

Paper No. 32
HRW

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Grover Van Dexter

v.

Second Childhood, Inc.

Cancellation No. 23,491

Stephen E. Feldman of Stephen E. Feldman, P.C.
for Grover Van Dexter.

James C. Nemmers for Second Childhood, Inc.

Before Walters, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Grover Van Dexter has filed a petition to cancel
Registration No. 1,747,220 for the mark

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for "collectible doll and kits for making collectible dolls consisting primarily of body parts made of porcelain or gofum, fabrics and patterns for clothing, wigs and paints, sold as a unit."¹

In the petition to cancel, petitioner alleges that he is the owner of a retail store that sells antique toys including antique dolls and collectible toys and dolls; that he is the owner of a registration for the mark SECOND CHILDHOOD for retail antique toy stores² and a second registration for the same mark for clothing;³ that long prior to respondent's date of first use, petitioner began using his mark in connection with antique toys including dolls and collectible dolls and toys and collectable clothing; that he has advertised and promoted his goods and policed his mark; that respondent's goods are sold in the same channels of trade to the same class of purchasers as petitioner's goods; and that respondent's use of its "SECOND CHILDHOOD" mark for its goods is likely to cause confusion.

¹ Reg. No. 1,747,220, issued Jan. 19, 1993, claiming a first use date of Sept. 2, 1988 and a first use in commerce of Nov. 28, 1988. A disclaimer has been made of the term INC. A combined Section 8 and 15 affidavit has been filed.

² Reg. No. 1,109,762, issued Dec. 19, 1978, claiming a first use of June 9, 1969 and a first use in commerce of July 5, 1969. A combined Section 8 and 15 affidavit has been filed and accepted.

³ Reg. No. 1,424,912, issued Jan. 13, 1987, claiming a first use date of June 9, 1969 and a first use in commerce of July 5, 1969. A Section 8 and 15 affidavit has been filed and accepted.

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Respondent, in its answer, has denied the salient allegations of the petition to cancel, and has set forth the affirmative defenses of laches and estoppel, based on petitioner's having made a threat to cancel respondent's mark in June 1994 and not having taken any further action until the filing of this petition in October 1994.

The record consists of the file of the involved registration; the trial testimony for petitioner consisting of the deposition of petitioner, and accompanying exhibits, the deposition of Eric Alberta, a collectible specialist appraiser in New York City, the deposition of Elizabeth McGarrity, a doll collector in New York City, and the deposition of Robert Lester, owner of a shop in Greenwich Village selling collectible toys including dolls; a notice of reliance introducing status and title copies of petitioner's pleaded registrations; and the trial testimony for respondent, consisting of depositions of Peggy Bailey, the owner of Second Childhood, Inc., and accompanying exhibits, and the depositions of Shirlee Funk, a doll collector and of Nancy McCray, a dealer in antique dolls.⁴ Both parties filed briefs, but an oral hearing was not requested.

⁴ In neither case was opposing counsel present for the depositions taken by the other party.

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Earlier in this case, the parties filed cross-motions for summary judgment. In its decision issued April 25, 1996, the Board granted petitioner's motion to the extent that judgment was entered in his favor on the issue of priority of use, but denied both motions with respect to the issue of likelihood of confusion, stating that "genuine issues of material fact remain regarding, at a minimum, respondent's laches and estoppel defenses and the applicability of such defenses, which depend on whether likelihood of confusion is inevitable." [Footnotes omitted]. Accordingly, we proceed on the basis that petitioner has established priority of use and the only issue before us is the likelihood of confusion.⁵

Petitioner, in his testimony, described the opening of his present store in Greenwich Village with his partner Yoji Morimoto (now deceased) in 1969; the use of the mark SECOND

⁵ The only evidence introduced with respect to respondent's defenses of laches and estoppel consists of the testimony of Peggy Bailey of her attendance at four doll shows and her placing a new advertisement in the period from July 1994 and October 1994. We agree with petitioner that this continuation of normal business activities, and presumably sale of dolls, is clearly insufficient to demonstrate any detrimental reliance by respondent on the delay between petitioner's first learning of respondent's use and the filing of this petition, which, at the most, was four months. See *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757; 204 USOQ 697 (CCPA 1980)[party charging estoppel by laches must show that it suffered or will suffer detriment as a result of inaction by the other party]. Accordingly, and since respondent has offered minimal argument with respect to these defenses, no further consideration has been given thereto, or the question of whether or not they could have been raised here.

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CHILDHOOD in connection with the store from then until the present; and the sale through both the retail store and mail orders of collectibles, toys, and dolls from all over the world, including Japan. He stated that, from the opening of his store, he has also sold the works of contemporary Japanese artists, including dolls. Petitioner further testified that his store is popular with tourists, particularly Japanese, and introduced copies of articles written over the years about him and his "old toy" shop. Petitioner testified, and introduced exhibits, as to his strong policing of his mark, including the warnings to infringers placed in his advertisements and his prosecution of others using marks considered to infringe his mark in connection with the sale of dolls, toys and the like. He described his learning of respondent's business from customers in 1994 and his cease-and-desist letter written to respondent in May 1994. Petitioner stated that, since learning of respondent's business, "20 or more" customers had inquired whether he had a branch in Iowa selling dolls.

Each of petitioner's other witnesses testified that petitioner's store is well-known in the field of collectable toys and dolls, and that if he or she saw an advertisement from a business called "Second Childhood" for dolls, petitioner would be the presumed advertiser.

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Peggy Bailey, the owner of respondent, testified to the beginning of her doll business in 1988, which business consists of the sale of Japanese traditional dolls made to order for her by artisans in Japan, with no more than five being made of a given doll, and with prices ranging from \$300 to \$1400 (as shown the price list introduced in Exhibit 2). Ms. Bailey testified that her dolls are made for adults, are not toys, and are usually stored in a case. Her dolls are not antiques and she knows of no one else that sells dolls of this type in the United States. She sells most of her dolls at doll shows, with the remainder being sold by mail-order through her catalogue.

Ms. Bailey also testified with respect to her creation of her mark, indicating that the design element was drawn by her and is a depiction of herself as a little girl; her filing of an application for the mark and registration being at first refused on the basis of petitioner's mark, but the refusal later being withdrawn; and her use of the term "collectible" in the identification of goods in the application for the purpose of excluding antiques. She testified to advertising in magazines such as "Doll World" and "Dolls: The Collector's Magazine," but never in magazines such as "Antique Toy World" or "Toy Shop." She first became aware of petitioner upon the refusal of her application, and later became more acutely aware when Mr.

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Van Dexter sent his cease-and-desist letter in May 1994, which she referred to her attorney, who responded in an attempt to resolve the matter.

Nancy McCray, as an antique doll dealer in Iowa, testified that she had never heard of petitioner or his store; that respondent is the only dealer she knows dealing in imported dolls from Japan and respondent's customers are a very small subset of doll collectors; that "antique" in the doll collecting industry means dolls at least as old as 1935, with the newer dolls being "collectible;" that respondent's Japanese dolls are "new collectible;" that the phrase "collectible dolls" does not mean the same as "antique dolls."

Shirlee Funk, as a doll collector from Iowa, testified that she had never heard of petitioner; that she had co-founded with Peggy Bailey a doll club called Japanese American Doll Enthusiasts, which has about 260 members worldwide; that, as far as she knows, respondent is unique in importing these finely crafted dolls from Japan and that respondent has a small customer base; that respondent's customers could possibly, however, include collectors of antique dolls as well; and that, in her opinion, "antique" dolls are dolls made prior to 1920.

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Turning to the issue of likelihood of confusion, we consider those du Pont factors⁶ which petitioner argues are relevant to our decision and point to a strong likelihood of confusion.

First, insofar as the similarity or dissimilarity of the marks is concerned, petitioner argues that respondent has appropriated petitioner's entire mark SECOND CHILDHOOD to use as the dominant portion of its composite mark. Petitioner maintains that SECOND CHILDHOOD not only is the feature which creates the commercial impression for respondent's mark, but also is the portion which would be likely to be used by customers in referring to, or calling for, the goods of respondent. Petitioner argues that the remainder of respondent's mark is simply descriptive of its goods.

Respondent, on the other hand, argues that the marks of the parties are clearly dissimilar in appearance, sound and commercial impression. Respondent contends that not only are the words "Second Childhood" displayed in a distinctive lettering style in its mark, but the central portion in respondent's mark (the design and the phrase "Dolls for the Young at ♥") is not even present in petitioner's mark. Respondent maintains that the two marks, when viewed in their entireties, create distinct commercial impressions.

⁶ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ

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It is well established that there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark, provided that the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). Furthermore, it is often appropriate to give more weight to the word portions of a mark than to a design feature, since it is by the words that purchasers will refer to the goods, and the words, rather than a design feature or stylized lettering, will thus create the greater impression on them. Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994).

We agree with petitioner that the dominant feature of respondent's composite mark is the phrase SECOND CHILDHOOD, (the additional term INC. having no trademark significance). This is the word portion presented in the largest letters at the top of the mark and would be the first to meet a purchaser's eyes. The slogan or logo "Dolls for the Young at ♡" clearly has descriptive import, respondent's goods being "collectible dolls," i.e., dolls for adults. While the design features would undoubtedly be part of the overall commercial impression initially created by respondent's

563 (CCPA 1973).

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mark, the fact remains that purchasers would be more likely to remember over a period of time the distinctive word portion of the mark, SECOND CHILDHOOD, as the indicator of source. Certainly, in referring to the source of goods purchased, or sought to be purchased, customers would be most likely to use the phrase SECOND CHILDHOOD. Thus, taking into consideration the marks in their entireties, we find respondent's mark to be highly similar in commercial impression to petitioner's mark SECOND CHILDHOOD.

Turning next to the similarity or dissimilarity of the goods and services involved, petitioner contends that because both petitioner and respondent sell "collectible" dolls, the goods of the parties must be considered identical. Petitioner argues that, in view of the unlimited description of goods in respondent's registration, respondent cannot rely upon its evidence of actual use on a particular type of Japanese doll in an attempt to distinguish its goods from the dolls sold by petitioner.

Respondent maintains that it is clear from the description of goods in respondent's registration that its "collectible dolls" are new dolls, and not the antique dolls sold by petitioner. Respondent further argues that the testimony of Shirlee Funk and Nancy McCray refutes petitioner's argument that "collectible dolls" include

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"antique dolls" and shows that "collectible" refers to items newer than 1935, whereas "antique" refers to items older.

We begin with the general principle that, in determining likelihood of confusion, we must consider the identification of goods or services as set forth in the registrations involved, regardless of the evidence of record with respect to the actual nature of the goods or services of the parties. See *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986) and the cases cited therein.

Respondent has described its goods in its registration as "collectible dolls." Petitioner's mark is registered for "retail antique toy store services." Petitioner has established that its sales include antique dolls.⁷ The testimony of Nancy McCray and Shirlee Funk establishes that the word "antique" has a specific meaning in the doll collecting field and refers only to items from a time at least prior to 1935, whereas newer items would simply be called "collectible." Their testimony makes it clear that the term "collectible dolls" does not have the same meaning as "antique dolls" or "antique toys."

⁷ For purposes of this proceeding, we do not find it necessary to determine whether or not petitioner is also entitled to rely upon common law rights with respect to the use of the mark SECOND CHILDHOOD for the sale of dolls other than "antique dolls."

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We are convinced by respondent's evidence that a distinction is drawn in the doll collecting field between "antique" dolls and "collectible" dolls. Ms. Bailey has testified that she used the term "collectible" in the identification of her goods to specifically exclude "antique" dolls. Thus, we cannot accept petitioner's premise that the term "collectible," as used in respondent's recitation of goods, encompasses "antique" dolls. In order to find a likelihood of confusion, however, it is not necessary that the goods or services involved be identical or even competitive. It is sufficient if there is a relationship between the goods and/or services such that persons encountering them under their respective marks are likely to assume that they originate from the same source or that there is some association between their sources. See *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989) and the cases cited therein. Here, while "antique" dolls and "collectible" dolls are not identical, there is an obvious relationship between the two categories of dolls, both being the object of doll collectors, and, thus, there is the likelihood that persons encountering the two types of dolls under similar marks might assume that there is, at the very least, some association between the sources of the "antique" and the "collectible" dolls.

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Furthermore, there is a definite overlap in the channels of trade and of purchasers for the dolls, be they "antique" or "collectible." While respondent argues that its dolls are sold predominately at doll shows, with only a few being sold by mail order, and petitioner sells his dolls at a retail store or by mail-order, no meaningful distinction can be made on this basis. Respondent's registration is not restricted to any particular manner of distribution or sale, and thus must be assumed to include all the normal channels of trade for goods of this type. See *Sarah Coventry Inc. v. T. Sardelli & Sons*, 179 USPQ 630 (TTAB 1973). Although respondent may presently sell most dolls at doll shows, respondent might well change its manner of sale in the future, so as to concentrate more on the mail-order sales, a method of distribution often used by petitioner.

Even more significantly, we find evidence of record that there are doll collectors who are interested in both antique and the newer dolls. Shirlee Funk, as a doll collector, testified that she collected dolls from "all periods ...antiques as well as nonantiques." [Test 5:1-3]. She also testified that the customers of respondent might include collectors of antique dolls and that it was possible that a person might collect both antique dolls and Japanese dolls such as those offered by respondent. [Test 11: 6-13].

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While respondent has introduced testimony to the effect that Ms. Bailey would be not allowed to set up in a strictly "antique" doll show, Nancy McCray did state that "if it was antique and collectibles, then she could have a booth." [Test. 12:13-16]. Accordingly, purchasers already familiar with petitioner's sale of antique dolls under his SECOND CHILDHOOD mark might well encounter respondent's collectible dolls being offered under a similar mark.

In addition, even though the relevant purchasers may be sophisticated doll collectors, and clearly not buying these expensive dolls on a whim, we find the potential for confusion on the part of these purchasers when faced with the sale of two types of dolls under SECOND CHILDHOOD marks. Although doll collectors may be knowledgeable with respect to dolls, this does not mean that they are sophisticated in the field of trademarks or immune from confusion as to the source or affiliation of the respective dolls. See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992) and the cases cited therein. Once again, we emphasize that in view of the broad identification of respondent's goods in its registration as "collectible dolls," respondent cannot rely upon any uniqueness of the Japanese dolls which it presently sells under the mark to overcome a holding of the likelihood of confusion.

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Petitioner has also argued the strength of his mark, and has pointed to the evidence introduced to show recognition by others of the "fame" of his mark. While we agree that the evidence is adequate to show recognition, at least in the New York City area, of petitioner and his sale of antique toys and dolls under his SECOND CHILDHOOD mark, we do not consider this evidence rises to the level of demonstrating that petitioner's mark is a famous or extremely strong mark in the field of doll collecting in general.

The only other factor which petitioner has raised is that of actual confusion. Petitioner points to his own testimony with respect to customers' inquiries about a store or business in Iowa and to the three declarations from doll collectors submitted in connection with his motion for summary judgment in which they uniformly stated that they were "informed that there was another company in Iowa" and they "assumed it was the same company" [as the store in New York].

Respondent argues that petitioner's evidence fails to show any actual effect on purchasers' decisions to buy. Respondent questions the failure of Mr. Van Dexter to be able to identify any of the customers asking about the "Iowa store" and labels his testimony hearsay. As for the three declarations submitted by petitioner, respondent argues that

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the declarations are incomplete with respect to the type and amount of information given to the declarants and that once again there is no evidence of any effect on a purchasing decision. Respondent also points to the six years of concurrent use by the parties of their marks, prior to petitioner's learning of respondent, without any evidence of actual confusion.

Petitioner, by his testimony, has shown that he first learned of respondent by a customer inquiry and that there have been further inquiries about a business in Iowa operating under a similar mark. His testimony when considered to this extent is not hearsay. See *Towers v. Advent Software Inc.*, 17 USPQ2d 1471, 1473 (TTAB 1989). At the same time, this testimony is far from demonstrative of any actual confusion on the part of potential purchasers. The three declarations from doll collectors are sketchy and of little probative value. All in all, we find the evidence of any actual confusion to be minimal. Nonetheless, evidence of actual confusion is not essential to proving likelihood of confusion, but rather is only one factor to be taken into consideration. See *Hilson Research Inc. v. Society for Human Resource Management*, *supra*. In a similar vein, although petitioner has presented the testimony of three witnesses as to the potential for confusion, we find this to be of little probative weight, especially since this

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is a legal conclusion for us to make on a full review of the evidence with respect to the relevant du Pont factors.

Upon making this review, we find that the similarities of petitioner's and respondent's marks, the similarities of petitioner's services and respondent's goods and the similarities of the channels of trade and potential customers clearly outweigh any other factor which might be resolved in respondent's favor. Petitioner has established that there is a likelihood of confusion with the contemporaneous use by the parties of their marks for the services and goods involved.

Decision: The petition to cancel is granted.

C. E. Walters

H. R. Wendel

D. E. Bucher
Trademark Administrative Judges,
Trademark Trial and Appeal Board