for drawings of imaginary child-like characters that quickly became dolls almost a hundred

years ago. It has been used continuously in connection with dolls and related goods since then. There appears to be a continuing demand for **KEWPIE** dolls - in the retail market for new dolls and figurines, as well as by hobbyists and collectors in the re-sale market. While applicant argues, for reasons of his own, that the term has become generic, that has not been demonstrated on this record, and we cannot presume to know the understanding of this well-known term in the minds of members of the relevant purchasing public. In fact, on this record, we must conclude that the word, **KEWPIE**, when used in connection with dolls and collateral products, is a strong mark indeed.

Applicant also argues that the term "Kewpie" is weak because in addition to usage of this term with dolls and doll accessories, and with clearly related items like toys, puzzles, clothing and fabrics, the term "Kewpie" has been used by third parties in connection with a wide variety of very different products, from vegetables, green beans and other canned goods to garters, from chewing gum to toilet paper, from cameras to toothbrushes, from soft drinks to soap, from spoons to shoes, from mayonnaise and egg products to postcards, stationery and note cards.

However, other than opposers' registrations, we find in the record only one subsisting, third-party federal trademark registration:

KEWPIE for "prepared baby and dietetic foods-namely, meats, poultry, fish, vegetables and fruits" in International Class 5; "mayonnaise; salad dressing; mayonnaise based sandwich spread; apple sauce and cranberry sauce; jams, jellies and marmalade; canned, bottled, dried, smoked and frozen meats, poultry, game; seafood; and processed fruits; canned soups; dried, frozen, smoked and liquid eggs; edible oils and fats; dried egg whites and dried egg yolks" in International Class 29; and "sauces except cranberry and apple sauce; prepared mustard; vinegar; honey; spices; tartar sauce; mustard spice and ready-to-eat cereals" in International Class 30.²²

At least two other third-party registrations cited to by applicant are no longer subsisting registrations.²³

²² Registration No. 1237958 issued to Kewpie Kabushiki Kaisha, a Japanese corporation on May 17, 1983, with the application having been filed on March 30, 1977, under Section 44(e) of the Act, based upon Japanese Registration Nos. 832,284 and 969,293.

²³ Specifically, the following registrations for food items:



[Registration No. 0787246]

for "dry egg whites" in International Class 46 expired Sec. 9, December 31, 2005.

KEWPIE
[Registration No. 2176130]

for "canned vegetables" in Int. Class 46 cancelled Sec. 8, May 1, 2005.

Given that this lone third-party registration represents food items listed in a single Japanese registration based on Section 44(e) of the Act, we find that there is no probative evidence of third-party usage in this country that would result in our restricting the scope of protection to be afforded to opposers' claimed registrations.

The goods

As we have seen, opposers have registrations of the mark **KEWPIE** in two classes of goods - household goods made of fabrics in International Class 24 and dolls in International Class 28.

Opposers have also placed into the record licensing agreements as well as advertisements of products on which they have licensed the **KEWPIE** mark, specifically demonstrating their own use in the past on items as diverse as dolls, figurines and gift toys, holiday ornaments, boxed paper dolls, costumes and masks, sewing patterns, children's clothing, adults' sleepwear and loungewear, silk scarves, jewelry, lapel pins, coin banks, storage tins, lamps, tea sets, bank checks, calendars and stationery items. (Jesco Exhibits 11 - 17).

Applicant has filed an intent-to-use application for his mark to be used in connection with "household or kitchen utensils and containers, namely, cookie jars, plates, bowls, cups and glasses" in International Class 21.

Applicant's own testimony acknowledges that a range of **KEWPIE** products will be purchased by collectors (Testimony of David O'Neill, October 20, 2004, hereinafter "O'Neill II," at p. 34), confirming the relatedness of these products in the minds of some potential consumers. For collectors, whether the product involves a doll, or collateral products containing images of a doll face reminiscent of the child-like figure first created by Rose O'Neill, both will be seen as related because of the subject matter. Additionally, household materials made of fabrics (e.g., opposers' Reg. No. '785) are related to kitchen containers (i.e., applicant's goods herein). Furthermore, the fact that opposers have in the recent past licensed the **KEWPIE** mark for tea sets certainly reinforces the conclusion that those knowledgeable about **KEWPIE**-related products may well expect the same organization that markets **KEWPIE** dolls and tea sets will also be providing its imprimatur or sponsorship to the

sale of cookie jars. Finally, opposers also argue that in reality, applicant's prototype cookie jar is not so very different, in form or in appearance, from a **KEWPIE** figurine having an unusually large base.

Given the cumulative ways in which the specific goods herein are related, we find that this factor supports the position of opposers.

Trade channels

Applicant argues that the trial testimony of Ms. Barela-Kallen, Jesco's former licensing agent, supports his position that goods such as dolls and toys are *not* related to kitchen utensils in general or cookie jars in particular. However, a careful review of the record shows that she actually testified that "... they are related if you walk into a department store like a K-mart, Wal-Mart, [or] Target that carries housewares as well as toys." In short, she concludes that the relevant consumers will likely perceive of product relatedness in the market place when one looks at the particular channels of trade or the specific structure of the markets in which they actually move. See AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 350, 204 USPQ 808 (9th Cir. 1979). She testified that the

same customers in the same stores would purchase these respective goods. "This factor is very significant in illuminating what actually happens in the marketplace and, where other factors are not particularly probative, is of special importance." Homeowners Group, Inc. v. Home Mktg. Specialists, Inc., 931 F.2d 1100, 1110, 18 USPQ2d 1587, 1595 (6th Cir. 1991). Again, this related du Pont factor supports the position of opposers.

Conditions of sale

There is no demonstration that consumers of these respective items will be sophisticated or that the involved goods are so expensive as to result in an inordinate amount of care on the part of prospective consumers. Hence, we presume that the goods of opposers and the goods of applicant would be sold to ordinary members of the general public exercising no special degree of care. This factor favors a likelihood of confusion herein.

Conclusion:

We have found: that applicant's mark conveys the same connotation and commercial impression as do opposers' marks; that **KEWPIE** is a relatively strong mark having

achieved some degree of renown in the toy and gift field; and that the respective goods are related and would be purchased by the same ordinary members of the general public in the same stores.

Decision: The opposition is sustained based on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.