

This Opinion is not a
Precedent of the TTAB

Oral Hearing October 11, 2022

Mailed: February 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Little Free Library, Ltd.
v.
Little Legacy Library LLC
—

Opposition No. 91264613

Bradley J. Walz of Barnes & Thornburg, LLP
for Little Free Library, Ltd,

Emily Wasserman of Davis Graham & Stubbs LLP
for Little Legacy Library LLC.

—
Before Taylor, Goodman and Johnson,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Little Legacy Library LLC (Applicant/Defendant) filed an application on the Principal Register to register the mark LITTLE LEGACY LIBRARY (in standard characters, with LIBRARY disclaimed) for “Books, coloring books, and workbooks for children in fields of personal development, success, achievement, entrepreneurship, and fiscal responsibility” in International Class 16; and for “Classes, seminars, workshops, bootcamps, and podcasts for children in fields of personal development,


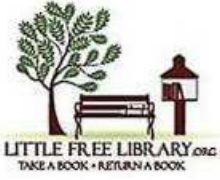
success, achievement, entrepreneurship, and fiscal responsibility” in International Class 41.¹

Little Free Library, Ltd. (Opposer/Plaintiff) opposes 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). Opposer has pleaded ownership of the following standard character and word and design marks:

Mark	Goods or Services	Registration No.	Register
LITTLE FREE LIBRARY (in standard characters)	Class 37: Construction of signage and cabinetry	4423845	Principal-2(f)
LITTLE FREE LIBRARY (in standard characters)	Class 35: Providing a website to promote book exchanges for others	4423846	Principal-2(f)
LITTLE FREE LIBRARY (in standard characters)	Class 20: wooden boxes with a storage area for books	6032304	Principal
LITTLE FREE LIBRARY (in standard characters)	Class 16: Guest books; Rubber stamps	5954466	Principal
LITTLE FREE LIBRARY (in standard characters)	Class 6: Signs, non-luminous and non-mechanical of metal	5954465	Principal

¹ Application Serial No. 88741142 was filed on December 28, 2019 based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

References to the briefs and the record refer to the Board’s TTABVUE docket system.

	<p>Class 37: Construction of signage and cabinetry</p>	<p>4564618</p>	<p>Principal-2(f)-in Part</p>
	<p>Class 41: Providing a website to promote book exchanges for others</p>	<p>4564619</p>	<p>Principal-2(f)-in Part</p>

Applicant filed an answer denying the salient allegations in the notice of opposition. Applicant also included in its answer three purported “DEFENSES.” The first “defense,” stating “the Notice fails to state a claim...,” is not a true affirmative defense because it asserts insufficiency of the pleading. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *4 n.5 (TTAB 2021) (failure to state a claim is not an affirmative defense) (citation omitted); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (same). The second “defense” stating “[t]here is no likelihood of consumer confusion” is merely an amplification of Applicant’s denial of likelihood of confusion, and we treat it as such. The third “defense” is an improper attempt to reserve the right to assert additional defenses. *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *6 (TTAB 2022) (Applicant’s “attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Opposer] fair notice of such defenses.”) (quoting *Philanthropist.com, Inc. v. Gen. Conference Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *4 n.6 (TTAB 2021)).

Each party filed a trial brief and Opposer filed a reply brief.² An oral hearing was held.

I. Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application.³ In addition, the record consists of Opposer's notices of reliance at 17, 18, and 28 TTABVUE and the declaration testimony of M. Greig Metzger, Opposer's Executive Director, at 21 and 27 TTABVUE. Opposer's confidential filings are located at 19 TTABVUE (notice of reliance) and 20 TTABVUE (declaration testimony of M. Greig Metzger).

Applicant submitted a notice of reliance at 26 TTABVUE and 31 TTABVUE (resubmission of notice of reliance for legibility) and the testimony declaration of Timothy L. Bratz, co-owner and managing member of Applicant, at 25 TTABVUE.

Opposer attached definitions of "library" with its reply brief. Because this evidence was not submitted during Opposer's testimony periods, we have not considered it. *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976) (party "must file a seasonable notice of reliance to place in the record matter of which it desires the Board to take judicial notice and cannot rely upon the mere possibility that judicial notice will be taken of adjudicative facts"); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.12(b) (2022).

² Opposer's brief is at 29 TTABVUE, its confidentially filed brief is at 30 TTABVUE, and its reply brief is at 33 TTABVUE; Applicant's brief is at 32 TTABVUE.

³ It was unnecessary for Applicant to submit a copy of its application file by notice of reliance. Defendant's notice of reliance, exhibit 1, 26 TTABVUE 7.

Both parties reference a “parties’ stipulation” in their notices of reliance where they identify certain submissions and their relevance. However, the parties did not submit any such “parties’ stipulation” to the Board for approval. TBMP § 705 (“Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence”). Moreover, some of the materials submitted under the respective notices of reliance “pursuant to the parties’ stipulation” may not be made of record by notice of reliance under Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e).⁴ Therefore, we do not consider the non-conforming materials of record unless the adverse party discussed a specific piece of evidence in its brief.⁵ See *Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, 100 USPQ2d 1213, 1216 (TTAB 2011) (parties who submit non-conforming evidence run the risk the proposed evidence “will not be considered even if the adverse party does not specifically object to it” unless the adverse party “specifically treats it of record” such that it is considered “stipulated into the record.”).

⁴ For example, Opposer’s press releases, newsletters, handouts, and financial statements and Applicant’s promotional email are not the type of material admissible under notice of reliance. See e.g., *Barclays Cap. Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164-65 (TTAB 2017) (press releases are not printed publications and are not proper subject matter for submission under notice of reliance); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1956-59 (TTAB 2008) (brochures and periodic newsletters are not proper subject matter under notice of reliance); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (financial statements and advertising documents do not qualify as either printed publications, or as official records as contemplated by Trademark Rule 2.122(e)); *Exxon Corp. v. Fill-R-Up Sys., Inc.*, 182 USPQ 443, 445 (TTAB 1974) (handouts and flyers inadmissible under notice of reliance).

⁵ For example, both parties submitted under notice of reliance and discussed Applicant’s trademark search report, which is not a printed publication, internet evidence, or an official record under Trademark Rule 2.122(e).

I. Entitlement to a Statutory Cause of Action

In every inter partes case, the plaintiff must establish its statutory entitlement to bring an opposition or cancellation proceeding. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at 7-8.

Opposer has properly made its pleaded registrations of record by submitting copies from the USPTO Trademark Status and Document Retrieval (TSDR) electronic database with its notice of opposition and also submitting these registrations under its notice of reliance. Trademark Rule 2.122(d)(1)-(d)(2), 37 C.F.R. §§ 2.122(d)(1)-(d)(2). The TSDR printouts were generated on June 24, 2020, which is reasonably contemporaneous to the filing date of the notice of opposition (September 8, 2020). *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Prods. of Haw., Inc.*, 204 USPQ 144, 146 (TTAB 1979) (status and title copy of pleaded registration mailed by USPTO on January 12, 1977 was reasonably contemporaneous with the notice of opposition filed on March 14, 1977).

The pleaded registrations establish Opposer's direct commercial interest and real interest in the proceeding and its reasonable belief in likely damage. *See Herbko Int'l*

v. Kappa Books, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (“In most settings, a direct commercial interest satisfies the ‘real interest’ test”); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *Shenzhen IVPS Tech. Co.*, 2022 USPQ2d 1035, at *13-14 (TTAB 2022) (valid and subsisting pleaded registration establishes opposer’s direct commercial interest in the proceeding and its belief in damage) (citing *Cunningham*, 55 USPQ2d at 1844).

Therefore, Opposer has shown its statutory entitlement to a cause of action and hence, its entitlement to oppose registration of Applicant’s application. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Cunningham*, 55 USPQ2d at 1844; *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition); *Barbara’s Bakery v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (opposer’s entitlement to opposition established by pleaded registration being of record and non-frivolous likelihood of confusion claim).

III. Priority

Applicant has not counterclaimed to cancel Opposer’s pleaded registrations. Because Opposer has made its pleaded registrations of record and shown they are valid and subsisting, priority is not an issue in this case as to the marks and goods and services recited in these pleaded registrations. *King Candy, Inc. v. Eunice King’s*

Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In addition, Applicant has admitted Opposer's priority. See Plaintiff's notice of reliance, exhibit 13, and Applicant's supplemental responses to first requests for admissions nos. 1-7, 17 TTABVUE 57-59.

IV. Likelihood of Confusion

We now turn our attention to the likelihood of confusion analysis. We consider Opposer's pleaded registered marks vis-à-vis the mark in the involved application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the 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). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities 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."). We discuss the *DuPont* factors for which there is relevant argument and evidence. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed.

Cir. 2019) (the Board considers each *DuPont* factor for which there is evidence and argument).

In our analysis we will focus on Opposer's standard character Principal Register marks LITTLE FREE LIBRARY for Class 20: "wooden boxes with a storage area for books"⁶ and LITTLE FREE LIBRARY (Section 2(f)) for Class 35: "Providing a website to promote book exchanges for others"⁷ which we find most relevant and are the marks and the goods and services Opposer has focused on in its brief.⁸ If we find a likelihood of confusion as to these marks and the goods and services, we need not find it as to the others; conversely, if we do not find a likelihood of confusion as to these

⁶ Registration No. 6032304, issued April 14 2020.

⁷ Registration No. 4423846 issued October 29, 2013, Section 8 accepted, and Section 15 acknowledged.

⁸ We acknowledge Applicant's arguments concerning other pleaded registrations. For example, Applicant notes in its brief that "LFL has admitted that there is no connection or relationship between LFL's signs, rubber stamps, or guest books, and the goods that Little Legacy offers or intends to offer." Defendant's brief, 32 TTABVUE 23, referencing Defendant's notice of reliance, exhibit 21, discovery deposition of Greig Metzger, 26 TTABVUE 126, and Plaintiff's brief, 29 TTABVUE 25-27. Applicant also references Opposer's Section 2(f) Registration No. 4423845 for "Construction of signage and cabinetry" in connection with its arguments directed to conceptual weakness of the LITTLE FREE LIBRARY standard character marks. Defendant's brief, 32 TTABVUE 10-12. We construe Applicant's arguments as to the descriptiveness of the terms for this registration covering "construction of signage and cabinetry" to be directed to Opposer's amendment during prosecution to Section 2(f) subsequent to the Examining Attorney's Section 2(e)(1) refusal. Applicant argues that Opposer is bound by prior statements made in this application and that its rights were only to "the combination of the terms 'LITTLE FREE LIBRARY' not the individual words themselves." Defendant's brief, 32 TTABVUE 32. Applicant also makes brief mention of this mark in connection with the relatedness of Applicant's goods stating the "issues are whether (1) LFL's "wooden boxes with a storage area for books" and/or "construction of signage and cabinetry" are related to Little Legacy's "books, coloring books, and workbooks for children ..." Defendant's brief, 32 TTABVUE 23. Nonetheless, because we find the most relevant pleaded registrations are Registration Nos. 6032304 and 4423846, these arguments have little persuasive value.

marks, we would not find it as to the others. *See Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015) (focusing on “the most relevant of Opposer’s pleaded registrations” for the *DuPont* analysis, and noting that “if we find a likelihood of confusion as to this pleaded registration, we need not find it as to the others. On the other hand, if we don’t reach that conclusion, we would not find it as to the other pleaded registrations either.”); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010) (same).

A. Fifth and Sixth *DuPont* Factors

Under the fifth and sixth *DuPont* factors, “fame of the prior mark (sales, advertising, length of use)” and “the number and nature of similar marks in use on similar goods [or services],” we consider the extent of commercial strength or weakness in the marketplace. *DuPont*, 177 USPQ at 567.

The fifth *DuPont* factor (“fame”) examines the extent to which the public perceives the mark as indicating a single source of origin. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 22 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source). Conversely, the sixth *DuPont* factor, (“the number and nature of similar marks in use on similar goods”) mitigates against a mark’s potential recognition by considering whether, because of widespread third-party use of similar marks in the marketplace, “customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Additionally, in determining the strength of a mark, we consider inherent strength, based on the nature of the mark itself. *New Era Cap. Co.* 2020 USPQ2d 10596, at *10; *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011).

Word marks registered without a claim of acquired distinctiveness are “held to be inherently distinctive.” *See generally, Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (word marks that are arbitrary, fanciful, or suggestive are “held to be inherently distinctive.”); *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”). On the other hand, a mark that registers under Section 2(f) is a concession that the mark is not inherently distinctive. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044-45 (Fed. Cir. 2018) (“At the outset, because TCCC seeks registration of its ZERO-containing marks under Section 2(f) of the Lanham Act, TCCC has conceded that ZERO is not *inherently* distinctive in association with the genus of goods at issue—soft drinks, energy drinks, and sports drinks.”) (emphasis in original).

1. Conceptual Strength

Opposer's LITTLE FREE LIBRARY mark for "wooden boxes with a storage area for books" registered on the Principal Register without a claim of acquired distinctiveness, and is inherently distinctive, while its LITTLE FREE LIBRARY mark for "providing a website to promote book exchanges for others" registered with a claim of acquired distinctiveness.

Opposer argues that its marks are conceptually strong. Plaintiff's brief, 29 TTABVUE 30. Applicant, on the other hand, submits that LITTLE FREE LIBRARY is not a strong mark conceptually and that there are hundreds of marks that contain the terms "little" and "library," that relate to products and services for children, education, and books. Defendant's brief, 32 TTABVUE 31. In support of this argument, Applicant references its commercial trademark search report's list of third-party registrations that it submitted under notice of reliance. Defendant's brief, 32 TTABVUE 31; Defendant's notice of reliance, exhibit 31, 26 TTABVUE 296-752; Plaintiff's notice of reliance, exhibit 167, 18 TTABVUE 63-81.

Third-party registrations "may bear on conceptual weakness [of a term in the relevant industry] if a term is commonly registered for similar goods or services." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017). However, the mere mention of third-party registrations in a search report does not make such registrations of record.⁹ See TBMP § 704.03(b)(1)(B) ("[A] party may not

⁹ Applicant has objected to the search report as hearsay for purposes of similarity of the marks. Defendant's brief 32 TTABVUE 21. We find this objection moot, because, as indicated, the third-party registrations are not of record and cannot be considered.

make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned”). *See also In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (search reports are not “credible evidence of the existence of the applications and/or registrations listed in such reports”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (“[T]he Board will not consider copies of a search report or information taken from a private company’s data base as credible evidence of the existence of the registrations listed therein.”) (citing *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983)).

In any event, Applicant has not identified any active third-party LITTLE FREE LIBRARY registrations or any three-word registrations that follow the naming convention “LITTLE [fill in the blank] LIBRARY” in connection with wooden storage boxes for books and related goods to show conceptual weakness of the inherently distinctive LITTLE FREE LIBRARY mark in Class 20. As to the LITTLE FREE LIBRARY mark for promoting book exchanges in Class 35, this mark is conceptually weak when used in connection with these services, as evidenced by its registration pursuant to a claim of acquired distinctiveness under Section 2(f). *See Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *17 (TTAB 2020) (Brooklyn Brewery marks registered under a claim of acquired distinctiveness “are inherently weak.”), *dismissed in part, aff’d in part, vacated in part, and remanded*, 17 F.4th 129 (Fed. Cir. 2021).

2. Fame

The fifth *DuPont* factor (fame) examines the extent to which the public perceives the mark as indicating a single source of origin. *DuPont*, 177 USPQ at 567. A famous or commercially strong mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Top Tobacco*, 101 USPQ2d at 1172 (Fame or commercial strength is “based on the marketplace recognition value of the mark.”). “Fame of an opposer’s mark, if it exists, plays a ‘dominant role in the process of balancing the *DuPont* factors.’” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Famous marks enjoy a “wide latitude of legal protection since they are more likely to be remembered and associated in the public mind than weaker marks.” *Palm Bay Imps.* 73 USPQ2d at 1694.

Fame, in the likelihood of confusion context, “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards*, 22 USPQ2d at 1734. In view of the extreme deference that is accorded 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, it is the duty of the party asserting that its mark is famous to prove it clearly. *N. Face Apparel Corp. v. Sanyang Indus. Co. Ltd.*, 116 USPQ2d 1217, 1226 (TTAB 2015).

Fame, or commercial strength, for likelihood of confusion purposes may be measured indirectly by, for example, “the volume of sales and advertising expenditures of the goods sold under the mark” “and other factors such as length of time of use of the mark; wide-spread critical assessments; notice by independent

sources of the products identified by the marks; and the general reputation of the products and services.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

Opposer argues that its LITTLE FREE LIBRARY mark is commercially strong. Opposer points to its use of the mark for more than ten years. Plaintiff’s brief, 29 TTABVUE 30; Metzger declaration, paragraph 10, 21 TTABVUE 5. Opposer’s witness testified that the first official book sharing box was placed in 2010 on a Hudson, Wisconsin bike path and that more than “4,000 Little Free Library book-sharing boxes [were] in place by the end of 2012.” Metzger declaration, paragraph 8, 10, 21 TTABVUE 4-5. As of 2020, there are “100,000 registered libraries in more than 100 countries worldwide, with 42 million books shared annually.” Metzger declaration, paragraph 8, 21 TTABVUE 4-5.

Opposer also references its revenue, submitted confidentially, which has “grown by double digits while its marketing expenses relative to its revenue growth remained constant or decreased.” Plaintiff’s brief, 29 TTABVUE 30; Metzger declaration, paragraph 17, 21 TTABVUE 8; confidential Metzger declaration, 20 TTABVUE. Opposer’s advertising and marketing includes Google paid search, ad buys on Instagram and Facebook, social media content and creation, website content and blogposts, direct mail and email marketing, publisher partnerships, and trade show and convention attendance. Metzger declaration, paragraph 20, 21 TTABVUE 10-15. Opposer points to receiving, since 2011, and “every year since then” “significant third-

party publicity of the LITTLE FREE LIBRARY mark for ‘wooden boxes with a storage area for books’” from “the nation’s top media outlets” such as *The New York Times*, *The Washington Post*, *The Los Angeles Times*, *USA Today*, *The Chicago Tribune*, *The Huffington Post*, *NBC Nightly News*, and *CBS Evening News*. Metzger declaration, paragraph 15, 21 TTABVUE 7; Plaintiff’s notice of reliance, exhibits 78-134, 17 TTABVUE 602-851; Plaintiff’s brief, 29 TTABVUE 30.

In this regard, we note that some of the evidence of media coverage submitted is undated (and only shows website print dates of 2013) and some of the dates in the news stories are not discernible because the printouts are somewhat illegible or the date, title, and content are blocked by a digital subscription popup. In addition, the vast majority of the stories provided appear to be published in 2012 and 2013, with what appears to be one article each provided for the years 2011, 2014, 2015, and 2017, and six articles for the year 2020. Metzger declaration, paragraph 15, 21 TTABVUE 7; Plaintiff’s notice of reliance, exhibit 78, 123-124, 127-129, 131-135.

Opposer also references its “social media presence” and followers in support of fame. Plaintiff’s brief, 29 TTABVUE 31; Metzger declaration, paragraph 21, 21 TTABVUE 15. Opposer’s social media following for its various social media accounts is as follows: Facebook: 237,994 followers (and 222,102 “Likes”); Instagram: 133,000 followers; Twitter: 31,700 followers. Metzger declaration, paragraph 21, 21 TTABVUE 15. Opposer has won awards for its book sharing programs that promote literacy: Innovations in Reading Prize from the National Book Foundation, the Library of Congress Literacy Award, Library Journal’s Movers and Shakers Award,

Women's National Book Association's Second Century Prize and Force for Positive Change Award, and the World Literacy Foundation's 2020 World Literacy Award. Metzger declaration, paragraph 16, 21 TTABVUE 7.

Applicant argues that the LITTLE FREE LIBRARY marks lack the commercial strength required to entitle them to a broad scope of protection and that "the evidence falls well short of what is required to demonstrate fame" or commercial strength. Defendant's brief, 32 TTABVUE 33. Applicant submits that Opposer's strength is "moderate" and not entitled to a "broad sphere of protection." Defendant's brief, 32 TTABVUE 33-34.

Upon consideration of Opposer's evidence, we find that Opposer has established a degree of commercial strength in the LITTLE FREE LIBRARY mark within the "wooden boxes with a storage area for books" market, but the mark is not so commercially strong that it falls on the very strong end of the spectrum for purposes of the likelihood of confusion analysis. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611 at *8, 11 (TTAB 2020) (although Opposer's mark was found to have a moderate degree of commercial strength, the mark was "not entitled to such a broad scope of protection that it bars registration of every mark containing the wording 'SOCK' or even 'SOCK IT' for use on socks").

3. Marketplace Evidence

Applicant argues that "there are numerous companies that not only use 'little' or 'library' but use the naming convention 'little [fill-in-the blank] library same or different middle term.'" Defendant's brief, 32 TTABVUE 31. To support this

argument, Applicant submitted evidence of third-party use.¹⁰ Such “[u]se evidence may reflect commercial weakness.” *Tao Licensing, LLC*, 125 USPQ2d at 1057. The third-party uses are as follows:

Mark or Trade Name	Goods/Services
Little Business Library	Website Listing of Businesses
Little Black Library	Nature of Goods/Services unknown
Little Learning Library	Child related educational learning tools
Little Red Wagon Library	Mobile Library
Little Seed Library	Seed Exchange
Little-Type-Library	Software
Little Traveling Library	Mobile Library
Little Leather Library Series Collection	Collection of Miniature Leather Books
Little Lulu Library	Set of Reprinted Comic Books
The Little Music Library	Book Title
Little Plant Library: Old Roses	Book Title
Little Red’s Library	Online Classes, subject unclear
Little Learning Library	Collection of Books, Hungry Caterpillar
Little Art Library	Instagram page sharing art history distilled from a collection of art books

¹⁰ The internet webpage exhibits do not include a date of access. However, Opposer did not object and discussed these exhibits. Therefore, this procedural shortcoming has been waived for purposes of admissibility and the exhibits stipulated thereto. *Shenzhen IVPS Tech. Co.*, 2022 USPQ2d 1035, at *20 n.26; *Calypso Tech.*, 100 USPQ2d at 1216.

Opposer argues that “[n]one of the 14 Web pages offered by Applicant contain any other evidence concerning the exposure of the website to any consumers, let alone the consumers relevant to this case.” Plaintiff’s brief, 29 TTABVUE 32. However, the Federal Circuit has stated that evidence of “use and registrations is ‘powerful on its face, even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). Opposer also argues that some of the uses provided by Applicant are single book titles, software, a seed exchange, and that one example is from the United Kingdom. Plaintiff’s brief, 29 TTABVUE 32; Defendant’s notice of reliance, exhibits 7-20, 26 TTABVUE 81-108.

As Opposer has pointed out, many of these uses (seed exchange, online classes, learning tools, business listing, computer software) are unrelated to Opposer’s goods or services, or relate to a title of a single work, and for at least one use, the nature of the goods or services is unknown. Therefore, these particular uses are not probative. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (“[T]he controlling inquiry [under the sixth *DuPont* factor] is the extent of third-party marks in use on ‘similar’ goods or services.”).

As to the remainder, we find that there are five probative third-party uses involving library services and book collections. The third-party use evidence here “reflects a more modest amount of evidence than that found convincing where a more considerable number of third-party uses were shown.” *See Jack Wolfskin*, 116

USPQ2d 1136; and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1673 n.1, 1674 (Fed. Cir. 2015). *But see Brooklyn Brewery Corp.* 2020 USPQ2d 10914, at *17 (six local Brooklyn-formative named establishments' use of the term "Brooklyn" in connection with beer sales have significant probative value as to commercial weakness). As a result, we find that Applicant has not established that the cited mark is commercially weak in connection with Opposer's goods and services.

Upon consideration of these factors as previously discussed, we find Opposer's marks to be entitled neither to an enhanced nor a diminished scope of protection. *See Brooklyn Brewery Corp.*, 2020 USPQ2d 10914, at *18 (citing *Palm Bay Imps.*, 73 USPQ2d at 1694).

B. First *DuPont* Factor

As to the first *DuPont* factor, "similarity or dissimilarity of the marks," we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) quoting *DuPont*, 177 USPQ at 567. *See also Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, (Fed. Cir. Sept. 13, 2019).

"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) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer argues the parties’ marks are similar in appearance and share the distinctive “little [fill-in-the-blank] library” naming convention. Plaintiff’s brief, 29 TTABVUE 23; Plaintiff’s reply brief, 33 TTABVUE 13. Applicant, on the other hand, argues that greater weight should be given to the undeniably dissimilar “critical terms” “legacy and free” given “the descriptive nature of the terms “little” and “library.” Defendant’s brief, 32 TTABVUE 19.

Applicant’s mark is LITTLE LEGACY LIBRARY and Opposer’s mark is LITTLE FREE LIBRARY. The marks have obvious similarities in sound and appearance. Both consist of three words and begin with the identical word LITTLE and end with the identical word LIBRARY. They obviously differ to the extent that the middle word in Applicant’s mark is LEGACY while and the middle word in Opposer’s mark is FREE.

As to connotation, both Opposer and Applicant provided definitions of “legacy,” and Applicant provided a definition of “free.” Plaintiff’s notice of reliance, 17 TTABVUE 421-25 (MERRIAM-WEBSTER DICTIONARY); Defendant’s notice of reliance, exhibits 22- 23, 26 TTABVUE 184-197 (RANDOM HOUSE UNABRIDGED DICTIONARY and MERRIAM-WEBSTER DICTIONARY). “Legacy” is defined as “: something that happened

in the past or that comes from someone in the past.” “Free” is defined as “without charge” (informal). The third-party use evidence submitted by Applicant shows that “library” can be used in connection with a physical library as a space for books, but “library” is also used in connection with a collection of books offered together. Defendant’s notice of reliance, exhibits 7-20, 26 TTABVUE 81-108.

According to Opposer’s witness, “free” suggests an “association with freedom of expression, a feeling of access and positivity, and that it attracts attention and participation at no cost,” while “legacy” connotes a line extension – possibly to historical books, or to include books whose titles are intentional homages to well-known historical titles.” Metzger declaration, paragraphs 9 and 27, 21 TTABVUE 5, 17. Opposer also argues that LEGACY in Applicant’s mark could refer to Opposer’s tribute boxes which are offered to honor a loved one, reiterating that consumers may view Applicant’s mark as a line extension. Plaintiff’s brief, 29 TTABVUE 24; Plaintiff’s reply brief, 33 TTABVUE 14.

Although Opposer acknowledges that “[t]he terms “legacy” and “free” have different meanings, it argues that the LITTLE LEGACY LIBRARY and LITTLE FREE LIBRARY marks “do not have very different meanings.” Plaintiff’s brief, 29 TTABVUE 23. Opposer submits that LEGACY in Applicant’s mark could refer to Andrew Carnegie and his mission related to public libraries and Opposer’s mission of promoting free public books. Plaintiff’s brief, 29 TTABVUE 24. Opposer also argues that LIBRARY in Applicant’s mark can mean a collection of books that are held in

one of Opposer's sharing boxes, and not just a collection of books alone, resulting in similar connotations of the parties' marks. Plaintiff's reply brief, 33 TTABVUE 14.

Applicant, for its part, argues that Opposer and Applicant "use 'little' and 'library' differently." Defendant's brief, 32 TTABVUE 20. Applicant submits that Opposer "uses 'little' to mean small in size and 'library' to be a place where books are stored" while Applicant uses "'little' to suggest children, and 'library' to suggest a collection of books." Defendant's brief, 32 TTABVUE 20. Applicant also points out the different meanings for the terms "free" and "legacy" which creates dissimilarity. Defendant's brief, 32 TTABVUE 19, 21. Applicant's witness Mr. Bratz stated that he "understand[s] the term "'legacy' to relate to something passed down—be it money or something less tangible like life philosophies. ... [and] 'free' to mean without cost." Bratz declaration, paragraph 39, 25 TTABVUE 6. Mr. Bratz stated "'Little Legacy Library' suggests entrepreneurial and success-oriented philosophies ('legacies') in the form of a collection or series of children's books" while "'Little Free Library' describes exactly what it is: a small box where people can get books without paying for them." Bratz declaration, paragraphs 40-41, 25 TTABVUE 6.

Applicant submits that the use of the common words "little" and "library" do not create similarity between the parties' marks. Defendant's brief, 32 TTABVUE 21. Applicant argues that Opposer has put no evidence in the record showing consumers associate Andrew Carnegie with Opposer, and the only reference to Andrew Carnegie was on an "old version of Opposer's website." Defendant's brief, 32 TTABVUE 20. Applicant also argues that there is no evidence to support Opposer's position that a

consumer would believe that Applicant's goods are a line extension. Defendant's brief, 32 TTABVUE 21.

As indicated, in our analysis, we do not place the marks side-by-side but consider how they are encountered in the marketplace. *See ECI Div. of E-Sys., Inc. v. Env't Commc'ns. Inc.*, 207 USPQ 443, 450 (TTAB 1980) ("confusion must be based upon whether the subsequently used mark stimulates or triggers a recollection of a mark previously exposed to in a related or associated marketing situation, remembering that this recollection is often hazy and imperfect"). We find that Applicant's LITTLE LEGACY LIBRARY mark may trigger a general or overall recollection by the consumer of Opposer's LITTLE FREE LIBRARY mark. Although the meaning of the middle term ("legacy" and "free") in each of the marks differ, we find the marks are sufficiently similar overall in appearance, sound, and commercial impression due to the common first and last terms. Even if consumers note and remember the different middle words in Applicant's and Opposer's marks, they are not likely to ascribe the differences between the marks to differences in the source of the respective goods or services.

In addition, as Opposer points out, consumers may likely assume that LITTLE LEGACY LIBRARY is a variant mark which identifies goods and services that emanate from the same source as those of Opposer. *See NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964, 1968 (TTAB 1987) (purchasers familiar with NUTRASWEET product, upon viewing NUTRA SALT, would be likely to believe it was a new product line put out by the NUTRASWEET producer or that the product

was somehow associated with or sponsored by the people producing the NUTRASWEET product); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.”).

We find the marks as a whole are more similar than dissimilar. This *DuPont* factor favors a finding of a likelihood of confusion.

C. Second *DuPont* Factor

The second *DuPont* factor considers “the similarity or dissimilarity and nature of the goods or services as described in an application or registrations.” *DuPont*, 177 USPQ at 567.

Applicant’s Class 16 goods are books, coloring books, and workbooks for children in fields of personal development, success, achievement, entrepreneurship, and fiscal responsibility. Opposer’s goods for its Class 20 registration are wooden boxes with a storage area for books.

Opposer’s witness testified that Opposer’s “book-sharing boxes and books of all kinds – including potentially Applicant’s books – are goods that are used together.” Metzger declaration, paragraph 28, 21 TTABVUE 17-18. Mr. Metzger stated that “consumers are able to purchase both books and a book-sharing box from Little Free Library’s website.” Metzger declaration, paragraph 28, 21 TTABVUE 17-18. Opposer

also promotes and sells special book-sharing boxes such as “the Legacy memorial book-sharing boxes.” Metzger declaration, paragraph 19, 21 TTABVUE 9.

Opposer allows its library stewards, who are individuals who purchase a charter sign for their library and register with Opposer, to order free books, with specification as to type such as to “receive only children’s books.” Metzger declaration, paragraph 11, 21 TTABVUE 7. Opposer’s witness indicated that in 2014, there was “an upward trend in financial literacy books appearing in the book-sharing boxes.” Metzger declaration, paragraph 14, 21 TTABVUE 7. Opposer participates in giveaways tied to book box library installation, and monthly publisher book giveaways, including a Scholastic book giveaway. Metzger declaration, paragraph 21, 21 TTABVUE 10-15.

Opposer’s witness stated that

Little Free Library encourages its Stewards to partner with local schools, and Little Free Library has partnered with distributors of children’s books, such as Interstate Books4School and Valu-Book collection, that include books for infants through 12th grade. Little Free Library also sells a Scholastic book bundle for grades Kindergarten through Second Grade. These book resources are available on the Little Free Library website, www.littlefreelibrary.org, along with the plans to build or purchase a book-sharing box. Little Free Library also developed a ‘Cops and Kids’ program that involved local police officers bringing and reading books to children in their local communities.

Metzger declaration, paragraph 13, 21 TTABVUE 6-7.

Opposer’s notice of reliance includes a webpage from its website offering items for purchase: “choose from a variety of handcrafted Library models” and providing “deeply discounted books and giveaways for stewards and fans.” The website shows the book storage box with books placed inside.



Plaintiff's notice of reliance, exhibit 155, 18 TTABVUE 15.

Opposer argues that “books, including the titles published or planned for publication by Applicant, are complementary and related” to its book-sharing boxes. Plaintiff's brief, 32 TTABVUE 27. Opposer argues that “regardless of who published the books, books, including Applicant's books, are related to [Opposer's] book sharing boxes.” Plaintiff's reply brief, 33 TTABVUE 17.

Applicant, on the other hand, argues that Opposer's assertion that the goods are complementary is “without legal or factual support.” Defendant's brief, 32 TTABVUE 24. Applicant argues that any books offered by Opposer are from third-parties and consumers are not likely to think the source of the book sharing boxes are the source of the books themselves. Defendant's brief, 32 TTABVUE 25.

“Evidence of complementary use may be given more or less weight depending on the nature of the goods, but this evidence may not be ignored. The extent to which particular [] products are deemed related will depend on the facts of each individual case.” *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289,

1290 (Fed. Cir. 1984) (bread and cheese are complementary products, often used in combination). A complementary relationship may be found even in the absence of evidence by the identifications themselves. *See Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *12 (TTAB 2019), appeal dismissed, No. 20-1068 (Fed. Cir. Nov. 13, 2019).

Opposer's identification for its Class 20 registration indicates the purpose of the storage boxes is for books, evidencing the relationship between Opposer's and Applicant's books, workbooks, and coloring books. In addition, Opposer's witness testimony, corroborated by its website, indicates that books are offered to "stewards" in connection with the purchase and registration of book storage boxes and that books are available for sale on the website along with the book storage boxes. Opposer's witness testified that "the functionality of a Little Free Library is directly connected to books being present and being exchanged through that box." Defendant's notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 124.

We find the identifications of goods themselves together with the testimony and evidence sufficient to show that Opposer's and Applicant's goods are complementary as they may be used together; Applicant's goods could be purchased or donated for use in Opposer's book boxes by consumers who purchase or use Opposer's book boxes.¹¹ *See e.g., In re Sela Prods., LLC*, 107 USPQ2d 1580, 1587 (TTAB 2013) (surge

¹¹ Applicant argues that there is no evidence that its goods are actually found in Opposer's book storage boxes, but such evidence is not required. Probative evidence includes evidence showing the same type of goods — books — are offered to or used by consumers of book storage boxes. *See e.g., In re Decombe*, 9 USPQ2d 1812, 1815 (TTAB 1988) (as evidence of complementary use, the Examining Attorney offered information from, for example, a news story, that fresh fruits and cookies (the type of goods at issue) are served together as desserts;

protectors, wall mounts and brackets complementary goods because purchasers are likely to encounter both during course of purchasing a television, audio or home theater system); *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 511 (TTAB 1984) (finding bath sponges and personal products such as bath oil and soap to be closely related because they are complementary goods that are likely to be purchased and used together by the same purchasers); *Sponge and Chamois Inst. v. Curtiss-Wright Corp.*, 120 USPQ 309, 310 (TTAB 1959) (chamois and sponge products are complementary products marketed side by side and closely related).

Turning to the parties' services, Applicant's services are classes, seminars, workshops, bootcamps, and podcasts for children in fields of personal development, success, achievement, entrepreneurship, and fiscal responsibility, while Opposer's Class 35 services are providing a website to promote book exchanges for others.

Opposer argues that there are many instances in "which a single trademark is used in connection with a website for promoting a cause and a class, seminar, workshop, bootcamp, or podcast related to the same cause. In fact, there are 143 registered marks that identify these very services in International Classes 35 and 41." Plaintiff's brief, 29 TTABVUE 27.

Applicant responds that Opposer "simply concludes without argument or evidence that a website to promote book exchanges is 'indisputably related' to classes and

In re Vienna Sausage Manufacturing Co., 230 USPQ 799, 799 (TTAB 1986) (copies of pages from certain cookbooks which contain recipes for dishes having cheese and sausage (the type of goods at issue) as principal ingredients evidenced complementary use of Applicant's sausage and the cited registration's cheese).

seminars teaching entrepreneurial principles.” Defendant’s brief, 32 TTABVUE 26. Applicant submits that the “classes it intends to offer will teach parents and children about success philosophies, personal development, and facing adversity” and contrasts that with Opposer’s “website [which] is not a class or workshop—it is a platform for selling wooden boxes, providing instructions on how to build those boxes, and listing resources on how to find the boxes.” Defendant’s brief, 32 TTABVUE 26, referencing Plaintiff’s notice of reliance, 18 TTABVUE 15-16.

As indicated, Opposer submitted third-party registrations to support relatedness of the services. Plaintiff’s notice of reliance, exhibit 15, 17 TTABVUE 66-419. Third-party registrations have probative value to the extent that they serve to suggest that such services emanate from the same source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (same).

As explained below, these third-party registrations do not convince us that the respective services are related. More particularly, some of the submitted registrations are cancelled or issued under Section 44(e) (or Section 44(e) in part) and are not probative of relatedness. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006) (expired and/or cancelled registrations generally are evidence only of the fact that the registrations issued); *In re Albert Trostel*, 29 USPQ2d at 1786 (third-party registrations which have issued under Section 44(e) of the Act ... without any use in commerce basis, have very little persuasive value). Others cover promotional services that are more in the nature of advertising or marketing services for others,

and some identify promotional services that appear to be directly connected to charitable endeavors.

The remaining third-party registrations show that businesses that promote, for example, social, medical or cultural causes often offer educational workshops, classes, and seminars in the same subject matter, or cover both promotional services and podcast services. However, none of these third-party registrations show the promotion of book exchanges, on the one hand, and the offering of personal development, success, achievement, entrepreneurship, and fiscal responsibility classes, seminars, workshops, bootcamps, and podcasts for children, on the other hand, by the same entity under the same mark.

The general point that general market categories, e.g., website promotional services and educational services in the nature of workshops, classes and seminars might be offered by the same business is not sufficient evidence of relatedness. *Cf. Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1310 (“a broad general market category is not a generally reliable test of relatedness of products”). Opposer has provided no evidence of the relatedness of its identified book exchange promotional services and Applicant’s identified personal development, success, achievement, entrepreneurship, and fiscal responsibility classes, seminars, workshops, bootcamps, and podcasts for children. Absent extrinsic evidence as to how these specific subject matter areas are related, the fact that business offer services under the same mark that fall within the general categories of website promotional services and educational services is insufficient on its face to show relatedness. *Cf. M2 Software*,

Inc. v. M2 Commc'ns. Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1947-48 (Fed. Cir. 2006) (“it was proper for the board to ground its determination of relatedness in the fields for which the goods are created, rather than the media format in which they are delivered”); *Cooper Indus., Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983) (“the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required ‘relatedness’”).

We thus find that Opposer has not established the relatedness of Opposer’s and Applicant’s services.

D. Third and Fourth *DuPont* Factors

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels,” while the fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made, i. e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

As to the classes of purchasers, Opposer identifies the purchasers of its book storage boxes as anyone with a piece of property and the users/customers of the book storage boxes as anyone who wants to read a book. Metzger declaration, paragraph 22, 21 TTABVUE 15. Opposer’s witness also stated “[p]arents are an important target class of consumers.” Metzger declaration, paragraph 22, 21 TTABVUE 16. As to its consumers, Opposer’s witness testified that

Well, you know, the customers that purchase or acquire our products are broad. In the United States, they could be corporations. They could be other nonprofit literacy organizations. They could be fraternal organizations like

Lions 16 Club, Rotary Club and – and other organizations like that ... we have customers that include the education, you know, school systems, foundations that support school systems. We have government agencies at both a – a local and county level that are our customers, parks and rec organizations within those, public safety organizations within those cities and counties. We also have, you – you know, individual just regular consumers, retail consumers that are our customers and include other – other organizations, other nonprofits that may not be necessarily in – in – in – focused on literacy, so faith community organizations buy and purchase our products and services, you know, the Boy Scouts, the Girl Scouts, you know, a wide variety of organizations that would be either engaged in trying to support community activity or to do good things within communities. The other people that are part of our – our customers, though, are not only those that buy either a Little Free Library or a charter sign or the like, but also the people that visit a Little Free Library to find a book or to explore a Little Free Library to discover a book that might be of interest to them.

Defendant's notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 127.

As to Applicant's consumers, Applicant's witness stated that "Little Legacy markets its books specifically to parents who are entrepreneurs, executives, or other white-collar professionals who want to teach their children about personal development, success philosophies, and personal finance." Bratz declaration, paragraph 26, 25 TTABVUE 5. Applicant's target consumer is children aged 4 to 7 years old. Plaintiff's notice of reliance, exhibit 177, Bratz discovery deposition, 17 TTABVUE 157.

Opposer argues that both parties target parents with elementary school age children. Plaintiff's brief, 29 TTABVUE 29. However, Applicant points out that Opposer's witness testified that "We have no specific targeted communications . . . to

parents of elementary-school children or the like” and that it markets its goods and services more generally. Defendant’s brief, 32 TTABVUE 28; Defendant’s notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 128, 132. Opposer’s witness also stated that their target consumer “is basically those people who enjoy reading books and wants to share that joy by installing a Little Free Library and sharing their love of books by providing books to others in their community.” Defendant’s notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 128. Opposer argues that Applicant’s arguments improperly attempt to narrow the relevant consumers of its goods and services as Opposer’s business model includes the exchange of books at all reading levels. Plaintiff’s reply brief, 33 TTABVUE 19.

We find some overlap of the parties’ customers. Opposer’s witness testified that its purchasers of book storage boxes could be anyone, including parents. Defendant’s notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 127. In addition, the relevant class of purchasers includes the ultimate end users, that is, the users of the book storage boxes that are installed in various locations which could also be parents and their children. *See In re Artic Elec. Co., Ltd.*, 220 USPQ 836, 837-38 (TTAB 1983) (likelihood of confusion can be found by the initial purchasers as well as the ultimate users of arcade games and coin and bill changer equipment).

As to the parties’ trade channels, inasmuch as there are no restrictions in the identifications of the goods and services in pleaded Registration Nos. 6032304 and 4423846 and the involved application, we must presume that the goods and services

move in all normal and usual channels of trade and methods of distribution for those goods and services and that they are available for purchase by all the usual purchasers. See *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Made in Nature, LLC*, 2022 USPQ2d 557, at *50 (for non-identical goods that have no limitations as to channels of trade or target purchasers in the registrations or application, it is presumed that the respective goods would move in all channels of trade normal for the parties' products, and that they are available to all usual purchasers for these goods).

Opposer sells its book storage boxes on its website, Amazon, and Etsy while Applicant sells its books on its website and Amazon. Metzger declaration, paragraph 20, 21 TTABVUE 10; Bratz declaration, paragraph 23, 25 TTABVUE 5. Opposer submitted a print-out from the Amazon website for a search of “little free library” displaying Opposer’s book storage boxes as the only result. Plaintiff’s notice of reliance, exhibit 172, 18 TTABVUE 100. Applicant’s witness stated that it conducted an Amazon search for “legacy library,” and did not see any results for Opposer’s products. Bratz declaration, paragraph 24, 25 TTABVUE 5.

Opposer argues that the parties’ trade channels overlap, pointing to Amazon, and the use by both parties of social media Facebook and Instagram accounts. Plaintiff’s brief, 29 TTABVUE 28. Opposer argues that Applicant’s Amazon search shows “only that on a particular day Applicant submitted a specific search query that returned certain results” and does not demonstrate that a consumer may not encounter Opposer’s and Applicant’s goods on Amazon. Plaintiff’s reply brief, 33 TTABVUE 18.

However, Applicant argues that selling on Amazon “says nothing as nearly every company in the world does the same thing.” Defendant’s brief, 32 TTABVUE 27. Applicant also argues that “selling and promoting goods on the internet is not sufficient overlap” of trade channels for goods. Defendant’s brief, 32 TTABVUE 27. As to the services, Applicant argues that there is no overlap between promotional services and educational services as Opposer’s promotional services involve a website “platform for selling wooden boxes, providing instructions on how to build those boxes, and listing resources on how to find the boxes.” Defendant’s brief, 32 TTABVUE 26, 27.

As to the Facebook and Instagram social media accounts used by each party, we find that overlap is not demonstrated here, as there is nothing in the record showing that purchasers for both parties’ goods or services would be directed to both Applicant’s and Opposer’s Facebook and Instagram accounts.

In addition, the fact that both parties may offer their goods for purchase on their own websites is generally not sufficient to show trade channel overlap due to the ubiquity of selling goods on the internet. *See Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 USPQ2d 1012, 1021 (TTAB. 2007) (“the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade”). As to both parties using Amazon to sell their goods, there is no evidence that the respective goods are offered in a manner that would suggest that they would be viewed by consumers seeking one or the other.

For instance, there is no evidence of record that the respective goods are retrieved by a conducting a single search query for “legacy library” or “little legacy library” or “little free library” and/or a showing that the parties’ goods are offered in close proximity on the same Amazon web page. Absent some evidence the goods are sold in close proximity, the record is insufficient to establish overlapping trade channels, because Amazon.com, similar to a department store or supermarket, sells virtually everything. *See Recot, Inc. v. Becton*, 54 USPQ2d at 1899-1900 (absent some evidence that the products are sold in close proximity to one another, the fact that the involved products are sold in supermarkets did not weigh in favor of confusion being likely). *See also Inter IKEA Sys. B.V.*, 110 USPQ2d at 1740 (rejecting opposer’s theory that “any goods or services sold through retail stores, catalogs or over the Internet move through the same channels of trade and, therefore, for all intents and purposes, all goods and services potentially move through the same channels of trade”).

As to Opposer’s services, Opposer “promotes book exchanges and literacy” on its website, (Metzger declaration, paragraph 29, 21 TTABVUE 18), and Opposer “has launched and sponsored literacy-based programs.” Metzger declaration, paragraph 19, 21 TTABVUE 10-11. As to Applicant’s educational services, Applicant’s witness stated that Applicant, who is not currently using the mark in connection with the services, “is considering offering weekend workshops and retreats for parents and their children where we would explore similar topics to the book series.” Plaintiff’s notice of reliance, Bratz discovery deposition, 18 TTABVUE 163. However, neither party’s testimony or evidence shows an inherent overlap of trade channels between

the promotion of book exchanges on a website and Applicant's educational services. *See, e.g., M2 Software, Inc.*, 78 USPQ2d at 1948 ("although both parties operate websites, that fact, without more, is insufficient to overcome the vast weight of evidence establishing that no overlap exists" as neither party submitted inherent evidence of trade channel overlap).

In sum, we find some overlap in consumers, but we find insufficient testimony and evidence of any overlap in the trade channels for the goods and services.

Under the fourth *DuPont* factor, purchaser sophistication or degree of care may tend to minimize likelihood of confusion. *Palm Bay Imps.* 73 USPQ2d at 1695. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Id.* "[T]he applicable standard of care is that of the least sophisticated consumer." *Stone Lion Cap. Partners*, 110 USPQ2d at 1163 (affirming that Board properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires consumer care for likelihood of confusion decision to be based "on the least sophisticated potential purchasers").

Opposer argues that "Applicant's book and workbooks are also sold at very low prices, or are given away free, which increases the likelihood of confusion." Plaintiff's brief, 29 TTABVUE 29. *See* Bratz declaration, paragraph 23, 25 TTABVUE 5 (books cost between \$7.95 (workbooks) and \$19.95 (books)). Applicant's witness indicates they donate books for every book sold. Bratz declaration, paragraph 31, 25 TTABVUE 5; Plaintiff's notice of reliance, exhibit 177, Bratz discovery deposition, 21 TTABVUE 168-169. Applicant's interrogatory response indicates "the hardcover books are

available for purchase at \$19.95, its paperback books are available for purchase at \$14.95 through Amazon, its Kindle books are available for purchase at \$1.99 through Amazon, and the workbook is available for purchase through its website as a printable PDF at \$7.95, or through Amazon as a printable PDF at \$9.95.” Plaintiff’s notice of reliance, Defendant’s interrogatory response no. 8, 17 TTABVUE 51. *See also* Defendant’s notice of reliance, 26 TTABVUE 216, 219, 223, 228, 233 (showing on their face Defendant’s book prices on its website and Amazon webpage).

Opposer’s witness testified that it “engages individuals to either acquire from us or build on their own a Little Free Library book exchange and – to – to promote literacy and the reading of books and sharing of books in their local communities.” Defendant’s notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 116. Opposer’s witness stated that the prices for its wooden storage boxes are between \$200 to \$400, with prices having gone up because of the cost of raw materials. Defendant’s notice of reliance, exhibit 21, Metzger discovery deposition, 26 TTABVUE 117. *See also* Amazon webpage submitted by Opposer showing on its face a \$319 dollar sales price for a wooden book storage box kit. Plaintiff’s notice of reliance, exhibit 172, 18 TTABVUE 100. Opposer witness testified that his “understanding is, in many instances, that consumers use the internet, the – our websites to understand our products and services. And so there’s research there, but I – we do not – I do not know the extent that people research options before approaching us.” Defendant’s notice of reliance, Metzger discovery deposition, 26 TTABVUE 131.

Applicant argues “there is a big price difference between LFL’s wooden book boxes—which a consumer may purchase for nearly \$400 dollars to serve as a permanent fixture on one’s property—and Little Legacy’s books—which consumers may purchase for less than \$20.” Defendant’s brief, 32 TTABVUE 29, referencing Opposer’s book storage box prices, Defendant’s notice of reliance, 26 TTABVUE 854-860, 863-866 (webpages from Opposer’s website showing on its face wooden storage box pricing), and Applicant’s book prices, Defendant’s notice of reliance, 26 TTABVUE 216, 219, 223, 228, 233 (Applicant’s webpages and Amazon webpage showing on its face Applicant’s book prices).

Applicant points out that it is “unlikely that consumers purchase LFL’s wooden boxes impulsively or on a whim as they require significant expense and continuing commitment to maintain.” Defendant’s brief, 32 TTABVUE 29, and referencing Plaintiff’s notice of reliance, 17 TTABVUE 904-911. Applicant argues that confusion is diminished due to the differences in the product and purchaser care for Opposer’s goods, even if Applicant’s goods are inexpensive. Defendant’s brief, 32 TTABVUE 29.

We find that given the costs to purchase and build the library, as well as site selection for installation, and the commitment to marketing and maintaining the library as a steward, a purchaser of Opposer’s wooden book storage boxes will exercise some degree of care, while consumers of Applicant’s less expensive books may exercise no more than ordinary care. Nonetheless, “even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue,

and therefore immune from source confusion.” *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1552 (TTAB 2012).

E. Seventh and Eighth *DuPont* Factors

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of Opposer’s and Applicant’s marks. *DuPont*, 177 USPQ at 567. The seventh and eighth *DuPont* factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *DuPont* factor, that there has been a significant opportunity for actual confusion to have occurred. *See In re Cont’l Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Under the eighth *DuPont* factor, we “look at actual market conditions, to the extent there is evidence of such conditions of record.” *See In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020).

Applicant’s witness testified that he is not aware of any confusion between the parties’ marks, and he testified that no one has every approached Applicant or inquired about Opposer’s products and services. Bratz declaration, paragraphs 34-36, 25 TTABVUE 5-6.

Opposer argues that “there is no evidence regarding the extent of Applicant’s use of the mark to gauge the absence of actual confusion in any meaningful way” and that Applicant’s services have not yet been offered. Plaintiff’s brief, 29 TTABVUE 33.

Applicant argues that there has been two years of concurrent use of the parties' goods, and this factor weighs in its favor as two years is a significant period. Defendant's brief, 32 TTABVUE 35.

We find, however, given the extent of usage of Applicant's mark and the nature of Applicant's marketing, which is limited to social media (Facebook and Instagram), its website, and targeted emails based on a database of entrepreneurs and real estate professionals from Mr. Bratz's real estate holding company, there has not been a significant opportunity for actual confusion. Plaintiff's notice of reliance, Bratz discovery deposition, 18 TTABVUE 155-156. *See Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *9 (TTAB 2019) (explaining that "for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred"). As to the services, there has been no opportunity for confusion as Applicant has not begun using the mark in connection with the identified services.

Therefore, we find these *DuPont* factors neutral.

F. Ninth *DuPont* Factor

The ninth *DuPont* factor considers the variety of goods on which a mark is or is not used. *DuPont*, 177 USPQ at 567.

Opposer argues that it uses its marks on a variety of goods and services and that this factor weighs in its favor. Plaintiff's brief, 29 TTABVUE 34. Opposer's rubber stamps, guest books, tribute plaques, wooden post and topper, dog hook, non-luminous and non-mechanical metal signs, gift cards and t-shirts, hat, and art print,

are mainly accessories or items used in conjunction with its wooden storage boxes for holding books. Defendant's notice of reliance, Metzger discovery deposition, 26 TTABVUE 118. Opposer's witness mentioned these goods in his testimony (Metzger declaration paragraph 22, 21 TTABVUE 15-16) but did not testify as to the specifics regarding such use, including, for example, how the mark is used on the goods, and the sales volume of each of these goods. Applicant points out that "many" of these goods do not bear Opposer's mark, pointing in particular to the dog hook. Defendant's brief, 32 TTABVUE 36, referencing Defendant's notice of reliance, 26 TTABVUE 855. As to its services, Opposer's witness did provide testimony about some of its other reading programs (e.g., Read in Color and Impact Library); however, none of these programs are offered under the Little Library mark. In addition, all of these programs relate to literacy, rather than specifically, the promotion of book exchanges.

In view of the above, we find this *DuPont* factor neutral. *See Devivo v. Ortiz*, 2020 USPQ2d 93614, at *15 (TTAB 2020) (Board found opposer's statement that she had used her mark on children's books, T-shirts, tank tops, sweatshirts, hoodies, coffee mugs, stickers, postcards, greeting cards, tote bags and informational and educational services coupled with minimal sales information was not sufficiently probative to establish use on a variety of goods).

G. Thirteenth *DuPont* factor

The thirteenth *DuPont* factor examines "any other established fact probative of the effect of use." *DuPont*, 177 USPQ at 567. Opposer references Applicant's prior knowledge of Opposer from the trademark search Applicant conducted as evidence of

wrongful intent. Plaintiff's brief, 29 TTABVUE 34-35. However, Applicant argues that "there is no such evidence of malintent. Indeed, the evidence is to the contrary." Defendant's brief, 32 TTABVUE 38.

Bad faith, or intent to confuse, falls under the thirteenth *DuPont* factor. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). An inference of bad faith "requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797-98 (Fed. Cir. 1987) (awareness of plaintiff's mark through trademark search and opinion of counsel that the mark was available notwithstanding Plaintiff's marks was not sufficient for an inference of bad faith). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See e.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he 'only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.'" (citation omitted)).

Thus, Applicant's mere knowledge of Opposer's marks through a trademark search is not enough to constitute bad faith. In order to demonstrate that Applicant's application was filed in bad faith, Opposer must show that Applicant intentionally sought to trade on Opposer's good will. Here, the record evidence is insufficient to support this contention.

We find the thirteenth *DuPont* factor based on bad faith adoption is neutral.

VII. Conclusion

We have considered all of the evidence and arguments pertaining to the relevant *DuPont* factors. In balancing the relevant *DuPont* factors, we conclude, as discussed above, that there is a likelihood of confusion between Applicant's mark LITTLE LEGACY LIBRARY for the identified books, coloring books, and workbooks for children in fields of personal development, success, achievement, entrepreneurship, and fiscal responsibility (Class 16) and Opposer's mark LITTLE FREE LIBRARY for wooden boxes with a storage area for books (Class 20, identified in Registration No. 6032304).

However, we find no likelihood of confusion between the marks with respect to Applicant's LITTLE LEGACY LIBRARY mark for the identified classes, seminars, workshops, bootcamps, and podcasts for children in fields of personal development, success, achievement, entrepreneurship, and fiscal responsibility (Class 41) and Opposer's mark LITTLE FREE LIBRARY for the identified wooden boxes with a storage area for books (Class 20, Registration No. 6032304) and for the identified services of providing a website to promote book exchanges for others (Class 35, Registration No. 4423846). Although the marks are similar and Opposer's mark has shown some commercial strength, the services have not been shown to be related.

Decision:

Opposition No. 91264613 is sustained on the basis of likelihood of confusion with respect to Applicant's Class 16 goods, but is dismissed as to Applicant's Class 41 services.