

This Opinion is Not a
Precedent of the TTAB

Mailed: November 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Lucky Pup Designs, Inc.

v.

Rachel Elizabeth Kennedy
—

Opposition No. 91210514
against Serial No. 85576906
—

Joshua R. Furman of Joshua R. Furman Law Corp.,
for Lucky Pup Designs, Inc.

Pollie A. Gautsch of G&A Legal APC,
for Rachel Elizabeth Kennedy.

—
Before Bucher, Cataldo and Shaw,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Rachel Elizabeth Kennedy (hereinafter “Applicant”) seeks registration on the Principal Register of the mark **LUCKY PUPPY** (*in standard character format*) for services recited, as amended, as “retail store services featuring pet food and pet

supplies, on-line retail store services featuring pet *[sic]* pet food and pet supplies” in International Class 35.¹

Lucky Pup Designs, Inc. (hereinafter “Opposer”), alleges that Applicant’s mark so resembles Opposer’s previously used mark **LUCKY PUP** “in connection with goods and services including dog collars, collars for pets, leashes for animals, harnesses, pet clothing, pet tags specially adapted for attaching to pet leashes or collars” (Notice of Opposition ¶ 6), that when used in connection with Applicant’s recited services, it is likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Applicant, in her answer, denied the salient allegations of likelihood of confusion. The parties have briefed the issues involved in this proceeding.

I. The Record

The record includes the pleadings and the file of the opposed application. Trademark Rule 2.122(b). Pursuant to the written agreement of the parties, Opposer filed the Declaration of its President, Margaret Wynn, in lieu of testimony. In addition, Opposer proffered under notices of reliance timely filed during its testimony period copies of Applicant’s webpages, a Google search hit list, and screen prints of a published article from Examiner.com titled *Grand Opening Lucky Puppy Rescue and Retail Store in Los Angeles* bearing a dateline of November 14, 2012. Applicant entered no evidence into the record during her testimony period.

¹ Application Serial No. 85576906 was filed on March 22, 2012, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

II. The Parties

Opposer submitted the declaration of Margaret Wynn, Opposer's current President. In 2003, Ms. Wynn began doing business as Lucky Pup Designs. Her business consists of the manufacture of dog collars, leads, tags, and apparel, and their sale throughout much of the United States. Opposer was incorporated in 2005. Ms. Wynn declared that since 2003, all of Lucky Pup Designs' products have



consistently featured the Lucky Pup mark shown at left. An actual label affixed to a dog collar is shown at right.



Opposer's website has been operational since 2004.² Opposer distributes its products to retail locations in Arizona, California, Colorado, Florida, Georgia, Illinois, Maine, Massachusetts, Missouri, Nevada, New York, Ohio, Oregon, Rhode Island, Texas, Virginia, and Washington, as well as reaching customers all around the world through online sales.

Although the affected application was filed based upon allegations of an intent-to-use, and Applicant has submitted no evidence during this proceeding, Opposer has placed into the record a number of screen prints from the Internet. For example, the following is drawn from an article published in Examiner.com, bearing a dateline of November 14, 2012 (highlighting supplied):

² <http://luckypupdesigns.com/>.

Grand Opening Lucky Puppy Rescue and Retail store in Los Angeles

November 14, 2012

A Humane Pet Store dedicated to the shelter animals in Los Angeles is having its grand opening on Dec. 8th 2012.

Check out the info and be sure to go and show your pup-lovin support!

Lucky Puppy Rescue and Retail info:

- Mission

Our Mission is to open up a world where **retail and rescue can work hand and hand** and puppy mills and pet stores are banished.

- Company Overview

The Poopie Foundation is a 501(c)(3) ALL Breed Dog Rescue that was founded in 2009 by Melissa Bacelar and Jeff Spinner. In 2010, Rachel Kennedy joined the foundation and together they are opening Lucky Puppy! A retail store that is dedicated to the rescue, rehabilitation and adoption of dogs from the Kill Shelters in Los Angeles.

- Description

The Lucky Puppy Boutique will carry high end **treats, beds, food, and toys** that will make your puppies feel loved and spoiled. Lucky Puppy only carries the highest quality foods and products and all profits will go to The Poopie Foundation and the dogs they save.

- General Information

Adoptions will be held at the store daily. There will be a number of adoptable dogs at the store and potential adopters can visit and play with the dogs that they would like to adopt. There will still be applications and home checks required before any dog can be adopted.

ATTEND THE GRAND OPENING!

Join us for the grand opening of the Lucky Puppy Rescue and Retail, a high-end humane boutique in Studio City that has already rescued hundreds of puppies that would otherwise be killed off at shelters. The Lucky Puppy Rescue and Retail will serve as a non-profit dog shelter, adoption and education center, and **retail store for pet supplies** in which all profits are put directly back into the rescue and dog care process. The green carpet grand opening of this one of a kind retailer will benefit The Poopie Foundation, which aims to save the lives of animals while simultaneously creating a puppy sanctuary where dogs can receive proper care and find loving, permanent homes and where owners can be properly educated on pet care.

The grand opening will be a night of dog friendly fun, including a silent auction and opportunities for attendees to adopt their own furry friends.

Lucky Puppy invites all animal lovers and their four-legged friends to walk the green carpet and join us in benefiting the Poopie Foundation. The grand opening will feature celebrities who have supported or adopted new family members from the Poopie Foundation, including George Lopez, Hillary and Haylie Duff, Eugene Levy and Dan Levy. Help us celebrate and acknowledge the Poopie Foundation's efforts to find loving homes for our four-legged friends through rescue and education with the grand opening of the Lucky Puppy Rescue and Retail.

Saturday, December 8, 2012.

Media Check-In: 6:00PM

Green Carpet Arrivals: 6:30PM - 8:30PM

Lucky Puppy Rescue and Retail

12238 Ventura Blvd,

Studio City, California 91604 ³

Opposer included a copy of a hit list on the Google search engine for the term “lucky puppy,” most of which refer to Applicant’s organization (highlighted below):

³ <http://www.examiner.com/article/grand-opening-lucky-puppy-rescue-and-retail-store-los-angeles>, as accessed by Opposer on April 9, 2014; 9 TTABVue at 4-6 of 6.

Google lucky puppy

Web Shopping Images Videos Maps More Search tools

About 89,900,000 results (0.33 seconds)

Lucky Puppy | About Us - Los Angeles
lucky puppyrescueandretail.com/
 Lucky Puppy is the ONLY 100% Not for Profit retail store in Studio City. 100% of all proceeds from your purchases go to our rescue dogs. Lucky Puppy is the ...
 Google+ page · Be the first to review

12238 Ventura Blvd, Studio City, CA 91604
 (818) 370-5516

Lucky Puppy Rescue and Retail - Los Angeles - Facebook
<https://www.facebook.com/LuckyPuppyRescueAndRetail/>
 Lucky Puppy Rescue and Retail, Studio City, CA. 6022 likes · 968 talking about this · 466 were here. The Poopie Foundation is a 501c 3 ALL Breed Dog Rescue ...

Lucky Puppy Rescue and Retail - Los Angeles - Facebook
https://www.facebook.com/LuckyPuppyRescueAndRetail?hc_location...
 Lucky Puppy Rescue and Retail, Studio City, CA. 6022 likes · 792 talking about this · 465 were here. The Poopie Foundation is a 501c 3 ALL Breed Dog Rescue ...

Lucky Puppy - Studio City - Studio City, CA | Yelp
www.yelp.com · Pets · Pet Services · Yelp, Inc.
 ★★★★★ Rating: 4.5 - 18 reviews
 18 Reviews of Lucky Puppy "This is a great store with a lot of wonderful products. I love the play pens with the adoptable puppies! Such a great idea!"

Friends Of Studio City Non-Profit Pet Store Raising Funds To ...
losangeles.cbslocal.com/.../friends-of-studio... KCBS-TV
 Nov 3, 2013
 Lucky Puppy boasts that they never euthanize a pet. "The thing we do here, no matter how long the dogs are ..."

Grand Opening Lucky Puppy Rescue and Retail store in Los ...
www.examiner.com/.../grand-opening-lucky-puppy-rescue-and-retail-sto...
 Nov 14, 2012 - Lucky Puppy Rescue and Retail's info: Mission. Our Mission is to open up a world where retail and rescue can work hand and hand and puppy ...

Lucky Puppy Rescue and Retail — Studio City Patch — Pat...
studiocity.patch.com/listings/lucky-puppy-rescue-and-retail Patch Media
 Lucky Puppy Rescue and Retail provides loving homes for dogs who would otherwise end up in shelters, while reducing the demand for inhumane puppy mills ...

Lucky Puppy Rescue - Petfinder
www.petfinder.com/shelters/luckypuppy.html Petfinder
 Lucky Puppy Rescue. WHO WE ARE A small rescue for abandoned dogs. All of our dogs live in a home with a foster family. MISSION STATEMENT Our mission ...

Lucky Puppy - Onesies, Hoodies & Tees - Nothing But Cute
<https://lucky puppyonline.com/>
 Lucky Puppy is a collection of finely woven super soft cotton apparel all adorned with the Lucky Puppy signature paw print, heart icon, doggy dish or other Lucky ...

Lucky Puppy Rescue (LuckyPuppyRnR) on Twitter
<https://twitter.com/LuckyPuppyRnR>
 The latest from Lucky Puppy Rescue (@LuckyPuppyRnR). 100% Not For Profit Rescue & Retail Instagram @LuckyPuppyRescue Facebook ...



Lucky Puppy Rescue and Retail

Directions Be the first to review

Address: 12238 Ventura Blvd, Studio City, CA 91604
Phone: (818) 370-5516
Hours: Open today · 11:00 am – 8:00 pm

Reviews
 Be the first to review

Feedback

- Searches related to lucky puppy
- lucky puppy rescue
 - lucky puppy dog rescue kennel
 - lucky puppy couture
 - lucky puppy games
 - lucky puppy facebook
 - lucky puppy volunteer

⁴ <https://www.google.com/>, as accessed by Opposer on April 9, 2014; 8 TTABVue at 4 of 5.

Finally, Opposer also included a copy of Applicant's webpage, reproduced in part, below:



Lucky Puppy is the ONLY 100% Not for Profit retail store in Studio City. 100% of all proceeds from your purchases go to our rescue dogs. Lucky Puppy is the sister store of The Poopie Foundation, which is a not for profit, 501(c)(3) that was established in 2010. All of the dogs in our store are up for adoption and have come from one of the local kill shelters in Los Angeles. To adopt a dog from Lucky Puppy you must fill out an application and then one of our volunteers will do a home check. Any donation you make to Lucky Puppy is Tax Deductible. Thank you for supporting our rescue dogs!

Sincerely,
Rachel, Alice and the Lucky Puppy Crew

12238 Unit B, Ventura Blvd
Studio City, California 91604
818-370-5516
We are open 7 days a week
Mon-Fri: 11AM to 8PM
Sat-Sun: 10AM to 8PM



III. Standing and Priority

At the time it filed its Notice of Opposition, Opposer offered, and continues to manufacture and sell designer dog collars, leads, tags, and apparel, under the mark **LUCKY PUP**. Wynn Dec. ¶ 2. Applicant seeks registration of a similar mark for retail store services featuring, *inter alia*, pet supplies. Accordingly, Opposer has demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and has a reasonable basis for its belief of damage. *Ritchie v.*

⁵ <http://luckypuppyrescueandretail.com/> as accessed by Opposer on April 9, 2014; 7 TTABVue at 4-8 of 8.

Simpson, 170 F.3d 1092, 50 USPQ 1023 (Fed. Cir. 1999); *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-190 (CCPA 1982); *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1978 (TTAB 2010); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark **DESIGNED2SELL**, and has thereby established his standing to bring this proceeding.”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009).

For purposes of priority, the earliest date that Applicant may rely upon is the filing date of its underlying application *i.e.*, March 22, 2012. *Giersch v. Scripps*, 90 USPQ2d at 1023. In the absence of any federal registration, petitioner must show earlier common law usage of the claimed mark. *Id.* In this context, Opposer has used its mark continuously since 2003. Wynn Dec. ¶¶ 2-6. Although Applicant, in her brief, continues to question whether Opposer has a “protectable mark,” or has used its **LUCKY PUP** mark “in a protectable manner,” Applicant has made no allegation in her pleadings that Opposer’s mark is not inherently distinctive nor has she proffered any evidence during the prosecution of this opposition proceeding. Accordingly, we find that Opposer has alleged facts showing proprietary rights in its mark and has established its priority in the absence of having its own registration.

IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based upon an analysis of all probative 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 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315

F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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.”).

A. Similarity of the Parties’ Goods and Services

We turn first to our consideration of the relationship between Opposer’s and Applicant’s goods and services. We must make our determinations under these factors based upon the services as they are recited in the relevant application (*Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1990)) as well as the goods on which Opposer actually uses its mark at common law. The respective goods and services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions surrounding their marketing are such that the goods will be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they originate from the same source. *See On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

As to this factor, Applicant argues that she “is strictly in the business of retail adoption of dogs and retail sales of pet products made by others” and “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.”

Opposer concedes that Applicant appears to use her mark with a wider variety of products than Opposer manufacturers and sells, and the involved ITU application published for opposition only as to retail store services. However, Applicant’s recitation of services includes “retail store services featuring ... pet supplies.” As a matter of law, pet supplies must be construed broadly enough to include the general category of dog collars, leads and tags similar to those offered by Opposer. In fact, despite Applicant’s stated intentions to the contrary, Applicant’s own website contains photographs such as the one at right displaying just such items in its retail setting.



Whether one finds these goods and services to be overlapping or merely complementary, they are closely related. Hence, we find that this critical *du Pont* factor favors a finding of likelihood of confusion.

B. Channels of Trade

We have to presume that Opposer’s channels of trade will include all normal trade channels for the sale of dog products such as dog collars, collars for pets, leashes for animals, harnesses, pet clothing, and pet tags specially adapted for attaching to pet leashes or collars. Despite Applicant’s attempts to distance its retail store services from Opposer’s dog products, it is clear from the record that Applicant’s retail sales of pet products made by others could well include the very goods identified by Opposer, and that there will be opportunities for the parties’ respective channels of trade to overlap in the retail marketplace, whether bricks-

and-mortar locations or online. Hence, this *du Pont* factor also favors a finding of a likelihood of confusion.

C. Classes of purchasers

Given that these goods and services are directed to ordinary purchasers of pet products, and that pet supplies like I.D. tags are relatively inexpensive, there is no reason to assume relevant consumers will be making purchasing decisions with a heightened level of care. This *du Pont* factor also favors a finding of a likelihood of confusion.

D. Similarities of the marks

Applicant has applied to register the mark **LUCKY PUPPY**. Opposer's previously used mark includes the wording **LUCKY PUP**.⁶ In comparing the marks, we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. Because the similarity

⁶ We reach the same result as to this *du Pont* factor whether Opposer's mark is identified as **LUCKY PUP** (standard character format mark with a space), "Lucky Pup" (part of Opposer's trade name), **LUCKYPUP** (standard character format mark without a space) or as part of a composite mark consisting of the term "LuckyPup" along with design features (e.g., face of a puppy inside a horseshoe). All of these various presentations create the same overall commercial impression.

or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The only dissimilarity in appearance is that Applicant has replaced “Pup” with “Puppy.” If this minor difference is noticed, it will not be long remembered. The three syllables of Opposer’s mark are pronounced identically to the first three syllables of Applicant’s four-syllable mark. As to connotations, the terms have identical meanings, as Opposer points out. In summary, we find that these two marks create the same overall commercial impressions, and this critical *du Pont* factor favors a finding of likelihood of confusion.⁷

E. The number and nature of similar marks in use on similar goods and services

Applicant argues that Opposer’s cited mark is weak or diluted in International Class 18 because of multiple variations on this term being used by third parties with live trademark registrations on the United States Patent and Trademark Office database. However, Applicant failed to make any of these third-party registrations of record. Even if the registrations had been made of record, they

⁷ While Applicant’s drawing of its mark in the involved application is **LUCKY PUPPY** in standard character format, we cannot help but notice that Applicant, in creating its commercial image through its street sign and website, has chosen to present the happy face of a puppy inside the prominent imagery of a horseshoe, as had Opposer a decade earlier in its composite mark.



would have little probative value inasmuch as they would not be evidence of actual use, and therefore we could not assume that the public had been exposed to those marks. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the United States Patent and Trademark Office). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983). In view thereof, we do not agree with Applicant's argument that consumers have become so conditioned by their exposure to a number of "Lucky Pup" or "Lucky Puppy" marks used in connection with pet products such that they are able to distinguish between the relevant marks herein based upon negligible differences in the marks. Hence, we find that this *du Pont* factor, at best for Applicant, is neutral in arriving at our determination on likelihood of confusion.

F. The nature and extent of any actual confusion

Given the inherent difficulty of obtaining reliable actual-confusion evidence, it is well-established that actual confusion is not required for a finding of likelihood of confusion. *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); *Giant Food, Inc. v. Nation's FoodService, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395-96 (Fed. Cir. 1983) (holding that "it is unnecessary to show actual confusion in establishing likelihood of confusion"); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012) (recognizing that "evidence of actual confusion is difficult to obtain").

Against this background, even limited numbers of instances of actual confusion can point toward a likelihood of confusion. The predecessor to our primary

reviewing Court has held that even a single instance of actual confusion is entitled to weight. *See Libbey-Owens-Ford Glass Co. v. Thermoproof Glass Co.*, 390 F.2d 770, 156 USPQ 510, 511 (CCPA 1968) (where the Board had dismissed a single instance of actual confusion, the Court of Customs and Patent Appeals reversed, *inter alia*, on the ground that this single instance was entitled to consideration); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975) (holding that even a single instance of actual confusion is at least “illustrative of a situation showing how and why confusion is likely”).

Accordingly, Opposer argues that its reported instances of asserted actual confusion are entitled to great weight under the facts of this case. Almost from the moment Applicant made an appearance nearby in Los Angeles, Opposer received an enormous volume of inquiries from confused consumers. According to Ms. Wynn, Opposer became aware of Applicant’s presence in December 2012 – immediately after Applicant’s grand opening. Then, for the *twelve-month period* from December 2012 to December 2013, Opposer received more than *six-hundred* misdirected telephone calls from confused consumers who thought that they were calling Applicant’s “Lucky Puppy” store. The callers were asking “for anything from store hours, to what dog apparel products were carried, to whether certain dogs were available for adoption.” We find this extraordinary evidence of actual confusion one of the strongest indicators possible in support of a finding of likelihood of confusion.

G. Weighing the relevant *du Pont* factors

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties’ arguments with respect thereto,

including any evidence and arguments not specifically mentioned or discussed in this opinion.

Given the compelling similarities of the marks in their entireties, the additional fact that the goods and services are closely related and will travel in the same channels of trade to be purchased by the same classes of ordinary consumers, and given the physical proximity of the parties along with the extraordinary evidence of actual confusion, we find there is a likelihood of confusion herein that dictates judgment in Opposer's favor.

Decision: The opposition is hereby sustained and registration of Applicant's mark is refused under Section 2(d) of the Lanham Act.