

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: December 13, 2017

Mailed: January 26, 2018

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*Kimberly-Clark Worldwide, Inc.*

*v.*

*Matosantos Commercial Corp.*

Opposition No. 91218800

Jennifer E. Hoekel and Donna F. Schmitt of  
Armstrong Teasdale LLP for Kimberly-Clark Worldwide, Inc.

Samuel F. Pamas-Portalatin of Hogle & Pamas, P.S.C. for  
for Matosantos Commercial Corp.

Before Taylor, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Matosantos Commercial Corp. (“Applicant”) seeks registration of the mark shown  
below



(with “BATHROOM TISSUE” disclaimed) for “toilet paper.”<sup>1</sup> In its amended notice of opposition, Kimberly-Clark Worldwide, Inc. (“Opposer”) alleges prior use of “a Puppy shown in various poses” for bathroom tissue and related products, and registration of the mark shown below



for “bathroom tissue.”<sup>2</sup> As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s marks and falsely suggest a connection with Opposer. In its answer, Applicant denies the salient allegations in the amended notice of opposition, and asserts a number of “affirmative defenses,” most of which are in fact merely amplifications of its denials. Applicant failed to explain, pursue or prove the true affirmative defenses asserted in its answer,

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<sup>1</sup> Application Serial No. 85901644, filed April 11, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on alleged first use dates of February 7, 2013. The application includes this description of the mark: “The mark consists of the words ‘Tender Puff’ written in white stylized letters over a blue curved banner. The words are surrounded by a dark blue shadow. The dark blue shadow is surrounded by a white outline. Below the blue curved banner is found the stylized words ‘Bathroom Tissue’ written in red letters. There is a curved green line on top and below the words ‘Bathroom Tissue’ and on top of the blue curved banner. Below the letters ‘TE’ of the word ‘Tender’ is found a white dog with beige ears, black paws, black eyes, and black nose holding a red heart like figure in its mouth.”

<sup>2</sup> Registration No. 4656343, issued December 16, 2014. The registration includes this description of the mark: “The mark consists of a dog with a tan, dark tan and white body, a black underside with black and tan paws with green and black eyes and black nose, black mouth and tongue in red and black and whose front right paw is on a roll of bathroom tissue that is white with gray shading.”

and they are accordingly waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

### **The Record and Evidentiary Objection**

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Applicant's involved application. In addition, Opposer introduced a notice of reliance ("NOR") on Office records and Applicant's written responses to Opposer's discovery requests, 25 TTABVUE;<sup>3</sup> as well as the testimony deposition of Erin M. Ehmke, one of its brand managers, and the exhibits thereto ("Ehmke Tr."). 26 TTABVUE. Applicant introduced a NOR on Opposer's written responses to Applicant's discovery requests, 31 TTABVUE; as well as the testimony deposition of Mariely Tomassini-Arcelay, one of its senior brand managers and product developers, and the exhibits thereto ("Tomassini-Arcelay Tr."). 32 TTABVUE.

Opposer objects to admission of the exhibits to the Tomassini-Arcelay trial deposition, none of which were produced during discovery. In fact, Applicant asserted several blanket and largely boilerplate objections to Opposer's discovery requests, and only produced the documents the night before the Tomassini-Arcelay trial deposition. 36 TTABVUE 29-31. The exhibits include packaging and invoices for products sold under Applicant's mark, which Opposer clearly requested in, *inter alia*,

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<sup>3</sup> Citations to the record reference TTABVue, the Board's online docketing system. Specifically, the number preceding "TTABVue" corresponds to the docket entry number(s), and any number(s) following "TTABVue" refer to the page number(s) of the docket entry where the cited materials appear.

Document Request Nos. 2 (“documents relating to ... use of the Applicant’s Mark”), 27 (“documents ... sufficient to show ... the manner of use of the Applicant’s Mark in connection with such goods”), 11 (“documents relating to ... sales by you ... in conjunction with the Applicant’s mark”), 21 (“communication between you and any third party including ... any ... customer”) and 38 (“documents relating to any sales by you of ... products bearing or sold in conjunction with the puppy design ...”).

Applicant does not dispute that it failed to produce the documents until the eve of the testimony deposition. Applicant argues, however, that during discovery it “never expressed that the documents requested by Opposer did not exist, and that “Opposer acquiesced to Applicant’s response” by failing to file a motion to compel. Applicant does not explain when or how the documents became available. It merely states that they “became available before Ms. Mariely Tomassini’s deposition and [were] produced before the same.” 39 TTABVUE 31-32.

Opposer’s objection is sustained. As Opposer points out, on August 12, 2016, almost six months before the deposition, Applicant sent an e-mail to Opposer specifically stating that “all responsive documents that have been found have been produced ... Thus, no further exchange of documents is expected from Matosantos.” 36 TTABVUE 66. Opposer therefore had no reason to file a motion to compel or to further pursue additional responses.

It is unfair for a party to withhold documents requested or refuse to answer interrogatories posed by its adversary or, as appears to be the case here, fail to make a complete investigation to locate the information ... opposer is not justified in having failed to submit the questioned

documents to applicant simply because no thorough investigation was made initially.

*Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987). Applicant's reliance on *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998) is misplaced, because in that case there was nothing "which would have led petitioner to believe that no such documents existed." Here, by contrast, Applicant sent the e-mail indicating that it produced what it found and would produce no more. We have therefore not considered the exhibits to the Tomassini-Arcelay testimony deposition.<sup>4</sup>

### **Standing and Priority**

Opposer introduced printouts from an Office database showing that it owns its pleaded registration and that the registration is valid. 25 TTABVUE 6-10. The registration establishes Opposer's standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). And because Applicant has not counterclaimed to cancel the registration, priority is not at issue with respect to the mark and goods identified therein. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).<sup>5</sup>

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<sup>4</sup> We hasten to add that, for the reasons discussed below, even if we had considered the exhibits to the Tomassini-Arcelay testimony deposition, they would not have changed the result. We accept that Applicant has sold toilet paper under its mark since 2013.

<sup>5</sup> Because we focus in this decision on Opposer's pleaded registration, the parties' arguments regarding priority and which of them was the first to use are not relevant. Section 2(d) of the Act prohibits registration of a mark confusingly similar to "a mark registered in the Patent and Trademark Office." *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) ("with respect to applicant's arguments concerning his priority of use of the mark for computer programs, a registration of a subsequent-user opposer is sufficient to deny registration to applicant if there is a likelihood of confusion") (citing *King Candy*).

**Likelihood of Confusion**

Determining whether there is a likelihood of confusion requires an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We focus our analysis on the mark in Opposer's pleaded registration, rather than the variations thereof in which Opposer claims common law rights.

**Goods, Channels of Trade and Classes of Purchasers**

While Applicant identifies its goods as "toilet paper" and Opposer identifies its goods as "bathroom tissue," the terms are synonymous and therefore the goods are identical. Indeed, Opposer refers to the goods bearing the pleaded mark as "toilet paper":



Applicant does not dispute that the goods are identical, and even claims in its brief that Opposer’s mark “consists of a design of ‘a puppy’ with its paw on top of a toilet paper ....” 39 TTABVUE 22.

Because the goods are identical, we must presume that the channels of trade and classes of purchasers are as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The legal identity of the goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Similarity of the Marks

The marks have obvious similarities and obvious differences. Opposer's mark consists solely of a dog "whose front right paw is on a roll of bathroom tissue," while Applicant's consists of a dog "holding a red heart like figure in its mouth," next to the words TENDER PUFF written over a banner under which appear the words BATHROOM TISSUE. While the differences between the marks are readily apparent, under the circumstances of this case, they are outweighed by the marks' even more obvious similarities.

Perhaps most importantly, Applicant's and Opposer's dogs look similar.



Each party refers to its dog as a "puppy." 26 TTABVUE 9-11; 32 TTABVUE 11-12, 35, 38. Both puppies are sitting and looking at the camera, and they are both light-colored. Applicant's dog is described as having "beige ears," the same color as Opposer's dog's ears. Applicant's dog has "black eyes, and black nose," while Opposer's has "green and black eyes and black nose." The puppies also appear to

potentially be the same breed, in whole or in part.<sup>6</sup> As Applicant states in its brief, “the images speak for themselves.” 39 TTABVUE 25.

While Applicant’s puppy is holding a “red heart like figure in its mouth” and Opposer’s puppy’s “front right paw is on a roll of bathroom tissue,” this difference is rendered relatively insignificant by the fact that both dogs are used and displayed in connection with toilet paper. Indeed, Applicant’s dog appears to the left of “the stylized words ‘Bathroom Tissue’ written in red letters,” while Opposer’s dog’s front right paw is literally “on a roll of bathroom tissue.” The marks therefore create similar commercial impressions – similar puppy mascots are being used to identify different brands of toilet paper.

Neither the literal portion of Applicant’s mark, TENDER PUFF BATHROOM TISSUE, nor its nondistinctive banner design, are sufficient to avoid confusion. In fact, generic terms such as “bathroom tissue” and suggestive terms such as TENDER PUFF are entitled to less weight in our analysis. *See e.g. Cunningham*, 55 USPQ2d at 1846 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

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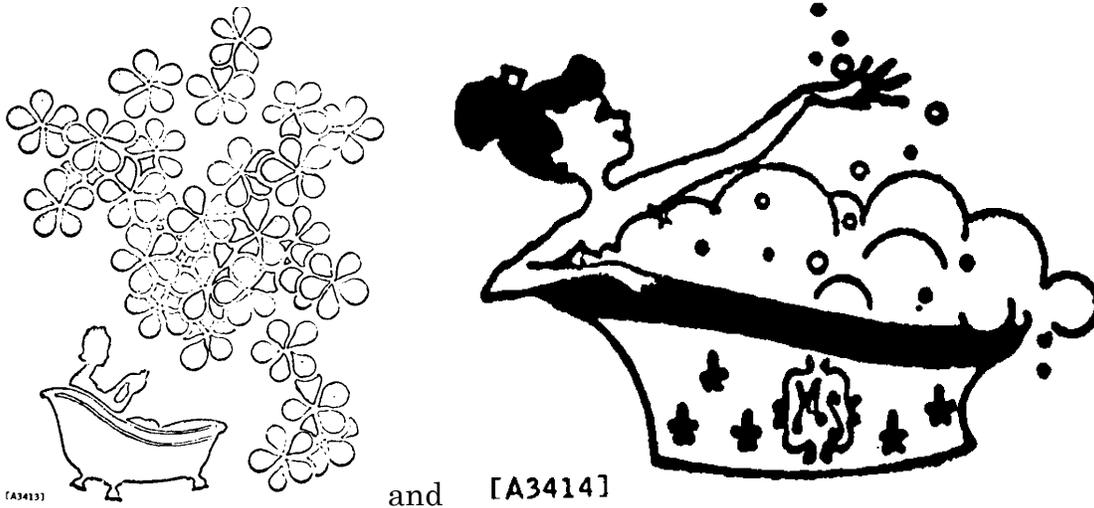
<sup>6</sup> Ms. Ehmke testified that Opposer’s dog is a “yellow lab,” 26 TTABVUE 9-11, while Ms. Tomassini-Arcelay was not “able to answer” when asked to identify Applicant’s dog’s breed. 32 TTABVUE 36

Moreover, while words are generally assigned greater weight than accompanying designs, this case is atypical in that Opposer's mark consists solely of the puppy with its paw on a roll of toilet paper, so rather than using words to call for Opposer's goods, consumers might identify Opposer's brand another way, perhaps by recalling and mentioning the dog, or "the puppy with toilet paper." *Cf. In re Viterra*, 101 USPQ2d at 1911 (Fed. Cir. 2012) ("the verbal portion of a word and design mark likely will be the dominant portion") and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Some consumers may even believe, upon encountering Applicant's toilet paper, that Opposer has begun using the words TENDER PUFF BATHROOM TISSUE to identify its toilet paper which was formerly identified only by the dog design.

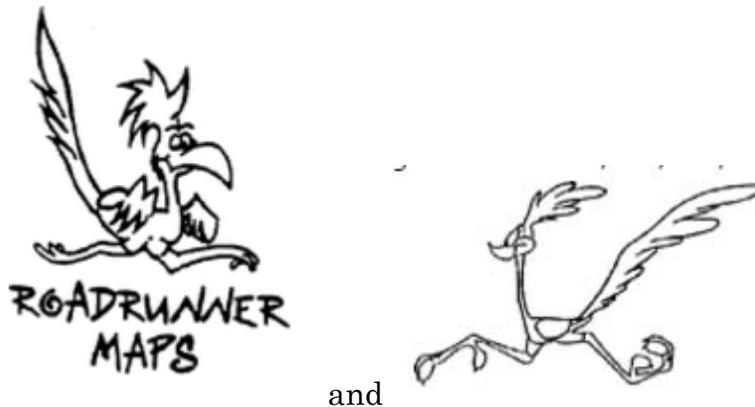
... where the question of likelihood of confusion to be decided involves design marks which are not capable of being spoken, the question of the similarity of the marks must be determined primarily on the basis of their visual similarity. Undoubtedly, if the marks were placed side by side for comparison, specific differences in them could be detected and those differences might well be enough to distinguish one from the other ... However, that is not the case. It is highly unlikely that the marks of these parties would be viewed together. When such marks are seen at different times on such similar goods, the recollection of the first viewed mark will be a general impression most likely devoid of the details noted by applicant. What will be remembered will be a figure of a frankfurter having arms, legs, a pleasant facial feature and a chef's hat. It is noteworthy also that the goods are not expensive and are purchased with less than a great deal of care.

*In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990).

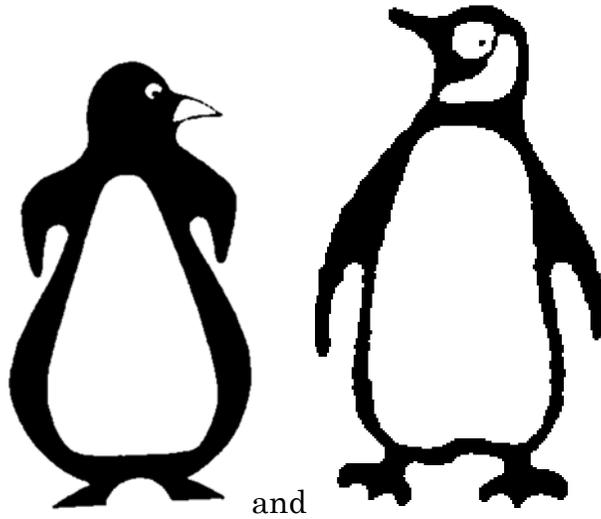
In fact, confusion is often found in cases such as this, where marks are used for highly similar or identical goods and include similar designs, even if there are also literal or other differences between the marks. For example, the following marks have been found confusingly similar:



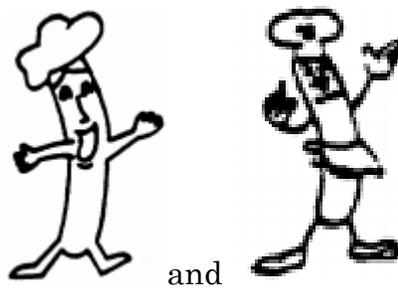
*In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971) (both for bath products).



*Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002) (applicant's road maps found to be within opposer's "natural area of expansion" given its licensing of its mark on a wide variety of goods).



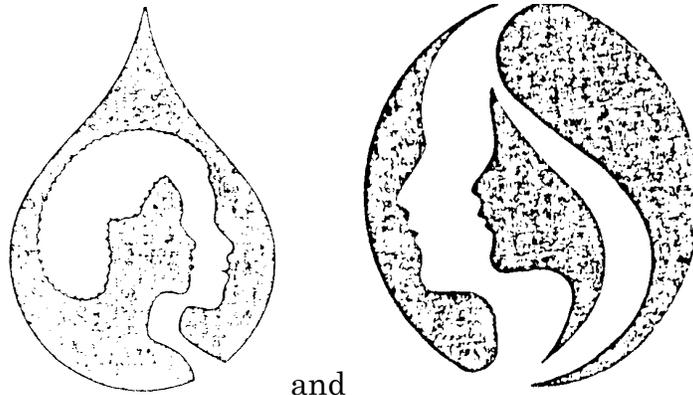
*Penguin Books*, 48 USPQ2d at 1280 (computer programs and books).



*In re Vienna Sausage*, 16 USPQ2d at 2044 (both for frankfurters).

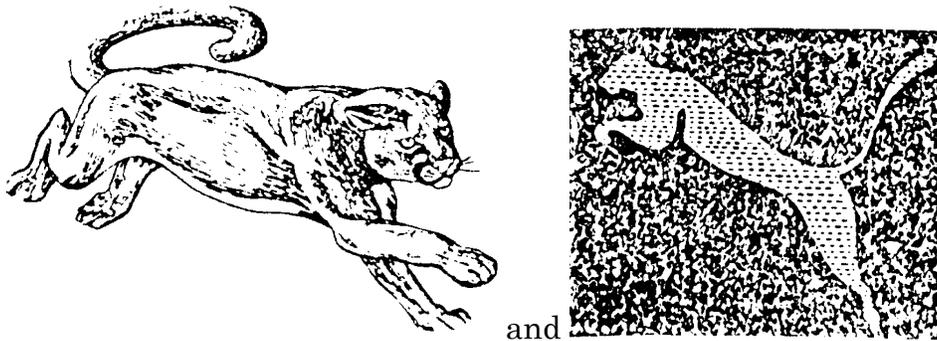


*Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988) (both for clothing).



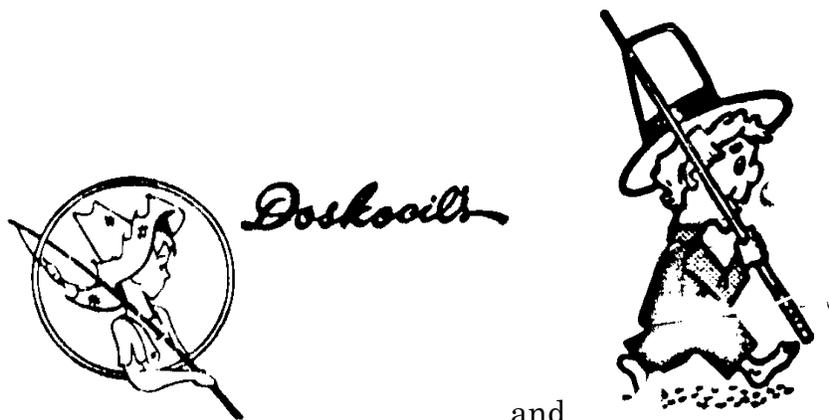
and

*In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (distributorship services in the field of health and beauty aids and moisturizing skin cream).



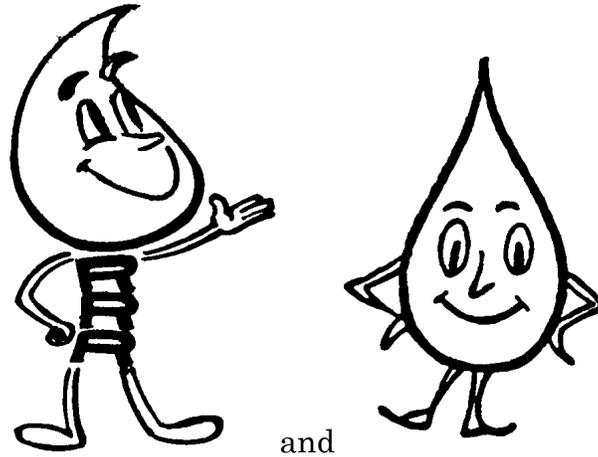
and

*Puma-Sportschuhfabriken Rudolf Dassier Kg v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (both for shirts).



and

*Odom Sausage Co., Inc. v. Doskocil Sausage, Inc.*, 169 USPQ 379 (TTAB 1971) (both for sausage).



*In re Triple R Mfg. Corp.*, 168 USPQ 447 (TTAB 1970) (both for oil filters).

One common theme running through several of these cases is the recognition that consumers generally do not encounter competing marks side-by-side, where their differences become more obvious. That is why the test is not whether marks can be distinguished side-by-side, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). The record in this case calls to mind *Odom Sausage*:

... there can be no question but that a side-by-side comparison of the marks reveals a number of differences in the various features of the boy designs, but the question of the confusing similarity of marks cannot be determined by comparing the two in juxtaposition since purchasers, in the ordinary marketing milieu, do not always see the goods in juxtaposition ... Under such circumstances and considering that the average purchaser is not infallible in his recollection of trademarks, much less specific details of design marks, his recollection of opposer's trademark would not be very clear and definite. Thus, relying upon

memory and vague impressions, it is not unreasonable to assume that, if he were to encounter applicant's competitive product in a package prominently displaying a farm boy design, which possesses marked similarities to and creates the same general overall commercial impression as opposer's mark, he would be likely to mistakenly assume that this sausage product originates from the same source ... in view of the similarities between opposer's farm boy design and that of applicant, the fact that applicant's mark incorporates the name "DOSKOCIL'S" is not considered sufficient to distinguish between the marks in issue and to avoid a likelihood of confusion in trade.

*Odom Sausage*, 169 USPQ at 382. Similarly, here Applicant's and Opposer's marks both prominently display puppies, with significant similarities, to identify identical products, and the marks create the same general overall commercial impression.

We have considered the marks "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Applicant's and Opposer's puppies appear quite similar. To the extent Opposer's mark is "pronounced," a customer will be likely to reference the dog design, and could be mistakenly understood to be identifying Applicant's mark featuring a similar dog, or Applicant's identical goods. The marks, featuring similar puppies in connection with identical goods, create similar overall commercial impressions. Therefore, notwithstanding the differences between the marks, which we have not ignored, we find that this factor weighs in favor of finding a likelihood of confusion.<sup>7</sup>

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<sup>7</sup> Applicant's focus on the differences between the parties' packaging is misplaced. Our task here is to compare the mark in Opposer's pleaded registration to the mark in the involved

The Strength of Opposer's Mark

While Opposer made a half-hearted attempt to establish that its mark is famous or at least strong, 36 TTABVUE 19, there is no evidence supporting the argument. Opposer's mere long term use, even though it is throughout the United States, is not enough, standing alone, to establish strength. *Cf. Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) ("fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark ..."). Therefore, this factor is neutral.

While Opposer's mark is not entitled to an increased scope of protection as a strong mark, at the same time we are persuaded that Opposer's mark is sufficiently distinctive that consumers familiar with it would be confused by Applicant's mark. In fact, there is no evidence of record that dogs have any toilet paper-related meaning or that dogs are used by any third parties to identify the source of, or otherwise in connection with, toilet paper. As a result, consumers familiar with Opposer's mark,

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application; Opposer has the right to use the mark in its registration by itself, even if it does not typically (or ever) do so. *See e.g. SCM Corp. v. Royal McBee Corp.*, 395 F.2d 1018, 158 USPQ 36, 37 n.4 (CCPA 1968) ("Certain exhibits reflect the parties' *current* practice of associating their house marks 'SCM' and 'Royal' with 'ELECTRA' and 'ELECTRESS', respectively. However, our concern here, of course, is whether 'ELECTRA', the mark actually registered, and 'ELECTRESS', the mark for which registration is sought, are confusingly similar when applied to the instant goods."); *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958) ("The fact that each of the parties applies an additional name or trademark to its product is not sufficient to remove the likelihood of confusion. The right to register a trademark must be determined on the basis of what is set forth in the application rather than the manner in which the mark may be actually used.").

i.e. its puppy with beige ears, “green and black eyes and black nose” could very well believe that Applicant’s identical goods, sold under a mark featuring a similar puppy “with beige ears” and “black eyes, and black nose,” are offered by Opposer.

Degree of Purchaser Care

While Opposer has established that toilet paper is inexpensive, 32 TTABVUE 20, 53, it has not established that it is necessarily an “impulse” purchase. Given its nature and how often it is used, we assume that some consumers will exercise care in purchasing toilet paper, despite its low price. At the same time, we must base our finding on the least discriminating consumers who may purchase inexpensive toilet paper exercising only an ordinary degree of care. *See, e.g. Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-64 (Fed. Cir. 2014). This factor is neutral.

Actual Confusion

The lack of actual confusion is irrelevant. Applicant has only been using its mark since 2013, and has only used it in Puerto Rico. 32 TTABVUE 16, 33. Therefore, we cannot gauge whether or the extent to which there has been an opportunity for confusion to occur if it were likely to occur. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF’s use of the VITTORIO RICCI mark on the merchandise in question in prior years ....”); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, “it is unnecessary to show actual

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confusion in establishing likelihood of confusion.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). This factor is also neutral.

### **Conclusion**

The parties sell identical goods, in the same channels of trade, to the same classes of consumers, using similar puppy designs, and when considered in their entirety, the parties’ marks are more similar than dissimilar. Confusion is likely.

**Decision:** The opposition is sustained and registration of Applicant’s mark is refused.<sup>8</sup>

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<sup>8</sup> Because we sustain the opposition on likelihood of confusion grounds, we need not reach the false suggestion of a connection claim.