

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

Mailed:
September 2, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

MacNeil Automotive Products, Limited

v.

Theresa Harris

Cancellation No. 92051000
against Registration No. 3336602

Steven Behnken of Momkus McCluskey LLC for MacNeil
Automotive Products, Limited.

Theresa Harris, *pro se*.

Before Bucher, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

MacNeil Automotive Products, Limited (petitioner) has petitioned to cancel the registration owned by Theresa Harris (respondent) on the Principal Register for the mark **PrettyPlateFrames** (*in standard character format*) for goods identified in the registration as "license plate frames" in International Class 12,¹ based upon a claim of likelihood of confusion.

¹ Registration No. 3336602 issued on November 13, 2007.

The parties to this litigation:

Respondent's Registration No. 3336602 issued based upon Application Serial Number 78745344 that Ms. Theresa Harris filed for the mark **PrettyPlateFrames** on November 2, 2005.

MacNeil Automotive Products, Limited, markets automotive accessories such as cargo liners, bug deflectors, side window deflectors, floor liners, floor mats and license plate frames. Since December 2003, MacNeil has continuously offered for sale "frames for license plates" under the mark **PLATEFRAME**. On January 16, 2009, MacNeil/petitioner filed Application Serial No. 77650830 to register this mark on the Principal Register, but on March 29, 2009, the Office refused registration based upon a likelihood of confusion with respondent's registered mark.² MacNeil then filed this petition for cancellation on May 21, 2009.

Respondent's initial answer denied the salient allegations of the petition to cancel, and asserted that the term **PLATEFRAME** was merely descriptive for

² In addition to the refusal based upon likelihood of confusion, petitioner's suspended trademark application was also refused as being merely descriptive under Section 2(e)(1) of the Lanham Act.

petitioner's goods and had not acquired distinctiveness. Then on January 28, 2010, an earlier panel of this Board denied respondent's October 21, 2009 motion for summary judgment based upon her unpleaded defense of the genericness of petitioner's alleged mark. Nevertheless, respondent was granted leave to amend her answer to assert this affirmative defense, which she subsequently filed on February 17, 2010, pleading genericness as an affirmative defense.

The record:

Petitioner introduced its notice of reliance on August 31, 2010, submitting for the record copies of documentary evidence, namely, copies of official records, printed publications, Internet publications, and Respondent's Answers to Petitioner's Request to Admit #2 - numbered exhibits 41 - 60; then on September 30, 2010, petitioner submitted the trial depositions of its witnesses, namely, Brian Evans, petitioner's Director of E-Communications and Internet Marketing, Samuel A. Ezzo, Advertising, Marketing and Creative Director, and Allan R. Thom, Vice President, Operations, with the attached exhibits, numbered 1 - 40.

Respondent submitted no evidence in support of her case or as rebuttal to petitioner's case, and did not file a trial brief.

Standing

A real interest in the proceeding and a reasonable belief of damage may be found where petitioner pleads (and later proves) that petitioner has been refused registration of its mark because of respondent's registration. Having done so in this case, we find that petitioner has demonstrated its standing.

Priority

The issue of the inherent distinctiveness of petitioner's alleged mark has been raised by respondent's affirmative defenses.³ Hence, respondent's affirmative defenses put petitioner on notice of this issue during the pleading phase of this *inter partes* proceeding. In spite of the fact that respondent has failed to introduce any evidence into this record, we find under the rule of *Otto*

³ As noted above, the U.S. Patent and Trademark Office also raised this issue in the initial Office Action of now-suspended Application Serial No. 77650830 to register petitioner's mark on the Principal Register.

*Roth*⁴ that petitioner cannot prevail unless its designation is, or has become, distinctive of its goods prior to the earliest date that respondent can rely upon, namely, the application filing date for her involved registration. *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990).

Petitioner is claiming proprietary rights in the term **PLATEFRAME** for "frames for license plates."

PLATEFRAME is a combination of the words "Plate" and "Frame." "Plate" is defined, *inter alia*, as "license plate,"⁵ while "Frame" is defined, *inter alia*, as "a border or case for enclosing a picture, mirror, etc."⁶ Based upon these definitions of the two terms that form petitioner's alleged mark, we find that the combination conveys immediately significant information about petitioner's goods, whether called "frames for license plates," "license plate frames," "license plate holders," "license

⁴ *Otto Roth & Co. v. Universal Food Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

⁵ The Board may take judicial notice of dictionary definitions, and we take judicial notice of this definition of the word "plate." See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See <http://dictionary.reference.com/browse/plate>

⁶ See <http://dictionary.reference.com/browse/frame>

frames," etc. As such, the designation is, at best for petitioner, highly descriptive for these goods. Given the posture of this case, the issue of the capability of this combined term has not yet been fully pursued under the two step test of *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). However, at the very best for petitioner, we deem the combined term to be highly descriptive inasmuch as the goods are "license plate frames." While petitioner is not using the word "license" as part of its mark, in the context of the named goods, prospective consumers will immediately understand that the "plates" involved herein are "license plates," and getting a mental impression of the goods intended by the designation "plate frames" takes no imagination.

The degree of descriptiveness of an adopted term affects the quantum of evidence needed to show acquired distinctiveness, whether making a determination under the rule of *Otto Roth*,⁷ under Section 2(f) of the Act, or the degree of fame under *Yamaha Int. Corp. v. Hoshino Gakki*

⁷ *Otto Roth & Co. v. Universal Food Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).
See discussion of fame *infra*.

While petitioner submitted extensive evidence in order to support a finding of fame under the *du Pont* factor #5 analysis, we find this evidence probative in determining whether this highly-descriptive matter acquired distinctiveness in the two years between October 2003 and November 2005, prior to the filing date of respondent's underlying application, as needed under the rule of *Otto Roth*, to provide petitioner with priority.

The Court of Appeals for the Federal Circuit has taken the position that "[u]nder the reasoning of *Otto Roth*, the proper focus of section 2(d) is not on 'mark' or 'trade name' but on whether there is a likelihood of confusion as a result of *trade identity rights* that the opposer/petitioner has acquired." *Towers v. Advent*, 16 USPQ2d at 1042.

We turn then, to the evidence of record, to determine whether petitioner has acquired sufficient trade identity rights to establish priority herein. With each order it shipped since at least 2003, petitioner has distributed a copy of its automotive catalogue - each one prominently featuring the involved goods and the attendant term.

Petitioner highlights the involved designation by way of several glossy, fold-out brochures that it distributes to wholesalers and to retail customers. As a matter of regular business, petitioner issues press releases to automotive-related magazines, including ones featuring the alleged mark herein. Based upon its paid advertisements in automobile magazines and other printed media, petitioner claims a most impressive number of individual impressions of petitioner's involved term, including tens of millions during the relevant two-year period leading up to respondent's application filing date. Furthermore, tens of thousands of page views of the **PLATEFRAME** items are recorded automatically every year by petitioner's website, www.WeatherTech.com, according to Mr. Brian Evans, petitioner's Director of E-Communications and Internet Marketing. Petitioner has expended millions of dollars each year in publicizing its marks, although the exact numbers remain confidential. While we cannot be sure of the exact dollar amount of the promotional expenditures directed solely to the designation at issue during this critical two year period, it is beyond dispute that petitioner made significant efforts to create a clear

association between the alleged mark and the listed goods by way of its many magazine advertisements.

Based upon this evidence showing ad copy prominently displaying the **PLATEFRAME** mark and goods, and specifically the extensive magazine advertisements between October 2003 and November 2005, we find that petitioner's mark had acquired sufficient trade identity rights prior to the application filing date for respondent's involved registration, and hence, petitioner has shown its priority.

Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc.*

v. *Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Goods

There is no question but that petitioner and respondent are marketing substantially identical goods that are certainly legally identical, and this factor weighs heavily in favor of petitioner.

Channels of Trade and Conditions of Sale

We must presume that these modestly-priced, legally-identical goods will move in all the same channels of trade to the same classes of ordinary consumers. In fact, the evidence of record shows that both parties actually sell their goods through their respective Internet websites. These related *du Pont* factors also weigh in favor of petitioner.

Fame of the Prior Mark

We found above that petitioner's mark had acquired *trade identity rights* prior to respondent's trademark application filing date. However, the showing needed to establish trade identity rights is not as high as needed to establish that a mark is *famous*.

As we discussed in the context of petitioner's priority, petitioner's **PLATEFRAME** mark is highly suggestive, and contains two elements that individually are highly descriptive or perhaps even generic. In fact, petitioner has identified its goods as "frames for license plates." Although petitioner has established priority of its highly descriptive mark on the basis of acquired distinctiveness, the evidence it provided which established acquired distinctiveness does not necessarily establish that the mark is famous. Indeed, fame "plays a 'dominant' role in the process of balancing the *du Pont* factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "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." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

Thus, considering fame, we note that there is no direct evidence showing that consumers view **PLATEFRAME**

as a distinctive source indicator for petitioner's listed goods. Petitioner has not submitted the type of evidence indicating that third parties perceive the term "PlateFrame" as identifying petitioner's license plates frames, e.g., declarations from consumers, surveys, etc.

Rather, the record contains circumstantial evidence of acquired distinctiveness. This includes evidence from which consumer association might be inferred, such as years of use, extensive amounts of sales and advertising, and any similar evidence showing wide exposure of the alleged mark to consumers. Clearly, there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; however, the evidence required is in proportion to the degree of non-distinctiveness of the mark at issue. *Yamaha Int. Corp.* 6 USPQ2d at 1008. Accordingly, petitioner has a heavy burden in this context given the highly-descriptive nature of this designation.

Petitioner has alleged more than 700 million impressions of this involved mark growing out of its magazine advertisements and other marketing over the years. Indeed, the record shows that petitioner has spent significant amounts of money on promoting its various product marks and its house marks over the years.

This extensive record contains hundreds of copies of magazine advertisements and web pages.

These images of PlateFrame advertisement copy reflect years of consistent impressions making up petitioner's marketing campaigns.



On the other hand, like the evidence of petitioner's total marketing expenditures, we find that the total number of consumer impressions of petitioner's large ads is not necessarily reflective of impressions of the mark **PLATEFRAME** alone. Rather, the ads collect together all of petitioner's marks, including but not limited to house marks such as **WeatherTech**¹⁰ and **MacNeil Automotive Products Limited**,¹¹

⁸ Petitioner's Exhibit 28-7, web page printed January 15, 2009; TTABVUE Entry #20, p. 21 of 246. In the event that the involved term's location on the spectrum of distinctiveness should ever be litigated more fully, ad copy like "PlateFrame is exactly that!" will not favor petitioner's position.

⁹ This photograph is one of four product images (always used right next to the involved mark) included in substantially all of petitioner's hundreds of advertisements made part of the record. Petitioner's Exhibits 15 - 19.

¹⁰ See Registration Nos. 1664203, 1891121, 2576007, 3126354, 3534011, 3917056 and 3940301.

¹¹ See Registration Nos. 1654099, 2734277, 3035695 and 3777867.

as well as registered product marks such as **RackSack**,¹² **DigitalFit**,¹³ **ClearCover**,¹⁴ **LampGard**,¹⁵ **Click and Stay**,¹⁶ **EasyOn**,¹⁷ and **TechShade**,¹⁸ and other designations on which petitioner has placed informal trademark notifications, such as **ClearFrame**[™], **FloorLiner**[™], etc.

In addition to the fact that many of these terms, like petitioner's **PlateFrame** designation, appear to be merely descriptive of a feature of the underlying products, the record does not provide a breakdown of the specific portion of the millions of dollars petitioner allegedly expended annually in promoting its marks that was directed specifically to the involved term. Hence, while we find that petitioner's cumulative evidence of the tens, if not hundreds, of millions of impressions of the alleged mark may be satisfactory to establish a sufficient level of distinctiveness for purposes of establishing

¹² See Registration No. 2709618.

¹³ See Registration No. 3489456.

¹⁴ See Registration No. 2830984.

¹⁵ See Registration No. 3780119.

¹⁶ See Registration No. 2777726.

¹⁷ See Registration No. 2145433.

¹⁸ See Registration Nos. 3901711 and 3955474.

priority of a distinctive source indicator, we find that this record does not establish that, by virtue of petitioner's use and advertising of its **PLATEFRAME** mark for its license plates frames, petitioner's claimed mark has become a strong mark.¹⁹ Consequently, in the context of our likelihood of confusion analysis, we must treat petitioner's mark as an inherently weak mark that is not entitled to a broad scope of protection. See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 296 (CCPA 1958). Given the highly descriptive nature of this designation, petitioner's proof of fame falls far short of establishing the degree of renown required to have *du Pont* factor #5 - the fame of petitioner's prior mark - weigh in petitioner's favor. Hence, this is a neutral factor.

The Marks

As to the first *du Pont* factor, we compare the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and

¹⁹ Furthermore, while we have concluded on this record, where no evidence has been submitted contesting petitioner's assertion that its mark has acquired distinctiveness and is famous, it does not follow that the same conclusion regarding the issue of acquired distinctiveness would be reached on a different record created during an *ex parte* examination of this question under Section 2(f) of the Act.

commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Because the similarity or dissimilarity of the marks is determined based upon a comparison of the marks in their entireties, the decision must be based upon the entire marks, not just select parts of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ["It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"]. On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

When comparing respondent's **PrettyPlateFrames** with petitioner's **PLATEFRAME**, both the similarities and the dissimilarities are fairly obvious. Respondent has modified petitioner's "PlateFrame" with the word "Pretty," and made the entire designation plural. The difference in sound is clear - a two-syllable designation has become a four-syllable term. "Pretty" is the first portion of respondent's adopted mark, and changes somewhat the overall appearance of the respective marks. These differences become less significant, however, when the focus turns to connotation. The thrust of petitioner's marketing approach is the attractive appearance and indestructibility of its license plate frames, making it, according to petitioner's tagline, "the ultimate license plate frame." We established above, based upon this record, that petitioner's **PLATEFRAME** designation has attained minimal source indicating significance when used in connection with these goods. Respondent's



claimed niche is that of "decorative license plate frames designed for women." In this context, persons who are familiar with petitioner's product and mark, upon seeing respondent's mark on similar goods, with the mere addition

of the word "Pretty," will likely assume this mark represents a brand extension for petitioner. Accordingly, we find the marks are highly similar as to their overall commercial impressions, and this factor favors petitioner.

The number and nature of similar marks in use on similar goods

Petitioner has shown from third-party advertisements and websites that its third-party competitors in this field generally use the term "license plate frames" as the generic designation for their competing products.²⁰ We certainly have no evidence that anyone other than respondent has adopted the telescoped term "PlateFrames" in connection with similar goods. While petitioner's mark may be inherently weak when used in connection with these named goods, it is not because the record demonstrates that any third-party competitors are using the designation "PlateFrames."

Conclusion:

In addition to demonstrating its priority, petitioner has shown that respondent sells legally identical goods

²⁰ See e.g., <http://www.pl8mate.com/>; License Plate Frame-Barbed Wire [SKU 46144-8] <http://www.bellautomotive.net/> and Pilot Automotive [WL-713-C] Clear Crystals Chrome Car License Plate Frame.

through the same channels of trade to the same classes of ordinary purchasers. While we acknowledge that petitioner's mark is a weak one, even weak marks are entitled to a narrow scope of protection. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) [even a weak mark is entitled to protection against the registration of a similar mark for closely-related goods or services]. In this case, we find that respondent's mark falls within this narrow ambit of protection to be accorded to the prior usage of petitioner's claimed mark.

Decision: The petition to cancel Registration No. 3336602 is hereby granted on the ground of likelihood of confusion. The registration will be cancelled in due course.