

**This Opinion is Not a  
Precedent of the TTAB**

Hearing: October 18, 2022

Mailed: May 11, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Comptime, Inc.*

*v.*

*E. Frances Paper, Inc.*  
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Cancellation No. 92073884  
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Michael Wiener of Michael Wiener Law  
for Comptime, Inc.<sup>1</sup>

Mark L. Seigel of The Seigel Law Firm LLC  
for E. Frances Paper, Inc.  
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Before Cataldo, Greenbaum and Allard,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

E. Frances Paper, Inc. (“Respondent”) is the owner of record of a registration on the Supplemental Register for the mark LITTLE NOTES (in standard characters, “NOTES” disclaimed), identifying the following goods:

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<sup>1</sup> A note to the file in Petitioner’s pleaded application indicates that Petitioner’s counsel died earlier this year. Accordingly, a copy of this decision will be sent directly to Petitioner at its address of record.

Address books; Calendars; Desktop business card holders; Gift bags; Greeting cards; Greetings cards and postcards; Guest books; Note books; Note cards; Notepad holders; Notepads; Pen holders; Pen and pencil cases and boxes; Pencils; Pens; Personal organizers; Photo albums; Stationery; Stationery boxes; Stationery cases; Wrapping paper; Writing paper; Blank note cards; Cards bearing universal greetings; Daily planners; Gift boxes containing note cards; Holders for desk accessories; Office stationery; Paper stationery; Paper boxes for storing greeting cards; Paper gift cards; Postcards and greeting cards; Social note cards; Stationery writing paper and envelopes, in International Class 16.<sup>2</sup>

In its petition for cancellation,<sup>3</sup> Comptime, Inc. (“Petitioner”) seeks cancellation of Respondent’s registration on the ground that Respondent’s mark, as applied to the goods identified in the registration, so resembles Petitioner’s earlier-used and applied-for LITTLE NOTES mark, identifying “announcement cards; greeting cards; note cards; postcards and greeting cards; printed invitations,” in International Class 16<sup>4</sup> as to be likely to cause confusion, mistake, or to deceive, in derogation of Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>5</sup>

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<sup>2</sup> Registration No. 5893398 issued on October 22, 2019, from application Serial No. 88121556, filed on September 18, 2018, asserting April 16, 2014 as a date of first use of the mark in commerce.

<sup>3</sup> 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

<sup>4</sup> Application Serial No. 88511653 was filed on July 12, 2019, seeking registration on the Supplemental Register under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), asserting October 29, 2013 as a date of first use of the mark in commerce. Petitioner amended its application to seek registration on the Principal Register on December 12, 2019.

<sup>5</sup> Petitioner appended exhibits to the petition to cancel. 1 TTABVUE 9-41. Except in limited circumstances, which are not present here, an exhibit to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c); and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §317 (2022) and authorities cited therein. Accordingly, these exhibits are not part of the record and will not be considered.

Applicant denied the salient allegations of the petition for cancellation in its answer, and also asserted but did not pursue a number of “affirmative defenses.”<sup>6</sup> Accordingly, we deem Respondent to have waived all of its asserted defenses. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014); *Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

The parties submitted evidence and trial briefs, and presented arguments in an oral hearing before this tribunal.

Having considered the evidentiary record, the arguments and applicable authorities, as explained below, we find that Petitioner has failed to carry its burden, and deny the petition.

## **I. The Evidentiary Record**

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. §2.122(b), the file of Respondent’s involved registration. In addition, the parties introduced the following evidence:

- Petitioner’s Notice of Reliance on screenshots from Petitioner’s webpage; a status and title copy and Trademark Status & Document Retrieval (“TSDR”) printout of Respondent’s involved registration;<sup>7</sup> and Respondent’s objections and responses to Petitioner’s first set of interrogatories. (34-35 TTABVUE.)
- Testimony Declaration of Petitioner’s President and Co-founder David Santulli (33 TTABVUE).

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<sup>6</sup> Amended Answer, 10 TTABVUE. The remainder of Applicant’s “affirmative defenses” are more in the nature of amplifications of its denials, and are so construed.

<sup>7</sup> By operation of Trademark Rule 2.122(b), the file of Respondent’s challenged registration is automatically of record, and Petitioner’s submission was redundant and unnecessary.

- Rebuttal Declaration of David Santulli with exhibits consisting of website advertising printouts, and website articles concerning online marketing. (44-46 TTABVUE.)
- Respondent's Notice of Reliance on portions of the discovery deposition of David Santulli; Petitioner's responses to certain of Respondent's interrogatories; and screenshots featuring Respondent's goods under its involved mark and articles discussing consumer exposure thereto. (38 TTABVUE.)
- Testimony Declaration of Respondent's Chief Executive Officer and Co-founder Jenni Laundon with exhibits consisting of Respondent's marketing materials and third-party declarations with exhibits supporting Respondent's use of its involved mark. (39 TTABVUE.)
- Respondent's Cross-Examination of Mr. Santulli. (55 TTABVUE.)

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

Entitlement to a statutory cause of action is a threshold issue that must be proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action under Trademark Act Section 14, 15 U.S.C. § 1064, a plaintiff must demonstrate “an interest falling within the zone of interests protected by the statute and ... proximate causation.” *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020), *cert. denied*, \_\_\_ U.S. \_\_\_ (2021), (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)). Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020); *see also Empresa Cubana*, 111 USPQ2d at 1062.

According to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), there is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at \*4. Thus, “a party that demonstrates a real interest in cancelling a trademark under [Trademark Act Section 14, 15 U.S.C.] §1064 has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] .... Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of §1064.” *Corcamore*, 2020 USPQ2d 11277 at \*7.

“A petitioner may demonstrate a real interest and reasonable belief of damage where the petitioner has filed a trademark application that is refused registration based on a likelihood of confusion with the mark subject to cancellation.” *Australian Therapeutic*, 2020 USPQ2d 10837, at \*4. In its petition for cancellation, Petitioner asserts that its pleaded application Serial No. 88511653 was refused registration on the basis of Respondent’s challenged registration, and that Respondent sent cease and desist letters to Petitioner.<sup>8</sup> Petitioner appended copies of its pleaded application and cease and desist letters to its petition to cancel.<sup>9</sup> However, as noted above, these exhibits do not form part of the record at trial. Trademark Rule 2,122(c), 37 C.F.R. §2.122(c); *Cf. Empresa Cubana*, 111 USPQ2d at 1062; *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018). Thus, they

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<sup>8</sup> 1 TTABVUE 4, 6, 8.

<sup>9</sup> 1 TTABVUE 10-35.

do not form the basis for Petitioner's claim of entitlement to a statutory cause of action.

Petitioner further asserts that it has made prior use of LITTLE NOTES as a mark, which is identical to the mark in the challenged registration and identifies goods that are identical in part. (1 TTABVUE.) Petitioner has demonstrated that it uses LITTLE NOTES in the manner of a common law trademark in connection with various cards and paper products.<sup>10</sup> (13 TTABVUE 4-12.) We find that Petitioner has established its entitlement to bring and maintain this proceeding on the ground of likelihood of confusion, based on Petitioner's status as a competitor of Respondent. *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (finding competitor has standing, now known as entitlement to a statutory cause of action, because it has an interest in the outcome beyond that of the general public); *NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at \*10 (TTAB 2021) ("Petitioner has established ... that it ... is a competitor of Respondent... [and] uses a mark with the same wording and design as the mark [in Respondent's] ... registration," therefore showing its entitlement to seek cancellation of Respondent's mark).

### III. Likelihood of Confusion

Trademark Act Section 2(d), 15 U.S.C. §1052(d), prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously

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<sup>10</sup> As discussed below, use of a nondistinctive term as a trademark does not necessarily mean that the term has acquired secondary meaning as a trademark. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981).

used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Our analysis is based on all of the probative evidence of record. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (noting the elements, or factors, to be considered). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect trademark owners from damage caused by registration of confusingly similar marks. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See 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.”).

In this case, there is little dispute that the parties are using the identical term, LITTLE NOTES, as a mark to identify goods that are in part identical, namely, note cards and greeting cards. *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1301-02 (TTAB 2015) (“With regard to the Section 2(d) claim, when the parties are claiming rights in the same mark for the same goods or services, likelihood of confusion is inevitable.”).

We turn then to the central issue in this proceeding, priority of use.

#### **IV. Priority**

“A party claiming prior use of a [mark similar to a] registered mark may petition to cancel the registration on the basis of such prior use pursuant to section 14 of the Lanham Act. 15 U.S.C. Section 1064.” *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994).

“To establish priority, the petitioner must show proprietary rights in the mark that produce a likelihood of confusion.... These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) [internal citation omitted]; *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). In determining prior use, “one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.” *West Fla. Seafood*, 31 USPQ2d at 1663.



In support of its claim of priority, Petitioner made of record:

- Santulli declaration averring Petitioner's first use of the LITTLE NOTES mark on September 4, 2013, with nearly \$2 million in gross sales at the time of trial. (33 TTABVUE 4);
- Screenshots of webpages displaying Petitioner's various cards and stationery under its LITTLE NOTES mark on Amazon.com (34 TTABVUE 9-85; 35 TTABVUE 2-49; 44 TTABVUE 3-510; 45 TTABVUE 3-358; 46 TTABVUE 3-175), some indicating the goods were first available on September 4, 2013 (e.g., 34 TTABVUE 23) and with generally favorable customer reviews. Many of the screenshots indicate the goods are "Designed for writing little notes & thank you's on the front of the card." (Exhibit 1 below);
- An on-line article discussing the top 10 e-commerce retailers in the United States in 2020, noting that Amazon.com holds by far the largest market share at 38.7%. (45 TTABVUE 361-376).

Health & Household › Stationery & Gift Wrapping Supplies › Stationery › Notecard Sets



## Kite Note Cards (24 Non-foldover Cards and Envelopes)

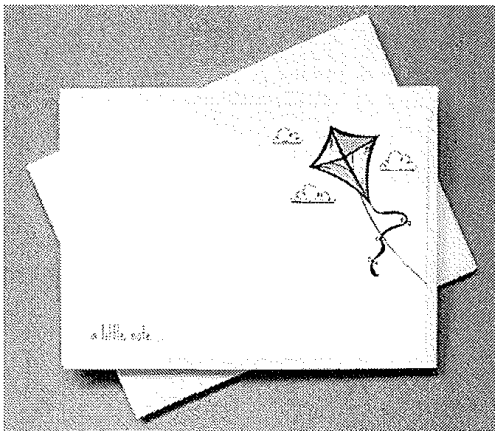
Brand: Little Notes by Comptime Ammsia

1 rating

Currently unavailable.

We don't know when or if this item will be back in stock.

- Adorable Note Card Set (24 cards and envelopes) - High quality paper & envelopes.
- Premium 110# Classic Crest Cover Stock & Matching Blank Bright White Envelopes.
- 6" x 4.25" This is a flat card, not a foldover.
- Designed for writing little notes & thank you's on the front of the card.
- Looking for foldover cards, check out our full line.



(44 TTABVUE 65)

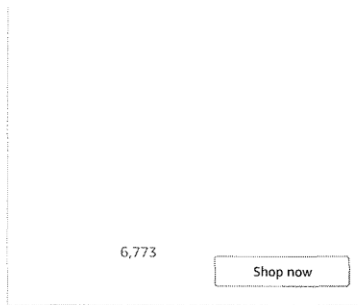
### Customer reviews

4.5 out of 5

3 global ratings

5 star	54%
4 star	46%
3 star	0%
2 star	0%
1 star	0%

How are ratings calculated?



Sponsored

Top reviews

### Top reviews from the United States

Dan Turck

#### Awesome For Halloween Wedding Day Love Notes

Reviewed in the United States on November 17, 2015

Verified Purchase

I used these to write little love notes to my wife for her to read while she was getting ready on our wedding day (which happened to be on Halloween). The maid of honor delivered them throughout the day, giving her the last one right before she walked down the aisle. She really loved it, and it created an amazing memory for her to cherish.

They are great quality, and absolutely beautiful. I hope more people have the opportunity to use them in such a memorable way. Definitely recommend!

Helpful Report abuse

Marlylou

#### Very pleased

Reviewed in the United States on October 21, 2015

Verified Purchase

The cards were exactly what I expected. I am very pleased with them. I wanted them to send personal thanks to individuals.

Helpful Report abuse

Amy

#### Adorable

Reviewed in the United States on October 9, 2015

Verified Purchase

These were nicer than I expected. I was worried that they would be to plan as thank you cards for my wedding. I would buy these again.

One person found this helpful

Helpful Report abuse

(44 TTABVUE 84)

Because Respondent's challenged registration is on the Supplemental Register, Respondent cannot rely on the filing date of the application that matured into its registration to establish a constructive use priority date. Section 26 of the Trademark Act, 15 U.S.C. §1094, provides that "registrations on the supplemental register shall not be subject to or receive the advantages of section[ ] . . . 1057(c)," which provides that

[c]ontingent on the registration of a mark on the **principal** register . . . the filing of an application to register such mark shall constitute

constructive use of the mark, conferring a right of priority, nationwide in effect . . . against any other person except for a person whose mark has not been abandoned and who, prior to such filing—(1) has used the mark; (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

15 U.S.C. §1057(c) (emphasis added). *See Nationwide Mutual Ins. Co. v. Nationwide Realty, LLC*, 120 USPQ2d 1618, 1632 (TTAB 2016) (“Respondent’s Supplemental Register registration, however, is entitled to none of the presumptions of Section 7 of the Trademark Act . . . and it is incompetent as evidence of Respondent’s first use of its mark. 15 U.S.C. §§1057(b) and 1094. It is also not entitled to constructive use of the filing date of the underlying application. 15 U.S.C. § 1057(b).”).

Nonetheless, as plaintiff in this proceeding Petitioner bears the burden of establishing its Trademark Act Section 2(d) claim for cancellation, including priority, by a preponderance of the evidence. *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997); *West Fla. Seafood*, 31 USPQ2d at 1662 .

Petitioner has not pleaded ownership of any registered trademark, and must rely on its common law use of LITTLE NOTES as a trademark to prove priority. In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal*

*Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). “Thus, even if something is **used** as a trademark, if it is not distinctive, the user does not have a trademark because he has no existing trademark rights.” *Id.* at 44.

Under the rule of *Otto Roth*, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through “whatever other type of use may have developed a trade identity.” *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43. The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.

*Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990). Accordingly, a party seeking to cancel the registration of another’s mark on the basis of likelihood of confusion with its own unregistered mark must establish that the unregistered mark is distinctive of its goods or services either inherently or through the acquisition of secondary meaning. *Id.*; see also, e.g., *Perma Ceram Enterprises Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992); *Kwik-Kopy Franchise Corp. v. Dimensional Lithographers, Inc.*, 165 USPQ 397, 398-99 (TTAB 1970).

In addition to arguing that Respondent’s mark is merely descriptive and has not acquired secondary meaning (54 TTABVue 9-10), Petitioner argues:

In contrast, the Petitioner’s use of its “LITTLE NOTES” trademark demonstrates that if the Petitioner’s trademark were not found to be inherently distinctive, its “LITTLE NOTES” trademark would be considered to have acquired secondary meaning. The Petitioner’s Substitute Rebuttal Evidence contains copious amounts of evidence demonstrating the extensive and substantial nationwide use Petitioner has made of its “LITTLE NOTES” trademark in connection with its goods, and how the Petitioner has made such use.

The strength of the Petitioner’s mark and copious use of its “LITTLE NOTES” trademark demonstrates that Petitioner’s “LITTLE NOTES”

trademark is a strong trademark and entitled to significant protection. (54 TTABVUE 10-11.)

Petitioner fails to explain how its LITTLE NOTES mark is inherently distinctive while Respondent's identical mark applied to goods that are in part identical is merely descriptive. Respondent's mark further is registered on the Supplemental Register which also is a concession that the mark was merely descriptive of the identified goods at least at the time of first use. *Quaker State Oil Ref. Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *Perma Ceram*, 23 USPQ2d at 1137 n.11.

Nor does the record support Petitioner's assertion. For instance, Respondent included with its brief the following definitions: LITTLE – small in size; not big; not large; tiny; and NOTE – a brief record of something written down to assist the memory or for future reference. (58 TTABVUE 13, definitions from Dictionary.com, based on The Random House Unabridged Dictionary 2023.)<sup>11</sup> Petitioner's own evidence, an example of which is reproduced above, states that its cards are "Designed for writing little notes & thank you's on the front of the card. (44 TTABVUE 65.) As applied to, inter alia, small-sized note cards, LITTLE NOTES is at best highly descriptive.

Because we have found Petitioner's mark highly descriptive of the identified goods, its burden of establishing secondary meaning is commensurately high. *In re*

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<sup>11</sup> It is well-settled that the Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *E.g.*, *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018). We exercise our discretion to do so in this case.

*Sausser Summers, PC*, 2021 USPQ2d 618, at \*7 (TTAB 2021) (quoting *Royal Crown*, 127 USPQ2d at 1048) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.”); *In re GJ & AM*, 2021 USPQ2d 617, at \*37-38 (TTAB 2018) (“Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source indicators.”); *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at \*10 (TTAB 2019) (“[T]he greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness.”) (quoting *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010)).

“To establish acquired distinctiveness, an applicant must demonstrate that relevant consumers perceive the subject matter sought to be registered as identifying the producer or source of the product.” *GJ & AM*, 2021 USPQ2d 617, at \*38 (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) and *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009)); *see also In re Uman Diagnostics AB*, 2023 USPQ2d 191, at \*37 (TTAB 2023) (“[T]o be placed on the principal register, descriptive terms must achieve significance ‘in the minds of the public’ as identifying the applicant’s goods or services – a quality called acquired distinctiveness’ ...” (quoting *US PTO v. Booking.com B.V.*, 140 S.Ct. 2298, 2020 USPQ2d 10729, at \*3 (2020)).

“Applicant may show acquired distinctiveness by direct or circumstantial evidence.” *GJ & AM*, 2021 USPQ2d 617, at \*38-39 (“Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive amount of sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers.”).

We consider the following factors: (1) association of the proposed mark with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); *GJ & AM*, 2021 USPQ2d 617, at \*39 (acknowledging the six factors the Federal Circuit has identified “to consider in assessing whether a mark has acquired distinctiveness”).

We consider all of the evidence of record as a whole; no single factor is determinative. *Converse*, 128 USPQ2d at 1546 (“All six factors are to be weighed together in determining the existence of secondary meaning.”); *Sausser Summers*, 2021 USPQ2d 618, at \*7 (“All six factors are to be weighed together in determining the existence of secondary meaning.”) (quoting *In re Guaranteed Rate Inc.*, 2020 USPQ2d 10869, at \*3 (TTAB 2020)); *GJ & AM*, 2021 USPQ2d 617, at \*39 (“On this

list, no single fact is determinative “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.”).

1. Factor One: Association of the proposed mark with a particular source by actual purchasers (typically measured by customer surveys)

Petitioner has not submitted any surveys or other direct evidence by which we may assess the association of its proposed LITTLE NOTES mark with a particular source by actual purchasers. As noted above, some of the webpages from Amazon.com offering Petitioner’s goods under the designation LITTLE NOTES (34 TTABVUE 9-85; 35 TTABVUE 2-49; 44 TTABVUE 3-510; 45 TTABVUE 3-358; 46 TTABVUE 3-175) include customer reviews such as: “These note cards were just right for the intended correspondence. I am pleased with the graphic, weight of paper, and space to write my note. Thanks!” (34 TTABVUE 18); “They’re perfect! Thank you!” (34 TTABVUE 25-6); “So cute and fast delivery. Loved them.” (34 TTABVUE 33); “Overall the product is exactly what I needed, however; I am about 5 envelopes short which is very inconvenient.” (34 TTABVUE 60.) On their face, these reviews indicate generally favorable customer opinions of the goods themselves, but fail to establish that the purchasers recognize LITTLE NOTES as a source-identifier for Petitioner’s goods.

2. Factor Two: Length, degree, and exclusivity of use

Under factor two, Mr. Santulli’s declaration indicates use of the proposed mark since September 4, 2013 in U.S. commerce in connection with the identified goods. “While ‘it is true that evidence of substantially exclusive use for a period of five years immediately preceding the filing of an application may be considered prima facie evidence of acquired distinctiveness’ under Section 2(f), *In re Ennco Display Sys., Inc.*,



56 USPQ2d 1279, 1286 (TTAB 2000), the ‘language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case.’” *Uman Diagnostics*, 2023 USPQ2d 191, at \*41 (citing *Yamaha Int’l Corp.*, 6 USPQ2d at 1004).

Here, evidence of Petitioner’s substantially exclusive use since September 2013 is not particularly persuasive on the showing of secondary meaning given the high degree of descriptiveness of the proposed mark. *Uman Diagnostics*, 2023 USPQ2d 191, at \*41 (“We have discretion to find that evidence of a period of use is insufficient to show acquired distinctiveness, and we do so here because of the highly descriptive nature of Applicant’s proposed mark.”); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at \*20 (TTAB 2020) (“Where, as here, the applied-for mark is highly descriptive or non-distinctive, use for a period of approximately fourteen years is insufficient to establish acquired distinctiveness.”); *Nextel Commc’ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009) (“Even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness” depending “on the degree of acquired distinctiveness of the mark at issue.”).

### 3. Factor Three: Amount and manner of advertising

Petitioner has disclosed in Respondent’s cross-examination of Mr. Santulli that it spends approximately \$13,000 per year on its advertising expenditures on pay-per-click campaigns on Amazon.com and Etsy. (38 TTABVUE 11-23.) Beyond these relatively modest expenditures, Petitioner has not introduced evidence of other

advertising for its goods, nor indicated any context of activities and expenditures of other providers of related goods.

There is no evidence regarding, for example, the type or number of any other advertisements Petitioner has run or U.S. consumer exposure to Petitioner's advertising. *See* Trademark Rule 2.41(a)(3) ("advertising expenditures ... identifying types of media and attaching typical advertisements" are pertinent to whether a proposed mark has acquired distinctiveness"); *Booking.com v. Matal*, 278 F. Supp. 3d. 891, 919 (E.D. Va. 2017) (finding "compelling" evidence that applicant's "BOOKING.COM branded television commercials ... received 1.3 billion visual impressions from U.S. consumers in 2015 and 1.1 billion impressions in 2016. Its internet advertisements during these years received 212 million and 1.34 billion visual impressions from U.S. customers, respectively. And its 2015 movie theater advertisements received approximately 40 million visual impressions from U.S. customers.").

#### 4. Factor Four: Amount of sales and number of customers

Mr. Santulli has averred that Petitioner has "grossed approximately \$1,825,000" (33 TTABVue 4) from the sale of goods under its LITTLE NOTES designation. Petitioner has not disclosed the number of its customers, market share or how its goods rank in terms of sales by other providers of similar goods, so we are unable "to accurately gauge" the level of Petitioner's success. *Target Brands v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007); *see also In re MK Diamond Prods., Inc.*, 2020

USPQ2d 10882, at \*23 (TTAB 2020) (probative value of raw sales figures were diminished due to lack of industry context).

5. Factor Five: Intentional copying

There is no evidence of third parties intentionally copying Petitioner's proposed mark.

6. Factor Six: Unsolicited media coverage of the goods identified by the proposed mark

Applicant has not submitted evidence of unsolicited media coverage of the goods identified by the proposed mark.

7. Conclusion: Secondary Meaning

Based on a review of all of the evidence of record under the relevant factors, we find that Petitioner has failed to demonstrate by a preponderance of the evidence that LITTLE NOTES has acquired distinctiveness or otherwise achieved secondary meaning among relevant U.S. consumers as a source identifier for Petitioner's goods.

**V. Summary**

Having considered the evidentiary record, the parties' arguments and applicable authorities, as explained above, we find that Petitioner has not demonstrated that its proposed common-law mark LITTLE NOTES has achieved secondary meaning as a source identifier for its identified goods. Accordingly, we hold that Petitioner has not established priority of use necessary to support a valid cause of action to cancel Respondent's registration for the mark LITTLE NOTES pursuant to Section 2(d) of the Trademark Act. In order to prevail pursuant to Section 2(d), Petitioner must establish, among other things, prior trademark rights in its own purported mark.

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Because Petitioner herein has failed to do this, the petition for cancellation must be dismissed.

**Decision:**

The Petition to cancel Respondent's registration on the ground of Petitioner's priority and likelihood of confusion under Trademark Act Section 2(d), is dismissed.