

Opposition No. 94,929

Registration has been opposed by Minnesota Mining and Manufacturing Company under Section 2(d) of the Trademark Act on the ground that since well prior to applicant's earliest date of first use, opposer has used the mark POST-IT for various adhesive paper products, that opposer's POST-IT mark is famous, and that applicant's mark, when used in connection with the identified services, is likely to cause confusion with opposer's previously used and registered mark POST-IT for the following goods: paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place³; stationery notes containing adhesive on one side for attachment to surfaces⁴; trays for holding stationery notes⁵; adhesive tape for home and office use⁶; and stickers⁷. Further, opposer alleges that applicant's mark falsely suggests a connection with opposer and that applicant's mark POSTSTICKERS is merely descriptive of the goods which applicant offers through its services.

Applicant, in its answer, admits that opposer is the owner of the pleaded registrations and that opposer's

³ Registration No. 1,046,353 issued August 17, 1976; renewed.

⁴ Registration No. 1,198,694 issued June 22, 1982; Sections 8 & 15 affidavit filed

⁵ Registration No. 1,208,297 issued September 14, 1982; Sections 8 & 15 affidavit filed.

⁶ Registration No. 1,284,295 issued July 3, 1984; Sections 8 & 15 affidavit filed.

⁷ Registration No. 1,718,114 issued September 22, 1992.

Opposition No. 94,929

POST-IT mark is famous. Applicant denied the remaining allegations of the notice of opposition.

The record in this case consists of the pleadings; the file of the involved application; trial testimony (with exhibits) taken by opposer; and opposer's notice of reliance on certified copies of opposer's pleaded registrations and portions of the discovery deposition of Stephen M. Dole (with exhibits). Applicant took no testimony and offered no other evidence herein.

Only opposer filed a brief. No oral hearing was requested.

The record shows that opposer first used the POST-IT mark on "bulletin board and tiles and rolls" in approximately 1975. (Wilson deposition, p. 9). In 1978 opposer began using the mark on self-stick removable stationery notes. The stationery notes, which are used primarily as communications tools, are made of adhesive-coated paper and are sold in a variety of colors and sizes. Opposer has extended its POST-IT line to include stickers, sticker tape, custom-printed note pads, memo boards, easel pads, glue sticks, labels, tape flags and dispenser items.

Opposer's POST-IT products are relatively inexpensive. For example, the stationery note pads range in price from

Opposition No. 94,929

\$.99 to \$5.00 and the stickers from \$.49 to \$4.99 per package.

Opposer's POST-IT products are sold through office supply stores/distributors, office superstores, mail order catalogs, educational distributors, mass merchandisers, drug stores, grocery stores, club stores, hardware stores and catalogs focused at the education market. Opposer's custom-printed POST-IT note pads are sold primarily through the speciality advertising and incentive market, the commercial print broker channel, and the office supply/distributor channel. Opposer's customers include political organizations, police departments, emergency associations, hospitals, the pharmaceutical industry, delivery service companies, teachers, dentists, doctors, and individual consumers.

Opposer has nationally advertised in magazines such as People, Time and Newsweek, on television, and through direct mail. Opposer has targeted the office market through use of direct mail, providing free samples to customers, brochures, literature, products videos and in-store displays. Opposer has targeted retail consumers using coupons in magazines, free-standing inserts in newspapers, and in-store displays and promotions. Opposer's custom-printing business has utilized trade magazine advertising, selected trade shows, publicity, and direct mail advertising. Opposer has

Opposition No. 94,929

expended tens of millions of dollars in advertising its products under the POST-IT mark.⁸ Opposer's market research studies show that it enjoys a 76% unaided brand awareness.

Products bearing the POST-IT mark have enjoyed hundreds of millions of dollars in domestic sales since 1980.⁹

Stephen Dole, in his discovery deposition, described the products which are offered through applicant's services as "postcards. . . [that] are peelable and stickable." (Deposition, p. 18).

The postcards can be custom-printed with a picture and/or desired text message. According to Mr. Dole, the postcards would be used as advertising tools for companies, and as information vehicles for organizations such as political groups and police departments. In particular, Mr. Dole envisioned police departments distributing the postcards with their emergency telephone numbers printed thereon.

The postcards are priced at \$.35 - \$.65 each and there is a maximum one-time printing charge of \$39.00 for artwork. POSTSTICKERS products are typical postcard size or approximately 4" x 6". Although the postcards currently bear a permanent adhesive, Mr. Dole testified that it would

⁸ Pertinent portions of opposer's exhibit 147, which were introduced under seal, represent opposer's advertising and promotional expenditures for POST-IT stationery notes.

⁹ Again, pertinent portions of opposer's exhibit 147, which were introduced under seal, represent dollar figures for sales of POST-IT stationery notes.

Opposition No. 94,929

be attractive to have a repositionable POSTSTICKERS postcard, and that he may in the future use a less strong, possibly even repositionable, adhesive. Applicant's services have been marketed through direct mail to about 600 associations and corporations. However, as of May 5, 1995, the date of Mr. Dole's discovery deposition, there had been no sales. Mr. Dole testified that he was aware of opposer's POST-IT stationery notes at the time he selected the mark POSTSTICKERS.

Inasmuch as applicant has admitted that opposer is the owner of the pleaded registrations and certified copies thereof have been made of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based on our analysis of the probative facts in evidence that are relevant to the factors bearing on this issue. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this case are the strength of opposer's mark, the similarity of the parties' marks, and the relatedness of the parties' goods and services.

Opposition No. 94,929

This record establishes and applicant has admitted the fame of opposer's POST-IT mark. It is well settled that a well-known or famous mark is entitled to a broader scope of protection than one which is relatively unknown. This is because the issue in an opposition proceeding such as this is whether, because of the marks used on the involved goods/services, there will be confusion, mistake or deception as to the source of the goods/services, and confusion is more likely to occur where a mark is very well-known or famous because there is a propensity of consumers to associate a little-known mark with one which is familiar to them. See *Fruit of the Loom v. Fruit of the Earth, Inc.*, 3 USPQ2d 1531 (TTAB 1987) and *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445 (TTAB 1987).

With the foregoing in mind, we turn to a comparison of the parties' marks. In this case, we find that when considered in their entirety, the marks POST-IT and POSTSTICKERS are similar in sound, appearance and commercial impression due to the shared presence of the term POST. In this regard, we note that there is no evidence of any current third-party use of the term POST as a mark, or part of a mark, in the field of adhesive paper products. In fact, opposer's witness, Mr. Hoke, testified that he was not aware of any third-party uses. Thus, the evidence points to the uniqueness of opposer's POST-IT mark in this field.

Opposition No. 94,929

Turning next to a comparison of opposer's goods and applicant's services, it is well settled that goods/services need not be identical or even competitive in nature to support a finding of likelihood of confusion. Instead, it is sufficient that the goods/services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's services of printing postcards with adhesive backing to the order and specification of others are related, at a minimum, to opposer's stationery notes and custom-printed notes. Not only are both parties offering for sale paper products with adhesive backing, but in the case of opposer's custom-printed note pads, they, like applicant's postcards, are printed to the specification of the individual purchaser. Moreover, opposer's stationery notes and custom-printed notes and the postcards which applicant offers through its services are communications tools. Further, many of opposer's customers (e.g., police departments, political organizations, and companies) are potential customers of

Opposition No. 94,929

applicant's services of printing postcards with adhesive backing to the order and specification of others.

Thus, taking into consideration all the pertinent factors, as discussed above, we conclude that consumers familiar with opposer's POST-IT adhesive paper products, who then encounter applicant's POSTSTICKERS mark, used in connection with printing postcards with adhesive backing to the order and specification of others, are likely to believe that these services are sponsored by or affiliated with opposer. Applicant, by failing to take testimony or file a brief herein has made no argument that confusion is unlikely.

As to the remaining grounds of the opposition, we note that opposer made no mention of the Section 2(a) ground in its brief on the case. Thus, we consider this ground to have been dropped.

Turning finally to the mere descriptiveness ground, opposer argues that POSTSTICKERS is a "contraction of", and is merely descriptive of, postcards with an adhesive backing, as well as applicant's services of printing postcards with adhesive backing to the order and specification of others. Further, opposer contends that Mr. Dole "unambiguously admitted in his deposition that POSTSTICKERS is merely descriptive, and that he selected the mark as a descriptive way to describe his products."

Opposition No. 94,929

(Brief, p. 19). In support of its position, opposer relies on the following portions of Mr. Dole's discovery deposition:

Q. When did you select the name PostStickers?

A. Probably in my dreams, many, many years ago. That's not legal, I know, but I'm saying that the idea of PostStickers, I can't put a date. I didn't sit down and say we have to register, what am I going to register my name under. Perhaps I saw a postcard, I wanted that and how was I going to marry that with stickers. PostStickers seemed a very natural and unobtrusive type of name to apply because it directly described what I was going to do.

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Q. Do you believe that PostStickers is descriptive of your product?

A. Yes. Post card bumper stickers.

Q. Merely descriptive?

A. Pardon?

Q. Merely descriptive of the product?

A. Merely? Yes. . . .

(Deposition, pp. 78-79).

We disagree with opposer that the above testimony establishes that POSTSTICKERS is merely descriptive, within the meaning of Section 2(e)(1) of the Trademark Act, of postcards with adhesive backing or printing postcards with adhesive backing to the order and specification of others. Obviously, Mr. Dole is not an expert in trademark law and there is no indication that he was aware of the legal

Opposition No. 94,929

meaning of "merely descriptive." Thus, we cannot say that Mr. Dole's above testimony is an admission that POSTSTICKERS is merely descriptive of applicant's services or the goods sold through such services. In view thereof, and inasmuch as opposer has otherwise failed to establish that POSTSTICKERS immediately describes an ingredient, quality, characteristic, or function of applicant's services or that it conveys information regarding the nature, function, or purpose of such services, opposer's mere descriptiveness claim must fail.

Decision: The opposition is sustained on the ground of likelihood of confusion.

G. D. Hohein

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Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Opposition No. 94,929