This Opinion is Not Citable as Precedent of the TTAB

Mailed:
June 18, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Hasbro, Inc.
v.
Lisa Pinkett

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Opposition No. 91123661
to application Serial No. 75462017
filed on April 3, 1998

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Kim J. Landsman and Estella J. Schoen of Patterson, Belknap, Webb & Tyler LLP for Hasbro, Inc.

Charles A. Wilkinson, Esq. for Lisa Pinkett.

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Before Seeherman, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Lisa Pinkett [applicant] has filed an application to register the mark LIL' TIGER for a wide variety of goods in four different classes, as follows:

> Records, cassette tapes, video tapes, compact discs, video discs, laser discs and computer software, all featuring educational and adventure themes for children; tape players, record players, compact disc players, video disc players, in Class 9;
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> Stationery featuring educational and adventure themes for children, in Class 16;

> Clothing, namely, shirts, pants, t-shirts, sweat shirts, sweatpants, sweaters, dresses, hats, coats, jackets, caps, rain coats, belts, mittens, gloves, shoes, sneakers, boots, slippers, sandals, nightgowns, robes, pajamas, sleep wear, underwear, socks, and swimwear, in Class 25; and
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> Toys, namely, board games, toy banks, puzzles, squirt guns, toy phones, flying discs, skates, doll houses, make-up kits, toy vehicles, building blocks in the form of geometric shapes, toy jewelry, swing sets and gymnastic apparatus, sand boxes, toy swimming pools, toy wagons and toy wheelbarrows, in Class 28.

The application is based on applicant's statement that she has a bona fide intention to use the mark in commerce on or in connection with each of these goods.[1]

The Pleadings

Hasbro, Inc. [opposer] has opposed registration of the mark for any of the identified goods in each of the four classes. In its notice of opposition, opposer asserts that it "is the owner of the distinctive TIGER trademark, Registration No. 1,696,222, which was registered on the Principal Register on June 23, 1992 in International Class 28 for 'toys; namely, dolls; board games; electronic games; battery operated, portable hand-held games with LCD adapters; table-top games; toys with synthetic speech capabilities; [and] educational games.'" Opposer also

[1] Opposer, in the notice of opposition (¶ 3), appears to acknowledge use by applicant of her mark as of January 1, 1997, but the application was never amended to assert this or any date of use and it is clear from the record there has been no use.

asserts ownership of a dozen other trademarks that include the term "Tiger"; that the filing date for each of the applications that resulted in issuance of these registrations is prior to the filing date of applicant's application; that opposer has been using TIGER and variations thereof continuously since September 25, 1979; that opposer has sold a great number of toys and games under its TIGER marks and extensively advertises its products; that the goods on which applicant intends to use her LIL' TIGER mark "are the same or substantially similar to" goods opposer sells under its TIGER marks; that clothing and stationery are the types of goods for which opposer could easily license its toy marks; that opposer's and applicant's goods are both intended "for the children's market" and are expected to travel in the same channels of trade; and that there is a likelihood that consumers will be confused, mistaken or deceived about the source or sponsorship of applicant's goods and wrongly conclude that they are products of or authorized by opposer, all to opposer's detriment.

In her answer, applicant admitted opposer's allegation that opposer owns the TIGER trademark, Registration No. 1,696,222, and that opposer "owns various other registrations." Applicant also admitted that she intends to use her mark for goods recited by opposer in the notice

of opposition and that some of these goods are intended for children. Otherwise, applicant explicitly or effectively denied the allegations of the notice of opposition. Applicant included in her answer several paragraphs entitled affirmative defenses; however, these are not true affirmative defenses and amount to nothing more than explanations of why applicant believes there is no likelihood of confusion.

The Record

The record consists of one notice of reliance filed by each party and a testimony deposition with 11 accompanying exhibits filed by opposer (with 10 of the exhibits introduced during direct testimony elicited by opposer's counsel and one exhibit introduced during cross examination). Opposer's notice of reliance "introduces into evidence copies of … official records of the Patent and Trademark Office," specifically, copies of its pleaded registrations; applicant's responses to opposer's interrogatories numbered 1 and 2 (including all subsections); and portions of the discovery deposition of applicant.[2] Applicant's notice of reliance seeks to

[2] The notice of reliance also lists the testimony deposition of Marc Rosenberg, opposer's witness, as "other evidence" on which opposer relies. We note that a party is obligated to file the transcript of testimony for any witness from whom testimony is taken, and it is unnecessary for either party to expressly notice reliance on all or any part of a testimony deposition. See

introduce records from the USPTO trademark electronic search system (TESS) regarding 45 third-party registrations for marks including the term "Tiger."[3]

In one section of its brief, opposer summarizes "The Current Proceedings" and closes its summary with a sentence requesting that the Board disregard applicant's notice of reliance as having been untimely filed. Specifically, opposer notes that applicant's notice was filed more than a month after the close of applicant's testimony period (i.e., during opposer's rebuttal period). Applicant, in her brief, did not respond to opposer's request, which we grant as conceded and well taken. See Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), and discussions in TBMP Sections 704.02 and 704.07 regarding time for filing notice of reliance on official records. Therefore, we have not considered the third-party registrations in reaching our decision herein.

The Parties

Applicant has not given direct testimony about her plans for using the LIL' TIGER mark on or in connection with the goods identified in her application. Nonetheless, by

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Trademark Rules 2.123(h) and 2.125, 37 C.F.R. §§ 2.123(h) and 2.125, and TBMP Sections 703.01(l). See also Sports Authority Michigan Inc. v. PC Authority Inc., 63 USPQ2d 1782, 1786 n. 4 (TTAB 2001).

[3] Applicant lists 47 registration numbers in her notice of reliance, but the attached copies of TESS records encompass only 45 registrations.

referring to the excerpts of the discovery deposition of applicant taken by opposer, we make the following findings of fact regarding applicant's plans. She developed the idea for an animated series featuring various characters, including one that would be named LIL' TIGER, in 1997. Pinkett discovery dep. pp. 35, 37. While applicant apparently has consulted with others who might aid her in creating the series, researched certain "animation houses," and consulted with others about how she might market the series and collateral merchandise, she has never used her mark. Id. at pp. 13-14, 17-18, 48-49, 57, 59-62. The products identified in applicant's application generally would be produced by licensees. Id. at p. 88.

Opposer acquired Tiger Electronics, Inc. in 1998, and its operations have gradually been merged into opposer's. Rosenberg testimony dep. p. 5. Tiger Electronics began operations in 1979, first used its TIGER logo covered by registration no. 1,696,222 in 1979[4], and has used it continuously since then, perhaps with some variations in the mark over time. Id. at pp. 7, 29. The company began in the hand-held electronic games market, later added "electronic

[4] The registered TIGER logo is shown below. The registration issued June 23, 1992 and lists September 25, 1979 as the date of first use and first use in commerce, of the registered mark.

learning toys," plush toys and dolls, robotic and "virtual" pets and eventually became "a full-service toy company," before being acquired by opposer. Id. at pp. 7-8. Opposer, through its Tiger subsidiary and, subsequently, division, has made toys under license from others and has licensed others to make collateral merchandise related to some of opposer's more successful toys and games. Id. at p. 8 (opposer has "made a lot of licensed learning toys with companies like World Book"), and pp. 10-11, 28, 35 and 38-39. Opposer does not license the registered TIGER logo for use by itself, but the logo is required to be used by any licensee that obtains a license involving a particular toy from opposer's line or a character from one of opposer's games. Id. at p. 43.

During both direct and cross examination, opposer's witness was asked to focus on the class by class identifications listed in applicant's application and to highlight items that have been the subject of licenses granted by opposer. Among the items said to have been produced by third parties under license from opposer have been phonograph players, videotapes, compact discs, tape players and compact disc players, stationery, shoes, sneakers, slippers, nightgowns, pajamas and t-shirts. Rosenberg dep. pp. 34-36 and 56-59. In addition, the witness characterized applicant's Class 28 identification as

"virtually off a licensing sheet from a master toy licensing agreement. So it would be almost all of the same things that we would look at doing." Id. at p. 36.

Arguments

The essence of opposer's argument is that it is the prior user of a TIGER mark, specifically, its registered TIGER logo already discussed herein; that the TIGER brand[5] is distinctive and valuable; that opposer's other marks including the term "Tiger" were adopted to capitalize on the recognition and good will attributable to the logo mark; that the TIGER trademark is inherently strong, because it is arbitrary in relation to opposer's goods, and the mark is famous among consumers of toys and games; that the goods identified in opposer's TIGER logo registration and in applicant's application overlap and are otherwise related; that opposer has licensed use of its marks on other products not listed in opposer's registration but which are the same as or similar to various items listed in applicant's application; that opposer and applicant will utilize the same channels of trade and market their respective products to the same classes of consumers; that these common consumers will not be sophisticated and will often make impulse purchases; that applicant was aware of opposer's

[5] We have construed references by opposer to its TIGER trademark to mean the TIGER logo.

TIGER mark when she adopted her LIL' TIGER mark and may have intended to capitalize on opposer's good will; and that, after weighing all the evidence, the Board must find a likelihood of confusion and sustain the opposition.

In her brief, applicant takes many liberties and cites to purported facts that have no support in the record. For example, applicant cites to portions of her discovery deposition that are not in the record[6], and she discusses the "existence of various other 'tiger' characters [which] should prevent Hasbro from expanding its rights to include all uses of the term 'TIGER'…." We summarize here only those arguments of applicant properly grounded in the record.

Applicant admits that "[n]o issue of priority is presented, since the 'TIGER & DESIGN' logo was registered in 1979 and has been maintained."[7] Brief, p. 5. Nonetheless, applicant asserts that that mark has distinctive design

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[6] A party generally may not put its own discovery deposition into the record by notice of reliance. When, however, the party's adversary has put portions of a discovery deposition into the record, the deposed party may offer other portions needed to provide proper context for the excerpts. See Trademark Rule 2.120(j)(4),37 C.F.R. § 2.120(j)(4). Here, portions of the discovery deposition applicant has cited were not made of record by either party.

[7] Applicant's erroneous reference to opposer's TIGER logo mark being registered in 1979 may have been adopted from opposer's brief, which also states that the mark was registered in 1979. The erroneous references by each party to the date of registration for this mark have no bearing on applicant's essential admission that the TIGER logo registration, whenever it issued, has been maintained.

elements and, because it is used always in that form, would be distinguishable from applicant's mark. Applicant also asserts that opposer's other marks including the term "Tiger" would be distinguishable from applicant's mark because they all contain a suffix after the term "Tiger" and applicant's mark contains the prefix "Lil'." She argues that opposer has presented no evidence of use of TIGER alone, i.e., without either the design elements of its TIGER logo or without a suffix term.

Applicant also argues there is insufficient evidence to support opposer's claim that its TIGER mark is famous and that it is more likely that opposer's sales success, for its own or for licensed products, is reflective of recognition of individual toy or game names rather than of the TIGER logo mark. When applicant's series is successful, she asserts, consumers will then recognize LIL' TIGER branded products as coming from an entity other than opposer. In any event, applicant asserts, even if opposer's TIGER logo were considered famous, that mark and applicant's mark would be distinguishable. Finally, applicant asserts that opposer has not shown that its various marks including "Tiger" and a suffix term constitute a family of marks, because there is no evidence of promotion of the marks as a family.[8]

[8] Applicant also argues that opposer's suggestion that applicant does not have a bona fide intent to use the LIL' TIGER mark is misplaced. Suffice it to say that opposer has not made much more

Discussion

We agree with applicant that the record does not support a Section 2(d) claim based on opposer's assertion that it owns a family of registered "Tiger" marks. There is no evidence in the record of promotion of "Tiger" as a family name and mere ownership of a multitude of registrations that include the same term does not establish the existence of a family of marks. See Colony Foods, Inc. v. Sagemark, Ltd., 735 F2d 1336, 222 USPQ 185 (Fed. Cir. 1984).

Turning to the individual registrations, we begin by noting that opposer has failed to put into the record copies of its pleaded registrations prepared by the USPTO and which show current status and title. The copies attached to opposer's notice of opposition do not show current status and title, nor do the copies submitted with opposer's notice of reliance.

The notice of reliance refers to the registrations as copies of "official records" not "status and title" copies prepared by the USPTO. To be sure, "plain" copies of third-party registrations qualify as copies of "official records"

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than an off-hand reference to such possibility and we have not considered this a true claim by opposer in this case. It was not a claim pleaded in the notice of opposition and opposer has not established that it was tried by express or implied consent of the parties.

and may be submitted under a notice of reliance. See, for example, TBMP Section 704.03(b)(1)(B). When, however, a party is utilizing a notice of reliance to put into the record registrations that it owns, it must put in copies prepared by the USPTO showing current status and title information regarding the registrations, if the party is to rely on the benefits provided by the Trademark Act that inure to the owner of a registered mark. See Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2), and TBMP Section 704.03(b)(1)(A). While in its brief opposer refers to the copies submitted with its notice of reliance as "status copies," merely calling them such does not change them from plain copies into copies showing current status and title.

Copies of opposer's registrations were introduced as exhibits to the testimony deposition of its witness, but the witness did not testify as to current status and title. In fact, when asked on cross examination whether opposer now owned the registrations originally obtained by Tiger Electronics, Inc., the witness testified "[t]hat would be a question better answered by the lawyers…." Rosenberg dep. p. 41.

Notwithstanding opposer's failure to make its pleaded registrations of record with its notice of opposition, or during its testimony period by appropriate testimony or by notice of reliance, applicant has essentially acknowledged

opposer's ownership of, and the current validity of, the TIGER logo registration (Reg. no. 1,696,222). In its answer to the notice of opposition, applicant admitted opposer's ownership of this registration. Answer, ¶ 1. Further, in its brief, applicant treats the registration as if it has been properly maintained and put into the record. Brief, p. 5 (see supra, notes 5 and 7). Thus, we consider this registration properly before us. See discussion in TBMP Section 704.03(b)(1)(A). On the other hand, we do not find applicant to have admitted both opposer's ownership of, and the maintenance of, opposer's other pleaded registrations.[9]

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[9] We note that applicant's answer admits opposer owns certain other registrations, and makes the admission in response to that paragraph from the notice of opposition that lists opposer's pleaded registrations in which "Tiger" is part of the registered mark. In addition, applicant also discusses opposer's other marks in terms of applicant's mark being distinguishable from marks of opposer that include the term "Tiger" and another suffix. On the other hand, applicant does not discuss the other marks individually and it is not clear whether she is discussing marks she considers to be registered and valid or marks that opposer merely claims to use in addition to its TIGER logo. In short, while it is absolutely clear that applicant has admitted the validity of the TIGER logo registration, and that it is owned by opposer, we do not view applicant as having clearly treated opposer's other pleaded registrations as properly of record, so as to obviate the need for opposer to properly put them into the record.

We note, however, that even if we had considered these other registrations to be properly of record, it would not change our finding that opposer has not established the existence of a family of marks. Nor would they change our decision, explained herein, to sustain the opposition as to two classes but to dismiss it as to the other two classes in applicant's application. This is because all but one of the additional registrations are for marks for electronic toys, games or learning aids in Class 28, and the other one is for computer game programs and manuals sold as a unit in Class 9. Thus, these registrations would only provide additional support for our decision to sustain the opposition as to Classes 9 and 28 but

The focus of our discussion is now limited to the question whether there is a likelihood of confusion between opposer's registered TIGER logo mark and applicant's LIL' TIGER mark. We analyze the issue of likelihood of confusion using the factors that were articulated in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted).

In many cases, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks").

The similarity or dissimilarity of the marks is assessed by comparing the marks as to appearance, sound,

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would not alter our decision to dismiss the opposition as to Classes 16 and 25.

connotation and commercial impression. Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). Moreover, it is well-settled that marks, when compared, must be considered in their entireties, not simply to determine what points they have in common or in which they may differ. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Nonetheless, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant has applied to register her LIL' TIGER mark in typed form, which means it could be displayed, when used, in any form of lettering. Thus, in comparing applicant's and opposer's marks in terms of appearance, we must consider all reasonable forms of display for applicant's mark. See Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) and Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992). It would be entirely reasonable for applicant to use a type font similar to that employed by opposer in its TIGER logo, though it would not be reasonable for us to assume that applicant would also present her mark with a tiger eyes and

tail design. The TIGER logo and LIL' TIGER, presented in similar fonts, would be visually similar to consumers, some of whom might not notice the subtle design elements in opposer's mark. We do not find the presence in applicant's mark of LIL' to be a ready means of distinguishing the marks, for in both opposer's demonstrated methods of use and in applicant's projected method of use, TIGER would be the dominant element of each mark.

Similarly, when the marks are articulated, the design elements in opposer's mark would be irrelevant and the diminutive LIL' in applicant's mark would not be stressed as much as would the term TIGER. More importantly, the marks would have the identical connotations of the mammal called a "tiger." The focus of applicant's mark is the word TIGER; LIL' merely is an adjective indicating the size of the tiger.

We find that the overall commercial impressions of the marks is very similar, particularly in view of the fallible memories of consumers, who retain general impressions of marks and cannot be presumed to have the luxury of being able to compare applicant's and opposer's marks side-by-side. Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992).

In terms of the similarity or relatedness of the involved goods, channels of trade and classes of consumers, we note that applicant's identification of goods is not restricted in any way. Likewise, there is no restriction in the identification of goods in opposer's TIGER logo registration. Accordingly, we must consider that applicant's and opposer's goods can be sold in all customary channels of trade and to all possible consumers for the identified goods. Octocom Systems, Inc. v. Houston Computers Services 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"). To the extent that the goods overlap or are closely related, they would, then, be expected to travel in the same channels of trade and to the same classes of consumers.

Both applicant and opposer identify goods in Class 28. Specifically, opposer's registration, in Class 28 alone, covers dolls, while applicant's Class 28 identification includes dollhouses; and both opposer and applicant list board games amongst their Class 28 products. In addition,

applicant identifies "toy phones" among its Class 28 products and we find these within the natural zone of expansion for opposer's mark, which is registered and used for electronic toys. In fact, exhibit one to the Rosenberg deposition shows various children's phones among opposer's 1999 TIGER product line. See Mason Engineering & Designing Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985) (First user of a mark in connection with particular goods possesses superior rights "as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark").

Given opposer's historical focus on hand-held electronic toys and games, we also find some of the items listed in applicant's Class 9 identification to be within the natural zone of expansion of opposer's use of its mark. For example, we consider tape players and compact disc players within opposer's natural zone of expansion and, in fact, a tape recorder and player is featured in opposer's 1999 catalog of TIGER products.

In contrast, we do not find the Class 16 stationery and the Class 25 clothing items to be within opposer's natural zone of expansion. While opposer's witness has testified about licensing of its FURBY character in conjunction with such products, the testimony is somewhat vague and general.

The witness does not testify when licensing would have been done or provide the names of licensees, and the testimony is not supported by any corroborating evidence of showing actual licensed products and how they might display the TIGER mark, as opposed to the FURBY character mark. Finally, we contrast the testimony with opposer's notice of opposition, which states that opposer "is not currently using the TIGER mark in a trademark sense on clothing or stationery…." Notice of opposition, ¶ 7.

The fame of a plaintiff's mark, when fame is shown in the record, is never an unimportant factor, for a famous mark deserves a broad scope of protection. Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); The Nasdaq Stock Market, Inc. v. Antartica, S.R.L., 69 USPQ2d 1718 (TTAB 2003). In this case, however, evidence of the fame of opposer's TIGER logo is extremely limited. In essence, it consists of the self-serving testimony of opposer's witness and a curt summary, assertedly prepared from opposer's business records, of gross sales figures and advertising/promotion/marketing expenditures from 1998 to 2001. Rosenberg dep. exh. 7. The figures are very substantial, but entirely devoid of context. We have no way of knowing whether, for example, the advertising and promotion dollars were spent on ads touting individual products, i.e., individual toys and

games, under their own product marks, or were spent on ads touting opposer's TIGER logo house mark. Nor do we know the relative percentage of these expenditures spent for print ads, television, radio, internet advertising or any other form of promotion. Further, we do not have a single advertisement or piece of promotional material that a consumer would be likely to see.[10] Finally, we note that both the sales and advertising figures have declined significantly during the four-year period covered by opposer's exhibit. We are not persuaded by this scant evidence, devoid of context, that opposer's TIGER logo has attained the status of a famous mark.

Even though we do not consider opposer's TIGER logo mark to be famous, for purposes of our likelihood of confusion analysis, we find that the balance of the *DuPont* factors tips in favor of finding a likelihood of confusion, in regard to applicant's Class 9 and Class 28 goods. On the other hand, the record created by opposer does not persuade us that there would be a likelihood of confusion if applicant were to use her mark for the identified Class 16 and Class 25 goods.

[10] Exhibits 1 and 2 to the Rosenberg deposition, catalogs showing TIGER brand products, are "basically a selling tool for all of our salesmen," according to the witness, not catalogs for consumers.

Decision: The opposition brought under Section 2(d) of the Trademark Act is dismissed as to Classes 16 and 25 of the involved application, but is sustained as to Classes 9 and 28.