Mailed: December 15, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Yvonne M. Conde and Oscar B. Pichardo
v.
Operation Pedro Pan Group, Inc.

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Opposition No. 91177853

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Abigail Rubinstein and Paul Fields, of Darby & Darby P.C. for Yvonne M. Conde and Oscar B. Pichardo.

Frank Herrera, of Rothstein Rosenfeldt & Adler for Operation Pedro Pan Group, Inc.

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Before Walters, Wellington, and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

The opposers in this case are individuals Yvonne M. Conde and Oscar B. Pichardo (Opposers)[1]. The applicant is Operation Pedro Pan Group, Inc. (Applicant). The mark at issue for opposition is PEDRO PAN for "Eleemosynary services

[1] Initially, the case was filed with a third individual opposer. However, the parties stipulated to his withdrawal as opposer during the course of the proceedings.

in the field of monetary donations,"[2] in International Class 36.

Opposers initiated the opposition on June 14, 2007, alleging that PEDRO PAN is "merely descriptive" of the service for which Applicant seeks registration. (Notice at Paras. 5, 15). The opposition notice goes on to allege that Applicant's PEDRO PAN mark "has not acquired distinctiveness or secondary meaning and therefore, is not entitled to registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f)." (Notice at Para. 16). The opposition alleges, "[i]n the alternative," that PEDRO PAN is "generic" for the service for which Applicant seeks registration, and is therefore "incapable of acting as an indicator of source and is not registrable."[3] (Notice at Para. 17). Finally, the opposition alleges that Applicant obtained the application by fraud. (Notice at Paras. 18-22). Specifically, Opposers allege "[u]pon information and belief" that Applicant "made false statements when it filed the Application and during the prosecution of the Application" regarding the date of first use of the mark as well as the correct translation of the mark. (*Id.*).

[2] Application No. 78802752, filed January 30, 2006, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use on December 26, 1960, and first use in commerce on June 1, 1991.

[3] Since Opposers did not present evidence at trial or argument in their brief on the issue of genericness, we consider this ground to have been waived and we have given it no consideration.

Applicant denied the salient allegations of the notice of opposition in its answer.[4] Opposers filed a brief. Applicant missed the date to file its trial brief, but sought leave to file a late brief, which leave was denied by the Board.[5] Accordingly, we have not considered Applicant's trial brief.

The Record and Evidentiary Issues

The record in this proceeding consists of the pleadings and the file of the PEDRO PAN application. 37 C.F.R. § 2.122(b). Opposers submitted news articles and other documents by notice of reliance. Additionally, both parties submitted testimony depositions of the two individual opposers, along with multiple exhibits, taken during their respective testimony periods. Opposers argue that the depositions from Applicant were untimely filed and should not be accepted. We note also that Applicant's counsel filed its depositions in the same submission as its excluded trial brief, buried within the 348 pages of that submission. Moreover, Applicant did not file the exhibits referenced in the depositions.

We find, however, there to be no showing that Applicant did not duly file its depositions or that Applicant withheld

[4] Applicant later sought, and was granted, leave to file an Amended Answer containing an additional (*Morehouse*) affirmative defense, which we discuss, *infra*.

[5] In an order dated September 3, 2009, the Board denied Applicant's motion for leave to file its brief late; and, in a Board order dated September 9, 2009, the Board denied Applicant's request for reconsideration. In the interim, Applicant filed a copy of its trial brief, which we have not considered.

the filing of its depositions. In fact, Applicant, having filed its depositions with its brief, even if the brief itself was late, filed them in a reasonable time after the date of the depositions. The facts here are analogous to those presented in the case of *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1393, note 6 (TTAB 1991). The Board there stated: "Although opposer claims that it has been prejudiced inasmuch as, prior to the filing and serving of its main brief, it had no knowledge that the entire trial deposition would become part of the record, the proper course would have been to assume that the deposition would be filed and would become part of the record since Trademark Rule 2.123(h) mandates that '[a]ll [trial] depositions which are taken must be duly filed in the Patent and Trademark Office.'" Accordingly, presented with analogous facts, and following the same reasoning, we reach the same conclusion. Thus, we have accepted and considered all of the depositions filed in this case. However, as stated above, Applicant did not submit the exhibits referenced in its depositions. So the exhibits have not been considered.

Opposers submitted a motion for the admission of the Internet evidence Opposers submitted during trial. The submission of the web pages was not objected to by Applicant, thus, we have considered this evidence for whatever limited probative value it may have. We hasten to

add that our decision herein would be the same regardless of whether or not we had considered this Internet evidence.

Standing

Generally, an opposer must only show a "personal interest in the outcome of the proceeding" as well as "a reasonable basis for belief of damage." *See Books on Tape Inc. v. The Booktape Corp.*, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (petitioner, as a competitor of respondent, "clearly has an interest in the outcome beyond that of the public in general and has standing.") It is not necessary that an opposer allege or establish its own prior rights in the marks at issue. *Id.* Opposers alleged the following in their Notice of Opposition:

1. "Each of the Opposers escaped Cuba and came to the United States with Operation Pedro Pan. Each Opposer is a Pedro Pan child." (Notice at Para. 6).
2. "Opposer Conde is the author of *Operation Pedro Pan: The Untold Exodus of 14,048 Cuban Children,* published by Routledge in 1999." Ms. Conde uses the email address PedroPanNY@aol.com to locate and correspond with other Pedro Pan children." (Notice at Para. 7).
3. "Opposer Pichardo used the email address PedroPanCA@aol.com to locate Pedro Pan children living in California and to organize social events

in California such as a reunion for Pedro Pan children." (Notice at Para. 8).

We find that Opposers have established their standing in this action.

***Morehouse* Defense**

First, we address an affirmative defense raised by Applicant. In its Amended Answer, Applicant seeks to rely on the *Morehouse* defense, based on the case *Morehouse Mfg Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Specifically, Applicant asserts that it owns a prior incontestable registration for a mark that incorporates the term PEDRO PAN for substantially the same services identified in the subject application. Applicant asserts that equity therefore estops Opposers from asserting that they will be damaged by Applicant's registration of the mark PEDRO PAN. (Amended Answer, Aff. Defense 17). However, as our precedent dictates, the *Morehouse* defense is an equitable defense which is not available to Applicant in response to a claim that its mark is "merely descriptive," as asserted by Opposers here. *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) ("It has been held that where a proceeding is based on descriptiveness or fraud, the equitable defenses of laches, acquiescence or estoppel are not applicable."); *Bausch & Lomb, Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1499 (TTAB 1986) ("The equitable defenses [including *Morehouse*] do not apply because it is in

the public interest to preclude registration of merely descriptive designations or registration procured by fraud"); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 573 (TTAB 1977) ("It is settled that the equitable defenses of laches and estoppel or acquiescence are not available in a proceeding of this character where the party in position of plaintiff is asserting in essence that the mark in question is devoid of the capacity to perform a trademark function."). Accordingly, we find that the *Morehouse* defense does not apply in this proceeding, and we have not considered Applicant's allegations in this regard.

Merely Descriptive

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have

other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

We consider a composite mark in its entirety. A composite of descriptive terms is registrable only if as a unitary mark it has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products). Accordingly, we look to the plain meaning of the words. The application contains the translation statement of PEDRO PAN as "Peter Bread." However, Opposers have submitted examples of several uses of "Pedro Pan" being translated as "Peter Pan."

In order for a mark to be characterized as "merely descriptive" under Section 2(e)(1), it is not necessary that the mark immediately convey an idea of each and every specific feature of the applicant's goods or services. It is sufficient that one significant attribute, function or

property be described. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

The testimonial depositions have established that both Opposers were born in Cuba. (Conde and Pichardo October 3, 2008 depos). Both arrived in the United States in the time period 1960 to 1962 along with approximately 14,000 other unaccompanied minor children from Cuba. *Id.* This effort, organized by the United States government, under the stewardship of Monsignor Bryan O. Walsh, was referred to as the "Unaccompanied Cuban Refugee Children's Program." (Pichardo March 9, 2009 depo. at 71). It was also dubbed "Operation Pedro Pan." (*Id.* at 23). As explained by Opposer Conde, "Pedro Pan is a spin on Peter Pan, the play by James Barrie and it's a twist using a Spanish name for the child who could fly and Never Neverland and who did not have parents so this was coined by the press in Miami." (Conde October 3, 2008 depo. at 20). Both Opposers refer to themselves and the other approximately 14,000 individuals who shared the same childhood immigration experience as Pedro Pan children. *Id.* ("Now when we see each other and we see another person more or less of our age, we look at each other and we say are you a Pedro Pan because that's the word that we used to identify ourselves.") Opposer Yvonne Conde is the author of a book entitled *Operation Pedro Pan, the Untold Exodus of 14,048 Cuban Children,* published by Routledge in 1999. *Id.* ("I would like to be able to have a website and give my book more publicity. And also in

conjunction with that I would like to as I have been doing find more Pedro Pan children.").

There are of record dozens of newspaper articles that use the term Pedro Pan to refer to the approximately 14,000 unaccompanied minors who arrived in the United States from Cuba in the time period 1960 to 1962 under the care of Monsignor Brian O. Walsh. Some excerpts follow. We note that some of these excerpts also use the term to describe or discuss related charity services, for which applicant specifically seeks registration:

"Former Pedro Pan foster children gather at fund-raiser in Coral Gables, Fla, and establish $5,000 scholarship program; Pedro Pan was formed in 1960s to help Cuban refugee children who arrived in US without parents." The Miami Herald December 13, 1991.

"[Monsignor] Walsh's care has been rewarded by former Pedro Pans who have named a number of their sons Bryan and by more than two dozen former charges who are priests. Many of the Pedro Pans rose to success in Miami and elsewhere.

Former Pedro Pans have been elected to city, county and state offices in Florida. One-time Pedro Pans include a federal judge in Philadelphia and several judges in California and Florida.

At a testimonial reception honoring Walsh in October, former Pedro Pans presented him with a check for $30,000, to help finance his dream of a permanent home for the next wave of children." The Miami Herald November 18, 1997.

"But the main thing expected to bring up to 15,000 people to the street is the free concert by salsa superstar Willy Chirino, a Pedro Pan kid himself who has a song and album named *Cuba Libre.*" The Miami Herald May 14, 2006.

"Codina, now one of Florida's most prominent real estate developers, was one of about 14,000 children – who have come to be called Pedro Pans – sent out of Cuba in 1961 and '62

by parents who feared that, if they stayed, they would have been subjected to communist indoctrination. . . . Though they represent less than 2 percent of Cuban refugees, Pedro Pans account for some of their biggest success stories." The Miami Herald Sept 22, 2003.

"In Miami's Little Havana neighborhood, the epicenter for Cuban exiles, Bikel spent hours with exiles in front of Elian's temporary home, and then left to spend time with some 'Pedro Panners.' These were some of the 14,000 Cuban children put on U.S.-bound planes in the early 1960s by parents who wanted them to escape the revolution. Operation Pedro Pan (Peter Pan) was run by Father Bryan Walsh, a local hero whom Bikel captures celebrating his 70th birthday with a group of middle-aged Pedro Panners. . . .

'All along I thought if walked down south of 8th Street and said that, I would have been lynched,' said Frank Avellant, a Pedro Pan child." Los Angeles Times February 5, 2001.

'"In recent years I went to a Pedro Pan reunion in Miami and met [Monsignor Bryan O. Walsh] and thanked him for giving me an opportunity to be a free man in America and we became close,' said [Mel] Martinez." The Miami Herald December 21, 2001.

"The roster of Pedro Pan children includes musicians, lawyers, doctors, university professors, journalists, real estate developers, artists . . . among them several well-known South Floridians." The Miami Herald June 14, 1999.

"The children became known as 'Los Ninos Pedro Pan,' or 'the Peter Pan Kids,' for their ability to fly away without adult accompaniment." Hartford Courant April 16, 2000.

"Between 1960 and 1964, 14,000 Cuban children were brought to Miami through a program dubbed Pedro Pan. [Monsignor] Walsh, then head of the Catholic Welfare Bureau, directed their exodus and cared for them here." The Associated Press December 27, 1981.

"Alex Vega, played by [Jimmy] Smits, is a Pedro Pan kid, one of 14,000 sent alone to the United States by parents who didn't want them raised in Fidel Castro's Cuba.

'Eventually we'd like Alex to go back to Cuba and see who he is,' Cidre says. 'That Pedro Pan thing has always stayed with me. I don't know why. My own parents balked about doing it with me. But every time I write about Cuba, I use

a Pedro Pan character." The Miami Herald September 30, 2007.

Additionally, we note that there are various instances in the record where Applicant itself has used the term PEDRO PAN descriptively to refer to the approximately 14,000 unaccompanied minors who arrived in the United States from Cuba during the time period 1960 to 1962 under the care of Monsignor Bryan O. Walsh. Some examples include the following:

In its Response to Office Action, dated 1/22/07, Applicant states: "Specifically, services associated with the Applicant's mark will be provided or offered to various members of the Pedro Pan community including various children's charities exclusive of hospitals." (Application file).

In a letter to Opposer Conde and others, dated February 1, 1991, from an officer for Applicant: "Dear Pedro Pans and Friends, . . . " (Conde October 3, 2008 depo. Ex. 3).

In a letter to Opposer Pichardo, dated May 5, 2005, from president of Applicant: "Dear Mr. Pichardo: We recently became aware as per enclosed material that you are trying to find other pedro pans [sic] in the area of Los Angeles which is a wonderful idea." (Pichardo October 3, 2008 depo. Ex. 14).

In a photo caption on Applicant's website: "Unaccompanied Cuban Minors 'Pedro Pans' arriving at Miami's Airport." (Conde October 3, 2008 depo. Ex. 12).

From Applicant's website: "All the unaccompanied Cuban minors who were part of the exodus now popularly known as Operation Pedro Pan, call ourselves Pedro Pans." (Conde October 3, 2008 depo. Ex. 11).

Applicant, in its answer contends that the third-party uses of the term, as well as their own uses, refer to Applicant's services. However, the record clearly

establishes that the term PEDRO PAN has been used by many third-parties generally as a moniker for this particular group of children who immigrated from Cuba in the early 1960's without their parents. The record also establishes that many charitable services have been rendered to, and fundraising has been done on behalf of, this group of "Pedro Pan" children, who are now adults; that the referenced charitable services do not refer only to those offered by Applicant; and that the relevant public, which logically includes both the Pedro Pan children (now adults) and the general public who is familiar with the historical event that brought these children to the United States, recognizes the term "Pedro Pan" as describing this group of children, even as they are now adults. The record also establishes that fundraising continues to be done on behalf of Cuban children who may immigrate to the U.S. in the future, and that the current adult Pedro Pan children are a large target group for this fundraising. Accordingly, we find Applicant's mark, PEDRO PAN, to be merely descriptive of the identified "Eleemosynary services in the field of monetary donations."

Acquired Distinctiveness

In its Amended Answer, Applicant denied the allegation that its mark had not acquired distinctiveness, and additionally asserted "acquired secondary meaning" as an affirmative defense." (Amended Answer Para. 16 and Aff. Defense 15). Since Opposers have shown PEDRO PAN to be

merely descriptive of Applicant's recited services, the burden now shifts to Applicant to show that the mark has acquired sufficient distinctiveness as to merit registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f); *Yamaha International v. Hoshino Gakki,* 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Although we have not considered Applicant's brief, we have considered the evidence in the record to determine whether PEDRO PAN has acquired distinctiveness as a mark for the identified services. In this regard, we note that Applicant originally submitted a claim of acquired distinctiveness in its application based on its ownership of Registration No. 2693435. This claim was subsequently deleted at the suggestion of the Trademark Examining Attorney.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Id.; Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983). It is sufficient that the relevant public associate the mark with a single, albeit anonymous, source. *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

The more descriptive the mark, the greater the burden on Applicant to prove its distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, *supra*, 6 USPQ2d at 1008. In order to prove Section 2(f) acquired distinctiveness, Applicant may rely on the evidence of record, including any evidence submitted during prosecution of its application. *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 92 USPQ2d 1626, 1629 ("The unambiguous language of 37 C.F.R. § 2.122(b) provides that the entire file of the registration at issue is automatically part of the record, without any action necessary by the parties. Therefore, the evidence of the mark's acquired distinctiveness submitted during prosecution was automatically part of the record before the Board").

While Applicant did not make its registration of record in this proceeding or during the prosecution of this application, we consider the registration to be of record because of the testimony of Opposers, essentially admitting Applicant's ownership and the current status of Registration No. 2693435, as noted below:

"Q: Mr. Pichardo, Are you aware that my client currently has a federal registration for Operation Pedro Pan Group, Inc. and Design?

A: Yes I am."

(Pichardo March 19, 2009 depo. at 10).

The issue is whether this prior registration is a registration on the Principal Register of the "same mark" such that it constitutes *prima facie* evidence of distinctiveness for purposes of Trademark Rule 2.41(b); 37 C.F.R. § 2.41(b). To rely on its prior registration to establish acquired distinctiveness, we must determine whether the marks and identified services are sufficiently similar that we can consider the acquired distinctiveness of the registered mark to extend to the mark and services in the application.

In order to be considered the "same mark" for purposes of establishing Section 2(f) acquired distinctiveness, the two marks at issue must be "legal equivalents" such that they "creat[e] the same, continuing commercial impression." *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)

The prior registration is OPERATION PEDRO PAN GROUP, INC., and design, as shown below for "Eleemosynary services in the field of monetary donations: namely sponsoring aiding promoting and assisting programs that benefit children in need," in International Class 36[6]:

[6] Registration No. 2693435, registered March 4, 2003, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use on December 26, 1960, and first use in commerce on June 1, 1991, disclaiming the exclusive right to use "OPERATION," "GROUP," and "INC." apart from the mark as shown; filed with a Section 2(f) claim of acquired distinctiveness. Sections 8 and 15 affidavits accepted and acknowledged.

The terms "OPERATION," "GROUP," and "INC." are disclaimed, and, thus, are admittedly merely descriptive. However, we find that although "PEDRO PAN" are the only words not disclaimed in the prior registration, they are not highlighted either. The word "OPERATION" is more outstanding, appearing at the top and in larger font. Furthermore, the design features of the mark figure prominently in the mark. Accordingly, we cannot say that, based solely on Applicant's prior registration, that the term "PEDRO PAN" alone has acquired distinctiveness for these services.

Furthermore, due to the prevalence of substantial third-party uses of PEDRO PAN in connection with these services and in reference to this specific group of children, we find the mark to be highly descriptive of the identified services. Accordingly, Applicant has a higher

burden to meet in showing it's applied-for mark has acquired distinctiveness.

In it's Amended Answer, Applicant states: "The fact that Applicant's current legal entity, namely, Operation Pedro Pan Group, Inc., was not formed until 1991 does not foreclose Applicant from enjoying trademark rights acquired by its predecessors in interest." (Amended Answer Para. 19). To the extent that Applicant may be alleging acquired distinctiveness based on use of the mark in connection with the identified services since the 1960's, the record does not establish that Applicant clearly is a successor in interest to Monsignor Walsh, nor that Monsignor Walsh was the owner of a mark PEDRO PAN for charitable services. While the record contains a copy of a letter from an earlier-existing organization, also using the term Pedro Pan in its name, also for charitable purposes, the body of the letter uses the term PEDRO PAN in a merely descriptive manner. Moreover, the group, Pedro Pan Foundation, sent a letter to Opposer Conde, among others, dated June 16, 1992, specifically denouncing any association with Applicant. (Conde October 3, 2008 depo. Ex. 7) ("There is absolutely no relationship between Pedro Pan Foundation and Operation Pedro Pan Inc. The latter was created by a group of individuals to establish their own agenda.")

More pertinently, Applicant's own statements against interest show the myriad uses by Applicant itself of the term PEDRO PAN to refer descriptively, rather than as a

mark, to the approximately 14,000 unaccompanied minors who arrived in the United States from Cuba during the time period 1960 to 1962 under the care of Monsignor Bryan O. Walsh. For example, in one letter from Applicant to Opposer Pichardo, Applicant used the term PEDRO PAN(S) to describe the aforementioned group of children and without initial capitalization. (Pichardo October 3, 2008 depo. Ex. 14). Applicant's own public website, as noted above, refers to the term PEDRO PAN(S) in a merely descriptive manner.

Accordingly, we find that Applicant has not met its burden of showing that PEDRO PAN has acquired distinctiveness for Applicant's identified "Eleemosynary services in the field of monetary donations."

Conclusion

Opposers' opposition to the registration of PEDRO PAN is sustained.[7]

DECISION: The opposition is sustained.

[7] Since we rule for Opposers on the ground that Applicant's mark is "merely descriptive" without 2(f) "acquired distinctiveness," we see no need to consider Opposer's fraud claim.