

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Outdoor Kids, Inc.

v.

Parris Manufacturing Co., Inc.

Cancellation Nos. 92045687 and 92046943

Joanna R. Mendoza of Law Offices of Joanna R. Mendoza, P.C.
for Outdoor Kids, Inc.

Andrea Barach and Jonathan D. Rose of Boulton, Cummings,
Conners & Berry, PLC for Parris Manufacturing Co., Inc.

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Parris Manufacturing Co., Inc. owns Registration No.
3055384 for KID'S OUTDOORS and design, as shown below, for
"clothing, namely, children's costumes, vests, shirts and
caps" (the Class 25 registration), and Registration No.
3055385 for the same mark for "toys, namely, toy guns, and
toy hunting and fishing gear" (the Class 28 registration).
The mark is described as consisting of "A banner showing the

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words 'KID'S OUTDOORS' with a side view of a large elk standing within an oval shown behind the banner." Both registrations issued on January 31, 2006, from applications that were filed on February 22, 2005, and both contain a disclaimer of KID'S OUTDOORS.



Outdoor Kids, Inc. has petitioned to cancel these registrations on the ground of likelihood of confusion and dilution.¹ Specifically, in Cancellation No. 92045687 (to cancel the Class 25 registration) petitioner has alleged it began using the mark OUTDOOR KIDS for outdoor clothing, footwear and headgear for children in February 1997, and

¹ See discussion, *infra*, with respect to the dilution ground. Petitioner also alleged in its petitions that "Respondent's mark consists of and comprises deceptive matter which may disparage and/or falsely suggest a connection to [petitioner]." ¶ 6. However, petitioner did not discuss any Section 2(a) grounds in its brief, and to the extent petitioner was attempting to assert that respondent's marks are deceptive or disparaging or falsely suggest a connection with petitioner, we deem those claims to have been waived.

that since May 1997 it has been using the mark in interstate commerce. In Cancellation No. 92046943 (to cancel the Class 28 registration) petitioner has alleged that in addition to its use on clothing, it began using the mark OUTDOOR KIDS for sporting goods for children in February 1997, and that since May 1997 it has been using the mark in interstate commerce. Both petitions also allege that petitioner obtained a trademark registration for OUTDOOR KIDS for goods in both Class 25 and Class 28. In its answers to both petitions respondent admitted the allegations of paragraph 2 of the petitions that petitioner "applied for a trademark of its mark OUTDOOR KIDS in January 2003, and the mark was registered July 20, 2004 (U.S. Trademark Registration 2,864,915) under both IC 025 and IC 028." Respondent otherwise denied the remaining essential allegations of the petitions for cancellation.²

On March 6, 2007 the Board granted petitioner's motion to consolidate the proceedings because they involve common questions of law and fact.

By operation of the trademark rules the record includes the pleadings and the files of the registrations sought to

² Respondent also asserted, as "affirmative defenses," that the petition fails to state a claim upon which relief can be granted, and that petitioner has never properly used OUTDOOR KIDS as a trademark for the goods specified in its application and registration. We have given no consideration to either defense. Respondent never filed a motion to test the sufficiency of the

be cancelled. The parties stipulated that testimony could be submitted by affidavit or declaration, and pursuant to that stipulation the parties made of record the declaration testimony, with exhibits, of Jennifer Decker, petitioner's president; Craig A. Phillips, respondent's president; and Jonathan D. Rose, respondent's counsel. The parties also stipulated that all discovery responses, including documents produced in response to document production requests, and copies of the parties' registrations, taken from the USPTO's TARR database, could be submitted under notice of reliance. Petitioner submitted respondent's responses to certain of petitioner's interrogatories and requests for admission; its pleaded registration taken from the USPTO's TARR database; and the TARR database entries for respondent's registrations that are the subject of this consolidated cancellation proceeding, which show the history of the applications/registrations. Respondent submitted the complete file of the two registrations at issue in this proceeding;³ petitioner's responses to certain of respondent's requests for admission, interrogatories and requests for production of documents, and portions of the discovery deposition of Jennifer Decker; the file of

pleadings, nor did it file a counterclaim or separate petition to cancel petitioner's pleaded registration.

³ It was not necessary for respondent to submit the files of these registrations, as they are automatically of record by operation of Trademark Rule 2.122(b).

petitioner's pleaded registration; and the certificates and file histories for certain third-party registrations and a third-party application.

The case has been fully briefed.

Petitioner adopted the name OUTDOOR KIDS in 1997, filing a fictitious business name statement for Outdoor Kids, Inc. on April 22, 1997 which indicated a "beginning date of business" on May 1, 1997 and also filed articles of incorporation for Outdoor Kids, Incorporated that were signed on April 30, 1997, and endorsed by the office of the California Secretary of State on May 23, 1997. Although the declaration testimony of petitioner's president states that petitioner first began using the mark in February 1997 and in interstate commerce by May 1, 2007, it appears that this use was as a trade name or service mark for the retail or online sale of products. It also appears that the only goods on which petitioner has used its mark are swimsuits and water bottles, as shown by Ms. Decker's declaration testimony:

¶ 14. From the early stages of the company the intent has been to expand into manufacturing and distributing of OUTDOOR KIDS brand outdoor clothing. OKI has been successfully selling private label OUTDOOR KIDS brand UV swimsuits (one-piece and two piece suits in pink, purple and royal blue). OKI is currently in various stages of negotiations and planning for manufacturing several types of outdoor clothing after the huge success of its

OUTDOOR KIDS branded UV suits, which significantly outsold the name brand also offered by OKI. Petitioner is planning to produce children's snow/ski bibs and bib/jacket sets based upon OKI's drawings and specifications and manufactured in Vietnam for sale beginning winter of 2009. These are OKI's own product, with each item of clothing bearing an OUTDOOR KIDS brand tag sewn in the garments with paper tags attached at the sleeve, on the zipper or at the collar.

¶ 15. Furthermore, OKI has designed a line of OUTDOOR KIDS brand t-shirts and hired an artist to prepare unique designs for those t-shirts. The first set of t-shirts is scheduled to be produced 2008-2009. Again, these will have the OUTDOOR KIDS paper tag attached to the garment.

¶ 16. Finally, OKI put its OUTDOOR KIDS brand name on Nalgene water bottles and sold them as "OUTDOOR KIDS Water Bottles."⁴ ...

Ms. Decker testified to the same effect in her discovery deposition, pp. 76-76:

Q.: Other than the UV suits, is there any other goods that - - are there any other goods that Outdoor Kids Incorporated has manufactured exclusively for sales?

A.: Water bottles. We don't manufacture them but we have our logo on them and we brand them and we sell those.

Q.: But the remainder of your products, you buy them wholesale from other manufacturers; is that right?

⁴ There is no indication as to whether petitioner removed the NALGENE trademark from these bottles.

A.: Yes.

Q.: Or through distributors?

A.: Yes.

Q.: And many of those products are sold under other trademarks; for example, North Face; isn't that right?

A.: Yes. It's like when you go to Macy's and Gottchalks and you buy a pair of Crocs there. That is correct.

The advertising that petitioner has submitted is in the nature of retail store advertising in which clothing bearing third-party marks is featured. For example, one advertisement features "40% OFF ALL NORTH FACE Rain Jackets," (emphasis in original) and also lists Sorel snow boots, Kamik rain and snow boots, Columbia rain and snow suits and Kidorable rain gear. The print catalog which petitioner used when it first commenced business also features items with third-party brands, such as "Snow Bibs by Rawik Kids," "Kamik rain and snow boots," "Snow Mittens by Zero" and "Goofy and Mickey bobbles by Zebco."

In short, the references to sales of goods in Ms. Decker's declaration appear in general to relate to its retail or online sales of third parties' products rather than to the sales of its own goods bearing the mark OUTDOOR KIDS. From the evidence of record it appears that petitioner has used OUTDOOR KIDS as a trademark only for

swimsuits and water bottles, and it is not clear when petitioner began selling these goods under the mark.⁵

Petitioner sells its products primarily through the internet at its website www.outdoorkids.com. It also has an arrangement with Amazon.com by which it is linked to the Amazon website as an official "storefront." In addition, petitioner receives orders by telephone, fax, email and letters, and people visit its retail store, OUTDOOR DAVIS, and its warehouse.

Respondent began making non-functional rifles for training purposes during World War II, and since the end of that war has been making toy rifles. It later expanded its line to other hunting and to fishing-related toys, along with play hunting and fishing costumes and other children's playwear. It first used the KID'S OUTDOORS and design mark at issue in this proceeding in connection with the sale of toy guns and toy hunting and fishing gear on June 23, 2004, and in connection with the sale of children's costumes, vests, shirts and caps on January 31, 2005.

⁵ Petitioner's witness stated that since its first retail order in 1997 it has "affixed its OUTDOOR KIDS mark to most all of the shipments of clothing and goods sold on the internet or via mail-order." ¶13. However, petitioner also characterized its inclusion of a thank you card with the merchandise as "affixing" or "attaching" it. *Id.* These notes say "Hi! Thanks again for your order. We hope you like your new things! Have a great [appropriate season]. From the Moms & Dads at Outdoor Kids." We do not regard these notes as showing use of the mark for the goods.

Before we address the substantive grounds in this proceeding, we must discuss both a procedural issue and the parties' evidentiary objections. First, petitioner has asserted in its brief that one of the grounds for cancellation of respondent's registrations is dilution. It does not appear to us that such a ground was adequately pleaded. The petitions do not actually use the word "dilution" at all, nor did petitioner plead that its mark became famous prior to respondent's constructive or actual use date. However, respondent has not objected to the statement in petitioner's brief that dilution is one of the grounds, and has discussed the merits of the ground in its own brief. Accordingly, because the parties have treated the ground of dilution as having been tried, we deem the pleadings to be amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure to include this ground.

Petitioner has raised a number of evidentiary objections on the basis of relevancy. We are frankly surprised that petitioner would consider this material irrelevant, e.g., petitioner has objected to the files of the registrations that it seeks to cancel, claiming that only the registrations themselves with the identifications listed on them are relevant. The objections are all overruled. Further, because it is so clear that the testimony and exhibits are relevant, we will address the

objections in summary fashion. The files of respondent's registrations are automatically of record pursuant to Trademark 2.122(b). Because statements which were made in the course of obtaining petitioner's pleaded registration are facts which may be considered in this proceeding, see *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978), petitioner's registration file is relevant. The third-party registrations taken from the TARR database go to the issue of the strength of petitioner's mark. Paragraphs 2 and 3 of the Phillips testimony declaration provide background about the company's activities, while paragraphs 8 and 9 relate to respondent's catalogs showing respondent's goods bearing the mark at issue and discuss the goods to which respondent affixes its mark. The testimony declaration of Jonathan Rose is not hearsay, in that Mr. Rose has testified to internet searches he performed; he has also by his testimony authenticated the exhibits attached thereto.

Respondent, too, has raised several objections to petitioner's testimony. Again, we will not burden this opinion with an extended discussion of them. To the extent that the witness testified that petitioner has standing in paragraph 5, we agree that this is a legal conclusion and has no evidentiary value. This objection is sustained. Objection 2, to paragraph 6, is overruled. Objection 3, to

paragraph 12, is overruled. Objection 4 is overruled, as such testimony as the manner in which customers could come into contact with petitioner's mark, development of petitioner's inventory, sales and advertising, etc., is clearly relevant. Objection 5 is overruled; it is not hearsay. We do not treat the material in paragraph 19 as hearsay, and therefore overrule objection 6, although we will consider the probative weight to be given to this testimony. Objection 7 insofar as it relates to paragraph 20 is overruled; we do not consider the witness's testimony as to which goods in respondent's catalog are similar to petitioner's goods to be "the improper opinion of a lay witness."⁶ As for paragraph 21, we agree that this is a legal conclusion, and sustain the objection to this paragraph.

Petitioner has made of record its Registration No. 2864915 for OUTDOOR KIDS in typed drawing form for "outdoor clothing, footwear and headgear for children, namely, jackets, parkas, socks, sock liners, ski bibs, UV protection

⁶ We note that part of a sentence in paragraph 20 of the Decker declaration appears to be missing, as the penultimate sentence ends with the phrase "petitioner's registration include." The portion of the sentence that is in the declaration is merely an introduction to the missing substantive part of the sentence, and therefore we give this sentence no probative value. However, the fact that the sentence is incomplete has no effect on our decision herein, since it purportedly was to indicate those goods in respondent's catalog that the witness believed were in the same category as petitioner's goods, and we can ascertain this information for ourselves.

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swim suits, floatation swim suits, hiking boots, snow boots, rain boots, rain jackets, rain pants, rain suits, hats, long underwear, gloves, mittens, snow suits, turtleneck shirts, t-shirts, cloth swim diapers" in Class 25, and "sporting goods for children, namely, skis, ski poles, ski leashes, ski harnesses, snowshoes, fishing poles, rock climbing harnesses" in Class 28. This registration issued on July 20, 2004 under the provisions of Section 2(f), and with KIDS disclaimed. Petitioner has also submitted testimony as to its use of this mark for swimsuits and water bottles. Petitioner has, therefore, adequately established that it is not a mere intermeddler, and that it has standing to pursue this consolidated proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

With respect to priority, because this is a cancellation proceeding in which both petitioner and respondent own registrations, priority is in issue. Cf. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, the parties may rely on the filing dates of their respective registrations to establish constructive use of their marks for the goods listed in their registrations. *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). The

filing date of the application which matured into petitioner's pleaded registration is January 29, 2003. The filing date of the applications which matured into respondent's registrations is February 22, 2005, which is obviously later. Moreover, respondent's president testified that it first used its mark for toy guns and toy hunting and fishing gear on June 23, 2004 and for children's costumes, vests, shirts and caps on January 31, 2005. Thus, with its constructive use date of January 29, 2003, petitioner has shown it has priority.⁷

This brings us to the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

⁷ As we discussed supra, petitioner apparently did not use OUTDOOR KIDS as a trademark for most of the goods identified in its registration. (In fact, at her discovery deposition petitioner's witness stated that she included the word "et cetera" in the original identification of goods in the application, which was based on use in commerce, because she was "trying to identify gross classes of what we might be wanting to sell at that point or any time in the future and that's why I used the word et cetera." p. 40.) However, respondent never counterclaimed to cancel the registration, and therefore we must treat the registration as valid. Petitioner may therefore rely on the registration for all the presumptions conferred by Section 7 of the Trademark Act.

We begin our analysis with the du Pont factor of fame because petitioner has asserted that its mark is famous and fame, when present, plays a dominant role in the determination of likelihood of confusion. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). We find that petitioner has failed to prove that its mark is famous for clothing or toys. Petitioner has provided no sales figures for its goods. As noted, the only goods on which petitioner uses the mark OUTDOOR KIDS are swimsuits and water bottles; the other items that it sells through its retail store and website bear the marks of third parties. It is not clear when petitioner started selling the swimsuits and water bottles bearing its mark, nor has petitioner provided information about the number that it has sold.⁸ We also point out that petitioner's registration does not include water bottles, and because petitioner's likelihood of confusion ground is based on its registration, rather than common law trademark rights in the mark for water bottles, its sales of water bottles are not relevant. In any event, petitioner has not shown that it began using its mark on water bottles prior to respondent's constructive or actual use dates.

⁸ In fact, petitioner has not provided sales figures with respect to any goods it sells, including goods of third parties that it sells through its online and retail stores.

Nor has petitioner provided any advertising figures, or provided anything other than some very general statements:

It has advertised in a variety of newspapers and parent-oriented publications across the United States. In the early years of the company we did advertising campaigns in New York, Boston, Chicago, San Francisco and Washington state.

Decker declaration, ¶10. Moreover, the four exhibits submitted as examples of such advertising are in the nature of retail store advertising. We have previously discussed one of these advertisements which, in addition to being for store services, is undated and is from a local newspaper, the "Davis Enterprise" (California). Another undated ad which appears to have been published in "Family & Leisure," is headlined "High Quality Outdoor Clothing & Equipment" and lists third-party marks North Face, Columbia, Sorel, Kelty and Teva. The other two exhibits are letters, both of which list products bearing third-party marks, e.g., North Face parkas, Medalist long underwear, Kamik snow boots, Fox River socks and Life is Good shirts and caps are listed in the November 20, 2005 letter. Such exhibits do not show advertising of OUTDOOR KIDS as a trademark for petitioner's goods, as opposed to third-party goods that petitioner sells. Petitioner has also stated that it has sold its products via "articles and interviews in magazines and newspapers (including 'Wall Street Journal' and 'Better

Homes and Gardens Kids')" Decker, ¶11, but did not submit examples of such articles or interviews. In view of petitioner's expansive view of what "sales and advertising" of its goods encompass, we cannot ascertain whether these articles and interviews actually refer to petitioner's goods sold under the trademark OUTDOOR KIDS.

Petitioner's president also testified that in 2007 hundreds of its OUTDOOR KIDS Nalgene water bottles were used in prize packages awarded in "Daddy Day Camp Olympiads," day-long outdoor events for children that promoted the Sony Picture movie "Daddy Day Camp," and that petitioner also ran a sweepstakes contest on-line for the movie promotion. Water bottles are not covered by petitioner's registration, nor has petitioner pleaded or proved prior common law rights in OUTDOOR KIDS for water bottles, and therefore any fame from this advertising campaign cannot show that petitioner's mark is famous for the goods at issue. In any event, the limited information provided by petitioner with respect to the distribution of these goods is not sufficient to show that OUTDOOR KIDS is a famous mark for water bottles.

Given the great deference that is given to a famous mark, one asserting that its mark is famous must clearly prove it. The vague and limited information provided by petitioner certainly is not sufficient for us to conclude

that its mark is famous for the goods identified in its registration.

On the contrary, we find that petitioner's mark is weak. During the course of prosecution the Examining Attorney refused petitioner's application on the ground of descriptiveness, and also required a disclaimer of KIDS because "the wording is merely a generic term for the goods." Office action mailed July 11, 2003. In response petitioner amended its application to seek registration under Section 2(f) of the Act, and also submitted a disclaimer of KIDS. By doing so, petitioner has admitted that OUTDOOR KIDS is not inherently distinctive, and that these words are merely descriptive of its goods, with the word KIDS being generic. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact.") Respondent has not counterclaimed to cancel petitioner's registration on the ground that its mark is merely descriptive, and therefore we must accept that the mark has acquired distinctiveness. However, there are degrees of acquired distinctiveness. Petitioner's mark is made up of two elements that are generic and/or highly descriptive, with KIDS being an admittedly generic term for

its goods and OUTDOOR being a highly descriptive, if not generic word for outdoor clothing. In fact, petitioner has identified its clothing as "outdoor clothing... for children." OUTDOOR is also highly descriptive of the Class 28 items identified in petitioner's registration, since they are all sporting goods that are used for outdoor activities.

Although petitioner was able to obtain a registration on the basis of acquired distinctiveness, the degree of such acquired distinctiveness must be viewed as minimal. The only Class 25 goods on which petitioner has used its mark are swimsuits, and there is no evidence as to sales figures or advertising for these goods. And petitioner has not used its mark for any of the goods in Class 28. Thus, there is nothing in the record that would enable us to conclude that, by virtue of petitioner's use and advertising of its mark for its own clothing and toy products, petitioner's mark has become a strong mark.⁹ Accordingly, in the likelihood of confusion analysis we must treat petitioner's mark as a weak mark that is not entitled to a broad scope of protection.

See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d

⁹ We point out that petitioner neither pleaded nor argued any rights in OUTDOOR KIDS as a service mark for e-tail or retail store services, or likelihood of confusion stemming from such rights. In any event, the record does not show that the mark has acquired distinctiveness for such services. Moreover, in view of our finding, discussed *infra*, that there is no likelihood of confusion with respect to use of the mark for the legally identical goods recited in the parties' registrations, there could be no likelihood of confusion with respect to petitioner's services.

158, 117 USPQ 295, 296 (CCPA 1958), ("though appellant [plaintiff] has obtained a registration for this mark on the principal register as a secondary meaning mark, there is nothing in the record to indicate that this mark is not still in the category of a weak mark").

This brings us to a consideration of the marks. Petitioner's mark is OUTDOOR KIDS with KIDS disclaimed, while respondent's mark is KID'S OUTDOORS appearing on a banner placed over the design of an elk. Both parties recognize that, in determining likelihood 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, provided the ultimate conclusion rests on a consideration of the marks in their entirety. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Where the parties differ is which element of respondent's mark should be considered the dominant feature. Respondent argues that because the words KID'S OUTDOORS in its mark are descriptive and have been disclaimed, the elk design in its mark must be considered the dominant portion. Petitioner, on the other hand, cites Board cases for the principle that, if a mark comprises both a word and a design, the word is normally accorded greater weight. We agree that, despite the fact that they are disclaimed, the words KID'S OUTDOORS remain a noticeable part of

respondent's mark. However, petitioner itself has acknowledged that the elk design is distinctive: "the inclusion of the graphic design of an elk does nothing to promote the concept of clothing and accessories for kids." Brief, p. 18. Moreover, there is no per se rule that words must always predominate over designs. See *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007). And, even if an element of a mark is dominant, this does not mean that other elements may simply be ignored in the likelihood of confusion analysis. Id. See *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) ("There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue"). Moreover, when the word portion of marks are highly suggestive or descriptive, the presence of a design may be a more significant factor. See *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984). Thus, in our consideration of the marks as a whole, we must consider the design portion of respondent's mark as a distinguishing element.

As for the word portion, as petitioner has pointed out, KID'S OUTDOORS is essentially a transposition of petitioner's mark, OUTDOOR KIDS. Both petitioner and respondent have cited various cases involving transposed elements, in some of which likelihood of confusion was

found, and in some of which it was not. The different outcomes show, once again, that the determination of likelihood of confusion depends on the facts of the particular case. See *Jaquet-Girard S.A. v. Girard Perregaux & Cie., S.A.*, 423 F.2d 1395, 165 USPQ 265, 266 (CCPA 1970) ("prior decisions on different marks used under different circumstances are of little value in deciding a specific issue of likelihood of confusion"). As we have already stated, the individual words "kids" and "outdoors" in each mark are highly descriptive and/or generic for the respective goods, and the phrase KID'S OUTDOORS is also descriptive, while OUTDOOR KIDS although registered under Section 2(f), has acquired distinctiveness only for that particular word order, and is still a weak mark. As a result, consumers are not likely to assume that all marks that contain these elements or permutations of these elements indicate a common source.

Further, the words in the respective marks have different connotations and commercial impressions. In the mark OUTDOOR KIDS the word OUTDOOR modifies KIDS, so the connotation is that of children who enjoy outdoor activities or nature. In the phrase KID'S OUTDOORS, the word KID modifies OUTDOORS, so the connotation is of an outdoor environment that is friendly to children, or that works on a

level for children where they can do what they like or where they have control.

In the particular circumstances of this case, where petitioner's mark is weak and the word portion of respondent's mark is descriptive, we find that the transposition of the words and the presence of the elk design in respondent's mark are sufficient to distinguish it from petitioner's mark. In short, this is a circumstance where consumers would rely on what would otherwise be slight differences between petitioner's OUTDOOR KIDS mark and respondent's KID'S OUTDOORS and design mark to distinguish the marks.

We recognize that some of the goods as identified in petitioner's registration encompass or are encompassed by some of the goods identified in respondent's registration, e.g., hats and caps, t-shirts and shirts, fishing poles and fishing gear, and therefore these goods must be deemed to be legally identical and to travel in identical channels of trade to the same classes of customers. These goods are also general consumer goods which would be purchased by the public at large, such that the purchasers would not be sophisticated, and may not exercise a great deal of care in making purchasing decisions. All of these du Pont factors favor a finding of likelihood of confusion.

However, each of the du Pont factors may, in any particular case, play a dominant role. In re E. I. du Pont de Nemours & Co., 177 USPQ at 567. See also, Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). In the present case, the weakness of petitioner's mark and the differences in the marks deserve greater weight in the likelihood of confusion analysis. As the Court said in Sure-Fit Products Co. v. Saltzson Drapery Co., 117 USPQ at 297:

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

Thus, when we weigh the relevant du Pont factors, we find that respondent's mark for its identified goods is not likely to cause confusion with petitioner's mark for its identified goods.¹⁰ In view of the weakness of petitioner's

¹⁰ Petitioner also points out that respondent has submitted limited evidence of third-party use or registrations of OUTDOOR KIDS marks. Third-party registrations show only that a term has significance in a particular field and, given that petitioner has admitted that the words "outdoor kids" are descriptive of clothing and toys for children, such evidence is unnecessary. Moreover, because the term is descriptive, it is not surprising that third parties would choose marks that are stronger indicators of source.

mark, the differences in the marks are sufficient to distinguish respondent's mark from petitioner's mark, despite the fact that the goods are legally identical, must be deemed to travel in the same channels of trade, and be purchased by ordinary consumers who do not exercise a great deal of care.

In reaching our conclusion that confusion is not likely to occur, we have not accorded any probative weight to petitioner's testimony about actual confusion. In her testimony declaration, executed on April 23, 2008, Ms. Decker stated:

¶19. Since the Respondent began using the mark in question, the issue of confusion between consumers and suppliers comes up on a regular basis, with [petitioner] being contacted under the mistaken impression that it is a different company using the OUTDOOR KIDS name or being referenced in a manner indicating that it is being mistaken with a different company. However, the names of those persons who have indicated confusion are not necessarily recorded. Nevertheless, I can attest that this occurs and that I have taken many such calls myself over the years.

Aside from the vague nature of this testimony, it is not credible. At her discovery deposition that was taken three months earlier, on January 17, 2008, she unequivocally testified that she was not aware of any instances of actual confusion:

Q.: Miss Decker, let me ask you, are you aware of any instances in which a

potential customer for your goods has been confused between the Outdoor Kids mark and the Parris [respondent] mark?

A.: No.

Disc. dep., pp.84-85. Thus, she clearly did not take many calls herself "over the years."¹¹ And we cannot accept that there were calls between the time of her discovery deposition and her testimony declaration. Petitioner had a duty to supplement its answers to discovery, and therefore cannot rely on evidence that it did not provide in discovery. Moreover, we do not believe that if petitioner had received evidence of actual confusion at the point that it was fully engaged in this proceeding that it would not

¹¹ Petitioner argues in its reply brief that respondent has misleadingly attempted to contradict Ms. Decker's trial testimony by using quotes from Ms. Decker's discovery deposition in which she testifies only with respect to whether she was aware of any instances in which a potential customer was confused. Petitioner states that "Respondent's argument that there is no evidence of actual confusion relies completely upon a carefully selected snippet of testimony that does not provide the full extent of the evidence on actual confusion." Reply brief, p. 14. However, if petitioner believed that the portion of Ms. Decker's discovery deposition was misleading it could have submitted additional portions of the deposition. See Trademark Rule 2.120(j)(4) (If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party). Nor does petitioner explain how or why the statements made by Ms. Decker in her discovery deposition do not contradict the statements made in her testimony declaration. To the extent that petitioner is suggesting that the telephone calls evidencing confusion relate to a third party, this is not evidence of actual confusion arising from respondent's use of its mark. And if petitioner is relying on confusion by suppliers, they are not the relevant group to show actual confusion.

have taken note of the details of such confusion, such as the dates of the incidents, the nature of the conversation, and the names of persons who were actually confused in order to use such information at trial.¹²

The next ground we consider is that of dilution. Section 43(c)(1) of the Trademark Act, 15 U.S.C. §1125, provides that "Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." Section 14 provides that dilution by blurring or by tarnishment under Section 1125(c) is a basis for bringing a cancellation action.

As set out in the Act itself, and as interpreted by case law, one of the factors to be considered in determining whether dilution has been proven is whether the plaintiff's

¹² It would seem that petitioner's president, who was a practicing attorney before she devoted herself full-time to her business, would have noted details of any instances of actual confusion from the time the petition for cancellation was filed in April 2006, or even from the time she first became aware of respondent's application as a result of a routine search of the USPTO records she did in July 2005.

mark is famous. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). A mark may have acquired sufficient public recognition and renown to demonstrate that it is a strong mark for likelihood of confusion purposes without meeting the stringent requirements to establish that it is a famous mark for dilution purposes. *Toro Co. v. ToroHead Inc.*, 62 USPQ2d at 1170.

We have already found that petitioner has failed to prove that OUTDOOR KIDS is a famous mark in our likelihood of confusion analysis. Therefore, given the stricter standard required to prove fame for dilution, it is clear that petitioner has not proven that OUTDOOR KIDS is famous for dilution purposes. Accordingly, we find that petitioner has failed to establish its claim of dilution.

Decision: The petition for cancellation is dismissed as to the grounds of likelihood of confusion and dilution.