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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The B.V.D. Licensing Corporation

v.

Bosideng Co., Ltd.

Opposition No. 91173468
to application Serial No. 78729641
filed on October 10, 2005

Carrie A. Shufflebarger of Thompson Hine, LLP for The B.V.D.
Licensing Corporation.

Yuval H. Marcus of Leason Ellis LLP for Bosideng Co., Ltd.

Before Holtzman, Bergsman and Kuczma,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Bosideng Co., Ltd. ("applicant") filed an intent-to-use
application for the mark BOSIDENG BSD and design, shown
below, for "suits, coats, overcoats, shirts, trousers,
skirts, sweaters, T-shirts, pajamas, underwear, leather
shoes," in Class 25.



According to the applicant, "[t]he transliteration of the Chinese characters in the mark is 'Bosideng' which is a coined term without any English translation."

The B.V.D. Licensing Corporation ("opposer") filed a notice of opposition against the registration of applicant's mark on the ground of likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C.

§1052(d), and on the ground of dilution pursuant to Section 43(c) of the Trademark Act of 1946, 15 U.S.C. §1125(c).

Opposer alleged ownership of nine trademark registrations for the marks B.V.D and/or BVD. For purposes of this opposition, we focus on the following three registrations:

1. Registration No. 0049931 for the mark B.V.D., in typed drawing form, for "undershirts and underdrawers," in Class 25;¹

2. Registration No. 0367184 for the mark B.V.D., in typed drawing form, for "underwear, shirts, shorts," in Class 25;² and

3. Registration No. 2853880 for the mark BVD, in typed drawing form, for "men's and boy's t-shirts," in Class 25.³

¹ Issued February 27, 1906; fifth renewal.

² Issued May 9, 1939; fourth renewal.

³ Issued June 15, 2004; Sections 8 and 15 affidavits accepted and acknowledged.

With respect to its claim of likelihood of confusion, opposer alleged that applicant's mark BOSIDENG BSD and design for the goods in the application so resembles opposer's BVD marks for underwear, shirts and t-shirts as to be likely to cause confusion. With respect to its dilution claim, opposer alleged that its BVD marks have been famous since the late 19th century and that the registration of applicant's mark "will cause dilution of the distinctive quality of Opposer's BVD marks."

Applicant denied the essential allegations in the notice of opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, opposer introduced the following testimony and evidence:

1. Notice of reliance on the following items:
 - a. Photocopies of opposer's pleaded registrations prepared by the U.S. Patent and Trademark Office showing that they are currently subsisting and owned by opposer;
 - b. Opposer's first set of requests for admission to which applicant failed to respond and, therefore, pursuant to Fed. R. Civ. P. 36(a)(3), the requests are deemed admitted;

- c. Copies of advertisements appearing in printed publications;
 - d. Excerpts from dictionaries copyrighted in 1973, 1980, and 2003 that identify B.V.D. as a trademark; and
 - e. Copies of articles published in the November 21, 2005, December 5, 2007, and November 24, 2008 issues of DNR magazine identifying BVD as one of the top 50 brands in the United States that men know best; and
2. Testimony deposition of Michael Scott Greene, Senior Vice President of Union Underwear, a licensee of opposer, with attached exhibits.
- Applicant did not introduce any testimony or evidence.
- The case has been fully briefed.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the

marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of opposer's marks.

This *du Pont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time

those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). In this regard, opposer did the bare minimum to prove that the mark BVD is famous for purposes of likelihood of confusion. Opposer did not take to heart the Board's warning in *B.V.D Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506 (TTAB 2007) that "non-

specific testimony about sales and advertising might not be sufficient to demonstrate the fame of a mark."

Opposer has introduced the following testimony and evidence to prove that its BVD marks are famous:

1. Excerpts from three dictionaries copyrighted in 1973, 1980, and 2003 that identify B.V.D. as a trademark;
2. Copies of articles published in the November 21, 2005, December 5, 2007, and November 24, 2008 issues of DNR magazine identifying BVD as one of the top 50 brands in the United States that men know best. DNR identifies itself as "Defining Men's Fashion."⁴ The 2005 and 2007 DNR surveys of well-known brands listed BVD as the 35th most well-known brand and the 2008 DNR survey listed BVD as the 27th most well-known brand. The 2007 survey referenced BVD as "legendary" and that it has "achieved cult-like status." The 2008 survey stated that BVD has "[l]ong been synonymous with men's underwear."⁵

⁴ Although opposer also introduced copies of the 2007 and 2008 DNR survey into evidence in the Greene testimony deposition, Mr. Greene did not testify as to the subject matter of the DNR magazine, its circulation, or the survey methodology.

⁵ The DNR surveys are admissible and probative only for what they show on their face, not for the truth of what has been printed. *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2010) (truth of matters asserted in printed publications not considered; printed publications considered as showing continued consumer exposure of opposer's mark in connection with opposer's name); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters).

3. Mr. Greene testified that "our annual sales internationally or even domestically are in the tens of millions of dollars ... and we've sold them in the tens of millions of dollars for every year that I can remember for the last couple of decades."⁶

4. Mr. Greene testified that "[o]ur advertising investment has always been an appropriate amount to suit a business of that size ... so that advertising investment has been there for quite some time."⁷ Mr. Greene did not testify as to what an "appropriate amount to suit a business of that size" would be.

5. BVD is the number two underwear brand at JC PENNEY.

We've done very well over the last few years, particularly at JC PENNEY. I don't have - - I couldn't tell you exactly how BVD compared to other brands, say, at Amazon, but I do know that at JC Penney we have just within the last year or two emerged as the number two brand within their stores. The top seller's [sic] their Stafford brand, which is a private label brand for JC Penney, but we have surpassed Jockey and now have the number 2 position on their floor.⁸

JC PENNEY has 1,100 stores throughout the United States.⁹

⁶ Greene Dep., p. 53. Mr. Greene is an employee of Union Underwear, opposer's licensee. (Greene Dep., p. 7). Opposer did not develop any testimony to explain how or why Mr. Greene is competent to testify regarding opposer's advertising, sales or market share.

⁷ Greene Dep., p. 54.

⁸ Greene Dep., pp. 24-25.

⁹ Greene Dep., p. 24.

6. Copies of numerous advertisements in magazines and newspapers from 1907 through 2008. However, there was no testimony regarding the circulation of these publications and how many people might have seen them.

7. Mr. Greene testified that the BVD mark may have originated in 1876.

Q. Do you know where [BVD] originated?

A. In vague terms, don't ask me too many questions on it, but there were three gentlemen back in I think it was 1876 that started. Bradley, Voorhees and Day were the three gentlemen's last names, so Bradley being the B, Voorhees V, and then Day the D, and then I believe their mark was trademarked in the early 1900s specific. And again, their business started as an underwear business doing union suits, which was a popular underwear item back at the turn of the 20th Century.¹⁰

When Mr. Greene's testimony regarding opposer's sales is joined with the dictionary entries recognizing BVD as a trademark,¹¹ as well as the extremely long period of use and the renown of the mark as referenced in the DNR surveys, we find that BVD is famous for purposes of likelihood of confusion.

¹⁰ Greene Dep., p. 13.

¹¹ *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988) ("When a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous").

Even though we have found that opposer has proven that its BVD marks are famous for purposes of likelihood of confusion, fame alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle opposer to a right in gross, and that is against the principles of trademark law. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports, Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983). Accordingly, we must consider the other *du Pont* factors for which evidence has been introduced.

B. The similarity or dissimilarity and nature of the goods at issue, likely-to-continue channels of trade and classes of consumers.

The description of goods for both applicant's application and opposer's pleaded registrations include underwear, shirts, and t-shirts. Accordingly, the goods are in part identical.¹² Because the goods described in the application and opposer's registrations are in part identical, we must presume that the channels of trade and classes of purchasers are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications

¹² It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

C. The degree of consumer care.

The extent of the testimony regarding the degree of consumer care is Mr. Greene's testimony that an underwear purchase is a "planned purchase."¹³ We construe a planned purchase to be a purchase where the consumer has a reasonably focused need for the product. With respect to a "planned purchase," the Federal Circuit has held that consumers exercise sufficient care to minimize source confusion. See *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) ("a reasonably focused need" for champagne weighs against a holding of likelihood of confusion). At a minimum, Mr. Greene's testimony indicates that purchasing underwear is not an impulse purchase.

Mr. Greene further testified that with an online purchase, a consumer will buy underwear "to get them over a certain threshold of a total purchase that they can save in

¹³ Greene Dep., p. 27.

some shipping fees."¹⁴ In that situation [making a purchase to get over a shipping fee threshold], the consumer is making a decision based on price and his/her degree of care regarding source may be so low as to amount to indifference.¹⁵

Opposer does not address Mr. Greene's testimony in its brief, rather it argues that "[p]roducts bearing the BVD mark are generally inexpensive - often sold in multi-packs for approximately \$14-\$32 per pack,"¹⁶ and "[w]hen consumers deal with inexpensive products, they are likely to exercise less care, which, in turn, makes confusion more likely."¹⁷ However, price alone is not determinative of the degree of care in a purchasing decision. *See Stouffer Corp. v. Health Valley Natural Foods, Inc.*, 1 USPQ2d 1900, 1092 (TTAB 1986) (although the products "are normally inexpensive, subject to quick consumption and frequent replacement purchase," the circumstances do not justify applying a lower standard of care than that of ordinary consumers because purchasing decisions will not be made impulsively or carelessly). Opposer argues, in essence, that there should be a per se rule that consumers of inexpensive items exercise a low degree of consumer care. We disagree. There is no per se

¹⁴ Greene Dep., p. 28.

¹⁵ On a different record, we might find that the source of the product is a factor in purchasing underwear online.

¹⁶ Opposer's Brief, p. 19, *citing* the Greene Dep., pp. 21-22.

¹⁷ Opposer's Brief, p. 18.

rule that low price equates to a low degree of purchaser care especially when opposer's own witness testified that the purchase of underwear is a "planned purchase." On the other hand, it is only logical that consumers will not exercise as much care purchasing inexpensive items as they will purchasing expensive items.

Because the testimony regarding the facts and circumstances surrounding the degree of consumer care was not fully developed (e.g., the definition of a "planned purchase," the importance of brand recognition in purchasing underwear, the role of price in an underwear purchase, etc.), any conclusion that we might reach regarding the degree of consumer in purchasing underwear would be drawn from inferences based on an incomplete record. Accordingly, this *du Pont* factor is neutral.

D. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*,

6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods and services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

Moreover, in comparing the marks, 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 terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than a specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB

1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is a general consumer who purchases underwear and t-shirts.

As indicated above, a basic principle in determining whether the marks at issue are similar or dissimilar is that the marks must be compared in their entirety. The Court of Appeals for the Federal Circuit, our primary reviewing court, provided the following guidance:

It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, 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 entirety. Indeed, this type of analysis appears to be unavoidable.

In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The word BOSIDENG is the dominant portion of applicant's mark. It is the most visually distinctive part of the mark especially to an English speaker. With respect to the letters BSD, the gravamen of opposer's opposition, they are the smallest component of the mark and not visually distinctive. In this regard, we note that Mr. Greene, opposer's witness, testified that "the word 'Bosideng' tends to be the dominant verbiage and 'BSD' is somewhat

subtler.”¹⁸ The letters BSD are so buried in the middle of applicant’s mark and so innocuous that consumers will not perceive applicant’s mark as being similar in appearance or sound to opposer’s mark. Thus, applicant’s mark has a different look and sound than opposer’s BVD mark.

With respect to the connotation and commercial impression of applicant’s mark, the name BOSIDENG is a coined term and the Chinese letters at the top of the mark engender the commercial impression of a Chinese product. Accordingly, applicant’s mark has a different meaning and engenders a different commercial impression than opposer’s BVD mark.

Opposer argues that “[a]pplicant clearly intends ‘BSD’ to be the dominant element, as Applicant’s U.S.-based subsidiary has a pending application [shown below] where in the ‘BSD wing’ design is even more prominently featured, the Chinese text is lacking, and the ‘BOSIDENG U.S.A.” house mark appears in much smaller, non-stylized text.”¹⁹

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¹⁸ Greene Dep., p. 57. Opposer argues that “the letter string ‘BSD,’ flanked on the sides with a wing design” is the dominant feature of applicant’s mark. (Opposer’s Brief, p. 15). However, opposer’s argument is contradicted by the testimony of its own witness.

¹⁹ Opposer’s Brief, p. 15.

However, it is the drawing of the mark in the application being opposed that controls whether the marks at issue are similar, not the mark in a different application. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). See also *Frances Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959) ("In determining the applicant's right to registration, only the mark in the application may be considered"); *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990).

When the marks are considered in their entireties, they are not similar in terms of appearance, sound, meaning or commercial impression.

D. Balancing the factors.

While the fame of opposer's mark and the identity of the goods and the presumption that the channels of trade and classes of consumers weigh in favor of finding a likelihood of confusion, the dissimilarity of the marks is a significant countervailing factor that outweighs the other factors. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive"). In view of the foregoing we find that applicant's mark BOSIDENG BSD and design for "suits, coats,

²⁰ Greene Dep., Exhibit 26.

overcoats, shirts, trousers, skirts, sweaters, T-shirts, pajamas, underwear, leather shoes" is not likely to cause confusion with opposer's BVD marks for underwear, shirts, and t-shirts.

Dilution

In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. Sections 13 and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063 and 1125(c).

The Lanham Act provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1125(c)(1).

Opposer contends that applicant's marks will "blur" the distinctiveness of opposer's BVD mark.²¹ The Lanham Act defines dilution by blurring as follows:

²¹ Opposer's Brief, p. 20.

"dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.²²

With respect to fame, the dilution analysis requires consideration of the following issues:

1. Whether BVD is a famous mark;
2. Whether BVD became famous prior to the filing date of applicant's application (October 10, 2005); and,
3. Whether BOSIDENG BSD and design is likely to cause dilution by blurring of the distinctiveness of BVD.

A. Whether opposer's mark is famous for purposes of dilution?

Although we have found BVD famous for purposes of opposer's likelihood of confusion claim, we must now determine whether BVD is famous in the context of a dilution claim. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - it either exists or it does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of

confusion "[f]ame is relative . . . not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection").

In *Toro*, we described the requirements for proving that a mark is famous:

While the eight statutory factors are a guide to determine whether a mark is famous, ultimately we must consider all the evidence to determine whether opposer has met its burden in demonstrating that the relevant public recognizes the [BVD mark] as "signifying something unique, singular, or particular." H.R. REP. No. 104-374, at 3 (1995). Because famous marks can be diluted by the use of similar marks on non-competitive goods and services, the owner of a famous mark must show that there is a powerful consumer association between the term and the owner.

* * *

Fame for dilution purposes is difficult to prove.

* * *

²² Section 43(c)(2)(B) of the Lanham Act, 15 U.S.C. §1125(c)(2)(B).

Therefore, an opposer ... must provide evidence that when the public encounters opposer's mark in almost any context, it associates the term, at least initially with the mark's owner.... Examples of evidence that show the transformation of a term into a truly famous mark include:

1. Recognition by the other party.
2. Intense media attention.
3. Surveys.

* * *

But in order to prevail on the ground of dilution the owner of a mark alleged to be famous must show a change has occurred in the public's perception of the term such that it is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods or services.

Toro Co. v. ToroHead Inc., 61 USPQ2d at 1180-1181. In other words, "the transformation of a term into a truly famous mark" means that "the mark must be a household name." *Thane International, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9th Cir. 2002). See also *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1610-1611 (TTAB 2010).

Opposer's evidence regarding fame is recounted *supra*. This evidence is not sufficient to show that opposer's mark is famous for purposes of dilution. In concluding that opposer has not met the stringent requirements of proving fame for purposes of dilution, we note that opposer's

evidence of fame falls far short of the quantum and quality of evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003) that was found sufficient to prove that opposer's mark was famous for dilution purposes. In *NASDAQ Stock Market Inc.*, opposer introduced market studies demonstrating that the awareness of opposer's stock market among investors reached more than 80% in 1999. In this case, opposer's DNR magazine articles are most akin to a brand awareness study but they are of limited probative value because opposer did not proffer a witness with first-hand knowledge of the study to explain how the study was conducted, how many people participated in the study or how many people read the published study. In addition, the opposer in *NASDAQ Stock Market Inc.* introduced newspaper and magazine articles, and stock market reports that evidenced a widespread recognition of opposer's mark beyond just investors. With the exception of the DNR survey articles noted above, opposer failed to introduce media evidence showing widespread recognition of opposer's mark, let alone that it has been transformed into a household name. Furthermore, although opposer introduced numerous advertisements displaying its mark, there was no testimony regarding how many people saw the advertisements. Finally, with the exception of Mr. Greene's vague testimony that opposer has done advertising suitable to support its sales,

opposer did not submit any testimony or evidence regarding its advertising expenditures.

In this regard, opposer argues that it "invested millions of dollars in advertising goods bearing the BVD mark in various media, including print, television, and the internet."²³ On pages 29-32 of his deposition, Mr. Greene describes opposer's print and internet advertising, not opposer's advertising expenditures. There is no testimony regarding opposer's advertising expenditures except Mr. Greene's testimony that "[o]ur advertising investment has always been an appropriate amount to suit a business of that size."²⁴ As indicated above, Mr. Greene, in his testimony, did not identify "an appropriate amount to suit a business of that size." While we may infer that it is sizable, since it is opposer's duty to clear prove that its mark is famous, *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d at 1904, we may not conclude that "sizable" is sufficient to prove that opposer's mark is famous for purposes of dilution.

Finally, opposer argues that "the fame of Opposer's BVD mark easily satisfies the higher standard" of fame required for dilution, *citing B.V.D. Licensing Corp. v. Body Action*

²³ Opposer's Brief, p. 21, citing the Greene Dep., pp. 29-32 and 53-55.

²⁴ Greene Dep., p. 54.

Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).²⁵

In that case, the Federal Circuit took judicial notice of "the fact that within our jurisdiction, which is the whole United States, the B.V.D. trademark is at least widely, if not universally, known." *Id.* at 1721. However, we will not take judicial notice of the fame a mark for purposes of dilution. In *B.V.D. Licensing Corp. v. Body Action Design Inc.*, the issue was likelihood of confusion, not dilution for which there is a more stringent standard for determining fame. In this regard, the Court specifically noted that the "focus" of that case was "not primarily on fame but on likelihood of confusion." *Id.* Fame is an evidentiary factor to consider in determining whether there is a likelihood of confusion whereas in a dilution claim, fame is an element of the cause of action. Second, according to the Advisory Committee notes, judicial notice may be taken of adjudicative facts [*i.e.*, the facts that would normally go to a jury in a jury trial] and judicial notice of facts should only be taken when the matter is "beyond reasonable controversy."

The usual method of establishing adjudicative facts is through the introduction of evidence, ordinarily consisting of the testimony of witnesses. If particular facts are outside the area of reasonable controversy, this process is dispensed with as unnecessary. A high degree of

²⁵ Opposer's Brief, p. 20.

indisputability is the essential prerequisite.

Fed. R. Evid. 201, *Advisory Committee Notes - 1972 Proposed Rules*. We should not use a debatable supposed fact [*i.e.*, the fame of the B.V.D. mark] to bootstrap a dubious conclusion to support an element of opposer's dilution claim.

In view of the foregoing, on the record before us, opposer failed to prove that the mark B.V.D. is famous for purposes of dilution.

B. Whether B.V.D. became famous prior to October 10, 2005?

In the event that this case is appealed and the reviewing court finds that based on opposer's record the mark B.V.D. is famous, we find that it became famous prior to the October 10, 2005 filing date of the application. We base this finding of fact on opposer's long use of the mark, the dictionary recognition, and the November 21, 2005 issue of the DNR magazine with the brand awareness survey.²⁶

C. Whether BOSIDENG BSD and design is likely to cause dilution by blurring of the distinctiveness of BVD?

In determining whether applicant's mark will cause dilution by blurring, Section 43(c)(2)(B) lists six factors. We focus our analysis on the first factor: the degree of

²⁶ Although the November 21, 2005 issue of the DNR magazine is subsequent to the October 5, 2005 filing date, the renown of the BVD mark had to exist prior to November 2005 for BVD to be identified as a well-known brand.

similarity between the mark or trade name and the famous mark.

The harm dilution does to the selling power of a mark is not only caused by a third-party use or registration of an identical mark. It may be caused by a "look-alike" mark, one that is close enough to the famous mark that consumers will recall the famous mark and be reminded of it, as this Board has explained, "even if they do not believe that the goods come from the famous mark's owner":

Dilution occurs when consumers associate a famous mark that has traditionally identified the mark holder's goods with a new and different source." *Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 832, 50 USPQ2d 1047, 1051 (8th Cir. 1999). Therefore, blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner.

Toro Co., 61 USPQ2d at 1183. See also *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1030 (TTAB 2011); *Coach Services*, 96 USPQ2d at 1612-13. The Board also noted in *National Pork Board*, 96 USPQ2d 1479, 1497 (TTAB 2010), that:

When making a determination under the Trademark Dilution Revision Act of 2005 (TDRA), after finding in the affirmative on the question of pre-existing fame, an important question in a dilution case is whether the two involved marks are sufficiently similar to trigger

consumers to conjure up a famous mark
when confronted with the second mark.

While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists. Also, in determining the similarity or dissimilarity of the marks, "we will use the same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Coach Services*, 96 USPQ2d at 1613. *See also Nike Inc. v. Maher*, 100 USPQ2d at 1030.

We find that applicant's mark BOSIDENG BSD and design is so different than opposer's BVD mark that it will not "trigger consumers to conjure up" opposer's mark. *See National Pork*, 96 USPQ2d at 1497. Accordingly, applicant's mark will not create an association with opposer's BVD mark to support opposer's dilution claim. *Cf. Kellogg Co. v. Pack'em Enterprises Inc.*, 21 USPQ2d at 1145 ("We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive").

On this record, opposer cannot prevail on its dilution claim because we have found that opposer has not met its

burden of proving that its mark is famous for purposes of dilution and because applicant's mark will not create an association with opposer's mark sufficient to cause dilution by blurring.

Decision: The opposition is dismissed on the ground of likelihood of confusion and on the ground of dilution.