

This Opinion is Not a  
Precedent of the TTAB

Hearing: September 8, 2022

Mailed: April 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Caterpillar Inc.*

*v.*

*Puma SE*  
—————

Cancellation No. 92067079  
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Naresh Kilaru and Laura K. Johnson of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. for Caterpillar Inc.

Johanna M. Wilbert and Christian G. Stahl of Quarles & Brady LLP for Puma SE.  
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Before Wolfson, Larkin, and Dunn,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

This case is a cat fight. In one corner is Puma SE (“Respondent” or “Puma”), which claims that it “has been a cat since birth,” 232 TTABVUE 56, and which owns Registration No. 4220096 for the stylized mark shown below:

**procat**

for “Clothing, namely, socks; footwear; headbands” in International Class 25.<sup>1</sup>

In the other corner is Caterpillar, Inc. (“Petitioner” or “Caterpillar”), which calls the CAT mark the “cornerstone of the company’s brand portfolio,” 230 TTABVUE 10, and which seeks to cancel Respondent’s registration on three grounds: (1) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent’s registered mark so resembles Petitioner’s CAT marks as to be likely, when used in connection with the goods identified in the registration, to cause confusion, to cause, mistake, or to deceive; (2) under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), on the ground that Petitioner’s CAT mark is famous and Respondent’s registered mark is likely to dilute Petitioner’s CAT mark by blurring; and (3) on the ground that Respondent abandoned its registered mark through nonuse with the intent not to resume use, within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1125.

The parties have swatted at one another for about five years, but neither has been able to land a knockout blow, and their bout has gone the distance. The case is fully briefed,<sup>2</sup> and counsel for the parties appeared at an oral hearing before the panel on

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<sup>1</sup> Respondent’s registration issued on October 9, 2012 from an application filed on May 17, 2012 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, which sought the extension of protection to the United States of International Registration No. 1114537 covering socks, footwear, and headbands, and many other Class 25 goods. On October 8, 2018, while this case was pending, Respondent filed a Declaration of Continued Use/Excusable Nonuse of Mark in Commerce under Section 71 of the Trademark Act, 15 U.S.C. § 1141k, in which Respondent alleged use of the registered mark in commerce for socks, footwear, and headbands, and deleted the other goods. On October 13, 2021, while this case was pending, Respondent filed another Declaration of Continued Use/Excusable Nonuse of Mark in Commerce under Section 71 of the Trademark Act with respect to socks, footwear, and headbands.

<sup>2</sup> Citations in this opinion to the briefs and other materials in the voluminous case docket refer to TTABVUE, the Board’s public online docketing system. *See New Era Cap Co. v. Pro*

September 8, 2022.<sup>3</sup> The final bell has sounded, and the winner by decision is Petitioner, as we grant its Amended Petition for Cancellation based on its Section 2(d) claim.

### **I. The Record and Evidentiary Issues**

The parties amassed an enormous record consisting of more than 15,000 pages of testimony and documentary evidence. The Board has remarked more than once that a “larger record is not necessarily a better record,” *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) (quoting *Sheetz of Del. Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013)), and this case illustrates the truth of that observation. While we recognize that the parties vigorously litigated three distinct and fact-intensive claims for relief asserted by Petitioner, we have decided Petitioner’s Section 2(d) claim below without reference to significant portions of the entire record, suggesting that the record contained considerable cumulative, duplicative, or unnecessary evidence. *See Made in Nature,*

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*Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Petitioner’s redacted main brief appears at 230 TTABVUE and its redacted reply brief appears at 233 TTABVUE. Respondent’s redacted brief appears at 232 TTABVUE. The parties designated portions of their briefs and significant portions of other materials in the record as confidential under the Board’s Standard Protective Order and filed the unredacted versions under seal. Except where otherwise indicated, all TTABVUE citations in this opinion are to the redacted publicly accessible versions of materials. Consistent with our need “to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of [our] decision,” *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016), we have discussed all evidence designated as confidential in general terms in this opinion to the extent possible.

<sup>3</sup> The panel commends counsel for both parties for their skillful written and oral advocacy on behalf of their respective clients.

*LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*14 (TTAB 2022) (noting that “sizeable portions of each party’s evidentiary materials were not pertinent to the issues involved in this rather straightforward priority and likelihood of confusion opposition proceeding”). Sometimes less is more (or at least enough), and this is one of those times.

The record includes the pleadings,<sup>4</sup> and the file history of Respondent’s registration, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), as well as the following materials submitted by the parties:

#### **A. Petitioner**

##### **Testimony Affidavits and Declarations**

- Testimony Affidavit of Kenny Beaupre, Petitioner’s Brand Licensing Manager, and Exhibits 1-24 thereto, 106 TTABVUE 2-327 (Beaupre Aff. ¶¶ 1-42; Ex. 1; 94 TTABVUE 2-266 (Exs. 1-7); 104 TTABVUE 2-210 (Exs. 1-5); 102 TTABVUE 2-346 (Exs. 6-7); 100 TTABVUE 2-292 (Exs. 8-24); 109 TTABVUE 2-419 (Exs. 7-14);<sup>5</sup>

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<sup>4</sup> The operative pleadings are Petitioner’s Amended Petition for Cancellation, 31 TTABVUE 23-52, and Respondent’s Answer thereto. 52 TTABVUE 2-32. Respondent denied the salient allegations of the Amended Petition for Cancellation, and interposed the affirmative defenses of laches and acquiescence. Although Petitioner filed this cancellation proceeding only a few days before the fifth anniversary date of the issuance of Respondent’s registration, after which date certain of Petitioner’s claims would have been time barred under Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), Respondent did not pursue its equitable defenses in its brief and we consider them waived. *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at \*4 (TTAB 2021). Respondent also asserted a self-styled “affirmative defense” of the absence of a likelihood of confusion, which is merely an amplification of its denials in response to Petitioner’s corresponding allegations in its Amended Petition for Cancellation. “Although it is permissible to amplify a denial of, for example, an allegation of a likelihood of confusion in a pleading . . . such amplification is not, and should not be pled as, a separate ‘defense,’ and we do not treat it as such here.” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*4 n.5 (TTAB 2021) (citation omitted).

<sup>5</sup> We will cite the Beaupre Affidavit and all other affidavits and declarations by paragraph and exhibit number (e.g., “Beaupre Aff. ¶ \_\_; Ex. \_\_”) as well as by corresponding TTABVUE pages.

- Testimony Affidavit of Diane Lantz-Rickard, Petitioner’s Global Brand Identity Manager for Caterpillar Inc., and Exhibits 1-34 thereto, 107 TTABVUE 2-51 (Lantz-Rickard Aff. ¶¶ 1-51; Exs. 1-2); 101 TTABVUE 2-854 (Exs. 3-17); 99 TTABVUE 2-232 (Exs. 17-22); 98 TTABVUE 2-151 (Ex. 22); 97 TTABVUE 2-277 (Exs. 22-30); 96 TTABVUE 2-421 (Ex. 30); 95 TTABVUE 2-321 (Exs. 30-34);
- Rebuttal Testimony Declaration of Robert Reading, an employee of Clarivate Analytics, and Exhibit A thereto, 188 TTABVUE 2-7;
- Rebuttal Testimony Affidavit of Jodie Haven MacLean, Corporate Secretary of Arkansas Boats, LLC, 189 TTABVUE 2-4;
- Rebuttal Testimony Affidavit of David Wanderscheid, Chief Executive Officer of Country Cat, Inc., 191 TTABVUE 2-4; and
- Rebuttal Testimony Declaration of Kevin Lam, a Trademark Research Assistant for Petitioner’s counsel, and Exhibits A-I thereto, 193 TTABVUE 2-150;

#### **Oral Cross-Examination of Respondent’s Witnesses**

- Transcript of the Cross-Examination Deposition of Peter Mastrostefano, General Counsel of Puma North America, and Exhibits 1-6 thereto, 172 TTABVUE 2-215;<sup>6</sup>
- Transcript of the Cross-Examination Deposition of Gillian Commander, Vice President of Strategic Planning at Puma North America, and Exhibits 1-11 thereto, 174 TTABVUE 2-311;
- Transcript of the Cross-Examination Deposition of Adam Petrick, Global Director of Brand and Marketing at Puma, and Exhibits 1-9 thereto, 176 TTABVUE 2-198;
- Transcript of the Cross-Examination Deposition of Neil J. Narriman, General Counsel of Intellectual Property at Puma SE, and Exhibits 1-3 thereto, 218 TTABVUE 2-194; and

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<sup>6</sup> We will cite all deposition transcripts by page and line number (e.g., “Mastrostefano Tr. \_\_: \_\_”) as well as by TTABVUE pages.

- Transcript of the Cross-Examination Deposition of Christopher Volpe, Chief Operations Officer and Chief Financial Officer for United Legwear, and Exhibits 1-7 thereto, 227 TTABVUE 2-295;

### **Notices of Reliance**

- Notice of Reliance Nos. 1-15, covering various materials including: No. 1 (Petitioner's active registrations), 83 TTABVUE 2-81; No. 2 (decisions of the Board and federal district courts involving Petitioner), 84 TTABVUE 2-175; No. 3 (decisions of arbitration tribunals in domain name disputes involving Petitioner), 85 TTABVUE 2-229; No. 4 (Internet materials regarding Petitioner's products), 86 TTABVUE 2-112; No. 5 (Printed publications regarding or mentioning Petitioner), 87 TTABVUE 2-312; No. 6 (Respondent's responses to certain requests in Petitioner's First Set of Requests for Admission), 88 TTABVUE 2-17; 92 TTABVUE 2-5; No. 7 (dictionary definitions of the word "pro"), 90 TTABVUE 2-54; No. 8 (Internet materials regarding the availability of Petitioner's products at certain retailers), 112 TTABVUE 2-92, 113 TTABVUE 2-136, 114 TTABVUE 2-8; No. 9 (electronic records from the databases of the United States Patent and Trademark Office ("USPTO") regarding disclaimers of the word PRO (alone or with other matter) in registered marks in Class 25), 115 TTABVUE 2-1440, 116 TTABVUE 2-332; No. 10 (Internet materials regarding uses of the word PRO on Respondent's websites), 117 TTABVUE 2-58; No. 11 (excerpts from Respondent's responses to certain of Petitioner's First Set of Interrogatories and documents produced pursuant to Rule 33(d) of the Federal Rules of Civil Procedure), 118 TTABVUE 2-47; No. 12 (Internet materials regarding Petitioner's social media pages), 120 TTABVUE 2-86; No. 13 (excerpts from declarations of Mr. Mastrostefano filed in this case), 121 TTABVUE 2-21; No. 14 (articles in printed publications regarding Petitioner's CAT brand), 123 TTABVUE 2-66, 124 TTABVUE 2-84, 132 TTABVUE 2-197; and No. 15 (articles in printed publications regarding Petitioner's CAT brand), 111 TTABVUE 2-560; and
- Rebuttal Notice of Reliance Nos. 1-15, covering various materials including: No. 1 (printed publications, dictionary definitions, Wikipedia entries, and Internet materials regarding third-party registrations and uses of "CAT"-formative marks identified by Respondent), 194 TTABVUE 2-146; No. 2 (USPTO electronic records regarding cancelled or amended registrations of, and abandoned applications to register, third-party "CAT"-formative marks cited by Respondent), 195 TTABVUE 2-149; No. 3 (dictionary definitions, Wikipedia entries, and Internet materials regarding third-party "CAT"-formative marks identified by Respondent), 196 TTABVUE 2-50; No. 4 (Internet materials, including social media pages, regarding various university and college feline mascots), 197 TTABVUE 2-59; No. 5 (Internet materials regarding the student populations of certain universities and

colleges with feline mascots), 198 TTABVUE 2-100; No. 6 (pages from Respondent's website at puma.com), 199 TTABVUE 2-48; No. 7 (Internet materials regarding feline images on apparel products for certain universities and colleges with feline mascots), 200 TTABVUE 2-33; Nos. 8-9 (Internet materials showing the sale of the parties' products through the same online retailers), 201 TTABVUE 2-57; 202 TTABVUE 2-79; No. 10 (Internet materials showing search results for the word "cat" on webpages of certain companies identified by Respondent), 208 TTABVUE 2-835; No. 11 (Internet materials regarding the results of a search for the words "Cat Footwear" using the Google search engine), 203 TTABVUE 2-15; No. 12 (printed publications consisting of articles referencing Petitioner and its products as "CAT" or otherwise mentioning the CAT brand), 204 TTABVUE 2-117; No. 13 (pages from Petitioner's website and social media accounts), 205 TTABVUE 2-56; No. 14 (Board docket printouts regarding opposition proceedings filed by Petitioner in the previous six months against applications to register "CAT-" formative marks in Class 25), 206 TTABVUE 2-87; and No. 15 (annual reports of Petitioner's licensee Wolverine World Wide, Inc.), 207 TTABVUE 2-345.

## **B. Respondent**

### **Testimony Declarations and Deposition**

- Testimony Declaration of Mr. Narriman, and Exhibits 1-19 thereto, 139 TTABVUE 2-405;
- Testimony Declaration of Mr. Mastrostefano, and Exhibits A-E thereto, 158 TTABVUE 2-122;
- Testimony Declaration of Mr. Volpe, and Exhibits A-D thereto, 160 TTABVUE 2-29;
- Testimony Declaration of Mr. Petrick, and Exhibits A-K thereto. 147 TTABVUE 2-201; and
- Testimony Deposition of William Shanks, a trademark investigator employed by Marksmen, Inc., and Exhibits 1-19 thereto, 183 TTABVUE 2-354;

### **Oral Cross-Examination of Petitioner's Witnesses**

- Transcript of the Cross-Examination Deposition of Ms. Lantz-Rickard, and Exhibits 1-29 thereto, 180 TTABVUE 2-693; and

- Transcript of the Cross-Examination Deposition of Mr. Beaupre, and Exhibits 1-21 thereto, 178 TTABVUE 2-576;

### **Notices of Reliance**

- Notice of Reliance Nos. 1-18, covering various materials including: No. 1 (USPTO electronic records regarding the involved registration and Respondent's cancelled or expired registrations of other CAT-formative marks), 142 TTABVUE 2-85; No. 2 (copies of the certificates of registration of third-party registrations of CAT-formative marks in Class 25 or other Classes), 143 TTABVUE 2-94; No. 3 (photographs of third-party apparel items bearing CAT-formative marks), 144 TTABVUE 2-81; No. 4 (Internet materials regarding third-party sales of products bearing CAT-formative marks), 145 TTABVUE 2-142; No. 5 (Internet materials showing the sale of footwear and the other goods identified in the involved registration under Respondent's mark), 146 TTABVUE 2-99; No. 6 (Internet materials showing the sale of goods other than those identified in the involved registration under Respondent's mark), 149 TTABVUE 2-186; No. 7 (Internet materials showing the sale of Respondent's goods under CAT-formative marks), 150 TTABVUE 2-96; No. 8 (Internet materials regarding books containing the term CAT in their titles), 151 TTABVUE 2-105; Nos. 9 and 15 (Internet materials regarding what Respondent describes as use of "the word 'cat' in ordinary parlance"), 152 TTABVUE 2-78, 163 TTABVUE 2-54; No. 10 (Petitioner's responses to certain interrogatories and requests for admission in Respondent's First Sets of Interrogatories and Requests for Admission), 153 TTABVUE 2-37, 185 TTABVUE 2-38; Nos. 11-12 (certificates of registration and USPTO electronic records regarding third-party registrations of PRO-formative marks for Class 25 goods), 154 TTABVUE 2-486; 155 TTABVUE 2-285; No. 13 (Respondent's responses and supplemental responses to certain requests in Petitioner's First Set of Requests for Admission, which Respondent stated were submitted "so as to avoid an unfair interpretation of the responses offered by" Respondent), 156 TTABVUE 2-14; Nos. 14 and 17 (what Respondent describes as "printed publications" demonstrating third-party use of CAT-formative marks on the goods identified in the involved registration), 162 TTABVUE 2-92, 165 TTABVUE 2-38; No. 16 (printed publications regarding what Respondent calls the "the nature and extent of the public exposure to Registrant, its marks, and its products over a period of many years"), 164 TTABVUE 2-58; and No. 18 (Internet materials showing what Respondent describes as "evidence of various uses of the term 'cat.')" 166 TTABVUE 2-52.



### **C. Evidentiary Objections**

“As a general matter, ‘the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations,’ and keeping in mind ‘the various objections raised by the parties’ in determining the probative value of objected-to testimony and evidence.” *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (quoting *Luxco, Inc. v. Consejo Regulador Del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)). “To the extent necessary, we decide below the parties’ major evidentiary objections going to the admissibility, rather than the weight, of certain evidence.” *Id.*

#### **1. Petitioner’s Objections**

Petitioner lodges objections to two of Respondent’s Notices of Reliance under the caption “Caterpillar’s Procedural Objections.” 230 TTABVUE 14. Petitioner objects to Respondent’s Notice of Reliance No. 3 on the ground that the “submitted materials are not printed publications, are not self-authenticating, and do not otherwise meet the requirements of [TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section] 704.08(c).” *Id.* at 15. Respondent’s Notice of Reliance No. 3 covers what Respondent describes therein as “photographs of apparel . . . attached hereto as Exhibits C-1 to C-20.” 144 TTABVUE 2.

Petitioner objects to Respondent’s Notice of Reliance No. 14 on the ground that the “submitted catalogs do not constitute traditional printed publications under TBMP 704.08(a), nor has Puma met its burden of showing that the catalogs are available to the general public or otherwise in general circulation.” 230 TTABVUE

15. Petitioner further objects on the ground that “[a]part from Puma’s allegations in the Notice of Reliance that the catalogs ‘are available on e-commerce sites such as Amazon and eBay, and through Arctic Cat dealers,’ the catalogs themselves contain no source, date, or circulation information.” *Id.* Respondent’s Notice of Reliance No. 14 covers what Respondent describes therein as “excerpts from ARCTIC CAT catalogs from 1992, 1999, 2005, and 2017,” which Respondent claims are “available to the general public on e-commerce sites such as Amazon and eBay, and through Arctic Cat dealers, both in physical and electronic form,” and are “also in general circulation among members of the public and the segment of the public purchasing or interested in purchasing Arctic Cat products.” 162 TTABVUE 2.

Finally, “[w]ith respect to any oral testimony or accompanying exhibits on which Puma seeks to rely, [Petitioner] incorporates by reference all objections it made on the record in connection with such testimony/exhibits.” 230 TTABVUE 15.

Respondent summarizes its arguments in response to these objections as follows:

Caterpillar’s Procedural Objections are untimely and should be denied. First, as Caterpillar’s own section title in its brief states, these objections are procedural in nature, not substantive, and should have been raised before now. Second, the evidence in both PUMA’s Third and Fourteenth Notices of Reliance complies with the Board’s rules of practice and further has been supported through foundational testimony provided by PUMA’s witnesses. Third, Caterpillar’s blanket objection seeking to preserve all previous objections throughout the entire proceeding is improper in that it expects PUMA and the Board to cull through all transcripts searching for possible objections that Caterpillar may seek to maintain. If Caterpillar wished to maintain such objections, the burden is on Caterpillar as the objecting party to identify its own objections with specificity and provide a basis for

maintaining those objections. Any objections not specifically addressed through briefing should be deemed waived.

232 TTABVUE 70.

In an appendix to its reply brief, Petitioner responds to Respondent's untimeliness argument as follows:

It is the Board's policy not to read trial testimony or examine other trial evidence prior to final decision. . . . To reach its determination that evidence submitted with Notice of Reliance Nos. 3 and 14 does not consist of printed publications, is not available to the general public, and is not self-authenticating in accordance with Trademark Rule 2.122(e) and TBMP 704.08, the Board necessarily must examine the extensive trial testimony and related exhibits cited by Puma in Appendix B of its trial brief. Despite the fact that Puma takes issue with Caterpillar's use of the word "procedural" in Caterpillar's evidentiary objections, "the determination of a motion that requires consideration of the substance of trial evidence, and not merely whether the evidence meets the applicable procedural requirements, including disclosure requirements, is deferred." . . . . Moreover, Caterpillar's objections do not relate to the procedural aspects of the Notices of Reliance, but to the characterization of the evidence itself; these are not defects that are curable, and a pre-trial motion would have been deferred.

233 TTABVUE 31 (citations omitted).

We agree with Respondent that Petitioner's objections to the materials attached to Respondent's Notice of Reliance Nos. 3 and 14 are procedural in nature and should have been raised promptly following the filing of the Notices. Petitioner argues in its reply brief that "[t]he photographs of apparel are not proper subject matter for introduction into evidence by way of a notice of reliance," 233 TTABVUE 31 (citations omitted), and that "[a]s a general rule, catalogs are not considered to be printed

materials in general circulation within the meaning of Rule 2.122(e),” *id.* at 32 (citations omitted), and Petitioner undoubtedly knew this when Notice of Reliance Nos. 3 and 14 were first filed. If Petitioner had objected promptly, Respondent might have been able to submit these materials in another manner.<sup>7</sup> We find that Petitioner waived its objections to these Notices of Reliance by raising them for the first time in its trial brief. *Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 USPQ2d 714, at \*12-13 (TTAB 2022) (holding that an objection to a notice of reliance on the ground that its attachments were not proper subjects for submission under notice of reliance was a procedural objection that was waived when not timely asserted and raised for the first time in the party’s brief). We **overrule** Petitioner’s objections to Notice of Reliance Nos. 3 and 14 and have considered them for whatever probative value they may have.

Petitioner does not respond in its reply brief to Respondent’s arguments regarding Petitioner’s purported incorporation by reference of its deposition objections, and we agree with Respondent that its objections to such purported incorporation are well-taken. *See generally* TBMP Section 707.03(c)(1) and cases cited in n.12. We have disregarded each of Petitioner’s objections to deposition testimony and exhibits made during the taking of testimony unless it was specifically renewed in Petitioner’s brief.

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<sup>7</sup> We note in that regard that most of the attachments to Notice of Reliance Nos. 3 and 14 were authenticated and discussed in the Shanks Testimony Deposition. 232 TTABVUE 72-78 (summarizing Mr. Shanks’ testimony regarding Exhibits C-1-C-17 to Notice of Reliance No. 3 and Exhibits N-1-N-4 to Notice of Reliance No. 14).

## 2. Respondent's Objections

Respondent objects to certain portions of the testimony of Petitioner's witnesses Lantz-Rickard and Beaupre and certain exhibits thereto, as well as to Petitioner's Rebuttal Notice of Reliance No. 11. We address only those objections that pertain to evidence that we have considered in our decision on Petitioner's Section 2(d) claim. *Kohler*, 125 USPQ2d at 1478.<sup>8</sup>

Respondent argues that Mr. Beaupre has not been identified as an expert witness by Petitioner, and that he should not be considered as such. 232 TTABVUE 60. Alternatively, Respondent lodges an objection under *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 27 USPQ2d 1200 (1993), to his characterization of a certain in-house survey, which Respondent claims is "unreliable and not credible evidence." 232 TTABVUE 60.

Respondent "objects to Paragraphs 41 and 42 and associated Ex. 24 of the [Beaupre] Affidavit . . . on the grounds that the submitted material is opinion testimony from a nonexpert and is based on facts that are outside of the affiant's personal knowledge, and/or is improper lay witness testimony." *Id.* at 64. Paragraph 41 is not relevant to our analysis of the likelihood of confusion, and we do not rely on it in that regard, so we need not address Respondent's objection to that paragraph. Paragraph 42, however, is directly relevant to the fame of Petitioner's mark in

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<sup>8</sup> The objected-to portions of Ms. Lantz-Rickard's Affidavit appear to be directed primarily to Petitioner's dilution claim, which we do not reach, and we do not rely on these portions of her testimony in our analysis of the fame of Petitioner's mark for likelihood of confusion purposes, so we need not address Respondent's objections to her testimony. We also need not address Respondent's objection to Petitioner's Rebuttal Notice of Reliance No. 11 because we do not rely on it in our analysis of the likelihood of confusion.

connection with footwear, which we discuss below in our analysis of the likelihood of confusion, so we will decide Respondent's objection.

Paragraph 42 refers to a 2009 CAT Footwear study that Mr. Beaupre testified showed a high level of "brand awareness of CAT footwear products among the U.S. public." Beaupre Aff. ¶ 42 (106 TTABVUE 48). Paragraph 42 includes what appears to be a slide from a presentation of that study that references the claimed high level of awareness. Exhibit 24 is the slide shown in paragraph 42. 103 TTABVUE 251.

Respondent argues that the referenced testimony and exhibit do "not include any associated underlying data or explanation on survey methodology," 232 TTABVUE 65, and that Mr. Beaupre confirmed this on cross-examination and also admitted that he had provided no information regarding how the study was developed and conducted. 231 TTABVUE 65. Respondent argues that it "has no way of knowing if the opinions expressed by Mr. Beaupre in Paragraphs 41, 42 and Ex. 24 qualify as 'testimony [ ] based on sufficient facts or data,' or if they are 'the product of reliable principles and methods' because Mr. Beaupre did not provide any, and it is therefore not admissible evidence." *Id.* Respondent argues in the alternative that Mr. Beaupre's testimony is improper lay witness testimony. *Id.* at 66.

Petitioner responds that the objected-to testimony "is clear, convincing, uncontradicted, and probative by virtue of [Mr. Beaupre's] role as brand licensing manager for Caterpillar for the past decade and his experience with Caterpillar's licensed merchandise business for over twenty-two years." 233 TTABVUE 37. Petitioner claims that Mr. Beaupre's recounting of "facts from brand awareness and

customer satisfaction studies conducted by Caterpillar over the course of his employment with Caterpillar's licensed merchandise business does not render Mr. Beaupre an expert," and that his testimony is "permissible lay opinion testimony." *Id.* at 38.

We need not resolve the issue of whether Mr. Beaupre's testimony here is that of an expert or a lay witness to rule on Respondent's objection. The problem here is not with Mr. Beaupre's status, but rather that he provides nothing more than the claimed results of a footwear study about which he apparently knows little. Beaupre Conf. Tr. 104:7-106:16 (179 TTABVUE 108-10). Because he (and we) know nothing about the survey's methodology, universe, sampling, or stimulus, we **sustain** Respondent's objection and have given Mr. Beaupre's testimony regarding the results of the survey no consideration in our decision.

## **II. The Parties**

These two dueling cats are heavyweights. Petitioner adopted the CAT brand in 1949, and it has been the company's primary public-facing brand name ever since. Lantz-Rickard Aff. ¶ 3 (107 TTABVUE 3). Petitioner's core business is heavy machinery, and it is today the world's leading manufacturer of construction and mining equipment, gas engines, industrial gas turbines, and diesel-electric locomotives. Lantz-Rickard Aff. ¶¶ 3-4, 12 (107 TTABVUE 3, 7). As discussed below, Petitioner has expanded the use of its CAT brand into a variety of other products, including footwear and apparel.

Respondent's predecessor-in-interest was founded in 1948, and Respondent has sold sporting goods for decades. Narriman Decl. ¶¶ 8-12 (139 TTABVUE 4-5). Respondent designs and manufactures athletic and casual footwear, apparel, and accessories. The Puma brand has evolved into an all-encompassing brand beyond sports, Narriman Decl. ¶ 12 (139 TTABVUE 5), but footwear is Respondent's main business. Narriman Tr. 94:15-16 (193 TTABVUE 98). Respondent is one of the top five sportswear brands in the world by revenue. Narriman Decl. ¶ 13 (139 TTABVUE 5).

### **III. Entitlement to a Statutory Cause of Action**

“Entitlement to a statutory cause of action, formerly referred to as ‘standing’ by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case.” *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at \*17 (TTAB 2022) (citations omitted); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). “A party in the position of plaintiff may petition to cancel registration of a mark when such cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1064, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark.” *JNF LLC v. Harwood Int'l Inc.*, 2022 USPQ2d 862, at \*3-4 (TTAB 2022) (citing *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014); *Corcamore LLC v. SFM LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020)). Petitioner



“must maintain its entitlement to the statutory cause of action throughout the proceeding and affirmatively prove its existence at the time of trial by introducing evidence to support the allegations in its pleading that relate to such entitlement as an element of its case-in-chief.” *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at \*11 (TTAB 2021), *aff’d mem.*, 2022 WL 3147202 (Fed. Cir. Aug. 8, 2022).

To “establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit. . . .” *JNF*, 2022 USPQ2d 862, at \*4 (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)). Petitioner made of record numerous registrations of CAT-formative marks for various goods, including the registration of CAT (in standard characters) for footwear on which we focus below. “Accordingly, Petitioner may seek to cancel Respondent’s registration, as its claim is within the zone of interests protected by statute and Petitioner has a reasonable belief in damage proximately caused by the continued registration of Respondent’s mark.” *Id.* See also *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at \*11-12 (TTAB 2023).

#### **IV. Petitioner’s Section 2(d) Claim**

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with

the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

We focus our analysis on Petitioner’s Section 2(d) claim on the standard-character CAT mark shown in Petitioner’s Registration No. 3365449 for goods identified as “footwear” (the “449 Registration”). 83 TTABVUE 63-66.<sup>9</sup> Of the numerous CAT-formative marks pleaded by Petitioner, the standard-character CAT mark in the ’449 Registration is the one that “has the most points in common with” Respondent’s PROCAT mark.<sup>10</sup> *Monster Energy*, 2023 USPQ2d 87, at \*12. “If we find a likelihood of confusion as to that mark and those goods, we need not find it as to [Petitioner’s] other registered marks[.]” *New Era*, 2020 USPQ2d 10596, at \*9-10.

#### A. Priority

“In a cancellation proceeding such as this one where both parties own registrations, priority is in issue.” *Sabhnani*, 2021 USPQ2d 1241, at \*15 (quoting *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*4 (TTAB 2019)). “Petitioner must prove that [it] has a proprietary ‘interest in [its] mark . . . and that interest was obtained prior to either the filing date[ ] of [Respondent’s] [underlying] application[ ] for registration or [its] date[ ] of first use.’” *Id.* (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at \*4-5 (internal quotation omitted)).

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<sup>9</sup> The ’449 Registration issued on January 8, 2008 and has been renewed. 83 TTABVUE 64.

<sup>10</sup> The parties’ briefs both display Respondent’s mark as “PROCAT,” and we do the same in this opinion, but we have taken into account the stylized manner in which the mark has been registered in our analysis of the similarity or dissimilarity of the marks.

The application that matured into Respondent's registration was filed on May 17, 2012, and claimed a priority date of January 3, 2012 based on Respondent's International Registration No. 1114537. Respondent does not claim any prior use of its mark, so its January 3, 2012 priority date "is the earliest date on which [it] may rely." *Id.*

"Petitioner may rely on the [May 18, 2007] filing date of the application that matured into [the '449] Registration . . . which is long prior to Respondent's . . . priority date." *Id.*, at \*15-16. Petitioner has thus established its priority.

### **B. Likelihood of Confusion**

"Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 567 (CCPA 1973) ("*DuPont*")." *Sabhnani*, 2021 USPQ2d 1241, at \*16. "We consider each *DuPont* factor for which there is evidence and argument." *Id.* (citation omitted).

"In every case under Section 2(d), 'two key considerations are the similarities between the marks and the similarities between the goods.'" *Id.* (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at \*5 (citing *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.")). "Petitioner 'bears the

burden of proving a likelihood of confusion by a preponderance of the evidence.” *Id.* (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at \*5).

Petitioner addresses the key first and second *DuPont* factors, 230 TTABVUE 44-48, as well as the third factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 177 USPQ at 567, 230 TTABVUE 48-49; the fourth factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567, 230 TTABVUE 49-50; the fifth factor, the “fame of the prior mark (sales, advertising, length of use),” *DuPont*, 177 USPQ at 567, 230 TTABVUE 41-44; the sixth factor, the “nature and number of similar marks in use on similar goods,” *DuPont*, 177 USPQ at 567, 230 TTABVUE 50-51, and the seventh and eighth factors, the “nature and extent of any actual confusion” and the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567, 230 TTABVUE 51-52.

Respondent does not address the second, third, and fourth factors, but argues that confusion is unlikely based on the first, sixth, seventh, and eighth factors, as well as the eleventh factor, the “extent to which applicant has a right to exclude others from use of its mark on its goods.” *DuPont*, 177 USPQ at 567, 232 TTABVUE 33-46.<sup>11</sup>

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<sup>11</sup> Respondent combines the sixth and eleventh *DuPont* factors in arguing that “[e]xtensive third-party use has weakened the CAT mark.” 232 TTABVUE 43. The gist of this section of Respondent’s brief is that Respondent “has provided extensive evidence detailing third-party use of ‘cat’-containing marks with similar goods.” *Id.* We discuss that evidence in our analysis of the sixth *DuPont* factor below. The eleventh factor concerns “the extent to which [the defendant] has a right to exclude others from use of its mark on its goods (in the instant [application or registration]).” *Made in Nature*, 2022 USPQ2d 557, at \*62. It “does not consider the strength or fame of the [defendant’s] mark in the same way the scope of

**1. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers**

“We begin with the second and third *DuPont* factors, which respectively consider ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’ and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhnani*, 2021 USPQ2d 1241, at \*19 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567)). “We also discuss the portion of the fourth *DuPont* factor that addresses the ‘buyers to whom sales are made.’” *Id.* (quoting *DuPont*, 177 USPQ at 567). “Apparently conceding the issue, [Respondent] did not address these [*DuPont*] factors in its brief, so we offer only a brief explanation of our conclusion.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1740 (TTAB 2016).

“In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the parties’ registrations.” *Sabhnani*, 2021 USPQ2d 1241, at \*19 (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at \*5). Respondent’s registration and the ’449 Registration both cover goods identified as “footwear,” and the goods are thus identical in part.<sup>12</sup> As a result, the second *DuPont* factor “strongly supports a finding of a likelihood of confusion.” *Id.*

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protection is determined for the prior user under *DuPont* factor five” or six. *Monster Energy*, 2023 USPQ2d 87, at \*46. The eleventh factor does not appear to be applicable here in any event because the involved goods are identical. *Id.*, at \*47.

<sup>12</sup> As noted above, Respondent’s Class 25 registration covers socks, footwear, and headwear. To prevail as to the entire registration, Petitioner need not show that there is a likelihood of confusion as to all three of these goods because “likelihood of confusion must be found as to

“The ‘identical goods in the parties’ registrations are construed to include all goods of the type identified and [i]t is well established that absent restrictions in the . . . registration[s], [identical] goods . . . are presumed to travel in the same channels of trade to the same classes of purchasers.” *Id.*, at \*20 (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at \*5 (internal quotation omitted)). There are no limitations on the “footwear” identified in the parties’ registrations, and the “third *DuPont* factor and the portion of the fourth *DuPont* factor regarding the buyers to whom sales are made thus also strongly support a finding of a likelihood of confusion.” *Id.*, at \*21.

## **2. Purchasing Conditions and Consumer Sophistication**

“The fourth *DuPont* factor also considers ‘[t]he conditions under which . . . sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *In re Embiid*, 2021 USPQ2d 577, at \*31 (TTAB 2021) (quoting *DuPont*, 177 USPQ at 567).

Petitioner argues that the “CAT and PROCAT registrations do not contain any restrictions as to a particular price point or class of consumers,” and that the “Board must presume that the parties offer ordinary, inexpensive clothing, footwear, and headwear items.” 230 TTABVUE 49. Petitioner further argues that this presumption “reflects reality, as retail prices for Caterpillar’s CAT-branded footwear and apparel generally range from \$9.99 to \$270” and the “prices of Puma’s footwear, headband, and sock products similarly range from \$10.00 to \$30.00.” *Id.* As noted above, Respondent does not address this *DuPont* factor, although elsewhere in its brief it

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the entire class if it exists as to [any] good” in the registration. *Sabhnani*, 2021 USPQ2d 1241, at \*19 n.17.

states that its PROCAT footwear “is sold at an entry level price point for youth soccer of less than \$20.” 232 TTABVUE 38-39.

The goods identified in Respondent’s registration as “footwear” “encompass ‘all goods of the type identified, without limitation as to their nature or price.’” *Embiid*, 2021 USPQ2d 577, at \*32 (quoting *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at \*8 (TTAB 2020)). We thus must assume that the identified goods include inexpensive footwear purchased by ordinary consumers. *Id.* (finding that goods identified as “shoes” “include off-the-shelf items purchased by all manner of people’ and worn by virtually everyone” (quoting *Indus. Nucleonics Corp. v Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973)).

The record shows that goods falling within the identification of “footwear” in Respondent’s registration have been offered for as little as \$13.98 and \$20.00 per pair. 118 TTABVUE 18-20, 29-45.<sup>13</sup> This inexpensive footwear can also be “purchased online directly from the vendor without the involvement of a salesperson.” *Embiid*, 2021 USPQ2d 577, at \*32 n.47. Here, as in *Embiid*, “[w]e find that the purchaser care factor is neutral in our analysis of the likelihood of confusion.” *Id.*, at \*33.

### 3. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani*, 2021 USPQ2d 1241, at \*26 (quoting *Palm Bay Imps., Inc. v.*

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<sup>13</sup> These documents, which include pages from Respondent’s website, were produced by Respondent pursuant to Rule 33(d) of the Federal Rules of Civil Procedure in its First and Fourth Supplemental Responses to Petitioner’s Interrogatory Nos. 1, 6-7, 10, and 15. 119 TTABVUE 7-51 (filed under seal).

*Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d, 1689, 1691 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quotation omitted), *aff’d mem.*, 777 F. Appx. 516 (Fed. Cir. 2019)).

“The proper test regarding similarity ‘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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted)). As discussed above in our analysis of the classes of consumers for goods identified as “footwear,” the average customers here must be deemed to include ordinary consumers of footwear. *See Embiid*, 2021 USPQ2d 577, at \*32 (goods identified as “shoes” are “purchased by all manners of people” and “worn by virtually everyone” (quotations omitted)).

**a. The Parties’ Arguments**

Petitioner argues that “[c]onsumers familiar with Caterpillar’s CAT-branded footwear and apparel products who encounter the PROCAT mark are likely to



perceive that Puma has incorporated CAT as the dominant, source-identifying element and paired it with the descriptive term ‘PRO.’” 230 TTABVUE 44. Petitioner further argues that the “pro-” prefix in Respondent’s mark will be perceived as weak because of the “(a) USPTO’s routine requirement that ‘PRO’ be disclaimed for Class 25 goods . . . ; (b) common dictionary meanings for the PRO- prefix as ‘professional’ or ‘in favor of’ . . . ; (c) Puma’s PROCAT consumer study materials referencing the ‘professional’ meaning . . . ; and (d) Puma’s use of phrases like ‘pro or rookie’ or ‘play like the pros’ with other products that incorporate ‘PRO’ in the name . . . .” *Id.* at 44-45 (citations omitted).

Petitioner further argues that

consumers are likely to view the addition of the descriptive term “PRO” as a brand expansion of Caterpillar’s CAT mark, a co-branding between Puma and Caterpillar, or other association between the parties. Puma’s prior commercial uses of the mark as “ProCat” or PROCAT in a manner that visually separates the “PRO” and “CAT” portions of the mark . . . only increases the possibility that “CAT” will be perceived as a separate, dominant element and that the PROCAT mark is likely to be associated with, sponsored by, or otherwise affiliated with the famous CAT brand.

*Id.* at 46 (emphasis supplied by Petitioner; citations omitted).

Petitioner also argues that “[b]ecause PROCAT incorporates the distinctive and famous CAT mark in its entirety, the marks should be considered similar,” and that “because the CAT mark is registered in standard character form for its footwear and apparel products, all potential depictions of the mark must be considered regardless of capitalization, font, or style,” such that “the minimal stylization in the PROCAT mark does not distinguish it from the CAT mark.” *Id.* at 47.

Petitioner concludes that “[i]n view of the broad scope of protection that the famous CAT mark should be afforded and the fact that the parties’ respective goods are identical, the Board should find that CAT and PROCAT are similar in overall commercial impression and weigh this factor in Caterpillar’s favor.” *Id.* at 48.

Respondent argues that “[a]llowing PUMA to maintain its stylized PROCAT registration for clothing (namely, socks, footwear, and headbands) will not create a likelihood of confusion because, when viewed in their entirety, PROCAT’s stylization and use of the term ‘pro’ is transformative to PUMA’s mark, creating a mark readily discernible from Caterpillar’s trademarks.” 232 TTABVUE 34. Respondent further argues that “the weakness of ‘cat’ as a source indicator further obviates any chance of confusion between the parties’ marks. In short, PUMA’s PROCAT marks and Caterpillar’s marks create distinct commercial impressions.” *Id.*<sup>14</sup> Respondent claims that the dissimilarity of the marks “ought to be the end of the analysis” of the issue of likelihood of confusion. *Id.*

Respondent further argues that “while both Caterpillar’s and PUMA’s marks contain the letters c-a-t, the similarity ends there,” but that “[i]nstead of focusing

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<sup>14</sup> Respondent claims that the majority of Petitioner’s “evidence focuses on use of its CAT logo, with its capital block letters over a triangle” but that Petitioner’s “legal argument attempts to shift the focus to the CAT *word mark*, which is nothing more than the common letters c-a-t.” 232 TTABVUE 34 (emphasis supplied by Respondent). According to Respondent, “[t]his pivot is perhaps understandable: the only thing Caterpillar has in common with PROCAT is those letters. Yet this is precisely the problem with Caterpillar’s confusion claim: in focusing so narrowly on those three letters, Caterpillar ignores critical context, including design elements of Caterpillar’s Reg. Nos. 1,908,556 and 2,234,260 for the CAT logo, which must be considered when assessing a likelihood of confusion for those registrations.” *Id.* at 33-34. As noted above, we confine our analysis to Petitioner’s ’449 Registration of CAT in standard characters for footwear, and do not address Respondent’s arguments regarding the dissimilarity of Petitioner’s composite marks to Respondent’s mark.

exclusively on this similarity as Caterpillar urges, a proper analysis must consider whether the differences in the marks give the marks a distinct sound, appearance, and connotation when viewed as a whole.” *Id.* at 37. According to Respondent, “differences at the beginning of the mark are the most relevant, as this is the part of the mark that receives the most focus,” and “[h]ere, ‘PRO’ (or the letters p-r-o) has not been disclaimed and has trademark and market significance, resulting in a mark that when taken as a whole—as it must be—has a different appearance, sound, connotation, and commercial impression than the Caterpillar marks.” *Id.* at 37-38.

Respondent further argues that in claiming “that PROCAT is not unitary and that ‘pro’ connotes ‘professional,’ thereby increasing the likelihood of confusion, [Petitioner] misses the mark” because the USPTO and the Board “routinely register trademarks using the term ‘pro’ or the letters ‘p-r-o’ as part of the mark *without* disclaimer, just as they did when allowing PUMA’s PROCAT mark to register.” *Id.* at 38 (emphasis supplied by Respondent). Respondent cites 58 registrations and applications in which PRO has not been disclaimed, *id.*, and argues that the USPTO and the Board “also recognize that ‘pro’ does not always mean ‘professional’ and can mean ‘for,’ as is PUMA’s intent.” *Id.* According to Respondent, consumers “are unlikely to perceive PROCAT as professional because it is a product line for small children . . . and the product is sold at an entry level price point for youth soccer of less than \$20.” *Id.* at 38-39 (citations omitted). Respondent further argues that “PROCAT is composed of more syllables and more letters than CAT and as a result sounds significantly different.” *Id.* at 39.

Respondent also claims that CAT, standing alone, is an inherently weak mark. *Id.*

Respondent argues that

Caterpillar's attempted elision of its logo-focused evidence and its word-focused arguments appears intended to obscure the fundamental problem with its confusion claim: the letters c-a-t *without* the Caterpillar stylized CAT logo or combined use with the CATERPILLAR mark simply do not carry the robust source identification Caterpillar claims. Any significance of the shared term 'cat' is minimal because 'cat' has been registered by many third parties in Class 25 as an element of a larger trademark.

*Id.* at 39-40 (emphasis supplied by Respondent).

Respondent argues that third-party registrations of CAT-formative marks in Class 25 "have evidentiary value because they demonstrate how a mark is used in ordinary parlance, like a dictionary definition," and because they "demonstrate that the [USPTO], by allowing so many marks featuring the shared portion, recognizes that parts of the marks *other than* the shared portion are sufficient to differentiate the marks as a whole and make confusion unlikely." *Id.* at 40 (emphasis supplied by Respondent). On this point, Respondent concludes that

[s]tanding alone, the common use of the letters c-a-t can form no reasonable basis for contending that the parties' marks as a whole are likely to be viewed as closely similar or as coming from the same or related sources, any more than common English words such as catwalk, catsuit, or catamaran would be associated with Caterpillar Inc.

*Id.*

Finally, Respondent argues that the marks "are distinct because they provide consumers with different commercial impressions." *Id.* at 41. According to Respondent, its "PROCAT mark is a continuation of [its] long history of using feline

imagery and its use of ‘cat’ in its product names” and it “considers the term ‘cat’ as a reference to a feline (i.e., a puma) to be important to its brand identity.” *Id.* Respondent claims that it “developed the PROCAT mark because it wanted a name that referenced a cat to align with PUMA’s brand and logo, and also wanted to imply that the products bearing the mark were *for* ‘cats,’ with ‘cats’ being primarily PUMA’s child customers,” and that its “PROCAT mark furthers a consumer impression associated with felines.” *Id.* (emphasis supplied by Respondent; citations omitted).

Respondent contrasts this claimed meaning with the claimed meaning of Petitioner’s CAT mark, which Respondent argues is managed by Petitioner “so that its CAT marks are *never* associated with felines.” *Id.* (emphasis supplied by Respondent). Respondent notes the co-existence of Petitioner’s CAT marks with various marks such as BOBCAT for apparel and PROCAT for a lawnmower. *Id.* at 42. On this point, Respondent concludes that “[w]hen viewing the marks as a whole, the overall commercial impressions of PROCAT and Caterpillar’s marks are markedly different, making confusion unlikely.” *Id.*

In its reply brief, Petitioner argues that “[w]hile Puma is correct that marks sharing a common component do not automatically create a likelihood of confusion, the common component here is the famous CAT mark,” and “CAT is the dominant portion of the PROCAT mark and should be given more weight in the similarity analysis than the descriptive component ‘PRO.’” 233 TTABVUE 21. According to Petitioner, “[a]s PROCAT contains a famous mark in its entirety, it is that portion of

the mark that must be given overriding weight in the similarity analysis—regardless of where in the mark the famous mark appears.” *Id.* at 22.

**b. Respondent’s Argument That CAT is An Inherently Weak Mark**

Because our analysis of the similarity or dissimilarity of the marks may be affected by the conceptual strength of Petitioner’s CAT mark, we begin with Respondent’s argument that the “fundamental problem” with Petitioner’s likelihood of confusion claim is that “the letters c-a-t *without* the Caterpillar stylized CAT logo or combined use with the CATERPILLAR mark simply do not carry the robust source identification Caterpillar claims” because “[a]ny significance of the shared term ‘cat’ is minimal because ‘cat’ has been registered by many third parties in Class 25 as an element of a larger trademark.” 232 TTABVUE 39-40 (emphasis supplied by Respondent). Respondent argues that it “submitted 39 third-party trademark registrations *for Class 25 goods* that contain the term ‘cat,’” *id.* at 19 (emphasis supplied by Respondent) (citing 143 TTABVUE 7-94), which are “relevant to prove that the shared portion of [the] parties’ marks has a well-understood and recognized suggestive or descriptive meaning, resulting in a finding of weakness of the shared portion.” *Id.* at 40. Respondent further argues that “the term ‘cat’ in connection with class 25 goods is not truly distinctive or source signifying” and that “[g]iven the inherent weakness of ‘cat’ as a word, the addition of ‘pro’ combined with the stylized lowercase letters is sufficient to differentiate the parties’ marks, making confusion between the marks unlikely.” *Id.*

At the outset, we note that the standard-character CAT word mark shown in the ’449 Registration is “registered on the Principal Register without a claim of acquired

distinctiveness and so is treated as inherently distinctive.” *Monster Energy*, 2023 USPQ2d 87, at \*20 (citing *New Era*, 2020 USPQ2d 10596, at \*10). The existence of the ’449 Registration is conclusive evidence of the validity of the registered mark. 15 U.S.C. § 1115(b). An inherently distinctive mark, however, may nonetheless have a particular meaning with respect to the involved goods, *New Era*, 2020 USPQ2d 10596, at \*10, so we must address Respondent’s evidence of third-party registrations of marks for the same or similar goods.

Respondent’s “[t]hird-party registrations ‘may bear on conceptual weakness if [CAT] is commonly registered for similar goods or services,’” *Sabhnani*, 2021 USPQ2d 1241, at \*22 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)), but of the cited 39 third-party registrations of CAT-formative marks, only nine cover goods identified either as “footwear,” the goods identified in the parties’ registrations, or as some form of shoes, goods that would be subsumed within “footwear.” The nine registrations are for the marks CATS,<sup>15</sup> 143 TTABVUE 18; ARCTIC CAT and design and ARCTIC CAT in standard characters, *id.* at 30, 86; SACRAMENTO RIVER CATS, *id.* at 36; LEOCAT, *id.* at 41; THUNDERCATS and design, *id.* at 45; LOVCAT and design, *id.* at 63; CAT & JACK, *id.* at 74; and CINCINNATI BEARCATS. *Id.* at 91.<sup>16</sup> Petitioner made of record

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<sup>15</sup> This registration covers shoes and other goods that are “offered and sold in association with the promotion of the University’s sports teams to persons desiring to associate themselves with the University of Arizona.” 143 TTABVUE 18.

<sup>16</sup> An investigation report prepared by Respondent’s private investigator William B. Shanks refers to a registration of DAVIDSON WILDCATS that allegedly issued to The Trustees of Davidson College on May 20, 2014 from an application covering “shoes” and other goods in Class 25. Shanks Tr. 18:9-16; Ex. 2 (183 TTABVUE 22, 228). The referenced registration is

USPTO electronic records indicating that the THUNDERCATS registration was cancelled with respect to shoes, sneakers, boots, and socks. 195 TTABVUE 82-83. “The existence of a cancelled registration—particularly one cancelled for failure to provide a declaration of continued use—does not tend to show that the cited mark is weak due to third-party use.” *New Era*, 2020 USPQ2d 10596, at \*13 (quoting *Inn at St. John’s*, 126 USPQ2d at 1745).<sup>17</sup>

With respect to the registrations covering various Class 25 goods other than footwear or shoes,<sup>18</sup> “Respondent simply assumes that [the various other goods] are ‘related goods’ to [footwear] . . . without any supporting argument, much less evidence.” *Sabhnani*, 2021 USPQ2d 1241, at \*25. But even assuming that the other goods are related to footwear, these registrations “have little or no probative value in showing the conceptual weakness of the word [CAT] in Petitioner’s mark” with respect to footwear itself. *Id.* (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017); *Inn at St. John’s*, 126 USPQ2d at 1745). *See also Made in Nature*, 2022 USPQ2d 557, at \*24 (“The third-party registrations of NATURE or MADE marks that Applicant submitted for products other than

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not of record, however, and we have given the reference in the investigation report no consideration in our decision.

<sup>17</sup> Petitioner also made of record USPTO electronic records stating that the registrations of the ARCTIC CAT composite mark and the CINCINNATI BEARCATS mark would be cancelled if certain required maintenance documents were not filed by specified dates, 195 TTABVUE 62, 70, 117, 121, but the registrations are characterized in the records as active and there is no evidence that they were subsequently cancelled, so we have considered them for whatever probative value they may have.

<sup>18</sup> Contrary to Respondent’s claim that the 39 registrations all cover goods in Class 25, 232 TTABVUE 19, four of them do not. 143 TTABVUE 14, 34, 49, 67.



Opposer’s identified goods have little or no probative value in showing the conceptual weakness of the terms NATURE or MADE in Opposer’s marks.”); *cf. Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1695 (Fed. Cir. 2018) (where the involved goods were identical meat products, third-party uses on other food products were “properly understood as having no real probative value for the analysis at hand.”).

Consequently, there are at most nine particularly relevant third-party registrations covering footwear or shoes, and that is a relatively small number in this context. *Sabhnani*, 2021 USPQ2d 1241, at \*25-26 (discounting the probative value of six relevant third-party registrations on conceptual weakness); *see also DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at \*28-32 (TTAB 2022) (finding that four registrations of shield marks “hav[ing] some resemblance to Opposer’s ‘S’ shield design marks” were “not qualitatively, nor quantitatively, analogous to the evidence the Federal Circuit found probative in *Juice Generation[, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015)] and *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015).”). Moreover, while the registrations all contain the word CAT, either in the singular or in the plural, eight of them “contain additional elements that cause . . . them to be less similar to Petitioner’s mark than Respondent’s” mark is to Petitioner’s mark. *Sabhnani*, 2021 USPQ2d 1241, at \*25. *See also Made in Nature*, 2022 USPQ2d 557, at \*25 (discounting the probative value of “marks containing additional elements, trademark formatives of different

grammatical syntax or having a differing overall commercial impression, rendering many of them less similar to Opposer's marks than Applicant's mark."). We find that Respondent's third-party registration evidence does not show any material conceptual weakness of the inherently distinctive standard-character CAT word mark shown in the '449 Registration.<sup>19</sup>

**c. The Dominant Portion of Respondent's Compound Mark**

"While the marks must be considered in their entirety, '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, provided the ultimate conclusion rests on consideration of the marks in their entirety.'" *Sabhnani*, 2021 USPQ2d 1241, at \*30-31 (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Respondent disputes that its PROCAT mark would be perceived as a compound mark presenting distinct words (PRO and CAT), or that CAT could be given greater weight in the analysis of similarity, as Petitioner argues. Instead, Respondent characterizes its PROCAT mark as a "unitary" mark. 232 TTABVUE 38. "[W]hen a mark as a whole creates a commercial impression separate and apart from any of its components, we consider the mark to be 'unitary.'" *In re Six Continents Ltd.*, 2022 USPQ2d 135, at \*18 (TTAB 2022). "The test for determining whether a composite

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<sup>19</sup> We address below Respondent's third-party use evidence of claimed commercial weakness of Petitioner's CAT mark under the sixth *DuPont* factor.

mark is unitary inquires whether the elements of a mark are so integrated or merged together that we cannot regard them as separable.” *Id.* “The inquiry focuses on ‘how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark.” *Id.*, at \*19 (quoting *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991)).

The Federal Circuit “has set forth the following elements of a unitary mark:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.”

*Id.* (quoting *Dena*, 21 USPQ2d at 1052).<sup>20</sup>

Respondent admitted that PROCAT does not have any dictionary meaning, Resp. to Req. for Adm. No. 5 (93 TTABVUE 8), and is “an artificial name,” *Narriman Tr.* 36:1-3 (193 TTABVUE 40), and there is no evidence that the word “has a distinct meaning of its own independent of the meaning of its constituent elements.” *Six Continents*, 2022 USPQ2d 135, at \*19. As a result, PROCAT is appropriately considered a “compound” mark; that is, it contains the multiple identifiable elements PRO and CAT. It is not a “unitary” mark like PROFILE that has a distinct meaning separate and apart from its constituent elements, because “consumers who encounter

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<sup>20</sup> Examples of PRO-prefix formative words that would likely be considered unitary under these standards if they were used as trademarks are the words “profile” and “promotion.”

[Respondent's] mark would readily recognize its constituent terms, [PRO and CAT]" and "when a compound term comprises two ordinary English words, consumers often recognize them as such, rather than considering the combination to be a fanciful term with no meaning at all" and "whether such a mark appears as one word or two often has little or no effect on consumers' impression of it." *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd*, 115 USPQ2d 1816, 1824 (TTAB 2015).<sup>21</sup>

Compound marks such as PROCAT that do not have a distinct meaning apart from their constituent elements may have a dominant portion. *Id.* at 1825 (finding that BUD was the dominant portion of the applicant's WINEBUD compound mark for alcoholic beverages, including wines). As discussed above, the parties disagree about the dominant portion of Respondent's PROCAT mark. Respondent argues that if its "unitary" mark PROCAT has a dominant portion, it is PRO, 232 TTABVUE 37-38, while Petitioner argues that "CAT is the dominant portion of the PROCAT mark and should be given more weight in the similarity analysis than the descriptive component 'PRO.'" 233 TTABVUE 21. Accordingly, we will begin by determining whether Respondent's PROCAT mark has a dominant portion before turning to a comparison of the marks in their entireties.

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<sup>21</sup> In several exhibits to Respondent's Notice of Reliance Nos. 5-6, which Respondent states show "continued use in commerce of the PROCAT mark," 146 TTABVUE 2; 149 TTABVUE 3, the words "pro" and "cat" are regularly rendered on and in connection with footwear as "ProCat" and often in separate colors. 146 TTABVUE 8, 18, 22, 26, 34, 39, 44; 149 TTABVUE 99, 104. Mr. Narriman also displayed and discussed use of the words "pro" and "cat" in different colors as examples of current use of the mark on footwear. Narriman Decl. ¶ 53 (139 TTABVUE 24). These uses corroborate that consumers would likely view Respondent's PROCAT mark as a compound of the words PRO and CAT rather than as a single term with a "distinct meaning of its own independent of the meaning of its constituent elements." *Six Continents*, 2022 USPQ2d 135, at \*19 (internal quotation omitted).

We agree with Respondent that elements at the beginning of a mark are often given greater weight, but the nature of the words PRO and CAT in Respondent's compound mark, and the structure of the mark, "counsel[ ] against a reflexive application of [that] principle." *Sabhnani*, 2021 USPQ2d 1241, at \*37 (finding that the word MIRAGE was the more significant portion of the respondent's ROYAL MIRAGE word mark). The "PRO-" prefix in Respondent's PROCAT mark "could be perceived as an abbreviation for 'professional,'" *New Era*, 2020 USPQ2d 10596, at \*14, as the Board has long recognized that "[t]he word 'PRO' has a laudatory connotation as applied to most products and services indicating that they are utilized by professional or are of professional quality." *Id.*, at \*15 (quoting *BAF Indus. v. Pro Specialties, Inc.*, 206 USPQ 166, 175 (TTAB 1980)). *See also Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1858 (TTAB 2008) (holding that the "Bass Pro Shops" logo in the petitioner's composite mark Bass Pro Shops Sportsman's Warehouse and design "specifically engender[ed] the commercial impression of a professional fisherman's sports center store.").

If PRO is perceived as "professional," it would have less source-identifying significance than CAT notwithstanding the position of PRO at the front of Respondent's compound mark. *See ProQuest Info. & Learning Co. v. Island*, 83 USPQ2d 1351, 1359 (TTAB 2007) (PRO found not to be the dominant portion of the opposer's PROQUEST mark because it was a "common, widely-used prefix[ ]"); *O. M. Scott & Sons Co. v. Kellogg Supply Co.*, 168 USPQ 122, 124 (TTAB 1970) ("it is our opinion that purchasers of the respective products of the parties will recognize and

associate the prefix ‘PRO’ with the word ‘professional’ and attribute little trademark significance thereto. That is, they will look to the other portions of the marks to distinguish between the marks as a whole.”).

Petitioner submitted considerable evidence to show that PRO has such a meaning in Respondent’s PROCAT mark. Petitioner made of record dictionary entries from the MERRIAM-WEBSTER DICTIONARY, COLLINS DICTIONARY, DICTIONARY.COM, OXFORD ENGLISH DICTIONARY, THE FREE DICTIONARY, LONGMAN DICTIONARY OF CONTEMPORARY ENGLISH, MACMILLAN DICTIONARY, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, and THE ONLINE SLANG DICTIONARY defining the noun and adjective “pro” as “professional,” 90 TTABVUE 6, 9, 12-13, 20, 28, 31, 35, 42, 45, and 52, as well as a webpage from abbreviations.com stating that “pro” is an abbreviation for “professional.” *Id.* at 38.

Petitioner also made of record USPTO electronic records regarding numerous registrations of marks for goods in Class 25 in which the word PRO has been disclaimed, alone or with other matter, together with portions of the file histories of many of those registrations.<sup>22</sup> These registrations include more than 20 that cover goods identified as “footwear” or some form of shoes. 115 TTABVUE 235-50, 264-68, 335-44, 359-89, 424-37, 467-677, 688-92, 989-92, 1131-43, 1189-1246, 1262-1365, 1402-40; 116 TTABVUE 2-39, 112-85. As discussed below, in those portions of the file histories that were included wherein the disclaimer requirement was made, the

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<sup>22</sup> Some of the USPTO electronic records submitted under Petitioner’s Notice of Reliance No. 9 pertain to pending applications. We have given them no consideration in our decision.

stated reason for the requirement of a disclaimer of PRO in the involved marks was usually the fact that PRO means “professional.” For its part, Respondent points to “58 examples where ‘pro’ was not disclaimed in applications and registrations,” 232 TTABVUE 38, and argues that the USPTO and the Board “also recognize that ‘pro’ does not always mean ‘professional,’” citing “51 examples of allowed trademark applications and registrations where ‘pro’ did not mean ‘professional.’” *Id.*

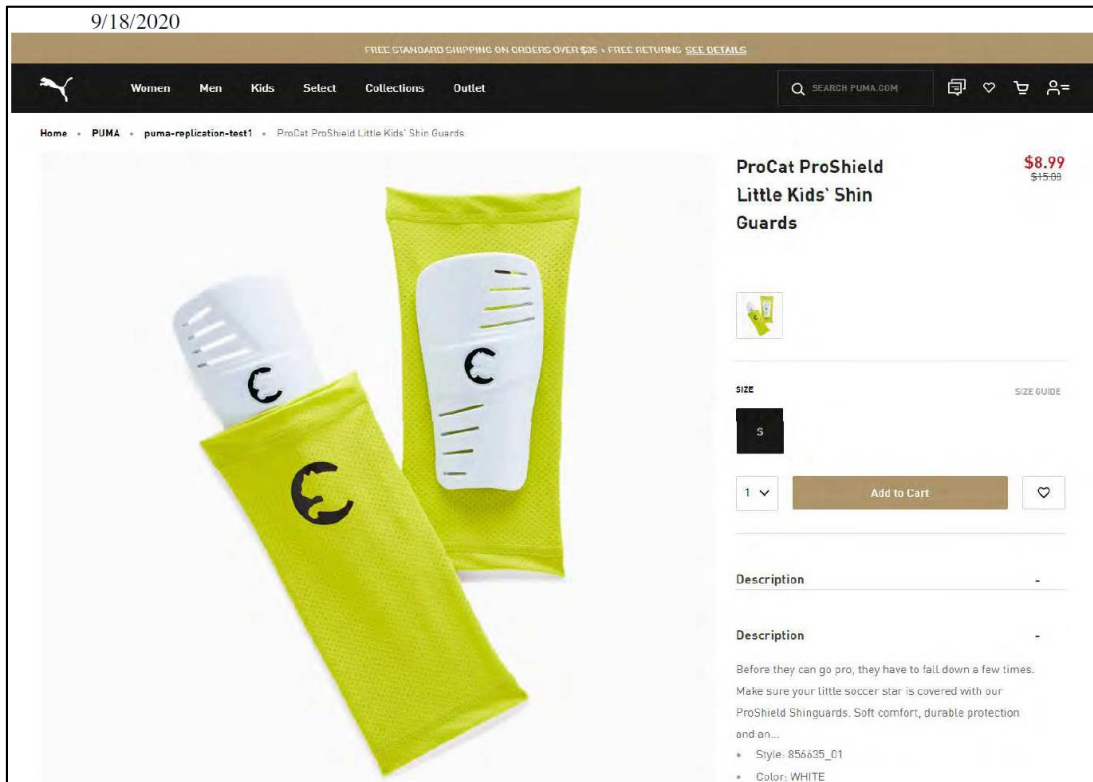
With respect to Respondent’s third-party registrations, of the 58 registrations in which PRO was not disclaimed, 23 cover “footwear” or some form of shoes,<sup>23</sup> and of the 43 registrations in which Respondent claims the word PRO did not mean “professional,” 14 cover “footwear” or some form of shoes.<sup>24</sup> Like Respondent’s PROCAT mark itself, some of these marks are shown as one compound word, or as two words joined by a hyphen or colon, in which a disclaimer of the word PRO would not be expected. These registrations have little or no probative value regarding the meaning of PRO in Respondent’s PROCAT mark.

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<sup>23</sup> Notice of Reliance No. 11, Exs. K-3 (PRO-MODERATOR), K-6 (PRO-THICKS), K-9 (PRO:DIRECT), K-10 (P PROGRIP (stylized)), K-13 (PROMAN), K-14 (PROWORKER), K-17 (ProGo USA), K-19 (PROLEVEL), K-20 (PRO STEPS), K-21 (TIMBERLAND PRO), K-22 (PRO and design), K-26 (PRO and design), K-31 (PRO RESULTS), K-32 (PRO KENNEX and design), K-35 (LT PRO), K-39 (PRO GEAR and design), K-40 (THE PROS BRAND), K-42 (PRO COMFORT FOOTWEAR), K-45 (PRO SL), K-48 (PRO MODEL), K-49 (PRO LINE and design), K-53 (PRO XP), and K-56 (PRO CAM-FIS and design). 154 TTABVUE 22-23, 43-53, 66-73, 74-79, 103-08, 109-14, 127-31, 137-41, 142-47, 148-53, 154-59, 183-87, 220-26, 227-35, 246-67, 309-14, 315-19, 325-30, 352-57, 370-74, 375-80, 403-09, 431-34.

<sup>24</sup> Notice of Reliance No. 12, Exs. L-11 (PRO-KEDS and design), L-14 (PRO SIMON (stylized)), L-19 (PRO KING and design), L-23 (PRO WEST), L-26 (PROFIRST), L-27 (PROTAURI and design), L-29 (PRONUPTIA (stylized)), L-32 (PROTACTIC), L-34 (PRO LiFek and design), L-38 (PROPERATOR and design), L-40 (PROCONSUL), L-44 (OVER PRO ACTIVE DUTY and design), L-46 (PROBLACKTIVE), and L-49 (PRO CALI and design). 155 TTABVUE 49-56, 66-71, 94-98, 118-23, 134-38, 139-43, 150-55, 169-74, 181-86, 204-11, 217-22, 238-43, 249-54, 265-69.

Petitioner also points to Respondent's own use of the word "pro" with respect to its goods. Petitioner made of record the following page from Respondent's website displaying its "ProCat ProShield Little Kids' Shin Guards":



117 TTABVUE 21. The product description states in part that "Before they can go pro, they have to fall down a few times. Make sure your little soccer star is covered with our ProShield Shinguards."<sup>25</sup> Against the backdrop of the dictionary meaning of

<sup>25</sup> Petitioner also cites confidential portions of Ms. Commander's cross-examination as support for its argument that PRO means "professional" in Respondent's mark. 230 TTABVUE 44-45. She was examined about a confidential consumer study that was conducted for Respondent by an outside company in which some shoppers described the PROCAT product as "professional." Commander Conf. Tr. 80:16-22, 86:1-88:18; Ex. 7 (175 TTABVUE 84, 90-92, 238-77). Most of the study is redacted, even in the version of the transcript that was filed under seal, and Ms. Commander testified that she was not familiar with it. Commander Tr. 80:13-81:8 (174 TTABVUE 85-86). Under the circumstances, we find that the comments of some shoppers do not establish the meaning of the PRO- prefix in Respondent's mark.



“pro,” we infer from this textual use of “pro” as an abbreviation for “professional” that the word “Pro” in the mark PROCAT for goods broadly identified as “footwear” would be understood by consumers to refer to the word “professional.”

Notwithstanding its own use of “pro” as an abbreviation for “professional” in its PROCAT advertising, Respondent argues that its intent in using PRO in its PROCAT mark is to “mean ‘for,’” 232 TTABVUE 38, and that “[c]ustomers are unlikely to perceive PROCAT as professional because it is a product line for small children . . . and the product is sold at an entry-level price point for youth soccer of less than \$20 . . . .” *Id.* at 38-39 (citations omitted). Respondent cites Mr. Petrick’s testimony on cross-examination that “PROCAT meant from the beginning for the cat or of the cat” and “[i]t was specifically, you know, meant to mean kind of like ‘Go, cat.’ It’s a brand for kids, you know, soccer products, so you know, it was indicating positivity about the cat.” Petrick Tr. 33:19-34:6 (176 TTABVUE 38-39). He testified that he doubted that consumers would perceive “pro” in PROCAT to mean professional “given the nature of the products.” Petrick Tr. 34:10-14 (176 TTABVUE 39).<sup>26</sup> Respondent also cites Mr. Mastrostefano’s confidential testimony on cross-examination to the same effect. Mastrostefano Conf. Tr. 36:7-37:20 (173 TTABVUE 185-86).

As discussed above, Respondent presented testimony as to the claimed derivation of its PROCAT mark, but as the Board explained in *New Era* in rejecting the

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<sup>26</sup> In his testimony declaration, Mr. Petrick similarly testified that the “PROCAT name arose because of the intended target for the product, children interested in soccer. The team wanted a name that referred to a cat to stay in line with PUMA’s brand and logo and also imply that the product was for cats, with cats being PUMA’s child customers (and their parents).” Petrick Decl. ¶ 13 (147 TTABVUE 4).

applicant's testimony that its PRO ERA mark was "an abbreviation for 'Progressive Era,'" "[t]he derivation of a mark is of no particular significance if the end result is a mark confusingly similar to a previously registered mark." *New Era*, 2020 USPQ2d 10596, at \*14 (quoting *In re Iowa Paint Mfg. Co.*, 149 USPQ 230, 231 (TTAB 1966) (citing *Meyer Chem. Co. v. Anahist Co.*, 263 F.2d 344, 120 USPQ 483, 484 (CCPA 1959) ("How the mark came to be adopted is not material to the issue.")). In that regard, Respondent has pointed to no evidence that any of its actual uses of its PROCAT mark that Respondent made of record have been perceived as communicating its claimed intended meaning of PRO to consumers. 146 TTABVUE 8-99; 149 TTABVUE 9-186.<sup>27</sup> "[T]here is nothing to suggest that purchasers of [Respondent's] goods are aware of the derivation of its [PROCAT] mark," *New Era*, 2020 USPQ2d 10596, at \*14 (quoting *Dap, Inc. v. Litton Indus., Inc.*, 185 USPQ 177, 178 n.2 (TTAB 1975)), and the "record is devoid of evidence that consumers are likely to perceive 'PRO' as it appears in [Respondent's] mark as" meaning "for," "in favor of," or, as Mr. Petrick claimed, "Go, cat." *Id.*

Although the dictionary definitions in the record indicate that "pro" may mean "for," the record as a whole establishes that the PRO- prefix in Respondent's PROCAT mark is more likely to be viewed as suggesting "professional" in some respect, perhaps aspirationally, than as connoting "for" or "in favor of," when the PROCAT mark is

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<sup>27</sup> As noted above, Respondent stated that the exhibits to its Notice of Reliance No. 5 showed use of the PROCAT mark in commerce, 146 TTABVUE 2, and that its Notice of Reliance No. 6 covers "printouts of websites showing evidence of other PROCAT products available in U.S. commerce." 149 TTABVUE 3.

used in connection with goods that are identified broadly as “footwear” and must be deemed to encompass all manner of such goods, not just “a product line for small children.” 232 TTABVUE 38-39. This is corroborated by the multiple disclaimers of PRO in marks registered for goods identified as “footwear,” which were usually required based on the dictionary definition of “pro” as “professional.” 115 TTABVUE 235-50, 335-44, 359-89, 424-37, 467-677, 1131-43, 1189-1246, 1296-1365, 1402-40; 116 TTABVUE 2-39, 112-85. “A highly suggestive term of this type is less likely to form a strong impression amongst prospective consumers seeking to distinguish similar marks.” *New Era*, 2020 USPQ2d 10596, at \*15 (citing *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)). *See also Monster Energy*, 2023 USPQ2d 87, at \*33 (finding that the word MONSTER was the dominant portion of the applicant’s ICE MONSTER and design mark for restaurant services and similar services even though it was the second word in the mark).

Under the circumstances, and in the absence of any persuasive evidence to the contrary, “we find that it is appropriate to give relatively less weight to the adjective [PRO] than to the noun [CAT] in determining the connotation and commercial impression of [Respondent’s] mark.” *Sabhnani*, 2021 USPQ2d 1241, at \*38 (citing *Stone Lion*, 110 USPQ2d at 1161 (holding that the Board did not err in “according little weight to the adjective ‘STONE’ in applicant’s STONE LION CAPITAL mark” in the course of “finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning and overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”)). We

turn now to the required comparison of the CAT and PROCAT marks in their entirety, giving greater weight in that comparison to the suffix -CAT in Respondent's mark than to the prefix PRO-.

**d. Comparison of the Marks**

We begin with the similarity or dissimilarity of the marks in appearance and pronunciation. "To state the obvious, [Respondent's PROCAT mark] is similar to [Petitioner's CAT] mark in that it incorporates the entirety of [Petitioner's] mark." *Anheuser-Busch*, 115 USPQ2d at 1822-23. "While there is no explicit rule that the marks are automatically similar because [Respondent's] junior mark, [PROCAT], contains [Petitioner's] entire mark [CAT], '[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another.'" *Double Coin Holdings*, 2019 USPQ2d 377409, at \*6-7 (quoting *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014)).

Petitioner's CAT "word mark is a standard character mark, which 'may be presented in any font style, size or color, including the same font, size and color as the literal portions of [Respondent's] mark,'" *Sabhnani*, 2021 USPQ2d 1241, at \*34 (quoting *In re Aquitaine Wine USA LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018)), and in "the same stylization actually used or intended to be used by [Respondent], or one that minimizes the differences or emphasizes the similarities between the marks.'" *Id.* (quoting *Anheuser-Busch*, 115 USPQ2d at 1823 (citing *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011)). "This is because the rights associated with a standard character mark reside in the wording

per se and not in any particular font style, size, or color.” *Aquitaine Wine USA*, 126 USPQ2d at 1186.

We thus must assume that Petitioner’s standard-character CAT word mark could be displayed in the same font style in which Respondent’s mark is registered, i.e., as **cat**, and that as a result, the relevant comparison of the marks in appearance may be made from the standpoint of a consumer who encounters Petitioner’s mark displayed on footwear in the font style shown in Respondent’s registration.<sup>28</sup> The marks are more similar than dissimilar in appearance in that comparison, particularly because the “pro-” prefix in Respondent’s mark could be viewed simply as identifying a line extension of Petitioner’s CAT mark involving “professional” footwear.

With respect to sound, we find unpersuasive Respondent’s argument that “PROCAT is composed of more syllables and more letters than CAT and as a result sounds significantly different.” 232 TTABVUE 39. While it is true that Respondent’s PROCAT mark has twice as many syllables, letters, and words as Petitioner’s CAT mark, the Board has long recognized that consumers do not process this sort of minutia when forming their general impressions of marks. *See In re John Scarne*

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<sup>28</sup> Our concurring colleague visualizes four other “alternate display[s]” of the CAT standard-character word mark in her critique of our analysis of the fifth *DuPont* factor. *Infra* at 84. These other displays are irrelevant under the first *DuPont* factor because Respondent’s PROCAT mark is not displayed in one of these manners. They are also irrelevant under the fifth *DuPont* factor because Petitioner does not use the CAT mark in one of these other displays in connection with footwear, and we must assess the strength of the mark for those goods based on its actual use on and in connection with them. *Cf. Monster Energy*, 2023 USPQ2d 87, at \*23-26 (determining strength of MONSTER ENERGY mark for restaurant services based on actual use of the mark for those services).

*Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.”). Just as marks are not viewed together when comparing them in appearance, they are not pronounced sequentially when comparing them for aural similarity or dissimilarity. For a consumer with a general recollection of the sound of Petitioner’s CAT mark for footwear who separately hears Respondent’s PROCAT mark verbalized in connection with identical goods, Respondent’s mark will likely not “sound[ ] significantly different,” 232 TTABVUE 39, but will instead likely sound like a “professional” variant of Petitioner’s CAT mark for footwear. The marks are much more similar than dissimilar in sound because of the presence of the word CAT in each.

Finally, with respect to connotation and commercial impression, we reject Respondent’s suggestion that the word CAT has different meanings in the two marks. Respondent argues, somewhat contradictorily, that in its PROCAT mark, the “CAT” is “a feline (i.e., a puma)” but also refers “primarily [to] PUMA’s child customers,” 232 TTABVUE 41, while in Petitioner’s mark, CAT has a different, non-feline meaning. *Id.* at 41-42. In support of the latter claim, Respondent cites Ms. Lantz-Rickard’s cross-examination testimony that Petitioner manages its brand “so that our CAT marks are never associated with felines.” Lantz-Rickard Tr. 48:21-49:1 (180 TTABVUE 52-53). There is no evidence, however, that the purchasing public for footwear understands that Petitioner’s “CAT marks are never associated with felines,” and Respondent’s counsel also elicited confidential testimony from Ms.

Lantz-Rickard to the effect that Petitioner has no knowledge of how the general public uses the term “cat.” Lantz-Rickard Conf. Tr. 52:5-12 (181 TTABVUE 56).

Respondent further argues that Petitioner’s “‘vigorous’ self-separation from all things feline has apparently been successful” because Petitioner “has co-existed with Clark Equipment Company’s BOBCAT mark not only on apparel, but also in connection with that company’s use of both BOBCAT *and PROCAT* on a lawnmower sold under the PROCAT mark.” 232 TTABVUE 42 (emphasis supplied by Respondent). Respondent claims that “[g]iven Caterpillar’s willingness to peacefully co-exist with cats of the feline variety, even including other PROCATS, and even in the heavy equipment line at the core of Caterpillar’s business, Caterpillar’s creeping attack on PUMA’s use of PROCAT on socks and shoes is mystifying. Taking Caterpillar at its word on BOBCAT, it should be *less* concerned about PUMA—not trying to cancel PUMA’s mark.” *Id.* (emphasis supplied by Respondent). Respondent cites Mr. Narriman’s testimony in support of these arguments. Narriman Decl. ¶ 59; Ex. 18 (139 TTABVUE 26-27, 391-400).

We are unpersuaded by Respondent’s suggestion that the co-existence of Petitioner’s CAT mark for footwear and the PROCAT mark for Clark Equipment’s lawnmower bears on the meaning of Petitioner’s CAT mark in connection with footwear. The issue here is not why or how Petitioner’s CAT mark for footwear can co-exist with the PROCAT mark for lawnmowers, but rather whether CAT and PROCAT are confusingly similar when used on identical goods.

In the final analysis, we reject Respondent's suggestion, based almost entirely on evidence extrinsic to the involved registrations, that CAT has one meaning as Petitioner's mark for footwear and a second and different meaning as the dominant portion of Respondent's PROCAT mark for footwear. Respondent submitted extensive evidence of its heritage as a "cat" and its use of "feline imagery and feline-based trademarks," 232 TTABVUE 14, including its leaping cat logo and numerous CAT-formative word marks, *id.* at 14-15, 18, 41, but this evidence is irrelevant under the first *DuPont* factor because we "must compare the marks as they appear in the drawings" in the registrations, *Aquitaine Wine USA*, 126 USPQ2d at 1186, and there is nothing on the face of Respondent's PROCAT mark, such as the leaping cat logo, that ties the mark to Respondent or its other feline-based trademarks. *Cf. Embiid*, 2021 USPQ2d 577, at \*18 (finding that there was "nothing on the face of Applicant's [TRUST THE PROCESS] mark, such as his image or signature, which ties the mark to him, and nothing in the record that in the context of shoes, TRUST THE PROCESS would necessarily mean Applicant.>").

We find that within the four corners of the involved registrations, the CAT and PROCAT marks are quite similar in meaning when used in connection with identical goods. *Cf. Monster Energy*, 2023 USPQ2d 87, at \*36 ("Considering the marks as a whole, we find the common term MONSTER, especially when applied to legally identical restaurant services, creates the same commercial impression, and this impression does not alter with the addition of the terms ENERGY, ICE, and the background design or stylization of Applicant's mark.>").



For the reasons discussed above, the PROCAT mark “looks, sounds, and conveys the impression of being a line extension of” Petitioner’s mark CAT when the marks are both used for footwear. *Double Coin Holdings*, 2019 USPQ2d 377409, at \*7.<sup>29</sup> There are some differences between CAT and PROCAT in appearance, sound, and commercial impression, “but they are outweighed by the marks’ similarities, particularly taking into account that the identity of the goods with which the marks are used ‘reduces the degree of similarity between the marks necessary to find a likelihood of confusion.’” *Sabhnani*, 2021 USPQ2d 1241, at \*39 (quoting *New Era*, 2020 USPQ2d 10596, at \*14 and citing *Coach Servs.*, 101 USPQ2d at 1721 and *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010)). The first *DuPont* factor supports a finding of a likelihood of confusion.

#### 4. The Strength of Petitioner’s CAT Mark for Footwear

We turn next to the fifth and sixth *DuPont* factors. “The fifth *du Pont* factor is the fame of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or services.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *DuPont*, 177 USPQ at 567). We will consider these *DuPont* factors in tandem because the “fifth *DuPont* factor enables [Petitioner] to prove that its pleaded marks are entitled to an expanded scope of protection by adducing evidence of [t]he fame of the prior mark (sales, advertising,

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<sup>29</sup> Respondent cites Petitioner’s branding guidelines, which were designated by Petitioner as “Highly Confidential” and attached as Exhibit 32 to the Lantz-Rickard Declaration, in support of Respondent’s argument, made in its brief filed under seal, that consumers are not likely to view PROCAT as a line extension of CAT. 231 TTABVUE 39 (citing 108 TTABVUE 56). But it is self-evident from the designation of the guidelines as “Highly Confidential” that they are not intended for exposure to the consuming public.

length of use),” while “the sixth *DuPont* factor allows [Respondent] to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *Made in Nature*, 2022 USPQ2d 557, at \*20-21 (quoting *DuPont*, 177 USPQ at 567).

**a. The Claimed Strength of the CAT Mark**

“Likelihood of confusion fame varies along a spectrum from very strong marks to very weak marks.” *Id.*, at \*30 (citing *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017)). “A famous mark is commercially strong and has extensive public recognition and renown.” *Id.* (citing *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)). “A mark is considered ‘famous’ for likelihood of confusion purposes when ‘a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.’” *Id.* (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). “Such a mark ‘casts a long shadow which competitors must avoid.’” *Id.* (quoting *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012) (internal quotation omitted)). “Because of the extreme deference that we accord 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 clearly prove it.” *Id.*, at \*31 (citing *Coach Servs.*, 101 USPQ2d at 1720).<sup>30</sup>

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<sup>30</sup> As the Board noted recently in *Monster Energy*, “[w]hile *DuPont* factor five specifies the ‘fame’ of the mark, the Court of Appeals for the Federal Circuit also considers the ‘strength’

In determining strength, “we consider [Petitioner’s] mark[’s] conceptual strength, based on the nature of the [mark itself], and [its] commercial strength, based on marketplace recognition of the mark[ ].” *Id.*, at \*21. “The inherent or conceptual strength of [Petitioner’s CAT] mark is not seriously at issue,” *New Era*, 2020 USPQ2d 10596, at \*10, because we have found above in our discussion of the first *DuPont* factor that the standard-character CAT mark is inherently distinctive for footwear and that Respondent has not shown its conceptual weakness.

The issue of commercial strength is more complicated, however, because much of Petitioner’s evidence of commercial strength is directed to the composite word-and-design mark shown below



which both parties call the “CAT logo.” *Lantz-Rickard Aff.* ¶¶ 3-13, 15-38, 44-45 (107 TTABVUE 3-36, 38-39). Petitioner has used and registered the CAT logo in connection with industrial equipment and a wide variety of other goods, including footwear.<sup>31</sup> Because the goods involved in Petitioner’s Section 2(d) claim are footwear, we will focus on Petitioner’s evidence regarding the strength of its CAT mark in that context. *See Monster Energy*, 2023 USPQ2d 87, at \*23-25 (fame of MONSTER

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of the mark under that factor.” *Monster Energy*, 2023 USPQ2d 87, at \*19 n.39 (citations omitted).

<sup>31</sup> The CAT logo is registered for “footwear” in Registration No. 1908556, which issued on August 1, 1995 and has been renewed. 83 TTABVUE 57-58.

ENERGY mark for energy drinks did not support fame of the mark for restaurant services).<sup>32</sup>

Respondent does not challenge the potency of Petitioner's fame evidence per se, but argues instead that the CAT logo is "really the strength of [Petitioner's] brand" because Petitioner's "brand guidelines require its distinctive logo to appear on all of

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<sup>32</sup> Petitioner argues that "numerous district court and TTAB decisions have found the CAT mark to be well-known and/or famous relying on evidence that is comparable (or lesser) than what has been discussed above," 230 TTABVUE 36, and that some of them have found "the CAT mark (word and logo versions) to be famous." 233 TTABVUE 9. Both statements are accurate, but none of the past decisions addressed the issue of likelihood of confusion fame for footwear. See *Caterpillar Tractor Co. v. Katrak Vehicle Co.*, 172 USPQ 409, 410 (TTAB 1971) (finding that Petitioner "has made extensive use of 'CAT' on and in connection with the sale of wheeled and track-laying vehicles and accessories for off-the-road service"); *Caterpillar Tractor Co. v. Gehl Co.*, 177 USPQ 343, 344 (TTAB 1973) (finding that "as a result of extensive use and promotion over a long period of time, the term 'CAT' has been well known to the trade and to the applicable purchasing public as indicating earthmoving and material handling equipment including front-end loaders originating with petitioner long before respondent adopted and began to use the mark 'HYDRACAT' for goods identical in kind; and that petitioner possesses a valuable good will and property right therein."); *Caterpillar Tractor Co. v. Elec. Carrier Corp.*, Opposition No. 56436 (TTAB Oct. 11, 1977) (finding that "the designation 'CAT' has been for many years well known to the purchasing public, to the trade, and even to applicant as identifying opposer itself as well as the products originating from opposer"), 84 TTABVUE 23; *Caterpillar, Inc. v. Cat Cont'l Co.*, Opposition No. 68672 (TTAB Jan. 29, 1988) (finding that "[t]here can be no serious dispute that opposer's 'CAT' mark and trade name have been extensively used and promoted and that 'CAT' is a famous mark for earth moving and materials handling equipment"), 84 TTABVUE 33; *Caterpillar, Inc. v. Nationwide Equip.*, 877 F. Supp. 611, 33 USPQ2d 1357 (M.D. Fla. 1994) (granting preliminary injunction in gray market case based on likely infringement of CAT, CAT DIESEL POWER, and CATERPILLAR marks without commenting on the strength of the marks); *Caterpillar, Inc. v. Telescan Techs., L.L.C.*, 2002 WL 1301304 (C.D. Ill. Feb. 13, 2002) (concluding that six domain names containing Caterpillar marks "contain some of the most famous marks in America—the Caterpillar marks—and that [the defendant] intends to use them to sell actual Caterpillar equipment"), 84 TTABVUE 49-50; *Caterpillar, Inc. v. Pave Tech, Inc.*, Cancellation No. 92041776 (TTAB Mar. 12, 2007) (finding that "petitioner's CAT and design mark is indeed a famous mark in the field of compact construction equipment"), 84 TTABVUE 66; *Caterpillar, Inc. v. Big Cat Energy Corp.*, Opposition No. 91193704 (TTAB Sept. 3, 2014) (finding that "the CAT mark has reached an extraordinary level of fame, not on in the oil and gas industry, but also with respect to the general consuming public"), 84 TTABVUE 113; *Caterpillar, Inc. v. Kelly*, Opposition No. 91210124 (TTAB Sept. 30, 2015) (finding that "the record clearly demonstrates the fame of Opposer's CAT marks, including in the oil and gas industry"). 84 TTABVUE 149.

its advertisements, suggesting that Caterpillar itself recognizes the obvious: the unadorned ‘CAT’ may be a word mark registered to Caterpillar, but that does not give Caterpillar a monopoly on the letters c-a-t.” 232 TTABVUE 8. Respondent claims that “[w]hen American consumers see the word ‘cat’ printed on a pair of socks at Target, without any accompanying logo, the first image that comes to mind is likely to be a household pet, not a front-end loader,” and that Petitioner “has no evidence to the contrary: it cannot show that its word mark, as distinct from its logo, is strong enough to support its confusion and dilution claims.” *Id.* In making these arguments, Respondent implicitly recognizes that the CAT logo is famous in other contexts, but suggests that we disregard the fame of the CAT logo in connection with footwear when assessing the fame of the CAT word mark for footwear.

Petitioner replies that “the CAT word and logo marks are individually registered, used interchangeably throughout Caterpillar’s materials, and entitled to equal weight.” 233 TTABVUE 9. Petitioner cites the *Big Cat Energy, Elec. Carrier*, and *Kelly* cases discussed in footnote 32 above as examples of cases “finding the CAT mark (word and logo versions) to be famous.” *Id.*

In support of its position, Respondent established, through its cross-examination of Mr. Beaupre regarding the use of Petitioner’s marks on footwear, that (1) all of Petitioner’s footwear contains the CAT logo on the inside of the shoe, Beaupre Tr. 21:19-22; 22:9-20 (178 TTABVUE 25-26); (2) Mr. Beaupre’s references to “CAT Footwear” in his affidavit included footwear that includes the CAT logo, Beaupre Tr. 94:14-20 (178 TTABVUE 98); (3) he could not say what percentage of Petitioner’s

licensed merchandise contained the CAT word mark, Beaupre Tr. 27:9-11 (178 TTABVUE 31); (4) there was no way to know, based on the sales figures provided in his testimony, how the sales of products bearing the CAT logo compare to the sales of products bearing the CAT word mark, Beaupre Tr. 36:1-5; Beaupre Conf. Tr 100:4-101:2 (178 TTABVUE 40; 179 TTABVUE 104-05); and (5) he could not provide information that would allow the determination of the percentage of sales of footwear associated with only the use of the CAT word mark. Beaupre Conf. Tr. 101:3-7 (179 TTABVUE 105). His testimony establishes that it would be next to impossible to segregate the uses of, and thus the public's exposure to, the CAT word mark from the CAT logo with respect to footwear.

In analyzing Respondent's suggestion that, for these reasons, we should disregard Petitioner's evidence of the strength of its CAT logo for footwear in assessing the strength of its CAT word mark for footwear, we are mindful of the Federal Circuit's instruction that when multiple marks appear together on goods, the commercial strength of each mark must be separately evaluated. *See generally Bose*, 63 USPQ2d at 1308-09. In *Bose*, the opposer regularly used its WAVE and ACOUSTIC WAVE product marks at issue in connection with its famous BOSE house mark, and the Federal Circuit explained that the commercial strength of a product mark cannot be found "simply as a matter of the long shadow cast by the accompanying famous house mark." *Id.* at 1308. The court noted, however, that it was "not faced with a record on which substantially every reference to the marked product is joined with reference to the famous house mark," but that "the consumer is presented through the advertising

and other promotional material with frequent references to the marked product standing alone and apart from the famous house mark.” *Id.* at 1306-07. The court held that the Board had “applied a correct test but scored the test incorrectly” in finding that the opposer’s ACOUSTIC WAVE and WAVE marks were not famous separate and apart from the famous BOSE house mark, where the record showed independent recognition of the subsidiary marks. *Id.* at 1309. In *Promark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1242 (TTAB 2015), the Board applied the analysis in *Bose* in finding that the opposer’s SMART ONES mark, which always appeared in connection with the well-known WEIGHT WATCHERS mark, was not separately famous or strong. *Id.* at 1245-47.

We do not view the CAT logo and the CAT word mark as analogs to the BOSE house mark and the WAVE and ACOUSTIC WAVE product marks in *Bose*, or the WEIGHT WATCHERS house mark and the SMART ONES product mark in *Promark*. To the extent that the CAT logo is Petitioner’s house mark, the CAT word mark is not a separate or different subsidiary product mark, but rather comprises the verbal and dominant portion of the house mark. To adopt the categorical position urged by Respondent, and tacitly applied by our concurring colleague,<sup>33</sup> that we should simply ignore Petitioner’s evidence of the use of its CAT logo for footwear in assessing the strength of the CAT word mark for those goods would be to elevate the

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<sup>33</sup> Our concurring colleague does “not propose a per se rule that bars any particular evidence for showing commercial strength of a standard character mark,” *infra* at 87, but then proceeds to apply one, de facto, in finding that the CAT word mark has no commercial strength at all and “is entitled only to the scope of protection accorded an inherently distinctive mark.” *Infra* at 88.

technical form of the marks over the substance of their use. The reality is that when consumers see the CAT logo on footwear, they necessarily see the CAT word mark,<sup>34</sup> particularly when the CAT logo is viewed at a distance on public-facing materials and on footwear when it is worn.<sup>35</sup> Consumers are also likely to separately see the CAT word mark in the phrase CAT® Footwear. We depict several such uses immediately below:



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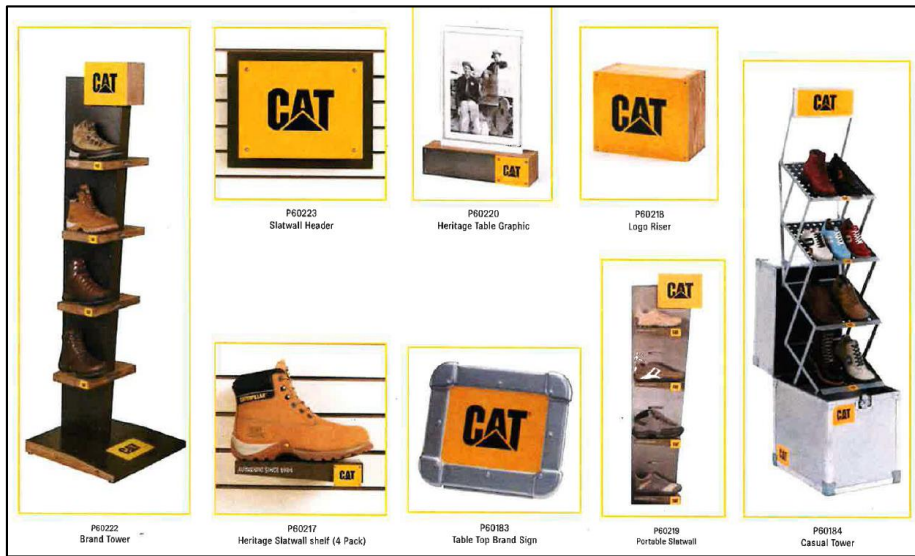
<sup>34</sup> In a composite word-and-design mark such as the CAT logo, “the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Sabhnani*, 2021 USPQ2d 1241, at \*31 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184 (internal citations omitted)). There is no doubt that the word CAT is the dominant portion of the CAT logo. Not only is this shown by the manner in which Petitioner uses the CAT logo, but it is also borne out by third-party media usage. For example, one article in the record refers to the CAT logo as “the famous ‘CAT’ yellow logo,” 204 TTABVUE 75, and in a second article in the record, “CAT” is identified as “the yellow tractor brand that you’ve probably seen breaking pavement on a highway near you” that “just released a new collection of dad sneakers that are as practical as they are trendy . . . .” 100 TTABVUE 166.

<sup>35</sup> Because this case involves footwear, we must take into account in our likelihood of confusion analysis the exposure of the marks to consumers when the footwear is worn. *Embiid*, 2021 USPQ2d 577, at \*33 (citing *Payless Shoesource, Inc. v. Reebok Int’l Ltd.*, 998 F.2d 985, 27 USPQ2d 1516, 1519-20 (Fed. Cir. 1993) (finding post-sale confusion to be a valid concern in a shoe case)).





Beaupre Aff. ¶ 8 (106 TTABVUE 5).



Beaupre Aff. Ex. 6 (102 TTABVUE 244).



Beaupre Aff. Ex. 6 (102 TTABVUE 199).



Beaupre Aff. ¶ 9 (106 TTABVUE 7).

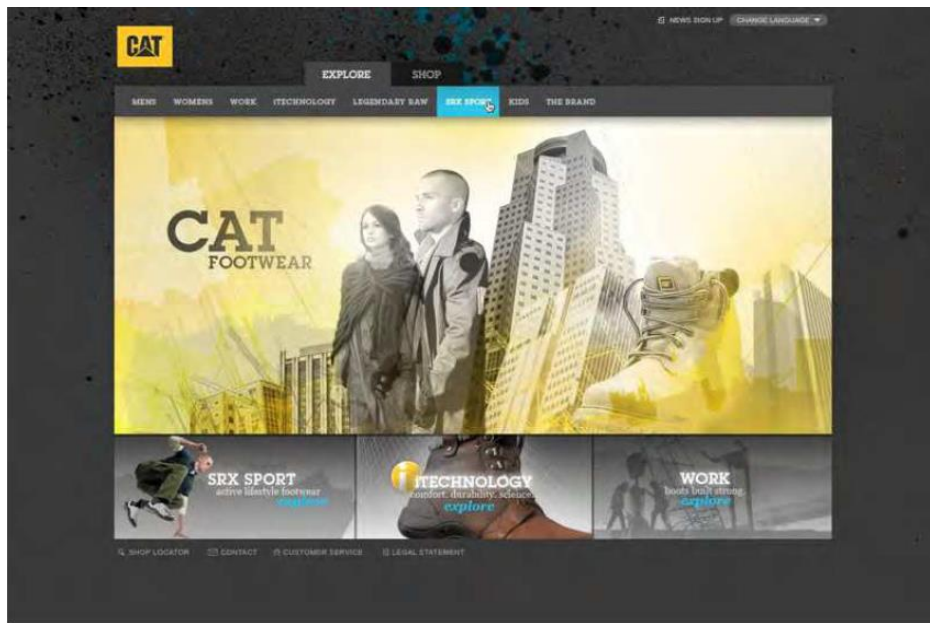
Accordingly, we will consider all of Petitioner’s evidence of the strength of the CAT marks for footwear, recognizing that the CAT logo is used in some manner on the goods, but further recognizing that the CAT word mark is separately displayed apart from the display of the CAT logo in at least some materials, including catalogs and advertising.

Fame for likelihood of confusion purposes “may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods.” *Made in Nature*, 2022 USPQ2d 557, at \*31.

Mr. Beaupre testified that as of the time of trial, Petitioner had used its CAT marks in connection with footwear for more than 40 years. Beaupre Aff. ¶ 4 (106 TTABVUE 3). Petitioner’s exclusive footwear licensee is currently Wolverine World Wide, Inc. (“Wolverine”), which “operates under the CAT Footwear brand (as shown

on the www.catfootwear.com website).” Beaupre Aff. ¶¶ 10, 13 (106 TTABVUE 10); Beaupre Tr. 94:7-13 (178 TTABVUE 98). Wolverine’s CATFootwear products include “CAT-branded work boots, CAT-branded casual footwear, CAT-branded athleisure shoes, and CAT-branded socks.” Beaupre Aff. ¶ 10 (106 TTABVUE 10). Since 2001, many millions of pairs of CAT-branded boots and shoes have been sold in the United States, Beaupre Conf. Aff. ¶ 10 (129 TTABVUE 10), and in 2002, Cat Footwear was named to Interbrand’s “best brand extension” global brand list. Beaupre Aff. ¶ 10 (106 TTABVUE 10).

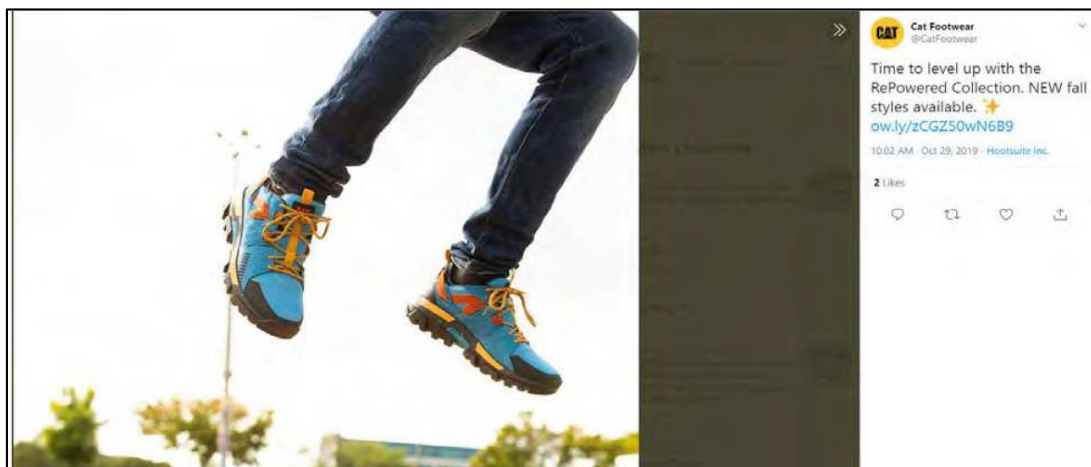
Petitioner’s licensed footwear is advertised and promoted through various websites, including catfootwear.com. Beaupre Aff. ¶ 13; Exs. 2-4 (106 TTABVUE 10; 104 TTABVUE 98-135). An example is shown below:



Beaupre Aff. ¶ 13 (106 TTABVUE 12). Petitioner’s websites are visited by millions of users each year. Beaupre Aff. ¶ 14 (106 TTABVUE 14). In 2019, there were several

million visits to the catfootwear.com website. Beaupre Conf. Aff. ¶ 14 (129 TTABVUE 14).

Licensed footwear is also marketed through Petitioner’s various social media accounts, which have extensive public exposure and followers. Beaupre Aff. ¶ 15; Ex. 5 (106 TTABVUE 14-17, 104 TTABVUE 136-210). An example is displayed on the page below, which shows the CAT logo, the words “Cat Footwear,” and the hashtag “#CatFootwear”:



Beaupre Aff. ¶ 15 (106 TTABVUE 16).

CAT-branded footwear and apparel have also been promoted in thousands of billboards, banner ads, direct mailings, product catalogs, and brochures, each prominently featuring the CAT word mark and/or the CAT logo. Beaupre Aff. ¶ 16; Exs. 6-7 (106 TTABVUE 17-21, 102 TTABVUE 2-22, 134-35, 138-49, 152-298). Some outdoor ads for CAT-branded footwear are displayed below:



Beaupre Aff. ¶ 16; Ex. 7 (106 TTABVUE 21; 102 TTABVUE 198). Mr. Beaupre testified that “[t]hese advertisements collectively translate into hundreds of millions of consumer impressions for CAT-branded footwear and apparel products in the United States.” Beaupre Aff. ¶ 17 (106 TTABVUE 21). CAT-branded footwear has also been promoted through Petitioner’s sponsorship of NASCAR and Petitioner’s and Cat Footwear’s sponsorship of specific drivers. Beaupre Aff. ¶¶ 32-34; Exs. 19-21 (106 TTABVUE 40-41; 100 TTABVUE 251-61).

Starting in 2011, Mike Rowe, the host of Discovery Channel’s “Dirty Jobs” show, began promoting a line of CAT-branded footwear. Beaupre Aff. ¶ 18; Ex. 8 (106 TTABVUE 22, 100 TTABVUE 2-4):

**MIKE ROWE WORKS BY CAT FOOTWEAR.**

Cat Footwear and Mike Rowe are proud to partner and launch Mike Rowe Works by Cat Footwear, a collaboration between two of the hardest-working brands in America.

**WHAT IS MIKE ROWE WORKS BY CAT FOOTWEAR?**  
A co-branded series of work boots and rugged casual shoes inspired by Mike's more than 300 dirty jobs. Two names trusted on the jobsite have collaborated to create boots and shoes ready to perform both on- and off-the-clock.

**WHY INVEST IN MIKE ROWE WORKS BY CAT FOOTWEAR?**

- After 300 dirty jobs, Mike Rowe, the perpetual apprentice, has become an authority on hard work.
- Cat Footwear has a long reputation for making the toughest work boots on the jobsite.
- Mike Rowe can help draw new customers - 90M people watch him each week.
- Mike Rowe is a trustworthy advocate for the American worker, launching [mikeroweworks.com](http://mikeroweworks.com) to celebrate skilled trades.

**WHAT CAN YOU EXPECT?**

- The same quality footwear that you are accustomed to from Cat Footwear but with Mike Rowe's signature "get ready to get dirty" styling.
- Mike's witty sense of humor in cooperative advertising for the collection.

**CAT**

*Rowe*

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Beaure Aff. Ex. 8 (100 TTABVUE 3).

CAT-branded footwear is currently sold at approximately 16,000 retail locations in the United States, a number of which feature various forms of promotion of the CAT brand, Beaure Aff. ¶ 21 (106 TTABVUE 25), including in-store displays of the sort shown below:



Beaupre Aff. ¶ 21 (106 TTABVUE 25-26).

CAT-branded footwear has been discussed, reviewed, and displayed in articles in various media, most of which refer to the goods as “CAT” or “Cat” footwear. Beaupre Aff. ¶¶ 24-25; Ex. 13 (106 TTABVUE 29-30; 100 TTABVUE 45-48, 61-68, 77, 79-80, 82, 84-86, 88-91, 106, 120-23, 128-29 (WALL STREET JOURNAL) (“Caterpillar licensed its name for a work boot made by Wolverine World Wide two years ago. The Cat boot, with a Cat bulldozer embroidered on the side, is now Wolverine’s hottest products,

with three million pairs sold last year”); 130-31 (GRAND RAPIDS PRESS) (discussing Mike Rowe’s promotion of “Cat Footwear”); 133-34 (WALL STREET JOURNAL) (discussing “Cat” gear, including footwear, and stating that Arnold Schwarzenegger “wears Cat shoes”); 147 (MEN’S HEALTH) (displaying a canvas boot under the caption “Cat Footwear”); 161-62 (FORBES) (showing a CATERPILLAR boot and referencing “Cat Footwear”); 166-70 (TEEN VOGUE) (article captioned “These CAT Sneakers Are All Over Instagram”); 204 TTABVUE 15-18 (FOOTWEAR NEWS article captioned “Cat Footwear’s New Customers Carry Science Degrees, Not Hammers”); 33-36 (FOOTWEAR NEWS article showing and referring to “Cat’s Excavator Superlite work boot” from “Cat Footwear”); 37-42 (CHICAGO TRIBUNE) (article captioned “CAT Footwear review: Are these durable boots versatile enough for multipurpose wear?” and discussing boots from “Cat Footwear”); 48-49 (FORBES) (displaying and discussing shoes from “Cat Footwear”); 75-81 (norwaygeographical.com article discussing the history of “Cat Footwear” and “two popular designs by CAT,” stating that “CAT offers different styles of footwear that have protection and durability in common,” and concluding that as between Timberland and Caterpillar, “CAT offers more durable boots, and we see CAT’s products as more suitable for outdoor sites and working locations”); 88-90 (hyperbae.com article discussing a collaboration between Heron Preston and “CAT Footwear” incorporating “CAT’s workwear roots”); 93-96 (dstngr.com article captioned “ENGINEERED FOR ORIGINALITY – Cat Footwear’s artistic campaign for AW20”); 103 (GQ) (displaying “Axel Arigato x CAT Footwear Excelsior trainers in orange”); 108 (RUNNER’S WORLD) (displaying and discussing “Cat



Footwear Intruder”). These articles are probative of the strength of the CAT word mark for footwear. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35 (finding that articles discussing the petitioner’s INSIGNIA mark for wine showed “appreciation by consumers and the wine market of Vineyards’ INSIGNIA brand.”).<sup>36</sup>

Petitioner designated advertising expenditures and sales figures regarding CAT-branded footwear as Trade Secret/Commercially Sensitive, the highest level of confidentiality under the Board’s Standard Protective Order.<sup>37</sup> We have reviewed those figures and summarize them in general terms. Between 2003 and 2019, Wolverine’s annual marketing expenditures for CAT-branded footwear in the United States were in the low seven figures, with the aggregate expenditures for that period in the mid-eight figures. *Beaupre Conf. Aff.* ¶ 36 (129 TTABVUE 46).<sup>38</sup> Between 2001 and 2019, Wolverine’s annual unit sales of CAT-branded footwear in the United States were in the low seven figures, *Beaupre Conf. Aff.* ¶ 10 (129 TTABVUE 10), and

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<sup>36</sup> Our concurring colleague discounts the probative value of these articles based in part on her claim that the use of CAT in the text of the articles is “merely a shorthand reference to the [CAT] design mark.” *Infra* at 86. She may be correct that the word CAT is used in the articles for this reason because, as the Federal Circuit has recognized, “the literal components of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ2d 198, 200 (Fed. Cir. 1983)). CAT may also be used in the articles because that is how the authors of the articles recalled the mark. What matters, however, is not why the word CAT appears in the articles, but rather that the word CAT is exposed to consumers as Petitioner’s mark, from which we can infer that the word CAT is “likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citing *Viterra*, 101 USPQ2d at 1908).

<sup>37</sup> Mr. Beaupre testified on cross-examination that these figures reflected sales and advertising by Wolverine, not Petitioner. *Beaupre Tr.* 100:2-9 (178 TTABVUE 104); *Beaupre Conf. Tr.* 107:16-19 (179 TTABVUE 111).

<sup>38</sup> The sales and advertising figures appear to be the most recent available, as Mr. Beaupre signed his affidavit in September 2020.

between 2007 and 2019, Wolverine’s sales of CAT-branded footwear in the United States generated annual revenues in the United States in the low- to mid-eight figures, with the aggregate revenues for that period well into nine figures. *Beaupre Conf. Aff.* ¶ 39 (129 TTABVUE 47).

Finally, Petitioner has aggressively enforced its CAT marks in a variety of manners, and has been involved in numerous Board proceedings involving marks for goods in Class 25, including proceedings in which Petitioner challenged the registration of CAT-formative marks for footwear. *Lantz-Rickard Aff.* ¶¶ 49-51 (125 TTABVUE 41-45). Petitioner’s apparent success in this regard is reflected in the paucity of third-party registrations of CAT-formative marks for footwear discussed above, and third-party uses of CAT-formative marks for footwear discussed below.

We find, based on the evidence discussed above, that Petitioner has clearly shown that its CAT word mark for footwear falls “on the much higher end of the commercial strength spectrum ‘from very strong to very weak,’” *New Era*, 2020 USPQ2d 10596, at \*12 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734), and thus has both conceptual and commercial strength for “footwear,” particularly boots and sneakers.<sup>39</sup> “This *DuPont* factor weighs in favor of finding a likelihood of confusion.” *Id.*

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<sup>39</sup> Our concurring colleague suggests that we have found the CAT word mark to be strong in “any and all displays involving different fonts and sizes.” *Infra* at 85. As noted above, our analysis under the fifth *DuPont* factor is based on the CAT mark as it is actually used on footwear, and in related advertising, promotion, and media coverage, and we need not and do not concern ourselves with “any and all displays” of the word mark “involving different fonts and sizes” other than those actually exposed to consumers. Further, a word mark displayed in standard characters (i.e., a mark made up purely of letters and/or numbers) is not considered to be capable of depiction in any and all displays “involving different fonts and sizes,” but only of depiction of those letters or numbers in any font style, size, or color without

**b. Whether Third-Party Uses of CAT-Formative Marks Have Weakened the Commercial Strength of Petitioner's CAT Mark**

“The purpose of introducing evidence of third-party use is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Sabhnani*, 2021 USPQ2d 1241, at \*22 (quoting *Omaha Steaks*, 128 USPQ2d at 1693 (internal quotation and quotation marks omitted)). The Federal Circuit held in *Omaha Steaks* that because the involved goods in that case were identical meat products, third-party uses on other goods such as popcorn, alcoholic beverages, and other food products were “properly understood as having no real probative value for the analysis at hand,” making the “evidentiary universe [of relevant third-party uses] much smaller.” *Omaha Steaks*, 128 USPQ2d at 1695. The court cited its earlier decision in *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991), which had noted that “no third-party marks and uses were as closely related as the ‘virtually identical uses of the parties are to each other.’” *Omaha Steaks*, 128 USPQ2d at 1695 (quoting *Nat’l Cable Television*, 19 USPQ2d at 1430).

Respondent argues that “third parties commonly use ‘cat’ in connection with apparel, headwear, and footwear,” 232 TTABVUE 19, that it “submitted 34 websites offering products for sale that use the term ‘cat’ . . . and 39 third-party trademark registrations *for Class 25 goods* that contain the term ‘cat,’” and that “[o]f these 39

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additional design elements. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *Aquitaine Wine USA*, 126 USPQ2d at 1186.

registrations, [Respondent] has submitted evidence confirming that 31 were used in commerce.” *Id.* (emphasis supplied by Respondent). Respondent explains that “[t]his was confirmed through locating websites selling the product, purchasing and photographing the product bearing the trademark, or through testimony of [Respondent’s] private investigator” William Shanks. *Id.* (internal citations omitted).<sup>40</sup>

As discussed above, there are at most nine third-party registrations of CAT-formative marks that cover goods identified as “footwear” or some type of shoes. Respondent provided evidence of use of five of those marks, CATS, ARCTIC CAT, CAT & JACK, THUNDERCATS and design, and SACRAMENTO RIVER CATS. 144 TTABVUE 7-9, 31-33, 81; 145 TTABVUE 28, 48, 57-59, 61-65. The only evidence of use of any of those marks on footwear or shoes, however, is the display of the ARCTIC CAT house mark and the “Cat Tracker” and “Cat Walkers” sub-brands in connection with shoes and boots shown in what Mr. Shanks described as “historical” ARCTIC CAT catalogs from the years 1992, 1995, 1996, 1999, 2000, 2002, 2004, 2005, 2008, and 2011 that he purchased.<sup>41</sup> Shanks Tr. 28:21-29:9; 30:11-14, 19-31:5; Exs. 2, 5; 97:21-98:6; 100:21-101:15 (183 TTABVUE 32-34, 101-02, 104-05, 198-205, 282-310;

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<sup>40</sup> Mr. Shanks testified, however, that he was unaware of the sales volume, advertising and promotion, or commercial recognition of any of the products discussed in his report. Shanks Tr. 104:4-105:9 (183 TTABVUE 108-09).

<sup>41</sup> Excerpts from the catalogs for the years 1992, 1999, 2005, and 2017 were attached as Exhibits N-1-N-4 to Respondent’s Notice of Reliance No. 14. 162 TTABVUE 2-92. As discussed above, we have overruled Petitioner’s objections to these exhibits.

184 TTABVUE 169-220, 288-95).<sup>42</sup> Mr. Shanks could not recall locating any ARCTIC CAT catalogs after 2011, Shanks Tr. 98:5-9 (183 TTABVUE 102), and he did not verify that any of the products shown in the catalogs were available for purchase at the time of trial. Shanks Tr. 98:10-15 (183 TTABVUE 102).

Mr. Shanks testified that ARCTIC CAT footwear was available in 2018, but that the “products were priced in the approximately \$250 range, and my total budget for product purchases was - - didn’t allow for that large of a purchase.” Shanks Tr. 99:19-100:2 (183 TTABVUE 102-03). He testified that other than those products and two non-footwear products that he purchased, he was not aware of other ARCTIC CAT products then being sold, Shanks Tr. 100:6-12 (183 TTABVUE 103), and he was not sure about any current sales of ARCTIC CAT footwear. Shanks Tr. 101:16-21 (183 TTABVUE 105).

Mr. Shanks testified that he was unaware of the use of any of the other CAT-formative marks that he investigated on footwear, including the CAT & JACK mark, Shanks Tr. 84:1-4 (183 TTABVUE 88), the BOBCAT mark, Shanks Tr. 64:11-17 (183

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<sup>42</sup> Some of the catalogs and other third-party uses of CAT-formative marks were included in the February 4, 2020 “Investigative Report” prepared by Mr. Shanks for Respondent as what he described as a “follow-up investigation that I conducted for Quarels [sic] & Brady in February - - in January and February of 2020 regarding use of ‘Cat’ on apparel and merchandise.” Shanks Tr. 50:8-19; Ex. 12 (183 TTABVUE 54; 184 TTABVUE 283-375). At Mr. Shanks’ deposition, Petitioner’s counsel objected to the introduction of Exhibit 12 “to the extent it was not previously produced in the current case, as the Bates numbers appear to show that it was produced in the case involving the Speed Cat mark,” Shanks Tr. 51:6-11 (183 TTABVUE 55), but Petitioner’s counsel examined Mr. Shanks about uses discussed in the second report subject to what Petitioner’s counsel called his “standing objection” to the report. Shanks Tr. 104:4-106:18; 111:1-8; 130:15-19. As discussed above, we will not consider any objection made at a deposition, such as this “standing objection,” that was not specifically renewed in Petitioner’s brief, and we have considered the February 4, 2020 Report and Mr. Shanks’ related testimony for whatever probative value they may have.

TTABVUE 68), the TRASHY CAT mark, Shanks Tr. 76:12-16 (183 TTABVUE 80), the COUNTRY CAT mark, Shanks Tr. 79:3-20 (183 TTABVUE 83), the RAISE THE CAT mark, Shanks Tr. 92:16-19 (183 TTABVUE 96), the BASS CAT mark, Shanks Tr. 110:14-15 (183 TTABVUE 114), the NALA CAT mark, Shanks Tr. 112:7-11 (183 TTABVUE 116), and the CAT PALACE mark. Shanks Tr. 122:1-5 (183 TTABVUE 126). The ARCTIC CAT marks discussed above thus appear to be the only third-party CAT-formative mark that had been used on footwear in the United States as of the time of trial,<sup>43</sup> and the ARCTIC CAT marks are less similar to the parties' PROCAT and CAT marks than those marks are to each other.

The record shows that apart from footwear, the apparel world is chock full of cats of all stripes. In addition to the BOBCAT of Clark Equipment Company discussed above, these include the WILDCATS of the University of Arizona, Davidson College, the University of Kentucky, Northern Michigan University, Northwestern University, Villanova University, and the University of New Hampshire, Shanks Tr. Exs. 2, 6-7, 9-10, 12 (183 TTABVUE 225-36, 313, 321, 324-25, 340-41, 344-45; 184 TTABVUE 5-9, 31-37, 143-49, 186, 251-53, 299-303, 347-49, 365-68, 372-75, 395-96; 145 TTABVUE 12-19, 27-29, 34-37, 104-06); the BOBCATS of Ohio University, Bates College, Georgia College, Lees-McCrae College, Montana State University, Quinnipiac University, the University of California Merced, the College of the

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<sup>43</sup> Mr. Shanks' 2019 report mentioned and displayed the use of the MR. CAT mark "printed on the insole" of a shoe, but he stated that the company "apparently only sells in Brazil." Shanks Tr. Ex. 2 (183 TTABVUE 219-20). Following an inquiry, Mr. Shanks received an email confirming that limitation. Shanks Tr. Ex. 2 (183 TTABVUE 219-20).

Ozarks, Frostburg State University, Peru State College, Saint Thomas University, Texas State University San Marcos, the University of Pittsburgh-Greensburg, and West Virginia Wesleyan College, Shanks Tr. Exs. 2, 6-7, 9, 12 (183 TTABVUE 237-55, 315, 326-33, 336-39, 348-49; 184 TTABVUE 54-58, 222, 347-52; 145 TTABVUE 24-25, 30-33); and the BEARCATS of the University of Cincinnati, Binghamton University, and Northwest Missouri State University. Shanks Tr. Exs. 2, 6-7, 9-10, 12 (183 TTABVUE 255-61, 311-12, 319, 342, 354; 184 TTABVUE 18-21, 110-18, 160-61, 241, 358-64; 145 TTABVUE 130-32, 137-40).

In addition to the marks discussed above, there are also SNO-CATS, GRUMPY CATS, CAT EYES, SACRAMENTO RIVER CATS, THUNDER CATS, NEW HAMPSHIRE FISHER CATS, CAROLINA MUDCATS, TRI-CITY VALLEYCATS, JAVA CATS, HILLCATS, SABERCATS, TOMCATS, and CATAMOUNTS; a CAT ME YOU and a CAT COVEN; and COOL CATS, BEETLE CATS, and the odd couple CAT & DOGMA, that have adorned shirts, sweat clothes, hats, and other non-footwear apparel. Shanks Tr. Exs. 2-5, 7-12, 16 (183 TTABVUE 189-95, 197-218, 221-25, 261-66, 270-310, 314, 316-18, 320, 322-23, 334-35, 346-47, 350-53; 184 TTABVUE 3-4, 10-17, 22-30, 38-44, 61-109, 129-42, 150-59, 162-63, 167-220, 223-40, 246-50, 254-61, 272-75, 280, 284-97, 303-39, 343-46, 353-57, 368-71, 382-84; 145 TTABVUE 9-10, 47-50, 56-70, 80-83, 90-103, 107-29, 133-36, 141-42). The titles of the Broadway musical CATS and the Dr. Seuss children's story THE CAT IN THE HAT, and the name of the

cartoon character “Top Cat,” have also appeared on shirts and other garments. 145 TTABVUE 38-46, 84-89.<sup>44</sup>

With the exception of the CATS marks relating to the Broadway musical and the University of Arizona, Respondent’s third-party marks used on what Respondent describes as “goods related to the goods of the parties,” 232 TTABVUE 44, contain CAT(S) combined with other matter that makes all of them less similar to either party’s mark than the parties’ marks are to each other. These third-party uses on clothing other than footwear are insufficient to show that Petitioner’s CAT mark has been weakened commercially to such an extent that consumers can distinguish between the parties’ uses of CAT, particularly when the parties’ CAT and PROCAT marks are used on identical goods. As the Federal Circuit explained in *Omaha Steaks*:

GOP’s mark on meat products cannot escape a likelihood of confusion with Omaha Steaks’ prior use on meat products in the relevant market for meat purely because other “Omaha” marks are being used by third parties on popcorn, alcoholic beverages, or other food products. Independent of these third-party uses on other goods, there may still be confusion between Omaha Steaks’ marks and GOP’s new mark for consumers purchasing meat.

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<sup>44</sup> The CATS mark has been registered for “baseball caps, sweatshirts and tee-shirts sold at retail outlets featuring items and memorabilia related to the registrant’s theater productions and at the registrant’s theater productions,” 143 TTABVUE 25-26, and shirts bearing it have been offered for sale through the website at [catsthemusicalgoods.com](http://catsthemusicalgoods.com). 145 TTABVUE 38-40. Although the file histories of this registration, and of the University of Arizona’s registration of CATS discussed above at footnote 15, are not in the record, we can reasonably assume that the respective restrictions in the identifications of goods in the two registrations were intended to enable these two CATS marks to coexist in the marketplace without conflict based on their association with, and marketing to fans of, the musical and the university’s sports teams.



*Omaha Steaks*, 128 USPQ2d at 1695. Here, Respondent's PROCAT mark for footwear cannot escape a likelihood of confusion with Petitioner's CAT mark for footwear simply because there are other CAT-formative marks in use on apparel.<sup>45</sup>

The quality and quantity of probative third-party CAT-formative marks for footwear are wanting. As in *Sabhnani*, "one third-party use" and, at most, nine "third-party registrations of 'varying probative value'," are "a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both' *Jack Wolfskin* and *Juice Generation*." *Sabhnani*, 2021 USPQ2d 1241, at \*25-26 (quoting *Inn at St. John's*, 126 USPQ2d at 1745-46). We find that the sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

### **c. Summary of Fifth and Sixth *DuPont* Factors**

Petitioner has shown that its CAT mark for footwear is inherently distinctive and has significant commercial strength, and Respondent has failed to rebut that showing. Accordingly, we will accord the mark more than just "the normal scope of

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<sup>45</sup> To an even greater degree, Respondent's PROCAT mark for footwear cannot escape a likelihood of confusion with Petitioner's CAT mark for footwear simply because "Cat is widely used in ordinary English without confusion" and "the letters c-a-t are omnipresent in American English, both as the stand alone word 'cat' and as part of other words like copycat, catwalk, and catamaran." 232 TTABVUE 22. We agree with Petitioner that uses of the word "cat" in its primary dictionary sense, including to refer to a popular house pet, in book titles, or in the American English vernacular, *id.* at 22-26, "are irrelevant to assessing the commercial strength of the CAT mark" for footwear. 233 TTABVUE 10-11. *Cf. Nat'l Cable Television*, 19 USPQ2d at 1430 ("ACE for canned, large peas could not escape likelihood of confusion with a prior use of ACE for canned, small peas because ACE is concurrently used by unrelated third parties on aircraft, clothing, computer services, hardware or even bread, bananas, milk and canned carrots" because "[p]roperly defined, the relevant purchasing public in the example need be defined no broader than purchasers of canned peas, and the third party ACE marks outside the segment become essentially irrelevant.").

protection to which inherently distinctive marks are entitled.” *Sabhnani*, 2021 USPQ2d 1241, at \*26 (quoting *Bell’s Brewery*, 125 USPQ2d at 1347).

### 5. The Absence of Evidence of Actual Confusion

“The seventh *DuPont* factor is the ‘nature and extent of any actual confusion,’ while the eighth *DuPont* factor considers the ‘length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Made in Nature*, 2022 USPQ2d 557, at \*56 (quoting *DuPont*, 177 USPQ at 567).

“[E]vidence of actual confusion is not required to prove a likelihood of confusion,” *id.*, at \*58, and its absence “is meaningful only if the record indicates appreciable and continuous use by [Respondent] of its mark for a significant period of time in the same markets as those served by [Petitioner] under its marks.” *Id.* (quoting *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Id.* (citing *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007)).

“As noted above, our analysis of the second, third, and fourth [*DuPont*] factors, discussing the similarity or dissimilarity of the [goods], channels of trade, and relevant consumers, is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the [parties’ registrations].” *Sabhnani*, 2021 USPQ2d 1241, at \*47 (quoting *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020) (emphasis in *Guild Mortg.*)). By contrast, the eighth *DuPont* factor “requires us to look at **actual market conditions**, to the extent there is evidence of

such conditions in the record.” *Id.*, at \*47-48 (quoting *Guild Mortg.*, 2020 USPQ2d 10279, at \*6 (emphasis in *Guild Mortg.*)). There is some such evidence in the record here, and “[a]ccordingly, we must look to the parties’ actual activities in the marketplace to determine whether there has ‘been a reasonable opportunity for confusion to have occurred.” *Id.*, at \*48 (quoting *Citigroup*, 94 USPQ2d at 1660).

While Petitioner argues that Respondent conducted an inadequate investigation of possible actual confusion, 230 TTABVUE 52; 233 TTABVUE 24, Petitioner admits that it is unaware of any instances of actual confusion. Resps. to Int. Nos. 6-7 (185 TTABVUE 11-12). Petitioner dismisses the probative value of the absence of such evidence because “the evidence reflects that Puma had limited sales of its PROCAT youth soccer cleats, socks, and headbands at Target stores from 2013-2017/2018 before Target transitioned to a different youth soccer brand,” 230 TTABVUE 51-52, and because Respondent “state[d] that it had **ZERO** advertising activities for the PROCAT brand, other than limited sales on Puma’s website that started in 2019 and unidentified promotion within the Target stores (when they were selling PROCAT products).” *Id.* at 52 (emphasis supplied by Petitioner). Petitioner concludes that “[g]iven the extremely low profile of the brand . . . the record does not support ‘appreciable’ or ‘continuous’ use of the PROCAT mark for the covered Class 25 goods.” *Id.* In its reply brief, Petitioner argues that “there is no evidence of record of CAT and PROCAT products being offered in the same stores or advertised in the same channels.” 233 TTABVUE 24.

Respondent does not contest Petitioner's factual claims regarding the extent of Respondent's sales and promotional activities. Instead, Respondent argues that it

began using PROCAT in 2012. . . . In ten years of co-existence selling within the same channel of trade, including both selling in Target, there have been zero instances of actual confusion reported to either Caterpillar or PUMA. . . . In other words, what has in fact happened in the market is exactly what we would expect in theory given the ubiquity of the term 'cat' and the other *DuPont* factors discussed above.

232 TTABVUE 45 (record citations omitted).<sup>46</sup>

Christopher Volpe, the Chief Operating Officer and Chief Financial Officer of United Legwear, the managing member of a joint venture with Puma North America, testified in his testimony declaration and on cross-examination about manufacture and sales of PROCAT footwear and other goods pursuant to a licensing agreement with Respondent. He explained on cross-examination that the PROCAT line was produced and manufactured exclusively for Target, and was sold to other retailers to close out any excess inventory. Volpe Conf. Tr. 18:21-19:3 (228 TTABVUE 21-22).

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<sup>46</sup> Respondent argues that the relevant period of the parties' coexistence without confusion is actually nearly 50 years because Respondent "has been using various product trademarks containing the letters c-a-t since at least the 1970s," and the "lack of confusion between the parties is all the more relevant given that PUMA and CATERPILLAR often use the same marketing channels and have even had their respective marks appear in some of the same movies and events." 232 TTABVUE 45. Respondent claims that "these fifty years of co-existence seem to have solidified in consumer's minds PUMA's association with feline imagery and 'cat' names and trademarks as associated with athletic footwear and apparel, while at the same time allowing consumers to associate CAT's logo and distinctive block lettering with heavy equipment and apparel promoting that industry." *Id.* at 45-46. We agree with Petitioner that "the relevant actual confusion inquiry should be between the marks at issue in this case—CAT and PROCAT," and that "[a]ny question of consumer confusion between the CAT and PUMA marks is irrelevant, as is confusion between the CAT mark and Puma's or third parties' other 'cat' marks." 233 TTABVUE 23.

In his testimony declaration, Mr. Volpe stated that in 2012 several millions of dollars in PROCAT goods were sold, but he did not break them down by product. Volpe Conf. Decl. ¶ 12; Ex. A (161 TTABVUE 6, 12-13). He further testified that several hundred thousand units of PROCAT soccer cleats were sold between 2013 and 2017, generating revenues of several million dollars, Volpe Conf. Decl. ¶¶ 11, 13; Ex. B (161 TTABVUE 6, 14-20), and on cross-examination he testified that there were no sales of PROCAT footwear in 2018 and 2019. Volpe Conf. Tr. 83:14-84:6 (228 TTABVUE 86-87). Target's orders for PROCAT footwear resumed in December 2020, Volpe Conf. Tr. 80:10-81:6; 83:14-19 (228 TTABVUE 83-84, 86), but products did not appear in Target stores until early 2021. Volpe Conf. Tr. 133:3-12 (228 TTABVUE 136).

As noted above, Respondent argues that Petitioner's CAT-branded goods were sold in Target, 232 TTABVUE 45, but Petitioner denies that there were any sales of CAT-branded footwear or apparel in Target. 233 TTABVUE 23. Mr. Beaupre testified that CAT-branded footwear and apparel have been sold in the United States in "thousands of third-party retail outlets," Beaupre Aff. ¶ 37 (107 TTABVUE 46), but Target is conspicuously absent from his list of examples of "national retailers," which includes Amazon.com, Sears, JC Penney, and Walmart, Beaupre Aff. ¶ 37 (107 TTABVUE 47), and he was not cross-examined regarding sales of any CAT-branded goods in Target. Petitioner made of record a page from Target's website displaying a CAT 3 Wheel Trike Pedal Tractor, Notice of Reliance No. 8 Ex. 52 (114 TTABVUE 5-8), but there is no evidence of any sales of CAT-branded footwear or apparel in Target, the trade

channel through which the vast majority of PROCAT goods of all types have been sold. Volpe Conf. Tr. 26:9-13 (228 TTABVUE 29).

In his declaration and on cross-examination, Mr. Volpe identified more than 20 retailers through which excess PROCAT inventory had been sold between 2012 and 2019. Volpe Conf. Decl. ¶ 11 (161 TTABVUE 5); Volpe Conf. Tr. 26:14-19; 76:15-19; 77:3-14 (228 TTABVUE 29, 79-80). Two of these retailers appear on Mr. Beaupre's list of national retailers through which CAT-branded footwear and apparel have been sold, Beaupre Aff. ¶ 37 (107 TTABVUE 47), but Mr. Volpe provided no information about the sales of PROCAT goods to these two retailers. Particularly given the evidence that the lion's share of sales of PROCAT footwear and apparel was to Target, the absence of any details regarding sales of PROCAT goods into these overlapping retailers gives Mr. Volpe's testimony no significant probative value. *Tiger Lily Ventures Ltd. v. Barclays Corp.*, 35 F.4th 1352, 2022 USPQ2d 513, at \*9 (Fed. Cir. 2022) (vague testimony about sales that did not provide "details to demonstrate the scope of the sales activity" did not establish that the absence of evidence of actual confusion was significant).

On this record, we find that "[t]here has been no meaningful opportunity for confusion to occur." *Double Coin Holdings*, 2019 USPQ2d 377409, at \*9. "We therefore find the absence of any actual confusion does not weigh in [Respondent's] favor." *Id.* The seventh and eighth *DuPont* factors are thus neutral in our analysis of the likelihood of confusion. *Sabhnani*, 2021 USPQ2d 1241, at \*49.

## 6. Summary of *DuPont* Factors

We agree wholeheartedly with Respondent that “the unadorned ‘CAT’ may be a word mark registered to Caterpillar, but that does not give Caterpillar a monopoly on the letters c-a-t.” 232 TTABVUE 8. But Petitioner’s ’449 Registration of “the unadorned ‘CAT’ . . . word mark,” *id.*, which can no longer be challenged under Trademark Act Section 2(d), *see* 15 U.S.C. § 1064, does give Petitioner conclusive evidence of its exclusive nationwide right to use CAT in commerce in connection with footwear, *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1035-36 (TTAB 2010) (citing 15 U.S.C. § 1115(b)), and the ability to prevent the registration of CAT-formative marks for footwear if Petitioner can prove, in each particular case, that there is a likelihood of confusion resulting from the use of the involved mark in connection with the involved goods.

Petitioner has done so in this particular case. The relevant *DuPont* factors collectively establish a likelihood of confusion arising from Respondent’s registration of its PROCAT mark for footwear. The involved goods, channels of trade, and classes of consumers are identical, the CAT and PROCAT marks are similar, and Petitioner’s CAT mark for footwear has conceptual strength, and significant commercial strength for footwear on the spectrum from very strong to very weak. The absence of evidence of actual confusion is not significant under the relevant marketplace conditions. We find that Petitioner proved, by a preponderance of the relevant evidence, that it is entitled to bring a statutory cause of action, that it has prior use of its registered CAT word mark for footwear, and that consumers who are familiar with that mark and who separately encounter Respondent’s PROCAT mark for the identical goods are

likely to believe mistakenly that footwear sold under the CAT and PROCAT marks has a common source.<sup>47</sup>

**Decision:** The Amended Petition for Cancellation is granted based on Petitioner's Section 2(d) claim, and Respondent's Registration No. 4220096 will be cancelled in due course.

Dunn, concurring opinion:

Because they are different,<sup>48</sup> and a standard character mark confers broader rights than a design mark, I diverge from the majority's decision to impute strength to the standard character mark CAT for footwear based on evidence that Caterpillar's




design mark for footwear is strong. *See In re Calphalon Corp.*, 122 USPQ2d 1153, 1160 n.8 (TTAB 2017) (“A standard character registration provides a registrant with the broadest form of coverage for the registered mark because such a registration gives the registrant rights in the mark in block letters as well as in ‘depictions of the standard character mark regardless of font style, size or color.’”)

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<sup>47</sup> Because we have granted the Amended Petition for Cancellation on the basis of Petitioner's Section 2(d) claim, we need not and do not reach its other claims. The “Board's determination of registrability does not require, in every instance, decision on every pleaded claim.” *Spiritline Cruises LLC v Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*1 (TTAB 2020) (quoting *Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013)).



<sup>48</sup> A standard character mark cannot include a design element. *See* Trademark Rule 2.52(a)(2), 37 CFR 2.52(a)(2). Moreover, because it would be a material alteration, Caterpillar

would not be allowed to amend an application to register its  design mark to CAT in standard characters. *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999); *In re Richards-Wilcox Mfg. Co.*, 181 USPQ 735 (Comm'r 1974); and Trademark Rule 2.72(b)(2), 37 CFR § 2.72(b)(2).




(quoting in part from *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)).

To be specific, Caterpillar’s evidence regarding its long and unvarying use of its  design mark on footwear is the basis for the majority’s decision finding that any display involving different fonts, sizes, and colors of the term CAT not only is allowed by Caterpillar’s standard character mark CAT for footwear, but is entitled to a wide scope of protection. Where, as the majority concludes here, Caterpillar’s standard character CAT mark falls “on the much higher end of the commercial strength spectrum ‘from very strong to very weak,’” the increased protection includes the ability to block less similar marks and less related goods. *See* J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition 11:73 (5th ed) (“All courts agree that ‘stronger’ marks are given ‘stronger’ protection—protection over a wider range of related products and services and variations on visual and aural format.”).

As the majority points out, and the visual depictions throughout the opinion show, Caterpillar’s brand guide requires the  design mark to appear on all of its footwear promotions and advertisements, and Caterpillar’s Brand Licensing Manager Beaupre testified in cross-examination that every item of Caterpillar footwear bears the design mark . To put it plainly, the footwear-buying consumers cannot recognize what they cannot see, and the record does not show that

footwear-buying consumers have regular exposure to any Caterpillar CAT mark

except  .

The majority reviews this evidence regarding use of the design mark  and draws the impermissibly broad conclusion that Caterpillar has demonstrated consumer recognition of Caterpillar's standard character mark CAT:


To the extent that the CAT logo is Petitioner's house mark, the CAT word mark is not a separate or different subsidiary product mark, but rather comprises the verbal and dominant portion of the house mark. To adopt the categorical position urged by Respondent, and tacitly applied by our concurring colleague, that we should simply ignore Petitioner's evidence of the use of its CAT logo for footwear in assessing the strength of the CAT word mark for those goods would be to elevate the technical form of the marks over the substance of their use. The reality is that when consumers see the CAT logo on footwear, they necessarily see the CAT word mark, particularly when the CAT logo is viewed at a distance on public-facing materials and on footwear when it is worn. Consumers are also likely to separately see the CAT word mark in the phrase CAT® Footwear.

*Supra* at 55-56.



This reality, that we, the Board, decide that consumers see less than the whole design mark for the purpose of finding strength in the literal element contained within the design mark, is wholly fashioned by the majority. There is no precedent for substituting our perception of reality for Caterpillar's burden to demonstrate that its standard character mark for footwear has such public recognition as to be commercially strong.



The majority's conclusion that it can separate the literal element in Caterpillar's

 design mark to accord CAT in standard characters strength separate from the


 design mark as a whole is based in part on the premise that consumers will use the literal term “to request the goods.” Such dissection of composite design marks and stylized word marks into visual and aural elements is disfavored. *See In re Electrolyte Labs., Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (“the spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.”); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 699 (CCPA 1980) (“It must be remembered that Great Plains’ trademark consists of highly stylized letters and is therefore in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.”); *In re Burndy Corp.*, 300 F.2d 938, 133 USPQ 196, 197 (CCPA 1962) (“The marks are not word marks and are not capable of being spoken. They are design marks and, although each is based on a capital letter ‘B,’ there are great dissimilarities between them which can be fully appreciated only from seeing them.”).

Even if assessing the strength of the mark as a whole allowed us to so dissect

Caterpillar’s  design mark to make the finding that consumers “necessarily see the CAT word mark,” this does not equate to a finding of commercial strength of the term CAT in any display involving different fonts, sizes, and colors. Without the design, the word CAT which is the literal element in Caterpillar’s  design mark


is still stylized in block letters of the same size as . Nothing in this record demonstrates how the consumer recognition of  presumed by the majority supports a finding that the footwear purchasing public perceives use of CAT in any alternate display involving different fonts and sizes (such as those shown below) on footwear as a strong source indicator for Caterpillar.<sup>49</sup>



The evidence of record shows that Caterpillar’s design mark  is widely recognized as the mark and abbreviated trade name of Caterpillar, whose “core business” is heavy machinery. Both Merriam Webster and Dictionary.com, two online dictionaries which the Board frequently uses for the purpose of judicial notice, define “cat” as both the noun “a carnivorous mammal (*Felis catus*) long domesticated as a pet and for catching rats and mice” and the trademark for “a Caterpillar tractor.”<sup>50</sup>

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<sup>49</sup> To the majority’s contention that the alternate displays of CAT are irrelevant because the finding of strength is based on their perception of the literal term CAT in Caterpillar’s design





mark , I disagree. The majority’s finding of strength is based on one specific stylization plus a design, but that strength finding pertains to any stylization, including the four examples. The alternate displays of CAT illustrate that the finding is too broad for the evidence.

<sup>50</sup> Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/cat>. Accessed Mar. 30 2023; Dictionary.com, <https://www.dictionary.com/browse/cat>.

In the comparison of the marks, I agree that the evidence that Caterpillar “manages its brand ‘so that our CAT marks are never associated with felines’” was insufficient to differentiate Puma’s **procat** mark from Caterpillar’s standard character mark. However, that evidence is pertinent to assessing whether the strength of Caterpillar’s design mark **CAT** has resulted in recognition of the term CAT in any stylization as an indicator that Caterpillar is the source of the goods. There is no factual basis for finding that the term CAT, which means a feline, in any and all displays involving different fonts and sizes will be perceived as indicating Caterpillar.


While my main objection is to consideration of Caterpillar’s use of its **CAT** design mark as support for finding that the CAT standard character mark is commercially strong, I also find the other evidence listed by the majority insufficient to support the finding of commercial strength. The majority also bases its finding of strength on the occasional use of CAT or CAT FOOTWEAR with the **CAT** design mark on footwear or in advertisements, and media use of the terms CAT or CAT FOOTWEAR. As to the former, I disagree that the evidence of Caterpillar’s intermittent use of CAT or CAT FOOTWEAR along with its **CAT** design mark is sufficiently detailed as to how often the consuming public has encountered the literal terms. On cross-examination, Caterpillar was unable to separate recognition of its sometimes concurrent use of CAT or CAT FOOTWEAR from recognition of its **CAT** mark, with the majority


finding, *supra* at 54, that Beaupre’s testimony “establishes that it would be next to impossible to segregate the uses of, and thus the public’s exposure to, the CAT word mark from the CAT logo with respect to footwear.” Because the footwear and advertising also bear the  design mark, this is not evidence that the term CAT is recognized as Caterpillar’s mark in other displays involving different fonts and sizes.

As to media use, my reluctance to give it much weight is twofold. While media recognition may echo or supplement consumer recognition of a mark, it should not supplant it. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) (“[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.”). In addition, because Caterpillar has chosen to use its  design mark on all footwear and in all advertisements for footwear, most of the articles discussing CAT footwear or its advertising campaigns include the  design mark, making the references to CAT alone merely a shorthand reference to the  design mark.<sup>51</sup> In sum, because the footwear and ads bear the  design mark, there is


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<sup>51</sup> As the majority notes, the media refers to “the famous ‘CAT’ yellow logo.” The majority regards that as use showing Caterpillar’s trademark rights have expanded to encompass all

no evidence that the footwear buying public perceives the literal term CAT in other forms, and not adjacent to the  design mark, as a source indicator for Caterpillar.

As the majority states, we assess the commercial strength of a mark along a spectrum. While I do not propose a per se rule that bars any particular evidence for showing commercial strength of a standard character mark, I think it obvious that the quantum of evidence needed to prove the commercial strength of a standard character mark also involves a spectrum. The quantum of evidence necessary to show the commercial strength of the standard character mark WOLFSONLARKINDUNN will be less than the quantum of evidence necessary to show the commercial strength of the standard character mark CAT, an ordinary dictionary term which also is an abbreviated trade name and trademark when used in connection with heavy machinery or in association with Caterpillar's  design mark. That is, because of the length, complexity, and coined nature of the term WOLFSONLARKINDUNN, significant consumer recognition of the mark in one display may be enough to support a finding of commercial strength in the standard character mark. But it is not enough here.

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stylizations of CAT and I regard it as recognition of the  design mark, but describing it rather than reproducing it.

Because the record shows consistent use and advertisement of the  design mark on footwear by Caterpillar, and Caterpillar admits it has no records of any such consistent use of any other CAT mark on footwear, any finding of fame for footwear based on this record is limited to Caterpillar's  design mark. The majority's finding that the CAT "word mark" is perceived as part of the Caterpillar  design mark on footwear improperly dissects the mark recognized by consumers and, even as supplemented with the evidence of intermittent use and media references to CAT footwear, is insufficient to support the majority's finding that Caterpillar's standard character mark CAT is commercially strong when applied to footwear.

On this record, Caterpillar's standard character mark CAT is entitled only to the scope of protection accorded an inherently distinctive mark, and this is sufficient to grant the Amended Petition for Cancellation. *See Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347-48 (TTAB 2017).