

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
April 10, 2014

Mailed:
July 17, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

3M Company

v.

Professional Gallery, Inc.

Opposition No. 91173411
to application Serial No. 78642201
filed on June 2, 2005

William G. Barber and Wendy C. Larson of Pirkey Barber PLLC
for 3M Company.

Dustin R. DuFault of DuFault Law Firm for Professional
Gallery, Inc.

Before Seeherman, Quinn and Kuczma, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Professional Gallery, Inc. (Applicant) has applied to
register the mark FLAG-IT! in standard characters for
"adhesive-backed labels; adhesive-backed plastic film
designating signatory action." The application, Serial No.

78642201, was filed on June 2, 2005, based on an alleged bona fide intention to use the mark in commerce (Section 1(b) of the Trademark Act).

3M Company (Opposer) has opposed registration on the grounds of likelihood of confusion and dilution. In particular, Opposer has alleged that it is the owner of a number of registrations for the marks POST-IT and POST-IT with designs for, inter alia, stationery notes containing adhesive on one side for attachment to surfaces, and for tape flags; that Opposer adopted and began using POST-IT as a trademark for adhesive-backed stationery products such as tape flags decades before Applicant filed its application; that Opposer's common law and statutory priority dates precede any priority date on which Applicant may rely; and that Opposer's POST-IT marks are famous and became famous well before the filing date of Applicant's application.

Applicant has denied the salient allegations in the notice of opposition.

The description of the record is set out at pages 8-12 of Opposer's trial brief (90 TTABVUE 10-14) and 7-16 of Applicant's brief (92 TTABVUE 8-17).¹ It includes the testimony, with exhibits, of Opposer's witnesses David

¹ In its brief Applicant has asserted that a survey conducted by Opposer, and introduced during the testimony of Dr. Blair, is either not admissible or should not be given probative value.

Duling, Jeffrey Hillins, Theodore Peichel, Edward Blair and, in rebuttal, David Ormson; and of Applicant's witness, Kevin Goldrick. Opposer has made its pleaded registrations, Internet evidence, certain of Applicant's discovery responses and portions of discovery depositions of record under a notice of reliance. Applicant has submitted, under notice of reliance, portions of discovery depositions,² certain of Opposer's responses to discovery, official records and Internet materials.

Opposer has submitted status and title copies of 13 registrations for POST-IT marks as Exhibits 1 to 13 to its notice of reliance. They can be found at 70 TTABVUE 10-53. Rather than setting them forth in this opinion (doing so occupied 2½ pages of Opposer's brief), we highlight the following two:

Registration No. 2736421 for POST-IT, issued July 15, 2003, for "stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards" (Section 8 & 15 affidavits

² Applicant's description of the evidence it submitted does not include the discovery deposition of David Ormson, one of Opposer's paralegals. Nevertheless, this deposition, or more accurately, portions of it, were properly submitted by Applicant under a notice of reliance, Exhibit 25, 72 TTABVUE 16-150, and it is of record.

accepted and acknowledged, respectively; renewed).³

Registration No. 3168105 for POST-IT, issued November 7, 2006, for "stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper. (Section 8 & 15 affidavits accepted and acknowledged, respectively).⁴

Standing

Opposer's registrations for its various POST-IT marks show that it has a direct commercial interest in this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943,

³ At the time the registration was made of record the renewal application had not yet been granted. In accordance with Board policy, we have ascertained that the registration has been renewed. The items "glue sticks for stationery or office use" and "paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place" have been deleted.

⁴ The Section 8 and 15 affidavits were considered by the Office after the registration was made of record. In accordance with Board policy, we have ascertained that the affidavits were accepted and acknowledged. We also note that "index cards" were deleted from the registration.

55 USPQ2d 1842 (Fed. Cir. 2000). Therefore, Opposer has established its standing.

Likelihood of Confusion

There are two elements to the ground of likelihood of confusion: priority and likelihood of confusion.

Priority

In view of Opposer's registrations, which are of record, priority is not in issue as to Opposer's marks and goods as identified in the registrations. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, Opposer has submitted testimony as to its use of the POST-IT mark continuously since 1980 for sticky notes, and for adhesive flags since 1987-88. Peichel p. 5, 8, 75 TTABVUE 8, 11. Applicant's mark was filed on the basis of intent-to-use, and Applicant has not submitted any evidence of use. In fact, Applicant stated, in its responses to Interrogatory Nos. 4, 8 and 10, (Exhibit 166, 70 TTABVUE 76-78) that Applicant had not commenced use of its mark in commerce. Thus, the earliest date on which Applicant may rely is the June 2, 2005 filing date of its application. Opposer has established its priority.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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).

Opposer has asserted that its POST-IT mark is famous. Because fame plays a dominant role in cases featuring a famous or strong mark, we turn first to the *du Pont* factor of the fame of the prior mark. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Opposer has submitted substantial evidence to show the fame of its POST-IT mark. It began using the mark for 3" x 3" sticky note pads in 1980, and since then has expanded its use to adhesive flags, flag highlighters and flag pens, binder tabs, easel pads, and so on, Hillins p. 21, 78 TTABVUE 24, with POST-IT flags having been introduced around 1987-88. Peichel p. 8, 75 TTABVUE 11. The POST-IT products are sold in office super stores such as Staples and Office Depot and mass retailers such as Walmart, Target and K-Mart, club stores such as Sam's and Costco, "the Dollar channel," grocery stores and

drugstores, and online through some of these same retailers and also e-tailers such as Amazon. Hillins p. 38-40, 78 TTABVUE 41-43. Opposer also custom prints POST-IT products for companies to use for their own promotional activities. Id. p. 39, 78 TTABVUE 42.

Opposer's sales figures for its POST-IT products were submitted under seal, so we can say only that they are substantial; for the period 2003 through 2012 annual sales were in the multi-millions of dollars, including millions of dollars each year for the POST-IT flag products. Exhibit 24, 80 TTABVUE 195-96. It is the market leader in the category for sticky notes. Hillins p. 24, 78 TTABVUE 27. Brand research studies Opposer conducted between 2005 and 2011 show that the POST-IT brand has very significant recognition; it is number one in both unaided and total awareness, and far ahead of other brands. Exhibits 25 through 31, 82 TTABVUE 132-524, 83 TTABVUE 3-348, 84 TTABVUE 3-218, 80 TTABVUE 197-412.⁵ A more specific study done for 2012 shows that the recognition for POST-IT brand for flags in the office/school supply category, although lower than for the POST-IT brand in general, is still

⁵ These exhibits were submitted as confidential, so we will not report the actual numbers.

significantly higher than competing brands. Exhibit 32, 80 TTABVUE 413.

Opposer promotes its POST-IT brand through TV commercials and media spots, office supply catalogs, freestanding inserts in magazines and newspapers, merchandising and promotional displays, direct mail and trade shows; and online through Opposer's Post-it.com website, through banner ads, retailers' websites, and social media such as Facebook. Hillins p. 59-61, 73, 74, 78 TTABVUE 62-64, 76, 80. Again, Opposer's advertising and promotional figures were submitted under seal, but the amounts spent in the period 2003-2012 on POST-IT products in general, and on POST-IT flag products in particular, are millions of dollars each year. Since 2005 Opposer has sponsored a NASCAR car, and the POST-IT trademark is displayed across the hood of the car. Hillins p. 85-86, 78 TTABVUE 87-88, Exhibit 36, 78 TTABVUE 347. Opposer also sponsors the 3M Championship, a Senior PGA golf event, at which there is the Post-It Greats of Golf Championship, a tournament for the great golfers of yesteryear. Hillins p. 87, 78 TTABVUE 89.

The POST-IT brand has also received many mentions in print, television and film. Examples of print references include the following:

The *Milwaukee Journal Sentinel* dated December 21, 2005 has an article entitled, "25th anniversary a reminder of Post-it notes' influence" (Exhibit 44, 78 TTABVUE 355);

The February 24, 2006 issue of *Life* magazine suggests a "Post-it party" to use the sticky notes to color a wall (Exhibit 46, 78 TTABVUE 357);

The September 2006 issue of *Men's Health* magazine features the "3M POST-IT SUPER STICKY NOTES" (Exhibit 49, 78 TTABVUE 364);

The June 28, 2007 issue of *The New York Times* has an article in its House&Home section about the "Post-it," and how the self-stick note keeps households running (Exhibit 54, 78 TTABVUE 369); and

The Sacramento Bee of June 28, 2010 has an article called "Stuck on Post-its" about the 30th birthday of the sticky notes (Exhibit 79, 78 TTABVUE 409).

The record shows that there have been several print articles, some with photographs, as well as television coverage, about a billboard made of POST-IT papers on a wall in Grand Central Terminal, including articles in the July 20, 2010 *New York Times* (Exhibit 81, 78 TTABVUE 412), the August 4, 2010 *Wall Street Journal* (Exhibit 82, 78 TTABVUE 413), and the November 17, 2010 issue of *Newsweek* (Exhibit 86, 78 TTABVUE 422).

Numerous television shows and movies make unsolicited mentions of POST-IT notes. For example, in a 2003 episode of *Sex and the City*, "one of the stars of the show actually

gets broken up [with] by her boyfriend using a POST-IT note." Hillins p. 95, 78 TTABVUE 98, (Exhibit 102, 78 TTABVUE 457). In a 2005 episode of *The Office*, as a gag the boss fires an employee for stealing POST-IT Notes. (Exhibit 103).⁶ POST-IT notes were the focal point of a scene in a *Gilmore Girls* episode. (Exhibit 109). And in *Romy and Michelle's High School Reunion*, the main characters say they invented POST-IT notes. (Exhibit 154, 78 TTABVUE 473). POST-IT notes were the subject of jokes in the monologues of Jay Leno and Jimmy Kimmel on their 2010 late night shows, while on the March 20, 2006 David Letterman show there were repeated mentions of POST-IT notes as two men created a portrait out of POST-IT notes during the course of the program. (Exhibits 119, 120, 108). An anchor on CNN, in reporting in 2005 on the 25th anniversary of POST-IT notes, said that with its introduction "life has never been the same," and "they have so many good uses." (Exhibit 104). The product was also the subject of a segment of the CBS News *Sunday Morning* show in 2007. (Exhibit 112). Opposer's highlighter pen with flags was featured on the Oprah Winfrey show in 2008,

⁶ This exhibit, as well as other video exhibits discussed herein, were identified during the testimony of Jeff Hillins (TTABVUE entry #78), and submitted on a separate CD-ROM.

in a segment in which Oprah interviewed the inventor.
(Exhibit 114).

Although the specific exhibits regarding impressions (an impression is one person viewing one advertisement or promotional piece) were marked confidential, annual impressions for the years 2004 through 2012 for the POST-IT mark and products number in the multi-millions and sometimes over a billion. Exhibit 165.

The above evidence leaves us in no doubt that POST-IT is a famous mark for sticky notes. The evidence, such as the sales figures, not only demonstrates the popularity of the actual product, but the volume and nature of publicity also highlights the fame of the POST-IT brand. In particular, the references in the television programs and the movie *Romy and Michelle's High School Reunion* reflect the writers' and producers' views that the POST-IT mark is so well known that viewers will immediately understand the reference. Although we acknowledge that POST-IT is primarily famous for sticky notes, the sales and advertising figures for POST-IT flags is substantial, and promotional activities such as the segment on *Oprah* add to the public recognition of the mark for these goods. In any event, sticky flags are so similar to sticky notes that the

fame pertaining to the mark for sticky notes spills over onto POST-IT for flags.

Applicant makes the argument that "even if found famous the POST-IT mark is weak and undeserving of wide latitude in protection." Brief, p. 41, 92 TTABVue 42. Applicant cites no support for this position, and we are not persuaded by it. Whether or not a mark is initially suggestive, and therefore would have less distinctiveness than an arbitrary or coined mark, once the mark is found to be famous, that means it is a strong mark and is entitled to a broad scope of protection. The cases standing for this principle are legion. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("[the marks ACOUSTIC WAVE and WAVE] are famous and thus entitled to broad protection"); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) ("Famous marks thus enjoy a wide latitude of legal protection").

Because we have found POST-IT to be a famous mark, this weighs very heavily in Opposer's favor in the likelihood of confusion analysis.

In terms of the *du Pont* factor of the similarity or dissimilarity of the goods, Applicant has admitted that its goods, identified as "adhesive-backed labels; adhesive-

backed plastic film designating signatory action," are in fact flags. Mr. Goldrick, Applicant's Vice President of Operations, testified:

Q: So, by the term "adhesive backed labels," you intended that to mean adhesive flags; is that correct?

A: Correct.

Q: And by the term "adhesive backed film designating signatory action," you intended that to mean adhesive flags that have a preprinted message that says "Sign Here" or something like that, correct?

A: Correct.

Goldrick p. 65, 87 TTABVUE 68. Applicant's president, Matthew Bertram, also testified at his discovery deposition that "flags" would fall within a "re-positionable adhesive-back label." Bertram p. 20, 70 TTABVUE 91. Opposer's registrations include "tape flags," and therefore the goods must be deemed legally identical. Even if we were to view the identification of "adhesive-backed labels" as referencing a product different from flags, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). We also point out that Applicant's identified "adhesive-backed labels" would be

legally identical to the "labeling tape" in Opposer's Registration No. 3168105. Further, the goods identified in Applicant's identification are encompassed within the "stationery notes containing adhesive on one side for attachment to surfaces" identified in that registration, and the "stationery notes containing adhesive on one side of the sheets for attachment to surfaces" in Opposer's Registration No. 2736421.

Because the goods are legally identical, they are presumed to travel in the same channels of trade and be sold to the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). This would include general department stores. Bertram p. 55, 70 TTABVUE 99.⁷

⁷ Applicant does not discuss the goods or channels of trade factors at all, identifying in the Table of Contents of its brief only the *du Pont* factors of the similarity of the marks, number and nature of similar marks in use on similar goods, fame, and no bad faith intent (the 13th factor). However, at pages 28-29, 92 TTABVUE 29-30, Applicant argues that the dissimilarity of the marks is the *du Pont* factor that should weigh most heavily, "especially with respect to the channels of trade through which both the Opposer's and [Applicant's] goods travel through." It is not clear what Applicant means, although we note that in general Applicant sells promotional goods, and therefore may be referring to the channels of trade for such goods. In any case, we point out that the channels of trade in both Opposer's and Applicant's identifications of goods are unrestricted, and therefore the goods must be presumed to travel in all channels of trade that are appropriate for such goods. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

With respect to the conditions of purchase factor, the consumers of POST-IT products are the public at large, including teachers, mothers, white collar workers and creative professionals. Hillins p. 40, 70 TTABVUE 43. Applicant's president, Matthew Bertram, testified that "anybody" could use Applicant's FLAG-IT! product, that "any regular person could be an end user of our flag product." Bertram p. 62-63, 70 TTAB 103-04. The flag packs are inexpensive, with the typical price ranging from a dollar up to \$10 or \$15. Hillins, p. 43, 78 TTABVUE 46. Opposer's witness Jeff Hillins testified that they are the subject of impulse purchases; "a lot of times POST-IT products aren't always a destination category where someone will actually go to a store specifically just for a POST-IT product. ... over the years [we] have developed a line of impulse products that would capture the eye of a consumer and they would feel [it] necessary to just buy it even though they may not need it." Hillins p. 41, 78 TTABVUE 44. With respect to flags specifically, Mr. Hillins testified that POST-IT flags are the subject of impulse purchase, stating that if the flags are displayed with products that are on a school list during the back-to-school shopping time frame, students, teachers or parents will buy them. Hillins p. 42, 78 TTABVUE 45.

Although the foregoing factors of fame, goods, channels of trade and conditions of purchase favor Opposer, Applicant relies primarily on what it asserts are differences in the marks to show that confusion is not likely. Essentially, Applicant contends that the only similarity between the marks is the element IT, an element that Applicant claims is so commonly used that it is not a sufficient basis on which to find the marks are similar. In support of this position, Applicant has made of record over 100 third-party applications and over 1200 third-party registrations for marks containing the element "IT."

Most of this evidence is not particularly probative. First, we note that third-party applications are evidence only of the fact that the applications have been filed, and therefore have no probative value to show that the element IT is commonly used in trademarks. *Weider Publ's, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014). As for the third-party registrations, they are not evidence that the marks are in use, or that the public is familiar with them. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). They can, however, be used in the manner of a dictionary, to show that a term has a significance in a particular industry. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)

(third-party registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used"); *In re Sela Prods., LLC*, 107 USPQ2d 1580, 1588 (TTAB 2013). In this case, Applicant has submitted third-party registrations for all sorts of goods and services, not merely those in the stationery field. See, for example, WEDGE-IT for frame height gauge for race cars (Reg. 2710056, 72 TTABVUE 725); GLOVE IT and heart design for golf gloves (Reg. No. 2793876, 72 TTABVUE 735); MOVE IT for providing real estate listings and real estate information via the Internet (Reg. No. 3567581, 72 TTABVUE 1003); and CLIP-IT for non-metal cable clips, non-metal pipe and cable clips (Reg. No. 3860374, 73 TTABVUE 92). Even for those third-party registrations for arguably similar goods, we are unable to conclude that "it" has any significance with respect to Opposer's and Applicant's products other than as an indefinite pronoun that, when combined with a verb, indicates that "it" is the recipient of the action.

Applicant has also submitted pages from various Internet-retailer sites, including Office Depot, Office Max, Target, Walmart and Staples, that list products identified by marks having the element "IT." For example, Exhibit 33 to Applicant's notice of reliance (73 TTABVUE

653-805) shows the results of a search of the Office Depot website for "it," as well as pages for some of the specific items shown in the search results. Most of the pages feature Opposer's POST-IT products, such as sticky removable file folder labels, sticky removable multi-use labels, sticky removable color-coding labels, flags and printed flags. Some pages also show other marks having the element IT, including CHEEZ-IT for snack crackers (73 TTABVUE 669), FIND IT for file folders, a CD/DVD binder, a supply caddy, a stackable storage bin and a 3-ring binder (73 TTABVUE 687, 688, 698, 701, 703), FIX-IT UTILITIES for repair software (73 TTABVUE 689), DIP-IT for coffeemaker cleaner (73 TTABVUE 690), MASTER CASTER ReStor-IT for a leather/vinyl repair kit (73 TTABVUE 700) and ReStor-It for a furniture touch-up kit (73 TTABVUE 791); Snap-It for an eyeglass repair kit (73 TTABVUE 794); Triplett Sniff-It 2 for an energy tester (73 TTABVUE 796); Tripp Lite Protect It! SWIVERL6 for a surge suppressor (73 TTABVUE 798); Clip-it for a flash drive (73 TTABVUE 804); Ativa Mobil-IT for various products, including computer accessory products such as a home/auto charging kit for use with iPod and other devices (73 TTABVUE 671), a netbook caddy (73 TTABVUE 687) a tech case (73 TTABVUE 688), a Bluetooth speaker (73 TTABVUE 692) and a privacy filter (73 TTABVUE 695), as well

as a business card wallet (73 TTABVUE 698) and a briefcase (73 TTABVUE 707); BATTLE CREEK Equipment Ice It! ColdCOMFORT for a therapy system (73 TTABVUE 740); BIC Mark-It Permanent Fashion Markers for markers (73 TTABVUE 742); BIC Wite-Out Cover-It for correction fluid (73 TTABVUE 744); Bracketron Universal GPS Grip-iT Mount for a device to hold a GPS (73 TTABVUE 746); Cocoon GRID-IT! for a tool organizer (73 TTABVUE 748) and a sun visor organizer (73 TTABVUE 750); LIKE-IT for an office organizer (73 TTABVUE 711) and stackable desk organizer (73 TTABVUE 715); Corel Create it! for a photo-editing disc (73 TTABVUE 752); Light It! for a sensor light (73 TTABVUE 780); Penatia Snip-it for ballpoint pen refills (73 TTABVUE 788); and IT-STAYS for adhesive (73 TTABVUE 709).

The sixth *du Pont* factor considers "the number and nature of similar marks in use on similar goods." The principle behind this factor is that if a certain term appears in many marks that are owned by separate entities and that are used for similar goods, consumers will look to other elements in the marks to distinguish them. The third-party uses that Applicant has made of record do not persuade us that consumers will distinguish Applicant's FLAG-IT mark from Opposer's POST-IT mark when these marks are used on identical adhesive flags. First, to be

probative, the marks must be used on "similar goods." Many of the goods shown on the websites do not, at least on this record, appear to be similar to the goods of Opposer and Applicant, e.g. snack crackers, furniture touch-up kits, eyeglass repair kits, energy testers, surge suppressors, flash drives, coffeemaker cleaners and cold therapy systems. The mere fact that they are sold on the same website does not per se make them similar. Further, some of the marks themselves are not similar to Opposer's and Applicant's marks. For example, in the Ativa Mobil-IT mark, IT is likely to be viewed as an abbreviation for "Information Technology," rather than the indefinite pronoun, while IT STAYS and LIKE-IT have a different look and/or syntax from the parties' marks.⁸ In addition, the grouping of the third-party uses as shown in the webpages submitted by Applicant does not reflect actual marketing conditions. It is unlikely that consumers of flags will search a retail website for all "IT" marks, as opposed to searching for the type of product they are interested in or searching for particular brand names. Thus, the fact that Applicant's search results show certain third-party marks on the same pages as Opposer's mark does not persuade us

⁸ There are also listings for marks that do not appear to have the element IT in them at all, e.g., MASTERVISION EARTH SILVER EASY-CLEAN, and others in which the letters I-T are merely part of another word, e.g., UNITED STATES POSTAL SERVICE HANDY BANDIT.

that consumers would be exposed to the various marks in this manner. Although a page of an actual office supply catalog that showed, in close proximity, goods bearing Opposer's mark as well as many third-party marks having the same look as Opposer's mark might be probative evidence on the sixth *du Pont* factor, the same cannot be said for computer search results of a website, since such results are determined by both the search strategy used and the logarithm by which the results are depicted.

We have gone into great detail with this exhibit of the Office Depot webpages because it puts into some perspective the listing of third-party marks that Applicant has highlighted at pages 21-23 of its brief (92 TTABVUE 22-24). We note, for example, that many of the third-party marks shown in the listing indicate only the mark and registration number, without any evidence of use of the mark. Of the 25 marks for which Applicant does provide a location in the record of the evidence showing use of the mark, many of the marks are for goods that are not particularly similar to the goods for which Applicant is attempting to register its mark. See, e.g., VELV-ITS! for what appears to be a children's activity set to make and decorate posters, frames and stickers (Exhibit 14, 87 TTABVUE 178-183); SKETCH IT for what appears to be a

child's game by which drawing fast brings the player tokens (Exhibit 5, 87 TTABVUE 127-132); SNIP IT for a children's activity kit for snipping and cutting activities (Exhibit 18, 87 TTABVUE 202-209); TagIt! for gift tags for wine bottles (Exhibit 17, 87 TTABVUE 198-201); MASK-IT for "all-in-one masking tape and drop cloth," Exhibit 6, 87 TTABVUE 133-141); TACK-IT for a temporary hold adhesive used to affix "appliques, trims, ribbon and more" (Exhibit 12, 87 TTABVUE 169-173); and STICK IT tape for hair attachments (Exhibit 13, 87 TTABVUE 174-177).⁹

There are some third-party marks for goods that are more similar to Opposer's and Applicant's goods. Of the marks listed above from the Office Depot website, there are some for office supplies/desk accessories such as FIND IT for file folders, BIC Mark-It Permanent Fashion Markers, BIC Wite-Out Cover-It correction fluid, and Penatia Snip-it for ballpoint pen refills. With Mr. Goldrick's testimony, Applicant made of record several other desk items with IT-suffix marks, specifically, the mark DOCIT (giving the

⁹ The exhibits in TTABVUE # 87 were submitted as exhibits to the testimony of Kevin Goldrick, as opposed to the marks and goods shown in the webpages submitted under notice of reliance. The exhibits relating to third-party use identified by Mr. Goldrick reflect items that he had purchased, with the exception of Exhibit 23, which is a printout of webpages he retrieved through "either Google search or Amazon.com" as a result of a search for "products with a logo using dash I-T." Goldrick, p. 51-52, 87 TTABVUE 54-55.

impression of DOC IT) used for, inter alia, a 3x5 card case with dividers, a set of tab dividers, expanding files with pockets, and a pencil case (Exhibit 21, 87 TTABVUE 228-268); CASE-IT for a 3-ring zipper binder (Exhibit 16, 87 TTABVUE 191-197); MEAD PRESS-IT SEAL-IT for envelopes (Exhibit 7, 87 TTABVUE 142-54); TAPE IT for label tape and stationery tape (Exhibit 23, 87 TTABVUE at 312-315); LABEL IT! for label printers (Exhibit 23, 87 TTABVUE at 322-325); and FLIP IT for a device with plastic cards with information such as "Vacation" to notify co-workers of an employee's whereabouts when not at his/her desk (Exhibit 10, 87 TTABVUE 163-165).

Although Applicant has submitted hundreds of webpages from various websites, in point of fact there are only a very few webpages that can be regarded as showing the use of similar marks on even arguably similar goods. Further, there is no evidence of third-party marks ending in IT for sticky notes or flags. In fact, Applicant's Vice President of Operations, Kevin Goldrick, and its Vice President for Sales and Marketing, Joseph Durand, both testified that they were not aware of any other trademarks for adhesive flags that end in hyphen I-T other than POST-IT and FLAG-IT! Goldrick p. 78, 87 TTABVUE 81, Durand p. 45, 70 TTABVUE 135. As for the products bearing IT-suffix marks

that Mr. Goldrick purchased, and which are shown in Applicant's trial exhibits 5 through 22, many of which are discussed above, Mr. Goldrick testified that he was unaware when the products were introduced into the market, or whether they were still being sold at the time of his testimony (a year after he purchased the items), or what the level of sales or advertising is for the products. Goldrick p. 79, 87 TTABVUE 82. Similarly, with respect to the products shown in Exhibit 23, which is the search results of the Internet search Mr. Goldrick conducted, Mr. Goldrick did not know when the products were introduced, or whether they are currently for sale, or the level of sales or advertising for these products. Goldrick p. 81, 87 TTABVUE 84. Thus, the evidence falls short in showing that consumers are so familiar with third-party IT-suffix marks for sticky notes and flags, or even for similar stationery items, that they would look to other elements to distinguish the various marks.

We also note that Opposer has had success in having third parties cease or modify their use of and/or abandon their applications for various IT-suffix marks, including some of the third-party marks noted by Applicant, e.g., FIND IT (Response to Requests for Admission Nos. 14, 15, 78 and 79); HOLD IT (Response to Requests No. 25 and 89);

LABEL IT! (Response to Requests Nos. 27, 28, 91 and 92);
LIKE-IT (Response to Requests No. 29 and 93); SECURE-IT
TAPE (Response to Requests No. 46 and 110); TAPE IT
(Response to Requests No. 58, 122 and 123); CLIP-IT
(Response to Request No. 73); COVER IT (Response to Request
74); and DOT-IT (Response to Request No. 77).¹⁰ Opposer
also submitted testimony and exhibits regarding other
third-party marks against which it successfully took
action, including CARD-IT (Exhibit 172 89 TTABVUE 141-
145); NOTE IT (Exhibit 173, 89 TTABVUE 146); ADHERE IT
(Exhibit 176, 89 TTABVUE 163); MARK-IT (Exhibit 179, 89
TTABVUE 189); EDIT-IT (Exhibit 182, 89 TTABVUE 199); FILM
IT (Exhibit 183, 89 TTABVUE 302); ROLLIT (Exhibit 187, 89
TTABVUE 392); SITE-IT (Exhibit 191, 89 TTABVUE 447) and
TAC-IT (Exhibit 195, 89 TTABVUE 487-498).

In view of the foregoing, we find that Applicant has
not demonstrated that the 6th *du Pont* factor should weigh
in its favor.

Therefore, when we consider the similarity of
Opposer's mark POST-IT and Applicant's mark FLAG-IT!, we do
not discount the similarity of the "-IT" ending, or
concentrate only on the first syllables. On the contrary,

¹⁰ Opposer's responses to Applicant's requests for admission were
filed by Applicant as Exhibit 29 to its notice of reliance, 72
TTABVUE 226-268.

we think consumers will view the marks POST-IT and FLAG-IT! as unitary marks, and will view them as being similar in appearance and pronunciation in that they are both constructed in the same manner, with a four-letter one-syllable verb identifying an action to be taken with respect to "IT." The beginning elements, POST and FLAG, rather than being seen as identifying separate sources for the goods, will be understood as merely identifying different activities that can be done with the goods. These words also have some similarity in meaning, in that POST refers to announcing something in written form ("to publish, announce, or advertise by or as if by use of a placard") while FLAG means to identify something ("to mark or identify with or as if with a flag") such that, the marks POST-IT and FLAG-IT! for adhesive flags both convey the connotation of noting information; POST-IT flags would mean flags that can be posted (placed) to identify specific information or a specific page, while FLAG-IT! flags would also indicate that the flags can be used to identify specific information or a specific page.¹¹ It must be

¹¹ Definitions from *Merriam-Webster Online*, <http://www.merriam-webster.com>, Exhibit 157, 70 TTABVue 67. We are not persuaded by Applicant's argument that the noun definition for "flag" would apply here, rather than the verb; because of the manner in which "flag" appears in the mark, FLAG-IT!, the word will be understood to be the verb form. Further, Applicant's president testified at his discovery deposition that Applicant came up with its FLAG-IT!

remembered that, when marks would appear on virtually identical goods or services, as is the case here, 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). The fact that Opposer uses the word "flag" immediately next to its mark POST-IT, and has done so since the product was introduced in 1987-88, reinforces the connection of its mark with FLAG. See examples of Opposer's goods and packaging at Exhibit 18, 78 TTABVUE 296-340. In addition, Opposer has advertised its flags with "flag" slogans such as "Flag it. Find it. Fast." (Exhibit 14, 79 TTABVUE at 87, 89, 97); "Find it. Flag it. Find it again." (Exhibit 14, 79 TTABVUE at 91, 93); "If it's worth finding, it's worth flagging" (Exhibit 14, 79 TTABVUE at 84); and "Find it and Flag it!" (Exhibit 14, 79 TTABVUE at 99, 102); "Write. Flag. Find it!" (Exhibit 20, 77 TTABVUE at 48-49, 52-54).¹²

mark because "we were looking for some sort of action word for the flags." Bertram p. 78, 70 TTABVUE 108.

¹² Applicant asserts that "this promotional campaign was subsequently discontinued shortly after discovery of [Applicant's] FLAG-IT! application," brief, p. 18, 92 TTABVUE 19, referring to the slogans containing the phrase FLAG IT. However, we note that one of the catalogs made of record by Opposer, showing the slogan "Flag it. Find it. Fast!" bears a copyright date of 2008. Exhibit 14, 79 TTABVUE 97. Inserts prepared for 2010 catalogs for several third parties, shown in confidential Exhibit 20, use the slogans "Write. Flag. Find It!", 77 TTABVUE

Accordingly, although there are differences in the marks due to the differences in the words POST and FLAG, overall the marks convey a similar commercial impression and the similarities in appearance, pronunciation and connotation outweigh the differences. See *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, *supra*, in which likelihood of confusion was found between PLAY-DOH and FUN DOUGH, both for modeling compound. As a result, consumers who are familiar with POST-IT for sticky notes, adhesive labels, or flags are likely to assume, when viewing FLAG-IT! used for flags, that these goods emanate from the same source as the POST-IT products and that this source has adopted a variation of its POST-IT mark specifically for its flags.

In saying this, we are aware that Applicant's mark includes an exclamation point, and Opposer's mark does not, but we do not consider the exclamation point to distinguish the marks. Consumers are not likely to remember the presence or absence of the punctuation mark. See *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980) (under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side

49, 51-54, and "Flag Your Catalog Favorites with These", 77 TTABVUE 47, while inserts for a 2012 catalog use the slogan "Flag 'Em Down!" 77 TTABVUE 64.

comparisons between marks, and must rely upon their imperfect recollections). When the similarities of the marks are considered in light of the facts that Opposer's POST-IT mark is famous, that the goods are identical and must be deemed to be sold in the same channels of trade, and that the goods are inexpensive items subject to impulse purchase, consumers are far more likely to recognize the overall similarity between the marks rather than distinguish them based on their differences.

Opposer has also asserted that Applicant adopted its mark with the intention of creating an association with Opposer's POST-IT mark. Opposer bases this assertion on the fact that Applicant is located approximately 40 miles away from Opposer; that Applicant's testimony and discovery witnesses were aware of POST-IT notes prior to the time Applicant filed its application, and Applicant was aware that Opposer used the POST-IT marks in connection with tape flags prior to filing its application (response to Interrogatory No. 15); and that Opposer and Applicant are direct competitors in the promotional products industry. Opposer also points out that Applicant did not call as a trial witness its president, who selected the mark FLAG-IT!, and that "[t]his lack of explanation from the person responsible for selecting Applicant's mark undercuts the

credibility of any assertion that Applicant did not intend to create an association with the famous POST-IT mark."

Brief, p. 41, 90 TTABVue 43.

We will not infer a bad intent from the fact that Applicant was aware of Opposer's POST-IT mark at the time it filed its application and for many years prior to that, and that Applicant did not provide the testimony of the person who selected its mark. As Applicant has shown, there are third-party IT-suffix marks, and the initial words in the marks, POST and FLAG, have totally different letters, and therefore Applicant may have thought that its mark was sufficiently different from Opposer's POST-IT mark. However, the fact that we have found no bad intent on Applicant's mark cannot justify its registration. As the Court has said, there is "no excuse for even approaching the well-known trademark of a competitor." *Recot Inc. v. M.C. Becton*, *supra* at 54 USPQ2d 1898, quoting *Nina Ricci S.A.R.L v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989). When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a "long shadow which competitors must avoid." *Id.* at 1897, quoting *Kenner Parker*, *supra* at 22 USPQ2d

1456. Given the universe of available marks, Applicant's FLAG-IT! mark comes too close to Opposer's POST-IT mark.

In view of the fame of Opposer's mark, which entitles it to a broad scope of protection, the identity of the goods and channels of trade, and the conditions of purchase, namely that the flags are purchased by the public at large without particular care and frequently on impulse, and the overall similarity of the marks, particularly in their commercial impression, we find that Applicant's mark FLAG-IT! for its identified goods is likely to cause confusion with Opposer's previously used mark POST-IT for flags and sticky notes.

Opposer has also submitted survey evidence in support of its claim of likelihood of confusion, evidence that Applicant has criticized at some length. Because we have found that, even without the survey, Opposer has proved likelihood of confusion, we need not rely on the survey to support our decision, and therefore there is no need for us to discuss the survey or the objections to it. No evidence or argument on any other *du Pont* factor has been submitted. To the extent that any is relevant, we treat it as neutral.

In view of our finding of likelihood of confusion, it is unnecessary for us to consider the ground of dilution, and we choose not to do so.¹³

Decision:

The opposition is sustained.

¹³ We note that Opposer has given this ground rather short shrift in its brief, devoting approximately 1½ pages to this ground, most of which merely lists the factors set forth in the Trademark Act, followed by single sentences essentially stating for each factor that Opposer has satisfied it. Brief, pp. 45-46.