

This Opinion is not a  
Precedent of the TTAB

Mailed: August 6, 2018

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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*Principle Business Enterprises, Inc.*

*v.*

*DML Marketing Group, Ltd.*

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Cancellation No. 92061653

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David C. Purdue of Purdue Law Offices LLC,  
for Principle Business Enterprises, Inc.

Neill A. Levy, Esq.,  
for DML Marketing Group, Ltd.

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Before Ritchie, Greenbaum and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Principle Business Enterprises, Inc. (“Petitioner”) has petitioned to cancel Registration No. 4296056 for the mark PILLOW PODS, in standard characters, owned by DML Marketing Group, Ltd. (“Respondent”).<sup>1</sup> The registration issued February 26, 2013 on the Principal Register for “socks” in International Class 25.

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<sup>1</sup> Application Serial No. 85208146, which matured into the registration at issue, was filed on December 30, 2010, with a later-filed Statement of Use claiming dates of first use of November 8, 2011 and first use in commerce of June 4, 2012.

Petitioner alleges priority and likelihood of confusion with its prior registered mark PILLOW-PAWS, in typed drawing form<sup>2</sup> for “polyurethane foam lounging and recreational slippers” in International Class 25,<sup>3</sup> and PILLOW PAWS, in standard characters, for “slipper socks; slippers; socks” also in International Class 25.<sup>4</sup>

Respondent denied the salient allegations of the petition. Respondent also, via its Second Amended Answer and Counterclaim, which is the operative pleading herein, filed a counterclaim. The counterclaim is filed in the alternative, “if it is held that registrant’s mark is confusingly similar to petitioner’s marks,”<sup>5</sup> in which case Respondent seeks restriction of both of Petitioner’s pleaded registrations as well as of Respondent’s registration under Section 18 of the Trademark Act, 15 U.S.C. § 1058, as follows:

1. Petitioner’s Registration No. 819533 (which Respondent refers to as the “1966 Pillow-Paws Registration”) for PILLOW-PAWS, to be amended to “nonslip polyurethane foam lounging and recreational slippers;”
2. Petitioner’s Registration No. 4695272 (which Respondent refers to as the “2015 Pillow Paws Registration”) for PILLOW PAWS, to be amended to “nonslip slipper socks, nonslip slippers, nonslip socks, and newborn baby booties with or without a nonslip tread;” and
3. Respondent’s Registration No. 4296056, for PILLOW PODS, to be amended to “socks excluding newborn baby booties and nonslip socks.”

Respondent asserts that these restrictions would both conform to the actual use by the parties and would avoid a likelihood of confusion.<sup>6</sup>

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<sup>2</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” or “typset” drawings. See TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 807.03(i) (October 2017).

<sup>3</sup> Registration No. 819533, registered on November 29, 1966. Renewed three times.

<sup>4</sup> Registration No. 4695272, registered on March 3, 2015.

<sup>5</sup> 12 TTABVUE 14.

<sup>6</sup> 12 TTABVUE 15-17.

In its Answer to the Counterclaim, Petitioner denied the salient allegations of the counterclaim.

The case is fully briefed.

### I. The Record and Stipulations

The record consists of the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 21.22(b), the file of Respondent's involved registration. In addition, the parties submitted a Stipulation of Facts<sup>7</sup> and Stipulation Regarding Exhibits,<sup>8</sup> which includes facts and exhibits that the parties agreed to enter into the record.<sup>9</sup>

Petitioner further submitted a notice of reliance and an amended notice of reliance, which include Respondent's responses to Petitioner's discovery requests.

Respondent submitted a first and second notice of reliance, which include dictionary definitions of the terms "paw," "pod," and "pillow;"<sup>10</sup> Petitioner's responses to Respondent's discovery requests; and USPTO electronic database and Internet printouts showing third-party registrations and uses of the terms "pillow" and "paw" to show suggestiveness of the terms in Petitioner's pleaded registrations.

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<sup>7</sup> 16 TTABVUE.

<sup>8</sup> 28 TTABVUE. The parties have stipulated that the documents submitted with their Stipulation Regarding Exhibits are admissible evidence without further proof of their authenticity. Additionally, the parties have stipulated that documentary evidence procured through discovery, including photographs of physical exhibits, as well as responses to discovery, are deemed admissible in this case. *See* 27 TTABVUE.

<sup>9</sup> In the conference order dated January 11, 2017, the Board Interlocutory Attorney assigned to the case noted that the parties did "discuss Accelerated Case Resolution ("ACR")." 23 TTABVUE 1. Although the parties did not formally adopt ACR, their stipulations do add to the efficiencies of the proceeding.

<sup>10</sup> The definitions of "pillow" and "pod" were not legible as submitted on the dictionary pages. 33 TTABVUE 68-70. Nevertheless, as discussed *infra*, we take judicial notice of the relevant definitions.

Respondent also submitted the testimony declaration of its President and Chief Executive Officer, Mark Hierbaum, dated August 18, 2017.<sup>11</sup>

## II. Background Findings

Plaintiff has used the mark PILLOW PAWS on polyurethane foam lounging and recreational slippers since 1966, and on slippers, slipper socks and socks since 1984.<sup>12</sup> This includes the PILLOW-PAWS mark, which Plaintiff uses interchangeably with PILLOW PAWS.<sup>13</sup> Plaintiff introduced PILLOW PAWS Cuddle Paws Style 1090 newborn baby booties without tread in 2000, and Style 1080 newborn booties with tread in 2001.<sup>14</sup>

All PILLOW PAWS slipper socks, slippers, socks, and polyurethane foam lounging and recreational slippers have a nonslip tread on the heel and sole, with the exception of certain baby booties.<sup>15</sup> In particular, Cuddle Paws newborn baby booties Styles 1090, 1091, and 1092 do not have a nonslip tread.<sup>16</sup>

Respondent has used its PILLOW PODS mark on socks since 2011.<sup>17</sup> Respondent sells socks and hosiery under other marks as well, including PILLOW SOLE, PLUSH FEET, and pursuant to a license, LAURA ASHLEY.<sup>18</sup> Respondent sells a line of socks marketed as Gripper socks with a nonslip tread.<sup>19</sup> In prior years these were co-

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<sup>11</sup> 34 TTABVUE.

<sup>12</sup> 26 TTABVUE 2.

<sup>13</sup> *Id.* at 3.

<sup>14</sup> *Id.*

<sup>15</sup> *Id.* at 4.

<sup>16</sup> *Id.*

<sup>17</sup> *Id.* at 2.

<sup>18</sup> 34 TTABVUE 5.

<sup>19</sup> *Id.*

branded with the PILLOW PODS mark.<sup>20</sup> However, Mr. Hierbaum has testified that Respondent “has made a decision to discontinue use of its PILLOW PODS trademark on its Gripper socks with a nonslip tread.”<sup>21</sup> He also testified that there are currently no purchase orders pending and Respondent will no longer accept any.<sup>22</sup> Thus, Respondent “will continue to market and sell the Gripper socks with a nonslip tread but not with the PILLOW PODS mark. The Gripper socks will henceforth be marked with one or more of [Respondent’s] other registered marks.”<sup>23</sup>

### III. Standing and Priority

Standing is a threshold issue that must be proven in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing . . . must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”). To establish standing in a cancellation proceeding, a petitioner must show both “a real interest in the proceedings as well as a ‘reasonable’ basis for his belief of damage.” *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The parties’ stipulation of facts clearly establishes that Petitioner has used its PILLOW PAWS mark in association with polyurethane foam

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<sup>20</sup> *Id.*

<sup>21</sup> *Id.* at 6.

<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

lounging and recreational slippers since 1966, and in connection with slippers, slipper socks and socks since 1984.<sup>24</sup>

We find these stipulated facts sufficient to demonstrate that Petitioner is not a mere intermeddler but has a direct and personal stake in this proceeding, as a competitor of Respondent, and therefore has a reasonable basis for its belief of damage stemming from the maintenance of a registration of a purportedly confusingly similar mark for similar goods.<sup>25</sup>

Petitioner's priority was stipulated by the parties. Thus, priority is not at issue for Petitioner in this proceeding. Respondent, conversely, has standing to assert its counterclaim by virtue of being the defendant in the cancellation proceeding. *See* Trademark Act Section 14, 15 U.S.C. § 1064; *see also* *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Anthony's Pizza & Pasta Intl. Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1274 (TTAB 2009) ("Defendant has standing to cancel plaintiff's pleaded registration by virtue of being the defendant in the consolidated proceeding, and the fact that plaintiff has asserted its registration against defendant.").

#### IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) ("*du Pont*") *cited*

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<sup>24</sup> 26 TTABVUE 2.

<sup>25</sup> We further note that Respondent does not contest Petitioner's standing in this case.

*in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

For purposes of our likelihood of confusion analysis, we focus on the most relevant pleaded registration, Registration No. 4695272 (PILLOW PAWS). That is, if we find a likelihood of confusion as to this pleaded registration, we need not find it as to the other. On the other hand, if we do not find likelihood of confusion with the mark in this registration, we would not find it as to the other pleaded registration. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Goods, Channels of Trade and Classes of Consumers

Respondent's goods are identified as "socks." The identification of goods in Petitioner's pleaded Registration No. 4695272 (PILLOW PAWS) includes "socks." Accordingly, the goods are identical in part. It is sufficient for a finding of likelihood of confusion that relatedness is established for any one of the goods included in the identification. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Thus, the second *du Pont* factor strongly favors a finding of likelihood of confusion.

When the respective identifications of goods are identical or legally identical and without restrictions as to channels of trade or classes of purchasers, as is the case here, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers.<sup>26</sup> *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62

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<sup>26</sup> Respondent notes that it originally sought to restrict Petitioner's channels of trade, but later amended its counterclaim to omit such restrictions. 12 TTABVUE 9. We thus do not consider Respondent's arguments regarding the parties' typical channels of trade.



USPQ2d 1001, 1005 (Fed. Cir. 2002) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983) (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”)). Thus, we presume the trade channels and classes of purchasers are the same for both Petitioner’s and Respondent’s identical socks.

Accordingly, the third *du Pont* factor also heavily favors a finding a likelihood of confusion.

#### B. Nature and Extent of Similar Marks on Similar Goods

The sixth *du Pont* factor examines the number and nature of any similar marks in use on similar goods or services to determine the scope of protection to which the plaintiff’s mark is entitled. *du Pont*, 177 USPQ at 567. Respondent contends that Petitioner’s PILLOW PAWS mark is entitled to a narrow scope of protection because the term PILLOW is suggestive of Petitioner’s goods. In support of its argument, Respondent relies upon the dictionary definition of the term PILLOW, as well as third-party registrations and associated evidence of use for these registered marks that include the term PILLOW for purportedly similar goods.<sup>27</sup>

The “existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nonetheless, in determining the degree of weakness, if any, in the shared term PILLOW, “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the

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<sup>27</sup> Respondent’s Brief, pp. 24-29, 37 TTABVUE 25-30.

specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Regarding the probative value of third-party registrations for similar marks on similar goods, we also note the following:

Third-party registrations may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to both parties’ marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is inherently relatively weak. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]hird-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.”). Evidence of use of similar marks by third parties for similar or related goods or services, in turn, is relevant to a mark’s commercial strength. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

*Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1346 (TTAB 2017); *see also In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018).

Since Petitioner’s pleaded registration identifies types of footwear or hosiery, we do not find probative in our analysis regarding the strength or weakness of Petitioner’s pleaded mark the third-party registrations and websites submitted by Respondent that do not identify footwear or hosiery. *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) (“Registrations for goods unrelated to the clothing field are irrelevant to our discussion”). Respondent, however, submitted the following

registrations, with associated websites showing use, for marks including the term “PILLOW” for various types of footwear, footwear accessories and hosiery items:<sup>28</sup>

- PILLOWWALKERS (Registration No. 4650451) for shoe inserts;
- PILLOWS FOR YOUR FEET (Registration No. 4485482) for, inter alia, shoe inserts;



- (Registration No. 3993885) for, inter alia, insoles for footwear;
- PILLOW TALK (Registration No. 4709605) for, inter alia, “socks”;
- PILLOW PETS (Registration No. 4139534; PILLOW disclaimed) for, inter alia, slippers;
- THE PILLOW BOOT BY COUGAR (Registration No. 4132979) for footwear;
- PILLOW TOP (Registration No. 3399393) for footwear;
- FEEL MY PILLOWS (Registration No. 4788590) for, inter alia, footwear;
- PILLOWS FOR POINTES and design (Registration No. 1821434, “FOR POINTES” disclaimed) for footwear;
- AIR-PILLO (Registration No. 1415103) for shoe insoles;
- PILLOW SOLE (Registration No. 3554809, “SOLE” disclaimed) for socks;<sup>29</sup> and
- PILLOW PUTZZ (Registration No. 4580629, “PILLOW” disclaimed) for slippers.

With regard to the third-party registrations and associated website uses, we find that this evidence falls short of the “voluminous” and “extensive” evidence presented in *Jack Wolfskin*, 116 USPQ2d at 1136; or of that in *Juice Generation*, 115 USPQ2d at 1673 n.1 (at least twenty-six relevant third-party uses or registrations of record). Consequently, we accord this evidence minimal weight. In addition, the marks in the

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<sup>28</sup> 33 TTABVUE 77-198. Respondent also submitted 14 examples of the term “PILLOW” used by third-parties for marks used in association with clothing (not footwear or hosiery), hair care, or cosmetics. However, as noted, we do not find these examples probative to our analysis.

<sup>29</sup> This registration is owned by Respondent, who did not submit evidence of use.

third-party registrations contain additional words or design elements that distinguish them from Petitioner's PILLOW PAWS mark, undercutting their probative value. Additionally, we find that none of the third-party marks of record is as similar to Petitioner's PILLOW PAWS as is Respondent's mark PILLOW PODS.

Notwithstanding the foregoing, we find that Petitioner's PILLOW PAWS mark is suggestive of Petitioner's goods in that the dictionary definition of PILLOW, *see infra*, suggests to consumers that Petitioner's goods are soft and comfortable footwear and hosiery. As a result, Petitioner's PILLOW PAWS mark is not as conceptually strong as a term that is entirely arbitrary.

Although we have found that Petitioner's PILLOW PAWS mark is suggestive of its goods, we nevertheless find that the nature and extent of similar marks on similar goods, i.e., the sixth *du Pont* factor, to be neutral for the reasons explained above.

### C. Comparison of the Marks

We next consider the similarity or dissimilarity of the parties' marks, in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. *Palm Bay Imps.*, 73 USPQ2d at 1692.

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, 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 Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Moreover, and of particular relevance here, when the goods are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

Petitioner's mark is PILLOW PAWS. Respondent's mark is PILLOW PODS. We consider the following definitions, set forth in relevant part:<sup>30</sup>

Pillow: 1.a. a support for the head of a reclining person; *especially*: one consisting of a cloth bag filled with feathers, down, sponge rubber, or plastic fiber; b. something resembling a pillow especially in form.

Paw: 1. The foot of a quadruped (such as a lion or dog) that has claws; *broadly* the foot of an animal; 2. A human hand especially when large or clumsy.

Pod: 2a. an anatomical pouch; 4. A usually protective container or housing.

-Pod: foot: part resembling a foot; pleopod.

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<sup>30</sup> Merriam-Webster.com. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Taking into account these relevant definitions, the commercial impression of PILLOW PODS is very similar to PILLOW PAWS in that a “pillow pod” is likely to be perceived by consumers with regard to Respondent’s identified socks as either a cushioned pouch, or a cushioned place to put one’s foot, very much the same as “pillow paws” is likely to be perceived with regard to Petitioner’s identified socks and slippers as a cushioned place for one’s foot. Thus we find that the commercial impressions of the marks are very similar. The marks are also similar in sight and in sound, as both PILLOW PAWS and PILLOW PODS start with the word PILLOW and have an alliterative flow, followed by a single, monosyllabic word. It is often noted that it is the first part of a mark that is “most likely to be impressed upon the mind of a purchaser and remembered.” See *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), and *Palm Bay Imps.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label).

When considered as a whole, the marks are very similar in sight, sound, and commercial impression, and this *du Pont* factor favors finding a likelihood of confusion.

#### D. Actual Confusion

Finally, Respondent asks us to consider the lack of actual confusion. The parties stipulated that neither was “aware of any instances of actual confusion.”<sup>31</sup> While actual confusion, where it exists, may be very powerful evidence, the lack of evidence

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<sup>31</sup> 26 TTABVUE 4.

of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). This is especially true where, as here, the record is unclear as to the amount of meaningful opportunities for confusion to have occurred. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1202 (TTAB 2007).

Accordingly, we find this *du Pont* factor to be neutral.

#### E. Summary

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that (1) Petitioner has demonstrated priority of use of its PILLOW PAWS mark; (2) Petitioner's PILLOW PAWS mark is substantially similar in sight, sound and commercial impression to Respondent's PILLOW PODS mark; (3) the parties' goods are identical and therefore are presumed to travel in the same trade channels and offered to the same classes of purchasers; and (4) although the term PILLOW in Petitioner's mark has been shown to be suggestive of Petitioner's goods based on the dictionary definition of such term, this evidence does not demonstrate meaningful weakness of Petitioner's mark to overcome the substantial similarities between the parties' marks used in connection with identical goods, and the evidence of third-party use is also not sufficient to show weakness of Petitioner's mark in this context.

Overall, we find that Petitioner has demonstrated, by a preponderance of the evidence, its claim of priority and likelihood of confusion.

## V. Respondent's Section 18 Counterclaim

Respondent filed, via counterclaim, in the alternative, a proposed amendment to both of the pleaded registrations and to its registration pursuant to Section 18 of the Trademark Act, in the event that the Board deems such amendments necessary to avoid a likelihood of confusion. 15 U.S.C. § 1068. Section 18 of the Lanham Act is “in the nature of an equitable remedy,” and may be invoked in a situation where, as here alleged by Respondent, a restriction would appropriately “avoid a likelihood of confusion” and be limited to use as shown. *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n. 3 (TTAB 1995). With this in mind, we address, as requested, Respondent's request for Section 18 in the alternative. That is, we have considered the original, unamended identifications of goods in our likelihood of confusion analysis. *See Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825 (TTAB 2013). Having found a likelihood of confusion, we consider whether Respondent has proven its counterclaim under Section 18 with the proposed amended identifications. *Id.* at 1838. Since our likelihood of confusion analysis was limited to Petitioner's Registration No. 4695272, we also similarly limit our Section 18 analysis to this pleaded registration.

Under the proposed restrictions, Respondent's registration (Registration No. 4296056, for PILLOW PODS) would be amended to “socks excluding newborn baby booties and nonslip socks.” Petitioner's Registration No. 4695272 (PILLOW PAWS) would be amended to “nonslip slipper socks, nonslip slippers, nonslip socks, and newborn baby booties with or without a nonslip tread.”



We take judicial notice of the following dictionary definitions from Merriam-Webster.com:

Sock: 1. *Archaic*: a low shoe or slipper; 2. *Also plural* sox; a knitted or woven covering for the foot usually worn under shoes and extending above the ankle and sometimes to the knee.

Slipper: a light low-cut shoe that is easily slipped on the foot.

Bootie: a usually ankle-length boot, slipper, or sock, *especially*: an infant's knitted or crocheted sock.

It is clear from these definitions that even with the proposed amendments, there is overlap between the identifications. In particular, the infant baby booties that Respondent seeks to include in Petitioner's Registration No. 4695272 (PILLOW PAWS), are defined as a type of "sock." We note that the parties also referred in their Stipulation Regarding Exhibits to Petitioner's booties in Exhibit BE as being "socks."<sup>32</sup> Furthermore, as discussed in our Background Findings, Respondent has admitted to selling nonslip socks under the same marks as its other socks, including previously under the PILLOW PODS mark, indicating that consumers would expect these goods to derive from a single source.<sup>33</sup>

Accordingly, we find that the proposed amendments would not avoid a likelihood of confusion, as is required for the amendments sought by Respondent under Section 18 of the Trademark Act. *Eurostar*, 34 USPQ2d at 1271, n.3; *Embarcadero*, 105 USPQ2d at 1838. In view of our finding that the restrictions proposed by Respondent

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<sup>32</sup> 28 TTABVUE 8, 142.

<sup>33</sup> 34 TTABVUE 5.

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are not sufficient to avoid a likelihood of confusion, we dismiss Respondent's Section 18 counterclaim.

***Decision:*** The petition for cancellation is granted. The counterclaim based on Section 18 of the Trademark Act is dismissed. Registration No. 4296056 will be cancelled in due course.