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November 12, 2019

Small Paws Rescue, Inc.
Attn. Robin Pressnall
3316 S. 72nd W. Ave.
Tulsa, Oklahoma 74107

SENT BY CERTIFIED MAIL RETURN RECEIPT

RE: Alleged Trademark Violation

Dear Miss Pressnall:

As mentioned in our letter dated 11.05.19, our firm has reviewed Small Paws Rescue Inc.'s allegation of trademark infringement. In each case of trademark infringement allegation, the court's standard is the same - is it probable, under all of the circumstances, that consumers of the relevant goods will be confused. We find there is no confusion based on the following case law, statutory law, and the facts. When determining likelihood of confusion, courts use several factors derived from a 1961 case. (*Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961).) These factors, are sometimes known as the "Polaroid factors."

Every federal circuit in the United States uses a multi factor analysis such as the Polaroid factors or the Lanham Act (15 U.S.C. §§ 1051 et seq.) factors in determining if there is a likelihood of confusion. Although the number of factors may vary from each federal circuit, the principles are similar and all relate in some way to consumer perception.

Strength of the Mark

A mark is "weak" if it is descriptive and has not acquired sufficient secondary meaning. The owner of a weak mark will have difficulty proving likelihood of confusion. Secondary meaning



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does not require proof that consumers know the name of the company that owns the trademark, rather, it requires that consumers associate the mark with a single commercial source. There is no single commercial source for, "small paws". For example, a stroll down the grocery store aisle or pet store will clearly show other companies using the words, "small paws", such as "Science Diet Small Paws Dog Food", and "Science Diet Adult Small Paws Chicken Meal", etc. Packaging of Science Diet dog food will clearly show, "Small Paws" and then the trademark symbol next to it. There are a number of other companies using "small paws" in their name.

Similarity of the Marks

As a general rule, marks must be compared in their entirety, including appearance, sound, connotation, and commercial impression. In dissecting and comparing the elements of each mark, the following is true:

Appearance

The Small Paw Rescue, Inc. logo is generically block printed in white font and has five dogs on it, while the OC Small Paws Rescue, Inc. logo is distinctively designed in cursive and orange colored, with cats below it. There is no similarity.

Sound

The sounds of the names of the organizations are distinctive.

Connotation

A connotation will be said to arise when a trade mark, as a whole or in part, conveys a secondary meaning or an associated meaning to a thing, person or place. "Small paws" does not carry a



commonly understood cultural or emotional association. As stated above in detail, there is no single commercial source for, "small paws", so therefore there is no secondary meaning or connotation.

Commercial Impression

When the average consumer hears the phrase, "small paws" they think of "Hill's Science Diet Small Paws Dog Food", not a charity. Consumers think of over ten different Hill's Science Diet Pet Foods such as "Science Diet Small Paws Dog Food", "Science Diet Adult Small Paws Chicken Meal", etc. Packaging of Science Diet dog food will clearly show, "Small Paws" and then the trademark symbol next to it.

Similarity of the Goods

The standard of infringement is whether an ordinary prudent purchaser would be likely to purchase one item, believing he was purchasing the other. As a general rule, a trademark owner is permitted to use a similar mark as long it is on dissimilar goods. For example, Small Paws Rescue, Inc. is only associated with rescuing a specific breed of dog called the Bichon. OC Small Paws, Inc. is only focused on saving cats from high-kill shelters. There are no related products or services.

The courts also consider the similarity of the advertising and distribution channels. Many courts weigh this evidence separately to determine if consumers or distributors may be exposed to potential confusion. For example, OC Small Paws, Inc operates in California. How can there be a similar advertising or distribution channel when Small Paws Rescue, Inc., has been delinquent in their charitable registration status with the California Department of Justice, Office of the Attorney General since 2017?



Degree of Care Exercised By the Consumer

The degree of care exercised by the consumer varies according to the purchase. Generally, a buyer or donor with excess disposable income for a charity is more likely to be discriminating and is less likely to be easily confused as to similar marks. The reason for this higher degree of care is because the consumer donates money to charities less frequently. Therefore the courts assume that such donors are likely to be more discriminating and source-conscious when donating. Under these circumstances, the courts require a more substantial showing of similarity to justify a claim of likelihood of confusion.

Defendant's Intent

The defendant's intent is a relevant factor in proving infringement. According to the Restatement of Trademarks, it is appropriate to consider the defendant's intent because a party intending to cause confusion will generally be successful in doing so. Direct evidence of the defendant's alleged intention to deceive is unavailable. OC Small Paws, Inc. has never even heard of your organization. In actuality, most consumers have never heard of your organization, or even know of the description of a Bichon dog. There is no bad faith on the part of OC Small Paws, Inc.

OC Small Paws, Inc.'s only intention is to save cats from being killed, not to draw away donations from Bichon dogs.

Likelihood that the senior user will bridge the gap.

If it is probable that the senior user will expand into the other user's product area, the more likely there will be confusion. In this case, Small Paws Rescue, Inc. only deals with saving Bichon dogs. They have never, do not have, and will have no reasonable desire to move beyond



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Bichons. The Small Paws Rescue, Inc. web site clearly and unequivocally states, "*Each breed has a rescue organization for their breed...Small Paws has rescued over 15,000 Bichons in the past 20 years from across the country.*" In over 20 years of operations, Small Paws Rescue, Inc. has never rescued a cat from being killed. To imply they may suddenly start now is disingenuous.

Quality of the junior user's products or services.

In some cases, the lesser the quality of the junior user's goods, the more harm is likely from consumer confusion. In this case, OC Small Paws, Inc. service approach is of such high quality that the number one pet retailer in the world has selected OC Small Paws, Inc. to perform cat rescues at their retail locations.

Actual Confusion

There is no alleged, credible, or material proof of actual confusion between these two charities. Small Paws Rescue, Inc. is only associated with rescuing a specific breed of dog called the Bichon. OC Small Paws, Inc. is only focused on saving cats from high-kill shelters.

OC Small Paws to date has never been approached by a potential donor who thought they were associated with the Small Paws Rescue, Inc. charity or Bichon dogs.

Based on the aforementioned legal analysis, under all the circumstances, we find there is no reasonable confusion among consumers, and we demand that you cease and desist your business interference with OC Small Paws, Inc.

We are disappointed that Small Paws Rescue, Inc. has decided to exceed their scope of trademark status protection by manipulating social media sites into removing OC Small Paws,




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Inc.'s sites. To think of all the cats that have been killed, or will be killed by your actions in damaging the donations and reputation of OC Small Paws, Inc. is horrific. OC Small Paws, Inc. would like to think that an organization such as Small Paws, Inc. that is dedicated to saving the lives of dogs, would be equally interested in saving the lives of cats.

Notwithstanding the above evidence, OC Small Paws, Inc. would like to know if you would be interested in avoiding any potential negative publicity; as OC Small Paws, Inc. would like to focus its resources on saving cats from being killed, rather than this dispute. In this spirit, OC Small Paws, Inc. would be willing to have a conversation to discuss potentially drafting a disclaimer on their sites to the effect that they are not associated with Small Paws Rescue, Inc. Additionally, OC Small Paws, Inc. would also be willing to have a conversation regarding cross marketing that would likely benefit both charities by increasing awareness and driving donation increases.

If you would be interested in discussing, please contact my firm within 10 business days so that we may schedule a call.

Regards,



Jonathan Wasylenko
Attorney At Law