

This Opinion is Not a
Precedent of the TTAB

Mailed: August 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Natural Dog Acquisition LLC

v.

Pet Go Round of Greensboro

—
Cancellation No. 92074028

Henry B. Ward III, Samantha N. Skains-Menchaca and Rebeca Harasimowicz
of Moore & Van Allen PLLC for Natural Dog Acquisition LLC.

A. Justin Eldreth of Eldreth Law Firm, PC
for Pet Go Round of Greensboro.

—
Before Zervas, Bergsman and Lynch,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Pet Go Round of Greensboro (“Respondent”) is the owner of Registration
No. 5011176 (“the ’176 registration”) for the mark



for “retail store services featuring a wide variety of consumer goods of others” in International Class 35. The ’176 registration issued on the Principal Register on August 2, 2016 based on an application filed on July 31, 2015, and claims first use and first use in commerce on December 11, 2014.¹ The wording “DOG” and “PET FOOD MARKET” is disclaimed.

Natural Dog Acquisition LLC (“Petitioner”) filed an Amended Petition to Cancel the ’176 registration,² alleging it is the owner of the following registrations:

- Registration No. 4947310 (“the ’310 registration”) for the mark



¹ The mark is described as consisting of “a silhouette of a stylized dog in a jumping pose, superimposed on a partial sunburst, with the wording, ‘THE’ below, with ‘NATURAL DOG’ printed below ‘THE’ and with a banner below containing the wording ‘PET FOOD MARKET’ in all caps.” Color is not claimed as a feature of the mark.

² 11 TTABVUE 4-9. Citations in this opinion are to the TTABVUE docket entry number and the electronic page number where the document or testimony appears. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to non-confidential parts of the record include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

(the “NATURAL DOG COMPANY and Design mark”) issued on the Principal Register on April 26, 2016, from an application filed on December 23, 2014, for:

“non-medicated balms for use on noses for pets” in International Class 3; and

“dog food; dog treats” in International Class 31.

The wording “NATURAL DOG COMPANY” has been disclaimed.³ The ’310 registration claims first use and use in commerce for the International Class 3 goods since September 2008, and first use and use in commerce for the International Class 31 goods on August 1, 2015.

• Registration No. 5466549 (“the ’549 registration”) for the standard character mark NATURAL DOG COMPANY (“DOG COMPANY” disclaimed) issued on the Supplemental Register on May 8, 2018 from an application filed on August 22, 2017, for:

various balms, protective barriers, bar shampoos, lotions and preparations for various animals in International Class 3; and

“edible chews for dogs” in International Class 31.

The wording “DOG COMPANY” has been disclaimed. The ’790 registration claims first use and first use in commerce on September 1, 2008 for the International Class 3 goods; and on January 26, 2015 for the International Class 31 goods.

³ The mark is described as consisting of “a dog’s face wearing a halo bracketed on either side by vertical curved lines. The design is above the stylized word ‘NATURAL’ above the words ‘DOG COMPANY’ in smaller type.” Color is not claimed as a feature of the mark.

- Registration No. 6185790 (“the ’790 registration”) for the standard character mark NATURAL DOG COMPANY which issued on the Principal Register on October 27, 2020 from an application filed on December 28, 2018 pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for:

various balms, protective barriers, bar shampoos, lotions, dental products and grooming preparations for various animals, “all ... made substantially in whole or part of natural ingredients,” in International Class 3;

“Dietary, nutritional, and feed supplements for animals and pets; all of the aforementioned made substantially in whole or part of natural ingredients” in International Class 5; and

“Edible chews and treats for animals and pets; all of the aforementioned made substantially in whole or part of natural ingredients” in International Class 31.

The wording “DOG COMPANY” has been disclaimed. The ’790 registration claims first use and first use in commerce on September 1, 2008 for the International Class 3 goods; in March, 2020 and in March 2019, respectively, for the International Class 5 goods; and on January 26, 2015 for the International Class 31 goods.

Petitioner also alleges:

5. Since at least as early as September 2008, Petitioner has continuously used the marks NATURAL DOG COMPANY & Design and NATURAL DOG COMPANY in U.S. commerce in connection with Petitioner’s Goods [defined as the goods of the ’549 and ’310 registrations].

6. Petitioner is the owner of common-law rights in the marks NATURAL DOG COMPANY & Design and

NATURAL DOG COMPANY in connection with Petitioner's Goods.

7. Petitioner's NATURAL DOG COMPANY mark has acquired secondary meaning through Petitioner's continuous, extensive, and substantially exclusive use of the same in connection with the marketing, distributing, offering for sale, and selling of Petitioner's Goods in Class 3 since September 2008. As such, Petitioner has built significant and valuable goodwill in its NATURAL DOG COMPANY mark, and the purchasing public recognizes and associates the NATURAL DOG COMPANY mark with Petitioner and Petitioner's Goods.

8. Petitioner's NATURAL DOG COMPANY mark has acquired secondary meaning through Petitioner's continuous, extensive, and substantially exclusive use of the same in connection with the marketing, distributing, offering for sale, and selling of Petitioner's Goods in Class 3 since September 2008. As such, Petitioner has built significant and valuable goodwill in its NATURAL DOG COMPANY mark, and the purchasing public recognizes and associates the NATURAL DOG COMPANY mark with Petitioner and Petitioner's Goods.⁴

Petitioner claims Respondent's mark will likely cause confusion with its marks and is not registrable. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

Respondent filed an Answer in which it denied the salient allegations of the Amended Petition to Cancel and raised five affirmative defenses, of which only two – laches and waiver – are true affirmative defenses.⁵ The first “affirmative defense,” that the amended Petition to Cancel fails to state a claim upon which relief can be granted, is not an affirmative defense. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1101 n. 6 (TTAB 2019). The others are mere amplifications of its denials, which

⁴ 7 TTABVUE 13.

⁵ 14 TTABVUE 3.

we do not consider as separate affirmative defenses. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *1 (TTAB 2020).

The proceeding is fully briefed.

I. The Record

In addition to the pleadings, the record consists of the file of the involved registration, *see* Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following evidence:

A. Petitioner's Evidence

- Trademark Status and Document Retrieval (TSDR) system printouts of the '310, '176, '549 and '790 registrations submitted under Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d), with the Amended Petition for Cancellation, showing active status and title in Petitioner's name for the '310, '549 and '790 registrations (7 TTABVUE).
- The declaration of William D'Alessandro, Petitioner's Chief Executive Officer (21 TTABVUE; 22 TTABVUE), with the following exhibits:
 - Schedule 1 – a screenshot from Petitioner's website;
 - Schedule 2 – listing and contact information for third-party store locations selling Petitioner's goods;
 - Schedule 3 – media coverage reposted on Petitioner's website; and
 - Schedule 4 – screenshots of Amazon webpages.
- The declaration of Duncan Hall, a Records Request Processor at the Internet Archive (24 TTABVUE), and its Exhibit A, consisting of screenshots of the Internet Archive's records.

- Notice of Reliance (23 TTABVUE) submitting:
 - Exhibit B – screenshots from Petitioner’s website; and
 - Exhibit C – Respondent’s responses to Petitioner’s supplemental interrogatories (25 TTABVUE).
- Notice of Reliance (28 TTABVUE) submitting:
 - Exhibit D – Screenshots of various webpages (including Facebook); and
 - Exhibit E – Screenshots from various webpages (e.g. Instagram) of Nature’s Emporium, an entity related to Petitioner.

B. Respondent’s Evidence

- The declaration of Ryan Smith (27 TTABVUE 2), Respondent’s CRO and prior COO and Vice President, submitting:
 - Exhibit 1 – A lease for The Natural Dog Pet Food Market retail location;
 - Exhibits 2 - 6 – Designs, proposals and mockups of Respondent’s signage;
 - Exhibits 7 - 8 – Photographs of signage;
 - Exhibit 9 – “Page Transparency” information for Respondent’s Facebook page;
 - Exhibit 10 – A Facebook advertisement for a job fair hosted by Respondent;
 - Exhibits 11-25 – Third-party webpages;
 - Exhibits 26-41 – Internet search results for pet-related products; and
 - Exhibits 42-47 – Internet search results for “natural dog food.”

- The declaration of Scotty Tanner, Respondent’s CEO (27 TTABVUE 165), submitting:
 - Exhibit 1 – A TSDR printout of the ’310 registration;
 - Exhibits 2 - 3 – A TSDR printout of an Office Action for the NATURAL DOG COMPANY & Design mark, and Petitioner’s Response;
 - Exhibit 4 – A copy of the specimen for the ’310 registration;
 - Exhibits 5 and 6 – TSDR printouts for the ’549 and ’790 registrations;
 - Exhibits 7 - 34 – printouts of Office Actions and registrations for third-party marks containing the terms NATURAL and DOG; and
 - Exhibits 35 - 44 – various emails.
- A Notice of Reliance (27 TTABVUE 531) mentioning the Smith and Tanner declarations with exhibits, “All Applications and Registrations of the Parties, Documents submitted by Petitioner to date [and] The Petitioner’s Responses to Registrant’s Discovery,”⁶ but submitting only Petitioner’s responses to Respondent’s interrogatory and document requests.

II. Evidentiary Stipulation

On September 29, 2021, the Board approved the parties’ evidentiary stipulation “to the admission and use at trial of all interrogatory responses and documents and things produced by either party during the discovery period,” their “waive[r of] any objections based on authenticity or hearsay as to all produced documents,” and their

⁶ 27 TTABVUE 531.

“right to object to all documents and things on the grounds of relevance, materiality, competency, and weight.”⁷

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may petition to cancel the registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that is proximately caused by continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Petitioner’s use and registration of its NATURAL DOG COMPANY and NATURAL DOG COMPANY and Design marks establish that it is entitled to seek cancellation of the ’176 registration.⁸ *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...

⁷ 25 TTABVUE 2-3.

⁸ Amended Notice of Opposition Exhs. A-C, 7 TTABVUE 9-32; D’Alessandro Decl, ¶ 2, 21 TTABVUE 4.

direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that plaintiff uses its mark “is sufficient to support [plaintiff’s] allegations of a reasonable belief that it would be damaged”).

IV. Petitioner’s Burden of Proof

As noted by the Federal Circuit, “[b]ecause a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration’ and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation. 15 U.S.C. § 1057(b) (1988). Accordingly, in a cancellation ... the petitioner bears the burden of proof. Moreover, the petitioner’s burden is to establish the case for cancellation by a preponderance of the evidence.” *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) (internal citations omitted); *see also, On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000).

V. Priority⁹

A party claiming prior use of a mark may petition to cancel a registration on the basis of such prior use pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064.

⁹ Petitioner argues in its main brief that there is no dispute with regard to Petitioner’s claim of priority, and that the only matter before the Board is likelihood of confusion. (29 TTABVUE 14). In its response, Respondent disputes Petitioner’s claim of priority (30 TTABVUE 36). Petitioner, in its reply brief, discusses priority and Respondent’s arguments. (31 TTABVUE 8-10). Simply put, we do not accept Petitioner’s contention that there is no dispute that it has priority of use.

To establish priority on a likelihood of confusion claim brought under Section 2(d), a party must prove that, vis-à-vis the other party, it owns “a mark or trade name previously used in the United States ... and not abandoned.” A party may establish its own prior proprietary rights in a mark through actual use, use analogous to trademark use, or an earlier constructive use date accorded to the party’s own application. *See Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009).¹⁰

Petitioner states in its reply brief that it “claims prior trademark rights in Petitioner’s NATURAL DOG COMPANY marks by virtue of Petitioner’s prior use and acquired distinctiveness thereof, rather than prior registration.”¹¹ We thus limit our analysis to Petitioner’s asserted common law rights to (i) the NATURAL DOG COMPANY mark; and (ii) the composite mark NATURAL DOG COMPANY and Design.

Respondent’s priority date

We first determine Respondent’s date of first use of its mark. In order to prevail in this proceeding, Petitioner will have to establish its priority before that date.

¹⁰ A plaintiff or defendant that seeks to rely on use analogous for establishing priority must specifically plead such reliance or the issue must be tried by implied consent. *Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1141-42 (TTAB 2013); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008); *Fair Indigo v. Style Conscience*, 85 USPQ2d 1536, 1538-39 (TTAB 2007). In this case, neither party pleaded “use analogous” to support their own claim of priority, and neither party mentioned “use analogous” in its briefing.

¹¹ 31 TTABVUE 9.

A party may rely up the filing date of the application underlying its registration for purposes of priority as its constructive use date. *See* Trademark Act Section 7(c); *Cent. Garden & Pet v. Doskocil*, 108 USPQ2d at 1140; *Larami v. Talk to Me Programs*, 36 USPQ2d at 1844. Thus, Respondent may rely on the July 31, 2015 filing date of the application which matured into the '176 registration.

Respondent, however, relies on a first use date earlier than the filing date of its application – it relies on first use in “2013 in North Carolina.”¹² A registrant “is not bound by the date of first use alleged in the application and is entitled to carry the date of first use back to a prior date by proper evidence. However, in such a situation ..., [a registrant] is under a heavy burden and his proof must be clear and convincing and must not be characterized by contradiction, inconsistencies and indefiniteness.” *George Putnam & Co., Inc. v. Hydro-Dynamics, Inc.*, 228 USPQ 951, 952 (TTAB 1986) (citing *Neville Chem. Co. v. The Lubrizol Corp.*, 196 USPQ 756 (TTAB 1977)); *Mgmt. and Comput. Servs., Inc. v. Mgmt. Analysis Corp.*, 181 USPQ 529 (TTAB 1973).

According to Respondent, it “opened a retail location under the name THE NATURAL DOG PET FOOD COMPANY in December of 2013 and Registrant’s use in commerce of Registrant’s Mark began in preparation for this opening and was in widespread use at least by that time.”¹³ Mr. Smith, who has been employed by Respondent since 2009, testified:¹⁴

¹² 30 TTABVUE 36.

¹³ 30 TTABVUE 9-10.

¹⁴ Mr. Smith does not define the term “PET GO ROUND Mark,” which he frequently uses in his declaration. We construe his use of the term “PET GO ROUND Mark” as a reference to the mark of the '176 registration because Mr. Smith (i) states in Paragraph 6 that “the PET

7. Pet Go Round of Greensboro, Inc. opened a retail location under the name THE NATURAL DOG PET FOOD COMPANY in December of 2013 and Registrant's use in commerce of Registrant's PET GO ROUND Mark began in preparation for this opening and was in widespread use at least by that time. Pet Go Round used Registrant's PET GO ROUND Mark in retail store services and sold an array of pets; pet food; and pet supplies including dog and cat foods, bedding; treats; chews; frozen foods; kibble; dehydrated foods; and various supplies for wild birds, hobby animals, back yard chickens, hamsters, gerbils, fish, and others; as well as apiary supplies

8. Between October of 2013 and December of 2013, Pet Go Round of Greensboro, Inc. had contracted with Innovative Signs and Designs to create a signage for its retail locations. The designs, proposals, and mockups show all the integral parts of the Registrant's PET GO ROUND Mark

9. Prior to October of 2013, Pet Go Round had created large banners featuring the PET GO ROUND Mark that date back to construction on the building which is as early as May 2013.

10. Upon information and belief, by the end of 2013, the signage featuring the Registrant's PET GO ROUND Mark was connected to its Greensboro, North Carolina retail location I have personal knowledge that Registrant's use of the PET GO ROUND Mark is current and has been consistent since 2013.¹⁵

14. On Monday, November 11, 2013, Pet Go Round of Greensboro, Inc. hosted a job fair, which was advertised on Facebook in association with the PET GO ROUND Mark

GO ROUND Mark [] is the subject of this proceeding"; (ii) signed his declaration on the last day of Respondent's testimony period as reset in the Board's May 26, 2021 order (20 TTABVUE 1); and (iii) consistently refers to the mark depicted in exhibits to his declaration as "the PET GO ROUND Mark."

¹⁵ 27 TTABVUE 4-5.

Exhibit 10¹⁶ to Mr. Smith's declaration, duplicated below, shows Respondent's mark and a November 11, 2013 date for a job fair:



Based on this evidence, which we find clear and convincing with no contradictions, inconsistencies and indefiniteness, we find that Respondent established it first used its mark in December, 2013 for the services identified in the '176 registration.¹⁷

¹⁶ Smith Decl. Exh. 10, 27 TTABVUE 31.

¹⁷ Petitioner did not allege that “THE NATURAL DOG” is merely descriptive and has not acquired distinctiveness. Therefore, whether THE NATURAL DOG is merely descriptive and has acquired distinctiveness is not in issue. Under Trademark Act Section 7(b), 15 U.S.C. § 1057(b), a registration of a mark upon the Principal Register is prima facie evidence of the validity of the registered mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration.

Petitioner's priority date

As mentioned, Petitioner “claims prior trademark rights in Petitioner’s NATURAL DOG COMPANY marks by virtue of Petitioner’s prior use and acquired distinctiveness thereof, rather than prior registration.”¹⁸ In this regard, Petitioner claims:

- First use of the NATURAL DOG COMPANY and Design mark since as early as September 2008 for “non-medicated balms for use on noses for pets”;¹⁹
- First use of the NATURAL DOG COMPANY mark since at least as early as September 1, 2008 for “non-medicated balms for use on noses for pets, namely, dogs, cats, rodents, and horses; non-medicated lotion for the noses of pets, namely, dogs, cats, rodents, and horses; non-medicated balms for use on paws of dogs, cats and pets; non-medicated grooming preparations for pets, specifically dogs, cats, rodents, and horses, namely, lotion for skin, fur, and coat, soaps, perfumery, essential oils for cosmetic purposes, dentifrices, shampoos, conditioners, and lotions, creams, sprays, balms, and oils for ears, paws, face, tear stains, fur, tails, skin, noses, hooves, and manes; balms for all skin folds including interdigital skin folds, nasodigital skin folds, vulvar skin folds and tail skin folds; non-medicated balms for use on dog’s interdigital spaces and skin folds on face, noses, ears, neck, body and tail; non-medicated protective barrier for use on pets, specifically on the paws of dogs and cats, namely, balms, and sprays for use on pets, specifically dogs and cats; non-medicated sun protective barriers, namely, balms, and sprays for use on pets, specifically dogs and cats; bar shampoo for pets, namely, dogs, cats, and horses”;²⁰ and
- acquired distinctiveness of its mark in 2008.²¹

¹⁸ 31 TTABVUE 9.

¹⁹ Amended Petition to Cancel, ¶ 1, 7 TTABVUE 3.

²⁰ *Id.*, at ¶ 2.

²¹ *Id.*, at ¶¶ 8.

We refer to the goods in the paragraphs set forth immediately above as “Petitioner’s Common Law Goods.”

Petitioner’s claim of acquired distinctiveness is consistent with (i) its disclaimer of NATURAL DOG COMPANY in the ‘310 registration; (ii) the registration of its mark on the Supplemental Register (i.e., the ’549 registration);²² and (iii) its claim of acquired distinctiveness in the ’790 registration (and disclaimer of DOG COMPANY).²³ A claim of acquired distinctiveness under Section 2(f) constitutes a concession that the mark in its entirety is not inherently distinctive. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

The Court of Appeals for the Federal Circuit held as follows:

Under the rule of *Otto Roth* [*Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)], 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.

* * *

Section 2(d) bars registration, or serves as a basis for cancellation, if there is a likelihood of confusion as to source. As to an unregistered term, such a likelihood of confusion results when there are trade identity rights in

²² “Registration of a mark on the supplemental register [is] not ... an admission that the mark has not acquired distinctiveness.” Trademark Act § 27, 15 U.S.C. ¶ 1095.

²³ Amended Petition to Cancel, Exhs. A-C, 7 TTABVUE 9-32.

the prior user's term. Those trade identity rights arise when the term is distinctive either inherently or through the acquisition of secondary meaning.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1401-02 (Fed. Cir. 1990).

Thus, unlike Respondent which owns a mark registered on the Principal Register without a claim of acquired distinctiveness and without a disclaimer of the term NATURAL, Petitioner must establish acquired distinctiveness of the term NATURAL DOG COMPANY as a source indicator to prevail in this proceeding.²⁴ “To show that a mark has acquired distinctiveness, an applicant [or party] must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *see also Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012).

Before determining whether Petitioner’s marks have acquired distinctiveness, we consider the degree of descriptiveness of Petitioner’s marks as applied to Petitioner’s Common Law Goods, because it “is helpful in laying a foundation for our discussion of acquired distinctiveness.” *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, *5 (TTAB 2020); *see also Royal Crown Co. v. Coca-Cola Co.*,

²⁴ Of course, the NATURAL DOG COMPANY and Design mark contains a design element, which Petitioner described in its registration as “a dog’s face wearing a halo bracketed on either side by vertical curved lines.” Petitioner minimizes the significance of the design element, stating in its main brief that “the combined terms NATURAL DOG are the dominant portions of both Petitioner’s Marks and [Respondent’s] marks.” 29 TTABVUE 17. Petitioner hence relies on the distinctiveness of the term NATURAL DOG COMPANY.

892 F.3d 1358, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018) (“[T]he ... burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning” (citing *Steelbuilding.com*, 75 USPQ2d at 1424)); *id.* at 1048 (“[T]he Board must make an express finding regarding the degree of the mark’s descriptiveness on the scale ranging from generic to merely descriptive, and it must explain how its assessment of the evidentiary record reflects that finding.”); *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265-66 (Fed. Cir. 2015) (Board was within its discretion not to accept applicant’s allegation of five years’ use given the highly descriptive nature of the mark); *In re Boston Beer Co.*, 198 F.3d 1370, 1373 (Fed. Cir. 1999) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” (quoting *In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1727 n.4 (Fed. Cir. 1990))).

“A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U. S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). While we may not impermissibly “dissect” a mark, we may consider the “meaning and weight” of each of the components of the mark:

The Board, to be sure, may ascertain the meaning and weight of each of the components that makes up the mark. The Board, however, ultimately must consider the mark as a whole and do so in the context of the goods or services at issue.

DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). *See also In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1337 (TTAB 2009) (“[I]t is entirely acceptable to consider the component parts of a composite mark when divining the likely perception of the composite.”); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1051 (TTAB 2006) (“Nor has the examining attorney engaged in impermissible dissection of a mark by determining that one term in the mark is descriptive and another generic. This is all part and parcel of routine examination of a multiword mark.”).

The record includes the following:

- Petitioner’s webpages having the following articles:
 - “Dogs in Canada” (October 25, 2015) which states, “One product that fits both bills is Snout Soother. This natural balm is designed to heal and moisturize” (21 TTABVUE 105).
 - “Pet Product News” (July 31, 2015), which states, “Natural Dog Snout Soother is a nose balm for dogs. The all-natural product is formulated to prevent and treat cracking and dryness” (21 TTABVUE 107).
 - “PetAge” (January 30, 2015) “Natural Dog Snout Soother is a safe, 100% natural nose balm ...” (21 TTABVUE 128).

- Mr. Smith’s testimony:

From my own experience as a purchasers of wholesale goods, I know that NATURAL is an extremely common phrase in the pet food industry and it is often combined with DOG in marketing, in searches, in metadata, in descriptions of goods, and as the generic term for natural dog food, as shown on the examples attached hereto as

Exhibits 42-47. Note that Rover.com uses Natural Dog Food as its metatag on the website.²⁵

- An email dated March 30, 2020 from Cara Sugg, Wholesale Account Specialist of Natural Dog Company, stating, “Touching base to see what your thoughts were on the samples of the all-natural and organic healing balms we sent over to you in December?”²⁶

- The following third-party uses of “natural” describe a feature of goods for pet skin care:

- “Now it is time to do the same ... with our all-natural organic Petitioner shampoo and natural dog and Petitioner care products”; and “We believe in Natural, Organic Skin Care[.]” (27 TTABVUE 45).
- “Our all-natural line of skincare formulas for animals uses only the finest ingredients” (27 TTABVUE 56).
- “An all-natural balm for pets with itchy skin and paws.” ... “It is 100% natural and non-toxic, which means it is safe if licked!” (27 TTABVUE 61).
- “[M]assage oil rich in natural ingredients to relieve muscle and joint pain.” (27 TTABVUE 64).

- Dictionary definitions of “natural,” including one dictionary defining the term as “produced or existing in nature; not artificial or manufactured,” and “with little or no processing, artificial ingredients or preservatives = *natural food*.”²⁷

²⁵ 27 TTABVUE 7.

²⁶ 27 TTABVUE 517.

²⁷ Collins American English Dictionary, 27 TTABVUE 256-57.

- Petitioner’s identification of goods in the ’790 registration contains the limitation “all of the aforementioned made substantially in whole or part of natural ingredients.”²⁸

- Ten third-party Principal registrations for marks containing a disclaimer of the term NATURAL or NATURALS, and one Supplemental Register registration for a mark containing the term NATURAL, all for pet-related goods or services.²⁹

Based on the foregoing, we find that the term “natural” is a highly descriptive term for Petitioner’s Common Law Goods, indicating that such goods have little or no processing, artificial ingredients or preservatives. The wording DOG is generic for Petitioner’s Common Law Goods, and the term COMPANY does not function as a source indicator.³⁰ The absence of a source indicative function of DOG COMPANY is evidenced by Petitioner’s disclaimer of DOG COMPANY in its Supplemental Register registration. In addition, the record contains uses of NATURAL DOG as part of the phrase “natural dog food,”³¹ thus the juxtaposition of these terms is not unordinary.

²⁸ Amended Petition to Cancel, Exh. C, 7 TTABVUE 30-32.

²⁹ 27 TTABVUE 230-31, 239-42, 249-51, 266-68, 288-89, 291-94, 307-08, 317-19, 325-27, 334-36, and 354-55. Third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976).

³⁰ Business type designations and abbreviations such as “Corporation,” “Inc.,” “Company” and “Ltd.” merely indicate a business type or structure and have no source-indicating capacity. *USPTO v. Booking.com B.V.*, __ U.S. __, 2020 USPQ2d 10729, at *6 (2020) (“[A]ddition of the word ‘Company’ supplied no protectable meaning, the Court concluded, because adding ‘Company’ ‘only indicates that parties have formed an association or partnership to deal in such goods.’”) (quoting *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888)); *see also In re Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265, 267 (CCPA 1953); *In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522, 1526 (TTAB 2006).

³¹ Smith Decl. Exhs. 42-44, 27 TTABVUE 151-58, 381, 389,

Nothing about the combination of words in the mark detracts from their individually descriptive or generic meanings. We find that NATURAL DOG COMPANY, considered as a whole, is a highly descriptive term for a characteristic of Petitioner's Common Law Goods.

Having identified the degree of descriptiveness of the term NATURAL DOG COMPANY, we turn to Petitioner's showing of acquired distinctiveness. "[T]he considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade[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*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). Although all six factors are to be weighed together in determining the existence of secondary meaning, no single factor is determinative. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, *11 (TTAB 2019) ("On this list, no single fact is determinative.").

"Acquired distinctiveness may be shown by direct or circumstantial evidence. Direct evidence of acquired distinctiveness includes actual testimony, declarations or surveys of consumers as to their state of mind (e.g., factor 1). Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive sales and advertising, and any similar

evidence showing wide exposure of the mark to consumers (e.g., factors 2 through 6).” *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, *24 (TTAB 2019) (citing *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000)).

Petitioner makes the implausible claim that in 2008, the year it commenced use of its marks, the marks acquired distinctiveness.³² Petitioner’s Chief Executive Officer, William D’Alessandro sinks this claim in his April 29, 2020 declaration – the declaration states that Petitioner earned just \$526 dollars in sales in 2008, and lists no advertising expenses for that year (or for the years 2009-2011).³³ We thus move forward and determine whether Petitioner’s marks acquired distinctiveness at a later date, but prior to Respondent’s established priority date of December 2013.

The most relevant evidence regarding alleged acquired distinctiveness lies within Mr. D’Alessandro’s declaration and its exhibits. Mr. D’Alessandro declares, however, that the declaration is made “in support of the registration on the Principal Register and acquired distinctiveness of the NATURAL DOG COMPANY mark, which is the subject of [] Application No. 88/244,670.” (Application Serial No. 88244670 matured into the ’790 registration.) He does not mention the present proceeding – Petitioner evidently repurposed Mr. D’Alessandro’s declaration.

Much of Mr. D’Alessandro’s declaration pertains to activities approximately two years ago, when the declaration was executed and submitted in connection with the

³² Amended Petition to Cancel ¶¶ 1 and 8, 7 TTABVUE 3.

³³ D’Alessandro Decl. ¶ 4, 21 TTABVUE 4. There are two paragraph No. 2 in the D’Alessandro declaration. Therefore, the advertising and sales figures set forth in paragraph No. 3 is actually paragraph No. 4.

registration of Petitioner’s mark. Here, we are concerned with acquired distinctiveness at a much earlier time period. However, some material in the declaration has relevance.

The declaration that Petitioner “has substantially exclusively and continuously used the NATURAL DOG COMPANY mark in connection with animal and pet products, including non[-]medicated balms for use on noses for pets, since at least as early as September 1, 2008, throughout the U.S. in commerce” and identifies Petitioner’s and its predecessor’s advertising and sales figures:³⁴

Year	Advertising Expenditures	Sales Success
2008	Record Not Available	\$526
2009	Record Not Available	\$45,420
2010	Record Not Available	\$107,931
2011	Record Not Available	\$91,959
2012	\$ 1,339	\$88,516
2013	\$ 9,658	\$180,446
2014	\$ 9,445	\$521,127
2015	\$35,907	\$911,916
2016	\$59,366	\$1,275,121
2017	\$163,762	\$2,036,826
2018	\$425,483	\$3,939,338
2019	\$1,249,372	\$8,201,771

We are not impressed with these figures insofar as they pertain to advertising and “sales success” prior to 2014. The total advertising expenditures identified up to then are a mere \$10,997. “Sales success” is not defined. If “sales success” means gross sales, the declaration does not reflect how many items Petitioner and its predecessor sold. Total “sales success” for the six-year period prior to 2014 is \$514,798, which is not an

³⁴ D’Alessandro Decl. ¶¶ 2, 3, 7 TTABVue 4.

impressive number in the context of an allegation of acquired distinctiveness of a highly descriptive mark for the types of goods at issue.

Mr. D'Alessandro identified media coverage of Petitioner's animal and pet products, but only the following three are dated prior to 2014:³⁵

NATURAL DOG COMPANY animal and pet products, including non-medicated balms for use on noses for pets, featured on television:

- (a) *Deborah Duncan at 9am*, GREATDAY HOUSTON, September 30, 2012, as shown at <https://www.youtube.com/watch?v=hdUOCs1TO-8>.
- (b) *The latest and greatest in pet products!*, ANIMAL PLANET, September 30, 2012, as shown at <https://www.youtube.com/watch?v=FKvgcpq95pc>.
- (c) *With Vago Muradian*, DEFENSENEWS, September 30, 2012.

The “copies” of these television programs Mr. D'Alessandro references as exhibits are simply webpages from the naturaldogcompany.com website containing links to videos. Providing an Internet link to a webpage is insufficient to make the referenced video materials of record. *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, at *21 n.13 ((TTAB 2016) (Board “cannot consider the video itself” which does not become part of the record through a YouTube link, and noting that video files may be submitted through the TEAS Response to Office Action form). Because of the ephemeral nature of Internet websites, the “Board does not accept Internet links as a substitute for submission of a copy of the resulting page.” *TV Azteca, S.A.B. v.*

³⁵ D'Alessandro Decl. ¶ 4, 7 TTABVUE 5.

Because he was not employed by Petitioner's predecessor at the time, Mr. D'Alessandro states that upon information and belief, the appearance or discussion of Petitioner's goods on these television programs was unsolicited. “Pursuant to [Fed. R. Civ. P. 56(c)(4)], an affiant or declarant may testify based on his or her personal knowledge from a review of the contents of files and records.” *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (citing *Londrigan v. Federal Bureau of Investigation*, 670 F.2d 1164, 1174-75 (D.C. Cir. 1981); *Washington Cent. R. Co., Inc. v. National Mediation Bd.*, 830 F. Supp. 1343, 1353 (E.D. Wash. 1993)).

Martin, 128 USPQ2d 1786, 1789 n.15 (TTAB 2018) (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1194 n.21 (TTAB 2018); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)). Not only are there an extremely limited number of unsolicited media prior to the December 2013 critical date, the record does not include the actual content.

Thus, even if Petitioner's use was substantially exclusive and continuous for the six years prior to 2014, due to the limited evidence and its lack of persuasiveness, we are not persuaded that Petitioner's highly descriptive mark had acquired distinctiveness before 2014. *Cf. Threshold.TV, Inc. and Blackbelt TV, Inc. v. Metronome Enterprises, Inc.*, 96 USPQ2d 1031, 1039 (TTAB 2010) (although plaintiff's president "stated that opposer has used BLACKBELT TV since October 1998, such use for twelve years in and of itself does not establish acquired distinctiveness.").

Because Petitioner has not established by a preponderance of the evidence acquired distinctiveness prior to Respondent's established first use date, Petitioner has not met its burden of establishing priority.

VI. Likelihood of Confusion, Laches and Waiver

Because Petitioner has not established priority, its claim under Section 2(d) of the Trademark Act must fail, and we need not reach the issue of likelihood of confusion.

We also need not reach Respondent's affirmative defenses of laches and waiver.³⁶

³⁶ Petitioner has not cited a Board decision recognizing waiver as a viable affirmative defense, and we do not know of any such case. Professor McCarthy has commented as follows regarding waiver as an affirmative defense in trademark law:

Decision: The Petition to Cancel is denied.

Bergsman, Administrative Trademark Judge, concurring:

When I analyze the term “Natural Dog Company” in its entirety in connection with the relevant goods, I am left wondering what is a natural dog company, what is a natural dog, and what is a dog company. Nevertheless, I am constrained to find the term “Natural Dog Company” merely descriptive inasmuch as

- Petitioner disclaimed the exclusive right to use the term “Natural Dog Company” in its pleaded Registration No. 4947310 for the mark NATURAL DOG COMPANY and design;
- Petitioner sought to register the mark NATURAL DOG COMPANY, in standard characters, on the Supplemental Register (Registration No. 5466549) while also disclaiming the exclusive right to use the term “Dog Company”; and

I'm not aware of any reasoned argument of why the existing traditional defenses to trademark infringement are so inadequate that a new defense of “waiver” should be created. In just about all of the reported cases discussing a claim of “waiver,” the conduct involved would fit comfortably within the traditional defenses of laches or acquiescence. In many of those cases, those traditional defenses were in fact asserted and defendants appeared to add a “waiver” defense in hopes it would have some effectiveness that the traditional defenses lacked. But the law does not need the complication of a new and additional defense of uncertain dimensions. The existing traditional defenses are perfectly adequate to protect a deserving defendant accused of trademark infringement.

J. Thomas McCarthy, 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 31:43 (5th ed. 2022).

- Petitioner registered the standard character mark NATURAL DOG COMPANY pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f) (Registration No. 6185790) while disclaiming the exclusive right to use the term “Dog Company.”

Where I disagree with the majority is that I would find NATURAL DOG COMPANY to be a merely descriptive term, not a highly descriptive term. Assuming arguendo that NATURAL DOG COMPANY is a merely descriptive term, not a highly descriptive term, Petitioner’s evidence remains insufficient to support finding that NATURAL DOG COMPANY has acquired distinctiveness.