

This Opinion is not a
Precedent of the TTAB

Hearing: May 10, 2018

Mailed: July 24, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Dexas International, Ltd

v.

Ideavillage Products Corp.

Opposition No. 91225850

Daniel V. Thompson of Law Office of Daniel V. Thompson P.C.
and Mark A. Richmond for Dexas International, Ltd.

Jason M. Drangel of Epstein Drangel LLP
For Ideavillage Products Corp.

Before Kuhlke, Goodman and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Ideavillage Products Corp. (“Applicant”) seeks registration on the Principal Register of the mark SNACKEEZ DUO (in standard characters) for “Beverageware; household containers for foods; thermal insulated containers for food or beverages; bottles, sold empty for beverages; cups for beverages; insulating sleeve holder for

beverage cups; portable beverage and food container holder” in International Class 21.¹

Dexas International, Ltd. (“Opposer”) has opposed registration of the applied-for mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the basis of priority and likelihood of confusion with its common law mark SNACK-DUO as used on food and drink containers.² In its Answer, Applicant denied the salient allegations of the Notice of Opposition, as amended.³ The parties fully briefed the issues and appeared for oral argument.

I. The Evidentiary Record

The record consists of:

- The pleadings;
- The file of Application Serial No. 86472355 under Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b);
- Opposer’s first notice of reliance, containing
 - excerpts from the trade publications *Pet Business* (July and September 2014 issues) and
 - *HomeWorld Business* (September 2014 issue) both publications displaying Opposer’s SNACK-DUO advertisements;

¹ Application Serial No. 86472355 was filed on December 5, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Amended Notice of Opposition, 7 TTABVUE. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

³ Answer, 9 TTABVUE. Applicant’s Answer also interposed four “affirmative defenses.” The first, second, and fourth, claiming that the amended Notice of Opposition failed to state a claim on which relief can be granted, arguing that there is no likelihood of confusion, and reserving the right to assert further defenses, respectively, are not affirmative defenses. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 311.02(b). The third pleaded affirmative defense interposed the equitable defenses of laches, acquiescence, estoppel, or waiver, but these defenses were not pursued in Applicant’s brief, and are therefore waived. *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 n. 5 (TTAB 2018).

- Applicant's written discovery response stating that it relies on its filing date of December 5, 2014 to establish priority;
- A cease-and-desist letter Applicant's counsel sent to Opposer on or about March 11, 2015;⁴
- The declaration of Dave Palcek, President and co-founder of ICD Publications, publisher of *HomeWorld Business*, which displayed Opposer's SNACK-DUO advertisement in its September 2014 print issue;⁵
- The declaration of Doug Poindexter, President of World Pet Association, which hosted the annual SuperZoo pet industry trade show in Las Vegas in July 2014, at which Opposer displayed its SNACK-DUO product;⁶
- The declarations of Nick Musteen, Opposer's Sales Director, about the unveiling, promotion, and shipping of samples of its SNACK-DUO product;⁷
- The declaration of Jeff Dennis, Opposer's Project Management Director, about the packaging and labeling of the SNACK-DUO product with hangtags bearing the mark, and its display at the July 2014 SuperZoo trade show;⁸
- The declaration of Jeff Logan, Opposer's Marketing Director, about promoting the SNACK-DUO product, including by advertisements in *Pet Business* and *Homeworld Business* magazines;⁹
- The deposition of Mark Kalaygian of MacFadden Communications Group, publisher of *Pet Business* magazine, regarding publication of Opposer's SNACK-DUO advertisements and circulation of the magazine;¹⁰
- The declaration of Loriann Lombardo, Vice President of Product Development for Applicant, regarding Applicant's SNACKEEZ products, its marketing and promotional efforts, and the SNACKEEZ DUO product;¹¹

⁴ 13 TTABVUE.

⁵ 14 TTABVUE.

⁶ 14 TTABVUE.

⁷ 15 TTABVUE (confidential) and 30 TTABVUE.

⁸ 16 TTABVUE.

⁹ 21 TTABVUE.

¹⁰ 21 TTABVUE.

¹¹ 24 TTABVUE.

- The deposition of Jeffrey Dennis, Opposer’s Project Management Director, by Applicant’s counsel;¹²
- The deposition of Jeff Logan, Opposer’s Marketing Director, by Applicant’s counsel;¹³
- The deposition of Nick Musteen, Opposer’s Sales Director, by Applicant’s counsel.¹⁴

II. Standing

Any person who believes it is or will be damaged by registration of a mark has standing to file an opposition. 15 U.S.C. § 1063. Our primary reviewing court has enunciated a liberal threshold for standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quotation omitted), *cert. denied*, 135 S. Ct. 1401 (2015). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999). A claim of likelihood of confusion that “is not wholly without merit,” including prior use of a confusingly similar mark, may be sufficient “to establish a reasonable basis for a belief that one is damaged.” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) *quoted in Executive Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1179 (TTAB 2017). Here, Opposer has established that the parties are competitors; it has, accordingly, a real commercial interest in this proceeding. *See Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519,

¹² 25 TTABVUE.

¹³ 27 TTABVUE.

¹⁴ 29 TTABVUE (28 TTABVUE confidential).

5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor has standing to challenge registration). Moreover, Opposer received a cease-and-desist letter from Applicant claiming that the parties' marks would cause a likelihood of confusion.¹⁵ "[C]ease and desist letters provide additional evidence that opposer has business interests that have been affected, i.e., a real interest in the proceeding, and thus, has standing." *Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013) *quoted in Apollo Medical Extrusion Technologies, Inc. v. Medical Extrusion Technologies, Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017). Opposer's standing is thus established.

III. Priority

To prevail on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, based on a previously used mark, it is the Opposer's burden to prove both priority of use and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). A party seeking to cancel a registration under Section 2(d) must prove that it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion as to source. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). A party may establish its own prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994). Here, because Opposer has not pleaded or submitted any registrations, it must

¹⁵ Correspondence dated March 11, 2015 from Applicant's counsel Jason M. Drangel, addressed to the president of Opposer. See Opposer's first notice of reliance, 13 TTABVUE 67.

rely on its asserted common law rights, which must precede Applicant's actual or constructive use of its mark. *WeaponXPerformance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018).

Applicant relies on December 5, 2014, the filing date of its Section 1(b) intent-to-use application to register SNACKEEZ DUO, as its constructive use priority date.¹⁶ *See Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (“[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights”).

Although Opposer made its first actual commercial sales of its SNACK-DUO product in interstate commerce beginning in January 2015,¹⁷ about a month after Applicant's constructive use date, Opposer claims priority based on use analogous to trademark use of SNACK-DUO since early July 2014, and based on interstate shipment of two samples bearing the SNACK-DUO mark to a retailer in the months preceding Applicant's December 5, 2014 constructive use date. We examine each of these two bases for priority in turn.

A. Analogous Use

It is well settled that use of a mark in a manner analogous to technical trademark use may furnish a valid basis for claiming priority and maintaining an opposition.

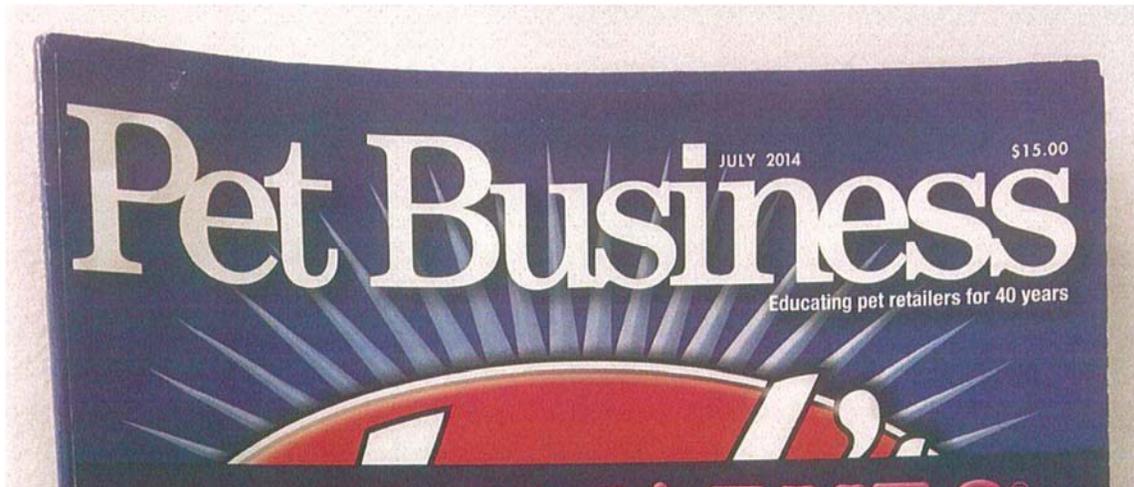
¹⁶ Applicant's response to Opposer's Request for Admission no. 1, admitting “Applicant relies on its constructive use date of December 5, 2014 to establish priority over Opposer in this Opposition.” 13 TTABVUE 64.

¹⁷ Musteen decl. ¶ 10, 30 TTABVUE 4.

T.A.B. v. PacTel, 37 USPQ2d at 1881; *L. & J.G. Stickley, Inc. v. Cosser*, 81 USPQ2d 1956, 1968 (TTAB 2007). As the Federal Circuit has observed: “[I]t has been pointed out that in relying on §2(d) of the Lanham Act as a ground of opposition, it is not necessary that an opposer prove prior use of a similar term in a strict trademark sense.” *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 11 USPQ2d 1638, 1639 (Fed.Cir.1989). Rather, “Use ‘analogous’ to trademark use means use of a nature and extent such as to create an association of the term with the user’s goods. Examples of use analogous to trademark use to establish priority under §2(d) include prior use of a term: in advertising brochures, in catalogues and newspapers, and in press releases and trade publications.” *Id.* (quoting 1 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION §20:4 at 1023-26 (1984)). “Thus, even before proper trademark use commences, advertising or similar pre-sale activities may establish priority if they create the necessary association in the mind of the consumer.” *Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1142 (TTAB 2013). *See generally* 2 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 16:14 (5th ed. June 2018 update).

Opposer contends it has made analogous use of its SNACK-DUO trademark in precisely this way. In the first week of July 2014, five months before Applicant’s filing date, Opposer introduced its SNACK-DUO product in *Pet Business* magazine, a trade publication with over 25,000 recipients such as pet product retailers, pet store owners, buyers, as well as pet industry distributors, manufacturers, and other people

associated with pet retail products, according to its publisher.¹⁸



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Although it is primarily a trade publication, Opposer’s Director of Marketing testified “we know that it does reach a vast amount of people who are associated with the pet industry. There’s a lot of groomers. There’s a lot of -- you know, there’s – there’s dog sitters and pet walkers. And there’s a lot of extra services that are around the pet industry. And a lot of those people are seriously passionate about dogs, and we consider them a consumer audience.”²⁰

In that issue, Opposer introduced a one-third page vertical advertisement of its SNACK-DUO product, which could contain food and drink in one cylindrical container:

¹⁸ Kalaygian dep. 14:25-15:10, 15:11-16, 26:10-15, 27:9-15, 21 TTABVUE 17-18, 29-30.

¹⁹ Opposer’s first notice of reliance, ex. 3, 13 TTABVUE 39.

²⁰ Logan dep. 18:19-19:6, 27 TTABVUE 21-22.

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Snack-Duo[™]
WITH COLLAPSIBLE COMPANION CUP

**One Drink.
One Snack.**

Same Bottle.

VISIT US AT SUPERZOO BOOTH 1074!

Carry cool water and a crunchy snack for your pet – when you’re both on the go!

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By mid-July 2014, the advertisement began to generate inquiries from pet product stores. On July 17, Jeffrey Dennis, Opposer’s Project Management Director, forwarded five “reader inquiries from Pet Product News about our ad for the Snack Duo” to Opposer’s sales team. The inquiries ranged from “Pawprints & Whiskers” in

²¹ Logan decl. ex. A, 17 TTABVUE 4-7; Logan dep. 27 TTABVUE 53-56.

Kingston, New York to “Brookview” in Mason City, Iowa to “Annie Get My Dog” in Sherman Oaks, California.²²

Jannah Grimes, a buyer from Camping World, based in Bowling Green Kentucky, emailed Opposer’s Sales Director Nick Musteen on July 9: “Nick, Could you quote the snack-duo? Looks like a neat item that our customers would get great use out of.”²³ He responded, “The Snack-Duo will be available in 60-90 days...” and specified its price per unit. They continued their colloquy over the next several months, before and after a large trade show at which Opposer promoted the SNACK-DUO.

Opposer’s *Pet Business* advertisement invited recipients to “VISIT US AT SUPERZOO BOOTH 1074!” —a large trade show scheduled in Las Vegas later that month.²⁴ According to the president of World Pet Association, which hosts the annual SuperZoo trade show, “SuperZoo is the most popular trade show for the pet store industry, attracting thousands of retailers, product suppliers and service providers every year.”²⁵ “A record-breaking 22,987 pet industry professionals took over the Mandalay Bay Convention Center in Las Vegas this July 22-24.”²⁶ This number included 16,639 attendees and 910 companies, many exhibiting their new products.²⁷ SuperZoo 2014 debuted 641 new products to the pet industry. A special area on the

²² Ex. F, Musteen decl. 30 TTABVUE 22-24. Opposer designated the Musteen declaration and its attached exhibits as confidential, 15 TTABVUE, but later submitted another declaration from Mr. Musteen repeating much of the same information and redacting only certain price and sale figures. 30 TTABVUE.

²³ Ex C, Musteen decl. 15 TTABVUE 13.

²⁴ Logan dep. 17:20-18:10, 27 TTABVUE 20-21.

²⁵ Poindexter decl. ex A, 14 TTABVUE 12.

²⁶ Poindexter decl. ex B, 14 TTABVUE 14.

²⁷ Poindexter decl. ¶ 4, 14 TTABVUE 9.

show floor, the New Product Showcase, is dedicated to these emerging products, and attendees are given the chance to vote on the best new products in [various categories].”²⁸ Opposer exhibited a booth at the trade show:



And it placed its SNACK-DUO product on display among the showcased new products, where it won a second place award for new products for dogs:

²⁸ Poindexter decl. ex. B, 14 TTABVUE 15.

²⁹ Dennis decl. ex. B, Dennis dep. 26 TTABVUE 58.



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Following the trade show, Opposer ran its SNACK-DUO ad again in the September 2014 issue *Pet Business* magazine, with the same circulation as before.³¹ Opposer also ran a full-page advertisement in the September 15, 2014 issue of *HomeWorld Business*, a magazine with an average monthly circulation of 12,025 that “focuses on the housewares retail and wholesale industry, including mass merchandisers, department stores, houseware specialty stores, supermarkets, other retailers, wholesalers and distributors,” according to its publisher.³² Opposer’s ad promoted use of the SNACK-DUO product by humans:³³

³⁰ Opposer’s first notice of reliance, 13 TTABVUE 53; Dennis decl. ¶ 4, 16 TTABVUE 3, Dennis decl. ex B, 16 TTABVUE 8; Musteen decl. ¶¶ 2-4, 30 TTABVUE 2; Musteen dep. ex 7, 28 TTABVUE 79.

³¹ Kalaygian dep. 20:6-24, 26:10-15, 21 TTABVUE 23, 29.

³² Palcek decl. ¶¶ 2-3, 14 TTABVUE 2.

³³ Logan decl. ¶¶ 2, 5, 7, exs. A-F, 17 TTABVUE 2-15.

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Snack-DuO™

One Drink. One Snack. Same Bottle.

The innovative, dual-chamber hydration system of the Dexas H-DuO has led to the creation of Snack-DuO. One watertight chamber holds your choice of beverage while the other chamber holds energy or protein bars, trail mix, nuts, or any other healthy snack. Two side-by-side chambers make for one perfect workout partner.

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Opposer’s Sales Director avers that “Following the trade show, Dexas interacted with a number of retailers who indicated interest in the Snack-DuO product, after having seen the product at the SuperZoo trade show or in one of the several print publications where Dexas ran ads for the Snack-DuO.”³⁵ As examples, he submits “four email chains ... representative of the many contacts we received, most of which were unrecorded because they were by phone or by face-to-face contact in sales calls.”³⁶

³⁴ Logan dep. ex. D, 27 TTABVUE 60.

³⁵ Musteen decl. ¶ 5, 30 TTABVUE 3.

³⁶ *Id.*

One such email chain was his ongoing colloquy with the buyer from Camping World, Jannah Grimes. The following are pertinent email excerpts:

- On September 23, 2014 he wrote, “Since we are about to order inventory, what would you forecast Camping World would order for an item such as this. NO COMMITMENT, I won't hold you to it. Just trying to gauge need.”
- She responded, “No commitment, but based on the cost and sales from similar items; I would say [hundreds of] units throughout 2015. They wouldn't go into stores until mid-March, so I based my forecast taking that into consideration.”³⁷

This exchange eventually impelled Opposer to send the buyer two samples of the SNACK-DUO product—a development we shall address separately. Opposer's first commercial sale of the SNACK-DUO product took place on January 21, 2015 to a feed and supply store in North Carolina.³⁸ Over the next two years, according to its sales figures, which have been designated as confidential, Opposer sold a significant number of SNACK-DUO units for a substantial dollar volume.³⁹ Since these sales commenced in the month after Applicant's December 5, 2014 constructive use filing date, they are not relevant to show priority based on actual use in commerce, but they are relevant to show that technical trademark use followed Opposer's initial

³⁷ Musteen decl. ex. C, 30 TTABVUE 9-12. The precise number of SNACK-DUO units the buyer projected Camping World would order was redacted as confidential, but it was a substantial number.

³⁸ Musteen decl. ¶ 10, 30 TTABVUE 4.

³⁹ Musteen decl. ¶ 11, 30 TTABVUE 4. The Board is not bound by confidentiality designations, and discourages parties from over-designating materials as confidential. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g); *see also Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (the Board will not be bound by improper confidentiality designations); Trademark Rule 2.116(g) (Jan. 2017) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”). Still, we have referred to this evidence sparingly, maintaining as much confidentiality as possible, while addressing the evidentiary points needed to elucidate the bases for the decision.

advertising and promotion of the SNACK-DUO mark within a commercially reasonable time. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1255 (TTAB 1995).

For our present purposes, the issue is whether the pre-sale activities Opposer conducted before Applicant's constructive use date constitute analogous use sufficient to establish prior rights in Opposer's mark. *See Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993) (priority of use against ITU application may be established with prior use analogous to trademark use). To help answer this issue, both parties cite the governing precedent *T.A.B. v. PacTel*, 37 USPQ2d 1879, where the Federal Circuit stated that:

[W]hat is required is public exposure of a mark that would be expected to have any significant impact on the purchasing public. ...

That is not to say that a fixed percentage, like 20%, much less 51%, of the potential customers must have formed in their mind the required prior public identification. As we noted above, it simply requires more than a negligible portion of the relevant market. In other words, advertising of sufficient clarity and repetition to create the required identification must have reached a substantial portion of the public that might be expected to purchase the service. Thus, the user must prove that the necessary association was created among more than an insubstantial number of potential customers. Otherwise, he cannot show significant impact on the purchasing public.

Id. at 1883 (punctuation and citations omitted).

Opposer contends that the standard enunciated in *T.A.B v. PacTel*—more than insubstantial and more than negligible—would seem to be a low bar to hurdle in terms of absolute numbers.⁴⁰ For an example of a case where an assertion of analogous use succeeded, Opposer directs our attention to *Jimlar v. Army and Airforce Exchange*

⁴⁰ Opposer's brief p. 13, 31 TTABVUE 19.

Service, 24 USPQ2d 1216 (TTAB 1992), where the Board found sufficient analogous use of the mark A-CLUB for footwear based on the opposer's display of a sample at a trade show:

In the present case, we concur with opposer that the display of a sample of its Highland-style boot, which had affixed thereto a patch prominently featuring the term "A CLUB," at an industry trade fair or show in Manhattan beginning on December 1, 1987 constitutes use analogous to trademark use upon which opposer can rely. Such use, which in essence is a form of advertising for the product, is plainly an open and public use of the "A CLUB" designation. The trade show display of the Highland-style boot, with the patch illustrating the "A CLUB" mark conspicuously appearing on the product, would be expected to have had a significant impact on prospective customers for opposer's boots. Notably, it was of a sufficient nature and extent as to create, in the mind of the potential purchasers of opposer's goods who attended the several-day affair, an association of the "A CLUB" designation with opposer's goods, especially in light of the fact that orders for the goods followed relatively shortly thereafter.

Id. at 1221.⁴¹

Applicant argues that "As discussed in *T.A.B. Systems*, 'the user must prove that the 'necessary association' [with the user's mark] was created among more than an insubstantial number of potential customers,'"⁴² yet "Opposer has completely failed to prove *any* association, no less, the '**necessary association**' or 'significant impact'

⁴¹ Opposer also directs our attention to the facts in *L. & J.G. Stickle v. Cosser*, 81 USPQ2d 1956, where the Board found that petitioner had prior rights in a mark based on analogous use. The evidence of analogous use consisted of petitioner's use of the mark on a display in its showroom and in its 1977 catalog. *Id.* at 1968. Applicant here minimizes the significance of the showroom display of the mark in *Stickle*, as the Board in *Stickle* found priority via analogous use "at least by the end of 1977 when its 1977 catalog was issued." *Id.* We find the *Jimlar* decision more on point because it involved a trade show, like the one at which Opposer displayed its mark.

⁴² *Id.* quoting *T.A.B. v. PacTel*, 37 USPQ2d at 1882-83.

of such efforts on potential customers.”⁴³ Applicant summarizes Opposer’s exposure of its mark to potential customers prior to Applicant’s filing date:

25,010 *Pet Business* subscribers in early July 2014;

22,987 people at the 2014 SuperZoo trade show later in July 2014;

25,010 *Pet Business* subscribers as of September 2014; and

12,025 *HomeWorld Business* subscribers as of September 15, 2014.⁴⁴

This evidence attempts to establish “where,” “when,” and “how many” people were exposed to the SNACK-DUO mark, Applicant notes, but “since it fails to make the ‘necessary association’ (*i.e.*, to connect the dots between these three (3) critical components or demonstrate any consumer identification whatsoever), Opposer’s evidence does not support more than an insubstantial or negligible use of and/or consumer exposure to the Snack DuO Mark, and therefore, is wholly insufficient to support its claim for analogous use.”⁴⁵

Unlike *Jimlar*, where the opposer displayed its mark at an industry trade fair or show and “orders for the goods followed relatively shortly thereafter,”⁴⁶ Applicant argues that there is scant evidence of early orders in the present case. After Opposer published its first SNACK-DUO advertisement in the July 2014 issue of *Pet Business*, five pet store retailers across the country inquired about the product, but “the sales records show that no sales were consummated with any of the five (5) potential inquirers from *Pet Business* magazine,” Applicant argues, and “[i]n any event,

⁴³ *Id.*

⁴⁴ *Id.* at 15, 32 TTABVUE 20.

⁴⁵ *Id.* at pp. 15-16, 32 TTABVUE 20-21.

⁴⁶ *Id.* at p. 18, 32 TTABVUE 23.

potential interest of five (5) consumers out of a pool of 25,010 potential readers is clearly insubstantial.”⁴⁷

Similarly, although 22,987 people participated in the SuperZoo trade show over several days later that July, according to Doug Poindexter, President of World Pet Association, which hosted the trade show, “Mr. Poindexter did not mention anything about Opposer at all, no less any specific details of Opposer’s alleged presence at the 2014 SuperZoo Trade Show, including, any discussion about the size, location or foot traffic associated with the Snack DuO Product and/or the 2014 SuperZoo Snack DuO Display.”⁴⁸ Applicant continues:

There is not one shred of evidence or testimony that anyone, no less potential purchasers, saw, commented on or otherwise expressed any interest in the Snack DuO Product or the 2014 SuperZoo Snack DuO Display during or after the 2014 SuperZoo Trade Show as a result of Opposer’s apparent efforts. Despite acknowledging that it is Opposer’s company objective to pursue sales at trade shows, ... Opposer’s employees could not recall a single sale that resulted during or after the 2014 SuperZoo Trade Show from Opposer’s promotion of the Snack DuO Products at the 2014 SuperZoo Trade Show. ... Opposer’s sales records confirm that no sales of Snack DuO Products occurred.⁴⁹

...

Here, unlike in *Jimlar*, any evidence of sales or prospective sales as a result of the 2014 SuperZoo Trade Show is clearly lacking. There is simply no proof that even one of the alleged 22,987 attendees of the 2014 SuperZoo Trade Show saw the 2014 SuperZoo Snack DuO Display and/or the Snack DuO Products, and then made any inquiry whatsoever, no less placed an

⁴⁷ *Id.* at p. 20, 32 TTABVUE 25 citing Musteen deposition ex 7, 28 TTABVUE 140-155 (confidential).

⁴⁸ *Id.* at 17, 32 TTABVUE 20 citing Poindexter dec., 14 TTABVUE 9-15.

⁴⁹ *Id.* at 16, 32 TTABVUE 21 citing Dennis dep 22:17-19, 23-25, 30:5-8, 33:4-9, 26 TTABVUE 25, 33, 36; Logan dep. 34:15-22, 27 TTABVUE 37; Musteen deposition 19:10-20:9, 22:19-22, 40:15-41:21, 44:15-48:6 and ex. 7, 28 TTABVUE 22-23, 25, 43-44, 47-51, 140-155 (confidential).

order for the Snack DuO Product, during or after the 2014 SuperZoo Trade Show....⁵⁰

Further, unlike *Jimlar*, Applicant stresses that “Opposer was not ready to ship Snack DuO Products at the 2014 SuperZoo Trade Show, as the goods displayed were non-functioning prototypes (as late as October 21, 2014, Opposer still did not have final production products) and Opposer did not ship its first Snack DuO Product until nearly six (6) months following the 2014 SuperZoo Trade Show.”⁵¹

As for Opposer’s SNACK-DUO advertisements in the September issue of *Pet Business* (circulation 25,010) and the September 15, 2014 issue of *HomeWorld Business* (circulation 12,025), Applicant insists that there is no indication of any interest, inquiries, or sales resulting therefrom.⁵² In fact, Applicant urges, the *HomeWorld* advertisement “promoted the Snack DuO Product for adults for the first time and employees from Opposer testified that this version of the Snack DuO Product (as opposed to Snack DuO Product for pets) was not as successful as Snack DuO Product for pets. ... It is not even clear when the first sale of the Snack DuO Product for adults took place, but it was well after the March 2015 Housewares Show.”⁵³

On the whole, then, Applicant concludes that this case is less like *Jimlar* than it is like *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215 (TTAB 2007). In *Westrex*,

⁵⁰ *Id.* at 18, 32 TTABVUE 23.

⁵¹ *Id.* at 17, 32 TTABVUE 20, citing Musteen dep. ex. 7, 28 TTABVUE 22-23, 25, 43-44, 47-51, 140-155 (confidential).

⁵² *Id.* at 20, 32 TTABVUE 23, citing Dennis dep. 30:13-33:9, 26 TTABVUE 33-36.

⁵³ *Id.* at 20, 32 TTABVUE 25 citing Dennis dep. 27:11-13, 30 TTABVUE 27; Musteen dep. 51:10-16, 29 TTABVUE 54.

the opposer claimed that its eleven years of pre-sales activity amounted to analogous trademark use. During that time, the evidence showed, it spent approximately \$50,000-\$60,000 in advertising expenditures creating artwork, packaging, and a web site; announcing the product launch on the web site; issuing a press release; promoting the tubes at trade shows; sending price list to prospective purchasers; and acquiring parts and equipment for the manufacturer of the tubes. *Id.* at 1218. After three years, it took one order, which was later cancelled. *Id.* It “took a bit of a hiatus” from its promotional activities for three years due to the Asian economic crisis. *Id.* Over the entire eleven-year timespan, it received nine sporadic emails from potential customers about its potential release date, which it repeatedly altered on its website, finally stating that it was “to be determined.” *Id.*

Based on this evidence, the Board determined that:

[T]he \$50,000-60,000 in advertising expenditures over an eleven-year time period are insufficient to establish that the necessary association or public identification was indeed created among more than “an insubstantial number of potential customers.” This is especially true given the absence of any indication as to the response, if any, received to any advertising (i.e. print ads, trade shows) unrelated to opposer’s web site. Thus, the Board is unable to draw the critical inference that the public identified the term GOLD LION as a source indicator for opposer’s goods by virtue of opposer’s pre-sale activities.

Id. at 1219.

Here, as in *Westrex*, Applicant argues, “Opposer has unquestionably failed to make the necessary minimum association required by *T.A.B Systems*.”⁵⁴

We agree with Opposer, however, that it has established priority by analogous use. It is not necessary that Opposer “connect the dots” by direct evidence, such as a

⁵⁴ *Id.* at 18, 32 TTABVUE 23.

survey. “The cases on analogous use have not required that the opposer proffer survey evidence or other direct evidence of the consuming public’s identification of the target word or phrase with the opposer as the source of a given product or service. Instead, the fact finder may infer the fact of identification on the basis of indirect evidence regarding the opposer’s use of the word or phrase in advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications.” *T.A.B. v. PacTel*, 37 USPQ2d at 1881. Nor is it necessary that each “dot” of evidence, taken separately, prove analogous use. “However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, 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 Florida Seafood, Inc., v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) *quoted in Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1150 (TTAB 2016).

In *Westrex*, on which Applicant relies, the pieces of evidence did not fit together into a cohesive whole. There, the opposer’s desultory marketing, marked by years-long gaps in its promotional efforts, extended over eleven years, during which time it continually postponed the date on which it would introduce its product, finally acknowledging, somewhat lamely, that the date was “to be determined.” 83 USPQ2d at 1218-9. After reviewing these facts, the Board concluded, “Lastly, we note that a significant time period (eleven years) elapsed between opposer’s pre-sale activities and first technical sale under the ... mark. Such a lengthy time period is not ‘commercially reasonable’ and indicates that opposer’s activities were far too sporadic to rise to the level of analogous use.” *Id.* at 1219. As Opposer states in its reply brief,

“Applicant’s citation to, for example, the *Westrex* case ... is misplaced. *Westrex* merely shows negligible exposure, a relatively small attempt at promotion spread over eleven years. *Westrex*, and the other cases cited by Applicant, are easily distinguishable on their facts from our situation, and merely illustrate again how much promotion is not enough.”⁵⁵ We agree.

Jimlar presented a more cohesive assemblage of the pieces of evidence, and a more commercially reasonable period of time between the opposer’s pre-sale activities and its commencement of sales. There, the opposer displayed footwear bearing its mark at a booth at a several-day trade fair attended by exhibitors and their potential clients, retailers. 24 USPQ2d at 1218. The Board found a commercially reasonable duration between the trade fair and its subsequent sales of the footwear:

While opposer has no records that any orders were taken for the Highland-style boot when it was first displayed at the trade fair in Manhattan, orders therefor were subsequently placed and the goods, in due course, were manufactured and shipped. The earliest documented purchase order and corresponding invoice are dated, respectively, January 5, 1988 and September 9, 1988.... Other invoices demonstrate that the earliest shipment of such goods was to Leroy’s Shoes and Clothing in Big Bear Lake, California on June 24, 1988.... Thus, during a period of between 16 and 17 months, shipments of the Highland-style boot bearing the patch with the “A CLUB” composite mark thereon were continuously made by opposer.

Id.

The opposer in *Jimlar* thus made technical use of its mark within six to nine months after displaying the mark to potential purchasers, and the Board accordingly found that “it has priority in view of a prior use analogous to trademark use which it can permissibly tack to its subsequent technical trademark use....” *Id.* at 1221.

⁵⁵ Opposer’s reply brief p. 9, 33 TTABVUE 14.

Here, Opposer promoted its SNACK-DUO mark more extensively than the opposer in *Jimlar*. Its initial advertisement in *Pet Business* was circulated to 25,010 recipients.⁵⁶ From across the country, initial inquiries about the ad for the Snack Duo came in, referring to the product by its brand name.⁵⁷ Jannah Grimes of Camping World, asked Opposer's Sales Director, Nick Musteen, "Could you quote the snack-duo? Looks like a neat item that our customers would get great use out of."⁵⁸ Her communications with Mr. Musteen were no doubt prompted by the *Pet Business* ad, as they began before the SuperZoo trade show, which she did not attend. Mr. Musteen was asked at his deposition:

Q. Camping World didn't come out of an order at that show, correct, because she wasn't there?

A. She wasn't there, no. It was off of trade publication.⁵⁹

These initial inquiries made in the couple of weeks after the first *Pet Business* advertisement are consistent with promotion of a new brand that garnered burgeoning attention. The *Pet Business* trade publication urged readers to visit Opposer's booth at the SuperZoo trade show later that month.⁶⁰ At the SuperZoo trade show, in which 22,987 people participated, Opposer displayed the SNACK-DUO product at its booth and in the new products section. Mr. Poindexter, president of World Pet Association, which hosted the SuperZoo trade show, specifically mentioned

⁵⁶ Logan decl. ex. A, 17 TTABVUE 4-7; Logan dep. 27 TTABVUE 53-56.

⁵⁷ Ex. F, Musteen decl. 30 TTABVUE 22-24.

⁵⁸ Ex C, Musteen decl. 15 TTABVUE 13.

⁵⁹ Musteen dep. 24:7-10, 29 TTABVUE 27; Musteen dep. 40:15-41:14, 29 TTABVUE 41.

⁶⁰ Logan decl. ex. A, 17 TTABVUE 4-7; Logan dep. 27 TTABVUE 53-56.

Opposer's participation as an exhibitor.⁶¹ Opposer's Sales Director, who was present at the trade show, was asked:

Q. Do you remember receiving any feedback from anybody at this show regarding the product and their interest in buying the product?

A. [after objection] It was the hit of the show. And mostly the display is what was great. That was the most talked about feedback.⁶²

Opposer's SNACK-DUO product garnered second prize for best new product in the category of "dog" products, showing that it indeed attracted the attention of attendees.⁶³ After the trade show, Jannah Grimes, Camping World's buyer, requested samples of the SNACK-DUO, which were sent, and projected Camping World's anticipated demand for the product, which would number in the hundreds, for the coming year.⁶⁴

As in *Jimlar*, Opposer does not have a record of orders taken for the SNACK-DUO during the SuperZoo trade show, but its publicity, augmented by its follow-up advertisements in *Pet Business* and *HomeWorld Business* in September 2014, resulted in substantial sales commencing in January 2015—comparable to the six-to-nine month time span between the *Jimlar* trade show and that opposer's initial sales.⁶⁵ The fact that more SNACK-DUO products are sold for pet use rather than human use makes little or no difference, as it is the same product under the same

⁶¹ Poindexter decl. ¶ 6, 14 TTABVUE 10.

⁶² Musteen dep. 26:9-16, 29 TTABVUE 29.

⁶³ Opposer's first notice of reliance, 13 TTABVUE 53.

⁶⁴ Musteen decl. ex. C, 30 TTABVUE 9-12.

⁶⁵ Musteen decl. ¶¶ 10, 11, 15 TTABVUE 4 (confidential).

mark, with pet and non-pet hang tags.⁶⁶ As Opposer puts it in its reply brief, “[T]he ultimate proof of success is the steady and extensive stream of sales beginning in 2015, six months after the product debut in July, 2014. ... Those customers must have heard about the product somewhere.”⁶⁷

Hence, in this case, the evidentiary “dots” can be connected like pieces of a puzzle. *See West Florida Seafood v. Jet Restaurants*, 31 USPQ2d at 1663. Based on the record evidence, we find that Opposer’s public exposure of the SNACK-DUO mark created and cultivated the necessary association of that mark with Opposer’s product among more than an insubstantial number of the purchasing public. *T.A.B. v. PacTel*, 37 USPQ2d at 1883. Protection of that association, otherwise known as goodwill, is consistent with both the language and purpose of the Lanham Act. *See Matal v. Tam*, ___ U.S. ___, 137 S. Ct. 1744, 122 USPQ2d 1757, 1762 (2017) (quoting *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U. S. 189, 224 USPQ 327, 331 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers”). Opposer has established priority by analogous use.

B. Transport of Samples

Additionally, Opposer contends that it should prevail on priority because it commenced technical use of its mark when it shipped two samples of the SNACK-

⁶⁶ Dennis decl. ¶ 2, 16 TTABVUE 2; Dennis dep. 25:2-13, 25 TTABVUE 28.

⁶⁷ Opposer’s reply brief p. 9, 33 TTABVUE 14, citing Musteen Dec. Ex. K at 15 TTABVUE (filed under seal).

DUO product to Camping World, one on September 30, 2014 and the other on November 19, 2014.⁶⁸ The shipments resulted from the ongoing colloquy between Camping World's buyer, Jannah Grimes, and Opposer's Sales Director, Nick Musteen:

- On August 20 she inquired, "Nick Do you have a sample of the Snack Duo that we could review? We would like to see it in blue. I know you stated it wouldn't be available until September/October- we are just wanting to review a sample. We wouldn't be adding until 2015."

He responded that day, "I'll put this on the top of my list for tomorrow's meeting. We only had a couple of samples, but had several more that were supposed to be coming in. I'll have you an answer by tomorrow afternoon."

- She prompted him on September 16, "Following up to see if you have a sample of the Snack Duo available yet? Please send along if so."

He responded that day, "Not yet. We will have an executable plan for it within the week. I will keep you posted."

- On September 23, she followed up, "Just wanting to stay on top of this as we are trying to finalize this line review. We need to see a sample before committing on adding. We have discussed and would rather do the Snack Duo vs the HDuo, but have held onto the HDuo awaiting the Snack Duo sample. (that was a mouthful..) Please let me know ASAP when a sample will be available to send."

He responded that day, "I've ordered a specific sample for you specifically. The ones we have apparently aren't functional prototypes. Only for Design."⁶⁹

- A week later, on September 30, she wrote, "I know you stated below that you ordered us a sample. Do you know the ETA?"

⁶⁸ Opposer's brief pp. 19-20, 31 TTABVUE 25-26.

⁶⁹ Ex. C to Musteen decl., 15 TTABVUE 9-10, 12.

He responded that day, “I have a Functional working first strike off sample heading out to you first thing in the morning. It is a Clear Sample, one we used to approve the tooling or make changes. Is that OK to send?”⁷⁰

Opposer shipped out the first sample to Camping world on or about that day, according to the Musteen declaration: “On or around September 30, 2014, Dexas shipped its first sample unit of the Snack-DuO product to ... Camping World, whose email chain is Exhibit C. The unit was shipped interstate, from Dexas’ headquarters in Coppell, TX, to the retailer Camping World located in Bowling Green, KY. This sample unit included a prototype hangtag which included the Snack-DuO trademark.”⁷¹

On October 10, 2014, Ms. Grimes confirmed: “We received the sample. Can you fill out the new item form attached and send images of the Snack Duo in blue and copy points?”

- She followed up on October 21: “Any update? I would like to have all items setup by November so we can get orders placed. Also need copy points and images. Do you know when we can expect a final sample of the SnackDuo in blue? We have to have by the beginning of December for this planogram set.”

He responded that day: “Camping World has become top priority in getting out the Snack Duo. (Not kidding! You all are going to get it FIRST!) I am airing in the pieces and we will be assembling them here in Dallas. I will have all of the weights, copy and final labels [hang tags] by Friday of this week. If the Lids we received yesterday are officially approved today, I can send you out a final production sample this week.”⁷²

Mr. Musteen avers that the second sample was shipped to Camping World on November 19 and received on November 20, 2014.⁷³ Asked to explain the delay in sending Camping World the samples, Mr. Musteen testified:

Q. ... Do you recall looking at this e-mail chain from Exhibit C, you know, why it took so long to get the actual samples?

A. She had to have blue.

⁷⁰ Musteen decl. ex. C, 30 TTABVUE 9-12.

⁷¹ Musteen decl. ¶ 6, 30 TTABVUE 3.

⁷² Musteen decl. ex. C, 30 TTABVUE 7-8.

⁷³ Musteen decl ¶ 7, 30 TTABVUE 3; Musteen dep. 42:21-23, 29 TTABVUE 45.

Q. That was it?

A. (Moving head up and down.)

Q. You had other colors?

A. We had a purple. We did -- we had a lot of purple left. But she specifically needed this -- that blue.⁷⁴

After receiving the samples, “Camping World did in fact place an order for Snack-DuO, as reflected in its Purchase Order of December 18, 2014 (Exhibit I), requesting delivery by February 16, 2015. Camping World has reordered the product many times since then,” Mr. Musteen declared.⁷⁵

Applicant argues that “the final production sample sent to Camping World was not paid for by Camping World and Camping World did not issue a purchase order for Snack DuO Products until December 18, 2014 (after Applicant’s Priority Date, which is December 5, 2014) for shipping in February, 2015.”⁷⁶ The Trademark Act specifies, though, that a trademark shall be deemed to be in use in commerce when the goods bearing the mark “are sold or transported in commerce.” 15 U.S.C. § 1127 (emphasis added). As the Federal Circuit has explained, “The statute is clear that the actual sale of goods is not required to satisfy § 1127’s ‘use in commerce’ requirement, provided that the goods are ‘transported’ in commerce.” *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 103 USPQ2d 1672, 1675 (Fed. Cir. 2012). “It is well

⁷⁴ Musteen dep. 31:22-32:7, 29 TTABVUE 34.

⁷⁵ Musteen decl. ¶ 9, 30 TTABVUE 3, ex. K, 15 TTABVUE 30-79 (confidential).

⁷⁶ Applicant’s brief p. 26, 32 TTABVUE 31. Applicant also argues that Opposer did not plead technical use in commerce as a basis for priority, Applicant’s brief pp. 23-24, 32 TTABVUE 28-29, but the amended notice of opposition clearly claims that “Opposer has nevertheless since July, 2014 continuously used in commerce the trademark SNACK-DUO (hereinafter referred to as ‘Opposer’s Mark’) for food and drink containers, by affixing the mark to the goods, ... and transporting the goods across state lines.” Amended notice of opposition ¶ 3, 7 TTABVUE 3.

settled that goods do not have to be sold in commerce in order to come within the ambit of the statute. The statute states that a mark is ‘used in commerce’ when it is placed on the goods and the goods are either ‘sold or transported in commerce.’” *McDonald’s Corp. v. McKinley*, 13 USPQ2d 1895, 1898 n. 6 (TTAB 1989) (priority of use may be attained by either the sale or gift of promotional items, such as toys offered as promotions by a quick-service restaurant). See 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:118 (5th ed. June 2018 update) (“distribution of free samples of a new product may also qualify as a ‘transportation.’”).

Opposer, citing *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1774 (Fed. Cir. 1987), maintains that a single interstate shipment of goods bearing a mark may be sufficient to support an application to register the mark, provided that the shipment has the color of a bona fide transaction and is followed by activities to place the product on the market on a commercial scale.⁷⁷ Applicant argues that reliance on *Hydro-Dynamics* is misplaced, and cites *Brinkmann Corp. v. Optronics, Inc.*, 211 USPQ 653, 659 (TTAB 1981) for the proposition that “A higher commercial use standard than that required for the purpose of laying a foundation for registration has been held to be necessary where, as here, two competing parties claim a right of ownership in the same or a similar mark for like goods.”⁷⁸

⁷⁷ Opposer’s brief pp. 19-20, 31 TTABVUE 25-26.

⁷⁸ Applicant’s brief p. 25, 32 TTABVUE 30.

Both of those decisions predated the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, which amended the Trademark Act to provide that: [t]he term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127; *see Christian Faith Fellowship Church v. adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1642 (Fed. Cir. 2016). The primary purpose of the TLRA amendment was to eliminate the practice of token use, or use made solely to reserve rights in a mark, and to substitute a new standard that instead contemplates “commercial use of the type common to the particular industry in question.” *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 (TTAB 1994) (reviewing the legislative history), *aff’d without published opinion, White v. Paramount Pictures Corp.*, 108 F.3d 1392 (Fed. Cir. 1997) (opinion available at 1997 WL 76957). Under this standard, “[u]se in commerce should be interpreted with flexibility to account for different industry practices.” *Id.*

Determining whether the distribution of free samples to prospective purchasers constitutes bona fide use of a mark in the ordinary course of trade is a very fact-intensive inquiry. “Depending on the particular facts and industry practice, some types of promotional activities, such as distributing samples, may qualify as use in commerce.” *Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017). The facts in *Tao* exemplify how distribution of free samples may, in a particular case, fall short of constituting use in commerce. In that case, a cancellation proceeding, one issue was whether the respondent, an importer of alcoholic beverages, had actually used its TAO mark in commerce prior to filing its statement of use. The respondent claimed it had distributed two to three complimentary sample

bottles of TAO VODKA to three parties—a shareholder, a restaurant across the street, and a distributor—to allow them to evaluate the product. *Id.* at 1050-52. The Board questioned the credibility of the respondent’s witness, who lacked documentation of this claimed distribution, and found that its “sharing of these samples with the three parties was more in the nature of a preliminary advisory consultation than bona fide use of the TAO VODKA mark in the ordinary course of trade.” *Id.* at 1055. “[T]his activity was preliminary and exploratory, and Respondent was not yet ready to introduce the product in the ordinary course of trade.” *Id.* at 1054. The respondent admitted that none of the three entities to which it distributed the samples ever sold a single bottle of TAO vodka. *Id.* at 1051. “The absence of any sales whatsoever under the mark for more than 2 years following Respondent’s sample-related activities underscores their preliminary nature.” *Id.* at 1055. The Board concluded “We find that the record as a whole reflects that Respondent was not yet using or even ready to use the mark in the ordinary course of trade, but was merely exploring such use at some point in the future.” *Id.*

In contrast, *Tao* cites *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1981 (TTAB 2010) as an example of how distributing samples to a prospective purchaser may qualify as use in commerce. *Tao v. Bender*, 125 USPQ2d at 1053. In that case, Automedx sold demonstration units of portable medical ventilators that were not yet approved for human use to the U.S. military so that the military could test and evaluate them before committing to a larger purchase of the ventilators for human use. *Automedx v. Artivent*, 95 USPQ2d at 1980-82. The Board reviewed the legislative history of the statutory standard “bona fide use of a mark in the ordinary course of trade,” and stated, in accord with *Paramount v. White*, that “Use in commerce should

be interpreted with flexibility to account for different industry practices.” *Id.* at 1981.

The Board reasoned:

If the sales at issue were made for legitimate marketing or other commercially reasonable reasons in the ordinary course of trade (i.e., genuine use of the mark), then we must find that the sales constitute bona fide use of the mark in commerce.

Based on the testimony and evidence of record, we find that opposer’s April 2005 and August 2006 sales of the ventilators to the military were for legitimate business reasons (i.e., to test and refine the portable ventilators) and not merely to reserve the right to register the marks.

Id. at 1982.

Although *Automedx* involved a test sale, rather than a free distribution of the product, that is not a material distinction. As we have observed above, the statute provides in the disjunctive that sale or transport of goods may constitute use in commerce, and distribution of goods without sale may so qualify. *See, e.g., Lens.com*, 103 USPQ2d at 1675.

In the present case, we have recounted the communications between Opposer and Camping World’s buyer in some detail above because they show how this case is more similar to *Automedx* than it is to *Tao*. Camping World, a retailer capable of selling the product to the consuming public, already had an established relationship with Opposer, having purchased and sold Opposer’s HDuo product at retail.⁷⁹ After Opposer publicized its new SNACK-DUO line in *Pet Business*, Camping World’s buyer inquired about it.⁸⁰ The buyer not only initiated the dialogue about the product, but repeatedly requested samples of the SNACK-DUO product, asking for it by its brand name.⁸¹ Applicant argues that the second sample, sent in November 2014, was

⁷⁹ Musteen dep. 26:20-28:8, 29 TTABVUE 29-31.

⁸⁰ Musteen dep. 27:4-20, 29 TTABVUE 30.

⁸¹ Musteen decl. ex. B, 30 TTABVUE 7-13.

a “production sample” defined in the trade as “the final approved version of a style produced by whomever is doing production. Often a production test run is done and the output is gauged for quality and the samples ideally used for marketing, promotion, pre-sales and perhaps trunk sales.”⁸² That, however, is consistent with Opposer’s pre-sale use of the samples, which were more suitable for use than the test samples in *Automedx*. Furthermore, according to Opposer’s sales director, Opposer already had the product ready, but had to produce a blue one to the buyer’s specification.⁸³ Applicant argues that “It is alleged that Opposer applied a hang tag bearing the Snack DuO Mark to the “final production sample”, but this is not clear from any documented evidence other than testimony by Mr. Musteen that this actually occurred.”⁸⁴ We find, however, that Mr. Musteen’s testimony is credible and consistent with the documentary evidence. Upon receiving the samples, Camping World promptly ordered the product in the hundreds, and has since then continued buying the product wholesale and selling it at retail. Thus, as in *Automedx*, the samples served a legitimate commercial purpose, as part and parcel of the process by which Opposer’s product would enter the marketplace. We find that this is bona fide use of the mark in the ordinary course of trade, and not merely to reserve a right in the mark. 15 U.S.C. § 1127. Opposer has consequently established priority through

⁸² Applicant’s brief p. 26, 32 TTABVUE 31 quoting the Fashion-Incubator, a specialty encyclopedia for manufacturers, www.Fashion-Incubator.com/the-13-different-kinds-of-samples/. At Applicant’s request, we take judicial notice of this definition. See *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011).

⁸³ Musteen dep. 31:22-32:7, 29 TTABVUE 34-35.

⁸⁴ Applicant’s brief p. 26, 32 TTABVUE 31.

technical use in commerce.

C. Applicant's Arguments

Even though the aforementioned evidence indicates that Opposer has established prior proprietary rights in SNACK-DUO by analogous use and technical use of the mark in commerce, Applicant nonetheless maintains (1) that Opposer has not established that it owns a protectable trademark, and (2) that Applicant has priority through tacking of its SNACKEEZ mark. We examine each argument in turn.

1. Whether Opposer Owns a Protectable Trademark

Applicant contends that “Opposer’s purported Snack DuO Mark “is simply a combination of commonly used English words (‘snack’ and ‘duo’), which are inherently descriptive as applied to the Snack DuO Product—a dual chamber product intended to house two things,” so absent proof of acquired distinctiveness prior to Applicant’s filing date, “Opposer has failed to establish trademark rights in the Snack DuO Mark prior to Applicant’s Priority Date.”⁸⁵

We perceive two problems with Applicant’s position. First, this defense was not raised until it filed its brief. In a similar case, where the defense that the opposer lacked proprietary rights in its common law mark was neither pleaded nor tried, and was raised for the first time in the applicant’s final brief, the Board gave no consideration to the defense:

Applicant contends that opposer’s mark is geographically descriptive and further that opposer has failed to prove that its mark has acquired secondary meaning.

* * *

The problem with applicant's contention that opposer lacks proprietary rights is that this argument is raised for the very first time in this case in

⁸⁵ Applicant’s brief p. 10, 32 TTABVUE 15.

the final brief. Applicant's claim was not pleaded as an affirmative defense in its answer, and applicant did not introduce any testimony or evidence on its claim at trial. While applicant's allegations, if proved, might constitute a good defense and warrant a different result in this case, applicant's defense was never joined as an issue in this proceeding and the issue was never tried, either expressly or implicitly, by the parties. To allow applicant to interject its defense for the first time at final hearing would constitute an undue surprise for opposer who had no notice until well after trial that the defense would be raised by applicant.

The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715, 1717 n. 5 (TTAB 1991); *see also Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (absent argument or evidence from applicant, opposer's mark deemed distinctive).

Here, Applicant did not raise this defense in its pleadings, during discovery, or at trial. Aside from the assertion of descriptiveness in its brief, quoted above, Applicant adduced no evidence in support of this assertion, in the form of dictionary definitions, third-party registrations, third-party usage, or other forms of evidence available to prove descriptiveness. *See In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)) (evidence of descriptiveness "may be obtained from any competent source, such as dictionaries, newspapers, or surveys."); *see also RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1812 (TTAB 2018) ("Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade, industry, or ordinary parlance," (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015))). Instead, Applicant treated SNACK-DUO as Opposer's trademark, as evidenced by its discovery responses:

H. “Snack-DuO Product” means Opposer’s food and drink container marketed and sold under the trademark SNACK-DUO.

I. “SNACK-DUO Mark” means Opposer’s unregistered trademark used in connection with its Snack-DuO Product.⁸⁶

Accordingly, this defense, raised for the first time in Applicant’s final brief, will be given no consideration.

Second, for purposes of completeness, we find that Opposer’s SNACK-DUO mark is suggestive with respect to its goods, and thus inherently distinctive. *See In re North Carolina Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017); *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010). There is but a thin line of distinction between suggestive and merely descriptive terms, and distinguishing between the two is often difficult. *See, e.g., Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004); *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). 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). On the other hand, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012).

Although the line of distinction is fine, we find that Opposer’s mark falls on the side of suggestiveness; it does not immediately convey knowledge of its feature or function; rather, it suggests indirectly, by terms requiring thought and perception,

⁸⁶ Applicant’s response to Opposer’s first Requests for Admissions and Interrogatories, 13 TTABVUE 58; 32 TTABVUE 42.

that the product to which it is affixed is a container comprising two chambers, one of which might be used to carry food, while the other might be used to carry something else, such as a beverage. Applicant's mark contains the same elements, SNACK and DUO, adding only the suffix EEZ, yet it was not required to disclaim any of those elements as descriptive; and Applicant has called Opposer's mark a "trademark." Moreover, the buyer for Camping World clearly treated SNACK-DUO as a trademark, calling for the product by Opposer's brand name, and distinguishing it from another of Opposer's products, the HDuO. The mark thus serves the function of a trademark, identifying Opposer's goods and distinguishing them from those manufactured or sold by others. 15 U.S.C. § 1127. We conclude that Opposer's mark is suggestive and therefore inherently distinctive.

2. Whether Applicant Can Gain Priority By Tacking

In its brief, Applicant claims that it can gain priority by tacking its SNACKEEZ DUO mark to its SNACKEEZ mark, which registered on the Principal Register on May 20, 2014, before Opposer's dates of first analogous or technical use.⁸⁷ The Supreme Court described tacking succinctly in *Hana Financial*:

Recognizing that trademark users ought to be permitted to make certain modifications to their marks over time without losing priority, lower courts have provided that, in limited circumstances, a party may clothe a new mark with the priority position of an older mark. This doctrine is called 'tacking,' and lower courts have found tacking to be available when the original and revised marks are 'legal equivalents' in that they create the same, continuing commercial impression.

Hana Fin., Inc. v. Hana Bank, 135 S. Ct. 907, 113 USPQ2d 1365, 1366 (2015) *quoted*

⁸⁷ Registration no. 4534742 for "household and travel food containers, namely, food and beverage containers" in International Class 21, application filed on May 24, 2013; Applicant's brief pp. 11-14, 32 TTABVUE 16-19; Lombardo decl. ¶ 6, ex. A, 24 TTABVUE 3, 8-11.

in Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U., 797 F3d 1363, 116 USPQ2d 1129, 1132 (Fed. Cir. 2015).

Opposer contends that Applicant cannot rely on tacking to gain priority for two reasons: first, because Applicant did not plead tacking as an affirmative defense, and second, because SNACKEEZ and SNACKEEZ DUO are not legal equivalents. With respect to the first reason, Opposer states that “The TBMP is crystal clear that tacking is a defense which must be affirmatively pleaded.”⁸⁸ Yet here, “While the Answer contains a number of affirmative defenses, conspicuously absent is the defense of tacking....”⁸⁹ Applicant raised the tacking defense in its trial brief, forcing Opposer to respond in its reply brief. As a consequence, Opposer contends that tacking is an unpleaded and untried affirmative defense, which is therefore waived.

Applicant does not argue that its Answer pleaded tacking. It argues instead that its answers to interrogatories “indicated its intention to rely upon the Snackeez Mark’s priority date of September 2013 [its stated date of first use] and Snackeez DUO Mark’s priority date of December 5, 2014....”⁹⁰ Those answers are as follows:

INTERROGATORY NO. 1: State the date Applicant asserts as its priority date in this Opposition.

RESPONSE: Subject to, and without waiving the General Objections above, Applicant states that the SNACKEEZ Mark has a date of first use of September 2013 and the SNACKEEZ DUO Mark has a constructive date of first use of December 5, 2014.

⁸⁸ Opposer’s reply brief p. 2, 33 TTABVUE 7 citing TBMP 311.02(b) n. 15, TBMP 311.02(c) n. 1, and TBMP 314 n. 3 and authorities cited therein.

⁸⁹ Opposer’s reply brief p. 2, 33 TTABVUE 7, referring to Applicant’s Answer to the first amended notice of opposition, 9 TTABVUE.

⁹⁰ Applicant’s brief p. 12 n. 3, 32 TTABVUE 17.

INTERROGATORY NO. 2: State whether Applicant will rely on a first actual use date or the constructive use date of December 5, 2014 to establish priority over Opposer.

RESPONSE: Subject to, and without waiving the General Objections above, Applicant will rely upon both dates identified in response to Interrogatory No. 1. Applicant also objects to the terms “actual use” as having no defined or understood meaning.

INTERROGATORY NO. 3: If the response to the preceding Interrogatory 2 was to rely on a first actual date, state the first actual use date and describe the acts that constitute the first actual use.

RESPONSE: Subject to, and without waiving the General Objections above, Applicant relies upon the first use date of its SNACKEEZ Mark on Snackeez Products and continuous, uninterrupted use of its SNACKEEZ Mark thereafter on Snackeez Products and substantial sales, marketing and promotions of Snackeez Products bearing the SNACKEEZ Mark through today. Applicant also objects to the terms “actual use” as having no defined or understood meaning.

INTERROGATORY NO. 4: State the facts Applicant alleges are sufficient to establish that Applicant has priority of rights in and to the mark at issue in this Opposition.

RESPONSE: Subject to, and without waiving the General Objections above, this Interrogatory is objected to on the grounds it seeks Applicant’s legal argument and a legal conclusion.

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Applicant also maintains that it “indicated its intention to re[]ly on the Snackeez Mark’s priority date of September 2013 and Snackeez DuO priority date of December 5, 2014 (i.e., Applicant’s Priority Date) in its Motion to Dismiss (4 TTABVUE).”⁹²

⁹¹ Applicant’s answers to Interrogatories 1-4, attached to Applicant’s brief at 32 TTABVUE 47-48. While such material is untimely to be considered part of the record, we consider it in the context of Applicant’s argument that the pleadings have been amended by implied consent to include this affirmative defense.

⁹² Applicant’s brief p. 12 n. 3, 32 TTABVUE 17.

Opposer responds that “Applicant’s reference to a few inconsistent and confusing discovery responses, and the mooted Motion To Dismiss ... does not excuse the failure to plead tacking nor amount to notice to Opposer that tacking was an issue to be tried.”⁹³ We agree. “[T]acking’ is a defense that must be pleaded to put opposer on notice of new matter that applicant is placing at issue (i.e., a mark previously used by applicant that is the legal equivalent of applicant’s opposed mark, and that provides the basis for applicant to claim prior use).” *H.D. Lee Co., Inc. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008); accord *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271,1276 (TTAB 2009). Here, Applicant failed to plead the affirmative defense of tacking. Its ambiguous references to its prior registration, made in the course of discovery and its motion to dismiss, in no way contended that its registered and applied-for marks were legal equivalents, creating the same, continuing commercial impression. They were insufficient to put Opposer on notice of a tacking defense. See *Productos Lacteos Tocumbo S.A. de C.V.v. Paleteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (unpleaded affirmative defenses of prior registration defense and tacking not considered), aff’d 188 F. Supp. 3d 22, 57 (D.D.C. 2016). Consequently, the unpleaded defense of tacking cannot be relied upon by Applicant and will not be considered. See *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d at 1717 n. 5; TBMP §§ 311.02(c), 314 (June 2018) (“an unpleaded defense cannot be relied upon by the defendant unless the defendant’s pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.”).

⁹³ Opposer’s reply brief p. 3, 33 TTABVUE 8.

Moreover, even if the defense had been properly pleaded, we find that Applicant would not be able to tack its registered mark to its applied-for mark for purposes of gaining priority. The standard for tacking is very strict and tacking in general is permitted only in “rare instances,” *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991); *Wet Seal v. FD Mgmt.*, 82 USPQ2d at 1635. “[T]he standard of legal equivalence used in reviewing efforts to ‘tack’ the prior use of one mark onto that of another is higher than that used in evaluating two competing marks. ... [E]ven if the two marks are confusingly similar, they still may not be legal equivalents.” *Van Dyne-Crotty*, 17 USPQ2d at 1868. To meet the legal equivalents test, two marks must “create the same, continuing commercial impression so that consumers consider both as the same mark.” *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1768 n. 8 (TTAB 2015) (quoting *Hana Financial*, 113 USPQ2d at 1367); *see also In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010).

Applicant’s addition of the word DUO to SNACKEEZ differentiates the applied-for mark from its registered predecessor not only in sight and sound, by adding a two-syllable suffix, but in connotation and commercial impression, by suggesting the dual nature of its product. Applicant admits that it released the SNACKEEZ DUO product as part of its “line extension efforts,”⁹⁴ not as a continuation of the same branded product line. As Opposer observes, “The marks here are different enough that Applicant decided to file an application to register SNACKEEZ DUO, even though SNACKEEZ was already registered. Why apply to register SNACKEEZ DUO if it is

⁹⁴ Applicant’s brief p. 13, 32 TTABVUE 18.

legally the equivalent of SNACKEEZ?”⁹⁵ The addition of one word can make a very big difference in commercial impression. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989) *aff'd*, unpublished op, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) (even where both marks “are dominated by the word AMERICAN and the same star and double bar design,” AMERICAN MOBILEPHONE and design and AMERICAN MOBILEPHONE PAGING and design found to be “legally different”) *cited in* 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:26 (5th ed. June 2018 update). That holds true here.

For these reasons, we find that Applicant’s registered and applied-for marks are not legal equivalents, creating the same, continuing commercial impression. Consequently, Applicant cannot rely on tacking for purposes of gaining priority, and must rely instead on its constructive use date of December 5, 2014—a date over which Opposer has established its priority.

IV. Likelihood of Confusion

“Lord, give us the wisdom to utter words that are gentle and tender, for tomorrow we may have to eat them.” — Morris K. Udall.

When Applicant learned of Opposer’s SNACK-DUO product, its counsel sent Opposer a sternly-worded letter in March 2015 reciting its rights in SNACKEEZ and SNACKEEZ DUO, and demanding “that you cease and desist any and all advertising, marketing, use and sale of the SNACK DUO Infringing Product. We also demand that no later than ten (10) days from the date of this letter, confirm in writing that all importation, exportation, manufacture (domestic and foreign), offering for sale,

⁹⁵ Opposer’s reply brief p. 5, 33 TTABVUE 10.

sale, distribution, advertising, promotion and display of the infringing goods has ceased.”⁹⁶ Now that Opposer has opposed registration of Applicant’s SNACKEEZ DUO mark, claiming (and establishing) priority, Applicant contends that its applied-for mark can coexist with Opposer’s SNACK-DUO mark with no likelihood of confusion. The irony of this backpedaling is not lost on either party.

Applicant argues that its cease and desist letter “did not unequivocally state that there was a likelihood of confusion, only that the Snack DUO Product ‘infringes upon’ [Applicant’s] intellectual property rights, and, as such the Warning Letter is by no means conclusive evidence of any likelihood of confusion.”⁹⁷ Applicant cites two nonprecedential Board decisions in support of this position, *Karma Ath., Ltd. v. Kallmann*, 2015 TTAB LEXIS 562 (TTAB 2015) and *Computer Geeks, Inc. v. Compgeeks.com*, 2010 TTAB LEXIS 303 (TTAB 2010).

Both of those decisions cited the precedential Board decision *Ultra Elecs., Inc. v. Workman Elec. Prods., Inc.*, 192 USPQ 497 (TTAB 1976), in which the respondent caused a letter to be sent to the petitioner charging the petitioner with infringement of the respondent’s mark, “it being expressly asserted by respondent that confusion in trade would result from contemporaneous use of their marks.” *Id.* at 497. When the petitioner petitioned to cancel respondent’s registration, the respondent changed its tune, categorically denying the petitioner’s allegation of likelihood of confusion. *Id.* The petitioner “moved for summary judgment on the ground that respondent, by

⁹⁶ Applicant’s counsel’s March 11, 2015 correspondence to the president of Opposer, in Opposer’s notice of reliance, 13 TTABVUE 67, authenticated in Applicant’s responses to Opposer’s Requests for Admission nos. 4 and 5, 13 TTABVUE 65.

⁹⁷ Applicant’s brief p. 28, 32 TTABVUE 33.

virtue of the admission of likelihood of confusion set forth in its letter, is estopped in the instant proceeding to deny likelihood of confusion....” *Id.* at 497-98. The Board held:

a letter of infringement in which a party expresses the view that there is likelihood of confusion between its mark and that of the adverse party is not necessarily controlling on the question of likelihood of confusion. However, the admission contained in the letter may be a persuasive factor in resolving any doubts which may exist concerning the likelihood of confusion.

Id. at 498. In view of the facts of that case, including the cease and desist letter, the Board granted the petitioner’s motion for summary judgment and directed that the respondent’s registration be cancelled. *Id.*

We employ the same standard. We will consider Applicant’s cease and desist letter as relevant to, though not controlling on, the question of likelihood of confusion as we consider the applicable factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (the “*DuPont* factors”). Applicant’s letter describes its claimed trademark rights in the SNACKEEZ and SNACKEEZ DUO marks, among other asserted intellectual property rights, alleges that Opposer’s SNACK-DUO product infringes those rights, and unequivocally demands a cessation of use, all of which presupposes a likelihood of confusion. Hence, we will consider the letter to the extent it informs our determination of the applicable *DuPont* factors.

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on an analysis of all of the probative facts in evidence that are relevant to the *DuPont* factors, *id.* at 567, cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. ___, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We

have considered each relevant *DuPont* factor for which there is evidence or argument, and have treated the other factors as neutral. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *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) (factors “may play more or less weighty roles in any particular determination”); *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. *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002)) (“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.’”); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)).

A. Similarity of the Marks

We turn to the first *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety 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); *Palm Bay Imports, Inc. v.*

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968); *In re Inn at St. John's, LLC*, No. 126USPQ2d 1742, 1746 (TTAB 2018).

As Opposer correctly notes, the marks are nearly identical.⁹⁸ Applicant seeks registration of SNACKEEZ DUO and Opposer has prior rights in SNACK-DUO. Both marks follow the same structure, beginning with the same lead element, SNACK, and ending with the same element, DUO.

Applicant argues that “Visually, as evidenced by the below side-by-side depictions, the respective marks are clearly distinguishable.”



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⁹⁸ Opposer’s brief p. 24, 31 TTABVUE 30.

⁹⁹ Applicant’s brief p. 29, 32 TTABVUE 34.

However, Applicant has applied for a standard character mark, which may be displayed in “any particular font style, size, or color,” 37 CFR § 2.52(a) including the same font, size, and color as Opposer’s mark. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). Moreover, “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. v. Triumph Learning*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) *quoted in In re i.am.symbolic, LLC*, 123 USPQ2d at 1748. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). Consumers encountering the parties’ marks are likely to first notice the identical lead term, SNACK, *see Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (noting that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”), reinforced by the identical end term DUO.

The only difference between the marks is that Applicant’s mark follows SNACK with EEZ, and Opposer’s mark inserts a hyphen. Applicant suggests that its suffix EEZ “can be extended as long as the speaker would like to extend the “eeeeeeez” sound,” and is intended to reflect the “ease” of carrying a drink and snack for a child.¹⁰⁰ But if consumers notice that difference at all, they are likely to perceive one mark as an extension of the other’s product line. “[C]areful purchasers who do notice

¹⁰⁰ Applicant’s brief p. 30, 32 TTABVUE 35.

the difference in the marks will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source.” *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014). Similarly, the hyphen in Opposer’s mark does not distinguish it from Applicant’s mark. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464 (TTAB 2016) (finding MINI-MELTS and MINI MELTS similar). In short, the minor middle elements sandwiched between SNACK and DUO are not so prominent as to diminish the strong similarity engendered by the identical elements that begin and end both marks.

Those identical elements, SNACK and DUO, suggest the same connotation and commercial impression: that of a container with two sections, one for food, the other for something else, such as a beverage. Applicant argues that “the significance of a mark is not determined in the abstract, but in connection with the goods to which the mark is applied and the context in which it is used because that is how purchasers encounter the mark.”¹⁰¹ But as we shall see *infra*, both parties’ goods perform the same or similar function. Applicant’s product packaging, shown above, states “SNACKEEZ DUO! Drink & Snack Cup in One!”¹⁰² Opposer advertises “SNACK-DUO. One Drink. One Snack. Same Bottle.”¹⁰³ So if the parties’ marks are viewed in

¹⁰¹ Applicant’s brief p. 30, 32 TTABVUE 35, citing *Presto Prods. v. Nice-Pak Prods.*, 9 USPQ2d at 1897. Applicant also contends that “The ‘duo’ portion of Opposer’s Snack DuO Mark also has another meaning to consumers since it is a play on Opposer’s earlier released two chambered drinking product marketed under the name HDuO (a name meant to look and sound like H2O).” *Id.* But that interpretation is consistent with an extension of Opposer’s product lines from HDuO to SNACK-DUO; it does not mitigate the similarity of the parties’ marks in connotation or commercial impression.

¹⁰² See product image accompanying footnote 99.

¹⁰³ See product images accompanying footnotes 29, 30, 31, 34.

the context of their goods, as purchasers would view them, they would convey the same meaning and commercial impression.

Thus, considering the marks in their entireties, we conclude that the marks are more similar than dissimilar. Applicant evidently came to the same conclusion upon learning of the SNACK-DUO product, as evinced by its cease and desist letter to Opposer. This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Relatedness of the Goods, Channels of Trade, and Classes of Customers

Under the second and third *DuPont* factors, we consider “[t]he similarity or dissimilarity and nature of the goods” and of “established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. The second factor “considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods....’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014). When the marks are extremely similar, as they are here, it is only necessary that there be a viable relationship between the goods to support a finding of likelihood of confusion. *In re Concordia Int’l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Both parties’ goods perform the same or similar function of holding a snack and a drink in one container. Although the parties’ containers look different (Applicant’s consisting of a disposable container holding the snack above the beverage, and Opposer’s consisting of a reusable plastic container with side-by-side chambers holding the snack next to the beverage), the issue is not whether consumers would be likely to confuse the goods, but rather whether they would be likely to be confused as to their source. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); *In re I-Coat Company, LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018).

Likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’ *Id.*” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). As noted above, given the similarity in the parties’ marks and goods, one party’s product would tend to be seen as a variation of the other, suggesting another product line emanating from the same source. *See In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

Applicant evidently believed the parties’ products were similar, judging from its cease and desist letter alleging that Opposer’s SNACK-DUO product infringed its trademark rights. Yet now, citing testimony of Opposer’s witnesses, Applicant argues that “the Snackeez DUO Product and Snack DuO Product are not similar or competitive. ... Applicant’s Snackeez DUO Product is designed for use by children, and marketed and promoted as such. ... On the other hand, Opposer’s Snack DuO Products are for pets and adults.”¹⁰⁴ Applicant continues, “Opposer’s employees testified that they admittedly saw Applicant’s Snackeez/Snackeez DUO Products offered for sale on television, the primary means of sales of products by Applicant. ... Opposer’s employees also testified on cross-examination that the respective products are sold to different retail buyers and sold to different end consumers (Snack DuO

¹⁰⁴ Applicant’s brief p. 31, 32 TTABVUE 36 *citing* Dennis dep.: 18:22-19:12; Logan dep.: 31:20-32:6; Musteen dep.: 52:19-53:3.

Product for adults/pets vs. Snackeez DUO Product for children)....”¹⁰⁵

As Opposer correctly notes, though, the subject application’s identified goods, “beverageware; household containers for foods; thermal insulated containers for food or beverages; bottles, sold empty for beverages; cups for beverages; insulating sleeve holder for beverage cups; portable beverage and food container holder,” overlaps with Opposer’s SNACK-DUO product, and contains no limitations or restrictions as to channels of trade or classes of customers.¹⁰⁶

We agree. We must consider the goods as they are described in the application, not extrinsic evidence of actual use. *In re i.am.symbolic*, 123 USPQ2d at 1749.

The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys., Inc. v. Houston Computs. Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The Board may not read limitations into an unrestricted application. See *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1043 (Fed. Cir. 1983). “Registrability is determined based on the description in the application, and restrictions on how the mark is used will not be inferred.” *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4 (Fed. Cir. 1993).

In this case, the application contains no limitations on the means of marketing its goods, or the age of consumers who may purchase or use its goods. Absent such limitations, their goods must be presumed to travel in all channels of trade normal

¹⁰⁵ Applicant’s brief p. 32, 32 TTABVUE 37, *citing* Musteen dep.: 25:14-26:2, 33:19-43:4, 52:19-53:3; Logan dep. 28:17-23; 30:11-18, 31:20-32:6; Dennis dep.: 36:11-14.

¹⁰⁶ Opposer’s brief pp. 25-26, 31 TTABVUE 31-32.

for those goods, to all usual classes of consumers for those goods. *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160-61; *In re Viterra*, 101 USPQ2d at 1908; *In re i.am.symbolic*, 123 USPQ2d at 1750. In this case, since Opposer's goods are designed for use by humans, as well as pets, the class of customers for both parties' products would be ordinary consumers of food and beverage containers. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these ... items could be offered and sold to the same classes of purchasers through the same channels of trade"). The parties' goods, channels of trade, and classes of customers overlap.

The second and third *DuPont* factors thus weigh in favor of a finding of likelihood of confusion.

C. Sophistication and Care of Customers

Under the fourth *DuPont* factor, "conditions under which and buyers to whom sales are made, i.e. 'impulse' vs careful, sophisticated purchasing," *DuPont*, 177 USPQ at 567, Opposer argues that the parties' goods "are inexpensive consumer items sold in retail stores. These are 'impulse items sold to unsophisticated purchasers.'"¹⁰⁷ Applicant does not respond to this argument. Since there is no restriction in the subject application as to price or quality, there is no reason to infer that ordinary purchasers of food and beverage containers will be particularly sophisticated, discriminating, or careful in making their purchases. *See In re Davia*, 110 USPQ2d 1810, 1818 (TTAB 2014)("Generally, casual purchasers of low-cost,

¹⁰⁷ Opposer's brief p. 26, 31 TTABVUE 32.

every-day consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods.”). Hence we find that this *DuPont* factor weighs in Opposer’s favor, as well.

D. Fame of Opposer’s Mark

Under the fifth *DuPont* factor, “fame of the prior mark,” Applicant repeats its argument that Opposer’s mark is descriptive with no acquired distinctiveness, “so it is clear that Opposer’s Snack DuO Mark is not famous.”¹⁰⁸ *DuPont*, 177 USPQ at 567.

In determining the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”)

The fame of a mark is not “an all-or-nothing measure” when considered in the context of likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). Rather, likelihood of confusion fame “varies along a spectrum from very strong to very weak.” *Juice Generation*, 115 USPQ2d at 1676. Opposer does not claim its mark is famous, in the sense of being very strong.

As we have determined, Opposer’s mark is suggestive, and therefore inherently distinctive. Since the introduction of the SNACK-DUO product into commerce, Opposer “has regularly promoted the Snack-Duo in a variety of print trade

¹⁰⁸ Applicant’s brief p. 32, 32 TTABVUE 37.

publications such as Homeworld Business and Pet Business, and on social media, and continues to actively promote the Snack-DuO,” according to its Marketing Director.¹⁰⁹ According to its Sales Director, its volume of sales and revenue for the SNACK-DUO product, though confidential, indicate that the product has enjoyed some measure of market success.¹¹⁰

Considering the record in its entirety as to strength, we accord Opposer’s mark a moderate degree of strength as to its goods in the likelihood of confusion analysis.

E. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the parties’ subject marks. *DuPont*, 177 USPQ at 567.

Applicant contends that “there is absolutely no evidence of actual confusion.” In fact, Applicant urges, employees of Opposer testified on cross-examination that they have not heard of any confusion by retailers, consumers or distributors in the marketplace.¹¹¹

“While evidence of actual confusion may be considered in the *DuPont* analysis, a showing of actual confusion is not necessary to establish a likelihood of confusion.” *In re i.am.symbolic*, 123 USPQ2d at 1747. A showing of actual confusion may be highly probative, if not conclusive, of a likelihood of confusion. *In re Majestic Distilling Co.*,

¹⁰⁹ Logan decl. ¶ 2, 17 TTABVUE 2.

¹¹⁰ Musteen decl. ¶ 11, 30 TTABVUE 4 (redacted).

¹¹¹ Applicant’s brief pp. 32-33, 32 TTABVUE 37-38 *citing* Dennis dep.: 33:10-21; Logan dep.: 31:13-19; Musteen dep.: 35:19-24.

65 USPQ2d at 1205. Yet the opposite is not true; an absence of evidence of actual confusion carries little weight. *See J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). The issue before us is the *likelihood* of confusion, not actual confusion. The parties' marks have been in contemporaneous use for only a short time. *Primrose Ret. Cmtys., v. Edward Rose Senior Living*, 122 USPQ2d at 1039-40 (three years' contemporaneous use too short a time in which to gauge opportunity for actual confusion). And during that time, the extent to which the parties' branded products have appeared in proximity to one another in the marketplace is unclear. Given this evidence, we are at a disadvantage to gauge the opportunity for actual confusion to have occurred in the marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Consequently, the seventh and eighth *DuPont* factors are neutral.

V. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *DuPont* factors. Because we have found that the marks at issue are similar; that Applicant's identified goods are related to Opposer's goods; that they would move in overlapping trade channels; that they are offered to the same or overlapping classes of purchasers, who would exercise no more than ordinary care; that Opposer's mark possesses a moderate degree of strength as to its goods in the likelihood of confusion analysis; and that the absence of evidence of actual confusion in the marketplace does not mean there is no likelihood of confusion; we conclude, based on the preponderance of the evidence, that

Applicant's mark SNACKEEZ DUO, as used on or in connection with the goods identified in the application, so resembles Opposer's mark SNACK-DUO, as used on or in connection with its goods, as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The opposition to Applicant's mark SNACKEEZ DUO is sustained.