

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Can! Cars for Kids

v.

Charitable Adult Rides & Services, Inc.

Opposition No. 91255836

Christopher D. Olszyk, Jr., Ryan N. Miller, Cali R. Spota, and Brieanne E. Scully of
Fox Rothschild LLP, for American Can! Cars for Kids.

Katherine M. Hoffman and Own M. Praskievicz of Solomon Ward Seidenwurm &
Smith LLP, for Charitable Adult Rides & Services, Inc.

Before Bergsman, Lynch, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Charitable Adult Rides & Services, Inc. (“Applicant”) seeks to register on the
Principal Register, under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the
standard character mark CARS for “charitable fundraising” in International Class
36.¹

¹ Application Serial No. 88461169 was filed on June 5, 2019, based on an allegation of use in
commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming February

American Can! Cars for Kids (“Opposer”) opposes the registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Opposer’s alleged prior common law use of the mark CARS FOR KIDS in connection with “business and charitable fundraising services broadly described as the arranging and organizing of charity sales and auction of automobiles and watercrafts for charitable fundraising purposes.”² In further support of its pleaded claim, Opposer also alleges ownership of prior pending application Serial No. 85796733 for the standard character mark CARS FOR KIDS (CARS disclaimed) for, inter alia, “charitable fundraising by means of collecting and reselling used automobiles and watercraft,” in International Class 36.³

Applicant filed an answer to the notice of opposition in which it denied the salient allegations asserted therein and alleged various purported “affirmative defenses” which we deem mere amplifications to the denials of the allegations in Opposer’s pleading.⁴ *The Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *4 (TTAB 2021); *see also DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *1 (TTAB 2020) (mere

3, 2003 as both the date of first use and the date of first use in commerce.

² 1 TTABVUE 4-6.

³ Notice of Opposition, ¶ 5; 1 TTABVUE 4.

⁴ Applicant’s Answer to Notice of Opposition, 4 TTABVUE. In addition to the amplifications of its denials, Applicant also asserted a purported “affirmative defense” to reserve the right to assert additional affirmative defenses. A defendant cannot reserve unidentified defenses or counterclaims in its answer since it does not provide a plaintiff fair notice of such defenses. Whether Applicant may amend its answer to include additional affirmative defenses or counterclaims would be resolved by way of a motion for leave to amend. No such motion was filed by Applicant during the course of this proceeding. Accordingly, this purported “affirmative defense” will be given no consideration.

amplifications of the applicant's denials not considered as separate affirmative defenses).

I. Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's involved application file. The record also includes the evidence summarized below.

A. Opposer's Evidence

1. Testimony Deposition of Malcolm Wentworth, Opposer's Chief Executive Officer, and the following accompanying exhibits:⁵ (a) copy of Opposer's certificate of incorporation in the State of Texas incorporated originally under the name TEXANS CAN!; (b) copy of Opposer's Assumed Name Certificate in Texas for the name "Cars for Kids" issued on August 14, 1989; (c) screenshots of Opposer's website, www.carsforkids.org, and Facebook page; (d) copies of intake forms and letters dating back to 1993 for Opposer's "Cars for Kids" Car Contribution campaign; (e) copies of various print advertisements in numerous publications for Opposer's "Cars for Kids" Car Contribution program; (f) copies of various articles about Opposer's "Cars for Kids" Car Contribution program; (g) proposed schedules and expenses for radio slot advertisements for Opposer's "Cars for Kids" Car Contribution program; (h) unsolicited media coverage of Opposer's "Cars for Kids" Car Contribution program; (i) radio advertisements of Opposer's "Cars for Kids" Car Contribution program; (j) table setting forth advertising expenditures between 2008-2018 for Opposer's "Cars for Kids" Car Contribution program; (k) copy of an unrelated federal court proceeding where it was determined that a third-party was infringing upon Opposer's "CARS FOR KIDS" mark; (l) copy of assignment of the mark CARS FOR KIDS from America Can! to Opposer; and (m) copy of screenshots from Applicant's www.careasy.org website.
2. Notice of Reliance⁶ on (1) status and title copy of Opposer's pleaded pending application for the mark CARS FOR KIDS; (2) status and

⁵ 12 TTABVUE (redacted copy) and 13 TTABVUE (confidential version).

⁶ 11 TTABVUE.

title copy of Applicant's involved application;⁷ (3) Applicant's responses to Opposer's interrogatories; (4) Applicant's response to Opposer's document requests, including documents produced by Applicant pursuant to the requests;⁸ (5) a copy of the U.S. Court of Appeals for the Third Circuit's decision in *Kars 4 Kids Inc v. America Can!*; and (6) screenshots from Applicant's website www.careasy.org.

B. Applicant's Evidence

1. Testimony Declaration of Howard A. Pearl, Applicant's Chief Executive Officer, and the following accompanying exhibits: (a) a screenshot of Applicant's website displaying the names of Applicant's partners in its charitable fundraising efforts; (b) representative copies of letters from donors; (c) a status and title copy of Applicant's involved application;⁹ and (d) copies of representative invoices and supporting materials that show Applicant's consistent sales and fulfillment of its charitable fundraising services under the proposed CARS mark.
2. Notice of reliance on the following: (a) a status and title copy of Applicant's involved application;¹⁰ (b) a plain copy of Applicant's Registration No. 6390330 for the mark



(Section 2(f), in part, as to the term CARS) for "charitable fundraising"; and (c) a plain copy of Applicant's Registration No. 6390330 for the mark a status and title copy of Applicant's Registration No. 6390331 for the mark

⁷ It was unnecessary for Opposer to submit a status and title copy of Applicant's involved application because, as noted above, the involved application is automatically of record under Trademark Rule 2.122(b).

⁸ Documents produced by an adverse party during discovery are not admissible under a notice of reliance alone. *See* Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii). Thus, we have given no consideration to these produced documents in our analysis.

⁹ As previously stated, it was unnecessary for Applicant to submit a status and title copy of its involved application because, as noted above, the involved application is automatically of record under Trademark Rule 2.122(b).

¹⁰ *See* n. 7, *supra*.



_____ (Section 2(f), in part, as to the term CARS) for “charitable fundraising.”¹¹

The case is fully briefed.¹²

II. Background – The Parties

Opposer is a charity that claims to have helped “turn around the lives of children since 1985.”¹³ It employs a comprehensive marketing approach to raise funds for its education programs by receiving charitable donations of used automobiles and watercraft and reselling the vehicles at auction.¹⁴ Opposer uses the funds it receives through these charitable donations and through its auctions of automobiles and watercraft to create and support educational programs for at-risk youth at the high school level in order to help them obtain a high school diploma and to give them the

¹¹ Applicant did not submit copies of its two prior registrations showing both the current status of and current title to the registrations, as required by Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2) (“A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance in accordance with paragraph (g) of this section, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration.”). Thus, these two registrations are not of record and we have given them no consideration in our analysis.

¹² 16-18 TTABVUE.

¹³ Wentworth Decl., ¶ 5 (12 TTABVUE 2).

¹⁴ *Id.* at ¶ 6 (12 TTABVUE 3).

tools to achieve economic independence.¹⁵ Opposer's programs have served over 100,000 students.¹⁶ Since at least 1989, Opposer has continuously and consistently used its CARS FOR KIDS mark in interstate commerce in connection with its charitable fundraising and car auction services.¹⁷

On or before February 3, 2003, Applicant created its CARS mark for use in commerce with its charitable business to provide affordable transportation to elderly adults.¹⁸ Applicant desired a trademark that would directly link its name "Charitable Adult Rides & Services" in the minds of consumers, for which Applicant's CARS mark is intended to be an acronym.¹⁹ From its inception, Applicant's mission has been to serve as a social enterprise that enables sustainable revenue streams for nonprofit organizations of any size across North America.²⁰ It seeks to achieve this by providing access to turn-key car donation programs, and includes support services to aid in the growth and professional development of its nonprofit partners.²¹ Applicant is a nonprofit that only serves nonprofits.²² Applicant directs its charitable services, and its advertising and marketing of those services, to other nonprofit organizations to

¹⁵ *Id.* at ¶ 7 (12 TTABVUE 3).

¹⁶ *Id.*

¹⁷ *Id.* at ¶ 13 (12 TTABVUE 4).

¹⁸ Pearl Decl., ¶ 2 (15 TTABVUE 2).

¹⁹ *Id.* at ¶ 3 (15 TTABVUE 2).

²⁰ *Id.* at ¶ 5 (15 TTABVUE 3).

²¹ *Id.*

²² *Id.* at ¶ 7 (15 TTABVUE 3).

assist them in raising revenue by providing a turn-key vehicle donation program.²³ Applicant has partnered with close to 8,000 nonprofits to increase their revenue.²⁴ Since 2003, Applicant's CARS program has returned more than \$320 million to nonprofits.²⁵

III. Entitlement to a Statutory Cause of Action²⁶

A plaintiff's entitlement to a statutory cause of action for opposition or cancellation must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). Opposer may oppose Applicant's application if such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and Opposer has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021).

Opposer's Chief Executive Officer, Mr. Wentworth, testified that Opposer began using the mark CARS FOR KIDS in connection with charitable fundraising and car

²³ *Id.*

²⁴ *Id.* at ¶ 6 (15 TTABVUE 3).

²⁵ *Id.*

²⁶ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

auction services since at least as early as 1989.²⁷ The record includes documentary evidence corroborating Mr. Wentworth's testimony that Opposer uses the mark CARS FOR KIDS in connection with the aforementioned services.²⁸ We additionally note that Opposer submitted a copy of its prior pending application for the mark CARS FOR KIDS for, inter alia, "charitable fundraising by means of collecting and reselling used automobiles and watercraft."²⁹

In view of the foregoing, we find that Opposer has established its entitlement to a statutory cause of action through the combination of the testimony Mr. Wentworth and the documentary evidence submitted by Opposer. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *4 (TTAB 2019) (standing established by testimony, with exhibits, of use of confusingly similar mark); *Grand Canyon W. Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008) (standing established by testimony as to prior use of similar mark); *see also Liqwacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value). We further note that Applicant does not dispute Opposer's entitlement to a statutory cause of action.

²⁷ Wentworth Decl., ¶11 (12 TTABVUE 3).

²⁸ Wentworth Decl., Exhs. L, M (12 TTABVUE 91-4-9 and 16-19).

²⁹ Opposer's Notice of Reliance, Exh. 1 (11 TTABVUE 6-14).

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its pleaded mark and that use of Applicant’s mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant’s services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated*

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

“In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

A. Priority

As the alleged prior user, Opposer bears the burden of proving its claim of acquisition of prior proprietary rights in its pleaded mark. *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987); see also *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013). (“[O]pposer must prove by a preponderance of the evidence that its common law rights were acquired before any date upon which applicant may rely.”).

“As a general matter, priority in a Trademark Act § 2(d) case goes to the party which made first use of its mark on the relevant goods [or services].” *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1139 (TTAB 2013). Here, Opposer has submitted credible testimony stating that it first began use of its pleaded CARS FOR KIDS mark in connection with its charitable fundraising services at least as early as 1989, along with corroborating documentary evidence.³⁰ Applicant also submitted testimony that it began use of its involved CARS mark on or before February 3, 2003.³¹

Testimony, even of a single witness, if “sufficiently probative,” may be sufficient to prove priority. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108-09 (TTAB 2007). There is nothing in the record that would cause us to question the reliability or accuracy of either Mr. Wentworth’s or Mr. Pearl’s testimony, particularly since such testimony is buttressed by accompanying documentary evidence.

Because the record demonstrates that Opposer’s use of its pleaded CARS FOR KIDS for its charitable fundraising services predates Applicant’s first use of its CARS mark for its charitable fundraising services, Opposer has established, by a

³⁰ Wentworth Decl., ¶11 (12 TTABVUE 3).

³¹ Pearl Decl., ¶¶ 2 and 15 (15 TTABVUE 2 and 4).

preponderance of the evidence, its prior use of its pleaded CARS FOR KIDS mark for its charitable fundraising services.³²

B. Similarity of the Services

We turn first to the second *DuPont* likelihood of confusion factor focusing on the comparison of the services identified in Applicants' involved application and the services offered by Opposer pursuant to its prior common law use of its pleaded CARS FOR KIDS mark, as well as Opposer's pleaded pending application.

Applicant's services are identified as "charitable fundraising." Opposer has demonstrated use of its pleaded CARS FOR KIDS for charitable fundraising by means of collecting and reselling used automobiles and watercraft. We further note that the same services are identified in Opposer's prior pending application for the mark CARS FOR KIDS.

Applicant argues that the parties' respective services are not related because it primarily offers its services to other non-profit organizations, a substantial difference from Opposer's operation that does not appear to contain such a limitation.³³ Additionally, Applicant contends that Opposer's use of the wording "FOR KIDS" in its mark creates an inherent limitation in the marketing of its services and resulting channels of trade, as it promotes its operation goal of supporting charitable causes for children.³⁴ Applicant's argument is unavailing.

The Federal Circuit has held that when analyzing an applicant's and registrant's

³² We note that Applicant does not contest Opposer's priority of use.

³³ Applicant's Appeal Brief, p. 24 (17 TTABVUE 28).

³⁴ *Id.* at p. 25 (17 TTABVUE 29).

goods or services for relatedness, the determination is based on the description stated in the applications and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 123 USPQ2d at 1749). Applicant's broadly-worded identification encompasses all types of charitable fundraising, including Opposer's more delineated charitable fundraising services. *See e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (same); *cf. In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). As such, the parties' respective services are legally identical in part.

Accordingly, the second *Dupont* factor heavily weighs in favor of a finding of likelihood of confusion.

C. Similarity of Trade Channels/Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. We initially note that because there are no restrictions as to trade channels or classes of purchasers set forth in the identification of services of Applicant's involved application, we presume Applicant's services travel through all usual channels of trade for such services and are offered to all normal potential consumers of such services. *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA); *see also Stone Lion Capital Partners, LP v. Lion*

Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Since the trade channels of Applicant's services are unrestricted and because the parties' goods are legally identical in part, we must presume that both Opposer's and Applicant's legally identical-in-part services travel in the same or overlapping trade and distribution channels and will be marketed to the same or overlapping potential consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods...."); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Accordingly, the third *DuPont* factor also heavily favors a finding of likelihood of confusion.

D. Strength of Opposer's CARS FOR KIDS mark

"In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc.*, 110 USPQ2d at 1476); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength

is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). The fifth *DuPont* factor, the “fame” of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar services, *DuPont*, 177 USPQ at 567, may be considered in tandem to determine the strength of Opposer’s CARS FOR KIDS mark and the scope of protection to which it is entitled. *Bell’s Brewery, Inc.*, 125 USPQ2d at 1345.

a. Conceptual Strength

With regard to the conceptual strength of Opposer’s CARS FOR KIDS mark, we note that the Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some non-source identifying significance which undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Extensive registration and use of a term by others has been treated as “powerful” evidence of its weakness. *See In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1746 n. 8 (TTAB 2016) (citing *Juice Generation, Inc.*, 115 USPQ2d

at 1674 and *Jack Wolfskin*, 116 USPQ2d at 1136).

In its trial brief, Applicant challenges the distinctiveness of Opposer's CARS FOR KIDS mark claiming that the mark is inherently weak because it merely describes the services Opposer provides.³⁵ Additionally, Applicant refers to a federal court litigation between Opposer and a third-party where the third party's use and federal registration of the mark 1-877-KARS-4-KIDS was found to willfully infringe upon Opposer's pleaded CARS FOR KIDS mark. Applicant, however, did not submit a status and title copy of the third party's registration for the 1-877-KARS-4-KIDS mark nor did it submit any evidence demonstrating use of this mark in commerce. Even assuming Applicant had submitted such evidence, we find that a single third-party registration or evidence of commercial use by a single third party of a mark similar to that of Opposer for identical or similar services does not constitute "powerful" evidence of demonstrating any conceptual weakness of Opposer's mark. By comparison, in *Juice Generation*, there were at least 26 relevant third party uses or registrations of record, *see* 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n. 2. Moreover, Applicant's argument that Opposer's mark is merely descriptive of its services is not supported by any evidence submitted by Applicant. Attorney argument is not a substitute for evidence. *Cai*, 127 USPQ2d at 1799 ("Attorney argument is no substitute for evidence.") (citation omitted).

Therefore, we find, on this limited record, that Opposer's CARS FOR KIDS mark,

³⁵ Applicant's Trial Brief, p. 23 (17 TTABVUE 27).

in its entirety, should be entitled the normal scope of protection accorded an inherently distinctive mark. That being said, however, we do note that the term CARS in Opposer’s mark is, at best, descriptive of Opposer’s services, as evidenced by Opposer’s disclaimer of the term in its pleaded application. *See, e.g., In re Six Continents Ltd.*, 2022 USPQ2d 135, at *18 (TTAB 2022) (disclaimer of word SUITES in ATWELL SUITES MARK “is a concession that ‘Suites’ is not inherently distinctive.”) (citing *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) (“it has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term . . . at the time of the disclaimer”)).

b. Commercial Strength

i. Fame— 5th *DuPont* Factor

We next determine the alleged degree of fame of Opposer’s CARS FOR KIDS mark under the fifth *DuPont* factor.³⁶ Its commercial strength “may be measured indirectly by the volume of sales and advertising expenditures in connection with the services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the services identified by the mark []; and the general reputation of the services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017).

³⁶ The Federal Circuit has held that “[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)).

To demonstrate the fame of its CARS FOR KIDS mark, Opposer submitted a variety of evidence, showing that: (1) since at least 1989, Opposer has regularly and continuously used the mark CARS FOR KIDS in interstate commerce in connection with its charitable fundraising and car auction services;³⁷ (2) Opposer has expended significant resources on a national basis in its extensive marketing and advertising efforts including on-line, print and broadcast advertising, billboards, door hangings and other publicity methods in promoting its CAR FOR KIDS mark and the underlying automobile and watercraft donation program;³⁸ (3) between 2015 and 2018, Opposer's advertising expenditures for its CARS FOR KIDS mark averaged \$2.8 million;³⁹ (4) in 2019, Opposer budgeted over \$3.5 million in advertising for its CAR FOR KIDS mark;⁴⁰ (5) Opposer promotes its services under the CARS FOR KIDS mark using, among other things, its www.carsforkids.org website, as well as social media websites, such as Facebook where it has 150,000 followers;⁴¹ (6) from 1992-2001, Opposer advertised its CARS FOR KIDS mark in various Texas newspapers and radio stations;⁴² (7) although Opposer's activities were initially concentrated in Texas, where the charity was founded, Opposer has since advertised its charitable car donation services in all 50 of the United States and has received car

³⁷ Wentworth Decl., ¶ 13 (12 TTABVUE 4).

³⁸ *Id.* at ¶ 14 (12 TTABVUE 4).

³⁹ *Id.* at ¶ 34 (12 TTABVUE 7).

⁴⁰ *Id.*

⁴¹ *Id.* at ¶ 15 (12 TTABVUE 4).

⁴² *Id.* at ¶¶ 16-25 (12 TTABVUE 4-5).

donations from all 50 of the United States;⁴³ (8) between 1989 and 2004, the CARS FOR KIDS program received over 60,000 car donations from across the country;⁴⁴ (9) between 2004 and 2017, the CARS FOR KIDS program added over 151,000 additional vehicle donations, resulting in over \$115 million in revenue,⁴⁵ (10) in 2011, Opposer advertised its Cars For Kids program on WBAP-AM, an AM news/talk radio station licensed to Fort Worth, Texas and serving the Dallas-Fort Worth Metroplex;⁴⁶ (11) in 2011, Opposer advertised its Cars For Kids program with ESPN.com, including pre roll videos, homepage takeovers and banners on ESPNDallas.com;⁴⁷ (12) in 2013, Opposer was featured by Neighborsgo, a weekly community newspaper published by The Dallas Morning news, and its Cars For Kids program was recognized as the only car donation facility in the United States that is run by the charity it benefits and has been in business for 21 years;⁴⁸ (13) since at least 2014, Opposer has advertised its Cars For Kids program on Pandora, a nationwide subscription-based music streaming service, now owned by Sirius XM, with both audio and banners;⁴⁹ and (14) since at least 2014, Opposer has partnered with SiriusXM to advertise its Cars For Kids program on Fox Business, CNN, CNN

⁴³ *Id.* at ¶ 26 (12 TTABVUE 5).

⁴⁴ *Id.*

⁴⁵ *Id.* (12 TTABVUE 5-6).

⁴⁶ *Id.* at ¶ 27 (12 TTABVUE 6).

⁴⁷ *Id.* at ¶ 28 (12 TTABVUE 6).

⁴⁸ *Id.* at ¶ 30 (12 TTABVUE 6).

⁴⁹ *Id.* at ¶ 31 (12 TTABVUE 6-7).

Headline News, Howard Stern 100, Sirius Stars, MSNBC, CNBC, XM Bloomberg Radio, ESPN Radio and Fox News – all having nationwide viewership/listenership.⁵⁰

“In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.” *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), *rev’d on other grounds*, 2008 WL 6862402 (D.D.C. Apr. 3, 2008). In analyzing the evidence, we initially note that the length of time Opposer has used its CARS FOR KIDS mark in commerce for its charitable fundraising services, while not insubstantial, is insufficient standing alone to establish that its mark has achieved such commercial renown that it may be considered a very strong mark. Moreover, Opposer has submitted very scant evidence concerning unsolicited media attention and no evidence of industry accolades received for its CARS FOR KIDS charitable fundraising program. Additionally, Opposer has not submitted evidence demonstrating (1) how many potential or actual consumers visit its website, or (2) the circulation of the newspapers it advertises its CARS FOR KIDS charitable fundraising program.⁵¹ Similarly, Opposer did not

⁵⁰ *Id.* at ¶ 32 (12 TTABVUE 7).

⁵¹ Opposer also failed to submit any evidence to demonstrate (1) how its donations and revenues compare to its competitors in the industry, (2) how many times consumers encounter its CARS FOR KIDS mark for the services provided thereunder, or (3) any context for its achievements in the services it provides under its CARS FOR KIDS mark, e.g., market share. Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of Opposer’s CARS FOR KIDS mark into context. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *cf. Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed.

submit evidence demonstrating how many persons listen to the radio programs where it advertises its CARS FOR KIDS mark. That being said, the record demonstrates that Opposer has expended a significant amount of advertising for its CARS FOR KIDS program over a long period of time and such advertising has appeared nationwide.

Based on the totality of the evidence submitted by Opposer, we find that Opposer has demonstrated that its CARS FOR KIDS mark has attained a moderate amount of commercial success and renown when used in association with its charitable fundraising services, but does not fall on the very strong end of the fame spectrum.⁵²

ii. Similar Marks on Similar Services – 6th *DuPont* Factor

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods. *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). If the evidence establishes that the consuming public is exposed to widespread third-party use of similar marks for similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc.*, 73 USPQ2d at 1693.

Cir. 2018) (“Market share is but one way of contextualizing ad expenditures or sales figures.”).

⁵² Applicant argues that its involved CARS mark is more famous than Opposer’s CARS FOR KIDS mark. See Applicant’s Trial Brief, p. 28 (17 TTABVUE 32). The fame of Applicant’s mark, however, is irrelevant in our analysis. Only the fame of Opposer’s mark is relevant. See *DuPont*, 177 USPQ at 567 (explaining that the Board must examine the “fame of the **prior mark**”) (emphasis added); cf. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“A newcomer does not gain the right to register a substantially identical mark simply because the number of persons exposed to the registrant’s mark may be small in relation to the newcomer’s volume of use.”)

Although Opposer has conceded that it is aware that a particular third party uses the mark 1-877-KARS-4-KIDS in connection with charitable fundraising,⁵³ there is no other evidence of record demonstrating third-party use of marks containing the wording CARS FOR KIDS or similar variations for services identical or similar to those provided by Opposer under its pleaded mark. This very limited evidence does not show that Opposer's CARS FOR KIDS mark has been weakened by third-party use. *See, e.g., In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, Slip Op. No. 18-2236 (Fed. Cir. Sept. 13, 2019) (four third-party registrations and no third-party uses were "a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant"); *In re i.am.symbolic*, 123 USPQ2d at 1751 (where the conflicting marks were identical, evidence of the coexistence of the cited registered mark with two third-party registrations of the same mark for the same or similar goods "falls short of the 'ubiquitous' or 'considerable' use of the mark components present in" *Jack Wolfskin* and *Juice Generation*). *Cf. TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1427-28 n.92 (TTAB 2018) (67 third-party registrations and numerous uses of TRADER-formative marks showed that the formative was weak). Accordingly, the sixth *DuPont* factor is neutral.


In sum, the evidence of record shows that Opposer's CARS FOR KIDS mark, in its entirety, is entitled to a normal scope of protection.

⁵³ Wentworth Decl., ¶ 35 (12 TTABVUE 7).

E. Similarity of the Marks

We next consider the first *DuPont* likelihood of confusion factor, which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc.*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The average purchaser includes members of the general public who donate their automobiles.

Our analysis cannot be predicated on dissection of the involved marks. *See Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.*; *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

The evidence of record demonstrates that Opposer has prior use of its pleaded CARS FOR KIDS mark in the following form:⁵⁴ . We also note that Opposer seeks to register the standard character mark CARS FOR KIDS for its charitable fundraising services. Applicant's mark is CARS in standard characters.

Here, the parties' respective marks both incorporate the term CARS. However, we find that this shared term does not render the marks confusingly similar. In the present case, the weakness of the term CARS in both Opposer's and Applicant's marks deserves greater weight in the likelihood of confusion analysis.⁵⁵ As the Court of Customs and Patent Appeals, the predecessor to the U.S. Court of Appeals for the Federal Circuit, stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958):

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

This especially holds true in this case since Opposer, in its prior pending

⁵⁴ Wentworth Decl., Exh. C (12 TTABVUE 26).

⁵⁵ By seeking to register its proposed CARS mark under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), Applicant has admitted that the term is descriptive of its services and, therefore, has conceded that the term is not inherently distinctive. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *9 (TTAB 2019). The Section 2(f) claim has not been challenged in this proceeding and, therefore, is not before us.

application, has disclaimed the exclusive rights to the wording CARS in light of the highly descriptive nature of the term. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.”) (internal quotation omitted); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks). By disclaiming the term CARS, Opposer has conceded that it does not have exclusive rights in the wording CARS alone. The purpose behind a disclaimer is to make clear that a party registering a composite mark that includes a descriptive or generic term is not thereby abridging the right of others who may need to use the term. *In re Pencils Inc.*, 9 USPQ2d 1410, 1411 (TTAB 1988) (“the basic purpose of a disclaimer is to make of record, if it might otherwise be misunderstood, that a significant element of a composite mark is not being exclusively appropriated, apart from the composite”).

We further find that the parties’ respective marks convey different connotations and overall commercial impressions. Opposer’s CARS FOR KIDS suggests a type of fundraising service that involves children and cars. Applicant’s CARS mark, however, does not express that same connotation or commercial impression.

Opposer argues that Applicant’s CARS mark should not register because it would “provide Applicant with a monopoly over the term CARS within the category of charitable fundraising, and rendering those future adopters of [the] same or similar

marks containing the term CARS as potential infringers.”⁵⁶ Opposer further maintains that “[i]t would be inappropriate to allow registration of a mark that forms the first portion, and therefore most impressionable portion, of many marks (most notably Opposer’s), thus resulting in superior rights in the term over others, including Opposer.”⁵⁷

We are not persuaded by Opposer’s argument. Here, we are only concerned as to whether Applicant’s CARS mark is likely to cause confusion with Opposer’s CARS FOR KIDS mark, not with alleged descriptiveness of Applicant’s mark or the sufficiency of its Section 2(f) claim, or with some hypothetical future third-party uses that may or may not cause confusion with Applicant’s involved CARS mark. Moreover, while we acknowledge that the term CARS is the first word in Opposer’s pleaded mark and, generally, the first portion of a mark is more likely to make an impression on potential consumers, see *In re Detroit Athletic Co.*, 128 USPQ2d at 1049 (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”), the term CARS is nonetheless descriptive of Opposer’s services and has been appropriately disclaimed. Disclaimed matter that is descriptive of a party’s goods or services, as is the case here, is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 128 USPQ2d at 1050) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TRADEMARK MANUAL OF EXAMINING PROCEDURE

⁵⁶ Opposer’s Trial Brief, p. 24 (16 TTABVUE 30).

⁵⁷ Opposer’s Reply Brief, p. 8 (18 TTABVUE 14).

(TMEP) § 1207.01(b)(viii) (July 2022). As such, we look to the wording FOR KIDS in Opposer's mark as the more distinctive elements of Opposer's mark. The wording FOR KIDS, however, is not present in Applicant's mark.

In sum, while we have not overlooked the disclaimed term CARS in Opposer's mark in considering the marks at issue, we nonetheless find that marks are not sufficiently similar, particularly in light of the highly descriptive nature of the term CARS in relation to both parties' marks and associated services, as well as the differing connotations and overall commercial impressions presented by the parties' respective marks.

Thus, the first *DuPont* factor does not favor a finding of likelihood of confusion.

F. Sophistication of Purchasers

Under the fourth du Pont factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues that its services are directed to other non-profits, which are inherently sophisticated consumers.⁵⁸ Applicant further maintains that even if the Board were to find overlap in the type of consumers targeted by Opposer and Applicant, the Board should nevertheless conclude that charitable fundraising generally captures a more care level of consumer, one who cares about the causes to which they are making donations.⁵⁹

⁵⁸ Applicant's Trial Brief, p. 27 (17 TTABVUE 31).

⁵⁹ *Id.*

Applicant has provided no evidence of this avowed sophistication. *Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”)). Also, Applicant’s identification does not limit the class of consumers to non-profits, and regardless, such entities can include small and relatively unsophisticated ventures. “Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *Stone Lion*, 110 USPQ2d at 1163. Even if there were evidence supporting the sophistication of Applicant’s consumers, there is no evidence that Opposer’s customers or potential customers are sophisticated. Notwithstanding, even sophisticated purchasers are not immune from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)). *See also In re Shell Oil Co.*, 26 USPQ2d at 1690-91; *In re Integrated Embedded*, 120 USPQ2d 1504, 1516 (TTAB 2016).

Thus, the fourth *DuPont* factor is neutral.

G. Lack of Actual Confusion

We next turn to the seventh *DuPont* factor (nature and extent of any actual confusion) and the related eighth *DuPont* factor (extent of the opportunity for actual confusion), raised by Applicant in its trial brief.⁶⁰

No evidence of actual confusion was submitted. The absence of any reported

⁶⁰ Applicant’s Trial Brief, pp. 20-21 (17 TTABVUE 24-25).

instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

Assessing the lack of any reported instances of confusion requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *17 (TTAB 2020) (citing *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020)). Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade could be telling. In this regard, we consider all of the evidence of record that may be relevant to this

eighth *DuPont* factor.

Here, the evidence of record demonstrates that the parties' respective marks have coexisted in commerce since 2003, a period of approximately twenty years.⁶¹ The record also demonstrates that both parties have expended millions of dollars in advertising their services on a nationwide basis.⁶² Additionally, the record demonstrates that the parties have raised hundreds of millions of dollars through their charitable fundraising services.⁶³ Further, the record shows that Applicant has partnered with many U.S. businesses and organizations across the United States in providing its charitable fundraising services.⁶⁴ Based on the foregoing, we find that there has been a true opportunity for actual confusion to occur.

As previously noted, however, the record is devoid of any instances of actual confusion between the parties' respective marks. Accordingly, we find that the seventh and eighth *DuPont* factors favor a finding that confusion is unlikely. *See Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364, 367 (Fed. Cir. 1986) ("These distinctions coupled with the lack of actual confusion over a period of years lead us to conclude that use of the mark ROMANBURGER is not likely

⁶¹ Wentworth Decl., ¶11 (12 TTABVUE 3) and Pearl Decl., ¶¶ 2 and 15 (15 TTABVUE 2 and 4).

⁶² Wentworth Decl., ¶¶ 26, 32-34 (12 TTABVUE 5 and 7) and Pearl Decl., ¶¶ 8 and 15 (15 TTABVUE 2 and 4).

⁶³ Wentworth Decl., ¶9 (12 TTABVUE 3) and Pearl Decl., ¶ 8 (15 TTABVUE 3).

⁶⁴ Pearl Decl., ¶ 9 (15 TTABVUE 3). The businesses and organizations include: NPR & PBS Public Media Broadcasters across North America, Autism Speaks, American Institute for Cancer Research, Jewish Family Services, Play4Autism, The Salvation Army, Meals on Wheels America, 15) Shriners Hospitals for Children, Sierra Club Foundation, St. Jude Children's Research Hospital, The American Red Cross, and American Diabetes Association.

to cause confusion, mistake or deception”); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (“In the absence of evidence to the contrary, such lack of actual confusion over so many years must be considered in this case as supportive of a finding that confusion is not likely in the future”).

H. Market Interface

Applicant raises the tenth *DuPont* factor of market interface between the parties in its trial brief.⁶⁵ Applicant argues that although the traditional defenses of laches and estoppel are not typically an issue in opposition proceedings, given that such defenses start to run from the time an application is published for opposition, the Board may still consider Opposer’s lack of prosecution and delayed engagement with Applicant as emblematic of the absence of any actual confusion.⁶⁶ It appears that Applicant may have a misunderstanding as to the nature of the *DuPont* factor regarding market interface.

The tenth *DuPont* factor requires us to consider evidence pertaining to the “market interface” between the parties, including evidence of any past dealings between the parties which might be indicative of a lack of confusion in the present case. Most decisions involving this factor address an agreement between the parties that evinces their business-driven conclusion and belief that there is no likelihood of confusion, and weighs heavily in favor of a finding that confusion is not likely. *In re Opus One Inc.*, 60 USPQ2d 1812, 1820 (TTAB 2001); *see also Bongrain Int’l (Am.)*

⁶⁵ Applicant’s Trial Brief, p. 27 (17 TTABVUE 31).

⁶⁶ *Id.*

Corp. v. Delice de France, Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) (“[I]n trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, ... such agreements may, depending on the circumstances, carry great weight ...”). Compare *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1641 (TTAB 2007) (“Applicant has not explained how the agreement “negates” the likelihood of confusion and we do not find that it does.”).

Here, there is no evidence of record concerning any agreement between the parties which may be indicative of a lack of confusion. In other words, there is no evidence of any type of understanding or arrangement between the parties that demonstrates that confusion is not likely to result from the contemporaneous use of the parties’ respective marks in commerce. Thus, we find the market interface *DuPont* factor to be neutral.

V. Conclusion

We have considered all of the parties’ arguments and evidence of record, and all relevant *DuPont* factors. Applicant’s CARS mark for its identified services is not likely to cause confusion with Opposer’s mark CARS FOR KIDS for its identified services. In view of the weakness of the term CARS in Opposer’s mark, as well as the differing meaning and commercial impression conveyed by the parties’ respective marks, we find that the additional wording in Opposer’s mark, i.e., FOR KIDS, is sufficient to distinguish Applicant’s CARS mark from Opposer’s pleaded CARS FOR KIDS mark, despite the fact that the services are legally identical in part, must be deemed to travel in the same channels of trade, and are offered to the same or overlapping consumers. Our conclusion is buttressed by the fact that there is no

evidence of actual confusion between the marks, although the marks have coexisted for approximately twenty years, the parties have advertised their services nationally, and Applicant has partnered with numerous U.S. businesses nationwide. *See, e.g., In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992) (lack of actual confusion supported determination of no likelihood of confusion).

We thus find that Opposer has not established by a preponderance of the evidence that Applicant's CARS mark for its identified services so resembles Opposer's CARS FOR KIDS for its services as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The opposition is dismissed.