

Hearing:  
March 26, 2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Paddington & Company, Ltd.

v.

Lead Co., Ltd.

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Opposition No. 91150248  
to application Serial No. 75729380  
filed on June 11, 1999

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Pasquale A. Razzano of Fitzpatrick, Cella, Harper & Scinto  
for Paddington & Company, Ltd.

Michael A. Grow of Arent Fox Kintner Plotkin & Kahn, PLLC  
for Lead Co., Ltd.

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Before Hairston, Walters and Bergsman, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The Lead Co., Ltd. seeks to register the mark shown  
below for "handkerchiefs of paper; tissue paper; notebooks;  
memo paper; name card paper; envelopes; scrapbooks;  
ballpoint pens; pencils; crayons; pencil cases; letter  
holders; boxes of paper; paper sacks for packaging; picture  
postcards; comic books; catalogues in the field of general  
merchandise and clothing; and magazines dealing with topics

of sports, cultural events and general interest" in International Class 16 and "clothing and footwear, namely, flat shoes; basketball shoes; sandals; slippers; raincoats; mantillas; shorts; half coats; shirts; dresses; baby bunting; jackets; jumpers; jeans; parkas; Hawaiian print shirts; pajamas; night gowns and night shirts; bathrobes; sweaters; sport shirts; athletic uniforms; t-shirts; pullovers; mufflers; mittens; scarves; socks; hats and caps; and belts" in International Class 25.<sup>1</sup>



Teenie Weenie Bear

Paddington & Company, Ltd. has opposed registration of applicant's mark, alleging (1) a claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, and (2) a claim that applicant lacked a bona fide

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<sup>1</sup> Serial No. 75729380, filed June 11, 1999; based on an allegation of a bona fide intention to use the mark in commerce.

intent to use the mark in commerce when applicant filed its application.

Specifically, opposer alleges that since long prior to the filing date of applicant's application, opposer has continuously used "the image of the Paddington Bear character in interstate commerce for a wide variety of children's products sold throughout the United States, and is currently using this image in connection with such goods, as well as in advertisements for the goods;" that "the goods so marked have been widely sold and used throughout the United States so that the image of Paddington Bear has acquired great value and goodwill inuring to the benefit of Paddington;" that "Paddington's continuous use in commerce of the image of the Paddington Bear character since at least as early as 1959 has provided Paddington with common law rights in and to this character image;" that applicant's mark is so similar to opposer's Paddington Bear character as to be likely to cause confusion or to cause mistake or to deceive when applied to applicant's goods; that "the similarity of Applicant's bear design mark and Opposer's Paddington Bear character is likely to cause consumers to believe that Applicant's goods originate with or are connected or sponsored by Opposer or one of its licensees resulting in likelihood of confusion and damage to Opposer's extensive goodwill in the famous Paddington Bear character;"

and that applicant did not have a bona fide intention to use its mark in commerce on the specified goods when applicant filed its application.

Applicant filed an answer to the notice of opposition in which it denied the salient allegations thereof.

The record consists of the pleadings; the opposed application; the testimony (with exhibits) of opposer's witness Nicholas Durbridge, a director of opposer and chairman and CEO of Copyrights Group Limited; the testimony (with exhibits) of applicant's witness Jodi Arlen, a paralegal with the law firm representing applicant;<sup>2</sup> applicant's notice of reliance on opposer's responses to applicant's interrogatories and requests for admissions; and opposer's rebuttal notice of reliance on status and title copies of its registrations for the standard character marks PADDINGTON and PADDINGTON BEAR for various goods and its Community Trade Mark Registration No. 001407568 for the Paddington Bear character.

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<sup>2</sup> Applicant also submitted the testimony of its president Young Soo Kim and its advertisement department manager Haeng-Ja Nam. In orders issued April 1, 2006 and August 3, 2007, the Board granted opposer's motions to strike the testimony of Young Soo Kim and Haeng-Ja Nam, respectively. In view thereof, we have not considered this testimony.

The parties have filed briefs<sup>3</sup> and an oral hearing was held on March 26, 2009 at which counsel for the parties appeared.

Each party, in its brief on the case, has raised objections to portions of the adverse party's testimony and exhibits. These objections are based principally on lack of personal knowledge of the witness and relevancy. Suffice it to say that we have considered all of opposer's and applicant's testimony and exhibits, keeping in mind the objections to certain portions of the record. We have accorded whatever probative value the testimony and exhibits merits.

Opposer and its Paddington Bear character

In 1958, Michael Bond, an English author, wrote a novel titled "A Bear Called Paddington." (Durbridge Test. Dep. at 11) It is the story of a bear which arrives at Paddington Station in London after having traveled from Peru as a stow-away. The bear is found by Henry and Mary Brown, who name him Paddington after the station where they found him. Mr. and Mrs. Brown take Paddington home and love him as a child. (Durbridge Test. Dep. at 12-13; Opposer's Test. Exh. 10)

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<sup>3</sup> In an order issued August 14, 2008 the Board granted applicant's motion to strike opposer's reply brief as untimely. In view thereof, we have not considered opposer's reply brief.

The novel was published in the United States in 1959.

(Durbridge Test. Dep. at 11) From 1958 to the early 1970's, Mr. Bond wrote ten novels and three collections of short stories about Paddington Bear, all of which have been published in the United States. (Durbridge Test. Dep. at 11)

In the late 1960s/early 1970s, Michael Bond formed opposer Paddington & Company in response to the demand for Paddington Bear-branded merchandise. (Durbridge Test. Dep. at 6; Opposer's Test. Exh. 69A) In 1975, opposer granted a license to Eden Toys, Inc., to make Paddington Bear plush toys and market the goods in the United States. (Durbridge Test. Dep. at 14-15) Opposer has since licensed the use of the Paddington Bear character in the United States on a wide variety of items such as posters, games and activity kits, silver jewelry and Christmas ornaments, buttons, pins, thimbles and tack pins, and stationery products. (Durbridge Test. Dep. 36-56; Opposer's Test. Exh. 2-53) Opposer, through its licensees, has used the Paddington Bear character on items such as a children's hat (Opposer's Test. Exh. 137); tie (Opposer's Test Exh. 138); children's jacket (Opposer's Test. Exh. 139); children's hairbrush (Opposer's Test. Exh. 140); children's toothbrush (Opposer's Test. Exh. 141); and children's toy chalk set (Opposer's Test. Exh. 142).

Applicant and its TEENIE WEENIE BEAR and bear design mark

Because the testimony of applicant's witnesses Young Soo Kim and Haeng-Ja Nam was stricken, we have no information concerning applicant.

Opposer's standing and priority

We find that opposer's testimony coupled with the numerous exhibits establish opposer's real commercial interest in the Paddington Bear character mark. Lipton Industries Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We likewise find that the evidence of record clearly establishes opposer's use and/or licensed use of the Paddington Bear character mark in the United States prior to the filing date of applicant's intent-to-use application. Specifically, the evidence of record establishes that opposer and/or its licensees have used the Paddington Bear character mark in the United States in connection with Christmas ornaments (Opposer's Test. Exh. 134); children's growth charts (Opposer's Test. Exh. 136); children's hats (Opposer's Test. Exh. 137), ties (Opposer's Test. Exh. 138); children's jackets (Opposer's Test. Exh. 139); children's hairbrushes (Opposer's Test. Exh. 140); children's toothbrushes (Opposer's Test. Exh. 141); children's activity kits (Opposer's Test. Exh. 142); children's games (Opposer's Test. Exh. 144); children's dinnerware (Opposer's Test. Exh.

145); and children's calendars (Opposer's Test. Exh. 147).

Contrary to applicant's contention, the use of the Paddington Bear character on the above goods is not pure ornamentation, but rather serves as a secondary source trademark. As discussed in J. T. McCarthy, McCarthy on Trademarks and Unfair Competition § 3.4 (4<sup>th</sup> edition updated 2009) (footnotes omitted):

Trademarks can also serve to identify a "secondary source" in the sense of indicating sponsorship or authorization by a recognized entity. For example, the name or logo of a university on clothing can signify that the university authorizes, endorses and licensees the sale of such wearing apparel by the manufacturer. The same is true of sports teams' emblems, television marks and characters, and commercial firm's marks used on wearing apparel.

See also *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982) [indicia on T-shirts is not purely ornamental, but serves as a secondary indication of authorization]; *In re McDonald's Corp.*, 199 USPQ 702 (TTAB 1978) [McDONALD's and "golden arches" identifies the secondary source of authorization of the use on the mark on clothing]; and *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) [corporate logo on t-shirt serves as an identifier of a secondary source].



Likelihood of confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The relevant du Pont factors in this proceeding are discussed below.

The fame of opposer's Paddington Bear character mark

We first turn to the du Pont factor of fame, because the fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In this case, the relevant consumers would be children and their parents.

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services at issue, by the length of time the mark has been in use,

widespread critical assessments and notice by independent sources of the goods and services identified by the mark as well as the general reputation of the goods and services. Bose Corp. v. Audio Products Inc., 63 USPQ2d at 1305-06 and 1309. Although raw numbers of products sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products). Bose Corp. v. QSC Audio Products Inc., 63 USPQ2d at 1309.

Furthermore, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it. Leading Jewelers Guild Inc. v. LJOW Holdings LLC, 82 USPQ2d 1901, 1904 (TTAB 2007).

As previously indicated, ten novels and three collections of short stories about Paddington Bear have been published in the United States (Durbridge Test. Dep. at 11); in 1975 opposer Paddington & Co. was formed in response to the demand for Paddington Bear-branded merchandise (Durbridge Test. Dep. at 6; Opposer's Test. Exh. 69A); and opposer has licensed the use of the Paddington Bear

character on a wide variety of merchandise (Durbridge Test. Dep. 36-56; Opposer's Test. Exh. 2-53).

The Paddington Bear character also has appeared in television programs broadcast in the United States and in videos and DVDs sold in the United States. (Durbridge Test. Dep. at 17-19.) The Paddington Bear television programs were broadcast by Public Broadcast Service (PBS) stations. For example, during the week of April 26 to May 3, 1981, the Paddington Bear programs were broadcast by 215 PBS stations, and an A.C. Nielsen survey revealed that that the programs were viewed by a cumulative audience of 1,710,000 television households which represented a total audience of 2.9 percent of all television households in the United States.

(Durbridge Test. Dep. at 77) The Paddington Bear character has been featured in contests and promotions with Good Housekeeping magazine, the American Library Association, and UNICEF. (Durbridge Test. Dep. at 82) During the 1990 Christmas season, Macy's had a tie-in with the Paddington Bear character. In addition to offering a variety of Paddington Bear merchandise at its stores, Macy's conducted a short musical review at its Herald Street Store in New York City which featured the Paddington Bear character. Also, Macy's sales associates wore pins which featured an image of Paddington Bear, and the first Paddington Bear balloon appeared in the Macy's Thanksgiving Day Parade.

(Durbridge Test. Dep. at 93-95) In 1994, Sears Roebuck and Co. entered into a license to sell merchandise with the Paddington Bear character at its stores. (Durbridge Test. Dep. at 57) In 2002, the Dayton Hudson Corporation constructed a Christmas grotto in the Minneapolis airport featuring animated scenes from the story Paddington Bear and the Christmas Surprise. (Durbridge Test. Dep. at 88.) Also in 2002, Marshall Fields and Company created a series of Christmas windows featuring the Paddington Bear character at its downtown Chicago store. (Durbridge Test. Dep. at 88)

Opposer presented no specific evidence of the dollar amounts expended on advertising merchandise offered under the Paddington Bear character mark because opposer's licensees do not provide opposer with this information. (Durbridge Test. Dep. at 104) Furthermore, opposer presented no specific evidence of the dollar amounts of sales attributable to merchandise sold under the Paddington Bear character mark. Rather, opposer's witness Mr. Durbridge testified that one could "generate an approximation of what the sales" of "Paddington-branded" merchandise has been using a formula involving the royalty rate and the wholesale and retail prices of the merchandise. (Durbridge Test. Dep. 62) "Paddington-branded" merchandise includes merchandise bearing the Paddington Bear character mark, the word mark PADDINGTON BEAR and/or the term PB.

(Durbridge Test. Dep. 116) According to Mr. Durbridge, opposer earned approximately \$3.2 million in royalties for the sale of Paddington-branded merchandise from 1991 to early 2004 and the royalty rate for such merchandise is between 8-10% of the wholesale selling price. (Durbridge Test. Dep. 101-02) Using this formula, opposer states in its brief on the case that "U.S. retail sales for PADDINGTON-branded merchandise during the 1991-early 2004 time frame totaled more than \$92 million." (Brief at 10)

After careful consideration of opposer's evidence, we find that it falls short of establishing that the Paddington Bear character mark is famous. We recognize that the Paddington Bear character mark has achieved a high degree of recognition. However, as indicated, opposer has presented no evidence with respect to advertising expenditures for merchandise offered under the Paddington Bear character mark. Furthermore, the purported \$92 million in retail sales covers not only merchandise sold under the Paddington Bear character mark, but merchandise also sold under the word mark PADDINGTON BEAR and/or the term PB. Thus, we cannot determine what amount of the purported \$92 million is attributable to the Paddington Bear character mark. In addition, opposer failed to put the retail sales figure in context in terms of where Paddington-brand merchandise ranks among other brands of merchandise which feature, for

example, marks consisting of children's storybook or television characters. Finally, although opposer has sold a large number of books featuring the Paddington Bear character, opposer has failed to place this number in context.

In view of the foregoing, we are unable to conclude that opposer's Paddington Bear character mark is famous for purposes of our likelihood of confusion analysis. Nonetheless, we acknowledge that the Paddington Bear character mark is strong as a result of the length of time in which the mark has been in use, the large number of licenses of the mark, and the books, contests, promotions and product tie-ins featuring the Paddington Bear character. Similarity/Dissimilarity of the goods and channels of trade

We now turn to the du Pont factor of the similarity or dissimilarity of the goods. The record shows that opposer has licensed the Paddington Bear character mark for use on a wide variety of goods. As the Board noted in *DC Comics v. Pan American Grain Mfg. Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005), "[i]t is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on 'collateral' products has become a part of everyday life." Thus, although none of applicant's Class 16 goods are the same as the goods in connection with which opposer has used the Paddington Bear character mark, at the

very least, applicant's Class 16 ballpoint pens, pencils and notebooks are in the nature of collateral products. As such, they may be related to opposer's goods in the mind of the consuming public in terms of their origin. In view of the facts that opposer has licensed the use of the Paddington Bear character in connection with a wide variety of goods; and consumers recognize that, in the general marketing environment, merchandising marks are used to identify a variety of goods and services, we find that applicant's Class 16 ballpoint pens, pencils, notebooks and opposer's goods are related. We also find that applicant's ballpoint pens, pencils and notebooks and opposer's goods would be sold in some of the same channels of trade (e.g., gift and card shops) to the same classes of consumers.

With respect to applicant's Class 25 goods, they cover, inter alia, jackets and hats. Opposer has shown that its licensees have used the Paddington Bear character mark in connection with children's hats and jackets. In the absence of any limitations in the identification of goods in applicant's application, we must presume that the identified Class 25 jackets and hats encompass children's jackets and hats. Thus, in this respect, the goods of opposer and applicant are legally identical. We also find that these goods of the parties would be sold in the same channels of

trade (e.g., clothing stores, mass merchandisers) to the same classes of consumers.

The du Pont factor of the similarity of the goods and trade channels favors opposer.

Customers and conditions of purchase

Both parties' goods are of a type that are relatively inexpensive and are purchased by the general public rather than by sophisticated purchasers. This factor favors opposer.

Similarity/Dissimilarity of the marks

We next turn to the du Pont factor of the similarity or dissimilarity of the marks. Before we compare the parties' marks, we must first determine exactly what opposer's mark is for purposes of our comparison. As noted, opposer does not own a registration, and therefore is entitled to base its likelihood of confusion claim only on its common law rights in, and its actual manner of usage of, its Paddington Bear character mark.

In its brief on the case, opposer asserts rights in "the well known design of the Paddington Bear character," and relies on ten poses of the Paddington Bear character taken from opposer's Community Trademark Registration No. 001407568. (Brief at 1) In each of the poses, the Paddington Bear character is depicted in a floppy hat and duffle coat. Also, opposer's witness Mr. Durbridge



testified that the Paddington Bear character "is known for his floppy hat and duffle coat." (Durbridge Test. Dep. at 13) Furthermore, Mr. Durbridge testified that in the television programs, videos and DVDs the Paddington Bear character "always appears in his duffle coat and with his floppy bush hat." (Durbridge Test. Dep. at 19) Although the Paddington Bear character appears in other outfits depending upon the nature of the story, "he always goes back to his duffle coat, that is what he is known for by millions and millions of consumers around the world and in this country." (Durbridge Test. Dep. at 19) Finally, a close review of opposer's evidence of record reveals that the Paddington Bear character is indeed generally pictured with a floppy hat and duffle coat.

Under the circumstances, we find that for purposes of our comparison of the marks, opposer's Paddington Bear character mark is the two-dimensional depiction shown below with a floppy hat and duffel coat:



Applicant's mark is TEENIE WEENIE BEAR and bear design as shown below:



Teenie Weenie Bear

We turn now to a comparison of the marks. In comparing the marks, we are required to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., v. Veuve Clicquot Ponsardin Fondée, supra*. The test is not whether

the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to applicant's mark, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Where both words and a design comprise the mark (as in applicant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. In *re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Thus, notwithstanding the size of the bear design in applicant's mark, we find that the dominant portion is the literal portion of the mark, namely the words TEENIE WEENIE BEAR. We find that these words, along with the differences in applicant's and registrant's

respective bear designs, sufficient to distinguish the marks.

In terms of appearance, as we have noted, applicant's mark is dominated by the words TEENIE WEENIE BEAR. Moreover, although both applicant's mark and registrant's mark include a bear wearing a duffle coat, the bear designs are hardly identical. The faces of the bears are not at all like; Paddington Bear has a highly stylized bear face, whereas Teenie Weenie Bear has a realistic bear face. Furthermore, unlike Paddington Bear, Teenie Weenie Bear wears pants and a baseball cap turned backwards.

In terms of sound, applicant's mark includes the words TEENIE WEENIE BEAR; opposer's mark does not include any words. However, to the extent that purchasers would vocalize opposer's mark, they would be likely to refer to it as "Paddington Bear" which obviously differs in sound from TEENIE WEENIE BEAR. In short, the marks are dissimilar in sound.

In terms of connotation, due to the words TEENIE WEENIE BEAR in applicant's mark, such mark connotes a "little" or "small" bear.<sup>4</sup> Opposer's mark, on the other hand, has no

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<sup>4</sup> We judicially notice that the term "teen-weeny" is defined as:  
-**adjective** *Baby Talk*.  
tiny; small  
Also, **teenie-weenie**.  
Random House Dictionary (2009).

such specific connotation. Thus, the marks also are dissimilar in connotation.

Finally, when the marks are viewed in their entireties, giving appropriate weight to the dominant portion of applicant's mark, they are dissimilar in commercial impression. Again, we recognize that both marks include a bear wearing a duffle coat, but this does mean that the marks are similar. The detectives Dick Tracy and Colombo both wore rain coats, but they are hardly similar to one another.

For the above reasons, we find that when opposer's and applicant's marks are viewed in their entireties, they are dissimilar in appearance, sound, connotation and commercial impression.

This factor weighs against a finding of likelihood of confusion.

Third-party marks/use

During the testimony of its witness, Jodi Arlen, applicant introduced the following materials:

(1) approximately 400 third-party registrations for marks which consist of or include a bear design for a wide variety of goods and services along with web pages that appear to be websites posted by the owners of certain of the registrations; (2) web pages of third-party commercial websites that offer teddy bears for sale; (3) over 1000

third-party registrations and applications for marks that include the word "BEAR" for a wide variety of goods and services; (4) photographs of six third-party stuffed bears wearing duffle coats and hats or hoods; (5) two children's books featuring bear characters; (6) excerpts from a book titled The Teddy Bear Encyclopedia (2001); and (7) a third-party calendar that features teddy bears. By this evidence, applicant attempts to establish that there are "numerous third parties using bear designs as trademarks." (Brief at 13).

Insofar as the third-party registrations are concerned, they are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973). Furthermore, the Federal Circuit has recently stated, that "[t]he probative value of third-party trademarks depends upon entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Fondee*, supra at 1693. At best, examples of uses of a bear design in third-party websites comprise evidence that the consuming public could potentially be cognizant of third-party use of bear designs. The record, however, is devoid of any evidence of the consuming public's awareness of such uses; nor is there any information as to, for example, how long the websites have been operational or the extent of public

exposure to the sites. Where the "record includes no evidence about the extent of [third-party] uses ... [t]he probative value of this evidence is minimal." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). Furthermore, third-party applications have no evidentiary value other than to show that the applications were filed.

The remaining evidence consists of web pages of third-party commercial websites that offer teddy bears for sale; photographs of six third-party teddy bears wearing duffle coats and hats or hoods; two children's books featuring bear characters; a book about the history of teddy bears; and a third-party calendar that features teddy bears. Such evidence demonstrates that teddy bears are indeed ubiquitous in the children's toy market, and that teddy bears obviously co-exist and are distinguished because of the differences in the teddy bears themselves and/or other terms used in conjunction with the teddy bears. Thus, although the bear designs in opposer's and applicant's marks may both be characterized as teddy bears wearing duffle coats, this is an insufficient basis on which to find that opposer's and applicant's marks are similar.

This du Pont favors applicant.

Conclusion

We conclude that although opposer's Paddington Bear character mark is a strong mark, and the du Pont factors of the similarity of the goods, channels of trade, customers and conditions of purchase favor opposer, the factors of the dissimilarity of the marks and third-party use, which favor applicant, are dispositive. Thus, we find that opposer has not proven that the use of applicant's TEENIE WEENIE BEAR and bear design mark for the identified goods is likely to cause confusion with the Paddington Bear character mark for opposer's goods.

Applicant's alleged lack of a bona fide intent

Opposer maintains that there is absolutely no evidence of record to support applicant's alleged bona fide intention to use its mark in commerce on or in connection with the goods recited in the application. Opposer contends that applicant, in response to opposer's discovery requests, failed to produce documents or information supporting applicant's alleged bona fide intent to use its mark. Having failed to produce such documents or information, opposer argues that this is sufficient to prove that applicant lacked a bona fide intent to use the mark in commerce at the time applicant filed its application.

Opposer has the burden of establishing, by a preponderance of the evidence, its claim that applicant



lacked the requisite bona fide intention to use its mark in commerce on or in connection with the goods recited in the involved application. Although opposer argues that applicant, in response to opposer's discovery requests, failed to produce documents or information supporting applicant's alleged bona fide intent to use its mark, opposer did not make applicant's discovery responses properly of record in this case. See Trademark Rule 2.120(j)(3)(i). Thus, opposer has not established a prima facie case that applicant's application is invalid for lack of the requisite bona fide intention to use its mark in commerce. Because opposer has not established a prima facie case, the burden does not shift to applicant to come forward with evidence to refute such case. In other words, applicant was under no obligation to come forward with evidence to support its bona fide intention to use its mark.

Conclusion

In view of the foregoing, we conclude that opposer has not proven that applicant lacked a bona fide intention to use its mark in commerce on or in connection with the goods recited in the application.

**Decision:** The opposition is dismissed on both grounds.  
Bergsman, Administrative Trademark Judge, dissenting in part:

I concur in the majority's determination that opposer has not proven that applicant lacked a bona fide intention

to use its mark in commerce on or in connection with the goods recited in the application. In contrast, I disagree with the majority's conclusion that there is no likelihood of confusion.

"When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, the goods are closely related and in part identical. Because opposer uses the Paddington Bear character as a secondary source for collateral merchandising products and because applicant's Class 16 ballpoint pens, pencils and notebooks are in the nature of collateral products, consumers would likely encounter the marks under the same marketing milieu. Under such circumstances, the similarity between the marks is significant.

Both marks comprise anthropomorphic bears wearing "duffle" coats and hats. This is important in this case because, as set forth above, the record shows that the Paddington Bear character mark is a strong mark. Without more, photographs of six third-party teddy bears wearing duffle coats and hats or hoods does not weaken opposer's mark. Furthermore, because we have found that prospective consumers will not exercise a high degree of care in

purchasing the products at issue,<sup>5</sup> their attention will focus more on the similarities in the marks than the differences. As noted by the majority, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Finally, I disagree with the majority's finding that the name "Teenie Weenie Bear" is the dominant element of applicant's mark. I find that the bear design is the dominant element because of the size and placement of name vis-à-vis the design and that, therefore, the name identifies the design.

In view of the foregoing, I would sustain the opposition under Section 2(d) of the Trademark Act of 1946 and refuse registration.

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<sup>5</sup> "Both parties' goods are of a type that are relatively inexpensive and are purchased by the general public rather than by sophisticated purchasers."