

**THIS OPINION
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THE TTAB**

Mailed: November 15, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United States Postal Service
v.
Lost Key Rewards, Inc.

Opposition No. 91185802
to Application No. 77407614
filed on February 27, 2008

Jennifer A. Van Kirk, Flavia Campbell and Nathaniel Edwards
of Lewis and Roca and Karen Estilo Owczarski, Esq. for
United States Postal Service.

Carol N. Green of Law Offices of Carol N. Green for Lost Key
Rewards, Inc.

Before Walters, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

The United States Postal Service ("USPS" or "opposer")
filed its opposition to the application of Lost Key Rewards,
Inc. to register the mark shown below.¹ The application

¹ Application Serial No. 77407614 filed February 27, 2008, based upon
use of the mark in commerce, alleging dates of first use and first use
in commerce as of February 1, 2008, for each class of goods and
services. The application includes the following statements:
"The color(s) gold, dark orange, cherry red, medium blue, blue violet,
lime green, royal blue, white, baby blue, light silver gray, black,

includes a disclaimer of KEY and REWARDS apart from the mark as a whole.

Mark:



Goods:

"Encoded micro particulates, tags and taggants of plastic, metal or silicate for use in the field of passive labeling, tracing or tracking of persons, animals, vehicles or goods of any kind," in International Class 9;

"Plastic key tags," in International Class 20;

"Key return registration," in International Class 35; and

"Lost property return; Tracking services for retrieval of encoded products," in International Class 45.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods and services so resembles opposer's previously used and

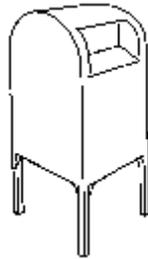
peach puff yellow, antique white and old lace beige is/are claimed as a feature of the mark," and
"The mark consists of Mail / Key Box-Royal Blue, with hint of a White oblong asymmetrical shading outline consisting also of Baby Blue this specifies the "indentation" on the top of the Royal Blue mail/key box. The front of mail/key box has a small Dark Royal Blue rectangular slot for mail or key. Hand-Peach Puff Yellow with a hint of Antique White and Old Lace Beige. Key Hub-Black with small Light Silver Gray drawn line inside of key hub. Key Shaft-Light Silver Gray. Background-Gold with tint of Dark Orange with White Hue. The "stylized" capitalized letters are "LOST KEY" are Cherry Red, with a small reflection of letters downward into the Background color. The "stylized" capitalized letters "R E W A R D S" are Medium Blue with a tint of Blue Violet. Banner-located under the word "R E W A R D S" is Lime Green."

registered marks, as shown below, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Registration No. 2711226

Mark: ("round-top mailbox design - front")

[Registered April 29, 2003, pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f); Sections 8 and 15 affidavits accepted and acknowledged]



Services:

"Sorting, handling, and receiving packages, letters and advertisements," in International Class 35; and

"Pickup, transportation and delivery of packages, documents, letters and advertisements by various modes of transportation," in International Class 39.

Description:

"The mark consists of a three-dimensional configuration of a mail collection box."

Registration No. 2708659

[Registered April 22, 2003, pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), in part, as to "UNITED STATES POSTAL SERVICE"; Sections 8 and 15 affidavits accepted and acknowledged]

Mark: ("round-top mailbox design - side")



Services:

Sorting, handling, and receiving packages, envelopes and letters," in International Class 35; and

"Pickup, transportation and delivery of packages, envelopes and documents, by various modes of transportation," in International Class 39.

Description:

The mark consists, in part, of the stylized head of an eagle.

In particular, opposer asserts that it uses its design marks in the color blue, that it has used the marks since 1908, and that the public has come to associate these marks with opposer. Opposer pleads that applicant has incorporated opposer's mark into its mark in its entirety, and that, particularly in view of the nature of applicant's services, confusion as to source is likely.

Additionally, opposer asserts a claim under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that applicant's mark comprises matter that may falsely suggest a connection with an institution, namely, the United States Postal Service ("USPS"). In particular, opposer

pleads that its round-top mailbox design is a symbol that is uniquely indicative of the USPS.

Applicant, in its answer, denied the salient allegations of the claim.

The Record

As in all oppositions, the record includes the pleadings and the file of the involved application. Opposer has made of record by notice of reliance photocopies of certified status and title copies of Registration Nos. 2711226 and 2708659; various specified responses of applicant to opposer's interrogatories and requests for admissions, and excerpts from various newspaper and magazine articles retrieved from the Nexis database. Opposer has also submitted the testimony deposition by opposer of Megaera M. Ausman, USPS historian, Krista Becker, USPS marketing specialist and former USPS licensing specialist, and Thad E. Dilley, USPS manager of brand equity and design and corporate communications, all with accompanying exhibits.

In addition to duplicates of other material already of record, applicant has submitted by notice of reliance its own discovery responses in their entirety, as discussed below, and excerpts from three newspaper and magazine articles retrieved from the Nexis database. Applicant has also submitted the testimony deposition of Marla LaVoice,

applicant's founder, CEO and president, with exhibits. Both parties filed briefs on the case.

Applicant submitted several exhibits with its brief. Exhibit C to the brief consists, in part, of an affidavit of Marla LaVoice. Opposer properly objected to this evidence in its reply brief. Not only is an affidavit improper in the absence of consent by opposer, but in this case the exhibit in its entirety is untimely to the extent that it adds evidence not previously made of record during trial. Opposer's objection is sustained and we have given no consideration to the evidence submitted with applicant's brief.

Applicant's Exhibit C to its notice of reliance consists of opposer's discovery requests and all of applicant's responses thereto. Opposer has objected to this evidence as improper. Applicant may not submit its own responses to discovery unless, in fairness, additional responses are necessary to overcome an allegedly misleading impression created by opposer's submission of applicant's discovery responses. See Trademark Rule 2.120(j)(4). Applicant has not submitted any written statement in this regard and, moreover, we do not find the discovery submitted by opposer to be incomplete or otherwise prejudicial. Therefore, we conclude that this evidence was improperly submitted; opposer's objection is sustained; and we have

given no consideration to Exhibit C to applicant's notice of reliance.

Factual Findings

Opposer has been using collection boxes in the shape shown in its two registrations for the USPS's sorting, handling, receiving and transporting of mail and packages since approximately 1894. Today, there are approximately 180,000 USPS collection boxes in this shape throughout the United States. The number of collection boxes was as high as 375,000 twenty years ago, but the number has been declining. Since 1971, the USPS collection boxes have been consistently one specific color of blue, which was described by witnesses variously as "navy blue" and "dark blue." The USPS conducts extensive advertising and promotion of its goods and services across a wide range of media. The collection box, in the noted shape and color blue, features prominently in much of this advertising and promotion. In fact, it was the centerpiece of a nationwide advertising campaign in 2000. The evidence shows that the color blue on the USPS collection box is as equally a prominent indicator of USPS origin as is the shape of the box alone. Thus, opposer has established that the particular color blue has acquired distinctiveness as used on a collection box for the sorting, handling, receiving and transporting of mail and packages.

Opposer has an extensive licensing program for all of its intellectual property, including the blue collection box in the noted shape. Opposer receives approximately a dozen requests per year to license the use of the collection box in connection with advertising for a wide range of goods and services. Opposer has licensed the use of the collection box in the blue color, but with modifications that slightly change and exaggerate the shape of the collection box, in the movies SHREK 3 and The Bee Movie. Opposer has licensed the use of the blue collection box in the noted shape to two entities that provide lost key services similar to those described by applicant. In these instances, the blue collection box is used to show that persons finding lost keys that are tagged may return the keys by dropping them in any USPS collection box. As with any other mail, for the appropriate fee the USPS delivers the keys to the address indicated on the tag. This licensed use predates both any date of use upon which applicant can rely and applicant's application filing date.

Applicant expressly admitted the validity of opposer's collection box design mark and its awareness thereof.

Applicant's case is based primarily on admissions and the testimony and accompanying exhibits of Dr. LaVoice, applicant's founder, CEO and president. Her testimony about her use of the mark in connection with the identified

services was contradictory and vague. However, we are able to make several findings, as follows, from this evidence. Applicant began developing the company in June, 2006 and, in February, 2008, applicant began marketing services under the mark to potential clients. Applicant has admitted that it was aware of opposer's mailbox design market at the time it developed and began marketing its services; that it markets its services to the general public, encompassing businesses and individuals; and that it intends to use opposer's delivery services and mailboxes, among others, for its lost property return services and tracking services for the retrieval of encoded products. Applicant also intends to provide a rewards program under the mark for the finders of lost keys/property.

At the time of trial, applicant's website was not available for viewing by the public and applicant did not have any clients.² Exhibit H to Dr. LaVoice's testimony is what Dr. LaVoice describes as a sales page shown to potential clients. It is difficult to read the text on the page, although it clearly contains applicant's mark thereon and the heading "Sales [-] Purchase Key Tag." Dr. LaVoice read the following statement from the middle of the sales page: "The Lost Key Rewards key tags instruct the key finder

² Applicant's use of its mark in connection with the identified goods and services is not at issue in this appeal and will not be addressed herein.

to place the lost keys in any U.S. mailbox for their safe return." Applicant is not a licensee of the USPS for any property.

The evidence of record also establishes that other mail delivery services, such as Federal Express, DHL, and UPS, use collection boxes in shapes and colors that are different from the shape and color of the USPS mailbox.

Analysis

Standing

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made its pleaded registrations of record (*see infra*) and demonstrated its use of these marks in the color blue since long prior to the filing date of applicant's application or any use date she might have established. Opposer's use and registration of its collection box design marks establish that opposer has standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

1. Section 2(d) Claim

Priority

In view of opposer's ownership of valid and subsisting registrations and its use noted above in connection with standing, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Additionally, opposer has shown its priority because it has established its use of the registered collection box in the color blue, and the acquired distinctiveness thereof, since long prior to the filing date of applicant's application or any use date she might have established.

Thus, the only issue to decide herein is likelihood of confusion.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531

(Fed. Cir. 1997). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The relevant *du Pont* factors in the proceeding now before us are discussed below.

Fame

The evidence establishes without question that the USPS collection box, *i.e.*, its shape and blue color, is "famous" as that term is used in Trademark law. The broad exposure of the general public to the USPS collection boxes in the noted shape and color, as well as the representation of the collection boxes on stamps, in movies and other media have rendered the collection box in the noted shape and color a ubiquitous symbol of the USPS.

The Marks

We examine the similarities and dissimilarities of the involved marks as to their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve*

Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d at 1692.

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Further, as the fame of a mark increases, as in the case of opposer's famous blue collection box design mark, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1305 (Fed. Cir. 2002).

Applicant's word and design mark consists of a yellow rectangular background with the words LOST KEY featured prominently above the slightly smaller word REWARDS. Only slightly less prominent than the words LOST KEY is the hand holding a key and dropping it into a collection box. While the collection box is not identical to the USPS collection box design marks, it is substantially similar in certain key elements, namely, that it stands on legs, that it has a curved top, and that it is blue. Each of these features is

the same as the USPS collection box and different from the shape and color of the USPS competitors' collection boxes shown in the record. In view of the fame of opposer's collection box design marks and the nature of applicant's goods and services, the relevant consumers, *i.e.*, the general public, are very likely to believe that the collection box depicted in applicant's mark is the USPS collection box design mark.

The words KEY and REWARDS are disclaimed in applicant's mark. The nature of applicant's services is the tagging of keys and other property so that when keys or property are lost, the finder thereof can simply put the key or other property in a USPS or other mail collection box to return to the owner. Applicant intends to give a reward to the finder who so returns the key or property. Thus, the design either merely describes or is highly suggestive of the specific nature of applicant's services. Additionally, the words LOST KEY REWARDS are, if not merely descriptive of a significant aspect of applicant's services, at least highly suggestive therewith. As such, and in view of the size of the design relative to the words as well as the fame of the USPS blue collection box, we find that the blue collection box in applicant's word and design mark is at least equally prominent to the word portion of the mark.

Because of the established fame of opposer's collection box design marks, we find that applicant's mark as a whole is sufficiently similar in at least appearance, connotation and commercial impression to opposer's collection box design marks that, if used in connection with the same, similar or related goods and/or services, confusion as to source is likely.

The Goods and Services

It is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in applicant's application vis-à-vis the goods

and/or services identified in opposer's pleaded registrations and in connection with which it has established use of its marks. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

Applicant's services are identified as:

"Encoded micro particulates, tags and taggants of plastic, metal or silicate for use in the field of passive labeling, tracing or tracking of persons, animals, vehicles or goods of any kind," in International Class 9;

"Plastic key tags," in International Class 20;

"Key return registration," in International Class 35; and

"Lost property return; Tracking services for retrieval of encoded products," in International Class 45.

Opposer's services are identified in its registrations as:

"Sorting, handling, and receiving packages, envelopes and letters," in International Class 35; and

"Pickup, transportation and delivery of packages, envelopes and documents, by various modes of transportation," in International Class 39.

Additionally, opposer has established that it has licensed its blue mailbox design mark to businesses that utilize tags to provide lost keys/property retrieval and return services

via the USPS and use the USPS collection box design in connection with these services.

Essentially, each of the goods identified in the application is a necessary and significant aspect of applicant's services as identified. Likewise, these goods, or very similar goods, would be necessary and significant aspects of opposer's licensees' similar services. Since opposer's licensees' use inures to opposer's benefit, we find that applicant's goods are at least related to the tracking devices that opposer's licensees must use.

Applicant's identified services are identical in purpose to the key return services rendered by opposer's licensees, utilizing similar methodology, *i.e.*, a form of tagging and return of property via the USPS. As such, the respective services are closely related. Moreover, since applicant's services utilize opposer's services as an integral part thereof, and opposer's mark is famous, the services are sufficiently similar that, if identified by substantially similar marks, confusion as to source or sponsorship is likely.

Section 2(d) Conclusion

We find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion. We conclude

that consumers familiar with opposer's services rendered and licensed under its blue collection box design mark would be likely to believe, upon encountering applicant's design mark, that applicant's goods and services originate from or are associated with or sponsored by opposer.

2. Section 2(a) Claim

Opposer contends that, under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), applicant's mark comprises matter that may falsely suggest a connection with an institution, namely, the USPS. In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection claim, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in *Notre Dame*, required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate the following:

- 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- 2) that the mark would be recognized as such;

3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and

4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.

In re MC MC S.r.l., 88 USPQ2d 1378, 1379 (TTAB 2008); *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998); *In re Sloppy Joe's Int'l Inc.*, 43 USPQ2d 1350, 1353 (TTAB 1997).

Section 2(a) refers to a false suggestion of a connection with a person or institution, which includes government agencies. *In re Peter S. Herrick P.A.*, 91 USPQ2d 1505 (TTAB 2009) and cases cited therein. See also *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218 (Fed. Cir. 2009) and cases cited therein. The USPS is an independent governmental organization that was explicitly authorized in the United States Constitution (Article 1, Section 8, Clause 7) and became the entity it is today by Act of Congress in 1983. There is no question that the USPS is an institution within the meaning of Section 2(a). Moreover, as previously discussed herein, opposer has established that its round-top mailbox design is a famous mark and a symbol that is ubiquitous and uniquely indicative of the USPS.

Also as discussed above in connection with the Section 2(d) claim, not only is the design portion of applicant's mark an integral and equal part of the overall commercial impression engendered by the mark, but the collection box depicted in applicant's mark is substantially similar to the USPS collection box design and it is a similar color blue. Additionally, the nature of applicant's goods and services include the deposit of lost keys in a USPS collection box for return to their owner. This act of depositing a key in a USPS collection box is depicted in the design portion of applicant's mark. Thus, applicant's mark is a close approximation of the identity of the USPS.

Because the evidence of record shows that competing private delivery services use collection box designs that are different in shape and color from the USPS collection box and from each other, applicant's use in its mark of a collection box substantially similar to the USPS collection box points uniquely and unmistakably to the USPS.

While the record shows that the USPS has licensed the use of its blue collection box design to numerous third parties, including at least two parties who offer retrieval and return of lost items through the USPS, applicant has admitted that it is not a licensee of the USPS and has no other connection to the USPS. Also, as discussed above, the fame of the USPS collection box design and color is such

that applicant's use of the blue collection box in its mark will lead consumers to presume that applicant has a connection with, or its services are authorized by, the USPS.

In conclusion, we find that applicant's mark falsely suggests a connection with the USPS thereby precluding registration under Section 2(a).

Decision: The opposition is sustained on the grounds of Sections 2(d) and 2(a) of the Trademark Act, and registration to applicant is refused.