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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210514
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/576,906

Lucky Puppy Designs, Inc.	)	Opposition No. 91210514
	)	
Opposer,	)	
	)	
v.	)	
	)	
Rachael Elizabeth Kennedy,	)	
	)	
Applicant	)	

APPLICANT'S MAIN BRIEF

Applicant Rachael Elizabeth Kennedy ("Applicant") hereby files her main Brief, responding to Opposers Trial Brief and asserts that the opposition brought against registration of Applicant's LUCKY PUPPY trademark by Opposer Lucky Puppy Designs, Inc. ("Opposer") based on likelihood of confusion should be denied by the Trademark Trial and Appeal Board.

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Pursuant to 37 C.F.R. § 2.128 and TBMP Rule 801.02(b), Applicant Rachael Elizabeth Kennedy ("Applicant") respectfully submits this Final Brief.

DESCRIPTION OF THE RECORD

Applicant acknowledges Plaintiffs description of the evidentiary record.

STATEMENT OF THE ISSUES

Whether the Applicant's filed Mark, "Lucky Puppy," when used in connection with "retail store services featuring pet food and pet supplies, on-line retail store services featuring pet pet food and pet supplies" is likely to be confused with Opposer's unregistered mark "LUCKY PUP."

RECITATION OF THE FACTS

After conducting due diligence on the USPTO registry, Applicant filed for registration of its LUCKY PUPPY trademark on March 22, 2012 as a 1B application for "retail store services featuring pet food and pet supplies, on-line retail store services featuring pet food and pet supplies." Applicant received an office action based on two registrations (3952253 and 3803516) for LUCKY PUPPY, responded to this office action and, after careful consideration by the examining attorney, was published for opposition on February 13, 2013. Applicant started using this trademark for its pet rescue business on December 8, 2012 bearing the LUCKY PUPPY trademark on its retail and pet rescue store. On May 4, 2013 Opposer filed an opposition based on its unregistered trademark LUCKY PUP for various pet supplies including dog collars, leads and tags.

ARGUMENT

I. <u>STANDING</u>

Opposer failed to prove its allegations that it will be damaged by the registration of the Applicant's Trademark LUCKY PUPPY. Although Opposer alleges in the Notice of Opposition that it has used the alleged "LUCKY PUP" mark prior to the filing date of the

opposed application, and although Opposer alleges that the alleged "LUCKY PUP" mark so resembles the Applicant's LUCKY PUPPY to be likely, when used in connection with the services identified in the opposed application, to cause confusion, to cause mistake, and to deceive, Opposer failed to prove these allegations and, therefore, cannot show that it has standing. See Boswell v. Mavety Media Group Ltd., 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient but whether allegations have been proven). **Specifically, Opposer failed to prove that he used, prior to Applicant's first constructive use, a protectable mark that is confusingly similar to Applicant's marks as set forth in the opposed application**. In other words, Opposer failed to show that it used the "LUCKY PUP" mark in a protectable manner, prior to Applicant's filing of the opposed application for the LUCKY PUPPY trademark. In fact, the USPTO has not had a chance to determine if the trademark LUCKY PUP is protectable because it has not been filed for in the USPTO registry. Opposer has had ample opportunity to file for the LUCKY PUP trademark for their goods but has failed to do so. Perhaps this is a strategic move in light of other conflicting LUCKY PUPPY trademarks already existing on the USPTO registry for similar goods as sold by Opposer. Opposer cannot show that it had a protectable interest in the mark prior to Applicant's first constructive use date. As such, Opposer cannot show that it will be damaged by the registration of Applicant's LUCKY PUPPY mark and thus lacks standing.

II. PRIORITY AND LIKELIHOOD OF CONFUSION

To prevail in this opposition, Opposer must establish that it is the prior user of a distinctive mark and that contemporaneous use of the parties' respective marks on their Respective services would be likely to cause confusion, mistake or to deceive consumers. 15 U.S.C. § 1052(d).

A. Likelihood of Confusion

In determining whether a likelihood of confusion exists, the Board must analyze the well-recognized factors set forth in *In re E. I. du Pont de Nemours & Co.,* 177 USPQ 9 OF 18 563 (CCPA 1973) and *In re Majestic Distilling Co., Inc*., 65 USPQ2d 1201 (Fed. Cir. 2003). "In an opposition, the opposer bears the burden of proving by a preponderance of the evidence a substantive ground for refusal to register the subject trademark. In a likelihood of confusion case under Trademark Act § 2(d), this burden requires an opposer to prove that it has **some prior trademark right** and that applicant's mark is likely to cause confusion with that trademark*." Life Zone Inc. v. Middleman Group, Inc.,* 87 USPQ2d 1953, 1959 (TTAB 2008) (emphasis added); see *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd*., 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) ("It is beyond question that an opposer alleging likelihood of confusion under Section 2(d) has the burden of proof to establish that applicant does not have the right to

register its mark.") (internal punctuation eliminated). The focus of a likelihood of confusion analysis is not "the mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.,* 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) quoting from *Witco Chem. Co. v. Whitfield Chem. Co.,* 164 USPQ 43, 44-45 (CCPA 1969), aff'g, 153 USPQ 412 (TTAB 1967).

It is clear that, when the evidence of record is considered in light of the relevant du Pont factors, there is no likelihood of confusion. *See generally Application of E. I. Du Pont De Nemours & Co*., 177 USPQ 563, 567 (CCPA 1973). Specifically, Applicant's LUCKY PUPPY mark and Opposer's "LUCKY PUP" mark are sufficiently dissimilar that consumer confusion is unlikely.

1. Applicant's LUCKY PUPPY mark is not confusingly similar to Opposer's mark.

To determine whether the parties' marks are confusingly similar, the Board must consider whether the marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Opposer's rationale for its argument that the parties' marks are confusingly similar is that both marks contain the words "lucky" and "pup". (Opposer's Final Br. at 9). Opposer's analysis is, however, deficient. *See Freedom Savings & Loan Assn v. Way, 226 USPQ 123* (11th Cir. 1985)(use of identical, even dominant, words in common does not automatically mean that two marks are similar).

a. Visual Appearance and Sounds of the Mark

While the parties' marks are obviously visually similar to the extent that they both consist of or include the words "lucky" and "pup", the marks are just as obviously dissimilar to the extent that Applicant's mark, but not Opposer's mark, includes the full word PUPPY.

Opposer's argument is that Applicant's LUCKY PUPPY mark is confusingly similar visually to its alleged mark because the only difference is the end of the last word, "py" (Opposer's Final Br. at 9). While this is inarguably true, the parties' marks are not, when compared in their entireties, confusingly similar. While Opposer may wish to argue that the "pup" word is the dominant element of the parties' marks visually, it has failed to prove that consumers are most likely to remember this aspect of the parties'

marks. *See Hoover Co. v. Royal Appliance Mfg. Co.*, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) (burden of proof is on the opposer to prove which aspects of the marks consumers are most likely to remember) and cases cited therein. Given the absence of any evidence to the contrary, both parts of the parties' marks must be given equal weight when comparing the marks for confusing similarity. "When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared." *Opryland USA Inc. v. Great Am. Music Show Inc.,* 23 USPQ 1471, 1473 (Fed. Cir. 1992). "[E]ach case requires consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark." *Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.,* 152 USPQ 599, 602 (CCPA 1967) (emphasis in original).

b. Connotation and Commercial Impression of the Marks

Applicant avers that the term "LUCKY PUPPY" is suggestive of a retail store services featuring pet adoptions and pet supplies wherein the dogs are "lucky" to be adopted. Applicant also avers that Opposer's mark "Lucky Pup" is a weak mark in class 18 because variations are also used by third parties with live trademark registrations on the USPTO database. An example is found in the "LUCKY PUPPY" trademark registration number 3952253 in class 018 for "dog apparel." It is highly unlikely, if Opposer ever files for the LUCKY PUP trademark in class 018, they will receive a registration. For example, another applicant filed for LUCKY PUP serial number 76577795 for the goods of "pet accessories, namely-- grooming tools; feed supplements; grooming cleaners; pet whistles; collars, harnesses, leashes, and charms for attachment thereto; apparel; cushions; picture frames; feeding bowls; placemats for feeding bowls; brushes; cages; pet carriers; toys; pet treats; and gift sets which may include one or more items from the above list of accessories." Abandoned in 2004 because the applicant did not respond to an office action citing various other similar trademarks including:

- "LUCKY DOG" (U.S. Reg. No. 1283555) in typed letters for "pet food," with a disclaimer of "DOG";

- "LUCKY DOG" (U.S. Reg. No. 1389314) and design for "pet food," with a disclaimer of "DOG";

- "LUCKYPET" (U.S. Reg. No. 1976309) in typed letters for metal and plastic "pet identification tags";

- “LUCKYPET” (U.S. Reg. No. 1980760) and design for metal and plastic “pet identification tags”;

- LUCKY DOG” (U.S. Reg. No. 2040143) in typed letters for “electric hair trimmers for use in trimming pet hair”; and

- “YOUR LUCKY DOG” (U.S. Reg. No. 2609568) in typed letters for “dog collars.”

2. The goods identified in the Opposed Application are not closely related to Opposer's services and goods.

While Applicant concedes that the use of her mark and Opposer's use of its alleged mark are similar, the main thrust of Applicant's business is not the sale of those similar items.

Opposer has stated it designs, manufacturers, and sells the goods of designer dog collars, leads, tags and apparel (Opposer's Final Br. at 6) rather than any retail services

Applicant on the other hand is strictly in the business of retail adoption of dogs and retail sales of pet products made by others. More importantly, Applicant has no intention of expanding her business into the production and sale of branded dog collars, leads, tags and apparel similar to those offered by Opposer.

In sum, the parties’ different services and goods are not related.

III. **SETTLEMENT AND DISCOVERY**

The parties had discussed settlement ideas but the parties were unable to resolve the opposition. The Applicant was served discovery requests and did not timely respond to these discovery requests because the Applicant is a small non-profit, has limited resources and time due to the nature and current state of its business, and felt the requests unduly burdensome. Applicant asserts she made good faith efforts to settle the dispute and believes the Opposer to be unreasonable in light of their un-registered name.

SUMMARY

Opposer failed to establish that it used a distinctive and protectable mark prior to Applicant's constructive use date. Therefore, Opposer did not prove priority and, therefore, cannot prevail in this proceeding. Even assuming *arguendo* that enough evidence can be cobbled together to establish Opposer's priority of use, Opposer's never has proven its mark LUCKY PUP to be a protectable trademark by filing it with the US Patent and Trademark Office and is thus incredibly weak. In this light, the obvious dissimilarity of the parties' marks in their entireties outweighs any evidence as to the other du Pont factors and by itself makes it unlikely that confusion would result from the simultaneous use of the marks. *See, e.g., Kellogg Co. v. Pack-Em Enter. Inc.,* 14 USPQ2d 1545 (TTAB 1989), aff'd, 21 USPQ2d 1142 (Fed. Cir. 1991)(FROOTEE ICE not confusingly similar to FROOT). Therefore, Applicant requests that the instant opposition be DENIED and that the Application Ser. No. 85/576,906 be GRANTED and issued as a registration.

Respectfully submitted

G & A LEGAL

Dated: September 18, 2014

By: _____

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