

Mailed: April 14, 2014

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

Pepsico, Inc.

v.

Jay Pirincci

Opposition No. 91187023
to Application No. 77297998
Filed: October 6, 2007

Paul J. Reilly and Lauren Beth Emerson, Baker Botts, LLC, for opposer.

Jay Pirincci, applicant, *pro se*.

**Before Quinn, Mermelstein, and Wellington, Administrative Trademark
Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Jay Pirincci seeks registration of the mark **CAN DEW** (in standard characters) for

Nutritional drink mixes for use as a meal replacement in a
can plastic or bottle, International Class 5,

based on an intention to use the mark in commerce. Pepsico, Inc. opposes registration, alleging (1) that applicant's mark is likely to cause confusion in view of opposer's use of and registrations for **MOUNTAIN DEW**, and related marks, pursuant to Trademark Act § 2(d); 15 U.S.C. § 1052(d); and (2) that applicant's mark is likely to cause dilution by blurring of opposer's marks, pursuant to Trademark Act § 43(c); 15 U.S.C. § 1125(c).

By its answer, applicant denied the salient allegations of the notice of opposition.

For the following reasons we sustain the opposition.

I. Description of the Record

The record comprises the pleadings and the files of the opposed applications. Trademark Rule 2.122(b). In addition, the parties proffered the following:


A. Opposer's Evidence

- Testimonial Declaration of Elizabeth Bilus, Intellectual Property Counsel for PepsiCo, with exhibits (Oct. 26, 2010) (Dkt. # 92);
- Testimonial Declaration of Brett O'Brien, Director of Marketing for PepsiCo, with exhibits (Nov. 1, 2012) (Dkt. # 91, 88 (under seal));
- Testimonial Declaration of Hal Poret, Senior Vice President of ORC International, testifying as an expert and introducing survey evidence, with exhibits (Oct. 26, 2012) (Dkt. # 90);
- Opposer's Notice of Reliance (Nov. 14, 2012) (Dkt. # 87);
- Opposer's Rebuttal Notice of Reliance (March 6, 2013) (Dkt. # 110).

With its notice of reliance, opposer submitted copies of each of the registrations listed below from the USPTO's electronic databases showing that each listed registration is valid and subsisting, and is owned by opposer.¹ *Opp. Not. of Reliance* Exh. M; *see also Bilus Dec.* Exh. B–E, H–K.

¹ Renewals and affidavits of continuing use under Trademark Act §§ 8–9 have been filed as appropriate with respect to the listed registrations. Affidavits under Trademark Act § 15 were filed with respect to the first five listed registrations.

In its notice of opposition, opposer pled ownership of five additional registrations (Reg. Nos. 2641068, 2946260, 3118413, 2900848, and 3196801). Two of them (Nos. '413 and '801) were submitted with opposer's notice of reliance filed November 14, 2012. However, as of the date of this decision, all five registrations have been cancelled pursuant to Trademark Act § 8, so we will give them no consideration. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (an expired or cancelled registration is evidence of nothing but the fact that it once issued).

Reg. No.	Mark	Goods & Services	Filing Date	Issue Date
0820362	MOUNTAIN DEW	Soft drinks and concentrates used in the preparation thereof. IC 32	April 15, 1966	Dec. 13, 1966
1200615	DEW	Soft Drinks. IC 32	April 6, 1981	July 6, 1982
1932027	DO THE DEW	Soft Drinks. IC 32	Aug. 23, 1993	Oct. 31, 1995
2732061	MOUNTAIN DEW VERTICAL CHALLENGE	Organizing sporting events namely ski and snowboard races. IC 41	Feb. 13, 2002	July 1, 2003
2986575	MOUNTAIN DEW	Clothing, namely, t-shirts. IC 25	Feb. 19, 2004	Aug. 16, 2005
3353706		Lip balm; lip gloss. IC 3	Oct. 24, 2005	Dec. 11, 2007
3392639	DEW ICED (“ICED” disclaimed)	Smoothies. IC 32	March 6, 2007	March 4, 2008
3426588	MOUNTAIN DEW	Drinking glasses. IC 21	Sep. 12, 2007	May 13, 2008

(As the parties have done, we refer collectively to opposer’s registrations as the “**DEW** marks.”)

B. Applicant’s Evidence

- Applicant Jay Pirincci’s Declaration,² with exhibits (Jan. 2, 2013).

II. Entry of Partial Summary Judgment

As published in the *Official Gazette* and opposed, the subject application included the following goods in Class 32:

Fruit drinks and fruit beverages; Fruit flavored carbonated beverages; Fruit flavored energy drinks; Non-alcoholic malt beverages; Malt beer; all in a can, plastic or bottle.

Prior to trial, opposer moved for summary judgment on its likelihood of confusion and dilution claims as to the goods in both opposed classes. *Motion for Summ. J.* (Nov. 4, 2011); Dkt. # 70. Noting that “opposer ha[d] introduced substantial evidence that

² We refer to this document as a “declaration” because it is titled as such. As will be seen, however, it is not a declaration pursuant to the rules governing this proceeding.

MOUNTAIN DEW is an exceedingly famous mark,” *Order* 8 (June 25, 2012); Dkt. # 82, the Board found “no genuine dispute as to any material fact regarding the fame of **MOUNTAIN DEW**, and [that] this fact weighs heavily in opposer’s favor.” *Id.* at 9.

Comparing the marks, the Board noted that “DEW” is an arbitrary term for the goods at issue, and that although applicant’s mark includes the word “CAN,” that word is descriptive of beverages sold in cans, and the term is thus entitled to little weight in comparing the marks. Again, the Board found no genuine dispute of fact as to the similarity of the marks. *Id.* at 10–11.

In comparing the goods at issue, the Board found the parties’ Class 32 goods to be identical in part, again establishing no factual dispute for trial. *Id.* at 11–12. Nonetheless, the panel did find a genuine dispute of material fact as to the relationship of opposer’s goods and services with applicant’s Class 5 “nutritional drink mixes for use as a meal replacement.” *Id.* at 12. And accordingly, the Board found that while the partially-identical Class 32 goods would be sold in the same channels of trade, there remained a genuine dispute as to the similarity of the channels of trade for applicant’s Class 5 goods with respect to opposer’s goods and services. *Id.* at 13. The Board also found “that consumers would not exercise a great deal of care in purchasing the parties’ goods,” *id.* at 14, but that opposer had presented insufficient evidence to demonstrate that “applicant intended to trade upon opposer’s goodwill,” *id.* at 14.

Finally, the Board found a survey presented by opposer’s witness, Mr. Poret, to have been executed “in a well-accepted format,” and further that the survey “is admissible and credible.” *Id.* at 16–17. In the context of the parties’ Class 32 goods, the sur-

vey found a significant level of “net confusion,” and further that the confusion was the result of the common word “DEW” in the marks. However, the survey did not consider the impact of applicant’s intended use of its mark on the identified Class 5 goods. *Id.* at 16.

In consideration of the evidence presented, the Board granted partial summary judgment to opposer on its Section 2(d) claim, finding no genuine dispute of material fact and that confusion is likely with respect to applicant’s Class 32 goods. Summary judgment was denied with respect to applicant’s Class 5 goods.³ The Board found that genuine issues remained for trial at least as to whether applicant’s Class 5 goods, customers, and channels of trade are similar or related to opposer’s goods. *Id.* at 18. The Board also denied summary judgment on the ground of dilution by blurring, finding that “genuine disputes exist as to the ‘extent to which [opposer] is engaging in substantially exclusive use’ of its marks, whether applicant ‘intended to create an association with’ opposer’s mark and whether there is ‘[a]ny actual association’ between the parties’ marks.” *Id.* at 19 (quoting Trademark Act § 43(c)(2)(B)(iii), –(v), –(vi)).

Because summary judgment has already been entered with respect to applicant’s Class 32 goods, we confine ourselves in this decision to consideration of the registrabil-

³ Applicant seems to place substantive significance on the Board’s denial of summary judgment with respect to his Class 5 goods. *App. Br.* at 7 (“The recent USPTO order has ruled to allow the continuation of this dispute for category 005 for a reason. Pepsico cannot receive protection in all categories.”). To the contrary, unlike a *grant* of summary judgment, “the denial of a motion for a summary judgment because of unresolved issues of fact does not settle or even tentatively decide anything about the merits of the claim. It is strictly a pretrial order that decides only one thing — that the case should go to trial.” *Switz. Cheese Ass’n, Inc. v. E. Horne’s Mkt., Inc.*, 385 U.S. 23, 25 (1966); *Senza-Gel Corp. v. Seiffhart*, 803 F.2d 661, 231 USPQ 363, 369 (Fed. Cir. 1986) (“A denial of summary judgment . . . is not a judgment at all.”).

ity of applicant's mark for use on "nutritional drink mixes. . ." in Class 5. Nonetheless, some of the findings made in the order granting partial summary judgment are also relevant to the issues now before us. We see nothing in the briefs or trial record now before us to cast doubt on any of the findings made in the prior order. We accordingly treat those findings as the law of the case,⁴ and defer to them when appropriate.

III. Preliminary Matters

Applicant represents himself in this proceeding. The applicable rules permit him to do so, although the Board does not recommend it. Board proceedings often involve complicated issues of substantive law and procedure which can prove difficult for a layman. Throughout this proceeding, the Board has reminded applicant of the advisability of retaining counsel,⁵ at one point warning that "it appears likely that if applicant does not retain an attorney, his efforts will continue to fail and his efforts to defend this pro-

⁴ To the extent relevant here,

[t]he law of the case is a judicially created doctrine, the purposes of which are to prevent the relitigation of issues that have been decided. . . . The doctrine requires a court to follow the decision on a question made previously during the case. It is applied more or less strictly depending on the circumstances of the case. . . . At the trial level. . . , the law of the case is "little more than a management practice to permit logical progression toward judgment." Orderly and efficient case administration suggests that questions once decided not be subject to continued argument, but the court has the power to reconsider its decisions until a judgment is entered.

Jamesbury Corp. v. Litton Indus. Prods. Inc., 839 F.2d 1544, 5 USPQ2d 1779, 1783 (Fed. Cir. 1988) (footnotes omitted).

⁵ See *Order* at 2–3 (Dec. 3, 2008), Dkt. # 6 ("Applicant is reminded that he will be expected to comply with all applicable rules and Board practices . . . it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney"); *Order* at 3 (June 30, 2011), Dkt. # 49; *Order* at 10 (Jan. 7, 2012), Dkt. # 107 ("applicant has been warned repeatedly that he must comply with the Trademark Rules applicable in this proceeding, despite his decision to proceed pro se").

ceeding will be severely prejudiced.” *Order* at 3 (June 30, 2011), Dkt. # 49.

As predicted, applicant has indeed had serious difficulty in defending this opposition *pro se*,⁶ and as will be seen, this pattern continued through trial and briefing. While we have kept in mind that applicant is representing himself, we are limited in our ability to excuse the consequences of his unfamiliarity with the law. Although it is appropriate to show patience toward an unrepresented party, lack of representation is not a license to disregard the applicable rules or statutory requirements.

A. Opposer’s Evidentiary Objections

By stipulation, the parties agreed to permit the submission of “testimony . . . by declaration with a[] . . . signature of the witness/declarant, in support of their respective cases,” reserving the right to cross-examination and to object to the declaration testimony on other grounds. *Stipulation* (Sept. 24, 2012), Dkt. # 86 (emphasis added); *see Order* (Dec. 5, 2012), Dkt. # 101 (approving stipulation). During his testimony period, applicant filed “Applicant Jay Pirincci’s Declaration,” (Jan. 2, 2013), Dkt. # 106, a seventeen-page statement, together with various attachments. Opposer raised several objections to the form and substance of the Pirincci Declaration soon after it was filed, *Opp. Objections* (Jan. 11, 2013), Dkt. # 108, and in an attachment to opposer’s trial brief, *Opp. Br. Appx. A* (May 3, 2013). In a telephone conference with the Board interlocutory attorney, it was confirmed that applicant’s filing was intended as a testimonial

⁶ *See Order* at 3–4 (Apr. 19, 2011), Dkt. # 42 (applicant’s attempted expert disclosures untimely and not in compliance with rules); *Order* (Dec. 27, 2011), Dkt. # 76 (applicant’s response to opposer’s motion for summary judgment (and cross-motion) stricken for non-compliance with rules), *Petition Denied* (Comm’r May 16, 2012), Dkt. # 81; *Order* (Jan. 7, 2013), Dkt. # 107 (testimony of seven of applicant’s witnesses quashed for failure to comply with rules).

declaration, although a decision on opposer's objections was deferred until final hearing. *Order* (Jan. 14, 2013), Dkt. # 109.

Opposer's most serious objection is that applicant's testimonial statement "lacks the required attestation." *Opp. Objections* ¶ 1. In a typical Board case, our rules require that testimony be taken by oral deposition subject to the witness' oath or affirmation, and recorded and transcribed by a court reporter. Trademark Rule 2.123(a)(1). However, if the parties so agree, the rules explicitly permit the Board to consider "testimony . . . in the form of an affidavit^[7] by [the] witness or witnesses." Trademark Rule 2.123(b). Another rule says that when filing any trademark-related paper with the USPTO which requires an affidavit, a party may instead submit a signed *declaration*, using the following attestation:

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Trademark Rule 2.20. And finally, a Federal statute not specifically related to trademarks provides that any time a declaration, affidavit, or the like is required by a feder-

⁷ An *affidavit* is a "written or printed declaration or statement of facts, made voluntarily, and confirmed by the oath or affirmation of the party making it, taken before a person having authority to administer such oath or affirmation." BLACK'S LAW DICTIONARY 54 (5th ed. 1979). Affidavits are typically sworn to and subscribed before a notary public, whose signature and seal also appear on the document.

The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

al statute or regulation, the filer may submit a declaration by using the following simple attestation:

I declare (or certify, verify, or state) under penalty of perjury
that the foregoing is true and correct. Executed on (date).
(Signature).

28 U.S.C. § 1746.

Thus applicant could have taken a testimonial deposition upon an oath or affirmation before a court reporter pursuant to Trademark Rule 2.123(a). But the parties' stipulation relieved them of the significant expense and formality of a proper testimonial deposition, allowing them to submit testimony by *declaration* instead.⁸ But a declaration isn't simply a written statement. In this context, a declaration is a statement which is attested to pursuant to Trademark Rule 2.20, or at least pursuant to 28 U.S.C. § 1746. Applicant followed none of these procedures, but simply signed his statement without attestation. And although opposer filed its objections promptly, applicant did not attempt to cure the defect by submitting a properly-attested testimonial declaration while trial was in progress or any time after that.

The Board's rules pertaining to the taking of testimony plainly require that witnesses must formally attest to statements of fact submitted during trial by oath or affirmation (for a testimonial deposition), although if the parties agree to do so, testimony may be submitted in the form of an affidavit, or a simple declaration to the effect that the recited facts are true and correct and are given under penalty of perjury. But

⁸ Testimony in the form of an affidavit would likely have also been acceptable, although even the nominal expense and bother of having the papers signed and notarized was unnecessary under both the parties' agreement and Trademark Rule 2.20.

the Rules do not permit the consideration of unsworn testimonial statements at trial. *See* FED. R. EVID. 603 (“Before testifying, a witness *must* give an oath or affirmation to testify truthfully.” (emphasis added)). Although oaths and the like have obscure origins in ancient law, they remain a fundamental part of our modern legal system. Courts and administrative agencies routinely require that witnesses attest to testimonial statements (*i.e.*, statements of fact relevant to the issue before the tribunal) by one of the foregoing means or an equivalent.⁹

We conclude that the Board’s rules and the parties’ agreement required that witnesses attest to their testimonial statements by an oath or affirmation in one of the various forms discussed, but that applicant’s statement did not satisfy any of these alternatives. The necessity for proper attestation is not a trivial matter in a Board proceeding. Opposer timely objected to applicant’s statement, and preserved that objection in its brief. Accordingly, opposer’s objection is SUSTAINED; we will not consider applicant’s “declaration” filed January 1, 2013, (or the copy filed June 5, 2013, Dkt. # 113). Nonetheless, and mindful of applicant’s lack of representation before the Board we will,

⁹ Although they may seem a quaint anachronism, oaths, affirmations, and the like retain at least two salutary effects in modern proceedings: First, the degree of solemnity lent by an oath or affirmation is a strong admonishment to the witness of the seriousness of his obligation to the tribunal to be forthcoming and honest in his statements. And second, if the formality itself is not a sufficient reminder to the witness, the act of attestation entails its own incentives to tell the truth. As noted in Trademark Rule 2.20, willful false statements in a declaration to the USPTO may jeopardize the validity of any resulting registration; indeed, they might even constitute a felony, punishable by imprisonment and a fine. *See* 18 U.S.C. § 1001 (false statements); 18 U.S.C. § 1621 (perjury). Although criminal prosecutions are rare, even the remote possibility of such consequences ought to give pause to anyone tempted to take liberties with the truth. These oaths and attestations thus provide assurance — although admittedly not a guarantee — to the tribunal and to the parties that the witness’ statement is trustworthy.

with one exception,¹⁰ consider the documents attached to applicant's declaration¹¹ if and to the extent they would have been admissible under a notice of reliance. To the extent necessary, we discuss the admissibility of specific items below.

B. Motion to Strike Applicant's Brief

Applicant filed its trial brief on June 5, 2013, one day late. Opposer moves to strike it. *Opp. Mot. to Strike* (June 13, 2013) (Dkt. # 115). Applicant responded, alleging — along with some irrelevant matters — that the interlocutory attorney assigned to this case informed him “that the deadline would be on June 6, 2013.” *Response* at 2 (June 26, 2013) (Dkt. # 117). Applicant's factual allegations were not supported by a declaration or any other evidence.

The Board may retroactively extend (*i.e.*, reopen) the time for applicant to file his brief “if [applicant] failed to act because of excusable neglect.” Fed. R. Civ. P. 6(b)(1)(B).

¹⁰ Attached as an exhibit to applicant's putative declaration was a copy of applicant's brief and cross-motion in response to opposer's motion for summary judgment (with exhibits). This paper was originally filed December 22, 2011, but stricken for failure to comply with the rules applicable to a brief on a motion. *See Order* (Dec. 27, 2011); Dkt. # 76. Opposer objects to consideration of this document, and rightly so. To the extent it was intended to be considered for its factual content, applicant's brief and cross-motion is — like the declaration itself — a statement which was not made under oath or affirmation. On the other hand, if it was applicant's intention that its brief and cross-motion be considered for the arguments it sets out, it would constitute an impermissible second brief on the merits of the case. (And as a brief, it would once again be stricken because it does not meet the requirements for a trial brief.) But again, we will consider the exhibits attached to the brief and cross-motion, if and to the extent that they would have been admissible under a notice of reliance.

¹¹ Our willingness to consider the *attachments* to applicant's “declaration” does not extend to any material which was linked to or referred to by applicant but not actually attached to his declaration. *See Opp. Objections* ¶ 2 (Jan. 11, 2013). The Board will not follow hyperlinks or look for evidence which is not actually submitted. *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (“reference to a website's internet address is not sufficient to make the content of that website or any pages from that website of record”). *See also Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (because of the transitory nature of internet postings, evidence referenced only by links may later be modified or deleted).

The determination of excusable neglect depends on all of the circumstances of the case, including (1) any prejudice to the other party; (2) the length of the delay and its effect on this case or others; (3) the reason for the delay; and (4) whether the movant acted in good faith. *Pioneer Invest. Servs. Co. v. Brunswick Assoc. Ltd. P'ship*, 507 U.S. 380, 395 (1993).

We begin with the reason for the delay, which the Board, along with a number of courts, have found to often be the most significant factor. *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997). Applicant's allegation is that the assigned Board interlocutory attorney incorrectly advised him orally that his brief was due June 6, 2013. *Response* at 2 (June 26, 2013) ("Jay Pirincci trusted her advice and used this information in preparing his Trial Brief. If he can't rely on the interlocutory attorney in charge who can he rely on for procedural information[?]").

Applicant's argument is unavailing. The applicable rule is clear: "All business with the Office should be transacted in writing. . . . The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Trademark Rule 2.191. This rule is a long-standing principle of practice before the USPTO, and is applicable to situations like this one, in which a party alleges that Office personnel made an oral promise or gave advice which is later at issue.¹² In this

¹² Trademark Rule 2.191 avoids the unseemly situation in which a USPTO employee might otherwise have to dispute a party's recollection of a conversation which was not memorialized in the record. This case illustrates the point: although we are skeptical of applicant's allegation that the interlocutory attorney gave applicant *any* sort of legal advice, let alone the wrong advice, Trademark Rule 2.191 makes clear that the question is irrelevant, as applicant could not
(continued...)

case, the due date for applicant's brief was clearly governed by Trademark Rule 2.128(a)(1), and the trial schedule as last reset on October 22, 2010. While it is not uncommon for Board personnel to tell a party — especially one appearing *pro se* — where the applicable rules may be found, the interpretation and application of them is the party's own responsibility or that of his counsel. While we are cognizant that applicant has chosen to proceed without the benefit of legal counsel, calculating (and meeting) the filing date for a brief is a relatively simple, fundamental task expected of all parties before the Board. Applicant's attempt to avoid this responsibility by blaming the interlocutory attorney is not well-taken.

As for the other *Pioneer* factors, we find that applicant's delay of one day caused no prejudice to opposer, which still had fourteen days remaining in which to file its reply brief, and could have requested an extension of time if needed (and apparently none was needed). The length of the delay was minimal and — but for the necessity of ruling on opposer's motion to strike — it has had little impact on this proceeding or on the Board's docket. And there is no evidence that applicant's delay of one day was the result of bad faith, so we treat that factor as neutral.

Finally, we must “take[] account of all relevant circumstances surrounding the party's omission.” *Pioneer*, 507 U.S. at 395. In addition to the non-exclusive *Pioneer* factors, we think it appropriate in this case to consider the additional burden on the Board were we to strike applicant's brief. While striking a brief on a motion is frequently dis-

rely on such oral advice even if it had been given. Because we must rely exclusively on the written record, we need not question, let alone besmirch, the memory, good faith, or veracity of either applicant or the interlocutory attorney.

positive, striking applicant's trial brief would not end this opposition; opposer must still prove its case and we would still have to consider any evidence that applicant had properly made of record. But considering evidence without the guidance of an argument is problematic for a variety of reasons and would impose an additional burden on the Board. Accordingly, we will consider this as an additional—albeit minor—consideration which weighs against striking applicant's trial brief.

In sum, the most important *Pioneer* factor—the reason for the delay—is not in applicant's favor, as applicant has offered no reasonable justification for its delay. Nonetheless, the one-day delay was minimal, caused opposer no prejudice, had very little impact on this proceeding, and does not appear to have been taken in bad faith. And in this particular case, considering applicant's evidence without the benefit of his argument would be a burden on the Board.

After consideration of all the factors, we DENY opposer's motion to strike.

IV. Standing and Priority

To establish its standing, opposer must prove that it has a real interest in the outcome of this proceeding and a reasonable basis for its belief that it would be damaged by issuance of a registration of the mark to applicant. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). In light of its claim that confusion is likely, opposer's submission of its pleaded trademark registrations adequately establishes opposer's interest in this proceeding and a reasonable basis for its belief that damage would result from registration.

Because opposer has established ownership of a number of valid and subsisting trademark registrations, priority is not an issue with respect to the marks in those registrations and the goods respectively identified in them. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Further, opposer's declaration testimony and other evidence establish opposer's use of its **DEW** and **MOUNTAIN DEW** marks (and variants) for soft drinks long prior to the filing date of the subject application. Opposer's declarants testified to the use of the **DEW** marks on soft drinks by applicant and its predecessor-in-interest since "the 1940's." *Bilus Dec.* ¶¶ 2–3; *O'Brien Dec.* ¶¶ 2–3. On this record, we find that opposer's marks were "previously used and not abandoned," Trademark Act § 2(d), and that opposer clearly has established priority with respect to its unregistered trademarks and the associated goods.

V. Likelihood of Confusion

A. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). 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); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209, 1210 (TTAB 1999). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

B. The Trademarks at Issue

Because the parties' briefs evidence some confusion on the issue, we first consider what marks and goods are at issue before engaging in the *du Pont* analysis.

1. The Marks

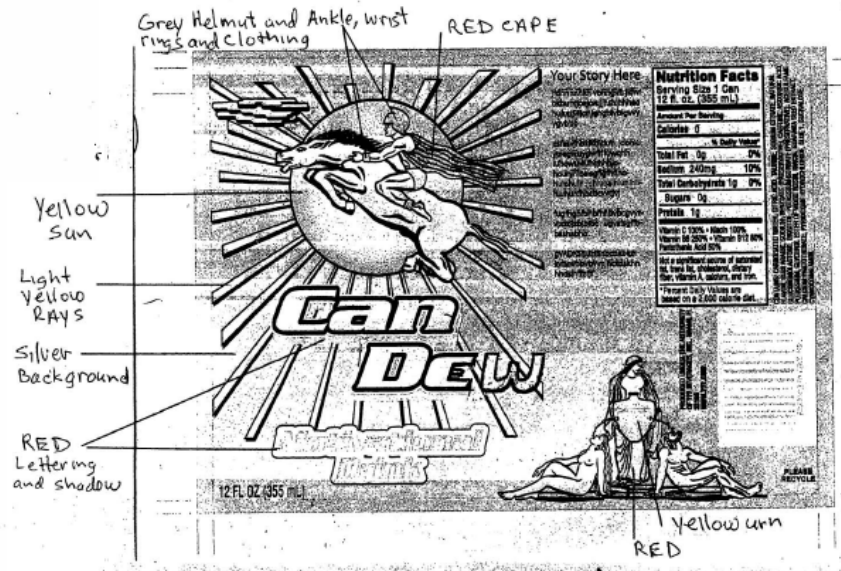
Like the marks in opposer's registrations,¹³ applicant's mark is depicted in "standard characters." A "standard character" mark is a word or words which are registered (or sought to be registered) "without claim to any particular font style, size, or color." Trademark Rule 2.52(a). The registration of a standard-character mark must be construed to cover the possible use of such a mark in any manner of display. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Nonetheless, applicant urges us to compare the entire label under which he intends to sell his product with the labels opposer actually uses on its products. *E.g.*, *App. Br.* at 3 ("[c]ompare [opposer's] jagged pointy design with subdued unattractive colors . . . to my design . . . of a warrior on a horse with the sun in the background"); *id.* at 5 ("[t]hey have made no comparison of the image of the product, the pictures, illustra-

¹³ For the sake of simplicity, our analysis omits opposer's '706 Registration (MOUNTAIN DEW CODE RED and design), which is opposer's only registration with a special-form drawing. As will be seen, it is unnecessary for our decision.

tions or colors on the labels”); *id.* at 9 (“Even after pointing out the obvious distinct differences between the products by displaying the applicant’s proposed image with its [*sic*] design, colors, image, . . . and comparing it to the label of a plastic bottle of Mountain Dew next to each other on the table during the depositions, [opposer’s witnesses] all said the two products were similar in many ways.”). The drawing of applicant’s proposed label is not properly of record,¹⁴ but even if it were, we cannot consider it in the manner applicant requests.

As reproduced below, applicant’s proposed label features the words “Can Dew,” and a design of the sun and clouds, in front of which is a leaping (or flying) horse, ridden by what applicant describes as a “warrior” in a helmet and cape. Below is a group of three figures, one of which holds an urn. Someone (presumably applicant) has handwritten notes around the label, apparently indicating that various elements of the label will be printed in particular colors.

¹⁴ Applicant’s proposed label does not fall within any of the categories of documents which may be submitted under a notice of reliance. *See* Trademark Rules 2.120(j) (certain discovery materials); 2.122(d)(2) (registrations); 2.122(e) (printed publications and official records). To be admissible, evidence such as this must be authenticated or identified through the testimony (or in this case, the declaration) of one having firsthand knowledge of the document and its authenticity. *See* FED. R. EVID. 901(a). We needn’t consider whether applicant’s declaration adequately identified this document because the declaration has been stricken, leaving applicant’s proposed label without a foundation for admission in evidence. Nonetheless, we discuss the label here to fully explain our decision.



Pirincci Dec. Exh. 1 (this exhibit also includes what appears to be a label from one of opposer’s beverages, presumably for comparison with applicant’s label).

Applicant’s contentions miss the mark — literally. Contrary to applicant’s arguments, this proceeding is about the registrability of *the mark which is depicted in the opposed application*. The drawing of the mark in the application consists of the words **CAN DEW**, in that order, no more and no less. And because applicant has applied for registration of its mark in standard characters, we must consider applicant’s mark to include the display of the words **CAN DEW** in any color, size, or typeface, regardless of applicant’s intended (or actual) use on its labels. *See Cunningham*, 55 USPQ2d at 1847 (“Registrations with typed drawings are not limited to any particular rendition of the mark, and, in particular, are not limited to the mark as it is used in commerce.”). Legally, we must assume that applicant’s applied-for mark could be used in the very same color, size, and typeface as that which opposer uses on its own labels.

Further, while applicant places considerable significance on the other elements of

the label he intends to use for his product, these elements, too, must be ignored in our analysis. Except for the words **CAN DEW**, nothing on applicant's proposed label is part of the trademark which applicant seeks to register. Therefore, no matter how distinctive they may be, neither the sun and clouds design, the horse and caped warrior, the three figures with an urn, nor the particular colors applicant intends to use can be considered in an effort to distinguish applicant's mark from the marks opposer has used and registered.

And for the most part, the same is true of opposer's marks. None of the marks in opposer's standard-character registrations is limited to the specific manner in which opposer actually uses those marks on its products. Opposer's standard-character registrations must be considered to cover opposer's use as trademarks of the words depicted in those registrations in any stylization, including display of the mark in the same color, size, and typeface as that which applicant intends to use. Thus, as far as opposer's standard-character registrations are concerned,¹⁵ any differences between opposer's actual and applicant's intended labels (other than differences in the words themselves) are irrelevant. A proper analysis thus compares the marks in opposer's registrations with the mark in the subject application. Any distinction that might be drawn based on

¹⁵ Unlike the rights afforded by opposer's registrations, the common-law rights flowing from opposer's *use* of its trademarks are determined by the manner in which opposer actually uses those marks on or in connection with its actual goods and services. Although opposer has alleged and proven rights based on its use of the **DEW** marks, we find it unnecessary to consider such rights at length. Accordingly, we generally confine this opinion to a discussion of applicant's right to register vis-à-vis opposer's registrations. Opposer's actual use of its marks may provide it with other rights of slightly different scope, but an opposition may be based on either registration or prior use, Trademark Act §§ 2(d), 13, and it is well-settled that a registrant's actual use of a mark does not by itself restrict the scope of a registration.

the color, size, or font in which the words may actually be used in connection with either party's goods or based on any other matter which might appear on their actual or intended labels cannot be considered.

2. The Goods

Similar principles apply to the goods at issue. We look to the identification of goods in the application to determine the nature of applicant's goods, notwithstanding any contrary evidence of applicant's actual or intended use of its mark:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), *quoted in Stone Lion Capital Partners, LP v. Lion Capital LLP*, — F.3d —, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Applicant's goods are identified as "nutritional drink mixes for use as a meal replacement in a can plastic or bottle." Nonetheless, opposer argues that "that the actual intended goods identified by **CAN DEW** under Classes 5 and 32^[16] are one and the same."¹⁷ *Opp. Br.* at 27. Because we have already granted summary judgment on op-

¹⁶ Applicant's International Class 32 goods were "fruit drinks and fruit beverages; fruit flavored carbonated beverages; fruit flavored energy drinks; non-alcoholic malt beverages; malt beer; all in a can, plastic or bottle." As noted, the Board previously granted opposer's motion for summary judgment with respect to applicant's Class 32 goods.

¹⁷ In this opinion we use "Class 5 goods" and "Class 32 goods" as convenient shorthand to refer to the goods identified in those international classes. Nonetheless, we recognize that in a likelihood of confusion analysis, the issue is the identified goods or services, and not their classification. The classification system neither limits nor extends the rights of an applicant or registrant. Trademark Act § 30; *In re Vic Boff Health and Fitness Aids, Inc.*, 189 USPQ 357, 358 (continued...)

poser’s likelihood of confusion claim with respect to applicant’s Class 32 goods, opposer contends that we must also find a likelihood of confusion with respect to applicant’s Class 5 goods, as well. *Id.* (citing *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993)). To the contrary, the fact that summary judgment was granted in opposer’s favor with respect to applicant’s Class 32 goods does not require that we find confusion to be likely with respect to applicant’s Class 5 goods.¹⁸

The identification of goods in an application must be read to include the full range of goods so described (and only those goods) regardless of what may be shown about the applicant’s actual or intended use of his mark. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). And while it is possible (and permissible) to identify a single item of commerce in more than one way — and even in more than one class, *see Int’l Salt Co.*, 166 USPQ 215 (TTAB 1970) — opposer has not demonstrated that “nutritional drink mixes for use as a meal replacement” are in fact identical to the soft drinks and beer applicant identified in Class 32. We must consider the goods *as they are identified in the application*, not based on the prosecution history of the application¹⁹ or testimony

(TTAB 1975).

¹⁸ In its motion for summary judgment, opposer also argued that applicant’s goods were but a “single product.” *Mot. for Summ. J.*, at 8 (Nov. 7, 2011); Dkt. # 70. While the Board’s order on opposer’s motion did not discuss this issue in detail, it held that summary judgment as to applicant’s Class 5 goods was precluded because “genuine disputes exist as to whether the parties’ goods . . . are similar or related.” *Order* at 18 (June 25, 2012).

¹⁹ As we have noted in other contexts, we do not apply the patent-law doctrine of file wrapper or prosecution history estoppel. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 963 (TTAB 1986). Instead, the identification of goods in a registration (and in an application which would become a registration if allowed), is interpreted according to the ordinary meaning of its words, regardless of whether and how the application was amended during
(continued...)

about applicant's contrary use or intent.²⁰ *See Octocom*, 16 USPQ2d at 1787; *Stone Lion Capital Partners*, 110 USPQ2d at 1162.

This case differs from *Jean Patou* and *International Salt*, both cited by opposer. In both cases, the applicant identified goods in two classes which were identical or at least could easily have been identical. In *Jean Patou* the goods were cosmetic skin care preparations in Class 3 and pharmaceutical skin care preparations in Class 5; in *International Salt*, one application identified "salt for use in chemical industries," while the other identified "salt for food purposes." Both *Jean Patou* and *International Salt* involved use-based applications and the applicant in both cases used identical specimens for both classes.

By contrast, the application now before us is not based on use in commerce, so we have no specimens or other evidence which might serve as guidance. Moreover, while

prosecution. *See, e.g., In re Thor Tech Inc.*, 85 USPQ2d 1474, 1477 (TTAB 2007) (relying on the ordinary meaning of the identification of goods with deference to terms of art used in the relevant industry); *see generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01 (Oct. 2013) (Specifying the Goods and/or Services — in General). The process by which an identification of goods in an application is amended does not affect the nature or scope of the goods which are ultimately listed.

²⁰ Although opposer suggests otherwise, the scope of the goods covered by an application or registration is not a question of the applicant's intent, but of the objective meaning of the identification as it appears in the application or registration. TMEP § 1402.01. Of course, the proprietor of an intent-to-use applicant who lacks a *bona fide* intent to use his mark on some or all of the identified goods is vulnerable to opposition (or later cancellation) on that ground *if* such a claim is brought; otherwise, we must take an identification of goods at face value.

Opposer points to applicant's testimony in a discovery deposition regarding applicant's intentions for use of its mark, contending that applicant admitted he has no current intent to use the **CAN DEW** mark on "non-alcoholic malt beverages" and "malt beer," both of which were included in applicant's Class 32 goods. *Opp. Br.* at 27; *see Opp. Not. of Reliance* Exh. B(i) (*Pirincci Dep.* at 33). While applicant's responses may have supported a *claim* that applicant did not have a *bona fide* intent to use its mark on malt beverages and beer and possibly other goods in applicant's Class 32 goods, opposer did not plead such a claim.

the applicants in *Jean Patou* and *International Salt* admitted that their applications were directed to the same actual product described in different ways, there is no such admission in this record. Finally, while opposer argues that applicant's Class 5 and Class 32 goods are but one product, opposer does not show here what was obvious in *Jean Patou* and *International Salt*, namely, that there is such a single product that meets applicant's description of goods in both Class 5 and Class 32. Even setting aside applicant's identified "non-alcoholic malt beverages" and (alcoholic) "malt beer,"²¹ it is not clear on this record that applicant's Class 5 nutritional drink mixes are in fact identical to applicant's Class 32 drinks and beverages, or whether "nutritional drink mixes for use as a meal replacement" could be (applying the ordinary meaning of the words with respect to the identified goods) the same thing as "fruit flavored energy drinks" or applicant's other Class 32 goods. Although *Jean Patou* and *International Salt* demonstrate that it is sometimes possible to identify the same product in different ways, which might appear in more than one class, opposer has not shown that to be the case here. Accordingly, it would be inappropriate to simply apply to applicant's Class 5 goods our decision granting opposer's motion for summary judgment as to applicant's Class 32 goods. We consider below whether and to what extent applicant's "nutritional drink mixes . . ." are *related* to opposer's "soft drinks." But on this record, we cannot begin with the assumption that applicant's Class 5 goods are *identical* to his Class 32 goods.

²¹ It is, of course, impossible for a single product to be both an alcoholic and a non-alcoholic beverage.

C. Relevant *du Pont* Factors

1. The Fame of the Prior Mark (Sales, Advertising, Length of Use)

We begin by considering the fame or strength of the prior mark. Fame, when found, is entitled to great weight in a likelihood of confusion analysis. *See Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the court of appeals has held, the “[f]ame of an opposer’s mark or marks, if it exists, plays a ‘dominant role in the process of balancing the *du Pont* factors,’” and “[f]amous marks . . . enjoy a wide latitude of legal protection.” *Recot*, 54 USPQ2d at 1456. “A strong mark . . . casts a long shadow which competitors must avoid.” *Kenner Parker*, 22 USPQ2d at 1456. A famous mark is one that has extensive public recognition and renown. *Bose*, 63 USPQ2d at 1305. In assessing fame, we consider all relevant evidence, including sales under the mark, advertising, and length of use of the mark. *du Pont*, 177 USPQ at 567.

As already noted, when the Board considered opposer’s motion for summary judgment, it found opposer’s **MOUNTAIN DEW** marks famous for “soft drinks.” Applicant submitted no trial evidence which could be construed as undermining the prior panel’s finding of fame, nor did he even argue the issue in his brief. Therefore, we start with the premise that opposer’s **MOUNTAIN DEW** marks are, as previously found, famous. This finding is highly relevant for the remaining issues in this case because opposer asserts the same marks against applicant with respect to applicant’s Class 5 goods. That said, the prior finding specifically mentioned only opposer’s **MOUNTAIN DEW** mark.

We go further and find that opposer's other pleaded marks—*i.e.*, opposer's marks comprising the term **DEW**—are also famous for “soft drinks.”

To begin with, the public has been widely exposed to opposer's use of **DEW** used as a component of opposer's famous **MOUNTAIN DEW** mark for soft drinks. There is no record evidence to suggest that **DEW** is anything other than a distinctive mark for soft drinks, nor is there evidence of any third-party uses of **DEW** for soft drinks or related goods or services. The record reveals that opposer and its predecessor-in-interest have marketed products under the **MOUNTAIN DEW** and **DEW** marks for well over fifty years. According to opposer's witnesses, the original **MOUNTAIN DEW** beverage was created in the 1940s, and the brand was acquired by opposer in 1964. *O'Brien Dec.* ¶ 2; *Bilus Dec.* ¶¶ 2–3. Opposer introduced in evidence nine Federal registrations, including **MOUNTAIN DEW** ('362 Reg.) for “soft drinks and concentrates,” registered in 1966, and **DEW** ('615 Reg.) for “soft drinks,” registered in 1982. Opposer also uses—and has registered—its marks on some goods other than soft drinks, registering **DEW ICED** ('639 Reg.) for “smoothies,” **MOUNTAIN DEW VERTICAL CHALLENGE** ('061 Reg.) for “organizing sporting events . . . ,” and **MOUNTAIN DEW CODE RED** and design ('706 Reg.) for “lip balm [and] lip gloss.” *Opp. Not. of Reliance* Exh. M(i–iv, vii–x); *Bilus Dec.* Exh. B–E, H–K.

The evidence makes clear that over the years, opposer has heavily promoted goods (mainly soft drinks) under its **MOUNTAIN DEW** mark, and continues to do so. In more than a decade between 1998 and 2009, opposer spent an average of \$50 million per year on advertising through television, radio, in print, on the internet, and through

point of sales displays. *O'Brien Dec.* ¶ 30. Although opposer's advertising expenditures specifically attributable to its **DEW** trademarks were submitted under seal, *O'Brien Dec.* Exh. L, we find that they are equally impressive.

Opposer's promotional efforts appear to have paid off; sales of products under opposer's **DEW** and **MOUNTAIN DEW** marks have been highly successful, making it the fourth-largest soft drink brand in the United States by sales volume, even outselling Coke and Pepsi's flagship brands in some markets. *Id.* ¶¶ 14–16, 18. As a result, opposer has netted over \$5 billion in annual sales since 2004, and over \$6 billion annually since 2009. *Id.* ¶ 28. Beverages sold under opposer's marks are ubiquitous in the market; they can be found in “grocery and convenience stores, mass market retailers, drug stores, vending machines and foodservice outlets.” *Id.* ¶ 20.

There is more evidence of the renown of opposer's marks in the record, but we need not belabor the point. Opposer's evidence of its long use of the **DEW** and **MOUNTAIN DEW** marks, its heavy advertisement of goods and services offered under the marks, and its strong sales clearly support an inference that opposer's mark is very well-known to a large segment of the public.²² Consistent with our finding upon consideration of opposer's motion for summary judgment, we find that opposer's **MOUNTAIN DEW** and **DEW** marks possess very substantial market strength and enjoy a high de-

²² Opposer argues that applicant *admitted* the fame of opposer's mark first, based on a vaguely worded question Mr. Pirincci posed to Mr. Poret, opposer's survey expert at Poret's deposition. *Opp. Br.* at 37 (citing *Poret Depo.* at 153:15–20). But applicant was not testifying at the time and the *questions* he asked at the deposition are not evidence. Second, opposer cites applicant's testimonial declaration as admitting to the fame of opposer's marks. *Id.* (citing *Pirincci Dec.* at 7). However, we have granted opposer's motion to strike applicant's declaration, so it is not available as evidence for either party.

gree of renown. Opposer's marks are clearly famous, at least with respect to soft drinks. As such, they are entitled to a wide scope of protection.

Although this finding does not end our analysis, *Coach Svcs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (fame is "insufficient, standing alone, to establish likelihood of confusion" (citing *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983))), it puts a heavy thumb on opposer's side of the scale and colors our consideration of the remaining factors.

2. The Similarity or Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation and Commercial Impression

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Svcs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). While we must consider the marks in their entireties, it is appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224

USPQ 749, 751 (Fed. Cir. 1985), *quoted in Stone Lion Capital Partners*, 110 USPQ2d at 1162.

Opposer has introduced a number of registrations in evidence, all comprising the term **DEW**, either alone ('615 Registration), in the compound term **MOUNTAIN DEW** ('362, '575, '061, and '588 Registrations), or with other wording such as **DO THE DEW** and **DEW ICED** ('027 and '639 Registrations). Because of the additional wording in opposer's other registrations, we will concentrate our attention on opposer's '615 Registration of the mark **DEW** for "soft drinks," as it is most similar to the mark in the subject application.²³

Applicant's mark is **CAN DEW**. In considering opposer's motion for summary judgment, the Board noted that, while "dew" is an arbitrary term for applicant's goods, the word "can" is descriptive of beverages sold in cans. *Order* 10–11 (June 25, 2012) (finding no genuine dispute of fact as to the similarity of the marks). We see no reason for a different conclusion here. Applicant's identification of goods specifically indicates that the nutritional drink mixes on which he intends to use the mark may be sold in a can. Because "can" is descriptive of applicant's identified goods, the term is entitled to "little weight in reaching a conclusion on the likelihood of confusion." *Cunningham*, 55 USPQ2d at 1846 (quoting *In re Nat'l Data Corp.*, 224 USPQ at 752). Accordingly, we

²³ We must sustain the opposition if applicant's mark presents a likelihood of confusion with *any* of opposer's pleaded marks. On the other hand, if there is no likelihood of confusion in view of opposer's '615 **DEW** Registration, it is unlikely that confusion would be found likely with regard to any of opposer's other registrations, all of which include additional elements in their marks. This is not to say that we have determined that confusion *would not* be likely with respect to opposer's other registrations or common-law marks, only that it is largely unnecessary to consider them further in deciding this opposition.

find that the word “DEW” would be perceived by potential purchasers as the dominant term in applicant’s mark.²⁴ The mark in opposer’s ’615 registration is thus identical in sound, appearance, and meaning to the dominant term in applicant’s mark.

Nonetheless, it appears to be applicant’s argument that DEW is not distinctive:

Why shouldn’t Dew be a generic word. What determines generic words. Why is MOUNTAIN allowed to be a generic term but not DEW. What makes Mountain more Generic than Dew. Popularity or descriptive value. Why can’t Dew be a descriptive word.

App. Br. at 6.

We cannot agree with applicant’s suggestion that **DEW**²⁵ is descriptive or generic.²⁶

There is simply no evidence in this record to support such a conclusion. In any event, opposer’s registrations are *prima facie* evidence of their validity. Trademark Act § 7(b).

²⁴ In the Board’s order granting partial summary judgment, the panel briefly contemplated the possibility that applicant’s mark had an additional meaning:

While applicant’s mark may be understood as a novel spelling of “can do,” we have no evidence that such a connotation will be imparted on consumers or that it would significantly distinguish the two marks.

Order at 10 n.4 (June 25, 2012). Following trial, the state of the record is no different in this respect than it was at summary judgment. Applicant has presented no evidence that would suggest that his mark would evoke the phrase “can do” in the mind of the relevant consumer, nor is this point even mentioned in applicant’s trial brief. Accordingly, we give the issue no further consideration.

²⁵ Because of our focus on opposer’s ’615 Registration for the mark **DEW** (without any additional wording or design), we need not consider the strength of the term **MOUNTAIN** or any other terms used in opposer’s pleaded registrations.

²⁶ Generally speaking, a term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). By contrast, a term is generic if it is used by the relevant public “to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Neither descriptive nor generic terms are distinctive (although descriptive terms can acquire distinctiveness).

At least with respect to opposer's '615 Registration (which consists only of the word **DEW**), any allegation that **DEW** is not distinctive is essentially an attack on the validity of that registration, which we may not consider in the absence of a counterclaim or separate petition to cancel the registration (and a descriptiveness claim could not be brought anyway, because the '615 Registration is more than five years old). Trademark Rule 2.106(b)(2)(ii).

Even if it could be argued that **DEW** is vaguely suggestive of a refreshing drink, it is nonetheless distinctive as applied to the goods in both opposer's registrations and the subject application. By contrast, "CAN" is entitled to little weight in comparing the marks at issue because it is descriptive. *See In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984) (the addition of descriptive or subordinate matter to the prior mark generally does not avoid a finding of likely confusion).

Considering the marks in their entireties, we conclude that applicant's mark is highly similar to the mark in opposer's pleaded '615 **DEW** Registration. This factor weighs in opposer's favor.

3. The Similarity or Dissimilarity and Nature of the Goods or Services as Described in an Application or Registration or in Connection With Which a Prior Mark is in Use

In comparing the parties' goods, "[t]he issue to be determined . . . is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). It is not necessary that the parties' goods be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the goods are related in

some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that the goods come from or are associated with the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant's Class 5 goods are identified as "nutritional drink mixes for use as a meal replacement in a can plastic or bottle." Although applicant states that his product has been the subject of "years of research and development," *App. Br.* at 2, the exact nature of the goods applicant intends to market under its **CAN DEW** brand remains unclear. Applicant describes his product as an "energy drink," *App. Br.* at 2, 3, 16, and "totally different than Pepsico's Mountain Dew brand." *App. Br.* at 3. He adds that "[h]is concept is a motivational drink—to motivate and inspire with health & knowledge where taste has a secondary concern." *Id.* During discovery, applicant was evasive, argumentative, and considerably less than forthcoming in response to opposer's attempts to learn more about the nature of his goods. *See, e.g., Pirincci Dep.* 22–26; *Opp. NOR* Exh. B(i).

It is unclear from this record what a "motivational drink" drink is, or how a beverage could "inspire [someone] with . . . knowledge," like the Pierian spring of myth. Nonetheless, while we would have preferred a clearer description of applicant's intended goods, customers, and channels of trade, "[t]he question of the likelihood of confusion must be based upon a consideration of [applicant's] goods *as described in the application*. Further, the description must be construed most favorably to the opposing prior

user.” *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (emphasis added; citations omitted). Thus, although we can often obtain from testimony a more nuanced understanding of nature of the identified goods, it is the identification which defines those goods in the first place; testimony about an applicant’s actual intentions or business practices can neither limit nor expand the scope of those goods. *Stone Lion Capital Partners*, 110 USPQ2d at 1161.

From applicant’s identification of goods, we gather that applicant’s Class 5 product is a mix (probably a powder or liquid concentrate) that can be combined (presumably with a potable liquid, such as water, milk, or juice) to make a beverage containing nutrients similar to what one might receive in a meal. Applicant’s identification specifically indicates that its product is for meal replacement. Thus we gather that applicant’s nutritional drink mixes might be used, for example, by those with particular nutritional needs, poor appetites, or those who otherwise have difficulty eating a full meal (such as the aged or infirm), as well as those who simply want to skip a meal for reasons such as convenience or expedience. Lastly, it appears that applicant’s product is intended to be sold in cans, plastic packaging, or a bottle.

The goods identified in opposer’s ’615 **DEW** registration are “soft drinks.” We take judicial notice of the fact that this is a broad category of non-alcoholic beverages, typically served cold, and often (but not always) carbonated.²⁷ We thus construe opposer’s

²⁷ Dictionary.com (unabridged) (based on the RANDOM HOUSE DICTIONARY (2013)); COLLINS ENGLISH DICTIONARY (unabridged) (10th ed. 2009). Both definitions found at <http://dictionary.reference.com/browse/soft+drink> (visited Jan. 24, 2014). See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006) (Board may take judicial notice of definitions found in online dictionaries that exist in printed format or have regular fixed editions.).

goods to include sodas of all types, as well as other non-alcoholic, flavored drinks. Opposer's goods are not limited to a specific purpose, although we note that soft drinks are frequently consumed with or between meals to quench the thirst, or simply for refreshment.

Thus construed, the parties' goods share both differences and similarities.

We first note that applicant's identified good is a "mix," while opposer's soft drinks are ready-to-drink. This is, at most, a very minor distinction. We have no specific information in this regard about applicant's mixes, but it is common knowledge that many drink mixes can be turned into a ready-to-drink product almost instantly and with little effort. In other words, a drink mix is virtually identical to a drink in most respects. The goods are thus similar, as the goods in opposer's **DEW** registration are non-alcoholic beverages and the goods in applicant's **CAN DEW** application can be readily turned into non-alcoholic beverages.

We recognize, as we must, that applicant's drink mixes are "nutritional" in nature, and are sold "for use as a meal replacement." On the other hand, opposer's identified soft drinks bear no such limitations — which logically means that they include both nutritional and non-nutritional soft drinks. Even if we *assume* for the sake of argument that most soft drinks are not especially nutritious (and possibly even unhealthy if regularly consumed in lieu of meals), that is not necessarily true of all soft drinks. Although the phrase "soft drinks" easily conjures up an image of sweetened, carbonated sodas (indeed, sodas appear to be the mainstay of opposer's actual business), the genre also includes other non-alcoholic beverages, such as fruit-based drinks which can be nutri-

tious in nature.

In this regard, opposer notes that the Board has had occasion to compare similar goods in the past. *Opp. Br.* at 24. In *Plus Prods. v. Brown*, 221 USPQ 1015 (TTAB 1984), an applicant seeking registration of its mark for use on “soft drink[s]” was opposed by the prior registrant of similar marks for, *inter alia*, “instant high protein vitamin mineral food drink[s],” and “high protein milk shake mix[es].” The Board found that such goods

bear a close relationship because each product is ultimately consumed as a beverage and purchased, notwithstanding different nutritional expectations in case[s] such as this, with that end in mind. The Board, in this regard, has not hesitated to find likelihood of confusion when confronted with drink concentrates and mixes on the one hand and soft drinks per se on the other which bear similar marks. We see little difference in the situation at hand and do not consider the “nutrition booster” character of opposer’s products as capable of justifying such a difference. Indeed, applicant’s specimen labels carry a suggestion that its [product] is a “high energy” drink (indicating nutritional values and bearing the phrase “Puts Back What a Good Workout Takes Out”).

Id. at 1017 (citations omitted). The Board further pointed out that

Applicant’s identification of goods . . . refers simply to “soft drinks” which are defined as beverages that are non-alcoholic and non-intoxicating. Thus, should registration be granted, there is nothing that would prevent applicant from using the mark on nutritionally fortified or supplemented soft drinks, a product category that would, we believe, unquestionably be viewed in the minds of purchasers as closely related to opposer’s drink mix and additive products. . . .

Id. n. 5; see also *Gen’l Foods Corp. v. Wis. Bottling Co.*, 190 USPQ 43, 44 (TTAB 1976)

(“The fact that opposer’s instant breakfast drink is a nutritional food product, and that applicant’s carbonated soft drinks have no food value but are, rather, sold only as a re-

freshment does not militate against a finding of likelihood of confusion.”). While we are not bound by findings of fact in unrelated proceedings, we find the logic of these prior Board decisions involving similar goods to be persuasive.

Continuing its argument that its soft drinks are related to applicant’s nutritional drink mixes, opposer points to six use-based third-party registrations for both “nutritional drink mixes for use as a meal replacement” and “soft drinks” (or particular kinds of soft drinks). *Opp. NOR* Exh. H(i)–(vi). While registrations are not evidence of use, third-party registrations which individually cover a number of different items and which are based on use in commerce²⁸ may serve to suggest that the listed goods are of a type that may emanate from a single source. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1140 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff’d* (unpublished) No. 88–1444 (Fed. Cir. Nov. 14, 1988). These registrations suggest that it is not unusual for “soft drinks” and “nutritional drink mixes for use as a meal replacement” to emanate from a common source and be sold under the same mark. Accordingly, consumers would likely assume that—if sold under the same or similar marks—opposer’s goods and applicant’s goods likewise share a common source.²⁹

²⁸ Opposer proffered a seventh registration (4130365 for **FAIRPHARM**), which was based on Trademark Act § 66(a) (Madrid Protocol). Like Trademark Act § 45 (applications pursuant to the Paris Convention), § 66 permits registration of marks without the requirement for prior use in the United States. Such registrations are of no help in inferring that purchasers in this country are accustomed to seeing a common source for the goods or services of the type listed, and we have accordingly given this registration no consideration. *Cf. Mucky Duck*, 6 USPQ2d at 1470, n.6 (registrations issued pursuant to Trademark Act § 44 “have very little, if any, persuasive value” for this purpose).

²⁹ Opposer further argues that the third-party registrations show that applicant’s Class 5 goods
(continued...)

Controlling precedent requires that “the description [of goods or services] must be construed most favorably to the opposing prior user.” *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (citing *CTS Corp. v. Cronstoms Mfg. Inc.*, 515 F.2d 780, 185 USPQ 773 (CCPA 1975)). Although opposer’s “soft drinks” and “applicant’s nutritional drink mixes. . .” may not be identical, they are nonetheless related to the extent that they are drinks (or mixes to make drinks) which might be nutritious. Further, we infer from opposer’s third-party registrations that consumers might assume that applicant’s goods and opposer’s goods are of a type which might originate from a single source.

Thus opposer has demonstrated a relationship between its “soft drinks” and applicant’s Class 5 goods. This factor thus favors a finding that confusion is likely.

4. The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels

To determine the similarity or dissimilarity of established, likely to continue trade channels for the parties’ respective goods, we again begin with the goods as they have been identified in the application and registration. Absent a limitation in the identification of goods (and neither the application nor the registration at issue is so limited), we must presume that the relevant goods move in all channels of trade normal for such items, and that they are purchased by all of the usual consumers for goods of that type. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart*,

are within its “natural zone of expansion.” However, the expansion of trade doctrine is usually considered in the context of priority (which is not in question here). *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1598 (TTAB 2011). The analysis under this *du Pont* factor requires consideration of the similarity of the goods.

Inc., 258 F.2d 956, 119 USPQ 139 (CCPA 1958)).

It is beyond dispute that soft drinks are sold through a vast number of retail outlets. They are available (for example) in cafeterias and restaurants, in grocery stores, convenience stores, discount outlets, drugstores, and vending machines in both public and private spaces. They are purchased for consumption both in public and at home. And although its identification of goods is the touchstone, it is clear in this case that opposer's actual goods are certainly no exception to the general availability of soft drinks; we have already recounted Mr. O'Brien's declaration testimony that opposer's own soft drinks are available in a wide range of retail outlets, including "grocery and convenience stores, . . . drug stores, vending machines and foodservice outlets. *O'Brien Dec.* at ¶¶ 19–20.

The record is a bit less clear in establishing the normal channels of trade for "nutritional drink mixes for use as a meal replacement," and because applicant has not yet begun using his mark, we do not have his actual business practices to serve as an example. Nonetheless, Mr. O'Brien testified that according to his personal knowledge and experience,³⁰ goods such as those identified in the subject application are often sold in "pharmacies and nutritional supplement stores." *O'Brien Dec.* ¶ 21.

Applicant himself has expansive expectations for marketing, indicating that his particular product will "be offered and promoted to all class [*sic*] of users and consum-

³⁰ Mr. O'Brien is not qualified (at least not on this record) as an expert in the marketing of nutritional drink mixes, nor was his declaration testimony presented as a market survey. Nonetheless, a lay witness is not precluded from offering an opinion if it is based on his own perception, helpful to determining a fact in issue, and not based on specialized knowledge such as that only an expert in the relevant field might possess. FED. R. EVID. 701. Mr. O'Brien's observations on the marketing of nutritional drink mixes easily meet this test.

ers in all geographical areas and provided with information by means of the many methods and processes of promotion, marketing and advertising.” *Opp. NOR Exh. A, App. (Resp. to Interrogatory # 4)*. Applicant further stated that he “intends to market, advertise, promote and/or sell” his **CAN DEW** products “[b]y means of the many available distributors of beverages in this country. . . .” *Id. Interrogatory # 5*.

Somewhat more specifically, applicant indicated in a discovery deposition that he had contacted “grocery chains” or “supermarket chains” as possible distributors of his products. *Pirincci Dep.* p. 61, *Opp. NOR*, Exh. B(i). While we may not *limit* our consideration to applicant’s actual or intended channels of trade, *Octocom*, 16 USPQ2d at 1787, applicant’s testimony strongly suggests that supermarkets or grocery stores are among the channels of trade which are normal³¹ for nutritional drink mixes for use as a meal replacement.

From this evidence we find that the normal channels of trade for both of the parties’ goods include, but are not limited to, drugstores and supermarket or grocery stores. At least to that extent, the normal channels of trade for the parties’ goods are identical. This is a significant overlap which favors a finding that confusion is likely.

5. The Conditions Under Which and Buyers to Whom Sales are Made, *i.e.* “Impulse” vs. Careful, Sophisticated Purchasing

Relevant to this *du Pont* factor, the record establishes that soft drinks (including opposer’s particular soft drinks) are available in a variety of retail settings, and that

³¹ Applicant testified that he “got the idea after talking with a few [potential distributors] that you need to have a complete product before I submit something that is not finished.” *Pirincci Depo.* p. 62. Notably, it does not appear that these potential distributors indicated to applicant that supermarkets and grocery stores were not appropriate retail channels for nutritional drink mixes.

they are inexpensive items, which “sell for approximately one to two dollars” for a twenty-ounce serving. *O’Brien Dec.* ¶ 24. Moreover, soft drinks are commonly purchased by a broad range of customers not limited to any particular socio-economic group.³²

The conditions of sale for applicant’s nutritional drink mixes are again somewhat less clear on this record. While it is unlikely that the potential purchasers for such products are as numerous or diverse as they are for soft drinks, we have already noted that the goods identified in the subject application would likely appeal to (at least) the elderly or ill—or those who might make purchases on their behalf—and those who are in a hurry, or those who cannot (or prefer not to) stop what they are doing for a meal. While those purchasing a nutritional drink mix for the elderly or ill might be expected to exercise some care in their purchases, that is not necessarily true for the latter group. Indeed, because they may be in a hurry (for the same reason they are skipping a meal), they may well exercise *less* care than usual in their purchases. But no matter the reason for purchasing applicant’s goods, it is clear that applicant intends to market his **CAN DEW** products to a wide group of potential consumers, and there is no evidence that nutritional drink mixes are particularly expensive or high-tech items which would require extensive research and careful study before purchase. When ordinary

³² Opposer’s evidence suggests that the actual target market for its **DEW** products is generally young and active. *O’Brien Dec.* ¶ 7 (marketing efforts directed to “sporting, music, and gaming events consistent with the brand and relevant to its core consumers”). Nonetheless, we do not understand opposer’s actual marketing and sales to be limited in any way to such consumers. In any event, the identification of “soft drinks” in the ’615 Registration is not limited to any particular class of consumer. Accordingly, we must construe the goods in that registration to be directed to all of the normal customers for “soft drinks,” regardless of whether they are targeted by opposer or in fact purchase opposer’s products.

goods are marketed to a broad segment of the general public, we may not assume that purchasers are particularly sophisticated or exercise unusual care in their purchasing decisions. Even if it could be shown that some of applicant's customers exercise a heightened degree of care in their purchase of nutritional drink mixes, we must consider whether confusion is likely from the perspective of the least sophisticated consumers. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009) (citing *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004)).

We conclude that the potential consumers for the parties' goods overlap, that the parties' goods are not expensive, and that consumers exercise no more than ordinary care in purchasing them.

This factor favors a finding that confusion is likely.

6. The Number and Nature of Similar Marks in Use on Similar Goods

Applicant contends that

“[t]he USPTO has allowed many trademarks where one word in the titles and names of a trademark are the same as another trademark. Many examples can be viewed on the USPTO website. (exhibit 2 Candewdeclarationexhibit1-4-12 and USPTO Website) Some examples are “Honey Dew”, “Fruity Dew Pop”, “Sun Dew”, “Honey Dew Donuts”, “Mountain Jam”, “Mountain Pack”, “Mountain Mudd”, “Cool Mountain”. USPTO has allowed these trademarks without any opposition. The USPTO would not allow a trademark if it was similar enough to cause confusion just because they didn't received any opposition to it.

App. Br. at 6–7.

There are several problems with applicant's argument: To begin with, although he names a number of purportedly-registered trademarks, applicant did not submit any

third-party registrations during trial. The parenthetical in the text quoted above appears to be a citation to both Exhibit 2 to applicant's declaration and the "USPTO website." However, Exhibit 2 to applicant's declaration is a list³³ of *opposer's* registrations, and needless to say, *opposer's* own registrations cannot be used to show the weakness of *opposer's* own marks. Nor is applicant's reference to the "USPTO website" sufficient to make the referenced third-party registrations of record. Our rules require that a party relying on trademark registrations submit copies of them during the party's trial period. *See* Trademark Rule 2.122(e). The Board will not search the USPTO records for evidence on applicant's behalf.

But even if these registrations had been properly submitted, they are not evidence of the weakness of *opposer's* marks. While evidence of third-party *use* of similar trademarks can be relevant in determining the strength of a trademark, third-party *registrations* cannot be given any weight in determining the strength of a registration. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). Although the number and nature of similar marks in *use* on similar goods may be considered on the ultimate question of likelihood of confusion, *du Pont*, 177 USPQ at 567, third-party registrations are not evidence that such marks are in use or that consumers are familiar with them. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269–70 (CCPA 1973).

We find this factor neutral in our analysis.

³³ Additionally, submission of a list of registrations is not sufficient to make those registrations of record. *Plus Prods. v. Pharmavite Pharm. Corp.*, 221 USPQ 256, 260 (TTAB 1984). Copies of the registrations must be submitted for the record.

7. Applicant's Intent in Adopting His Mark

Opposer contends that applicant filed his **CAN DEW** application in bad faith, and that we should consider that fact in our likelihood of confusion analysis. While the Board and our reviewing courts have on occasion noted that the intent of the applicant³⁴ in choosing its mark is relevant to the determination of likelihood of confusion, *e.g.*, *Tiffany & Co. v. Nat'l Gypsum Co.*, 459 F.2d 527, 173 USPQ 793, 795 (CCPA 1972), it is very rare that an applicant is found to have sought registration in bad faith, and rarer still for such a finding to significantly affect the outcome of the case. Here, opposer argues that applicant had prior knowledge of its **DEW** marks because they are famous, and because opposer's registrations are constructive notice of them. *Opp. Br.* at 33. Further, as opposer notes, applicant reluctantly admitted that he "probably" had heard of "Mountain Dew" prior to adopting his **CAN DEW** mark. *Opp. NOR Exh. B(i); Pirincci Dep.* at 29–30. Opposer urges that "selecting a mark highly similar to [o]pposer's famous marks for highly similar, if not identical, competitive goods creates a presumption that [a]pplicant has succeeded in creating a likelihood of confusion." *Opp. Br.* at 33–34. We disagree.

An applicant's prior knowledge of the senior mark is not enough to invoke intent as a factor in our likelihood of confusion analysis. *Action Temp. Svcs. Inc. v. Labor Force*

³⁴ More accurately, it is only an applicant's *bad* intent which is said to be relevant; "while evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion." *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009). Thus applicant's protest that "[h]is creation of Can Dew had nothing to do with the possibility of having any awareness of Mountain Dew," *App. Br.* at 2, does not weigh against a finding that confusion is likely.

Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989) (quoting *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 522, 204 USPQ 820, 829 (CCPA 1980)); *Ava Enters., Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783, 1787 (TTAB 2006). Bad faith will only be found when an opposer can prove that the applicant adopted his mark with the actual intent to confuse customers. *Lever Bros. Co. v. Riodela Chem. Co.*, 41 F.2d 408, 5 USPQ 152, 154–55 (CCPA 1930) (“[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”); see *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782–83 (2d Cir. 2009) (“the ‘only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.’” (quoting J. Thomas McCarthy, 4 MCCARTHY ON TRADEMARKS § 23:113)). Opposer’s proof of applicant’s intent in adopting his mark falls short of that standard. At best, opposer has shown only that applicant knew of opposer’s prior marks, and that — assuming applicant understands the principles of trademark law — he should have known better than to select **CAN DEW** as a trademark. Cf. *In re Bose Corp.*, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009) (the Board erred “[b]y equating ‘should have known’ . . . with a subjective intent”).

While intent to confuse can be inferred from the circumstances, the facts of this case do not support such an inference. For instance, although the marks are similar, they are clearly not identical. Likewise, applicant’s Class 5 goods at issue here are related, but not the same as opposer’s soft drinks. We cannot infer from these facts that

applicant chose his mark with the intent to confuse customers as to the source of his goods. Based on this record, it is entirely possible, for instance, that although applicant was aware of opposer's **DEW** marks, he nonetheless believed that confusion would not result from his use of **CAN DEW**. Applicant may have earnestly believed that the addition of **CAN** to opposer's **DEW** mark or — as applicant strongly argues — that the differences between applicant's intended goods and opposer's actual goods, their labels, ingredients, and the like, would make confusion unlikely. While we find such beliefs to be incorrect, we will not assume applicant's ill intent merely because we find confusion likely. Applicant repeatedly states that the adoption of his mark had nothing to do with opposer or its marks. *App. Br.* at 2, 3, 16. While opposer contends that such statements are false, we will not find bad faith adoption “[a]bsent a showing that [applicant's] explanation is untrue.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

We consider this factor neutral in our analysis.

8. Other Issues

Applicant raises two other issues which bear brief mention.

As noted above, opposer submitted the declaration of Hal Poret and a consumer survey he conducted. Opposer argues that the record establishes Mr. Poret's qualification as an expert and that the survey is admissible and demonstrates a high rate of confusion among participants. *Opp. Br.* at 17–18, 23, 31–32. In response, applicant strenuously argues that Mr. Poret “has only manipulated the methods, circumstances, standards to create the conclusion desired by Pepsico which has no significance . . . [and] can be simply stated as meaning nothing.” *App. Br.* at 9–11.

As already discussed, the Board previously considered this same survey in connection with opposer’s motion for summary judgment, finding it to be “admissible and credible,” and its results to be significant. *Order* 16–17 (June 25, 2012). Despite applicant’s arguments, we do not see anything in the record which casts doubt on Mr. Poret’s qualifications, the survey, or his conclusions. But because the survey (and Mr. Poret’s conclusions) focused on a comparison of the parties’ Class 32 goods, *Poret Dec.* ¶¶ 5, 6, 8, *see Order* 14–16 (June 25, 2012) (discussing survey), its relevance in determining whether confusion is likely with respect to applicant’s Class 5 goods is unclear. In any event, we need not answer the question, because we have not relied on the survey in reaching our decision; whatever its relevance, it would not have changed the outcome of this decision.

Several times in his brief, applicant speculates on opposer’s motivation in opposing registration of his mark. For instance, applicant alleges that this opposition “is a convenient way for Pepsico to take over my trademark as well as obstructing and eliminating competition,” *App. Br.* at 7–8, 11–12, and that opposer is monopolizing the manufacture of aluminum cans, *id.* at 13. As far as this proceeding is concerned, we do not see any support in the record³⁵ for such allegations.

³⁵ Applicant cites articles from the Forbes.com website, discussing opposer’s business. These articles can be admitted in evidence under a notice of reliance, but only as “printed publications” under Trademark Rule 2.122(e). “Printed publications”—as that term is used in Rule 2.122(e)—have limited use in a Board proceeding. Generally, such documents can be admitted only for what they show on their face, *i.e.*, to prove that such an article was published; they are not admissible to prove the truth of any information in them. Because applicant relies on what these articles say, they are inadmissible hearsay. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 n. 5 (TTAB 2008). But even if they were admissible, the articles show nothing about opposer’s intent in opposing the subject application.

As previously noted, our cases have occasionally considered an applicant's intent in adopting his mark. But applicant does not cite any statutes or cases standing for the proposition that the intent of the senior party is relevant to the Board's likelihood of confusion determination, and we are not aware of any. To the contrary, if the evidence leads to a conclusion that confusion is likely, the Trademark Act requires us to refuse registration to applicant, regardless of any ulterior motive on the part of the opposer. By their very nature, trademark cases often arise between competitors, and it would be naïve to believe that plaintiffs are always motivated solely by an altruistic desire to spare consumers from confusion. But whatever the motivation, the Trademark Act provides that a mark may not be registered if confusion would be likely with a mark registered or previously used. Trademark Act § 2(d). Whether opposer's alleged intent (assuming it could be proved) would be relevant in considering a different legal claim before a different court is of no consequence. "[T]he law pertaining to registration of trademarks does not regulate all aspects of business morality." *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (quoting *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 79, 198 USPQ 271, 275 (CCPA 1978)).

D. Balancing the Factors

We have found that applicant's **CAN DEW** mark is highly similar to the **DEW** mark in opposer's '615 Registration. We have also found that applicant's "nutritional drink mixes for use as a meal replacement," and the "soft drinks" identified in opposer's '615 Registration (and others) are related. We have found that the consumers for the respective goods overlap, and that the channels of trade for the parties' goods are identical, at least in part. Likewise, we found that the goods in question are inexpensive

and unlikely to be purchased with greater than ordinary care. We found that “the number and nature of similar marks in use on similar goods,” and applicant’s intent to both be neutral factors. And finally, in light of opposer’s long use of its **DEW** marks, its heavy promotion of goods sold under the marks, and its strong sales of marked goods we found opposer’s marks to be famous.

We note that all of our findings on the relevant *du Pont* factors are either neutral or favor a finding of likelihood of confusion. Thus, although opposer has not shown on this record that the parties’ goods share an especially close relationship, its strong showing on the other relevant factors — including the opposer’s fame and the similarity of the marks — more than makes up for its somewhat weaker showing on the second *du Pont* factor. *E.g.*, *In re Concordia Int’l Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983) (“The greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion.”); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (similarity of goods must be considered in light of other factors). We find that opposer has demonstrated by a preponderance of the evidence that applicant’s **CAN DEW** mark, as used on its Class 5 goods, would be likely to cause confusion with the mark in opposer’s ’615 **DEW** Registration as used on soft drinks.

VI. Dilution

Having already determined that applicant is not entitled to register under Trade-mark Act § 2(d), it is unnecessary to consider opposer’s dilution claim.

VII. Conclusion

We have carefully considered all of the evidence and argument submitted by the parties, including that which we have not specifically discussed. For the foregoing reasons, we conclude that opposer has demonstrated that applicant's **CAN DEW** mark, as used on "nutritional drink mixes for use as a meal replacement in a can plastic or bottle," would likely cause confusion in view of opposer's **DEW** mark ('615 Registration), as used on "soft drinks."³⁶ Trademark Act § 2(d). We further note the Board's previous summary judgment holding that applicant's mark is unregistrable with respect to applicant's Class 32 goods.

Decision: The opposition to registration is SUSTAINED and registration to applicant is refused.

³⁶ Our focus on opposer's '615 Registration as sufficient to resolve this opposition should not be taken as a finding that confusion would not be likely with respect to opposer's other previously-used or registered marks.