

TABLE OF CONTENTS

	<u>PAGE</u>
1. STATEMENT OF ISSUES	6
2. DESCRIPTION OF RECORD	6
3. RECITATION OF FACTS	7
A. The Subject Registration	7
B. Petitioner's Common Law Use of "TBC"	8
C. Notice of Cancellation	8
4. ARGUMENT	9
A. Likelihood of Confusion Analysis	9
a. Similarity in Appearance	10
b. Sound Connotation Analysis	11
c. Similarity in Meaning Analysis	12
B. Comparison of Goods	12
C. Resolution of Doubt in Favor of Senior User	13
D. False Suggestion of a Connection Analysis	14
5. SUMMARY	14

INDEX OF CASES

<u>CASES</u>	<u>PAGE(S)</u>
<i>American Speech-Language-Hearing Assn. v. National Hearing Aid Society,</i> 224 U.S.P.Q. 798 (T.T.A.B. 1984)	14
<i>Burger Chef Systems, Inc. v. Sandwich Chef, Inc.,</i> 608 F.2d 875, 203 U.S.P.Q. 733 (C.C.P.A. 1979)	10
<i>Canovas v. Venezia 80 S.R.L.,</i> 220 U.S.P.Q. 660 (T.T.A.B. 1983)	14
<i>Coca-Cola Co. v. Clay,</i> 139 U.S.P.Q. 308 (C.C.P.A. 1963), revg 133 U.S.P.Q. 606 (T.T.A.B. 1962)	6
<i>Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.,</i> 109 F.3d 1394, n.14, 42 U.S.P.Q.2d 1185, n.14 (9 th Cir. 1997)	13
<i>E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc.,</i> 393 F. Supp. 502, 185 U.S.P.Q. 597 (E.D.N.Y. 1975)	13
<i>Federated Foods, Inc. v. Fort Howard Paper Co.,</i> 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976)	9
<i>Giant Food, Inc. v. Nation's Foodservice, Inc.,</i> 218 U.S.P.Q.2d 1141, (Fed. Cir. 1987)	9
<i>Hancock v. American Steel & Wire Co. of New Jersey,</i> 97 U.S.P.Q. 330 (C.C.P.A. 1953), affg 91 U.S.P.Q. 350 (Comr 1951)	9
<i>In re Albert Trostel & Sons Co.,</i> 29 U.S.P.Q.2d 1783 (TTAB 1993)	13

<i>In re E.I. duPont de Nemours & Co.,</i> 177 U.S.P.Q. 563 (C.C.P.A. 1973)	9
<i>In re Logue,</i> 188 U.S.P.Q. 695 (T.T.A.B. 1975)	12
<i>In re Mango Records,</i> 189 U.S.P.Q. 126 (T.T.A.B. 1975)	10
<i>In re National Data Corp.,</i> 753 F.2d. 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)	10
<i>L. Leichner (London) Ltd. v. Robbins,</i> 189 U.S.P.Q. 254 (T.T.A.B. 1975)	9, 12
<i>Molenaar, Inc. v. Happy Toys, Inc.,</i> 188 U.S.P.Q. 469 (T.T.A.B. 1975)	9
<i>MRI Systems Corp. v. Wesley-Jessen Inc.,</i> 189 U.S.P.Q. 214 (T.T.A.B. 1975)	12
<i>Presto Products, Inc. v. Nice-Pak Products, Inc.,</i> 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988)	11
<i>SMS, Inc. v. Byn-Mar, Inc.,</i> 228 U.S.P.Q. 219 (T.T.A.B. 1985)	10
<i>Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.A.,</i> 222U.S.P.Q. 512 (T.T.A.B. 1984)	14
<i>Tektronix, Inc. v. Daktronics, Inc.,</i> 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976)	10

Telechron, Inc. v. Telicon Corp.,
198 F.2d 903, 909, 94 U.S.P.Q. 363 (3d Cir. 1952) 13

*United States Olympic Committee v. Olymp-Herrenwasche-fabriken Bezner
GmbH & Co.*,
223 U.S.P.Q. 154 (T.T.A.B. 1984) 14

STATUTES

15 U.S.C. § 1052 (a) 8

15 U.S.C. § 1052 (d) 8

1. **STATEMENT OF ISSUES**

The central legal issue is whether there is a likelihood of confusion of Registrant's "TBC HERRINGTON'S TEDDY BEAR CLUB" and design vis-a-vis Petitioner's common law mark "TBC". The test which must be applied by the Board in determining the rights of parties under section 2(d) is likelihood of confusion, mistake or deception. *Coca-Cola Co. v. Clay*, 324 F.2d 198, 139 U.S.P.Q. 308 (C.C.P.A. 1963), revg 133 U.S.P.Q. 606 (T.T.A.B. 1962). The presence of likelihood of confusion is determined by considering, inter alia, the similarity of the parties' marks and the relationship between involved goods or services. Given Petitioner's submitted evidentiary publications and submitted declaration, Petitioner submits that there is high likelihood of confusion between Registrant's mark and Petitioner's mark.

In addition, at issue in this case is whether Registrant's mark creates a false suggestion of a connection between the Registrant and the Petitioner. Given Petitioner's evidentiary publications and submitted declaration and Registrant mark's close proximation to petitioner's name and identity, Petitioner submits that use of Registrant's mark creates a false connection between Registrant and Petitioner.

2. **DESCRIPTION OF RECORD**

Registrant filed for a federal trademark application for "TBC HERRINGTON'S TEDDY BEAR CLUB" and design on June 14, 1999. Registrant was granted a registration on August 1, 2000, for goods in international class 028 for toys, namely, plush toys, stuffed toys, stuffed animals, and play figures. Prosecution history shows a first use date of October 1997 for the

mark.

On June 26, 2001, Petitioner instituted the instant cancellation proceeding against Registrant. Petitioner's complaint alleges a likelihood of confusion claim and a false suggestion of a connection claim. No discovery was conducted by either party in the instant inter partes proceeding.

On April 22, 2002, Petitioner filed a Notice of Reliance with the Trademark Trial and Appeal Board. The Notice of Reliance included a Declaration by an employee of Petitioner attesting to the Petitioner's common law rights to the mark "TBC". In addition, the Notice of Reliance also included publications of Petitioner's common law usage of the "TBC" mark with a copyright notice as to the dates of the mark's usage.

3. RECITATION OF FACTS

The Subject Registration

Registrant, Herrington & Company is in the business of merchandising teddy bears and is the owner of the mark being scrutinized in the instant cancellation proceeding. Registrant applied for the federal registration of the mark "TBC HERRINGTON'S TEDDY BEAR CLUB" on June 14, 1999. During the course of prosecution, Registrant disclaimed any exclusive rights to "TEDDY BEAR". Prosecution history shows that the mark has a first use date of October 1997. Registrant was granted a registration on August 1, 2000 for goods in international class 28 for stuffed toys, stuffed animals, and play figures.

Petitioner's Common Law Use of "TBC"

Since its inception in 1979, Petitioner, The Boyds Collection Ltd., has been in the business of creating, producing, and marketing teddy bears. During this period of over twenty years, Petitioner has made substantial monetary investments in building and preserving its goodwill.

Petitioner has taken steps building and protecting its goodwill by procuring federal trademark registrations to its name, "THE BOYDS COLLECTION". In addition to its federal trademarks, Petitioner uses "TBC" as a shorthand notation to signify *The Boyds Collection* to consumers. As can be noted from Petitioner's submitted specimens, from at least 1990 to the present day, Petitioner has used "TBC" as a source indication trademark on its product tags. Petitioner's continues to use "TBC" as to indicate the source of its goods to consumers. An example of such usage is as follows:

"© TBC 1990"

As such, TBC continues to be a symbol of the goodwill associated with "The Boyds Collection". Furthermore, it is obvious from the submitted evidence that "TBC" is an acronym for "The Boyds Collection".

Notice of Cancellation

The Notice of Cancellation sets forth a two claims: that Registrant's mark "TBC HERRINGTON'S TEDDY BEAR CLUB" is likely to cause confusion with Petitioner's claimed trademarks associated with collectibles in violation of 15 U.S.C. § 1052(d), hereafter Lanham Act § 2(d). In addition, Petitioner's Complaint also alleges Registrant's mark creates a false

suggestion of a connection between Petitioner and Registrant in violation of 15 U.S.C. § 1052(a), hereafter Lanham Act § 2(a).

4. ARGUMENT

In proving a likelihood of consumer confusion claim under the Lanham Act § 2(d), proof of actual confusion is not necessary. Actual confusion is very seldom proven in Board proceedings and it is recognized that the applicable test is a likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 U.S.P.Q.2d 1141, (Fed. Cir. 1987).

Likelihood of Confusion Analysis

In re E.I. duPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973), lists thirteen factors for a likelihood of confusion analysis. Of these factors, there are two key factors in a Lanham Act § 2(d) analysis: the similarity of the marks, and the similarity of the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976).

In conducting a likelihood of confusion analysis, the marks themselves are first examined for similarity in appearance, sound connotation and commercial impression. *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. 469 (T.T.A.B. 1975); *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 U.S.P.Q. 330 (C.C.P.A. 1953), affg 91 U.S.P.Q. 350 (Comr 1951). In the instant proceeding, Petitioner's word mark "TBC HERRINGTON'S TEDDY BEAR CLUB" is compared to Petitioner's "TBC". Similarity in any one the elements of sound, appearance or meaning may be sufficient, depending on the nature of the mark, to indicate

likelihood of confusion. *L. Leichner (London) Ltd. v. Robbins*, 189 U.S.P.Q. 254 (T.T.A.B. 1975).

a. Similarity in Appearance

In comparing the appearance of Registrant's mark and Petitioner's mark, it is proper to identify the predominant features in appearances. While the basic rule is that marks must be compared in their entireties and not dissected, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985).

Petitioner's mark comprises the letter string "TBC". Registrant's mark consists of a word and a design. In a word-design composite mark, the words are always presumed to be the dominant portion. *Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875, 203 U.S.P.Q. 733 (C.C.P.A. 1979); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976); *In re Mango Records*, 189 U.S.P.Q. 126 (T.T.A.B 1975). As applied to this case, the presumption is that the words comprise the dominant portion of the word-design composite mark. The burden rests on the Registrant in showing otherwise.

In examining the word as the dominant portion of the registered mark, it is necessary to analyze the impact of a disclaimer. By disclaiming words during the prosecution process, Registrant admits descriptiveness, justifying less weight to those words disclaimed in determining likelihood of confusion. *SMS, Inc. v. Byn-Mar, Inc.*, 228 U.S.P.Q. 219 (T.T.A.B. 1985). As for the words of the registered mark, a descriptive portion of a word mark is regarded

weaker and less dominant, thus makes a lesser impact on the ordinary consumer.

As applied to the subject registered mark, Registrant disclaimed any exclusive right to "TEDDY BEAR" as that portion of the word mark is descriptive and weak. The remaining dominant portion of the word mark consists of only "TBC HERRINGTON CLUB."

In light of the foregoing, when comparing the remaining dominant portions of Registrant's mark, "TBC HERRINGTON CLUB" with petitioner's "TBC", it is clear that there is a high likelihood of consumer confusion.

Furthermore, confusion is even more likely given that the Petitioner's TBC appears at the beginning of Registrant's mark. The first word or portion of a mark is considered the dominant portion of both Petitioner's and Registrant's respective marks. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988). The rationale for the first word being the most dominant portion of a word mark is that it is often the first part of the mark which is most likely to be impressed upon the mind of a purchaser and remembered. In distilling both Registrant's and Petitioner's marks to their premium dominant feature, it is clear that both employ the three letters "TBC" as their trademark signal. As such, an appearance analysis of Registrant's and Petitioner's mark favors the Petitioner as to a likelihood of confusion.

b. Sound Connotation Analysis

In comparing the sound connotation of both marks, the predominant sound is the pronunciation of the letters TBC. Analogous to the rationale for "TBC" being the dominant portion in the appearance analysis, a sound connotation analysis of "TBC" yields similar results. The first words heard by ordinary consumers when pronouncing Registrant's mark is "TBC".

Likewise, in pronouncing Petitioner's mark, an ordinary consumer will also pronounce "TBC". The pronunciations of Petitioner's "TBC" and Registrant's "TBC" are identical. As such, a sound connotation analysis of Registrant's and Petitioner's mark favors Petitioner as to a likelihood of confusion.

c. Similarity in Meaning Analysis

Petitioner's submitted evidence shows that The Boyds Collection is a source of teddy bears. The "TBC" designation is on virtually all of Petitioner's teddy bears, and on literature depicting teddy bears.

Comparison of Goods

In addition to a comparison between marks, a comparison between the goods or services is also proper in a likelihood of confusion analysis. The Board has consistently held that the presence of likelihood of confusion is usually determined by considering the relationship between parties' goods and services. Evidentiary factors which serve to indicate that the goods or services are very similar include: (1) the goods or services of the parties are directly competitive; (2) the channels of trade are substantially similar; and (3) the classes of purchasers are essentially the same. *L. Leichner (London) Ltd. v. Robbins*, 189 U.S.P.Q. 254 (T.T.A.B. 1975); *In re Logue*, 188 U.S.P.Q. 695 (T.T.A.B. 1975); *MRI Systems Corp. v. Wesley-Jessen Inc.*, 189 U.S.P.Q. 214 (T.T.A.B. 1975).

Both Petitioner and Registrant are competitors in the market of plush toys. As such, their channels of trade of identical in that Petitioner and Registrant distribute their plush products to purchasers of teddy bears. Indeed, Registrant's Registration description of goods (Attached

hereto as Exhibit A is USPTO Trademark Application and Registrations Retrieval of Registration No.: 2,372,585), indicates that Registrant uses the mark in conjunction with stuffed toys, stuffed animals, and play figures in international class 028.

Even if the Petitioner and Registrant were not competitors, it is sufficient to find a likelihood of confusion if the respective goods are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from, or are associated with, the same source. *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783 (TTAB 1993).

Resolution of Doubt in Favor of Senior User

Many courts have stated that when the issue of likelihood of confusion is in doubt, the question will be resolved in favor of the senior user. *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 909, 94 U.S.P.Q. 363 (3d Cir. 1952); *E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502, 185 U.S.P.Q. 597 (E.D.N.Y. 1975); *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, n.14, 42 U.S.P.Q.2d 1185, n.14 (9th Cir. 1997) ("In a close case amounting to a tie, doubts are resolved in favor of the senior user.")

It is clear that the Petitioner is the senior user of "TBC". This is corroborated by Petitioner's Notice of Reliance publication Exhibits B, C, E, and H which show Petitioner's usage of "TBC" at least back to 1990. All these publication Exhibits predate Registrant's first use date of October 1997. As such, this issue should be resolved in favor of the Petitioner, the senior user of the TBC mark.

False Suggestion of a Connection Analysis

Registrant's use of "TBC" falsely suggests a connection with The Boyds Collection. Registrant's mark is so close to Petitioner's name that consumers would presume that Registrant's goods are actually the Petitioner's. When Registrant's mark is the same as or a close proximation of Petitioner's used name that when Registrant uses its mark on its goods, a connection to the Petitioner would be presumed. *American Speech-Language-Hearing Assn. v. National Hearing Aid Society*, 224 U.S.P.Q. 798 (T.T.A.B. 1984); *United States Olympic Committee v. Olymp-Herrenwasche-fabriken Bezner GmbH & Co.*, 223 U.S.P.Q. 154 (T.T.A.B. 1984); *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.A.*, 222 U.S.P.Q. 512 (T.T.A.B. 1984); *Canovas v. Venezia 80 S.R.L.*, 220 U.S.P.Q. 660 (T.T.A.B. 1983).

"The Boyds Collection" is of sufficient fame and reputation within the teddy bear consumer market that when "TBC" is used on Registrant's goods, a connection to the Petitioner would be presumed. Use of "TBC" by Registrant creates a false connection to Petitioner inasmuch as "TBC" is a well known acronym for The Boyds Collection.

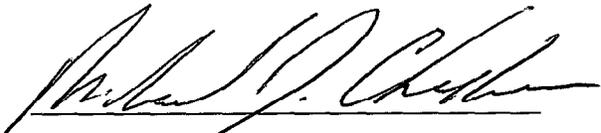
5. SUMMARY

Petitioner has shown that it is likely to be harmed by Registration of the subject trademark by either a likelihood of confusion or through a false suggestion of connection of goods between the Petitioner and the Registrant. As confirmed by Publication Exhibits, Petitioner has senior rights in the mark TBC, the predominant portion of subject cancellation proceeding. As such, the Notice of Cancellation should be granted and the subject registration

canceled from the Federal Registry.

Respectfully Submitted,

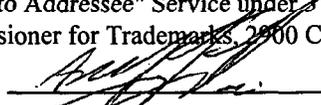
Dated: Chicago, Illinois
October 4, 2002

By: 

Michael J. Cherskov
CHERSKOV & FLAYNIK
The Civic Opera Building
20 North Wacker Drive
Suite 1447
Chicago, IL 60606

CERTIFICATE OF MAILING BY EXPRESS MAIL ET835345905US (Express Mailing Label No.)
I hereby certify that three copies of Petitioner's 16-page Trial Brief are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on October 4, 2002 and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia, 22202-3513.

Albert Y. Tsui
Name of Representative


Signature

October 4, 2002
Date of Signature

CERTIFICATE OF SERVICE

I hereby certify that on October 4, 2002, I served a copy of the foregoing Petitioner's Trial Brief upon Registrant Herrington and Company's counsel of record Elizabeth Moreno McArthur, by mailing a true and correct copy thereof via Express Mail having label No. ET835345896US by the United States Postal Service to the following address:

Elizabeth Moreno McArthur, Esq.
SQUIRE SANDERS & DEMPSEY L.L.P.
1 Maritime Plaza, Suite 300
San Francisco, CA 94111

Dated: October 4, 2002

By: 
Albert Y. Tsui

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 10/04/2002 14:01:32 ET

Serial Number: 75727867

Registration Number: 2372585

Mark



(words only): TBC HERRINGTON'S TEDDY BEAR CLUB

Current Status: A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

Date of Status: 2001-07-06

Filing Date: 1999-06-14

Registration Date: 2000-08-01

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 845 -TTAB

Date In Location: 2001-07-06

CURRENT APPLICANT(S)/OWNER(S)

1. Herrington & Company, Inc.

Address:

Herrington & Company, Inc.
150 McCormick Avenue
Costa Mesa, CA 92626
United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Toys, namely, plush toys, stuffed toys, stuffed animals, and play figures

International Class: 028

First Use Date: 19971000

First Use in Commerce Date: 19971200

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "TEDDY BEAR"

PROSECUTION HISTORY

2001-07-06 - Cancellation instituted for Proceeding

2000-08-01 - Registered - Principal Register

2000-05-09 - Published for opposition

2000-04-08 - Notice of publication

2000-02-03 - Approved for Pub - Principal Register (Initial exam)

1999-12-22 - Communication received from applicant

1999-10-26 - Non-final action mailed

1999-09-30 - Case file assigned to examining attorney

1999-09-26 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Elizabeth C. Moreno (Attorney of record)

ELIZABETH MORENO MCARTHUR
SQUIRE SANDERS & DEMPSEY, LLP
1 MARITIME PLAZA, SUITE 300
SAN FRANCISCO, CA 94111-3492
United States
