

This Opinion Is Not a  
Precedent of the TTAB

Mailed: February 13, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Garan Incorporated and  
Garan Services Corp.*

*v.*

*Manimal, LLC*  
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Opposition No. 91232774  
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Robert L. Epstein and William C. Wright of Epstein Drangel LLP  
for Garan Incorporated and Garan Services Corp.

James D. Weinberger and Sydney Kipen of Fross Zelnick Lehrman & Zissu, P.C.  
for Manimal, LLC.  
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Before Taylor, Bergsman and Heasley, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Manimal, LLC (Applicant) seeks registration on the Principal Register for the  
mark MANIMAL, in standard character form, for the clothing listed below:

Men's, Women's and Children's clothing, namely, Tops,  
bottoms, pants, underwear, socks, T-shirts, hats,  
sweatpants, sweatshirts, long sleeve shirts, thermal tops,  
shorts, bathing suits, athletic uniforms, tank tops, wrist  
wraps, footwear, jackets, warm-up suits, belts, beanies,  
bandanas, wrist bands, sweaters, jeans, Compression  
garments for athletic or other non-medical use, namely,

compression socks, stockings, leggings, jerseys, vests, trousers, sleeves, shirts, in Class 25.<sup>1</sup>

Garan Incorporated and Garan Services Corp. (Opposers) opposed the registration of Applicant's mark on the following grounds:<sup>2</sup>

- Likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d);
- Dilution under Section 45(c) of the Trademark Act, 15, U.S.C. § 1125(c);
- Applicant's mark is generic;
- Applicant's mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); and
- Abandonment.

With respect to its likelihood of confusion claim, Opposers allege that Applicant's mark so resembles Opposers' registered marks, including GARANIMNAL, in typed drawing form, for "children's shirts and pants," in Class 25, as to be likely to cause confusion.<sup>3</sup>

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

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<sup>1</sup> Application Serial No. 85511299 filed January 8, 2012, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of its mark anywhere and in commerce as of July 1, 2010.

Applicant, in its April 29, 2013 Response to Suspension Inquiry, amended its filing basis to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> Amended Notice of Opposition, 15 TTABVUE. Garan Services Corporation is a wholly owned subsidiary of Garan Incorporated. Jerald Kamiel Testimony Dep., p. 9 (28 TTABVUE 14).

<sup>3</sup> Registration No. 0954125 registered February 27, 1973; third renewal.

Opposers, in their brief on the case, did not refer to the genericness or descriptiveness claims and, therefore, we deem them waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (opposer's pleaded descriptiveness claim not argued in brief deemed waived); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (opposer's pleaded claims not argued in its brief deemed waived), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

### **I. The record**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.<sup>4</sup> The parties introduced the testimony and evidence listed below:

#### **A. Opposer's testimony and evidence.**

1. Notice of reliance on Opposers' pleaded registrations printed from the USPTO Trademark Status & Document Retrieval (TSDR) database showing the current status of and title to the registrations;<sup>5</sup> and

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<sup>4</sup> Because Applicant's application file is automatically of record, Opposers did not have to submit excerpts from it via a notice of reliance. 24 TTABVUE 47-52.

<sup>5</sup> 24 TTABVUE 6-45. Because Opposers attached to their Notice of Opposition copies of their pleaded registrations printed from the USPTO's Trademark Electronic Search System (TESS) and Trademark Status and Document Retrieval (TSDR) databases showing the

2. Testimony deposition of Jerald Kamiel, Opposers' President and Chief Operating Officer.<sup>6</sup>

B. Applicant's testimony and evidence.

1. Testimony declaration of George Corbo, Applicant's co-founder and Chief Executive Officer;<sup>7</sup>
2. Copies of eight third-party registrations for marks incorporating "animal(s)" or "imals" as a suffix for clothing;<sup>8</sup> and
3. Notice of reliance on Opposers' responses to Applicant's interrogatory Nos. 4, 15, 17, and 20.<sup>9</sup>

## II. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a "real interest" in the proceeding and a "reasonable" basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d

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current status of and title to the registrations, it did not have to introduce them as second time through a notice of reliance. *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

<sup>6</sup> 28 TTABVUE. Opposers posted the portions of the Kamiel deposition designated as confidential at 27 TTABVUE.

<sup>7</sup> 35-40 TTABVUE. Applicant posted the portions of the Corbo declaration designated as confidential at 29-34 and 43 TTABVUE.

<sup>8</sup> 41 TTABVUE.

<sup>9</sup> 42 TTABVUE.

1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposers established their standing by properly introducing into evidence their pleaded registrations showing the current status of the registrations and title to the registrations in Garan Services Corp. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff's two prior registrations suffice to establish plaintiff's direct commercial interest and its standing); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its brief, did not challenge Opposers' standing.

Once a plaintiff has shown standing on one ground, it has the right to assert any other ground in an opposition. *See Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its standing as to genericness ground of certification mark and was entitled to assert any other ground).

### **III. Priority**

Because Opposers' pleaded registrations are of record, priority in the opposition proceeding is not at issue with respect to the marks and goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing

*King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). Applicant, in its brief, did not challenge Opposers' priority.

#### **IV. Likelihood of Confusion**

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). See also *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative

effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

While Opposers made of record copies of their eight pleaded registrations, we focus our likelihood of confusion analysis on Registration No. 0954125 for the mark GARANIMAL, in typed drawing form, for “children’s shirts and pants.” This is Opposers’ mark most similar to Applicant’s mark for in part identical goods. See the discussion below. If we cannot sustain the opposition based on this registered mark, we could not sustain it based on the marks in the other pleaded registrations. *See North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

**A. The similarity or dissimilarity and nature of the goods.**

As noted above, the description of goods in Opposers’ Registration No. 0954125 for the mark GARANIMAL is “children’s shirts and pants.” Applicant is seeking to register its mark for, *inter alia*, children’s pants, t-shirts, long sleeve shirts, and tank tops.<sup>10</sup> Opposers’ broadly worded identification of “shirts” encompasses Applicant’s

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<sup>10</sup> Merriam-Webster.com defines “tank top” as “a sleeveless collarless shirt with usually wide shoulder straps and no front opening.” The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir.

more narrowly identified “t-shirts,” “long sleeve shirts,” and “tank tops.” Where an application or registration broadly identifies the products in the description of goods, we must presume that the goods encompass all goods of the type identified. *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007). Accordingly, Opposers’ goods and Applicant’s goods are in part or legally identical.

Under this *DuPont* factor, Opposers need not prove, and we need not find, similarity as to each product listed in the descriptions of goods. It is sufficient for finding a likelihood of confusion that Opposers establish that any item encompassed by the identification of goods within a particular class in the application and registration are related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014).

Applicant argues that the goods are not related because it uses its mark to identify exercise clothing “only for and directed at adults, whereas Opposers make children’s

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2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).



clothing sets ... only for and directed at children and adults shopping for them.”<sup>11</sup> However, we must consider the goods as the parties describe them in the application and registrations at issue. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“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 the sales of goods are directed.”); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”).

In addition, we do not read limitations into the identification of goods. *In re i.am.symbolic*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”); *In re Thor Tech*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Therefore, we may not restrict Applicant’s description of goods

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<sup>11</sup> Applicant’s Brief, pp. 19-29 (48 TTABVue 20-21).

encompassing men's, women's, and children's pants and shirts to exercise clothing for adults.

This *DuPont* factor weighs in favor of finding a likelihood of confusion.

**B. Established, likely-to-continue channels of trade and classes of consumers.**

Because the goods described in the application and Opposers' registration are in part or legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

Applicant contends that the classes of consumers are different because Opposers' customers are parents or grandparents of children they are trying to dress whereas Applicant's customers are adults committed to exercise.<sup>12</sup> As noted, we may not limit, by resort to extrinsic evidence, the scope of goods as identified in Opposers' registration or in the subject application. *E.g.*, *See Stone Lion Capital Partners*, 110

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<sup>12</sup> Applicant's Brief, p. 21 (48 TTABVUE 22).

USPQ2d at 1162 (“It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions, because ‘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 applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.’”) (quoting *Octocom Sys., Inc. v. Houston Comp. Servs. Inc.*, 16 USPQ2d at 1787); *In re Dixie Rests. Inc.*, 105 USPQ2d, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (citing *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed.Cir.1987)).

Because Applicant’s description of goods does not restrict its clothing to adults committed to exercise and, in fact, includes children’s clothing, we must presume that Applicant’s clothing is offered in all channels of trade normal for such clothing and that the clothing would be purchased by all potential customers, including the Opposers’ channels of trade and potential customers. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

The channels of trade and classes of consumers favor finding a likelihood of confusion.

**C. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.**

Neither Opposers, nor Applicant, is aware of any reported instances of actual confusion.<sup>13</sup> However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period in the same markets as those served by Opposers under their mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

As noted above, our analysis as to the similarity or dissimilarity of the goods, channels of trade and classes of consumers is based, as dictated by precedent from the Federal Circuit, on the identifications set forth in the application and Opposers' registration. *See Stone Lion*, 110 USPQ2d at 1162. As such, we may not consider, in

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<sup>13</sup> Corbo Testimony Decl. ¶26 (35 TTABVUE 9); Opposers' response to Applicant's interrogatory No. 15 (42 TTABVUE 11); Kamiel Testimony Dep. p. 39 (28 TTABVUE 44).

assessing *DuPont* factors three and four, evidence of how Applicant and Registrant are actually selling their products in the marketplace. *Id.* Analyzing the lack of any reported instances of actual confusion under *DuPont* factors seven and eight, by contrast, requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use of the same channels of trade could be telling. However, a defendant's unilateral contention of no actual confusion when channels of trade are only presumptively the same, rather than shown to be actually the same, may not be particularly probative.

Applicant has used the MANIMAL mark continuously since 2010 when it launched its apparel line<sup>14</sup> Applicant sells its apparel through its website, blog posts and social media accounts, including Instagram, Facebook and Twitter.<sup>15</sup>

In connection with the MANIMAL mark, which has figured prominently across all of the product categories we offer, Manimal offers nine different types of wrist wraps ranging from \$40 - \$55, nine different t-shirts ranging from \$25 - \$30, three different types of knee wraps ranging from \$35 - \$40, two types of stickers ranging from \$4 - \$8, and thirty-five prints with inspirational MANIMAL philosophical quotes ranging from \$45 - \$90.<sup>16</sup>

Between March 2015 and March 2019, Applicant's paid advertising on Facebook and Google Advertising has reached 10 million viewers who are predominantly male, in

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<sup>14</sup> Corbo Testimony Decl. ¶14 (35 TTABVUE 6).

<sup>15</sup> *Id.* at ¶ 15 (35 TTABVUE 7).

<sup>16</sup> *Id.* at ¶15 (35 TTABVUE 7).

the fitness industry, and between the ages of 21-40.<sup>17</sup> Applicant has 58,100 Facebook followers, 39,400 Instagram followers, and 640 Twitter followers.<sup>18</sup> Despite Applicant's social media following, its sales have been modest.<sup>19</sup>

"Garanimals was created in 1972."<sup>20</sup> It is a children's clothing line.

[T]he product line is newborn through preschool, size ten, boy/girl, and it's primarily knitted tops and bottoms, but there are also jackets. There are woven bottoms. There is skirts. There is all kinds of clothing that kids wear every day.<sup>21</sup>

"The consumers that buy Garanimals are either parents or grandparents of the children that they are trying to dress."<sup>22</sup> Since 2008, Opposers have sold their GARANIMAL clothing exclusively at Walmart and Walmart's online service.<sup>23</sup> Opposers sell GARANIMAL clothing at all of the approximately 4,000 Walmart stores in the United States.<sup>24</sup> Opposers' revenues generated through the sale of GARANIMAL clothing are substantial.<sup>25</sup> Opposers' advertising expenditures are also substantial.<sup>26</sup>

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<sup>17</sup> *Id.* at ¶17 (35 TTABVUE 7).

<sup>18</sup> *Id.* at ¶18 (35 TTABVUE 7).

<sup>19</sup> *Id.* at ¶16 (43 TTABVUE 8) (Confidential). Because Applicant has designated its sales revenues confidential, we may refer to them only in general terms.

<sup>20</sup> Kamiel Testimony Dep., p. 10 (28 TTABVUE 15).

<sup>21</sup> *Id.* at p. 11 (28 TTABVUE 16).

<sup>22</sup> *Id.* at p. 12 (28 TTABVUE 17).

<sup>23</sup> Opposers' response to Applicant's interrogatory No. 4 (42 TTABVUE 10); Kamiel Testimony Dep., p. 13 (28 TTABVUE 18).

<sup>24</sup> Kamiel Testimony Dep., p. 13 (28 TTABVUE 18).

<sup>25</sup> *Id.* at p. 22 (27 TTABVUE 27) (Confidential). Because Opposers designated their sales revenues confidential, we may refer to them only in general terms.

<sup>26</sup> *Id.* at pp. 24 and 35 (27 TTABVUE 29 and 40) (Confidential).

Opposers advertise twice a year on television for 12-14 weeks during the fall holiday season (September through November) and the spring/summer season (March through May).<sup>27</sup> Opposers started advertising on Facebook in 2015 or 2016 and have over 1,200,000 “likes.”<sup>28</sup> Opposers also have an Instagram account and a website.<sup>29</sup> Finally, Walmart advertises GARANIMAL clothing through the Walmart website.<sup>30</sup>

Because the parties’ clothing are distinct product lines within the larger apparel industry, sold through different channels of trade, and sold to different classes of consumers, it is unlikely that the same consumers will encounter the parties’ clothing in same marketing milieu. Accordingly, there has not been an opportunity for actual confusion to occur.

We find that the length of length of time during and conditions under which there has been concurrent use without evidence of actual confusion is a neutral factor.

**D. The strength of Opposers’ GARANIMAL mark.**

The fifth *DuPont* factor enables Opposers to expand the scope of protection afforded its pleaded mark by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use);” the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

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<sup>27</sup> *Id.* at 24 (28 TTABVUE 29).

<sup>28</sup> *Id.* at 26 (28 TTABVUE 31).

<sup>29</sup> *Id.* at 27 (28 TTABVUE 32).

<sup>30</sup> *Id.* at 28 (28 TTABVUE 33).

Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). To determine a mark’s place on that spectrum, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. See *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.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. Nov. 2019 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). We may measure commercial strength indirectly, by volume






of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

Turning first to the inherent strength, GARANIMAL is a fanciful term coined by Opposers and, therefore, it is an inherently strong mark. *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004) (defining a fanciful mark as “a non-dictionary word concocted by the trademark holder for its product” and observing that such marks are typically strong); *Mishawaka Rubber & Woolen Mfg. Co. v. Bata Narodni Podnik*, 222 F.2d 279, 105 USPQ 432, 437 (CCPA 1955) (“A strong and fanciful mark is entitled to broad protection.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion). *See also Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 230 USPQ 831, 834 (2d Cir. 1986) (a fanciful mark “is entitled to the most protection the Lanham Act can provide”).

Applicant argues to the contrary, contending that GARANIMAL is a weak mark, entitled to a narrow scope of protections as shown by the eight third-party

registrations that have an “animal(s)” or “imals” suffix for clothing. We list the third-party registrations below:<sup>31</sup>

Mark	Reg. No.	Goods
SKELANIMALS	5519099	Clothing, including, inter alia shirts and pants
	5433458	Hats, tops, and shirts
LANTANIMALS	5424832	Shirts, t-shirts, hats
	4952892	Apparel for dancers, business wear, including shirts, infants’ trousers, trousers, t-shirts
EARTHUMANIMAL	4475199	Shirts
	4406262	Shirts
HALFANIMAL	3424615	Hats, pants, shorts, sweat pants, sweat shirts, sweat suits, t-shirts, wind resistant jackets
MANIMALS	4918335	Clothing, namely, t-shirts featuring animals with humanoid characteristics, all not sized and targeted to infants, toddlers or preschoolers.

“This is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both *Jack Wolfskin v. New Millennium Sports*, [797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S.Ct. 982 (2016)], and *Juice Generation v. GS Enters.*, [794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)].” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019). Nevertheless, the

<sup>31</sup> 41 TTABVUE.

third-party marks suggest a connection with animals (e.g., in the nature of a design or marketing theme associated with animals) as do Opposers' mark GARANIMAL and Applicant's mark MANIMAL. Such a connection does not weaken the inherent strength of Opposers' GARANIMAL mark; it merely indicates that Opposers are not the only entity that has registered an "animal" suffix as part of its mark. Thus, when we analyze the similarity or dissimilarity of the marks, we must consider whether the resemblance of the marks is close enough to cause one seeing one or both of the marks to assume that there is some connection, association, or sponsorship between the marks.

We now turn to the commercial strength of Opposers' GARANIMAL marks. Opposers introduced the following evidence to prove their commercial strength:

- "Garanimals was created in 1972."<sup>32</sup>
- Since 2008, Opposers have sold their GARANIMAL clothing exclusively at Walmart and Walmart's online service.<sup>33</sup>
- Opposers sell GARANIMAL clothing at all of the approximately 4,000 Walmart stores in the United States.<sup>34</sup>
- Opposers' revenues generated through the sale of GARANIMAL clothing are substantial.<sup>35</sup>

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<sup>32</sup> Kamiel Testimony Dep., p. 10 (28 TTABVUE 15).

<sup>33</sup> Opposers' response to Applicant's interrogatory No. 4 (42 TTABVUE 10); Kamiel Testimony Dep., p. 13 (28 TTABVUE 18).

<sup>34</sup> Kamiel Testimony Dep., p. 13 (28 TTABVUE 18).

<sup>35</sup> *Id.* at p. 22 (27 TTABVUE 27) (Confidential). Because Opposers designated their sales revenues confidential, we may refer to them only in general terms.

- Opposers’ advertising expenditures are also substantial.<sup>36</sup>

- Opposers advertise twice a year on television for 12-14 weeks during the fall holiday season (September through November) and the spring/summer season (March through May).<sup>37</sup>

- Opposers started advertising on Facebook in 2015 or 2016 and have over 1,200,000 “likes.”<sup>38</sup>

- Psychologist Dr. Joyce Brothers referred to GARANIMAL clothing in her “booklet” “Clothing And A Child’s Self-Image.”<sup>39</sup> The theme of the work is that children build confidence in their ability to do things themselves when parents provide an unhurried atmosphere in which children may observe how parents dress them, as well as providing children with an opportunity to dress themselves.<sup>40</sup> Dr. Brothers refers to GARANIMAL clothing twice in her publication.<sup>41</sup>

Garanimals system of matching sewn-in animal labels helps the pre-schooler to handle his own wardrobe. With three pairs of slacks and five tops, a child can mix and match fifteen different outfits. The sense of “I can” fosters the child’s growing sense of independence.<sup>42</sup>

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<sup>36</sup> *Id.* at pp. 24 and 35 (27 TTABVUE 29 and 40) (Confidential).

<sup>37</sup> *Id.* at p. 24 (28 TTABVUE 29).

<sup>38</sup> *Id.* at p. 26 (28 TTABVUE 31).

<sup>39</sup> *Id.* at pp. 20-21, 40 and Exhibit A (28 TTABVUE 25-26, 45 and 68-78).

<sup>40</sup> *Id.* at Exhibit A (28 TTABVUE 71). *See also Id.* (28 TTABVUE 72) (“Parents can enhance a child’s new sense of selfhood by allowing the child small choices.”).

<sup>41</sup> We find that Opposers’ assertions, in their brief, that “a book has been written about GARANIMALS by the famous psychologist Dr. Joyce Brothers,” and ““What other trademark has had a book written about it by a famous psychologist, Dr. Joyce Brothers, detailing the positive psychological effect that GARANIMALS Products have had on the self-Image of children?” are overstatements. Opposers’ Brief, pp. 11 and 12 (44 TTABVUE 17 and 18).

<sup>42</sup> *Id.* at Exhibit A (28 TTABVUE 72).

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Parents will want to select practical clothing that can withstand the rough and tumble play of their child as he grows. In my traveling and talking with parents, the easy care and durability of Garanimals have been features many parents mentioned again and again.<sup>43</sup>

Opposers contend that the GARANIMAL marks are famous.

The GARANIMALS mark is a famous trademark due to its longevity of use, extensive advertising, huge distribution, and high sales volume of the GARANIMAL Products sold thereunder.<sup>44</sup>

For the reasons explained below, we find that Opposers' GARANIMAL marks are commercially strong but not famous marks. First, although long use of a mark is indicative of commercial success, it is not conclusive evidence of fame. *See Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1635-36 (TTAB 2007) ("Long use and/or registration of a mark, without evidence of the extent of consumer exposure to or recognition of the mark over the years, is not sufficient to prove fame."). *Cf. La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (finding evidence of long use insufficient to establish acquired distinctiveness of FISH FRY PRODUCTS where evidence involved uses of LOUISIANA FISH FRY PRODUCTS); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant's use of the product designs ranging from seven to seventeen years is insufficient to bestow acquired distinctiveness); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (finding evidence submitted by applicant insufficient to establish

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<sup>43</sup> *Id.* at Exhibit A (28 TTABVUE 73).

<sup>44</sup> Opposers' Brief, p. 9 (45 TTABVUE 15).

acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, inter alia, continuous and substantially exclusive use for sixteen years, deemed “a substantial period but not necessarily conclusive or persuasive”). *Compare Nina Ricci, S.A.R.L. v. ETF Enters., Inc.*, 203 USPQ 947, 951 (TTAB 1979) (“Not only has opposer enjoyed long use of its ‘RICCI’ marks, but the record shows the fame, prestige and reputation which the name ‘NINA RICCI’ has brought to opposer as evidenced by the numerous newspaper articles and reports of opposer’s activities in the ladies’ apparel fields, previously referred to.”).

Second, the only evidence of unsolicited media attention is the aforementioned reference in the Dr. Joyce Brothers publication. Jerald Kamiel, who introduced the booklet, speculated that the booklet was published “somewhere around ’75, ’76, something like that.”<sup>45</sup> He was unaware of its circulation.<sup>46</sup> Opposers’ proffered no testimony or other evidence as to whether it is still in circulation.

Finally, Opposers’ substantial advertising and revenues relating to the GARANIMAL marks shows that it is a successful product line. Inasmuch as since 2008, Opposers have sold GARANIMAL products sold exclusively through Walmart, it was incumbent upon Opposers to provide some context for its advertising expenditures and revenues (e.g., market share, how Opposers revenues and advertising expenditures compare with comparable goods). After all, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal

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<sup>45</sup> Kamiel Testimony Dep., p. 40 (28 TTABVUE 45).

<sup>46</sup> *Id.*

protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

We find that Opposers' GARANIMAL marks are commercially strong, but not famous.<sup>47</sup> This means that Opposers' GARANIMAL marks fall on strong side of the spectrum of from very strong to very weak.

**E. The similarity or dissimilarity of the marks.**

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d

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<sup>47</sup> "Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. ... Accordingly, a mark can acquired 'sufficient public recognition and renown for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame." *Coach Servs.*, 101 USPQ2d at 1724. See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). If Opposers' GARANIMAL mark does not meet the lesser standard of fame for purposes of likelihood of confusion, it cannot be famous for purposes of dilution. See *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1250 (TTAB 2015) ("Where, as here, a mark is not proven famous for purposes of likelihood of confusion, it will certainly not meet the higher threshold for fame required to prove dilution."). As Opposers cannot demonstrate, on this record, a required element of its dilution claim, we dismiss Opposers' claim under Section 43(c) of the Trademark Act.

728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“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.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the



descriptions of goods in Opposers' pleaded registrations and the application at issue include children's pants and shirts, the average customer is an ordinary consumer.

Applicant is seeking to register the mark MANIMAL and Opposers' marks are variations of GARANIMAL. The marks are similar because they share the word "animal" as a suffix. However, they differ because Applicant's mark places the letter "M" before the word "animal" to create "Manimal," a combination of man and animal. Opposers, on the other hand, place the letters "Gar" before the word "animal" to create a fanciful term without any meaning. Jerald Kamiel, Opposers' President and Chief Operating Officer concurs:

Q. Can you tell me what a Manimal is?

A. It's a part human, part animal that is - - has animal instincts and behavior, ugly, and very, very different than the animals that we have in Garanimals.

Q. Would you say in your advertising of Garanimals you are trying to create a particular image of what Garanimals is in the minds of consumers?

A. Yes.

Q. And what is that image?

A. The image we are trying to create is that Garanimals is a kids' wear brand of well made, comfortable, high quality, durable clothes that kids will want to wear, want to dress themselves and look correct.<sup>48</sup>

While we acknowledge that both marks suggest animals, we find that the marks in their entirety are dissimilar and purchasers will not ascribe a common source or

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<sup>48</sup> Kamiel Testimony Dep., pp. 32-33 (28 TTABVUE 37-38). Mr. Kamiel testified that Opposers do market research regarding the impact of their advertising. *Id.* at pp. 19-20 and 39 (28 TTABVUE 24-25 and 44).

sponsorship to the apparel sold thereunder. The overall differences in the marks visually, aurally, and in the commercial impressions engendered by the marks outweigh the similarities. The third-party registrations discussed above indicate that Opposers are not the only entity to register marks with an “animal” or “imals” suffix. In fact, all of the third-party registrations were issued after Opposers’ first use and registration of GARANIMAL. Thus, Opposers must believe that various “animal” or “imals” suffix marks can be used and registered side by side without causing confusion provided there are minimal differences between the marks. *See In re Hartz Hotel Servs., Inc.* 102 USPQ2d 1150, 1153 (TTAB 2012); *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 779 (TTAB 1979). Despite the inherent commercial strength of the GARANIMAL marks, the marks differ enough in sight, sound, meaning and commercial impression that confusion is not likely.

We find that the marks are not similar in appearance, sound, connotation or commercial impression.

**F. Balancing the factors.**

We find that the dissimilarity of the parties’ marks outweighs the other applicable *DuPont* factors. *See Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”); *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single *duPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”) (quoting *Odom’s Tenn. Pride*

*Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (“[O]ne *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”).

Therefore, we find that Applicant’s mark MANIMAL for men’s, women’s and children’s clothing listed in the description of goods is not likely to cause confusion with Opposers’ GARANIMAL marks for clothing.

## **V. Abandonment**

During the prosecution of Applicant’s application, the Examining Attorney cited application Serial No. 85115633 for the mark MANIMALS, in standard character form, for, inter alia, “clothing, namely, t-shirts, dresses, jackets, sweatshirts, hooded shirts, tank tops, hats, caps, pants, socks, polo shirts, long sleeve shirts, infant and toddler one piece clothing, cloth bibs, ties, footwear and aprons,” in Class 25, as a potential Section 2(d) bar to registration.<sup>49</sup> In response, Applicant submitted a consent agreement with The Mountain Corporation, owner of Registration No. 4918335, formerly the cited application. The Mountain Corporation agreed to amend its description of goods to “shirts featuring animals with humanoid characteristics”

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<sup>49</sup> April 13, 2012 Office Action in Applicant’s application (TSDR 2 and 4-7).

All references to the application record are to the Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format.

and agreed that Applicant may use and register MANIMAL for the goods listed in Applicant's application.<sup>50</sup> The Examining Attorney reviewed the consent agreement and approved Applicant's application for publication.<sup>51</sup>

Opposers allege that the consent agreement "constitutes a 'naked' consent by [Applicant] for The Mountain Corporation to sell T-shirts featuring animals with humanoid characteristics under the MANIMALS mark without [Applicant] having the right or the ability to control the nature or quality of those goods" and, therefore, the consent agreement "constitutes an abandonment of [Applicant's] exclusive right to use MANIMAL on clothing products."<sup>52</sup> Opposers contend that the "naked" consent agreement between Applicant and The Mountain Corporation goes against public policy and "[b]y entering into such an agreement, Applicant has abandoned any right it may have had to MANIMAL and is not entitled to register the same as a trademark."<sup>53</sup>

Section 45 of the Trademark Act, 15 U.S.C. § 1127, provides, in pertinent part, that "[a] mark shall be deemed 'abandoned' ..."

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

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<sup>50</sup> September 8, 2016 Response to Suspension Inquiry attached to Applicant's application (TSDR 1 and 3-4).

<sup>51</sup> November 30, 2016 Notation to File attached to Applicant's application (TSDR 1).

<sup>52</sup> Amended Notice of Opposition ¶¶59 and 60 (15 TTABVUE 14).

<sup>53</sup> Opposers' Brief, p. 20 (45 TTABVUE 26).

Assuming arguendo that the consent agreement is a naked consent, Opposers, as plaintiffs, must prove that the consent agreement whereby The Mountain Corporation agreed to the use and registration of Applicant's mark caused Applicant's mark to lose its significance as a trademark.<sup>54</sup> See *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 335-36 (CCPA 1982) ("Under part (b) [of the definition of abandonment in Section 45 of the Trademark Act, now designated as part 2] a mark becomes abandoned only when the mark loses its significance as an indication of origin, not the sole indication of source."); *Univ. Book Store v. Univ. Wisc. Bd. of Regents*, 33 USPQ2d 1385, 1393 (TTAB 1994). In other words, Opposers must prove that the consent agreement caused Applicant's mark to lose its significance as a source indicator. See *Guiding Eyes for the Blind, Inc. v. Guide Dog Found. for the Blind, Inc.*, 384 F.2d 1016, 155 USPQ 462, 464 (CCPA 1967); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) ("[I]n order to state a claim upon which relief can be granted for the ground of abandonment, applicant must plead facts which show a course of conduct by opposer which has caused opposer's mark to lose its trademark significance.").

Opposers have not introduced any evidence proving that Applicant's MANIMAL trademark has lost its significance as a trademark. In fact, because Opposers have not introduced evidence that The Mountain Corporation is using MANIMALS, there is no evidence that any entity other than Applicant is using MANIMAL or

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<sup>54</sup> Applicant did not expressly agree to the use and registration of MANIMALS for t-shirts by The Mountain Corporation.

MANIMALS as a trademark. On the other hand, Applicant has introduced sufficient evidence of its continuous use of MANIMAL to make a prima facie showing that MANIMAL functions as a trademark.<sup>55</sup> See *Woodstock's Enters. Inc. (CA) v. Woodstock's Enters Inc. (OR)*, 43 USPQ2d 1440, 1446 (TTAB 1997), *aff'd* 152 F.2d 942 (Fed. Cir. 1998) (“[S]o long as at least some purchasers identify respondent with the registered mark, it cannot be said that respondent’s course of conduct has caused the registered mark to lose its significance as a mark.”).

Opposers have failed to prove that Applicant has abandoned its MANIMAL trademark and, therefore, we dismiss the abandonment claim.

**Decision:** The opposition is dismissed.

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<sup>55</sup> Corbo Testimony Decl. Exhibits 2-3 (35 TTABVUE 29-82) and Exhibit 4 (36-39 TTABVUE).