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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial No. 76/295,724
Published in the Official Gazette of August 20, 2002

-----	x
BLUE MAN PRODUCTIONS, INC.,	:
	:
Opposer,	:
	:
v.	Opposition No. 91 154,055
	:
ERIC TARMANN,	:
	:
Applicant.	:
-----	x

OPPOSER’S BRIEF ON FINAL HEARING

PRELIMINARY STATEMENT

Opposer Blue Man Productions, Inc. (“Opposer” or “BMPI”) owns registrations for the famous BLUE MAN GROUP mark (the “Mark”) covering “entertainment services in the nature of live musical and theatrical performances” in International Class 41, “apparel, namely hats, t-shirts, sweatshirts” in International Class 25, and “musical sound recordings” in International Class 9. Opposer also owns pending applications to register the BLUE MAN GROUP mark for “mugs” (App. Ser. No. 76/385,635), “watches and ornamental pins” (App. Ser. No. 76/385,636), “clothing, namely jackets and caps” (App. Ser. No. 76/385,637), and

“prerecorded videos” (App. Ser. No. 76/385,638). Collectively, these goods and services are referred to hereafter as “Opposer’s Goods and Services.” Through extensive sales, advertising and promotion since the 1980s, Opposer has built up enormous goodwill in the Mark, so that today, the Mark is nationally and internationally famous for the Opposer’s Goods and Services.

On August 6, 2001, Applicant Erich Tarmann (“Applicant”) filed an application, serial number 76/295,724, to register the BLUEMAN mark for “tobacco, smokers’ articles, namely, cigarettes.” Because Applicant has applied to register its BLUEMAN mark for goods which are targeted to the same broad and non-specific class of purchasers as are Opposer’s Goods and Services, the relevant public is likely to believe that Applicant’s goods and services originate with BMPI or are sponsored, endorsed, approved or connected with BMPI and its famous BLUE MAN GROUP Mark. In view of the strength of Opposer’s Mark, the virtual identity of Applicant’s mark to Opposer’s Mark in respect to sight, sound and meaning, and the fact that the parties’ respective goods and services all target the same broad and unspecified class of purchasers, i.e., the public at large, the Board should sustain this opposition.

As a second ground of Opposition, Opposer alleges that because Applicant’s mark for tobacco products so closely resembles Opposer’s famous and distinctive BLUE MAN GROUP mark, Opposer’s mark will suffer a dilution of its distinctive quality and of the enormous goodwill which Opposer has built up in the BLUE MAN GROUP mark.

PROCEEDINGS

On August 6, 2001, Applicant filed an application, serial number 76/295,724, to register the BLUEMAN mark for “tobacco, smokers’ articles, namely, cigarettes.” The application claims a date of first use “at least as early as March 6, 2000,” but Applicant now also asserts priority under the Madrid Protocol, based on a Swiss registration, No. 171,796, dated December 4, 1997, for BLUEMAN AMERICAN BLEND. See Applicant’s Motion to Dismiss for Failure to Prosecute, for Judgment on the Pleadings, or Alternatively, for Summary Judgment, dated February 23, 2004, at 2.¹ The application was published for opposition in the Official Gazette on August 20, 2002.

On December 3, 2002, BMPI commenced this opposition on the ground that (1) Applicant’s mark so closely resembles Opposer’s Mark as to be likely, when applied to Applicant’s goods and services, to cause confusion, to cause mistake, or to deceive because the public is likely to believe that Applicant’s BLUEMAN tobacco products have their origin with Opposer and/or that such goods or services are approved, endorsed, or sponsored by Opposer or associated in some way with them; and (2) Applicant’s mark so closely resembles Opposer’s Mark as to be likely, when applied to Applicant’s goods and services, to dilute the distinctive quality of the BLUE MAN GROUP mark, which had become both famous and distinctive prior to Applicant’s claimed first use date. Applicant answered, denying the allegations.

¹ Opposer notes that the Swiss registration asserted by Applicant as a basis for its claimed Madrid Protocol priority date is not for the same mark that is at issue in this proceeding, i.e., BLUEMAN, but rather pertains to a different mark, BLUEMAN AMERICAN BLEND. This registration should therefore have no bearing on the outcome of this proceeding.

As its trial testimony, BMPI has submitted: (1) the trial testimony of Laura Camien, marketing director of Opposer, taken on July 15, 2004, and exhibits thereto ("Camien Tr."); (2) a Notice of Reliance dated January 21, 2004 with a certified copy of BMPI's federal registrations for the BLUE MAN GROUP Mark ("Not. of Rel./Registrations"); (3) a Notice of Reliance dated January 21, 2004, which contains articles, videotapes, and promotional materials, showing that Opposer's Mark and the goods and services bearing or connected to the same have been the subject of numerous articles and broadcasts in publicly-circulated media ("Not. of Rel./Articles"). Applicant submitted no trial testimony.

Applicant moved on February 23, 2004 to dismiss for failure to prosecute, for judgment on the pleadings, or in the alternative, for summary judgment. Applicant further moved on that same date to strike Opposer's Notice of Reliance concerning media coverage of Opposer. Opposer responded to both motions and incorporates its responses herein by reference. By an Order dated April 1, 2004, the Board denied the motion to dismiss and the motion for summary judgment as untimely filed. In that same Order, the Board deferred decision until final hearing on Applicant's motion to strike because "said motion is based entirely on substantive grounds," and accordingly also denied the motion to dismiss as premature.

STATEMENT OF ISSUES

(1) Whether the BLUEMAN mark that Applicant has applied to register so closely resembles Opposer's BLUE MAN GROUP mark as to be likely, when applied to Applicant's goods, to cause confusion, or to cause mistake, or to deceive because the public is likely to believe that Applicant's BLUEMAN tobacco products have their origin with Opposer and/or

that such goods or services are approved, endorsed, or sponsored by Opposer or associated in some way with them.

(2) Whether the BLUEMAN mark that Applicant has applied to register so closely resembles Opposer’s BLUE MAN GROUP mark as to be likely, when applied to Applicant’s goods, to dilute the distinctive quality of the BLUE MAN GROUP mark, which had become both famous and distinctive prior to Applicant’s claimed first use date.

FACTS

The Mark has been used since the 1980s in connection with Opposer’s Goods and Services. Throughout the decades, Opposer has continued to use and build up enormous goodwill in the Mark. BMPI owns the following federal registrations for the BLUE MAN GROUP mark:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods/Services</u>
BLUE MAN GROUP	2,450,660	5/15/01	Entertainment services in the nature of live musical and theatrical performances
BLUE MAN GROUP	2,438,222	3/27/01	Gift items, namely, decorative magnets; paper goods, namely, postcards and posters; apparel, namely, hats, t-shirts, sweatshirts
BLUE MAN GROUP	2,617,550	9/10/02	Musical sound recordings

Opposer’s Mark is among the most famous in the field of live theatrical entertainment. Since the 1980s, the BLUE MAN GROUP mark has sold more than seven million theater tickets in the U.S. (Not. of Rel./Articles, Meadville Tribune), and continues to sell them at a rate of ten thousand per week. (Not. of Rel./Articles, Pittsburgh Post-Gazette). Its Las Vegas production alone, still running at the Luxor Hotel & Casino, generates more than \$3 million each month in ticket sales. (Not. of Rel./Articles, Ad Age, Oct. 8, 2001). In

addition, Opposer has sold hundreds of thousands of copies of its Grammy-nominated sound recordings (Not. of Rel./Articles, What's On, at 108; Pittsburgh Post-Gazette), and has appeared as a featured performer on nationally popular television broadcasts including the following:

The Tonight Show with Jay Leno (appearances on 6/1/92, 9/21/92, 11/8/93, 5/20/94, 11/13/97, 12/31/99, 6/28/00, 4/22/03, 6/13/03, 8/8/03, 9/22/03)

The 43rd Annual Grammy Awards (2/21/01)

NBC A Closer Look (1991)

Live With Regis & Kathie Lee (1992)

Live With Regis and Kelly (11/5/01, 11/25/01)

Entertainment Tonight (11/93)

CNN Headline News (9/24/03, 9/23/03, 4/29/01)

The Today Show (4/22/03)

The Drew Carey Show (11/14/01)

ABC 4th of July Special (7/4/01)

The Simpsons (5/20/01)

CBS Sunday Morning (5/20/01)

(Not. of Rel./Articles)

Expenditures for television advertisements featuring the Mark, in connection with the sale of Intel computer chips, have exceeded \$550 million. (Camien Tr. at 9).² Such

² The advertisements, for Intel computer chips in the Pentium 3 and Pentium 4 series, were produced with the active creative involvement of Opposer, and five of the seven commercials were based on ideas that originated with Opposer. All ads featured the Opposer's BLUE MAN GROUP mark, and as described in Fortune Small Business, "they

advertisements have appeared on such popular television programs as Super Bowl XXXIV, Friends, The X-Files, and The Drew Carey Show. (Camien Tr. at 9).

Opposer and its goods and services sold under the Mark have also been prominently featured in numerous articles in publicly circulated media over the last twenty-five years, including the following early examples:

- 1988: Details (feature w/photo)
- 1989: Details (feature w/photo)
Village Voice (feature w/photo)
New York magazine (feature w/photo)
- 1990: Show Business (front page, feature w/photo)
- 1991: Village Voice (feature w/photo)
New York Times (featured review w/photo)
American Way magazine (feature w/photo, "Blue-Man Fandom")
Vanity Fair (feature w/photo)
New York Times (review of "Serious Fun" arts festival at Lincoln Center)
New York magazine (feature w/photo)
Theater Week (cover photo and feature story)
Frank Rich, WQXR Radio (review)
Stagebill (Lincoln Center "Serious Fun" arts festival)
- 1992: The Nation magazine (featured review)
Time magazine (feature w/photo)
Esquire magazine (feature w/photo)
Variety (featured review)
"The Edge" (PBS television program, featured segment)
New York Daily News (celebrity page, feature w/photo, describing how Opposer "leaped onto the world stage")
Playboy magazine (review)
People magazine (feature w/photos)
Business Week (article w/photo)
ARTnews (cover story w/photo)
New Yorker magazine (review w/caricature of Opposer)

come across as ads almost as much for Blue Man as for the chipmaker." (Not. of Rel./Articles, Fortune Small Business at 56.)

1993: GQ magazine (feature w/photo)
Creem magazine (feature w/photo)
Four Seasons Hotels & Resorts magazine (feature w/photo, describes “plenty of exposure on the Tonight Show, Live With Regis & Kathie Lee, and Charles Kuralt’s Sunday Morning”)
American in-flight magazine (describing Opposer as “among the most celebrated” Off-Broadway productions)
New York Times (Sunday “Arts & Leisure” section feature w/photos)

(Not. of Rel./Articles/Exh. A)

In addition to the above representative sample of the early and extensive press and media coverage which Opposer has continued to generate, Opposer has been featured as an answer in the New York Times Sunday Crossword puzzle (June 30, 1996, Not. of Rel./Articles), included as an answer to a question on the television game show Jeopardy! (Not. of Rel./Articles, 9/20/00), featured as an icon of New York City – together with the Statue of Liberty and Times Square -- in the tourist card game “New York City Visions” (1996, Not. of Rel./Articles), profiled in Fortune Small Business for its development of “Brand Blue” (March 2003, Not. of Rel./Articles), and featured as a halftime performer at New York Knicks NBA basketball games in Madison Square Garden (2/25/00, Not. of Rel./Articles).

Accordingly, Opposer has been recognized frequently as “a certified pop culture phenomenon” (Not. of Rel./Articles, Panorama at 32), “a multilayered industry of shows, recordings, videos, and performance tours entertaining millions of people,” (Not. of Rel./Articles, Go), a “household name” (Not. of Rel./Articles, Spark at 17), “world famous” (Not. of Rel./Articles, Official City Guide at 68), “international celebrities” (Not. of Rel./Articles, New York magazine, Mar. 25, 2001), and “blue icons” (Not. of Rel./Articles,

New York Times, Sept. 16, 2001). Opposer has also drawn criticism for this very success, labeled an “empire” that is “the McDonald’s of the music world” (The Week, Aug. 1, 2003, Not. of Rel./Articles) and attacked for “franchising the operation like Starbuck’s” (Shout, April 2002, Not. of Rel./Articles).

Applicant has applied to register the mark BLUEMAN for “tobacco, smokers’ articles, namely, cigarettes.” The application claims a date of first use “at least as early as March 6, 2000,” but Applicant now also asserts priority under the Madrid Protocol, based on a Swiss registration, No. 171,796, dated December 4, 1997, for BLUEMAN AMERICAN BLEND. See Applicant’s Motion to Dismiss for Failure to Prosecute, for Judgment on the Pleadings, or Alternatively, for Summary Judgment, dated February 23, 2004, at 2. The application was published for opposition in the Official Gazette on August 20, 2002. Up to now, Applicant appears to have made very little bona fide use of its mark in commerce in the United States. However, Applicant’s tobacco products are targeted to the same broad and non-specific class of purchasers as are the products and services sold by Opposer under the BLUE MAN GROUP Mark, i.e., the adult population of the United States. In the face of this and other evidence of record, as demonstrated below, the likelihood of confusion and/or dilution between Applicant’s BLUEMAN mark and Opposer’s BLUE MAN GROUP Mark is manifestly clear and this opposition should be sustained.

ARGUMENT

The only questions in this opposition are (1) the confusing similarity of Applicant’s BLUEMAN mark and BMPI’s BLUE MAN GROUP Mark for complementary goods and services, and (2) the likelihood of dilution of Opposer’s mark by Applicant’s mark. No issue

of priority exists between the parties' marks; it is not disputed that Opposer's Mark enjoys priority.

The confusing similarity of Applicant's mark to BMPI's Mark under Section 2(d) (15 U.S.C. §1052) of the Lanham Act is amply demonstrated by the evidence of record. Factors considered by the Board include: the strength or fame of a mark; the similarity of the marks; the similarity of the goods and services, trade channels, and purchasers; the conditions under which sales are made; and any intent to trade upon another's goodwill. In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); Roger & Gallet S.A. v. Venice Trading Co., 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 1987). Because Opposer's Mark is extremely well-known, Applicant's mark is very similar to Opposer's Mark, and the parties' goods and services are marketed to the same class of purchasers, the Board should sustain this opposition.³

The dilution claim is even clearer. The Board looks to the following factors in determining dilution, all of which favor Opposer here:

³ While actual confusion evidence is a factor that may be considered in assessing likelihood of confusion, DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567, it is well settled that it is not necessary for a finding of likely confusion, see, e.g., Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1571, 218 U.S.P.Q. 390, 395-96 (Fed. Cir. 1983) ("[I]t is unnecessary to show actual confusion in establishing likelihood of confusion."). Moreover, where, as here, an applicant has made scant actual use of its mark, this factor has no evidentiary value in the likelihood of confusion analysis. See, e.g., TCPIP Holding Co. v. Haar Communications Inc., 244 F.3d 88, 102, 57 U.S.P.Q.2d 1969, 1981 (2d Cir. 2001) ("[B]ecause [defendant] has not yet launched its portal in a serious way, there has been little or no opportunity for actual confusion to be manifested. As a result, the absence of evidence of actual confusion sheds no light whatever on the problem [of determining likelihood of confusion]"); Jockey Int'l, Inc. v. Butler, 3 U.S.P.Q.2d 1607, 1612-13 (T.T.A.B. 1987) (absence of actual confusion is of no consequence where applicant's sales were insignificant); Ralston Purina Co. v. Old Ranchers Canning Co., 199 U.S.P.Q. 125, 128 (T.T.A.B. 1978) (minimal use of mark lessens chance of actual confusion coming to light).

The degree of inherent or acquired distinctiveness of the mark;

The duration and extent of use of the mark in connection with the goods or services with which the mark is used;

The duration and extent of advertising and publicity of the mark;

The geographical extent of the trading area in which the mark is used;

The channels of trade for the goods or services with which the mark is used;

The degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;

The nature and extent of third party use of the same or similar marks by third parties; and

Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

For this reason as well, the Board should sustain this opposition.

I. APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION

A. Opposer's Mark Is Extremely Well-Known and is Entitled to a Broad Scope of Protection

1. Opposer's Mark Has Acquired A High Degree of Distinctiveness

Marks which have acquired a high degree of distinctiveness, such as Opposer's Mark, are afforded a broad scope of protection. See, e.g., Bose Corp. v. QSC Audio Prods. Inc., 293 F.3d 1367, 1373, 1376, 63 U.S.P.Q.2d 1303, 1307, 1309 (Fed. Cir. 2002) (ACOUSTIC WAVE and WAVE for electronic audio products so famous that defendant precluded from using POWERWAVE for amplifiers; Federal Circuit noted "voluminous evidence of nationwide critical notice" of plaintiff's marks); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254, 2 U.S.P.Q.2d 1677 (2d Cir. 1987) (flying horse symbol representing mythical character Pegasus so strong in connection with plaintiff's petroleum business as to preclude defendant

from using word mark PEGASUS in connection with petroleum industry or related businesses); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 U.S.P.Q. 390, 394 (Fed. Cir. 1983) (Opposer's GIANT marks had "acquired considerable fame" in one region of the country, a factor "which weighs in its favor in determining likelihood of confusion"). As noted by the Board in R.J. Reynolds Tobacco Co. v. R. Seelig & Hille, 201 U.S.P.Q. 856, 860 (T.T.A.B. 1978):

[I]t is well recognized that the law today rewards a famous or well known mark with a larger cloak of protection than in the case of a lesser known mark because of the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any resemblance thereto.

See also Recot Inc. v. M.C. Becton, 214 F.3d 1322, 1327, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000) ("The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.") (quoting Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 223 U.S.P.Q. 1281 (Fed. Cir. 1984)); 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §11:73, at 11-149 (4th ed. 2002) ("[T]he rationale is that the more distinctive, unique and well-known the mark, the deeper is the impression it creates upon the public's consciousness and the greater the scope of protection to which it is entitled.")

The broad scope of protection afforded to famous marks was highlighted by the Federal Circuit Court of Appeals in Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992) (FUNDOUGH confusingly similar to PLAY-DOH for modeling compounds). In Kenner Parker Toys, the Court noted that "fame of the prior mark[] plays a dominant role in cases featuring a famous or strong mark." Id. at 352, 22 U.S.P.Q.2d at 1456; accord Bose, 293 F.3d at 1371, 63 U.S.P.Q.2d at 1305; Recot, 214 F.3d. at 1328, 54

U.S.P.Q.2d at 1898. The Court further noted: “a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark” and “the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark.” Kenner Parker Toys, 963 F.2d at 353, 22 U.S.P.Q.2d at 1456. The strength of a mark is “usually the same as its economic and marketing strength.” 2 McCarthy, supra §11:73, at 11-149.

As detailed above, Opposer’s Mark has tremendous strength as evidenced by more than twenty-five years of use, the more than seven million tickets that have been sold to Opposer’s long-running theatrical productions presented under the Mark, the certified gold-selling, Grammy-nominated sound recordings sold bearing the Mark, the more than \$550 million worth of television advertising prominently bearing the Mark that appeared in connection with the sales of Intel computer chips, numerous featured appearances on The Tonight Show with Jay Leno beginning in 1992 and continuing through to the present, featured appearances on other successful television programs, feature articles and cover stories in national and international publications including Time, People, and The New York Times, and the plethora of other references in the press. Although the number of such media references has continued to grow over time, many of the examples just cited pre-date Applicant’s claimed first use date of March 6, 2000 and even pre-date the contested Madrid Protocol priority date of Dec. 4, 1997, derived from Applicant’s asserted registration of a different mark, BLUEMAN AMERICAN BLEND, in Switzerland.

Moreover, Applicant has cited no evidence of third-party registration or use, nor any other evidence which could even arguably rebut the overwhelming demonstration of strength of Opposer’s Mark.

The strength factor therefore weighs heavily in favor of finding likelihood of confusion.

B. Confusion is Likely Due to the Similarity of the Parties' Marks

1. The Dominant Portions of the Marks are Identical

It is well settled that "one feature of a mark may be more significant than other features, and that it is proper to give greater force and effect to that dominant feature." Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 U.S.P.Q. 390 (Fed. Cir. 1983); See also, 3 McCarthy on Trademarks § 23.44 (if the "dominant portion of both marks is the same, then confusion may be likely, notwithstanding peripheral differences"). In this case, the entirety of Applicant's mark BLUEMAN is identical to the dominant term in BMPI's mark BLUE MAN GROUP. When two marks share the same dominant element, a long line of cases has found that the marks are similar and that, therefore, confusion is likely. See, e.g., Giant Food, supra, at 1570-71, 218 U.S.P.Q. at 395 (noting that the dominant portion of both applicant's GIANT HAMBURGERS mark and Opposer's GIANT FOOD, SUPER GIANT, GIANT FOOD & Design, and GIANT & Design marks was the word GIANT and concluding that confusion was likely because the marks were similar in appearance, sound and overall commercial impression); In re Apparel Ventures, Inc., 229 U.S.P.Q. 225, 226 (T.T.A.B. 1986) ("SPARKS' is the dominant portion of applicant's mark and it is all of the registered mark. In light of this fact, and contrary to applicant's contentions, the marks create similar commercial impressions. They are similar in meaning, sound and appearance.").

A side-by-side dissection of differences is not the appropriate test. See, e.g., First Int'l Servs. Corp. v. Chuckles, Inc., 5 U.S.P.Q.2d 1628, 1632 (T.T.A.B. 1988). Rather, "focus must be on the recollection of the average purchaser, who normally retains a general rather than a

specific impression of trademarks.” Id. Because of the striking similarities of sight, sound and meaning, both as to the dominant portion and the marks in their entirety, Applicant’s mark here creates a similar commercial impression to Opposer’s marks. Coupled with the fame of Opposer’s mark entitling it to broad protection, the similarity of marks factor weighs in favor of finding a likelihood of confusion.

C. The Facts that the Parties’ Goods and Services are Complementary Favors a Finding of Likely Confusion

Applicant’s products and services are complementary to the goods and services offered by Opposer under the BLUE MAN GROUP Mark. Applicant has filed to register its mark for “tobacco; smokers’ articles, namely, cigarettes.” These goods are complementary. See Charrette Corp. v. Bowater Communication Papers Inc., 13 U.S.P.Q.2d 2040, 2042 (T.T.A.B. 1989) (“[i]t is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources”).⁴ In this regard, consumer perception is the key to likelihood of confusion. See 4 McCarthy, supra §24:19, at 24-38 to -39 (“In determining possible

⁴ Indeed, the fact that a given consumer might never encounter Opposer’s products and services and Applicant’s services in the same retail location, and thus not be able to make a side-by-side comparison, could increase the likelihood of confusion. See Faberge, Inc. v. Madison Shirt Corp., 192 U.S.P.Q. 223, 227 (T.T.A.B. 1976) (resemblance of BRUTUS for men’s shirts to BRUT for men’s toiletries, “when considered in light of a purchaser’s general recollection or imperfect recall of marks and the absence of a situation whereby side-by-side comparisons of the marks would be readily available,” was likely to cause confusion).

expansion of a product line, it is the ordinary customer's perception of possible expansion that counts, whether that perception comports with the reality of the senior user's actual plans or not.") (emphasis added). Here, because Opposer itself markets a wide range of products such as gift items, clothing and paper goods, and even features cigarette lighters as the focus of a segment in its current touring production (Not. of Rel./Articles, The Plain Dealer, July 24, 2003), the likelihood of confusion is exacerbated and less similarity between marks will be tolerated.

Further, in view of the fame of Opposer's mark and the unusual "empire" or "franchise" of products and services with which it has been associated, notably including Intel computer chips, it takes no leap of faith to conclude that persons encountering Applicant's BLUEMAN cigarettes would be familiar with Opposer's BLUE MAN GROUP mark and would be likely to conclude, erroneously, that such products are also licensed from or endorsed or sponsored by Opposer. See In re Melville Corp., 18 U.S.P.Q. 2d 1386, 1388 (T.T.A.B. 1991); McDonald's Corp. v. McClaine, 37 U.S.P.Q.2d 1274 (T.T.A.B. 1995) (in view of McDonald's history of licensing, persons likely to conclude that McDonald's is connected with applicant's legal services in some way, if not directly then by authorizing or sponsoring the activity); Corp. of Lloyd's of London v. Louis D'Or of France, Inc., 202 U.S.P.Q. 313 (T.T.A.B. 1979) (LLOYD'S OF LONDON aftershave likely to cause confusion with LLOYD'S OF LONDON for insurance.)

Moreover, where products travel through the same or related trade channels, confusion is also more likely. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. It is well established that likelihood of confusion must be decided on the basis of the goods or services set forth in the applications and registrations involved in a proceeding, regardless of the

specific nature, uses or channels of trade which may be disclosed by the evidence. E.g., Bose Corp. v. QSC Audio Prods. Inc., 293 F.3d 1367, 1377, 63 U.S.P.Q.2d 1303, 1310-11 (Fed. Cir. 2002); Charrette Corp. v. Bowater Communication Papers Inc., 13 U.S.P.Q.2d 2040, 2042 (T.T.A.B. 1989); McDonald's Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1898 (T.T.A.B. 1989). Both BMPI's BLUE MAN GROUP mark and Applicant's application are unrestricted as to channels of trade; thus, all of the parties' products must be assumed to travel in all of the normal channels of trade for such goods and services. E.g., Bongrain Int'l (Am.) Corp. v. Moquet Ltd., 230 U.S.P.Q. 626, 628 (T.T.A.B. 1986); In re Apparel Ventures, Inc., 229 U.S.P.Q. 225, 227 (T.T.A.B. 1986).

D. As the Newcomer, Applicant Had the Obligation to Avoid BMPI's Well-Known Mark

A newcomer to a product area, such as Applicant, has a duty to avoid selecting a mark close to a well-known mark in order to protect the senior user's established goodwill and investment. Any doubts are resolved in favor of the established mark, here BMPI's Mark. See Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 674, 223 U.S.P.Q. 1281, 1284 (Fed. Cir. 1984) ("When balancing the interest in a famous, established mark against the interests of a newcomer, we are compelled to resolve doubts on this point against the newcomer."); General Foods Corp. v. ITT Cont'l Baking Co., 196 U.S.P.Q. 189 (T.T.A.B. 1977) (FLAV 'N BAKE confusingly similar to Opposer's SHAKE 'N BAKE mark for similar goods which had been used for many years and which represented a considerable investment); Hancock v. American Steel & Wire Co., 203 F.2d 737, 741, 97 U.S.P.Q. 330, 333 (C.C.P.A. 1953) (any doubt should be resolved in favor of the senior user especially where a mark had

been registered 22 years prior to applicant's first use and where sales and nationwide goodwill had developed with substantial sales and advertising).

The rationale for placing an obligation on the newcomer is that selection of a dissimilar mark is relatively easy, whereas selection of a close mark suggests an intent to unfairly benefit from the senior user's hard earned reputation.

As noted by the Federal Circuit:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises "but one inference -- that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark," and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Specialty Brands, Inc., 748 F.2d at 676, 223 U.S.P.Q. at 1285 (quoting Planters Nut & Chocolate Co. v. Crown Nut Co., Inc., 305 F.2d 916, 924-25, 134 U.S.P.Q. 504, 511 (C.C.P.A. 1962)). As the newcomer, Applicant has not fulfilled its obligation to stay away from BMPI's long-established and well-known Mark, and has introduced no evidence to demonstrate an innocent explanation for its adoption and use of the BLUEMAN mark.

Because of Opposer's prior registration on the Principal Register, Applicant was on constructive notice of Opposer's prior rights at the time of the filing.

Where there is evidence of an applicant's intent to adopt a mark to benefit from the goodwill of an already successful mark, this factor weighs toward a likelihood of confusion.

See Roger & Gallet S.A. v. Venice Trading Co., 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 1987).

Such evidence is relevant because:

[I]f, in the adoption and use of the mark there be a purpose of confusing the mind of the public as to the origin of the goods to which it is applied, we have a right, in determining the question of likelihood of confusion or mistake, to consider the motive in adopting the mark as indicating an opinion, upon the part of one vitally interested, that confusion or mistake would likely result from use of the mark.

Shoe Corp. of America v. Juvenile Shoe Corp., 266 F.2d 793, 795, 121 U.S.P.Q. 510, 512 (C.C.P.A. 1959) (quoting Lever Brother Co. v. Riodela Chemical Co., 41 F.2d 408, 411 (C.C.P.A. 1930)). As noted by the Court of Customs and Patents and Appeals, there is "no excuse for even approaching the well-known trademark of a competitor" because "to do so raises but one inference -- that of gaining advantage from the wide reputation established by [another]." Planters Nut & Chocolate Co. v. Crown Nut Co., 305 F.2d 916, 924-25, 134 U.S.P.Q. 504, 511 (C.C.P.A. 1962) (emphasis added); Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd., 774 F.2d 1144, 1147, 227 U.S.P.Q. 541, 543 (Fed. Cir. 1985) (DOUGIES for combination training pants/diapers confusingly similar to HUGGIES for disposable diapers).

Given the duty of a newcomer such as Applicant to select a mark sufficiently different from existing well-established ones, this factor supports a finding of likely confusion. Accordingly, the intent factor also weighs toward a finding of likelihood of confusion.

In sum, all of the relevant factors favor Opposer and the opposition should be sustained on grounds of likelihood of confusion.

II. APPLICANT'S MARK IS LIKELY TO CAUSE DILUTION

A. Standard for Dilution

The Federal Trademark Dilution Act ("FTDA"), 15 U.S.C. § 1125 (c)(1), provides that the owner of a famous mark shall be entitled to an injunction against another's commercial use of a mark, if such use begins after the mark has become famous and dilutes the

distinctive quality of the mark. The FTDA remedies those situations where the public may well know that the junior user is not connected to or sponsored by the mark owner, yet the ability of the owner's mark to serve as a unique identifier of the owner's goods or services is weakened because the public now also associates that designation with a new and different source. See, e.g., Federal Express Corp. v. Federal Espresso Inc., 53 U.S.P.Q.2d 1345, 1350 (2d Cir. 2000).

The non-exclusive factors stated in Section 1125(c) that maybe considered in determining fame and distinctiveness of a mark are:

- The degree of inherent or acquired distinctiveness of the mark;
- The duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- The duration and extent of advertising and publicity of the mark;
- The geographical extent of the trading area in which the mark is used;
- The channels of trade for the goods or services with which the mark is used;
- The degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- The nature and extent of third party use of the same or similar marks by third parties; and
- Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Once fame and distinctiveness are shown, dilution is established if the marks are at a minimum substantially similar and applicant's target customers would likely make an association between the marks. Toro v. ToroHead, 61 U.S.P.Q.2d 1164, 1183 (T.T.A.B 2001). Accordingly, the issue is not whether the BLUE MAN GROUP mark is famous for tobacco products, but rather whether the BLUE MAN GROUP mark is so famous and the

marks so similar that Applicant's customers would immediately be reminded of the BLUE MAN GROUP mark and associate Applicant's use with Opposer, even if they would not believe that the goods originated with Opposer. Toro v. ToroHead, 61 U.S.P.Q.2d at 1183. See also Federal Express Corp. v. Federal Espresso Inc., 53 U.S.P.Q.2d 1345 (2d Cir. 2000).

B. The Opposer's Mark is Famous

1. The Opposer's Mark Had Acquired Fame as of Applicant's Priority Filing Date

With respect to the factor of "acquired distinctiveness", there is substantial evidence, detailed above, on which to conclude that by the relevant date (whether 1997, as Applicant asserts, or 2003 as Opposer contends) BLUE MAN GROUP had achieved a high degree of recognition in the United States as a trademark of Opposer. See TCPIP Holding Co. v. Haar Communications Inc., 57 U.S.P.Q.2d 1969 (2d Cir. 2001) (the level of distinctiveness acquired is relevant to the existence of fame).

In addition, as "distinctiveness" is properly assessed in a dilution analysis in inverse proportion to the number and types of third party uses of the term, Toro v. ToroHead, 61 U.S.P.Q.2d at 1180-81, Opposer has achieved absolute distinctiveness. To Opposer's knowledge, no other entity uses any mark incorporating the terms "BLUE MAN" as a mark in the United States, and Applicant has introduced no evidence of such third-party use.

2. The BLUE MAN GROUP Mark Has Been Used Throughout the U.S. for More Than Twenty-Five Years

The BLUE MAN GROUP mark has been used continuously and extensively throughout the country since at least 1988 in connection with Opposer's Goods and Services. Prior to any asserted priority date of Applicant, the BLUE MAN GROUP mark was seen on

a regular and repeated basis by millions of Tonight Show viewers, readers of The New York Times, Time, People, Esquire, GQ, Variety, The Nation, Playboy, Business Week, Theater Week, ARTnews, Vanity Fair, and the Village Voice, and millions of theatergoers throughout the United States.

3. The Opposer's Mark Was and Is Famous Among Persons Who Would Purchase Tobacco Products Through the Normal Outlets

When, as here, there are no limitations as to trade channels, an applicant's goods are presumed to travel in all normal channels for such goods to all persons who would typically purchase such goods. Knorr-Nahrmitte AG v. Havland Int/, Inc., 206 U.S.P.Q. 827, 835 (T.T.A.B. 1980). Accordingly, the normal channels for Tarmann's goods are anywhere that cigarettes may be sold, including hotels and theaters in which Opposer's performances are produced, and his potential purchasers are the normal purchasers for such goods, namely the entire adult population of the U.S.

The evidence amply shows that the BLUE MAN GROUP Mark was well-recognized among the general population, as of the relevant date. There is no question that such groups included persons who would normally purchase tobacco products of the type identified in Tarmann's application through the normal channels therefor. Indeed, the Board can take notice that many of the national publications which prominently featured articles about Opposer (such as Playboy, Esquire, Vanity Fair, GQ and the Village Voice) also run advertisements for cigarettes and other tobacco products.

The fact that Opposer had also distributed BLUE MAN GROUP branded merchandise to the public prior to the relevant date only increases the likelihood of dilution. Toro v. ToroHead, 61 U.S.P.Q.2d at 1184.

4. There is No Third Party Use of BLUEMAN, Apart from Applicant

There is no evidence of any use of BLUE MAN GROUP or any similar mark in the United States. To the extent that Opposer has perceived a conflict with another mark, Opposer has aggressively protected its mark. BLUE MAN GROUP, as a truly unique source identifier, is exactly the type of mark Congress intended to protect with the FTDA, Section 1125(c). H.R. REP. No. 104-374, at 3 (1995) ("the mark signifies something unique, singular or particular.").

5. BLUE MAN GROUP Has Been Acknowledged to be a Famous Mark by Others

As noted above, BLUE MAN GROUP has been widely recognized as a famous trademark in public discourse.

In sum, as a result of Opposer's efforts that reached all segments of the public, from children to senior citizens of all income and education levels, BLUE MAN GROUP was not only famous in March 1997, and in December 2000, it was so distinctive -indeed, it was and is unique-- that the public would have associated BLUEMAN with Opposer when encountered on tobacco or any other type of product.

C. BLUEMAN Blurs the Distinctiveness of BLUE MAN GROUP

Having established fame and distinctiveness, Opposer need only show that the BLUEMAN mark would lessen the capability of the BLUE MAN GROUP mark to indicate source in Opposer, uniquely. Toro v. ToroHead, 61 U.S.P.Q.2d 1164. There is no question in this case that blurring is likely to occur.

Marks need not be identical for blurring to occur, but only sufficiently similar that the junior mark will conjure up an association with the senior mark in the mind of consumers or

in the post-sale environment. Nabisco v. PF Brands, Inc., 51 U.S.P.Q.2d 1882, 1889 (2d Cir. 2000); Toro v. ToroHead, 61 U.S.P.Q.2d at 1182-83.

The second dilution factor also weighs in BLUE MAN GROUP's favor. The fact that BLUE MAN GROUP has sold clothing, gift items and paper goods and has received constant coverage in the general media since prior to Tarmann's relevant date indicates that BLUE MAN GROUP would have been well-known among the normal purchasers for the goods recited in Tarman's application, making a diluting association in the mind of such purchasers not only likely, but inevitable.

In sum, all of the relevant factors weigh in BLUE MAN GROUP's favor. The Board should refuse registration of BLUEMAN on the ground of dilution.

SUMMARY

Opposer's famous Mark BLUE MAN GROUP has been continuously and extensively used on or in connection with Opposer's Goods and Services for over twenty-five years. Opposer has gained tremendous goodwill and recognition in the entertainment field, and in connection with ancillary merchandise. Because the undisputed facts of record show that the overall commercial impression of Applicant's mark is confusingly similar to BMPI's famous and long-established Mark, and is likely to dilute the distinctiveness of Opposer's Mark, the Board should sustain this opposition.

CONCLUSION

For the foregoing reasons, the opposition should be sustained.

Dated: New York, New York
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing OPPOSER'S BRIEF ON FINAL HEARING was served on Applicant on September 21, 2004 by mailing a copy thereof via first-class mail, postage prepaid, addressed as follows:

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