

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
November 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Black Dog Tavern Company, Inc.

v.

Elizabeth A. Frechette

Opposition No. 91150887 to application Serial No. 76287988

and

Opposition No. 91151592 to application Serial No. 76017897¹

Emily LaPointe, General Counsel, The Black Dog Tavern
Company, Inc.

Elizabeth A. Frechette, pro se.

Before Seeherman, Quinn and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

The Black Dog Tavern Company, Inc. ("opposer") has
filed two notices of opposition to registration of two
applications filed by Elizabeth Frechette ("applicant"), who

¹ In an order mailed on January 13, 2003, the Board consolidated
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is representing herself in this proceeding. The first application is application Serial No. 76017897² for "paper articles, namely photographs, calendars and stationery" in International Class 16; "beverage glassware" in International Class 21; and "t-shirts, sweatshirts, jackets, pants and hats" in International Class 25 for:



The second application is application Serial No. 76287988³ for "retail store services featuring gift items" in International Class 35 for:



Both applications seek registration of the subject marks on the Principal Register.

In the notices of opposition, opposer pleaded ownership of numerous registrations for the following mark, identified

² Application Serial No. 76017897 was filed on April 5, 2000 and claims a bona fide intent to use the mark in commerce.

³ Application Serial No. 76287988 was filed on July 23, 2001 and claims a bona fide intent to use the mark in commerce.

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as "a standing Labrador in profile (the 'Standing Black Dog')" (Notice of Opposition, ¶ 2):



Specifically, opposer has pleaded the following registrations for the Standing Black Dog mark:

Registration No. 1561546,⁴ issued October 17, 1989, for "restaurant and bakery shop services" in International Class 42;

Registration No. 1620023,⁵ issued October 30, 1990, for "clothing, namely, hats, t-shirts, sweatshirts and shorts" in International Class 25;

Registration No. 2393737, issued October 10, 2000, for "jewelry, namely, pins, earrings, charms, pendants, charm bracelets, and watches; wall clocks, mantle clocks, and alarm clocks" in International Class 14;

Registration No. 2398106, issued October 24, 2000, for "china dishes; mugs; pet bowls; water bottles sold empty; beverage glassware; ice buckets; bird houses; and coasters, not of paper or of table linen" in International Class 21;

Registration No. 2398107, issued October 24, 2000, for "tote bags; all-purpose field bags; carry-on bags; duffle bags; umbrellas; insulated picnic bags and bottle totes; pet equipment, namely, pet backpacks, pet coats, pet leashes, and pet collars" in International Class 18;

Registration No. 2408614, issued November 28, 2000, for "playing cards, ball point pens, stamp

⁴ Section 8 filing accepted and Section 15 filing acknowledged.

⁵ Renewed.

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pad sets, pencil cases, bookmarks and bookends" in International Class 16;

Registration No. 2410612, issued December 5, 2000, for "stuffed toy dogs; golf balls and golf head covers, and toy dogs made of wood with wheels" in International Class 28;

Registration No. 2436745, issued March 20, 2001, for "beach towels; golf towels; burgees and flags made of cloth; tablecloths; placemats and napkins made of textiles; dish towels; oven mitts; and bandanas" in International Class 24; and

Registration No. 2487428, issued September 11, 2001, for "rugs and doormats" in International Class 27.

Additionally, opposer has asserted the following registrations, all for the mark THE BLACK DOG (in standard character form):

Registration No. 1559349,⁶ issued October 3, 1989, for "restaurant and bakery shop services" in International Class 42;

Registration No. 1593194,⁷ issued April 24, 1990, for "tinned cookies and bakery goods" in International Class 30;

Registration No. 1882153,⁸ issued March 7, 1995, for "printed matter, namely, catalogues published periodically featuring clothing, food, jewelry, toys and gift items" in International Class 16;

Registration No. 2000492,⁹ issued September 17, 1996, for "wine" in International Class 33;

Registration No. 2393742, issued October 10, 2000, for "clothing, namely, hats, t-shirts, sweaters, vests, polo shirts, chambray shirts, denim shirts, tank tops, jackets, pants, dresses, skirts, pajamas, belts, boxer shorts, bathing suits and

⁶ Section 8 filing accepted and Section 15 filing acknowledged.

⁷ Renewed.

⁸ Renewed.

⁹ Section 8 filing accepted and Section 15 filing acknowledged.

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aprons; children's rompers, onesies, sweatshirts, t-shirts, sweatshirts, hats, shorts and jackets" in International Class 25;

Registration No. 2396057, issued October 17, 2000, for "tote bags; all-purpose field bags; carry-on bags; duffle bags; umbrellas; insulated picnic bags and bottle totes; pet equipment, namely pet backpacks, pet coats, pet leashes, and pet collars" in International Class 18;

Registration No. 2396058, issued October 17, 2000, for "mugs, pet bowls; water bottles sold empty; ice buckets" in International Class 21;

Registration No. 2396059, issued October 17, 2000, for "stuffed toy dogs; golf balls; plastic flying discs" in International Class 28;

Registration No. 2436746, issued March 20, 2001, for "beach towels; golf towels; burgees and flags made of cloth; tablecloths; placemats and napkins made of textiles; dish towels; oven mitts; and bandanas" in International Class 24; and

Registration No. 2487429, issued September 11, 2001, for "rugs and doormats" in International Class 27.

Opposer has also alleged use of the Standing Black Dog mark and the words BLACK DOG on a variety of gift items such as hats, T-shirts, sweatshirts, shorts, mugs, bowls, water bottles, bags, towels, doormats and playing cards, as well as in connection with retail store services featuring gift items, prior to the filing date of applicant's application; and that applicant's use of her mark in connection with her identified goods and services is likely to cause confusion

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with opposer's marks. Trademark Act Section 2(d), 15 U.S.C. §1052(d).¹⁰

Applicant has answered the notices of opposition by denying the salient allegations thereof.

The record consists of the pleadings; the files of the two involved applications; the July 30, 2003 testimonial deposition of Robert Douglas, Jr., opposer's CEO, and accompanying exhibits; the testimonial deposition of Ms. Frechette and accompanying exhibits; the January 12, 2006 rebuttal testimonial deposition of Mr. Douglas and accompanying exhibits; and, pursuant to opposer's notice of reliance, a status and title copy of each of opposer's pleaded registrations mentioned above.

Opposer has filed its main brief. The Board did not receive a main brief from applicant.

The Parties

Opposer is a family-owned and operated retail and restaurant business founded by Robert Douglas, Sr. in 1971. Mr. Douglas, Sr. named his company after his pet dog at the time, i.e., "Black Dog," which was a black Labrador retriever mix. The Standing Black Dog mark is a depiction of Black Dog.

¹⁰ We note that in paragraph 9 of the notice of opposition, opposer has pleaded that it has a family of BLACK DOG marks, but that opposer did not argue that it has a family of marks in its brief. We therefore give no further consideration to opposer's pleaded allegation that it has a family of marks.

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In 1971, opposer opened a tavern named "The Black Dog Tavern" and a bakery named "The Black Dog Bakery," both in Martha's Vineyard, Massachusetts. Seven years later, in 1977, opposer first used the Standing Black Dog mark in connection with the tavern, and, in 1979, opposer first used the Standing Black Dog mark on t-shirts. Since at least 1988, opposer has been selling various goods through catalogs, with both the Standing Black Dog mark and the THE BLACK DOG word mark depicted on the catalogs. In 1993, opposer further expanded its business and opened "The Black Dog General Store," which was its first facility designated for retail sales. It has used the Standing Black Dog mark in connection with the general store since at least 1995. Currently, opposer owns and operates fourteen retail stores which sell a wide range of clothing and gift items, a tavern and a bakery, all of which use opposer's Standing Black Dog and word mark. It also sells a wide range of goods through its www.theblackdog.com website, and has been doing so since at least September 1999.

Opposer has participated in charitable fundraising. Specifically, opposer has donated money to "Time for Life," a charity that supports children recovering from cancer and various operations; "Dog Walk in New York City" sponsored by the American Cancer Society; and "American Rescue Dog." Further, opposer has taken patients from Boston Children's

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Hospital, as well as doctors and nurses, on day excursions on two "tall ships" owned by opposer and has donated "product" to the hospital.

Applicant is an individual who is "the owner of a t-shirt enterprise named 'Precious Paws.'" She is a two-time breast cancer survivor, and has a love for, and owns, Labrador retrievers. In a breast cancer fundraiser in October 1998, applicant walked five miles with her black Labrador retriever named Paige, which wore a pink ribbon tied around her neck. Paige and her ribbon were the inspiration for applicant's marks. In applicant's view, the "combination of the dog and the ribbon, along with the two pink paws below the dog, symbolizes the fight against breast cancer and the emotional support that one of America's most popular and gentlest breeds, the Labrador Retriever, gives to us in our time of need." Frechette Dep. at p. 18.

Applicant sells her goods to gift shops and to the general public through a web site. She first sold shirts bearing her mark on May 11, 2000 at the Mother's Day Craft Fair at the West Springfield Town Common and has been selling goods on her web site since 2000. While she once operated a retail store in Northampton, Massachusetts, she no longer does so. Applicant has advertised in local Massachusetts newspapers such as *The Republican* from Springfield, Massachusetts and the *West Springfield Record*,

as well as *Yankee* and *Coping* magazines. Further, applicant has donated goods and funds to various groups involved in the fight against cancer.

Preliminary Matters

Before addressing the merits of this case, we attend to three preliminary matters.

First, opposer has sought to introduce four registrations into the record by means of Mr. Douglas' rebuttal deposition. Three of these registrations issued after opposer commenced this proceeding but prior to the closing date of opposer's initial testimony period, i.e., October 30, 2005.¹¹ They are (i) Registration No. 2842709 for THE BLACK DOG (stylized) for various clothing items; (ii) Registration No. 3005863 for THE BLACK DOG for "retail store services in the field of clothing and general merchandise; online and catalog ordering services in the field of clothing and general merchandise"; and (iii) Registration No. 3008791 for the Standing Black Dog mark for "retail store services in the field of clothing and general merchandise; online and catalog ordering services in the field of clothing and general merchandise." Their submission during the rebuttal period is improper because they form part of opposer's case-in-chief and they could

¹¹ See the Board's August 24, 2005 scheduling order, which reset testimony periods in the present proceeding.

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have been introduced during opposer's initial testimony period. Accordingly, they have not been considered. The fourth registration is Registration No. 3014309 for THE BLACK DOG for "cocoa," which registered *after* the closing date of opposer's initial testimony period. While the Board typically does not entertain claims which were not the subject of the pleadings as originally filed or as amended, or as deemed amended, see cases cited in TBMP §314 (2d ed. rev. 2004), opposer referred to the underlying application for Registration No. 3014309 in paragraph 3 of the notice of opposition, and hence there was some notice given to applicant that opposer would rely on the registration should the application mature into a registration. Because opposer submitted this registration as soon as it could and applicant has not objected to the introduction of this evidence, we consider this registration as properly of record.¹² Thus, we will consider the issue in this case to be whether there is a likelihood of confusion only with regard to opposer's registered marks which are properly of record and opposer's pleaded common law marks.

The second preliminary issue concerns opposer's hearsay objection to the paid advertisements and newspaper and magazine articles made of record by applicant in her

¹² We would not have reached another decision in this case even if we had not considered the registration.

testimonial deposition. Opposer correctly maintains that "insofar as this material is offered to prove the truth of the matter asserted in its contents, it is inadmissible." Brief at p. 14. Opposer's objection is therefore sustained to the extent that we have not considered the advertisements and newspaper and magazine articles for the truth of their contents. We have, however, considered the articles and advertising for appropriate purposes, e.g., to show public exposure of applicant's marks.

The third preliminary issue concerns opposer's objection to applicant's "customer survey" on the grounds of relevance and hearsay. Brief at p. 14; Exhibits 3 - 415 to Frechette Dep. The "customer survey" is a printed form, one page in length, created by applicant that asks the following four questions:

1. How did you hear about *Precious Paws*?
2. Why did you purchase my merchandise or what were your thoughts if you have received *Precious Paws* merchandise as a gift?
3. At the time of purchase, did you believe you were purchasing merchandise associated with, licensed by, affiliated by, or in fact from the famous *Black Dog Tavern* of Martha's Vineyard?
4. Any other comments you feel necessary to say?

According to applicant, she "received [the "customer survey"] over the last five years ... [and they state] why ... customers purchase *Precious Paws* merchandise" from applicant. Frechette Dep. at p. 19. Applicant has not

submitted any compilation or analysis of results she obtained in her "customer survey."

Surveys and customer questionnaires are admissible, if they are pertinent to the inquiry, upon a showing that the poll is reliable and was compiled in accordance with accepted survey methods. *Baumholser v. Amax Coal Co.*, 630 F.2d 550 (7th Cir. 1980); *C.A. May Marine Supply Co. v. Brunswick Corp.*, 649 F.2d 1049 (5th Cir. 1981). "[I]f the survey is fairly and scientifically conducted, loss of the ability to cross-examine interviewees should not detract from the probative value of the survey." 5 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:167 (4th ed. database updated 2006). In this case, applicant has not attempted to establish that her "survey" was conducted in accordance with accepted principles of survey research.¹³ There is no evidence that the "survey" was made with the assistance of a survey professional; it appears that

¹³ For example, in *Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F. Supp. 1189, 1205, 217 USPQ 1137, 1149 (EDNY 1983), the court stated that the trustworthiness of surveys depended on evidence that (1) the "universe" was properly defined, (2) a representative sample of that universe was selected, (3) the questions to be asked of interviewees were framed in a clear, precise and non-leading manner, (4) sound interview procedures were followed by competent interviewers who had no knowledge of the litigation or the purpose for which the survey was conducted, (5) the data gathered was accurately reported, (6) the data was analyzed in accordance with accepted statistical principles, and (7) objectivity of the entire process was assured. The *Toys "R" Us* court noted that the "[f]ailure to satisfy one or more of these criteria may lead to exclusion of the survey." *Id.* See also 5 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:181 (4th ed. database updated 2006).

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applicant designed and conducted the "survey" by herself; and there is no evidence in the record that suggests that applicant has any expertise in conducting surveys or even has ever conducted another survey. More significantly, there are significant flaws in the "survey." Applicant limited the participants to her customers, asked them leading questions designed to elicit certain information, and provided such customers with information other than what appears on the face of Exhibits 3 - 415 (several of the responses contain information regarding this opposition proceeding).¹⁴ The record does not identify what other information applicant provided her customers prior to answering the questions. Because the "survey" was not conducted in accordance with accepted survey methods, the responses obtained from applicant's customers are not part of a proper survey but merely consist of hearsay statements which are not probative of the issues before us in this case. Opposer's objections to the survey are therefore sustained, and Exhibits 2 - 414 are given no further consideration.

¹⁴ See, e.g., response in Frechette Ex. 139, which states in part; "Elizabeth should not have to change her logo. She has personal photos of Paige & Lady, thus proving her choice of breed & clearly the dog has a ribbon of color[,] depicting hope and the fight against breast cancer, around her neck. Also, once she turns a profit[,] she plans on donating to (2) causes. What a generous person! Good luck Elizabeth, against cancer & Black Dog!!"

Priority

Because opposer has entered into evidence status and title copies of each of its registrations pleaded in the notices of opposition for opposer's Standing Black Dog and THE BLACK DOG marks, which show that the registrations are subsisting and that opposer is the owner, priority is not an issue for those goods which are claimed in such registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer has also established common law rights in both of its marks prior to the filing date of applicant's intent-to-use applications for a variety of goods and services and prior to the first use date of applicant's marks, i.e., on May 11, 2000 in connection with t-shirts and in March 2001 for retail store services. Mr. Douglas has testified as follows:

- Q. Let's just talk about the expansion of the business since the tavern first opened in 1971. Could you give me sort of a time line of the expansion of the business?
- A. Sure. January 1, 1971 The Black Dog Tavern opened for business. In the summer of 1971 the bakery on Water Street opened for business. In 1987 we started to sell the catalog - excuse me, publish the catalog for retail sales. In 1979 we started to sell The Black Dog T-shirt for the first time. In 1993 The Black Dog General Store, the first real location designated for retail sales was opened.

Douglas Dep. at p. 14. Opposer also has introduced advertisements for the Black Dog Tavern from the *Vineyard*

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Gazette in January 1971; an October 8, 1971 article written about the Black Dog Tavern in the *Vineyard Gazette*; an August 16, 1972 article on, and bakery advertisement for, the Black Dog Bakery in *The Grapevine*; and an August 26, 1971 article in the *New York Times* about The Black Dog Tavern. See Exhibits 2A - 2E to Douglas Dep.¹⁵ Mr. Douglas also testified that the Standing Black Dog mark was first used in 1977 in connection with the tavern and in 1979 in connection with t-shirts. Douglas Dep. at pp. 15 - 16. Further, the record includes Exhibits 10F, 10G, 10J and 10L to Mr. Douglas' deposition, which are combination catalogs and calendars, 8½ inches by 11 inches in size, with a perforation at the top of each page for a nail or thumbtack, for the years 1994 - 1995, 1996 - 1997, 1999, and 2001. THE BLACK DOG and the Black Dog design appear prominently in each catalog/calendar. The 1997 catalog depicts a poster bearing the wording "The Black Dog Tavern" and "The Black Dog Bakery & General Store" as well as the Standing Black Dog mark. Exhibit H to Douglas Dep.¹⁶

¹⁵ Although the newspaper articles cannot be considered for the truth of the matters asserted therein, they are proper evidence of the fact of publication and the publication dates of such articles.

¹⁶ Opposer also relies on a weekly appointment book depicted in opposer's 1991 catalog. See Exhibit 10D to Douglas Dep. The depiction of the appointment book does not include opposer's marks and there is no testimony that the appointment book includes such marks. Accordingly, opposer has not established that it has used its marks on weekly appointment books. The same holds true with respect to greeting cards and "The Story of the Little Black Dog" book, depicted in the 1994 - 1995

The record also reflects that opposer opened "The Black Dog General Store," i.e., "the first real location designated for retail sales," in 1993. Douglas Dep. at p. 14. Opposer has introduced an advertisement from *The Improper Bostonian*, dated May 24 - June 6, 1995, for The Black Dog Tavern, The Black Dog Bakery and The Black Dog General Store and catalog which contains the Standing Black Dog mark superimposed on a rising sun overlooking a nautical scene under the banner THE BLACK DOG.

In view of the foregoing, priority is either not in issue, or opposer has established its priority with respect to, inter alia, calendars, posters, t-shirts and general store services.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

catalog/calendar. The greeting cards depict "Vineyard scenes" and show a photograph of The Black Dog Tavern. However, neither the greeting cards nor the book exhibits use of opposer's marks. Therefore, we have not treated these exhibits as evidencing prior use by opposer.

Opposer's 2001 catalog/calendar depicts a copy of "The Black Dog Summer on the Vineyard Cookbook," which includes the Standing Black Dog mark on the cover of the book. While the catalog/calendar does state, "Prices Valid Until 3/31/01 or as long as Supplies Last," there is no testimony as to when the 2001 catalog/calendar was made available to the purchasing public. Therefore, we cannot treat the calendar as showing use of opposer's marks on a cookbook prior to the April 5, 2000 filing date of applicant's application Serial No. 76017897.

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1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Because we regard applicant's marks as being closer to opposer's Standing Black Dog design mark than the word mark THE BLACK DOG, we begin our analysis of the likelihood of confusion with this mark. We first consider the similarities between applicant's goods and services as described in the various International Classes of her application and opposer's goods and services.

International Class 16: As discussed above, the record shows that opposer has made prior use of its Standing Black Dog mark on calendars, as well as posters. Inasmuch as applicant's International Class 16 goods include calendars, applicant's goods are in part identical to opposer's goods.

International Class 21: Applicant's identified "beverage glassware" must be deemed to include "mugs," which is listed in the identification of goods for Registration No. 2398106 (Standing Black Dog). Because opposer's "mugs"

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include mugs made of glass, applicant's identification of goods necessarily encompasses opposer's "mugs." The goods hence overlap.

International Class 25: The parties' goods are in part identical. Both the involved application and opposer's Registration No. 1620023 (Standing Black Dog) recite t-shirts, sweatshirts and hats, and opposer has also established prior common law rights in the Standing Black Dog mark for t-shirts. Applicant's jackets and pants are otherwise related to the "hats, t-shirts, sweatshirts and shorts" in opposer's registration for the Standing Black Dog mark in that they encompass casual clothing items which would be purchased in the same clothing stores, and could form part of the same outfit.

International Class 35: Opposer has established that it operates a general store under the Standing Black Dog mark, and that it sells clothing and gift items as part of these retail store services. Opposer has shown that it has done so prior to the filing date of applicant's application and prior to the time when applicant operated her retail store in Northampton, Massachusetts, i.e., from March 2001 until April 2004. Frechette Dep. at p. 51. Applicant's identified "retail store services featuring gift items" in International Class 35 are therefore identical to or

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otherwise closely related to opposer's retail store services.

In view of the foregoing, we find that the *du Pont* factor concerning the similarities of the goods and services weighs heavily in opposer's favor.

We next consider the similarity of the established and likely to continue trade channels and the conditions under which and buyers to whom sales are made.

Because there are no restrictions or limitations in applicant's identification, applicant's goods and services are deemed to be sold in all channels of trade that are appropriate for such goods and services, and to all appropriate purchasers. Similarly, opposer's goods as identified in its Registration Nos. 1620023 and 2398106 are not restricted. Accordingly, insofar as the goods in Classes 21 and 25 are concerned, the parties' goods are deemed to be marketed in the same trade channels and to the same classes of purchasers, i.e., to the general public. *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

With respect to the paper articles and retail store services, opposer's rights in its mark for calendars and for retail store services, which are based on its common law rights, are limited to its actual channels of trade. The record shows that opposer sells its calendars and posters

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through catalogs and offers its services through its stores which are located in Massachusetts and Rhode Island.

Applicant has advertised in Massachusetts publications and states that products bearing her mark may be purchased in places such as Springfield and Boston, Massachusetts.

Opposer's retail stores are therefore in the same geographic area where applicant's goods are available for purchase.

Also, opposer's goods and services are marketed to the general public, which are the same purchasers to whom applicant's goods and services are directed. Indeed, applicant herself has acknowledged that some of her customers are also opposer's customers. Frechette Dep. at p. 18. Because opposer's and applicant's trade channels and classes of consumers are the same, and applicant advertises and sells her products in the same geographic area where opposer's retail stores are located, members of the same class of purchasers, i.e., the general public, may encounter both parties' goods and services. Accordingly, we find that the third and fourth *du Pont* factors weigh in favor of finding a likelihood of confusion.

Next, we consider the fame or relative strength of opposer's mark. Opposer has introduced into the record numerous advertisements and newspaper and magazine articles from sources such as *The New York Times*, *USA Today*, *The Wall Street Journal*, *Town and Country*, *The Washington Post* and

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The New Yorker, regarding opposer. According to Mr. Douglas, opposer has spent approximately \$5 million from 1987 to 2002 on advertising The Black Dog products and services. Douglas Dep. at p. 48 (Q. Can you give me the approximate amount of money spent on advertising The Black Dog products and Services from 1987 to 2002? A. Approximately \$5 million). From 2003 to 2005, opposer has spent approximately \$390,000 on advertising in connection with The Black Dog marks. Douglas Reply Dep. at p. 17 (Q. Would you provide the approximate dollar amount spent on advertising in connection with The Black Dog marks from 2003 to 2005? A. Approximately \$390,000). Also, opposer has generated approximately \$100 million in revenue in connection with both THE BLACK DOG word mark and the Standing Black Dog mark from 1987 to 2002. Douglas Dep. at p. 80 (Q. Can you give me the approximate dollar volume of revenue generated in connection with The Black Dog marks from 1987 to 2002? A. Approximately \$100 million). From 2003 to 2005, opposer has generated approximately \$34 million in sales. Douglas Rebuttal Dep. at p. 17 (Q. Would you provide approximate sales generated in connection with The Black Dog mark from 2003 to 2005. A. Approximately \$34 million). Further, there is no evidence in the record of any third parties using marks similar to opposer's Standing Black Dog mark, and we have testimony from Mr. Douglas that

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opposer has initiated oppositions against third parties and written letters in connection with "potential other marks that are infringing on the Black Dog mark."

From the foregoing, we find that opposer has established that its Standing Black Dog mark is strong. Applicant does not dispute this: She stated, during her cross-examination of Mr. Douglas, that "I know you are very famous. I am not questioning that at all." Douglas Rebuttal Dep. at p. 19.¹⁷

Next, we consider the similarities between opposer's mark and applicant's marks. We must determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

We acknowledge that there are specific, slight differences between applicant's standing Labrador silhouette and opposer's Standing Black Dog silhouette, such as the direction each dog is facing, and the shape of the tails and the collars, which in applicant's case is in the shape of a remembrance ribbon. However, the overall impression of the marks is that of a standing black dog that is, or is close

¹⁷ In view of the evidence submitted by opposer, we do not find opposer's mark to be famous, despite the statement made by applicant, who is proceeding pro se, regarding the fame of opposer.

in appearance to, a Labrador retriever. As such, the marks are similar in appearance and commercial impression. Any subtle differences between the marks, including the paw prints at the bottom of applicant's marks, are outweighed by the overall similarities in appearance and commercial impression; a side-by-side comparison is not the test, but rather the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). We add, too, that to the extent purchasers recognize the remembrance ribbon and recall that opposer's mark does not bear such a ribbon, it is likely that they will assume that applicant's marks are a modification of opposer's mark to include the ribbon. As described above, opposer has been involved in supporting various charitable causes, including the treatment of cancer.

"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 (Fed. Cir. 1992). Thus, in view of the similarities between the marks, the legal identity and/or relationship between the goods and services, the overlapping

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trade channels, and applicant's admission that opposer's mark is a strong mark, as well as our finding of such based on the opposer's sales and advertising and the lack of evidence of third-party use of dog design marks, we conclude that applicant's marks, when use in connection with the goods and services recited in applicant's applications, are likely to cause confusion with opposer's Standing Black Dog mark.

In view of our finding that there is a likelihood of confusion between opposer's Standing Black Dog mark and applicant's marks, we need not reach the question of whether there is a likelihood of confusion between opposer's THE BLACK DOG mark and applicant's marks.

DECISION: Both oppositions are sustained for the goods and services in International Classes 16, 21 and 25 and 35, on the basis of likelihood of confusion under Section 2(d), and registration of both of applicant's marks is refused.