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Sent: 4/14/2020 9:27:47 AM

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Subject: U.S. Trademark Application Serial No. 87784549 - ANNIE'S DOODLES - T58193US00 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 87784549.doc

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87784549

Mark: ANNIE'S DOODLES

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Reference/Docket No. T58193US00

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Annie's Doodles, LLC ("Applicant"), has appealed the final refusal to register the proposed mark "ANNIE'S DOODLES" in standard characters, for "dog breeding services" in International Class 44, and "providing a website featuring listings and photographs of pets available for adoption and related information concerning pet adoption" in International Class 45.

Registration was refused as to International Classes 44 and 45 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that the applied-for mark is likely to be confused with the following registered mark:

- “DR. ANNIE'S” (U.S. Registration No. 3988347) in standard characters, for “Animal grooming; Animal grooming services; Consultation services in the field of pet behavior; Insertion of subcutaneous microchips into pets for purposes of tracking and identification; Pet care services, namely, administration of medication; Pet care services, namely, dog walking, dog bathing and non-medicated pet grooming; Pet care services, namely, dog walking, dog bathing, non-medicated pet grooming and in-home medical care; Pet dentist services; Pet grooming services; Pet hospital services; Providing information and advice in the field of pet health; Providing information in the fields of animals and pet breeding, selection of the animals and pets, grooming, health and nutrition; Providing on-line information via the Internet in the fields of animals and pets, relating to breeding, selection of the animals and pets, grooming, feeding and nutrition; Providing self-service pet grooming facilities; Providing self-service pet washing facilities; Tattooing of pets for identification purposes; Veterinary dentistry; Veterinary emergency and trauma services; Veterinary services; Veterinary specialty services providing advanced dental and oral surgery; Veterinary specialty services providing advanced medical, diagnostic or surgical services for animals; Veterinary surgery” in International Class 44.

It is respectfully requested that this refusal be affirmed.

I. STATEMENT OF FACTS

On February 5, 2018, Applicant filed a Section 1(a) application for “ANNIE’S DOODLES” in standard characters, for use in connection with “dog collars” in International Class 18, “dog breeding services” in International Class 44, and “providing a website featuring listings and photographs of pets available for adoption and related information concerning pet adoption” in International Class 45.

On May 18, 2018, the Examining Attorney refused registration as to International Classes 44 and 45 pursuant to Trademark Act Section 2(d) on the ground that the applied-for mark was confusingly similar to the mark in Registration No. 3988347 (“DR. ANNIE'S”).¹ The Examining Attorney also refused

¹ The Examining Attorney also provided an advisory regarding the prior-filed U.S. Application Serial No. 86651613 (“ANNI ALBERS”), which abandoned prior to issuing the Final Office action.

registration as to International Class 18 pursuant to Trademark Act Sections 1 and 45 on the ground that the specimen did not show the applied-for mark in the drawing in use in commerce and pursuant to Trademark Act Sections 1, 2, and 45 on the ground that the applied-for mark as used on the specimen of record was merely a decorative or ornamental feature of the goods, and therefore, did not function as a trademark to indicate the source of the goods and to identify and distinguish them from others. In addition, the Examining Attorney required a disclaimer of the wording “DOODLES” and a statement regarding whether the name “ANNIE” in the mark identifies a particular living individual.

On October 16, 2018, Applicant submitted arguments in response to the Section 2(d) refusal, amended the filing basis of International Class 18 to intent to use under Section 1(b), submitted a disclaimer of the wording “DOODLES,” and submitted the written consent of Ann Carlson for the use of her first name “ANNIE” in the mark.

On June 27, 2019, the Examining Attorney issued a final refusal under Section 2(d).²

On December 27, 2019, Applicant filed the present appeal with the Trademark Trial and Appeal Board (“Board”). Applicant appeals the Trademark Act Section 2(d) refusal as to International Classes 44 and 45 only, therefore, International Class 18 is deemed abandoned.³ TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1202.01.

II. ARGUMENT

THE PROPOSED MARK “ANNIE'S DOODLES” IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARK “DR. ANNIE'S”

² On November 29, 2018, the Examining Attorney issued a new non-final Office action also refusing registration as to International Class 18 because of a likelihood of confusion with the mark in U.S. Registration No. 5080304 (“ANNIE PHILLIPS”). On June 27, 2019, the Trademark Act Section 2(d) refusal was made final as to International Classes 44 and 45 because of a likelihood with the mark in U.S. Registration No. 3988347 (“DR. ANNIE'S”) and as to International Class 18 because of a likelihood of confusion with the mark in U.S. Registration No. 5080304 (“ANNIE PHILLIPS”).

³ 1 TTABVUE; 4 TTABVUE 4.

Applicant has proposed the mark “ANNIE'S DOODLES” in standard characters, for use with “dog breeding services” in International Class 44 and “providing a web site featuring listings and photographs of pets available for adoption and related information concerning pet adoption” in International Class 45. Annie M. Harvilicz (“Registrant”) owns Registration No. 3988347, “DR. ANNIE'S” in standard characters, for use with, in relevant part “providing information and advice in the field of pet health; providing information in the fields of animals and pet breeding, selection of the animals and pets, grooming, health and nutrition; providing on-line information via the Internet in the fields of animals and pets, relating to breeding, selection of the animals and pets, grooming, feeding and nutrition.”

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017).

The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747; see TMEP §1207.01. In this case, the marks are similar in terms of appearance and commercial impression and the services are related in terms of nature, purpose, channels of trade, and classes of purchasers.

A. The applied-for mark is confusingly similar to the registered mark.

The applied-for mark “ANNIE’S DOODLES” in standard characters, is similar to the registered mark “DR. ANNIE’S” in standard characters, because the marks share the term “ANNIE’S” and create a similar overall general commercial impression of “a female given name, form of Ann, Anna, or Anne.”⁴

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §1207.01(b)(viii), (c)(ii).

The word “ANNIE’S” is the dominant portion of the applied-for mark because it is the first word in the mark and the other wording in the mark, “DOODLES,” is merely descriptive and has been disclaimed. Consumers are also generally more inclined to focus on the first word in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018). Furthermore, disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). The word “ANNIE’S” is also the dominant portion of the registered mark because the first term in the mark, “DR.,” is a merely a title, and therefore, has less source-indicating significance than the term “ANNIE’S.” See *Manhattan Group, LLC v. RMI Bratz, Inc.*, 2003 TTAB LEXIS 544, *9 (TTAB 2003) (finding that the marks SKWISH and MISTER SKWISH are similar because applicant’s mark incorporates opposer’s mark and “because MISTER is a title, it has less source-indicating significance than the term SKWISH which is the dominant portion of applicant’s mark.”); *In re Morgan Pipes, Inc.*, 2017 TTAB LEXIS 198, *3-4 (TTAB 2017) (“The word BONES is the dominant portion of Registrant’s mark because “MR.” is merely a title,

⁴ See June 27, 2019 Office Action.

while what follows the title, in this case BONES, is what is identified by the mark in its entirety. . . . As a prefix ‘MR.’ draws attention to what follows, in this case, BONES, which is identical to Applicant’s mark.”). The addition of a common and nondistinctive title or courtesy prefix to a mark, such as “Mr.,” “Mrs.,” “Mlle.,” “Dr.” or “MD,” does not alter the mark’s general commercial impression. *C.f. In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174 (Fed. Cir. 2005) (holding DR. RATH primarily merely a surname); *In re Revillon*, 154 USPQ 494 (TTAB 1967) (holding MLLE. REVILLON primarily merely a surname). Because the title “DR.” merely draws attention to the wording following it, the word “ANNIE’S” is the dominant portion of the mark.

The inclusion of the title “DR.” in the registered mark and the merely descriptive wording “DOODLES” in the applied-for mark does not alter the marks’ general commercial impressions or diminish the similarity between the marks. When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); TMEP §1207.01(b). In this case, the dominant wording “ANNIE’S” creates the general commercial impression of “a female given name, form of Ann, Anna, or Anne.”⁵

Contrary to Applicant’s assertion, there is no evidence that the term “ANNIE’S” is weak or diluted with respect to the relevant services.⁶ Applicant has submitted printed or electronic copies of third-party

⁵ See June 27, 2019 Office Action.

⁶ 4 TTABVUE 8-9.

registrations and applications for marks containing the wording “ANNIE” or “ANNIE’S” to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection.⁷

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). Evidence of widespread third-party use of similar marks with similar goods and/or services “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field. *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

However, the majority of these registrations appear to be for goods and services that are predominantly different from or unrelated to those identified in Applicant’s application, for example, cookies,⁸ retail book store services,⁹ breakfast cereal,¹⁰ wine,¹¹ comic strips,¹² sauces,¹³ and graduated rulers.¹⁴ Evidence comprising third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has “no bearing on the strength of the term in the context relevant to this case.” *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). Thus, these third-party

⁷ 4 TTABVue 8-9; October 16, 2018 Response to Office Action; May 29, 2019 Response to Office Action.

⁸ U.S. Registration No. 2424293.

⁹ U.S. Registration No. 1348750.

¹⁰ U.S. Registration No. 3517349.

¹¹ U.S. Registration No. 3533999.

¹² U.S. Registration No. 2683812.

¹³ U.S. Registration No. 2886439.

¹⁴ U.S. Registration No. 4321358.

registrations submitted by applicant are insufficient to establish that the shared wording “ANNIE’S” is weak or diluted.

Applicant asserts that although the third party registrations are “for a wide-ranging variety of goods and services,” there are also thirteen “ANN, ANNA or ANNIE formative marks for pet good/services registrations.”¹⁵ However, four of those thirteen “marks” are merely applications - “ANNE WITH AN E,”¹⁶ “SWEET ANNIE’S IN-HOME PET SITTING,”¹⁷ “ANNA,”¹⁸ and “ANNA & GEORGE.”¹⁹ Third-party applications are evidence only that the applications were filed; they are not evidence of use of the mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); TBMP §1208.02; TMEP §710.03. Moreover, many of the remaining marks referenced contain additional distinctive matter such as a first and last name or two first names, for example, “ANNIE SEZ,” “ANNA TOSANI,” “KIKI & ANNA,” and “ANN SUMMERS.” Therefore, their coexistence is of little significance because the marks are not similar and easily distinguished. Thus, the remaining few similar third-party registrations submitted by applicant are insufficient to establish that the wording “ANNIE’S” is weak or diluted.

In addition, third-party registrations are entitled to little weight on the issue of confusing similarity because the registrations are “not evidence that the registered marks are actually in use or that the public is familiar with them.” *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); see TMEP §1207.01(d)(iii). Therefore, these registrations have no bearing on the similarity between the marks “ANNIE’S DOODLES” and “DR. ANNIE’S.”

¹⁵ 4 TTABVUE 8-9; May 29, 2019 Response to Office Action.

¹⁶ U.S. Application Serial No. 87416384.

¹⁷ U.S. Application Serial No. 88189571.

¹⁸ U.S. Application Serial No. 88307863.

¹⁹ U.S. Application Serial No. 88101946.

Based on the foregoing, the mark “ANNIE'S DOODLES” in standard characters, is similar to the registered mark “DR. ANNIE'S” in standard characters.

B. Applicant’s services are related to Registrant’s services.

Applicant’s “dog breeding services” and “providing a web site featuring listings and photographs of pets available for adoption and related information concerning pet adoption” are related to Registrant’s “providing information and advice in the field of pet health; providing information in the fields of animals and pet breeding, selection of the animals and pets, grooming, health and nutrition; providing on-line information via the Internet in the fields of animals and pets, relating to breeding, selection of the animals and pets, grooming, feeding and nutrition” because the services are closely related in terms of their nature, purpose, channel of trade, and class of purchasers.

The evidence of record from *RoyalBlueGreatDanes.com*, *CrockettDoodles.com*, *ForestCreekKennels.net*, and *GorgeousDoodles.com* establishes that the same entity commonly provides dog breeding services, provides a web site featuring listings and photographs of pets available for adoption and related information concerning pet adoption, and provides information and advice in the field of animals, pets, pet health, pet breeding, selection of the animals and pets, grooming, health and nutrition and markets the services under the same mark and that the relevant services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use.²⁰ Thus, the services are related. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009).

The fact that the services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular services, but likelihood of

²⁰ *See* May 18, 2018 Office Action.

confusion as to the source or sponsorship of those services. *See in re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); TMEP §1207.01. The evidence of record establishes that Applicant's and Registrant's services are similar in terms of nature, purpose, channels of trade, and class of consumers, and therefore, consumers are likely to be confused as to the source of the services.

Applicant argues that the evidence of record is insufficient to show that the services are related because evidence consisting of four websites shows that any overlap of the services is de minimus.²¹ However, Applicant's reliance on *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2D (TTAB) 1059, for the proposition that the Examining Attorney's evidence is insufficient to show that the services are related is misplaced.²² In *In re Coors Brewing Co.*, the Court found that the evidence of record was insufficient in light of the requirement that "something more" be shown to establish the relatedness of food and restaurant products for purposes of demonstrating a likelihood of confusion. In this case, "something more" is not required as both Applicant and Registrant identify services in the related fields of provision of information about pets, selection and adoption of pets, and dog breeding. *See* TMEP §1207.01(a)(ii).

Applicant asserts that "a review of [registrant's] service identification, together with the specimen submitted with her Section 8 declaration, demonstrates that Dr. Annie Harvilicz [Registrant] is a practitioner of modern and traditional Chinese veterinary medicine,²³ and that the information services identified in the registration are merely ancillary services offered in connection with the primary veterinary services."²⁴ Applicant contends that the services are merely tangentially related because "the

²¹ 4 TTABVUE 11-12.

²² 4 TTABVUE 11-12.

²³ 4 TTABVUE 6.

²⁴ 4 TTABVUE 10.

Examiner proffered no evidence to show that the same source typically offers both veterinary services and dog breeding services.”²⁵

However, the issue is not whether Applicant’s services are related to veterinary services. The issue is whether Applicant’s services are related to Registrant’s identified services of “providing information and advice in the field of pet health; providing information in the fields of animals and pet breeding, selection of the animals and pets, grooming, health and nutrition; providing on-line information via the Internet in the fields of animals and pets, relating to breeding, selection of the animals and pets, grooming, feeding and nutrition.” Each of Registrant’s listed services are separate and independent of each other. They are not limited or tied to Registrant’s veterinary services and whether Registrant’s information services are primary or ancillary to those veterinary services is irrelevant. Determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Applicant also argues that there is no likelihood of confusion because the relevant consumers are sophisticated.²⁶ Assuming, *arguendo*, that Applicant is correct, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital*

²⁵ 4 TTABVUE 10.

²⁶ 4 TTABVUE 12.

LLP, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019).

Based on the foregoing, Applicant's "dog breeding services" and "providing a web site featuring listings and photographs of pets available for adoption and related information concerning pet adoption" are related to Registrant's "providing information and advice in the field of pet health; providing information in the fields of animals and pet breeding, selection of the animals and pets, grooming, health and nutrition; providing on-line information via the Internet in the fields of animals and pets, relating to breeding, selection of the animals and pets, grooming, feeding and nutrition" because the services are closely related in terms of their nature, purpose, channel of trade, and class of purchasers.

C. Summary

The marks "ANNIE'S DOODLES" and "DR. ANNIE'S" are similar because the marks share the term "ANNIE'S," convey the same idea, stimulate the same mental reaction, and have the same overall meaning. The services are related in terms of their nature, purpose, channels of trade, and class of consumers. Consequently, Applicant's applied-for mark is confusingly similar to Registrant's mark because the marks are similar in terms of commercial impression and the services are related. Moreover, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i).

III. CONCLUSION

Applicant's applied-for mark "ANNIE'S DOODLES" in standard characters, and the Registrant's mark "DR. ANNIE'S" in standard characters, are likely to be confused by potential consumers. For the foregoing reasons, the Examining Attorney respectfully requests that the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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