

ESTTA Tracking number: **ESTTA559770**

Filing date: **09/17/2013**

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

Proceeding	91194974
Party	Defendant GFA Brands, Inc.
Correspondence Address	JOHANNA M WILBERT QUARLES & BRADY LLP 411 EAST WISCONSIN AVENUE, SUITE 2040 MILWAUKEE, WI 53202-4497 UNITED STATES johanna.wilbert@quarles.com, marta.levine@quarles.com, david.cross@quarles.com, deena.rafinski@quarles.com
Submission	Brief on Merits for Defendant
Filer's Name	Johanna Wilbert
Filer's e-mail	johanna.wilbert@quarles.com, david.cross@quarles.com, andrea.fowler@quarles.com
Signature	/s/ Johanna Wilbert
Date	09/17/2013
Attachments	Redacted GFA Brief pdf - Adobe Acrobat Pro (3).pdf(5535548 bytes)

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

PROMARK BRANDS INC. and H.J.
HEINZ COMPANY,

Opposers,

v.

GFA BRANDS, INC.,

Applicant.

**Opposition Nos. 91194974 (Parent)
and Opposition No. 91196358**

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

APPLICANT'S TRIAL BRIEF

TABLE OF CONTENTS

	<u>Page No.</u>
DESCRIPTION OF THE RECORD	1
I. Testimonial Deposition Transcripts.....	1
II. GFA’s Notice of Reliance.....	2
III. Opposers’ Notice of Reliance	3
IV. Application Files and Pleadings.....	3
OBJECTIONS TO OPPOSERS’ EVIDENCE	4
STATEMENT OF THE ISSUES.....	4
RECITATION OF FACTS	4
I. GFA BRANDS, the SMART BALANCE marks and GOODS	4
II. GFA Brands’ Sales, Advertising, and Promotion of SMART BALANCE Products.....	6
III. The Strength of GFA’s SMART BALANCE Trademark	7
IV. Differences Between the Marks in Sight, Sound, and Meaning.....	8
V. HEINZ’s Confusion Survey and GFA Brands’ responsive Survey.....	9
VI. Third Party Use of SMART Trademarks.....	9
VII. Lack of Confusion with Other SMART Marks	20
ARGUMENT.....	20
VIII. GFA Is Entitled to Register the SMART BALANCE Marks Because There Is No Likelihood of Confusion.....	20
A. Heinz has not met its burden under the DuPont factors.....	20
B. Factor 1: The marks are dissimilar.....	21
C. Factor 4: Customers for these products exercise considerable care.	24
D. Factor 6 –Third party use of the term “Smart” in the consumer packaged goods industry precludes “Smart” from having source indicating significance or trademark strength.....	26

E.	Factors 7 and 8: There is no evidence of actual confusion.....	29
F.	Factor 13: Other Probative Facts – GFA’s Enforcement Strategy	30
IX.	The Survey Evidence Proves There Is No Likelihood of Confusion.....	31
A.	The Importance of Properly Conducted Confusion Surveys.....	31
B.	Was the Survey Conducted by an Appropriately Skilled and Experience Survey Expert? No for Heinz; Yes for GFA Brands.	32
C.	Was the Survey Universe Properly Chosen and Defined? No for Heinz, Yes for GFA Brands.	34
D.	Were the Survey Questions Clear and Not Leading? No for Heinz; Yes for GFA Brands.....	35
E.	Did the Survey Include a Control to Correct for “Noise” and to make sure any Confusion is Due to Trademark-Relevant Reasons? No for Heinz; Yes for GFA Brands.	36
F.	Other Flaws in the Sabol Survey.	38
X.	GFA’s use of the smart balance trademark will not dilute the smart ones trademark.	39
A.	Heinz Has Not Proven the Stringent Standards for a Dilution Claim.....	39
B.	Opposers have not shown that the SMART ONES mark met the high dilution fame standard before the filing date of GFA Brands’ intent-to-use applications.	40
C.	GFA Brands’ SMART BALANCE mark is not likely to dilute the distinctiveness of the SMART ONES mark when it is applied to frozen food products.	45
1.	The degree of similarity between the mark or trade name and the famous mark.....	45
2.	The degree of inherent or acquired distinctiveness of the famous mark.....	46
3.	The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.	47
4.	The degree of recognition of the famous mark.	48
5.	Any actual association between the mark or trade name and the famous mark.....	48
	CONCLUSION.....	49

TABLE OF AUTHORITIES

Page No.

Cases

7-Eleven, Inc. v. Wechsler,
83 U.S.P.Q.2d 1715 (T.T.A.B. 2007) 42, 43, 44

Burns Philp Food Inc. v. Modern Prods., Inc.,
24 U.S.P.Q. 2d 1157 (T.T.A.B. 1992) 22

Champagne Louis Roederer, S.A. v. Delicato Vineyards,
148 F.3d 1373, 47 U.S.P.Q. 2d 1459 (Fed. Cir. 1998) 21

Citigroup Inc. v. Capital City Bank Grp.
94 U.S.P.Q.2d 1645 (T.T.A.B. 2010) 46, 47, 48

Coach Servs. Inc. v. Triumph Learning LLC,
96 U.S.P.Q.2d 1600 (T.T.A.B. 2010); aff'd 668 F.3d 1356 (Fed. Cir. 2012). 42

Coach Servs., Inc. v. Triumph Learning LLC,
668 F.3d 1356, 101 U.S.P.Q. 2d 1713 (Fed. Cir. 2012) 24, 40, 43, 45

Domino’s Pizza Inc. v. Little Caesar Enters., Inc.,
7 U.S.P.Q. 2d 1359 (T.T.A.B. 1988) 31

Frank Mint Corp. v. Master Mfg. Co.,
667 F.2d 1005, 212 U.S.P.Q. 233 (Fed. Cir. 1981) 21

G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.,
16 U.S.P.Q. 2d 1635 (Fed. Cir. 1990)..... 30

General Mills, Inc. v. Health Valley Foods,
24 U.S.P.Q. 2d 1270 (T.T.A.B. 1992) 27, 28

General Mills, Inc. v. Kellogg Co.,
824 F.2d 622, 3 U.S.P.Q. 2d 1442 (8th Cir. 1987) 22

Heyer, Inc. v. Popper & Sons, Inc.,
152 U.S.P.Q. 196 (T.T.A.B. 1966) 23

In re Bed & Breakfast Registry,
791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1989) 23

<u>In re Broadway Chicken, Inc.</u> , 38 U.S.P.Q. 2d 1559 (TTAB 1996)	23
<u>In re E.I. DuPont De Nemours & Co.</u> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973)	20, 21
<u>In re Hartz Hotel Servs. Inc.</u> , 102 U.S.P.Q. 2d 1150 (T.T.A.B. 2012)	27, 29
<u>IN-N-OUT Burgers v. Fast Lane Car Wash & Lube</u> , Opposition No. 91183888, 2013 WL 3188897 (T.T.A.B. Mar. 14, 2013) (nonprecedential)	41
<u>Institut Nat’l Des Appellations D’Origine v. Vintners Int’l Co.</u> , 958 F.2d 1574, 22 U.S.P.Q. 2d 1190 (Fed. Cir. 1992)	28
<u>Jerrold Elecs. Corp. v. The Magnavox Co.</u> , 199 U.S.P.Q. 751 (T.T.A.B. 1978)	27
<u>King Candy Co. v. Eunic King’s Kitchen, Inc.</u> , 182 U.S.P.Q. 108 (C.C.P.A. 1974)	30
<u>Luigino’s, Inc. v. Stouffer Corp.</u> , 170 F.3d 827, 50 U.S.P.Q. 2d 1047 (8th Cir. 1999)	25
<u>Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.</u> , 228 U.S.P.Q. 364 (Fed. Cir. 1989).....	30
<u>NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.</u> , 69 U.S.P.Q.2d 1718 (T.T.A.B. 2003)	42, 43, 44, 46
<u>Nat’l Football League Properties, Inc. v. Prostyle, Inc.</u> 57 F. Supp.2d 665 (E.D. Wis. 1998).....	37
<u>Nike Inc. v. Maher</u> , 100 U.S.P.Q.2d 1019 (T.T.A.B. 2008)	46
<u>Paco Sports, Limited v. Paco Rabanne Parfums</u> , 86 F.Supp.2d 305, 54 U.S.P.Q. 2d 1205 (S.D.N.Y. 2000) <u>aff’d</u> . 234 F.3d 1262 (2d Cir. 2000)	38
<u>Plus Prods. v. Natural Organics, Inc.</u> , 204 U.S.P.Q. 773 (T.T.A.B. 1979)	27
<u>Polaris Indus. Inc. v. DC Comics</u> , 59 U.S.P.Q.2d 1798 (T.T.A.B. 2000)	40

<u>Red Bull Gmbh v. Cochran,</u> 2004 WL 2368486 (T.T.A.B. 2004)	22
<u>Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.,</u> 102 U.S.P.Q.2d 1187 (T.T.A.B. 2012)	43, 45, 46
<u>Rocket Trademarks Pty Ltd. v. Phard S.p.A.,</u> 98 U.S.P.Q. 2d 1066 (T.T.A.B. 2011)	28
<u>Shen Mfg. Co. v. Ritz Hotel Ltd.,</u> 393 F.3d 1238, 73 U.S.P.Q. 2d 1350 (Fed. Cir. 2004)	22
<u>Societe Des Produits Nestle S.A. v. Midwestern Pet Foods, Inc.,</u> Opposition No. 91163853, 2011 WL 1495460 (T.T.A.B. March 31, 2011) (nonprecedential) <u>aff'd</u> 685 F.3d 1046 (Fed. Cir. 2012).....	42
<u>Spraying Sys. Co. v. Delevan, Inc.,</u> 762 F. Supp. 772, 19 U.S.P.Q. 2d 1121 (N. D. Ill. 1991).....	28
<u>Starbucks U.S. Brands, LLC, et al. v. Marshall S. Ruben,</u> 780 U.S.P.Q.2d 1741 (T.T.A.B. 2006)	32
<u>Stouffer Corp. v. Health Valley Natural Foods Inc.,</u> 1 U.S.P.Q. 2d 1900 (T.T.A.B. 1986)	22, 25
<u>Toro Co. v. ToroHead Inc.,</u> 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001)	passim
<u>United Foods Inc. v. J.R. Simplot Co.,</u> 4 U.S.P.Q. 2d 1172 (T.T.A.B. 1987)	22
<u>Virgin Enters. Ltd. v. Moore,</u> Opposition No. 91192733, 2012 WL 3992908 (T.T.A.B. Aug. 31, 2012).....	42
<u>West Fla. Seafood v. Jet Rests. Inc.,</u> 31 F.3d 1122, 31 U.S.P.Q. 2d 1660 (Fed. Cir. 1994)	20
<u>Witco Chem. Co. v. Whitefield Chem. Co.,</u> 418 F.2d 1403, 164 U.S.P.Q. 43 (C.C.P.A. 1969).....	20
Other Authorities	
J. Jacoby, <u>Experimental Design and Selection of Controls and Trademark and Deceptive Advertising Surveys,</u> 92 Trademark Reporter 890 (2002)	40

MANUAL FOR COMPLEX LITIGATION (4th) p. 103 (2004)..... 35

Shari Diamond, “Reference Guide on Survey Research,” Reference Manual on Scientific Evidence, 2d ed., Federal Judicial Center 2000..... 34, 35, 36, 39

Rules

TMEP §1209.03 (2013) 24

Treatises

J. Thomas McCarthy, Trademarks and Unfair Competition
§ 11:90 (4th ed. 2013)..... passim

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25, cmt. f (1995)..... 44

DESCRIPTION OF THE RECORD

The evidence of record consists of the following:¹

I. TESTIMONIAL DEPOSITION TRANSCRIPTS

The certified transcripts of the testimonial depositions of the following witnesses:

- William E. Hooper, Senior Advisor to the Marketing Groups and Board Member of GFA Brands, taken on April 12, 2013, and filed with the Board on September 13, 2013 (including public and confidential portions), including Applicant's Exhibits 1-18 and Opposers' Exhibits 48-53;
- Philip Johnson, Chief Executive Officer of Leo J. Shapiro & Associates and GFA Brands' survey expert, taken on April 18, 2013, and filed with the Board on September 13, 2013, including Applicant's Exhibits 1-5;
- Timothy Kraft, Senior Vice-President, Associate General Counsel at GFA Brands, taken on April 26, 2013, and filed with the Board on September 13, 2013, including Applicant's Exhibits 70-76
- Leon Kaplan, President and CEO at Princeton Research and Consulting Center and GFA Brands' survey expert, taken on April 23, 2013, and filed with the Board on September 13, 2013, including Opposers' Exhibits 1-2; and
- William Shanks, Investigations Manager and Designated Lead Investigator at Marksmen, Inc., taken on April 23, 2013, and filed with the Board on September 13, 2013, including Applicant's Exhibits 6-13.

¹ A detailed index of the evidence made of record by GFA is attached as Appendix A.

II. GFA'S NOTICE OF RELIANCE

GFA's Notice of Reliance, filed April 29, 2013, including the exhibits submitted therewith, which introduced the following:

- USPTO records for Applicant's SMART BALANCE registrations (U.S. Reg. Nos. 2,200,663, 2,276,285, 2,952,127, 3,649,833, 3,747,526, 3,865,917, and 3,958,463);
- USPTO records for various third party registrations (U.S. Reg. Nos. 3,140,426, 3,945,900, 2,916,503, 2,338,871, 2,773,155, 2,686,279, 1,874,796, 3,522,138, 1,555,954, 3,420,245, 1,367,966, 4,183,609, 3,592,893, 2,107,921);
- Printouts from the website of third parties General Mills, Betty Crocker, Prego, Plum Smart, HP Hood LLC, Lightlife Foods, Orville Redenbacher, Kellogg Co., Glaceau, Smartfood, Inc., Gerber, New World Pasta Company, and Little Debbie;
- Printouts from Amazon.com and Barnesandnoble.com for third party cookbooks and other books using the term "Smart;"
- Packaging for third party products, including BISQUICK HEART SMART pancake and baking mix, PREGO HEART SMART Italian sauce, SUNSWEET PLUM SMART plum juice cocktail, HOOD SIMPLY SMART chocolate fat free milk, LIGHTLIFE SMART DELI veggie protein slices, ORVILLE REDENBACHER'S SMART POP! gourmet popping corn, KELLOGG'S SMART START cereal, GLACÉAU SMARTWATER bottled water, SMARTFOOD POPCORN popcorn, GERBER SMARTNOURISH ORGANIC baby cereal, RONZONI SMART TASTE enriched white pasta, and LITTLE DEBBIE fig bars; and

- The discovery deposition of corporate representative of Opposer, Marion Findlay, Senior Marketing Manager, conducted on January 17, 2012 and exhibits nos. 1 through 11 thereto.

III. OPPOSERS' NOTICE OF RELIANCE

Heinz's Notices of Reliance, filed March 12, 2013, including the exhibits submitted therewith, which introduced the following:

- GFA Brands, Inc.'s Response to ProMark Brands Inc.'s First Set of Interrogatories Nos. 5, 6, 7, 21, 29, 30, and 31;
- GFA Brands, Inc.'s Response to ProMark Brands Inc.'s Requests for Admission Nos. 1-136;
- Select pages from the website www.eatyourbest.com, as of March 11, 2013;
- The April 24, 2012 discovery deposition transcript and accompanying exhibits of Dr. Leon B. Kaplan, who testified as an expert witness on behalf of Applicant GFA Brands, Inc; and
- The December 18, 2012 discovery deposition transcript and accompanying exhibits of Philip Johnson, who testified as an expert witness on behalf of Applicant GFA Brands, Inc.

IV. APPLICATION FILES AND PLEADINGS

Pursuant to 37 C.F.R. § 2.122(b), the files of the trademark applications (U.S. Ser. Nos. 77/864,268 and 77/864,305) involved and the pleadings in this consolidated opposition are deemed to be of record.

OBJECTIONS TO OPPOSERS' EVIDENCE

As explained in Applicant's Response to Opposer's Evidentiary Objections, GFA Brands' only objection is a conditional motion to strike directed to testimony from Heinz's proffered survey expert, Barry Sabol, who gave about thirty pages of trial testimony listing opinions he had formed about the competing Eveready survey performed by GFA Brands' expert Philip Johnson, which showed only 2% of the relevant consumers would be confused. Sabol had not disclosed opinions critical of the Johnson survey in a report or discovery deposition. GFA Brands' survey experts Messrs. Johnson and Kaplan responded to Sabol's previously undisclosed opinions in their trial testimony. If their testimony is stricken, as Heinz has requested, then Sabol's undisclosed opinions should then be stricken as well.

STATEMENT OF THE ISSUES

GFA Brands agrees that Heinz has accurately stated the issues.

RECITATION OF FACTS

I. GFA BRANDS, THE SMART BALANCE MARKS AND GOODS

GFA Brands and its SMART BALANCE trademark are not new to the market. Rather, GFA Brands manages multiple trademarks, multiple products, and has successfully marketed its SMART BALANCE trademark in coexistence with Heinz's SMART ONES products since at least 1996.

Bob Harris started what is now GFA Brands about seventeen years ago, when he developed a butter substitute that he sold under the SMART BALANCE trademark. (Hooper Tr. 9:16-25.) Over time, GFA Brands expanded its product line and now offers a variety of health related food products, including gluten free products under the GLUTINO trademark and natural products sold under the EARTH BALANCE trademark.

GFA Brands also expanded the goods offered under the SMART BALANCE trademark. While SMART BALANCE was first used in 1996 on butter substitutes, GFA has since sold cooking oil, milk, popcorn, peanut butter, mayonnaise, eggs, and sour cream under the SMART BALANCE mark. (Hooper Tr. 13:8-20:24; Kraft Tr. 6:4-9.) In addition to its common law rights, GFA Brands has obtained several trademark registrations for SMART BALANCE. William E. Hooper, GFA's Senior Advisor and member of the Board of Directors, authenticated the registrations for and the ownership, use, and registration status of the following SMART BALANCE marks:

- SMART BALANCE for butter substitutes, cheese, lowfat and nonfat cheese substitutes, margarine, lowfat and nonfat margarine substitutes, shortening, lowfat and nonfat shortening, snack food dips, and vegetable oils, first used as early as October 1996 (Reg. No. 2,200,663);
- SMART BALANCE for mayonnaise, lowfat and nonfat mayonnaise substitutes, mayonnaise style dressings and salad dressings, first used as early as February 1999 (Reg. No. 2,276,285);
- SMART BALANCE for popped and processed popcorn, first used as early as September 2002 (Reg. No. 2,952,127);
- SMART BALANCE for peanut butter, first used as early as 2005 (Reg. No. 3,649,833); and
- SMART BALANCE for milk, first used in 2007 (Reg. No. 3865917).

Mr. Hooper also authenticated product packaging, product pictures, and advertisements for the physical products that GFA Brands has sold in connection with these trademarks, thus establishing concurrent use of these marks with the SMART ONES marks. (Hooper Tr. 12-32, Exs. 2, 4, 6, 8, 10, 12, 14, 15, 16.)

At issue in this opposition is GFA's intent to use applications and desire to expand its SMART BALANCE product offerings to include frozen entrees and snack foods that will include the SMART BALANCE "better for you" fat profiles, which the trademark has come to symbolize. Specifically, at issue are application number 77/864,305 for SMART BALANCE in

connection with frozen appetizers primarily containing poultry, meat, seafood or vegetables; frozen entrees primarily containing poultry, meat, seafood or vegetables; frozen entrees consisting primarily of pasta or rice; and application 77/684,268 for SMART BALANCE in connection with soy chips and yucca chips; snack mixes consisting primarily of processed fruits, processed nuts, raisins and/or seeds; nut and seed-based snack bars; cake mix, frosting, cakes, frozen cakes, cookies, coffee, tea, hot chocolate, bread rolls, crackers, pretzels, corn chips, snack mixes consisting primarily of crackers, pretzels, nuts and/or popped popcorn, spices, granola-based snack bars; pita chips.

II. GFA BRANDS' SALES, ADVERTISING, AND PROMOTION OF SMART BALANCE PRODUCTS

GFA Brands and Heinz have coexisted in the market for seventeen years while using the same advertising methods, promotional channels and even selling product in the exact same stores under the SMART BALANCE and SMART ONES marks. GFA Brands sells its SMART BALANCE products nationally through three major classes of trade, conventional grocery stores, mass merchants such as Wal-Mart, and club stores such as Costco or Sam's Club. (Hooper Tr. 21:16-23.) More specifically, GFA Brands sells its SMART BALANCE products in 97% of all stores that sell groceries, including grocery store chains such as Safeway, Kroger, Publix, Wakefern, SuperValu, and Fred Meyer. (Hooper Tr. 21:24-22:7.) With respect to mass merchants, GFA Brands sells its SMART BALANCE products in Wal-Mart and Target. (Hooper Tr. 21:16-23.) These are the same grocery store chains and mass-market stores in which Heinz sells products under the SMART ONES mark. (Gray Tr. 28:17-29:2.)

Similarly, GFA Brands and Heinz have historically used the same advertising and promotional tools to reach consumers of their products are sold under the SMART BALANCE and SMART ONES marks. Specifically, GFA Brands uses all forms of mass media, including

national television, national magazines as well as websites, social media, and Facebook to reach its consumers. (Hooper Tr. 26:9-27:9.) Representative samples of the advertisements and coupons that GFA Brands has used to promote the SMART BALANCE brand were introduced during Mr. Hooper's testimony deposition as Exhibits 12, 14, 15, 16. (Hooper Tr. 25-32.) These are some of the same methods used by Heinz to market its SMART ONES brand. In fact, the SMART ONES and SMART BALANCE brands have historically coexisted in some of very same retailer promotional circulars. (Hooper Tr. Ex. 49.)

GFA Brands has committed significant financial resources to market its SMART BALANCE brand. Confidential data regarding GFA Brands' advertising expenses was introduced during Mr. Hooper's testimony deposition and is found in Confidential Exhibit 13, and the confidential testimony related thereto. (Hooper Tr. 29-36.) Specifically, GFA Brands typically spends a total of [REDACTED] on advertising including television, print and local advertising as well as coupons. (Hooper Tr. 34:8-20.) [REDACTED]

[REDACTED] (Hooper Tr. 32:9-19.)

III. THE STRENGTH OF GFA'S SMART BALANCE TRADEMARK

The advertising efforts of GFA Brands have been successful, resulting in substantial gross sales for products bearing the SMART BALANCE trademark and impressive brand awareness statistics. Confidential information regarding GFA Brands' sales was introduced during Mr. Hooper's testimony deposition and is found in Confidential Exhibit 11 and the confidential testimony related thereto. (Hooper Tr. 23.) From 2010 to 2012, GFA Brands' gross sales for products bearing SMART BALANCE ranged from [REDACTED] to [REDACTED] each year, or [REDACTED] for the three year period.

Confidential information regarding GFA Brands' consumer tracking and brand strength was introduced during Mr. Hooper's testimony deposition and is found in Confidential Exhibits 17 and 18, and the confidential testimony related thereto. (Hooper Tr. 36-47.) Specifically, tracking data establishes that in 2010 SMART BALANCE had a [REDACTED] brand awareness for its butter products, [REDACTED] (Hooper Tr. 41:8-16, Ex. 17.) Today, GFA Brands' SMART BALANCE marks have approximately a [REDACTED] brand awareness. (Hooper Tr. 41:8-19.) Additionally, [REDACTED] [REDACTED] (Hooper Tr. 45:9-10.)

IV. DIFFERENCES BETWEEN THE MARKS IN SIGHT, SOUND, AND MEANING

SMART BALANCE and SMART ONES are different trademarks. The marks are different in how they appear on the page -- 12 letters vs. 9 letters. They are different in sound and different in meaning. The SMART BALANCE trademark communicates balance, specifically the right balance of great taste and good health, with a primary emphasis on heart health. (Hooper Tr. 25:5-11.) In contrast, Ms. Findlay, Heinz's corporate representative, testified that [REDACTED]

[REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 68:18-69:23) [REDACTED] [REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 69:21-23.) [REDACTED]

[REDACTED] [REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 71:14-72:6.)

V. HEINZ'S CONFUSION SURVEY AND GFA BRANDS' RESPONSIVE SURVEY

Heinz commissioned a deeply flawed survey from a purported expert, Barry Sabol. In response, GFA Brands retained Philip Johnson, a nationally known survey expert, who designed and supervised a survey following the Eveready format. Mr. Johnson's survey corrected the flaws in Sabol's survey and contradicted the Sabol survey's conclusion by proving no likelihood of confusion. GFA Brands also retained a separate survey expert, Leon Kaplan, who did not perform a survey of his own, but supplied a point-by-point critique of the Sabol survey.

VI. THIRD PARTY USE OF SMART TRADEMARKS

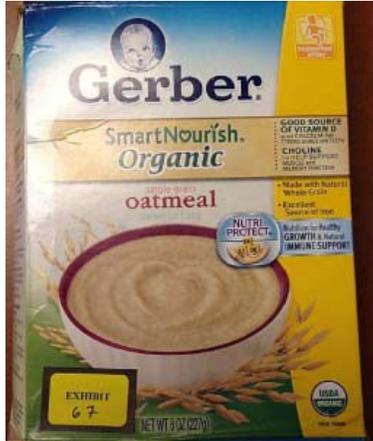
Consumers have in recent years been bombarded with SMART marks on food sold at the grocery store. In addition to GFA's use of the SMART BALANCE mark on various food products since 1996, other third party use of the term "Smart" for food and other health related goods is extensive. William Shanks, a private investigator retained by GFA Brands, testified about third party use of the SMART mark in grocery stores and authenticated documents related to the investigation performed by his employer, Marksmen. (Shanks Tr. 8-25, Exs. 6-13). Additionally, to further substantiate the use of "Smart" in other trademarks found in grocery stores, GFA Brands has submitted packaging for various third party products, including: (1) BISQUICK HEART SMART pancake and baking mix; (2) PREGO HEART SMART Italian sauce; (3) SUNSWEET PLUM SMART plum juice cocktail; (4) HOOD SIMPLY SMART chocolate fat free milk; (5) LIGHTLIFE SMART DELI veggie protein slices; (6) ORVILLE REDENBACHER'S SMART POP! gourmet popping corn; (7) KELLOGG'S SMART START cereal; (8) GLACÉAU SMARTWATER bottled water; (9) SMARTFOOD POPCORN popcorn; (10) GERBER SMARTNOURISH ORGANIC baby cereal; (11) RONZONI SMART TASTE enriched white pasta; and (12) LITTLE DEBBIE fig bars.

Examples of third party use of “Smart” can also be found in the trademark registry as well as the websites of the owners of such registered trademarks as summarized in the following table:

Owner/Goods & Services	Registration/Mark	Website
<p>General Mills, Inc.</p> <p>Baking mixes</p> <p>(App. Not. of Rel. at 2 and Exs. 8, 22 and 58.)</p>	<p>Reg. No. 3140426</p> <p>BISQUICK HEART SMART</p>	<p>http://www.generalmills.com/en/Brands/Baking_Products/Bisquick.aspx</p> <p>http://www.bettycrocker.com/products/bisquick/products/bisquick_heart_smart</p> 
<p>CSC Brands LP Campbell Finance 2 Corp.</p> <p>Sauces</p> <p>(App. Not. of Rel. at 3 and Exs. 9, 23 and 59.)</p>	<p>Reg. No. 3945900</p> 	<p>http://www.prego.com/products/healthy-and-delicious/heart-smart-traditional</p> 
<p>Sunsweet Growers Inc.</p> <p>Fruit juice</p> <p>(App. Not. of Rel. at 3 and Exs. 10, 24 and 60.)</p>	<p>Reg. No. 2916503</p> 	<p>http://www.plumsmart.net/index.html</p> 

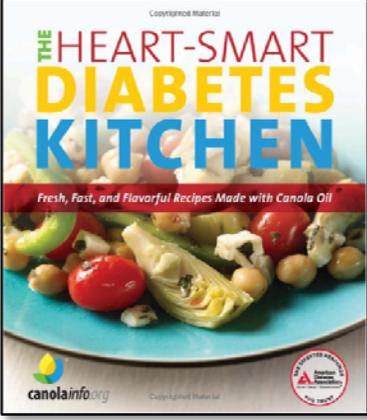
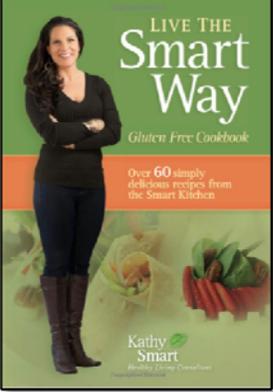
Owner/Goods & Services	Registration/Mark	Website
<p>HP Hood LLC</p> <p>Dairy products, namely ultra-filtrated low-fat and fat free milk</p> <p>(App. Not. of Rel. at 3 and Exs. 11, 25 and 61.)</p>	<p>Reg. No. 2338871</p> <p>SIMPLY SMART</p>	<p>http://www.hood.com/Products/prodListColl.aspx?id=862</p> 
<p>ConAgra Foods RDM, Inc.</p> <p>Soy based meat substitutes and soy based hot dog substitute</p> <p>(App. Not. of Rel. at 3 and Exs. 12, 26 and 62.)</p>	<p>Reg. No. 2773155</p> <p>SMART DELI</p>	<p>http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Smart-Deli-Turkey</p> 
<p>ConAgra Foods RDM, Inc.</p> <p>Soy based hot dog substitute</p> <p>(App. Not. of Rel. at 3 and Exs. 13 and 27.)</p>	<p>Reg. No. 2686279</p> <p>SMART DOGS</p>	<p>http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Veggie-Hot-Dogs</p> 
<p>Smartfoods, Inc.</p> <p>unpopped popcorn</p> <p>(App. Not. of Rel. at 3 and Exs. 14, 28 and 63.)</p>	<p>Reg. No. 1874796</p> <p>SMART POP</p>	<p>http://www.orville.com/healthy-microwave-popcorn-smartpop</p> 

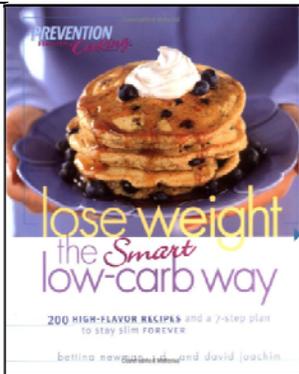
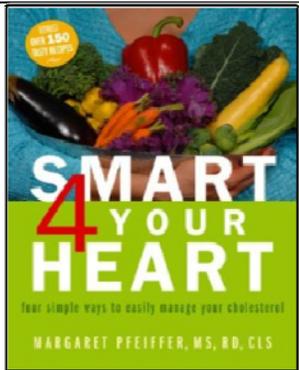
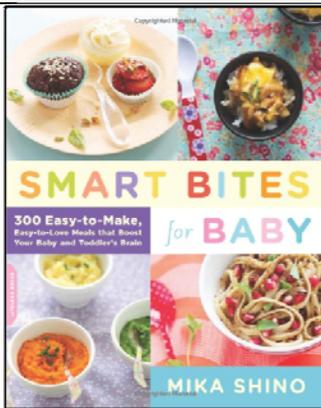
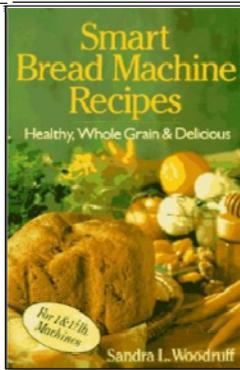
Owner/Goods & Services	Registration/Mark	Website
<p>ConAgra Foods RDM, Inc.</p> <p>Soy based food products used as sausage substitutes</p> <p>(App. Not. of Rel. at 3 and Exs. 15, and 29.)</p>	<p>Reg. No. 3522138</p> <p>SMART SAUSAGES</p>	<p>http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Smart-Sausages-Italian-Style</p> 
<p>Kellogg Company Corporation</p> <p>Cereal-derived food product to be used as breakfast food, [cereal bar], snack food or ingredient for making food</p> <p>(App. Not. of Rel. at 4 and Exs. 16, 30 and 64.)</p>	<p>Reg. No. 1555954</p> <p>SMART START</p>	<p>http://www.kelloggs.com/en_US/SmartStart.html</p> 
<p>Energy Brands Inc.</p> <p>Bottled drinking water</p> <p>(App. Not. of Rel. at 4 and Exs. 17, 31 and 65.)</p>	<p>Reg. No. 3420245</p> 	<p>http://www.glaceau.com/</p> 
<p>Smartfoods, Inc.</p> <p>Popped popcorn</p> <p>(App. Not. of Rel. at 4 and Exs. 18, 32 and 66.)</p>	<p>Reg. No. 1367966</p> <p>SMARTFOOD</p>	<p>http://www.smartfood.com</p> 

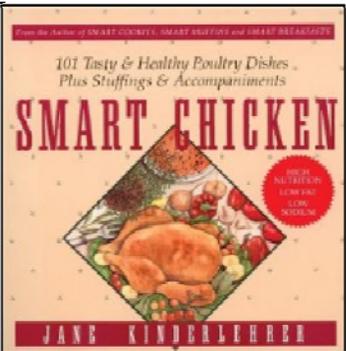
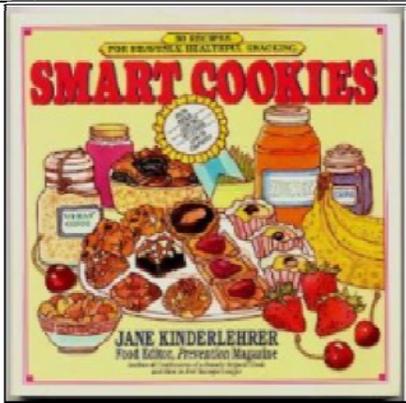
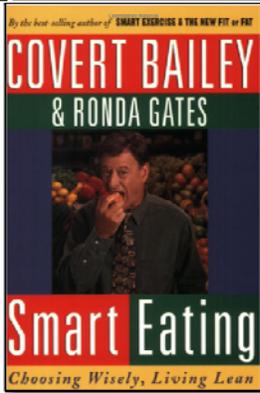
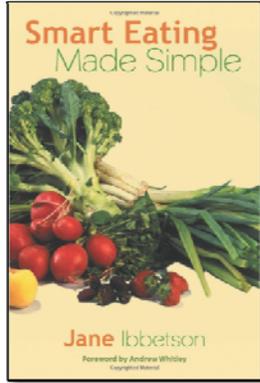
Owner/Goods & Services	Registration/Mark	Website
<p>Société des Produits Nestlé S.A.</p> <p>Blend of nutrients and minerals sold as an ingredient in food for babies; Infant Formula; Food and food substances for babies</p> <p>(App. Not. of Rel. at 4 and Exs. 19, 33 and 67.)</p>	<p>Reg. No. 4183609</p> <p>SMARTNOURISH</p>	<p>http://www.gerber.com/allstages/products/puree_baby_food/2nd_foods_purees_vegetable_risotto.aspx</p> 
<p>New World Pasta Company Corporation</p> <p>Pasta</p> <p>(App. Not. of Rel. at 4 and Exs. 20, 34 and 68.)</p>	<p>Reg. No. 3592893</p> <p>SMART TASTE</p>	<p>http://ronzonismarttaste.newworldpasta.com/pasta_story.cfm</p> 
<p>McKee Foods Kingman, Inc.</p> <p>cakes, snack cakes, cookies, [donuts, candy,] pies, [pastries, rolls, crackers, buns] and other bakery goods (excluding bread); [breakfast cereal, ready to eat cereal derived food bars; granola and granola bars]</p> <p>(App. Not. of Rel. at 4 and Exs. 21, 35 and 69.)</p>	<p>Reg. No. 2107921</p> <p>SNACK SMART</p>	<p>http://www.littledebbie.com/products/bars.asp</p> 

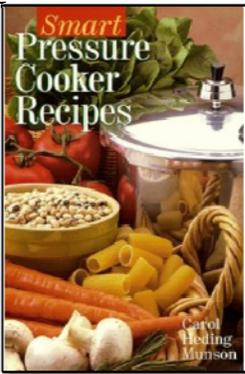
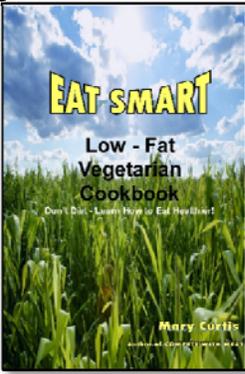
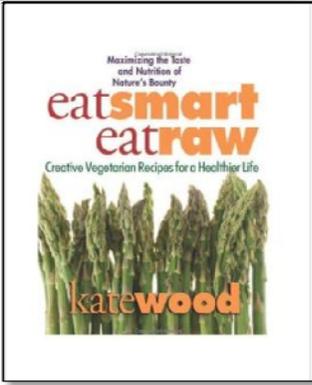
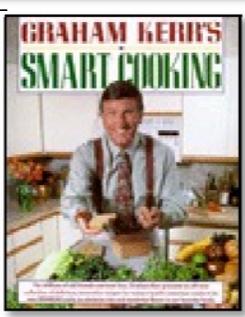
The use of the term “Smart” in commerce on many of the above-identified products was also confirmed by the testimony of Mr. Tim Kraft, who authenticated pictures of third party packaging and discussed purchasing or seeing various “Smart” products during his own shopping experiences, including SMART POP popcorn, SMART START cereal, SIMPLY SMART milk, and HEARTSMART BISQUICK pancake mix. (Kraft Tr. 9:15-13:17, Exs. 70-75.)

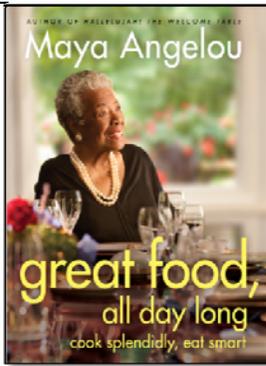
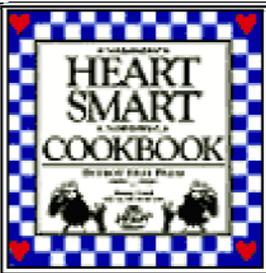
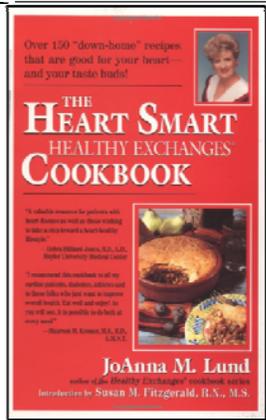
In addition to use on food products, authors and publishers extensively use the term “Smart” in connection with diet and health related cookbooks. Examples of such use include the following:

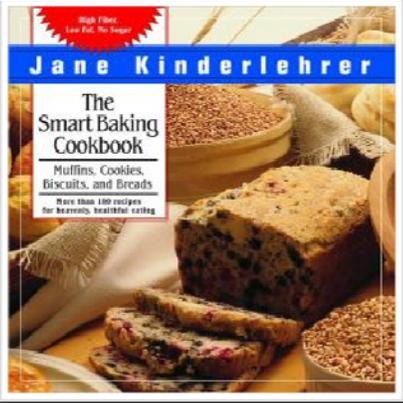
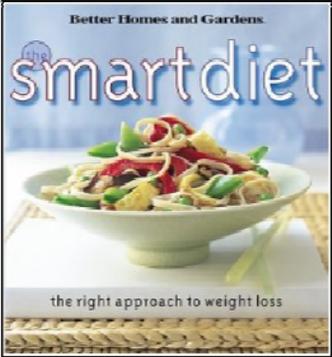
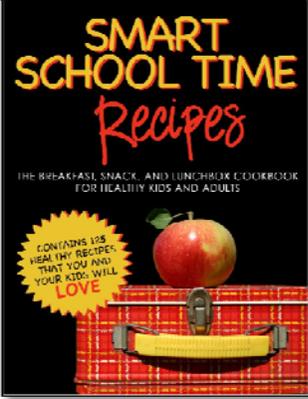
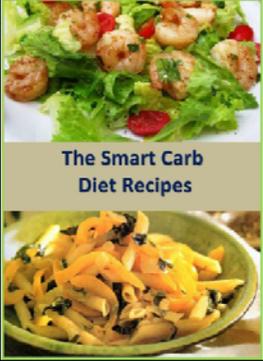
Book	Cover
<p>American Diabetes Association and CanolaInfo, <i>The Heart-Smart Diabetes Kitchen: Fresh, Fast, and Flavorful Recipes Made with Canola Oil</i>, 2009, http://www.amazon.com/Heart-Smart-Diabetes-Kitchen-Flavorful-Recipes/dp/158040331X/ref=sr_1_24?s=books&ie=UTF8&qid=1364934746&sr=1-24 (accessed and printed on April 15, 2013)</p> <p>(App. Not. of Rel. at 6 and Ex. 36.)</p>	
<p>Kathy Smart, <i>Live the Smart Way: Gluten Free Cookbook</i>, 2011, http://www.amazon.com/Live-Smart-Way-Gluten-Cookbook/dp/0987700308/ref=sr_1_45?s=books&ie=UTF8&qid=1364934872&sr=1-45 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 6 and Ex. 37.)</p>	

Book	Cover
<p>Bettina Newman R.D., <i>Lose Weight the Smart Low-Carb Way: 200 High-Flavor Recipes and a 7-Step Plan to Stay Slim Forever (Prevention Health Cooking)</i>, 2002, http://www.amazon.com/Lose-Weight-Smart-Low-Carb-Way/dp/B003D7JXIC/ref=sr_1_66?s=books&ie=UTF8&qid=1364935099&sr=1-66 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 6-7 and Ex. 38.)</p>	
<p>Margaret Pfeiffer, <i>Smart 4 Your Heart Four Simple Ways To Easily Manage Your Cholesterol</i>, 2009, http://www.amazon.com/Smart-simple-easily-manage-cholesterol/dp/0979962625/ref=sr_1_84?s=books&ie=UTF8&qid=1364935190&sr=1-84 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 7 and Ex. 39.)</p>	
<p>Mika Shino, <i>Smart Bites for Baby: 300 Easy-to-Make, Easy-to-Love Meals that Boost Your Baby and Toddler's Brain</i>, 2012, http://www.amazon.com/Smart-Bites-Easy---Make--Love/dp/0738215554/ref=sr_1_4?s=books&ie=UTF8&qid=1364934424&sr=1-4 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 7 and Ex. 40.)</p>	
<p>Sandra Woodruff, <i>Smart Bread Machine Recipes: Healthy, Whole Grain & Delicious</i>, 1994, http://www.amazon.com/Smart-Bread-Machine-Recipes-Delicious/dp/0806906901/ref=sr_1_11?s=books&ie=UTF8&qid=1364934424&sr=1-11 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 7 and Ex. 41.)</p>	

Book	Cover
<p>Jane Kinderlehrer, <i>Smart Chicken: 101 Tasty and Healthy Poultry Dishes, Plus Stuffings and Accompaniments</i>, 1991, http://www.amazon.com/Smart-Chicken-Stuffings-Accompaniments-Kinderlehrer/dp/1557040737/ref=sr_1_93?s=books&ie=UTF8&qid=1364935526&sr=1-93 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 7-8 and Ex. 42.)</p>	
<p>Jane Kinderlehrer, <i>Smart Cookies: 80 Recipes for Heavenly, Healthful Snacking</i>, 1985, http://www.amazon.com/Smart-Cookies-Heavenly-Healthful-Snacking/dp/0937858625/ref=sr_1_101?s=books&ie=UTF8&qid=1364935587&sr=1-101 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 8 and Ex. 43.)</p>	
<p>Covert Bailey and Ronda Gates, <i>Smart Eating: Choosing Wisely, Living Lean</i>, 1996, http://www.amazon.com/Smart-Eating-Choosing-Wisely-Living/dp/039585492X/ref=sr_1_14?s=books&ie=UTF8&qid=1364934424&sr=1-14 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 8 and Ex. 44.)</p>	
<p>Jane Ibbetson, <i>Smart Eating Made Simple</i>, 2012, http://www.amazon.com/Smart-Eating-Made-Simple-Ibbetson/dp/1468566598/ref=sr_1_49?s=books&ie=UTF8&qid=1364934966&sr=1-49 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 8 and Ex. 45.)</p>	

Book	Cover
<p>Carol Heading Munson, <i>Smart Pressure Cooker Recipes</i>, 1998, http://www.amazon.com/Pressure-Cooker-Recipes-Heading-Munson/dp/0806999853/ref=sr_1_40?s=books&ie=UTF8&qid=1364935432&sr=1-40 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 8-9 and Ex. 46.)</p>	
<p>Mary Curtis, <i>Eat Smart: Low - Fat Vegetarian Cookbook</i>, 2007, http://www.barnesandnoble.com/w/eat-smart-mrs-mary-curtis/1112402492?ean=9781257681631&itm=1&usri=9781257681631 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 9 and Ex. 47.)</p>	
<p>Kate Wood, <i>Eat Smart, Eat Raw: Creative Vegetarian Recipes for a Healthier Life</i>, 2006, http://www.barnesandnoble.com/w/eat-smart-eat-raw-kate-wood/1113943087?ean=978075702618&itm=1&usri=9780757002618 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 9 and Ex. 48.)</p>	
<p>Graham Kerr, <i>Graham Kerr's Smart Cooking</i>, 1991, http://www.barnesandnoble.com/w/graham-kerrs-smart-cooking-graham-kerr/1000078238?ean=9780385420747&itm=1&usri=9780385420747 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 9 and Ex. 49.)</p>	

Book	Cover
<p>Maya Angelou, <i>Great Food, All Day Long: Cook Splendidly, Eat Smart</i>, 2010, http://www.barnesandnoble.com/w/great-food-all-day-long-maya-angelou/1100300048?ean=9780679604372&itm=1&usri=9780679604372 (accessed and printed on April 16, 2013)</p> <p>(App. Not. of Rel. at 9-10 and Ex. 50.)</p>	
<p>Henry Ford and Heart and Vascular Inst. Staff, <i>Heart Smart Cookbook</i>, 1994, http://www.barnesandnoble.com/w/heart-smart-cookbook-henry-ford/1015887423?ean=9780836280593&itm=1&usri=9780836280593 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 10 and Ex. 51.)</p>	
<p>JoAnna M. Lund, <i>The Heart Smart Healthy Exchanges Cookbook</i>, 1999, http://www.barnesandnoble.com/w/heart-smart-healthy-exchanges-cookbook-joanna-m-lund/1100170456?ean=9780399524745&itm=1&usri=9780399524745 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 10 and Ex. 52.)</p>	
<p>Julie Van Rosendaal, <i>One Smart Cookie: All Your Favorite Cookies, Squares, Brownies and Biscotti... With Less Fat</i>, 2007, http://www.barnesandnoble.com/w/one-smart-cookie-julie-van-rosendaal/1101996996?ean=9781552859124&itm=1&usri=9781552859124 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 10 and Ex. 53.)</p>	

Book	Cover
<p>Jane Kinderlehrer, <i>Smart Baking Cookbook: Muffins, Cookies, Biscuits and Breads</i>, 2002, http://www.barnesandnoble.com/w/smart-baking-cookbook-jane-kinderlehrer/1102505558?ean=9781557045225&itm=1&usri=9781557045225 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 10 and Ex. 54.)</p>	
<p>Better Homes & Gardens, <i>Smart Diet</i>, 2000, http://www.barnesandnoble.com/w/smart-diet-better-homes-gardens/1008404626?ean=9780696211737&itm=1&usri=9780696211737 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 11 and Ex. 55.)</p>	
<p>Alisa Fleming, <i>SMART SCHOOL TIME RECIPES: The Breakfast, Snack, and Lunchbox Cookbook for Healthy Kids and Adults</i>, 2010, http://www.barnesandnoble.com/w/smart-school-time-recipes-alisa-fleming/1026901529?ean=9780979128639&itm=1&usri=9780979128639 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 11 and Ex. 56.)</p>	
<p>Andrew Rainier, <i>The Smart Carb Diet Recipes</i>, 2012, http://www.barnesandnoble.com/w/the-smart-carb-diet-recipes-andrew-rainier/1111647528?ean=9781105775802&itm=1&usri=9781105775802 (accessed and printed on April 17, 2013)</p> <p>(App. Not. of Rel. at 11 and Ex. 57.)</p>	

VII. LACK OF CONFUSION WITH OTHER SMART MARKS

Despite coexisting in the market place since 1996, there has been no customer confusion between the SMART ONES products and the SMART BALANCE products, a fact that was repeatedly confirmed by Heinz's own witnesses. (Hudson Tr. 92:18-22; Gray Tr. 76:10-16.) GFA Brands' witnesses were also unaware of any instances of actual confusion between SMART ONES and SMART BALANCE despite nearly 17 years of coexistence in the market. (Kraft Tr. 14:22-15:1; Hooper Tr. 13:3-7, 13:17-22, 16:1-5, 18:6-10, 18:25-19:4, 20:25-21:12.) Similarly, despite or perhaps because of the extensive use of the term "Smart" on other food products, Heinz's witnesses were unaware of any actual confusion between products bearing a SMART ONES trademark and any other products bearing any SMART mark. (Gray Tr. 76:17-77:6; Hudson Tr. 94:5-96:10.)

ARGUMENT

I. GFA IS ENTITLED TO REGISTER THE SMART BALANCE MARKS BECAUSE THERE IS NO LIKELIHOOD OF CONFUSION.

A. Heinz has not met its burden under the DuPont factors.

Heinz has not met its burden of proving that there is a likelihood of confusion. West Fla. Seafood v. Jet Rests. Inc., 31 F.3d 1122, 1125, 31 U.S.P.Q.2d 1660, 1662 (Fed. Cir. 1994)(opposer must prove likelihood of confusion by a preponderance of the evidence). Heinz must prove that there is a likelihood of confusion, not just possible confusion, and it has not done so. Witco Chem. Co. v. Whitefield Chem. Co., 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969).

To assess likelihood of confusion, the Board considers the thirteen DuPont factors. In re E.I. DuPont De Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Of those factors, the following are particularly relevant to this proceeding: Factor 1 – similarity or

dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression; Factor 4 – conditions under which, and the buyers to whom, sales are made, i.e., “impulse” vs. careful, sophisticated purchasing; Factor 6 – the number and nature of similar marks in use on similar goods; Factor 7 – the nature and extent of any actual confusion; and Factor 8 – the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

As explained below, and contrary to Heinz’s assertions, an evaluation of the DuPont factors proves that confusion is unlikely to occur. Because Heinz has not offered persuasive evidence to the contrary, let alone a preponderance of the evidence, this Proceeding should be dismissed. GFA Brands’ applications should be granted.

B. Factor 1: The marks are dissimilar.

Allowing GFA to register SMART BALANCE for frozen meals will not cause a likelihood of confusion because the term “balance” is different than the term “ones,” creating an overall difference between the SMART BALANCE and SMART ONES trademarks when the marks are viewed as a whole. As the Federal Circuit explained, “one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.” Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459, 1460-61 (Fed. Cir. 1998) (affirming dismissal of opposition based on dissimilarity of CRISTAL and CRYSTAL CREEK). The dissimilarity between the marks here is an appropriate factor upon which to rule in GFA Brands’ favor.

Pursuant to the “anti-dissection rule,” the parties’ marks must be compared as a whole, rather than by their component parts. Frank Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007, 212 U.S.P.Q. 233, 234 (Fed. Cir. 1981). Because a mark must be considered as a whole, the mere fact that marks share elements, even dominant elements, does not compel a conclusion

of likely confusion. General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“[t]he use of identical, even dominant, words in common does not automatically mean that the two marks are similar.”). In fact, the TTAB and the Federal Circuit have repeatedly held there is no likelihood of confusion between marks that share a common first element when the marks as a whole are dissimilar:

- LEAN LIVING allowed to register over LEAN CUISINE in Stouffer Corp. v. Health Valley Natural Foods Inc., 1 U.S.P.Q.2d 1900 (T.T.A.B. 1986);
- QUICK ‘N CRISPY allowed over QUICK ‘N BUTTERY and QUICK ‘N SAUCY in United Foods Inc. v. J.R. Simplot Co., 4 U.S.P.Q.2d 1172 (T.T.A.B. 1987);
- RED RAVE allowed over RED BULL in Red Bull GmbH v. Cochran, Opposition No. 91152588, 2004 WL 2368486 (T.T.A.B. 2004); and
- SPICE ISLAND allowed over SPICE GARDEN in Burns Philp Food Inc. v. Modern Prods., Inc., 24 U.S.P.Q.2d 1157 (T.T.A.B. 1992).

Thus, while both the Heinz and GFA Brands marks contain the term “Smart,” the inquiry about the similarity of the marks cannot end there. The additional terms BALANCE and ONES that comprise the marks have trademark and market significance, resulting in two marks that, when taken as a whole, have different appearances, sounds, connotations, and commercial impressions. See Shen Mfg. Co. v. Ritz Hotel, Ltd., 393 F.3d 1238, 1245, 73 U.S.P.Q.2d 1350, 1356-57 (Fed. Cir. 2004).

Furthermore, that the term “Smart” is both laudatory and extensively used by third parties means that the term is weak and must be given less weight in the trademark analysis. It has been repeatedly held that laudatory terms are descriptive or highly suggestive. TMEP §1209.03(k) (“Laudatory terms, those that attribute quality or excellence to goods or services, are

merely descriptive under §2(e)(1).”). Thus, if a highly laudatory term is used, the user cannot complain of the use by another of a laudatory expression of similar connotation. Heyer, Inc. v. Popper & Sons, Inc., 152 U.S.P.Q. 196 (T.T.A.B. 1966).

Heinz has admitted that “Smart” as used in SMART ONES is a laudatory or complimentary term. Specifically, Ms. Findlay, Heinz’s Senior Marketing Manager, [REDACTED] [REDACTED] [REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 68:18-21.)

Any significance of the shared term “Smart” is minimal for the additional reason that “Smart” has been both used and registered by many third parties as an element of a larger trademark in the consumer packaged goods industry. (App. Not. of Rel. Exs. 8-35 & 58-69.) As a result, the term “Smart” as one element of a trademark is not truly distinctive or source signifying. The common use of the term certainly can form no rational basis for contending that the marks as a whole are likely to be viewed as closely similar or as coming from the same or a related source. See In re Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1565-66 (T.T.A.B. 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field”); See also In re Bed & Breakfast Registry, 791 F.2d 157, 159, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1989) (“The record shows that a large number of marks embodying the words ‘bed and breakfast’ are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words ‘bed and breakfast.’”).

Finally, the marks at issue are distinct because they provide consumers with a different impression or connotation. When two conflicting marks each have an aura of suggestion, but each suggests something different, this tends to indicate a lack of confusion. For example, the Federal Circuit explained that despite the undisputed similarity of two COACH marks, the marks had different meanings and created distinct commercial impressions -- one in reference to luggage and a stage coach and the other in the context of an educational coach or tutor. Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369, 101 U.S.P.Q.2d 1713, 1721-22 (Fed. Cir. 2012).

As with the COACH example, SMART ONES and SMART BALANCE have different meanings and create distinct commercial impressions, which minimize the likelihood of confusion. Heinz's own corporate designee agrees with this analysis. For example, Ms. Findlay [REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 68:22-24.) [REDACTED] [REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 71:14-19.) [REDACTED] He testified that the SMART BALANCE trademark is positioned to communicate "the balance, the appropriate, right balance of great taste and good health, with primary emphasis on heart health." (Hooper Tr. 25:5-11.)

Thus, given the difference in sound, look, and connotation, the overall commercial impressions of SMART BALANCE and SMART ONES are markedly different.

C. Factor 4: Customers for these products exercise considerable care.

The TTAB and the courts have recognized that calorie-conscious customers are not impulse purchasers. Thus, Heinz's argument regarding the degree of care has explicitly been rejected by the TTAB and contradicted by Heinz's own witness. Specifically, when the TTAB

previously evaluated frozen prepared entrees in the context of an opposition involving the marks LEAN CUISINE and LEAN LIVING, it rejected the argument Heinz advances and instead held that although frozen entrees are generally inexpensive, because they are targeted to calorie-conscious consumers and are not generic food products, they are not purchased on impulse. Stouffer Corp., 1 U.S.P.Q.2d at 1902. As the TTAB explained, “even in the hustle and bustle atmosphere of a supermarket, diet-conscious purchasers of these prepared entrees are a special class of purchasers who may be expected, at least, to examine the front of the packages in order to determine what kind of entree is contained therein and its calorie content.” Id. The Eighth Circuit adopted this same analysis of sophistication among frozen entree purchasers when it affirmed the judgment of no infringement and no dilution between LEAN N’ TASTY and LEAN CUISINE. Luigino’s, Inc. v. Stouffer Corp., 170 F.3d 827, 831-32, 50 U.S.P.Q.2d 1047, 1050 (8th Cir. 1999).

Heinz’s own witnesses confirmed that its products are targeted to health conscious customers and that such customers are not making impulse purchases, directly contradicting the arguments Heinz’s lawyers make in their brief. Specifically, Ms. Marion Findlay, Heinz’s corporate representative at Heinz’s Rule 30(b)(6) discovery deposition, [REDACTED]

[REDACTED] (App. Not. of Rel. Conf. Ex. 70, Findlay Dep. 53:11-24.) Similarly, Heinz’s in-house counsel, Ms. Sabrina Hudson, confirmed that products sold under the SMART ONES marks were in the “frozen nutritional category,” which she described as a category of “mostly meals that are somehow better for you.” (Hudson Tr. 12:21-13:8.) Ms. Hudson went on to explain that these products could be better for you because “they are portion control or they have lower calories,

lower fat, probably as a result maybe lower in what people consider nutritional that are not necessarily good for you but have nutritional that are better for you, whole grains and things like that.” (Hudson Tr. 13:1-8.) Customers would understandably take time to read the product label to identify the relevant “better for you” characteristics and make sure they are purchasing the correct product for their health needs, [REDACTED]. It follows that the fourth DuPont factor favors GFA Brands.

D. Factor 6 –Third party use of the term “Smart” in the consumer packaged goods industry precludes “Smart” from having source indicating significance or trademark strength.

Factor 6, the number and nature of similar marks in use on similar goods, strongly favors GFA Brands. In today’s market, “Smart” is a laudatory term used on a wide variety of products ranging from smart cars, to smart phones, to smart water. In the food industry, the term “Smart” has been commonly used to convey a healthy product and to attract consumers looking for “better-for-you” foods. Many products sold in the same grocery stores as SMART ONES branded products use the term “Smart” to suggest healthy food. GFA Brands has introduced evidence of at least 14 other such products in addition to products sold under the SMART BALANCE mark using “Smart,” as summarized in the fact section VI above.

Additionally, the word “Smart” is in printed publications discussing “Smart” food decisions, and is a term that is widely registered by third parties for food products. GFA Brands has introduced evidence of at least 22 such publications. A review of these book titles demonstrates that the authors used the word “Smart” in their titles to convey that the books are about diet and nutrition, eat healthy, or eating “Smart.” (App. Not. of Rel. Exs. 36-57.)

That the SMART ONES mark has coexisted with so many products sold in some of the very same stores proves that Heinz’s rights are narrowly defined and strongly suggests that expanding the products offered under the SMART BALANCE trademark is not likely to lead to

confusion. See In re Hartz Hotel Servs. Inc., 102 U.S.P.Q.2d 1150, 1153-55 (T.T.A.B. 2012). (recognizing the extensive third party use of GRAND HOTEL and allowing the registration of GRAND HOTELS NYC over prior registration for the mark GRAND HOTEL).

In a similar case involving extensive third-party use, where the Board evaluated the registration of NATURE'S PLUS for vitamins, the applicant introduced evidenced of fifteen third-party registrations for marks containing the term PLUS. Plus Prods. v. Natural Organics, Inc., 204 U.S.P.Q. 773 (T.T.A.B. 1979). The Board drew the following inferences from the co-existence of these registrations: (1) The Trademark Office has historically registered PLUS marks for vitamins to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a whole, e.g. VITAMINS PLUS and IRON PLUS; (2) a number of different trademark owners have believed, over a long interval of time, that various PLUS marks can be used and registered side-by-side without causing confusion provided there are minimal differences between the marks. Id. at 779. The rationale of these inferences is further confirmed by prior decisions addressing third party use explaining that third-party registrations "reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various 'STAR' marks can coexist provided that there is a difference." Jerrold Elecs. Corp. v. The Magnavox Co., 199 U.S.P.Q. 751, 758 (T.T.A.B. 1978).

The use by numerous third parties in a market desensitizes consumers to the use of the term by reducing the individual distinctiveness of similar marks and making confusion unlikely. See General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q.2d 1270, 1277 (T.T.A.B. 1992). Thus, when evaluating breakfast cereals high in fiber, there was no likely confusion between FIBER ONE and FIBER 7 FLAKES due in part fact that the field of "FIBER" composite marks

for food was crowded, allowing consumers to distinguish between the other composite portions of the marks. Id.

Heinz cannot minimize the impact of this extensive third-party use. (Opp. Br. at 31.) Third-party registrations and printed publications are admissible to demonstrate how a mark is used in ordinary parlance. Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co., 958 F.2d 1574, 1582, 22 U.S.P.Q.2d 1190, 1196 (Fed. Cir. 1992). Moreover, when third party registrations are used to show a mark is descriptive, it is irrelevant whether the marks are in current use. See Spraying Sys. Co. v. Delevan, Inc., 762 F. Supp. 772, 778, 19 U.S.P.Q.2d 1121, 1125 (N. D. Ill. 1991). As noted above, registrations are widely recognized as evidence that the Trademark Office, by registering multiple marks with a common term, believed that the identical portions of the composite marks were weak and not likely to cause confusion. 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2013) (hereinafter "MCCARTHY"); Rocket Trademarks Pty Ltd. v. Phard S.p.A., 98 U.S.P.Q.2d 1066, 1075 (T.T.A.B. 2011) (no confusion was likely between senior ELEMENT and junior ZU ELEMENTS for apparel because third party registrations evidenced that "element" was suggestive of clothing).

Heinz's claim that confusion is likely given its exclusive use of the SMART mark for frozen meals is based on an arbitrary distinction when one considers that many competitive food products are sold using the SMART mark. For example, Heinz sells frozen desserts under the SMART ONES mark, while Bryers sells BREYERS CARB SMART ice cream bar, yet no confusion has resulted. (Hudson Tr. 94:21-95:11, Ex. 6.) The argument that SMART ONES is the only "frozen food" to have a federal trademark registration for a similar mark (Opp. Br. at

32) is wrong and meaningless when one considers Bryers's actual use of the CARB SMART mark.

Similarly, Heinz sells breakfast items under the SMART ONES trademark that contain eggs. (Hudson Tr. 92:10-17.) GFA Brands has sold eggs in connection with its SMART BALANCE mark. (Kraft Tr. 6:4-9.) Logically, a consumer seeking breakfast items may consider purchasing refrigerated eggs as well as frozen prepared eggs. That SMART ONES eggs are located in the refrigerated section while SMART ONES breakfast items are located in the frozen section is an arbitrary distinction that would be unlikely to prevent confusion if the term "Smart" were actually unique for goods in the breakfast category. In reality, it is not unique. In fact, Kellogg has been using the SMART START mark for breakfast cereal since 1988, well before SMART ONES entered the breakfast market. (App. Not. of Rel. Ex. 16.)

Here, the many third-party registrations incorporating the term "Smart" as well as the evidence of use of the term in commerce and in diet and health related books leads consumers to understand the inference that the term "Smart" has not been exclusively appropriated by any one entity in the field, and that customers distinguish between these marks when other terms are used. In re Hartz Hotel Servs., Inc., 102 U.S.P.Q.2d at 1153-55. Thus, as a result of the addition of the terms BALANCE and ONES, the marks when taken as a whole are unlikely to lead to confusion.

E. Factors 7 and 8: There is no evidence of actual confusion.

Factors 7 and 8, the nature and extent of actual confusion and the length of time during and conditions under which there has been concurrent use without confusion, strongly favor GFA Brands and favor a finding that confusion is not likely. GFA Brands began using its SMART BALANCE mark in 1996. (Hooper Tr. 11:17-19.) Heinz began using its SMART ONES mark in 1992. In about seventeen years of co-existence there have been no reported

instances of actual confusion. (Gray Tr. 76:10-16.) In fact, there have been no reported instances of actual confusion between SMART ONES and any other SMART mark in the grocery store. (Gray Tr. 76:17-77:6.)

Where, as here, the parties' marks have coexisted in the market for many years, the absence of a single instance of actual confusion strongly indicates that confusion is unlikely. King Candy Co. v. Eunice King's Kitchen, Inc., 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974) (absence of confusion for over twenty years supports a finding that confusion is not likely); G.H. Mumm & Cie v. Desnoes & Geddes, Ltd., 16 U.S.P.Q.2d 1635, 1638 (Fed. Cir. 1990) (affirming dismissal of opposition and noting despite over a decade of marketing in the United States, opposer was unable to offer any evidence of actual confusion); Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co., 228 U.S.P.Q. 364, 367 (Fed. Cir. 1989) (concurrent use of the marks for approximately twenty years with no reported instances of confusion suggests that the marks are not likely to cause confusion). By spending tens of millions of dollars in advertising the SMART BALANCE mark, if GFA Brands' presence in the grocery store was likely to cause confusion, confusion likely would have manifested at some point in the past fifteen years. That it has not strongly favors a finding that confusion is unlikely to occur as GFA Brands further expands the product line sold under the SMART BALANCE mark.

F. Factor 13: Other Probative Facts – GFA's Enforcement Strategy

Heinz's claim that GFA has "essentially admitted" confusion and dilution is a gross mischaracterization of GFA's former enforcement policy, which has no probative value in this proceeding. (Opp. Br. at 34.) Seventeen years ago when GFA was a new company with a new mark, GFA was concerned about the possibility of confusion with other marks using the term "Smart." (Kraft Tr. 9:4-10.) As GFA better understood the market place and realized that confusion is unlikely, its enforcement strategy has changed dramatically. In the words of GFA's

in-house counsel, Mr. Kraft, GFA's enforcement strategy "has had to evolve" because of the "rampant proliferation of the use of 'Smart' marks" in the marketplace. (Kraft Tr. 9:1:3.) GFA's current internal enforcement guidelines suggest enforcement against marks for similar categories of goods in which the term "Smart" is coupled with a word that begins with "B," such as "SMART BLEND." (Kraft Tr. 7:4-22.) Rather than being "essentially an admission" that registration of the SMART BALANCE for frozen foods would confuse purchases and dilute the SMART ONES mark, the change in GFA's enforcement strategy is evidence that the SMART portion of the SMART ONES mark has become a weak, descriptive term for healthy eating choices.

Further, the Board has previously recognized the limited value of a party's early enforcement strategies have explaining that it would be merely "one fact to be considered together with all of the other facts of record." Domino's Pizza Inc. v. Little Caesar Enters., Inc., 7 U.S.P.Q.2d 1359, 1988 WL 252360 at *6 (T.T.A.B. 1988). In this case, the change in GFA's enforcement position was a thoughtful response to the changing status of the term "Smart" in the marketplace, which has rendered that portion of the SMART ONES mark weak and descriptive.

II. THE SURVEY EVIDENCE PROVES THERE IS NO LIKELIHOOD OF CONFUSION.

A. The Importance of Properly Conducted Confusion Surveys.

A consumer survey can provide important evidence about whether confusion is likely. The advantage of a survey over analyzing the DuPont factors one-by-one is that a proper survey tests the combined effect of the of DuPont factors from the perspective of the relevant consuming public, which is the key to determining likelihood of confusion. See MCCARTHY, supra at § 32:158 (consumer surveys are important because trademark disputes "turn largely on factual issues of customer perception").

Consumer survey evidence is useful, however, only if the survey is done in accordance with generally accepted standards. Those standards are set forth in recognized authoritative works, including MCCARTHY and SHARI DIAMOND, “Reference Guide on Survey Research,” REFERENCE MANUAL ON SCIENTIFIC EVIDENCE (2d ed. 2000) (hereinafter “DIAMOND”). See also MANUAL FOR COMPLEX LITIGATION (4th) p. 103 (2004).

The survey evidence developed by Barry Sabol, upon which Heinz relies, fails nearly every one of the standards for survey admissibility. Sabol’s survey should be given little if any weight. On the other hand, the survey performed by GFA’s Brands’ survey expert, Philip Johnson, the CEO of Leo J. Shapiro & Associates, followed the standard Eveready format, which the Board and courts have repeatedly held to be reliable. See Starbucks U.S. Brands, LLC v. Ruben, 780 U.S.P.Q.2d 1741, 1753 (T.T.A.B. 2006) (“[G]iven the way in which this survey carefully follows the Ever-Ready likelihood of confusion survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein.”). Mr. Johnson’s survey shows no likelihood of confusion and should be given considerable weight. The Johnson survey confirms that the proliferation of SMART marks, the difference in the marks as a whole, and the care exercised by consumers when purchasing the goods in question leads to there being no likelihood of confusion.

B. Was the Survey Conducted by an Appropriately Skilled and Experience Survey Expert? No for Heinz; Yes for GFA Brands.

An important factor in assessing the validity of a survey is whether the expert who designed and implemented the survey was appropriately experienced. See DIAMOND, supra at 375. A survey should be conducted by an expert “who demonstrates an understanding of the foundational, current and best practices in survey methodology, including sampling, instrument design (questionnaire and interview construction), and statistical analysis.” Id. Heinz’s survey

expert, Barry Sabol, does not satisfy this requirement. (Kaplan Tr. 55:14-57:19.) Sabol has a stunning lack of experience with confusion surveys used in litigation. He admitted he has never read any portion of the leading treatise on trademark law, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, which includes a lengthy discussion of survey evidence. (Sabol Tr. 101:18-20.) Nor could he recall reading any of Professor Shari Diamond's writings on the standards for admissibility of survey evidence in litigation. (Sabol Tr. 101:1-103:4.)

Sabol does not even know what an Eveready survey is. (Sabol Tr. 101:8-13.) As MCCARTHY explains, the Eveready format is the "standard survey format" for confusion cases such as this. MCCARTHY, supra at § 32:174. Although he spent about 30 pages of his trial testimony attacking Johnson's Eveready survey, Sabol had not even tried to familiarize himself with the benefits or elements of such a survey. Sabol's total lack of experience with Eveready surveys and the leading authoritative works on surveys is reflected in his criticism of this standard format and in the many ways his own survey deviates from accepted practice.

GFA Brands, by comparison, retained Philip Johnson, a nationally known authority on consumer surveys generally and litigation surveys in particular. Given his long experience in this area, Johnson -- unlike Sabol -- has been reading MCCARTHY and Dr. Diamond's writings about surveys since they were first published many years ago. (Johnson Tr. 12:5-20.) Mr. Johnson has testified in evidentiary hearings, trials, or TTAB trial proceedings about 80 times, with more than half focusing on the issue of likelihood of confusion. (Johnson Tr. 12:20-13:7.) He has never been excluded as an expert on survey research methodologies, and none of the surveys he has performed have been excluded from evidence. (Johnson Tr. 12:21-13:15.)

C. **Was the Survey Universe Properly Chosen and Defined? No for Heinz, Yes for GFA Brands.**

The first step in designing a survey is to determine the population or “universe” to be studied. MCCARTHY, supra at § 32:159. Selecting the universe is important because even if proper questions are asked in a proper manner, if the wrong people are asked, the results are likely to be irrelevant.

A fundamental error in Sabol’s survey is that he excluded a large group of respondents whose states of mind are relevant to the issue of confusion, namely potential purchasers of the junior user’s products who were not aware of the senior user’s mark. See MCCARTHY, supra at § 32:161. Through screening questions, Sabol excluded respondents who, by his own admission, were less likely to be confused, with the result of increasing the percent of confusion his survey allegedly represents.

To qualify as a respondent, Sabol required a “yes” answer to a question asking whether they had personally purchased any frozen meals in the past 30 days **and** “yes” to a question about whether they had ever heard of Heinz’s SMART ONES brand products. The first question is problematic in itself. (Kaplan Tr. 27:5-29:1.) But the second screening question, requiring previous knowledge of the SMART ONES brand, caused Sabol’s universe to be blatantly under inclusive and improper. As explained in MCCARTHY, in a traditional case of forward confusion, such as alleged here, “the proper universe to survey is composed of the potential buyers of the junior user’s goods or services, not the senior user’s customers.” § 32:159 (emphasis in original.) Making awareness of the SMART ONES brand a part of the definition of Sabol’s universe is wrong because it excludes a segment of the relevant market for GFA Brands’ products, namely potential purchasers who are not aware of the SMART ONES brand.

Sabol's under inclusive universe was intentional, and it skewed his results toward confusion. Sabol's testimony reflects that it was a purposeful attempt on his part to increase the number of respondents "who might be confused by the introduction of Smart Balance" (Sabol Tr. 20:3-20; see Kaplan Tr. 29:3-25.)

Mr. Johnson's survey, on the other hand, did not limit the universe to those potential buyers who were aware of the Smart Ones brand. See MCCARTHY, supra at § 32:159. (Johnson Tr. 22:23-27:6.) Although there are many other flaws with Sabol's survey, the results of Johnson's survey of a properly defined universe shows only 2% indicated any possibility of confusion. This de minimus result proves there is no likelihood of confusion among the relevant consumers. (Johnson Tr. 55:2-57:5.) Sabol's incorrect universe, therefore, is not simply a harmless error. It is a flaw that contributed to the widely divergent results of the two surveys at issue.

D. Were the Survey Questions Clear and Not Leading? No for Heinz; Yes for GFA Brands.

Although there are several problems with the format of the questions in Sabol's survey instrument, some of the most severe problems are with Question 3, which is leading and suggestive: "If you were to see a brand of frozen meals in the frozen food section of a supermarket named Smart Balance, would you think it was associated with, licensed by, owned by or in any way connected to Smart Ones? You may answer yes, no, or don't know." As explained in MCCARTHY, phrasing the key confusion inquiry in the form of a close-ended question such as this is typically improperly leading. MCCARTHY, supra at § 32:175. Sabol's format, which somewhat resembles the basic Squirt format (Kaplan Tr. 15:11-16:1), has been repeatedly criticized because, as MCCARTHY explains, "it appears to suggest a connection which had never before occurred to the respondent." § 32:172; Kaplan Tr. 17:4-22.

The problem of Question 3 being leading and suggestive is compounded by Sabol's failure to ask an open-ended "why" type question or to use a control. See MCCARTHY, supra at § 32:172 n.9 (lack of a control is particularly problematic with a Squirt-type format); Kaplan Tr. 42:18-45:3. As Dr. Diamond explains, a "consumer's response to any question on the survey may be the result of information or misinformation from sources other than the trademark the respondent is being shown." DIAMOND, supra at 256-57. One standard way to address that problem is to ask an open-ended "why" type question to find out whether a yes answer to a Question 3 -- type question is caused by a perceived similarity in the two marks or for some other reason. (Johnson Tr. 43:16-45:13; Kaplan Tr. 38:3-42:14.) Furthermore, "why" questions are sometimes "the most illuminating and probative parts of a survey." MCCARTHY, supra at § 32:178. Yet, Sabol failed to ask any such open-ended questions.

Johnson, on the other hand, followed the accepted practice of asking open-ended questions. He did so to obtain the important "cause" information that cannot be captured by Sabol's close-ended Question 3. (Kaplan Tr. 40:13-42:14.)

E. Did the Survey Include a Control to Correct for "Noise" and to make sure any Confusion is Due to Trademark-Relevant Reasons? No for Heinz; Yes for GFA Brands.

A control group is an additional way to assure that positive responses in a confusion survey are caused by trademark-relevant reasons, and not because of "noise" or other irrelevant reasons. (Kaplan Tr. 20:15; 21:10.) A control group is an additional group of respondents who meet the same screening criteria and go through the same interview as the test group, except they are asked a confusion question about a different brand than the one alleged to infringe. Any confusion observed in the control group can be attributed to irrelevant, non-trademark issues, and that percentage is subtracted from the level of confusion observed in the test cell. J. Jacoby,

Experimental Design and Selection of Controls and Trademark and Deceptive Advertising Surveys, 92 Trademark Reporter 890, 905 (2002).

Because Sabol's study did not have a control group or open-ended questions, it lacked a mechanism to estimate and adjust for error or "noise" in the resulting data. "Noise" in the Sabol study can take many forms, including the interview experience itself, aspects of the questionnaire and guessing by the respondents. Any noise would inflate the level of confusion measured in the test cell. (Sabol Tr. 97:21-99:4.)

Sabol admitted that including a control group would have either reduced the percentage of people his study indicated were confused or kept the number the same. (Sabol Tr. 97:22-99:4.) It appears that Heinz restricted the budget for Sabol's survey to an unusually small sum, which may have influenced Sabol's decision to omit a control. (See Johnson Tr. 39:7-40:8; Sabol Tr. 99:5-1-1:3.)

Regardless of the reasons, Sabol's failure to control for noise or ask an open-ended "why" question yielded affirmative responses to Question 3 that are ambiguous and, therefore, largely meaningless. (Kaplan 42:8-45:3; Johnson 56:19-57:5) See Nat'l Football League Props., Inc. v. Prostyle, Inc. 57 F. Supp. 2d 665, 668-672 (E.D. Wis. 1998) (survey that omitted a control group was excluded).

The Johnson survey, on the other hand, included both an open ended "why" question as well as a properly constructed control group. (Johnson Tr. 35:17-38:4; 43:16-45:13.) Johnson's survey also took the customary steps to make sure respondents knew that a "don't know" answer is a legitimate answer. Experienced survey experts know that respondents are often reluctant to admit that they do not know an answer to a question, for fear of appearing uninformed. It is therefore standard practice to tell respondents that it is acceptable if they do not know the answer

to a question. (Kaplan Tr. 31:18-37:15; Johnson Tr. 32:25-33:22.) It is customary to include a statement, such as Johnson included in his survey, explaining to the respondents that there are no right or wrong answers to the questions and that if they do not know the answer they should simply say so. Sabol, on the other hand, included no such statement.

Sabol's opinion, which surfaced for the first time during his direct trial testimony, that Johnson intentionally designed his survey to obtain "don't know" answers is based entirely on speculation and reveals Sabol's lack of experience with litigation surveys. (Sabol Tr. 70:2-17.) Unlike Sabol, the two experts with extensive litigation experience, Mr. Johnson and Mr. Kaplan, explained that Johnson's survey was done in accordance with accepted methods. Johnson addressed the "don't know" issue exactly the way it always is handled in litigation surveys of this sort. (Kaplan Tr. 31:18-37:15; Johnson Tr. 32:25-33:22.)

F. Other Flaws in the Sabol Survey.

Sabol's survey is riddled with other flaws and deviations from standard practice. For example, Sabol failed to report any attempt to validate the interviews he relied upon for his survey data. In litigation, a survey expert typically attempts to demonstrate that an interviewer actually conducted the interviews, that the interviews were conducted properly and that the respondents were qualified to participate in the study. (Kaplan Tr. 47:21-49:17.) Sabol's report fails to discuss validation at all, calling into question the reliability of his entire study. See Paco Sports, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305, 323-24, 54 U.S.P.Q.2d 1205, 1220-1221 (S.D.N.Y. 2000) aff'd, 234 F.3d 1262 (2d Cir. 2000). Sabol conceded that his failure to include any validation in his report was an error. He also claimed he conducted a validation, albeit unreported. (Sabol Tr. 47:19-48:17.) Sabol's validation, however, did not use an independent party, which is not sufficient for a survey used in litigation. (Kaplan Tr. 47:21-49:17.) Johnson, on the other hand, employed a thorough, independent validation process for his

survey. (Johnson Tr. 47:5-49:20.) Unlike Sabol, he also reported the results of his validation in his expert report.

Other flaws in Sabol's survey procedure have been addressed in the trial testimony and reports submitted by Messrs. Kaplan and Johnson. They also addressed in their testimony the other misguided criticisms Sabol had of the Johnson survey.

Although it has been said that there is no such thing as a "perfect" survey, Sabol's survey is so flawed that it should be given little if any weight. Johnson's survey, on the other hand, follows the standard Eveready format for confusion surveys, was conducted with non-leading questions, and with all of the control, validation, double-blind and other safeguards customarily used by survey experts. It was also designed, overseen, and presented by a highly qualified survey expert. The Johnson survey, showing no likelihood of confusion, directly contradicts the results of Sabol's survey, confirms the foregoing analysis of the DuPont factors and should be given considerable weight in the confusion analysis.

III. GFA'S USE OF THE SMART BALANCE TRADEMARK WILL NOT DILUTE THE SMART ONES TRADEMARK.

A. Heinz Has Not Proven the Stringent Standards for a Dilution Claim.

Heinz has not come close to proving its dilution claim. Dilution by blurring occurs when consumers identify a single mark with two different sources. See MCCARTHY, supra at §24:69. For dilution to occur, the relevant public must connect one mark with two *separate* users, rather than mistakenly attribute two similar marks to a single source. MCCARTHY, supra at §24:72. This impairs the distinctiveness of the mark and weakens the ability of the opposer's mark to serve as a "unique identifier." Id.; see also 15 U.S.C. §1125(c)(2)(B). Thus, dilution and likelihood of confusion are based on "inconsistent states of customer perception." MCCARTHY, supra at §24:72 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25, cmt. f (1995)).

When a mark is being diluted, the public “intuitively knows, because of the context of the junior user’s use, that there is *no connection* between the owners of the respective marks.” Id. (emphasis added).

A claim for dilution requires that the opposer prove (1) opposer’s mark is famous; (2) in a proceeding opposing an intent-to-use application, that opposer’s mark became famous before the filing date of the application; and (3) applicant’s use is likely to cause dilution of the distinctive quality of opposer’s mark or lessen the capacity of the mark to identify and distinguish opposer’s goods or services. See Toro Co. v. ToroHead Inc., 61 U.S.P.Q.2d 1164, 1172-1173 (T.T.A.B. 2001); Polaris Indus. Inc. v. DC Comics, 59 U.S.P.Q.2d 1798, 1800 (T.T.A.B. 2000). Heinz has not proven that its mark was famous before GFA Brands filed its intent-to-use applications in 2009, because virtually all of its evidence post-dates 2009. Similarly, Heinz cannot prove that its mark would be diluted by adding one more SMART-branded food product to the plethora of SMART-branded food products already present in the marketplace. The “Smart” portion of Heinz’s SMART ONES mark had been rendered weak and descriptive of healthy eating choices by the proliferation of the term “Smart” in food product brands. Heinz’s claim for dilution should be denied.

B. Opposers have not shown that the SMART ONES mark met the high dilution fame standard before the filing date of GFA Brands’ intent-to-use applications.

The bar for establishing fame under a dilution analysis is set extremely high. See Toro Co., 61 U.S.P.Q.2d at 1170; Coach Servs., Inc., 101 U.S.P.Q.2d at 1724, (citing 4 MCCARTHY § 24:104 (4th ed. 2011)). Unlike fame under a likelihood of confusion analysis, which can vary along a spectrum from very strong to very weak, a mark is either famous or it is not famous for the purposes of dilution, see Coach Servs., Inc., 101 U.S.P.Q.2d at 1720. Dilution fame requires a showing that when the general public encounters in the plaintiff’s mark “in almost any context”

it initially associates the term with the Opposer. See Toro Co., 61 U.S.P.Q.2d at 1181. The Opposer's marks must have become "household terms [with] which almost everyone is familiar." Id. To prove that its mark is famous, the opposer must essentially "demonstrate that the English language has changed," and that its mark has become part of the vernacular. Id. at 1180.

A mark is defined under § 1125(c)(2)(A) as "famous" for dilution purposes if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the Board may consider all relevant factors, including: (1) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties, (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark, (3) the extent of actual recognition of the mark, and (4) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. However, evidence showing the transformation of a term into a truly famous mark may include recognition by the other party, intense media attention, and surveys. See Toro Co., 61 U.S.P.Q.2d at 1181.

The quantum of evidence required to prove that a mark has reached "dilution fame" is extraordinary. Examples of well-known marks that have *not* met the dilution fame requirement include the TORO mark for professional lawn care equipment;² the IN-N-OUT BURGER mark for fast food service;³ the BEGGIN' STRIPS mark for dog treats;⁴ and the COACH mark for luxury products including women's handbags.⁵

² See Toro Co., 61 U.S.P.Q.2d at 1181 (evidence of sales and advertising did not show that the public associated the term "Toro" with the Torro Co. in "every context.")

³ IN-N-OUT Burgers v. Fast Lane Car Wash & Lube, Opposition No. 91183888, 2013 WL 3188897 (T.T.A.B. Mar. 14, 2013) (nonprecedential).

The quantity and quality of evidence needed to establish fame under a dilution analysis is reflected in the evidence introduced in NASDAQ Stock Mkt. Inc. v. Antartica S.r.l., 69 U.S.P.Q.2d 1718 (T.T.A.B. 2003). In that case, the Board found that the NASDAQ mark had achieved dilution fame because the record included market studies showing that awareness of the NASDAQ stock market jumped from about 20% in 1990 to more than 80% in 1999, the NASDAQ website received seven million daily views, its daily market results appeared in hundreds of newspapers, broadcasting stations and websites, and its NASDAQ-listed companies received separate and significant media coverage as NASDAQ traded companies. Id. at 1729; see 7-Eleven, Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1727-1728 (T.T.A.B. 2007) (citing NASDAQ as an example of the extraordinary amount and quality of evidence required to show dilution fame); see also Virgin Enters. Ltd. v. Moore, 2012 WL 03992908 (T.T.A.B. 2012) (nonprecedential) (same). In 7-Eleven, Inc. v. Wechsler, the Board, citing NASDAQ, found that the BIG GULP mark had achieved the very high standard for dilution fame through extensive media attention, particularly those references identifying the mark as a symbol of American culture such as an article entitled “The Big Gulp is a symbol of American haste and greed,” and a 73% unaided awareness among all consumers, including non-users of the opposer’s services. See 83 U.S.P.Q.2d 1715, 1727(T.T.A.B. 2007). In Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc., the Board found that the BLACKBERRY mark for smartphones was famous because of the “ground breaking role of this device in shaping the culture and technology of the early twenty-first century, the incredible volume of sales, opposer’s extensive promotion and advertising expenditures within the United States, and evidence of widespread media attention.”

⁴ Societe Des Produits Nestle S.A. v. Midwestern Pet Foods, Inc., 2011 WL 1495460 (T.T.A.B. 2011) (nonprecedential) aff’d 685 F.3d 1046 (Fed. Cir. 2012).

⁵ Coach Servs. Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010); aff’d 668 F.3d 1356 (Fed. Cir. 2012).

See 102 U.S.P.Q.2d 1187, 1197 (T.T.A.B. 2012). The Board also found that BLACKBERRY has surmounted the dilution fame requirement because before the Applicants' intent-to-use applications were filed, BLACKBERRY branded goods had "kicked-off a technology revolution in the United States." Id.

In contrast to the extraordinary level of evidence of fame found sufficient in NASDAQ, 7-Eleven, and Research in Motion, Heinz has provided no evidence of media attention, no evidence that GFA has admitted the SMART ONES mark is famous for dilution purposes, and no survey evidence addressing the proper time frame. In fact, Heinz has produced only one piece of relevant evidence that pre-dates the filing date of GFA Brands' intent-to-use applications. Heinz's evidence falls far short of meeting the high standard for dilution fame.

Heinz was required to prove that its mark became famous *before* the filing date of GFA Brands' intent-to-use applications. See Toro Co., 61 U.S.P.Q.2d at 1173. GFA Brands filed intent-to-use applications serial nos. 77/864,305 and 77/864,268 on November 3, 2009. Therefore, all evidence that Heinz supplied from after November 3, 2009 is inapplicable to the Board's determination of the mark's famous character. See, e.g. Coach Servs. Inc., 101 U.S.P.Q.2d at 1725 (opposer's advertising figures, unsolicited media mentions, and survey data that post-date Applicant's intent-to-use application did not evidence dilution fame).

For example, Henz's allegations that recognition of the SMART ONES brand is high and that the brand has a strong reputation are based on testimony of the deponents' present awareness of the brand when they were deposed in 2013, and based on two articles from 2013. (Opp'rs. Br. at p. 12 (citing Gray Conf. Tr. 69:22-25, 24:11-14, and Hudson Tr. 17:11-21, 79:6-81:18 and Ex. 35.)) Even if they were directed toward the proper time frame, "[f]ame for FTDA purposes cannot be shown with general advertising and sales figures and unsupported assertions of fame

by the party.” Toro Co., 61 U.S.P.Q.2d at 1179. Similarly, the brand awareness study Heinz cites was conducted in 2010, making it inapplicable to the dilution fame analysis. (Opp’rs Br. at p. 38 (citing Gray Conf. Tr. Ex. 46)). That aside, the study found 53% unaided awareness for SMART ONES entrees, only 6% unaided awareness for breakfast items, and only 6% unaided awareness for desert items -- which are far below the 80% and 73% awareness in NASDAQ and 7-Eleven. (Opp. Br. pp. 12-13 (citing Gray Conf. Tr. 63:21-65:9 and Ex. 46)) Heinz’s survey expert, Barry Sabol, conducted a study that also post-dated November, 2009 and did not assess unaided awareness at all. (Sabol. Tr. Ex. 1.) The other evidence that Heinz cites in its attempt to prove fame is related to visits to the SMART ONES website was from fiscal years 2010 and 2011 -- again, after GFA Brands’ applications were filed. (Gray Conf. Tr. Ex. 44.)

Heinz’s argument that GFA has admitted that the SMART ONES brand is famous is not true. While GFA Brands’ in-house counsel Timothy Kraft said that 75% or greater awareness would indicate as strong brand (Opp. Br. at p. 13), Heinz’s survey showed that the SMART ONES brand achieved only 53%, 6%, and 6% unaided awareness in 2010. Although Mr. Kraft also stated that, he believed the SMART ONES brand was “well-known” (Opp. Br. at p. 13), that is not even close to stating that SMART ONES has reached the level of fame for dilution. Finally, Heinz’s allegation that GFA Brands’ Chief Marketing Officer stated that the SMART ONES brand is a “market dominator” was made in 2010, again after GFA’s intent-to-use applications were filed. (Opp. Br. p. 13, Hooper Tr. Ex. 52.)

In fact, the *only* piece of evidence that Heinz has referred to in its trial brief that pre-dates the filing of GFA Brands’ intent-to-use applications is a single exhibit that sets forth the number of physical containers of SMART ONES products shipped in 2008 and 2009. (Opp. Br. p. 15, Gray Tr. Ex. 45.) Even if this single piece of evidence were sufficient to show that SMART

ONES is a top selling brand, “[m]erely providing evidence that a mark is a top-selling brand is insufficient to show this general fame without evidence of how many persons are purchasers.”

See Coach Servs. Inc., 101 U.S.P.Q.2d at 1729 (quoting Toro Co., 61 U.S.P.Q.2d at 1181).

Heinz has provided no evidence of how many people purchased SMART ONES products before GFA Brands filed its applications -- merely how many units were shipped.

C. GFA Brands’ SMART BALANCE mark is not likely to dilute the distinctiveness of the SMART ONES mark when it is applied to frozen food products.

There are six, non-exclusive statutory factors for determining the likelihood of blurring in a dilution case: (1) the degree of similarity between the mark or trade name and the famous mark, (2) the degree of inherent or acquired distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the mark or trade name intended to create an association with the famous mark; and (6) any actual association between the mark or trade name and the famous mark. 15 U.S.C. § 1125(c)(2)(B). In its brief, Heinz has already conceded that there is nothing in the record suggesting that GFA Brands intended to create an association between the SMART BALANCE and SMART ONES marks. (Opp. Br. p. 40.) Each remaining factor is addressed in turn:

1. The degree of similarity between the mark or trade name and the famous mark.

For this factor to favor Heinz, it must prove that the SMART ONES mark and the SMART BALANCE mark are “highly similar.” See Research in Motion, Ltd., 102 U.S.P.Q.2d at 1197. While the dilution similarity analysis is not strictly the same as a likelihood of confusion analysis for similarity, the Board still considers the degree of similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See

id., (citations omitted). As GFA Brands has shown in its likelihood of confusion analysis of these factors (App. Br. p. 20-31 above), the SMART ONES mark and the SMART BALANCE mark are not “highly similar.” As GFA Brands has already shown, the terms ONES and BALANCE have individual trademark and market significance, the term SMART is laudatory and used extensively by third parties, which has rendered the term deserving of less weight in the trademark analysis, and the two marks provide consumers with different impressions -- the SMART BALANCE mark suggests a balance of ingredients, while the SMART ONES mark suggests that the consumer made a correct food selection.

2. The degree of inherent or acquired distinctiveness of the famous mark.

Opposers’ entire argument that its mark is distinctive rests on its registration on the Principal Register without a Section 2(f) claim. (Opp. Br. pp. 38, 40.) While the type of registration is one factor the Board considers in assessing distinctiveness, an overall distinctiveness analysis is made “even when it is undisputed that opposer's mark is registered on the Principal Register.” Citigroup Inc. v. Capital City Bank Grp. 94 U.S.P.Q.2d 1645 (T.T.A.B. 2010) (citing NASDAQ StockMarket Inc. v. Antartica S.r.l., 69 U.S.P.Q.2d 1718, 1735 (T.T.A.B. 2003)); Toro Co., 61 U.S.P.Q.2d at 1176. In addition to a mark’s registration, the Board considers other factors that show the mark is weak, such as other uses of the term by third parties. See Nike Inc., 100 U.S.P.Q.2d at 1028. Heinz has argued in a separate portion of its brief that the record is “totally devoid” of evidence showing third party use of “SMART-formative marks in connection with similar products.” (Opp. Br. at 25.) However, GFA Brands has provided a great deal of evidence that the term “Smart” is consistently used in relation to food products, and has acquired a descriptive meaning connoting a healthy eating choice. (App. Br. pp. 9-19) (showing extensive third party use through tables of third party registrations,

product packaging bearing the term “Smart,” websites, and cookbooks incorporating the word “Smart,” showing that third party use of the term “Smart” on consumer packaged goods precludes the term from having a source indicating trademark strength, and explaining that the “Smart” portion of the SMART ONES mark is laudatory and descriptive.))

That the word “smart” has become a descriptive term in the marketplace for healthy eating choices is further evidenced by the change in GFA Brands’ own enforcement strategy. Timothy Kraft testified that GFA Brands no longer polices every trademark containing the word “Smart” related to food products because “the marketplace is seeing this rampant proliferation of the use of ‘Smart’ marks, our strategy has had to evolve ... in today’s marketplace, we don’t think it’s as practical to try to police every use of the word ‘Smart.’” (Kraft Tr. 9:1:3.) Simply put, the proliferation of the word “Smart” in the food industry has rendered it a descriptive term for healthy eating choices.

3. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

As GFA Brands has explained above, Heinz is only one of a vast number of users of the term “Smart” to connote healthy eating choices in the food industry. Because the term “Smart” has proliferated in the food industry by appearing on “healthy” food product names other items related to healthy eating choices -- including SMART BALANCE branded products -- Heinz’s SMART ONES mark has already been diluted. See Citigroup, Inc. v. Capital City Bank Group, Inc., 94 U.S.P.Q.2d 1645 (T.T.A.B. 2009)(“the term ‘City Bank’ frequently has been adopted and used by third parties. In essence, to the extent that opposer is correct in arguing that the mere use of the words ‘City Bank’ in another mark would dilute opposer’s mark, such mark has already been diluted and the registration of applicant’s marks is not likely to cause additional

blurring of CITIBANK.”) Adding one more SMART BALANCE product into the mix of SMART-branded food products will not dilute the SMART ONES mark further.

4. The degree of recognition of the famous mark.

If a mark has been determined to be famous “as a prerequisite for dilution protection,” this factor requires the Board to apply a sliding scale to determine the extent of that protection. See Citigroup, Inc., 94 U.S.P.Q.2d at 1668. Because Heinz has not provided sufficient evidence to show that its mark was famous before GFA Brands filed its intent-to-use applications in November, 2009, Heinz has not met the prerequisite for consideration of this factor. Accordingly, because the SMART ONES mark does not meet the dilution fame requirement, this factor also favors GFA Brands.

5. Any actual association between the mark or trade name and the famous mark.

This final factor also favors GFA Brands. Despite being marketed in the same stores, through the same channels of trade, and appearing in the very same stores, neither party is aware of any instances of actual consumer confusion between the SMART BALANCE mark and the SMART ONES mark -- or for that matter, *any other* product bearing the word “Smart,” including confusion between SMART BALANCE and SMART POP! unpopped popcorn and SMART BALANCE and SIMPLY SMART branded milk. (Kraft Tr. 15:2:6; 29:12-30:2)

Furthermore, after GFA Brands’ survey expert, Philip Johnson, concluded on the basis of his Eveready format survey that there is “no likelihood of confusion whatsoever about the use of the Smart Balance name as a name for frozen meal entrees that are sold in a supermarket or other places that sell frozen foods.” (Johnson Tr. 6:5-9 and Ex. 2; see also Johnson Tr. 55:2:20.) Mr. Johnson holds that opinion with certainty. (Id.) Thus, this factor, like the other five factors,

favors GFA Brands. Heinz's trademark dilution arguments fail on all elements of this final prong of the dilution test.

CONCLUSION

For the foregoing reasons, GFA Brands respectfully submits that Heinz has failed to carry its burden of proving a likelihood of confusion and dilution. The opposition should be dismissed with prejudice.

Dated this 16th day of September, 2013.

/s/ Johanna M. Wilbert
David R. Cross
Marta S. Levine
Johanna M. Wilbert
Quarles & Brady LLP
411 East Wisconsin Avenue, Suite 2040
Milwaukee, Wisconsin 53202-4497
Telephone: (414) 277-5495
Facsimile: (414) 978-8942
Email: DRC@quarles.com
Email: marta.levine@quarles.com
Email: jwilbert@quarles.com

*Attorneys for Applicant,
GFA Brands, Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing Applicant's Trial Brief was sent by First Class U.S. Mail, postage prepaid, with a courtesy copy via e-mail, on this 16th day of September, 2013, to Counsel for the Opposers listed below.

Timothy P. Fraelich
Angela R. Gott
JONES DAY
North Point
901 Lakeside Avenue
Cleveland, Ohio 44114-1190
tfraelich@jonesday.com
agott@jonesday.com

Kevin C. Meacham
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, Pennsylvania 15219-2514
kcmeacham@jonesday.com

/s/ Johanna M. Wilbert

Attorney for Applicant

APPENDIX A

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

PROMARK BRANDS INC. and H.J.
HEINZ COMPANY

**Opposition Nos. 91194974 (Parent)
and Opposition No. 91196358**

Opposers,

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

v.

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

GFA BRANDS, INC.,

Applicant.

**APPLICANT'S RESPONSE TO OPPOSERS' EVIDENTIARY OBJECTION AND IN
SUPPORT OF APPLICANT'S CONDITIONAL OBJECTION TO SABOL'S
TESTIMONY ABOUT JOHNSON'S SURVEY**

SUMMARY OF ARGUMENT

Heinz's Evidentiary Objections and requests to strike the expert report and testimony of Philip Johnson and portions of the testimony of Dr. Leon Kaplan and Philip Johnson should be denied. First, Heinz's arguments against the admissibility of Mr. Johnson's survey turn in part on a matter of semantics and on Heinz's confusion of the "rebuttal" phase of a TTAB trial with the concept of an expert report served under Rule 26(a)(2)(D)(ii) to "contradict or rebut" an opposing expert. While Mr. Johnson's survey certainly contradicts or rebuts the results of Dr. Sabol's survey, Mr. Johnson's survey is offered in GFA's *case-in-chief*, not in its rebuttal case. As the applicant, GFA Brands has no rebuttal trial period, only a period for its case-in-chief. Johnson's survey was disclosed entirely in accordance with all of the Board's scheduling requirements, is admissible, is not offered as part of the rebuttal phase of the trial and can be used to support GFA's argument of no likelihood of confusion.

Second, Mr. Johnson's testimony about Sabol's survey and in response to Sabol's testimony criticizing the Johnson survey, as well as Mr. Kaplan's testimony responding to Sabol's criticisms of the Johnson survey, should be admitted because the testimony was both justified and harmless. Mr. Johnson's testimony was disclosed in his discovery deposition in response to questions by Heinz's own lawyer, after which Heinz had more than sufficient time to prepare for Mr. Johnson's trial testimony covering the same ground. Furthermore, Heinz opened the door to Messrs. Johnson's and Kaplan's testimony by eliciting more than thirty pages of testimony from Sabol criticizing Mr. Johnson, without previously supplementing Sabol's expert report.

Finally, if for whatever reason the Board is inclined to grant Heinz's motion to strike Messrs. Kaplan's and Johnson's testimony addressing Sabol's 30 pages of direct trial testimony about the Johnson survey, Sabol's testimony should also be stricken.

I. CHOROLOGY OF EVENTS RELATED TO THIS MOTION.

Discovery opened on July 29, 2010. (TTABVUE Doc. No. 2 at 2.)¹ After a series of extensions requested at different times by both parties, the Board set the expert disclosure deadline for May 1, 2012, and also required GFA to disclose its first expert to Heinz by March 21, 2012. (TTABVUE Doc. No. 29.) GFA disclosed the report of its first expert, Leon Kaplan, to Heinz on March 16, 2012, and the survey of its second expert, Philip Johnson, to Heinz on April 28, 2012, satisfying both expert disclosure deadlines. (Opp. Br. at 3.) Both disclosures also occurred within the discovery period, which did not close until May 31, 2012. (TTABVUE Doc. No. 29.)

¹ Discovery for Opposition No. 91196358, which was later consolidated into Opposition No. 91194974, opened on November 11, 2010 (TTABVUE Opp. No. 91196358 Doc. No. 2 at 2.) The two oppositions were consolidated on January 27, 2011. (TTABVUE Doc. No. 11.)

Heinz did not notice Mr. Johnson's discovery deposition before May 31, 2012.

Discovery was reopened from June 21, 2012 through July 21, 2012 to allow Heinz to take additional expert discovery of Mr. Johnson. (TTABVUE Doc. No. 35.) On July 13, 2012 Heinz requested a 45 day extension to take the deposition of Mr. Johnson. (TTABVUE Doc. Nos. 36-37.) Ultimately, the parties agreed to extend the deadline for Opposers' pretrial disclosures until January 8, 2013, to allow Heinz to depose Mr. Johnson. (TTABVUE Doc. Nos. 43-44.)

Opposers took Mr. Johnson's discovery deposition on December 18, 2012 -- more than seven months after GFA disclosed the Johnson survey to Heinz. During that ample time, and despite acknowledging the opportunity to do so (TTABVUE Doc. No. 34, p. 2), Heinz decided not to prepare a responsive report to the Johnson survey. After Mr. Johnson's discovery deposition, Heinz had four more months to prepare to cross-examine Mr. Johnson during his trial testimony, which was not taken until April 18, 2013.

II. PHILIP JOHNSON'S SURVEY IS ADMISSIBLE, IS NOT BEING INTRODUCED DURING THE REBUTTAL TRIAL PHASE, AND MAY BE USED AS PROOF THAT CONFUSION IS NOT LIKELY.

Heinz's motion to exclude the Johnson survey and related testimony is pettifoggery disguised as an evidentiary objection. Heinz's argument that the Johnson survey is inadmissible in GFA's case-in-chief because it indisputably contradicts or rebuts Sabol's survey is nonsensical. The Johnson survey is not being offered in GFA's rebuttal case -- it is evidence that contradicts Sabol's survey and is being offered at the only point GFA can offer it -- in GFA's case-in-chief. GFA disclosed Mr. Johnson's survey to Heinz during the discovery period, not during the rebuttal trial period or any other phase of the trial. In fact, as applicant GFA is not entitled to a rebuttal period during the trial. All of GFA's evidence should be admissible to

support GFA's case-in-chief because that is GFA's only opportunity to present evidence -- in its case in chief.

The Board has drawn a "fine line" between the proper use of an *opposer's* evidence offered *in its rebuttal case* to bear on the validity and probative value of an applicant's survey, and the improper use of such evidence to support the *opposer's* case-in-chief. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 U.S.P.Q.2d 1618, 1625 at n. 33 (T.T.A.B. 1989). But in all such cases where the Board drew such a "fine line," the survey was proffered by the *opposer after discovery closed*. Here, by contrast, the Johnson survey was disclosed before the close of expert discovery and is offered in the *applicant's* case-in-chief, *not* in the rebuttal phase of the trial.

For example, in Helene Curtis, the plaintiff/opposer introduced a likelihood of confusion survey for the first time during its rebuttal trial period, in response to the defendant/applicant's survey that showed that the likelihood of confusion was very low. See *id.* Ultimately, the Board admitted the plaintiff's survey but determined that neither survey was credible, and in what appears to be *dicta* stated in a footnote that it limited the plaintiff's use of the survey to discredit the defendant's survey. *Id.* at 1626-27, n. 38. Similarly, in Bridgestone Firestone N.Am. Tire, LLC v. Federal Corp. 673 F.3d 1330 (Fed. Cir. 2012), the Board, citing the Helene Curtis footnote, admitted the opposer's likelihood of confusion survey, which opposer offered during its rebuttal trial period, to the extent the rebuttal survey bore on the validity and probative value of applicant's survey. See Opp. No. 91168556, 2010 WL985350, at *2 (T.T.A.B. Feb. 24, 2010)(nonprecedential), rev'd on other grounds 673 F.3d 1330 (Fed. Cir. 2012).

In the Board's recent decision in Sheetz of Delaware, Inc. v. Doctor's Associates Inc., the Board again admitted the opposer's survey because it bore on the validity and probative value of

the applicant's survey, but did not consider it for the primary issue in dispute of secondary meaning, citing the "fine line" language from the footnote, established in Helene Curtis. See Opp. No. 91192657, slip op. at *12 (T.T.A.B. Sept. 5, 2013)(precedential). Unlike the Johnson survey here, the survey was disclosed by the *opposer after discovery closed* and was introduced during the trial phase. See id. at *11.

In contrast, when an *applicant* disclosed during discovery a responsive survey under Rule 26(a)(2)(D)(ii), the Board did use the survey's results to support the applicant's case-in-chief, even though the survey was not initially disclosed along with the expert's first critique of the opposer's expert report. In AMBEV v. The Coca-Cola Company, as in the present case, the applicant's expert offered a first report critiquing the survey of the opposer's expert, and later prepared a survey report that was independent of the opposer's survey. See Opposition Nos. 91178953, et al., 2012 WL 1881492 at *2 (T.T.A.B. May 2, 2012) (nonprecedential).² The Board, again citing the Helene Curtis footnote, stated that would allow the applicant's survey because it sought to deny or discredit the opposer's survey. Id. Importantly, the Board also considered the survey for the purpose of supporting the applicant's case-in-chief on the issue of secondary meaning. Id. at *10-11. Referring to the applicant's secondary meaning survey, which had been prepared by Simonson, the Board wrote:

We find that the Simonson survey validates the significant sales and advertising numbers discussed above. Consumers have been exposed to TCCC's ZERO products and advertising on television, over the radio, via print media, and in every conceivable retail outlet. Billions of the products have been sold since 2004. Ambev's attempt to show that the ZERO marks have not acquired distinctiveness simply fails in light of the scope of TCCC's significant sales and marketing numbers.

Id. at 9 (emphasis added).

² All nonprecedential decisions of the TTAB discussed in this brief are cited for their persuasive value only.

Any reference that the Board in AMBEV or GFA's counsel in this case may have made to either the Simonson survey or Mr. Johnson's report as "rebuttal" evidence was mere semantics derived from the discovery Rule 26 reference to expert reports that "contradict or rebut" an opposer's expert. As with the survey in AMBEV, the Johnson survey that Heinz seeks to exclude is contradictory evidence that was properly disclosed well before the close of discovery and is properly offered in Applicant's cases-in-chief.

The underlying expert report that the Board analyzed in AMBEV is available on the TTABVUE website. The survey that the Board considered to be admissible evidence was entitled "A Test of Relevant Consumers to Determine the Level of Secondary Meaning of the Term 'Zero' as Part of a Name with Respect to Soft Drinks." (See AMBEV, TTABVUE Doc. 86, Ex. 2.) In the "background and purpose" statement of the AMBEV survey, the applicant's expert did not ever mention the opposing survey or expert. Rather, he stated that "[t]he law firm of King and Spalding commissioned Simonson Associates, Inc. to conduct a survey to determine the level of secondary meaning of the term ZERO as part of a name with respect to soft drinks." Id., at Ex. 2, p. 1. In fact, the applicant's expert in AMBEV never mentioned the opposer's survey at all in his survey report. Id. at Ex. 2.

Like the AMBEV study, Mr. Johnson's survey is admissible evidence based on its function, not based on any magic words in its title or the report's description of his work. Mr. Johnson used a title and task description that was very similar to the title and task description used by the expert in AMBEV.³ Like the AMBEV expert, Mr. Johnson did not need to entitle his survey in any particular way or mention the other party's survey because the entire survey

³ Mr. Johnson's report was titled "Promark Brands, Inc. (Opposer) vs. GFA Brands, Inc. (Applicant) A Study of Likelihood of Confusion. Mr. Johnson described his task in this way: "Counsel asked whether I could design and conduct a study that would measure the extent, if any, to which the Smart Balance name that has been objected to by ProMark, is or is not likely to cause confusion when relevant consumers are exposed to it in connection with frozen meal products. I agreed and proceeded to design and conduct such a study."

itself *functions* to contradict or rebut Sabol's survey by demonstrating that the deficiencies in Sabol's flawed survey yielded results much different than the results of a properly designed survey. Like the expert in AMBEV, Mr. Johnson did not discuss the opposers' expert in his report, but rather stated later in his trial testimony that he was asked to "design and conduct a survey that would essentially be in rebuttal" to Dr. Sabol's survey. (Johnson Tr. 4:17-22.) Providing a survey with different results is a perfectly acceptable way to "contradict or rebut" a flawed survey with different results presented by the other side.⁴

GFA did not "wait[] to prepare an expert report long after the deadline," as Heinz claims. (Opp. Br. at 7.) GFA disclosed the Johnson survey in accordance with the Board's scheduling order and in accordance with the applicable Federal Rules of Civil Procedure. Disclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2) unless alternate directions have been provided by the Board. 37 CFR §2.120(a)(2). Rule 26(a)(2)(D)(ii) requires that a party disclose expert testimony within 30 days of the other party's disclosure if the evidence is intended solely to "contradict or rebut" evidence on the same subject matter identified by another party.

As explained in the comments to §401.03 of the TTAB Manual of Procedure, parties to TTAB proceedings are not required to anticipate all expert testimony that may be used by their opponents. Confusion surveys, for example, are expensive and are not required of opposers, and many opposers do not commission them. But if an opposer does disclose a confusion survey, an applicant should be allowed to disclose and introduce in its case a survey that has contradictory results. See Rule 26(a)(2)(D)(ii); § 401.03 TBMP.

⁴ Despite Heinz's contention, GFA never said that it would not use the Johnson survey in its case-in-chief. (Opposer's Objections, App. A p. 3) GFA has only a case-in-chief trial phase, with no rebuttal phase, so any such statement is nonessential and was never made.

There is no unfairness in doing so. Heinz had ample opportunity to take discovery about the Johnson survey, prepare a responsive report of its own if it desired, and prepare a cross-examination of Johnson at trial. True unfairness would occur if, due to an overly restrictive view of the role of an applicant's responsive survey, a probative survey is ignored when it would have tipped the balance to a different end. This trial, as are all trials, is a search for the truth. When there is probative evidence that will fairly help achieve that goal, it should be considered. As the Federal Rules of Evidence state: "These rules should be construed so as to administer every proceeding fairly, eliminate unjustifiable expense and delay, and promote the development of evidence law, to the end of ascertaining the truth and securing a just determination." Rule 102, F.R.E. It follows that the Johnson survey should be admitted not simply to neutralize the Sabol survey but should also be considered as support for the ultimate conclusion -- there is no likelihood of confusion.

II. THE TESTIMONY OF MR. JOHNSON AND MR. KAPLAN IS ADMISSIBLE.

Heinz's motion directed to portions of the testimony of Philip Johnson criticizing Sabol's survey and portions of the testimony of Leon Kaplan supporting Johnson's survey methods and criticizing Sabol's survey should also be denied. The testimony of Messrs. Johnson and Kaplan is admissible because providing the testimony without amending their expert reports was substantially justified and harmless. Mr. Johnson's testimony is also admissible because the subject matter of the testimony was disclosed in his discovery deposition; by giving that testimony in his discovery deposition he functionally supplemented his earlier report.

The omissions of Mr. Kaplan's opinions supporting Mr. Johnson's survey, and Messrs. Kaplan's and Johnson's opinions discrediting Sabol's survey, from expert reports were substantially justified and harmless under the exceptions to the expert report supplementation

requirements set forth in Fed. R. Civ. P. 37(c)(1). Information not disclosed in an expert report may still be used at trial if the omission from the expert report was “substantially justified or is harmless.” Fed. R. Civ. P. 37(c). The Board considers five factors when determining whether an omission was substantially justified or harmless:

- (1) the surprise to the party against whom the witness was to have testified;
- (2) the ability of the party to cure that surprise;
- (3) the extent to which allowing the testimony would disrupt the trial;
- (4) the explanation for the party’s failure to name the witness before trial; and
- (5) the importance of the testimony.

See General Council of the Assemblies of God v. Heritage Music Foundation, 97 U.S.P.Q.2d 1890, 1892 (T.T.A.B. 2011), citing MicroStrategy, Inc. v. Business Objects, S.A., 429 F.3d 1344,1357, 77 U.S.P.Q.2d 1001 (Fed. Cir. 2005).

All of the applicable factors favor the admission of Messrs. Johnson’s and Kaplan’s testimony. First, Heinz could not have been surprised by Mr. Johnson’s testimony about Sabol’s survey or about Mr. Kaplan’s critique of that survey. In Mr. Johnson’s discovery deposition, he stated that in preparation for his discovery deposition, he reviewed Sabol’s report and Mr. Kaplan’s criticism of that report. (Opp. Not. of Rel. Ex. F at 6:22-25; 7:4-9.) Mr. Johnson went on to explain that he was asked to prepare a survey in response to Sabol’s survey, and in doing so he was unable to simply re-run the survey by correcting a few fatal flaws. Rather, the survey was so flawed that he had to “start from scratch with what I consider to be a true likelihood of confusion study in this matter.” Id., 10:9-11:2. Heinz could not have been surprised that Mr. Johnson criticized Sabol in his trial testimony because it was Heinz’s own attorney who initially asked Mr. Johnson, in his discovery deposition “what was wrong with Dr. Sabel’s [sic] survey?”,

“what was wrong with the universe?”, and “what were the other criticisms that you had?” Id., 11:3-16.

Additionally, Heinz could not have been surprised that either Messrs. Johnson or Kaplan offered a criticism of Sabol’s survey, or, in the case of Mr. Kaplan, validated the method used by Mr. Johnson, because Heinz elicited nearly thirty pages of trial testimony from Sabol, criticizing Mr. Johnson’s survey. (Sabol Tr. 67:9-92:10.) Nowhere in Sabol’s report did he so much as mention the Johnson survey. If this portion of Sabol’s testimony is allowed to stand, as Heinz no doubt believes it should, certainly Messrs. Kaplan’s and Johnson’s response to it should also be allowed.

The second factor also favors admissibility, because Heinz had every opportunity to cure any purported surprise. Heinz’s attorneys had the opportunity to question Mr. Johnson about his opinions on Sabol’s survey throughout his discovery deposition - and they did so. The Board has recently found that a party cannot be “surprised” by an expert (coincidentally, Phillip Johnson) when that party has more than a month to prepare between the disclosure of a topic by an opposing expert and the date of a deposition, particularly when that party’s own expert offers a critique of the opposing expert on that topic. See Sheetz of Delaware, Inc., at *12 (any surprise to applicant by opposer’s failure to give applicant technical notice of Mr. Johnson’s rebuttal survey was ameliorated by applicant having more than one month to prepare for Mr. Johnson’s deposition; moreover, applicant submitted the declaration of Dr. Cogan critiquing Mr. Johnson).

Heinz’s lawyers had *four* months to prepare to cross examine Mr. Johnson between the time they first asked him questions about his critique of Sabol’s survey during his discovery deposition on December 18, 2012 and the time Heinz’s lawyer cross examined Mr. Johnson during his trial testimony on April 18, 2013. Sabol also offered more than thirty pages of

critique of Mr. Johnson's survey, none of which had been included in Sabol's report or in any discovery deposition testimony. (Sabol Tr. 67:9-92:10.) Because Heinz was not surprised, there is no need to reopen discovery and disrupt trial at this point. It follows that the third factor also favors admissibility.

The fifth factor, which goes to the importance of the testimony, also favors the admissibility of both Messrs. Johnson's and Kaplan's testimony.⁵ While direct evidence of actual confusion such as misdirected letters or phone calls is the best evidence of likelihood of confusion, see e.g. Thompson v. Haynes, 305 F.3d 1369, 64 U.S.P.Q.2d 1650 (Fed. Cir. 2002) (“[T]he best evidence of a likelihood of confusion in the marketplace is actual confusion.”)(citations omitted), evidence of actual confusion is not available in cases such as this where the applicant has not yet begun marketing its products under the mark. In such cases, survey evidence allows the fact finder to “make informed inferences about the likelihood of confusion that will take place.” See McCarthy §32:184.

GFA's products have not yet been marketed in the frozen food section under the SMART BALANCE mark, making a properly performed survey important evidence about whether there is a likelihood of confusion. Without criticisms of the survey evidence -- by experts from both parties for that matter -- the Board could be left to determine the merits of competing surveys in a vacuum. Allowing the experts to critique the other side's surveys will aid the Board's analysis of the merits of each party's arguments. Thus, the fifth and final factor also favors the admission of both Mr. Johnson's and Mr. Kaplan's testimony.

Mr. Johnson's testimony criticizing Sabol's report is also admissible because the subject matter of that testimony was disclosed to Heinz through its own lawyer's questioning during Mr.

⁵ The fourth factor, which seeks an explanation for a party's failure to name a witness before trial is not applicable here.

Johnson's discovery deposition. The Advisory Committee Notes to Rule 26(e) explain that there is "no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition or when an expert during a deposition corrects information contained in an earlier report." See Fed.R.Civ.P. 26, Advisory Committee Note (1993 Amendments, Subdivision (e)). The Board has also held that "there is no need, as a matter of course, to submit a supplemental disclosure to include information already revealed by a witness in a deposition or otherwise through formal discovery, including the identity of the witness." General Council of the Assemblies of God, 97 U.S.P.Q.2d. at 1861. As discussed above, Mr. Johnson provided criticisms of Sabol's survey in his discovery deposition, effectively supplementing his earlier report.

CONCLUSION

The disclosure rules were not intended to provide opportunities for one party to find procedural deficiencies or technical failures upon which to obtain an advantage over its adversary. General Council of the Assemblies of God, 97 U.S.P.Q.2d at 1893 (T.T.A.B. 2011). Parties are discouraged from filing objections -- such as Heinz's objections in this case -- that are not outcome determinative. See Rule 707.03(a), see also Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc., 77 U.S.P.Q.2d 1492, 1501 (T.T.A.B. 2005). Heinz opened the door to survey evidence by disclosing and then relying upon Sabol's survey in its case-in-chief. GFA then disclosed the Johnson survey well before the close of expert in discovery under Rule 26(a)(2)(D)(ii) and in accordance with the schedule set by the Board, "to contradict or rebut" Sabol's flawed survey. Heinz had ample opportunity to and did take discovery about Johnson's

survey. GFA now offers the Johnson survey in its case-in-chief, where the Board can and should use it for all purposes, as it did in AMBEV.

Similarly, Heinz opened the door for Mr. Johnson to criticize Sabol's survey, and for Mr. Kaplan to buttress Mr. Johnson's survey by providing more than thirty pages of previously undisclosed criticism of Johnson's survey during Sabol's trial testimony. Ultimately, such criticisms by both sides allow the Board to make an informed determination about which survey deserves the most weight when analyzing whether there is a likelihood of confusion. Mr. Johnson's survey and the testimony of both of GFA's survey experts provide important information for the Board. The Johnson survey and the testimony of both of GFA's experts are admissible as proper and timely evidence in GFA's case-in-chief. Heinz's evidentiary objections should be denied.

If for whatever reason the Board is inclined to grant Heinz's motion to strike Messrs. Kaplan's and Johnson's testimony addressing Sabol's criticism of the Johnson survey, then Sabol's testimony on this point should also be stricken.

Dated this 16th day of September, 2013.

/s/ Johanna M. Wilbert _____
David R. Cross
Marta S. Levine
Johanna M. Wilbert
Quarles & Brady LLP
411 East Wisconsin Avenue, Suite 2040
Milwaukee, Wisconsin 53202-4497
Telephone: (414) 277-5495
Facsimile: (414) 978-8942
Email: DRC@quarles.com
Email: marta.levine@quarles.com
Email: jwilbert@quarles.com

*Attorneys for Applicant,
GFA Brands, Inc.*

APPENDIX B

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

PROMARK BRANDS INC., & H.J.
HEINZ COMPANY,

**Opposition Nos. 91194974 (Parent)
and Opposition No. 91196358**

Opposers,

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

v.

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

GFA BRANDS, INC.,

Applicant.

APPLICANT'S EVIDENCE OF RECORD

I. APPLICANT'S TESTIMONY DEPOSITIONS

A. William E. Hooper, Senior Advisor to the Marketing Groups and Board Member of GFA Brands, taken on April 12, 2013, and filed with the Board on September 13, 2013 (including public and confidential portions), including Applicant's Exhibits 1-18 and Opposers' Exhibits 48-53

Public Exhibits:

App's Exhibit 1	U.S. Registration No. 2,200,663 for SMART BALANCE, and TSDR Status Info
App's Exhibit 2	Photos of SMART BALANCE product packaging for goods and services for Reg. No. 2,200,663, GFA000069, GFA000174, GFA000188-189, GFA000075, GFA000205, GFA000206, GFA000088, GFA000171, GFA000120, GFA000144-145, GFA000153-154, GFA000194
App's Exhibit 3	U.S. Registration No. 2,276,285 for SMART BALANCE, and TSDR Status Info
App's Exhibit 4	Photos of SMART BALANCE product packaging for goods and services for Reg. No. 2,276,285, GFA000082, GFA000201-204
App's Exhibit 5	U.S. Registration No. 2,952,127 for SMART BALANCE, and TSDR Status Info
App's Exhibit 6	Photos of SMART BALANCE product packaging for goods and services for Reg. No. 2,952,127, GFA000079, GFA000081, GFA000084, GFA000220, GFA000217-219

App's Exhibit 7	U.S. Registration No. 3,649,833 for SMART BALANCE, and TSDR Status Info
App's Exhibit 8	Photos of SMART BALANCE product packaging for goods and services for Reg. No. 3,649,833, GFA000073, GFA000077, GFA000214, GFA000216, GFA000213, GFA000215
App's Exhibit 9	U.S. Registration No. 3,865,917 for SMART BALANCE, and TSDR Status Info
App's Exhibit 10	Photos of SMART BALANCE product packaging for goods and services for Reg. No. 3,865,917, GFA000085, GFA000134-135, GFA000086, GFA000162, GFA000087, GFA000160-161,
App's Exhibit 12	Draft advertisement for SMART BALANCE product, GFA000003
App's Exhibit 14	Advertisement circular with coupons for SMART BALANCE products, GFA000017
App's Exhibit 15	Advertisement circular with coupon for SMART BALANCE product, GFA000014
App's Exhibit 16	Advertisement circular with coupon for SMART BALANCE products, GFA000018
Opprs' Exhibit 48	TESS printout for Ser. No. 77864305, SMART BALANCE
Opprs' Exhibit 49	Store Circular showing SMART BALANCE product GFA021855
Opprs' Exhibit 50	Store Circular showing SMART BALANCE product GFA023564

Confidential Exhibits:

App's Exhibit 11	Gross Sales, Total Marketing and Total Trade Spend for SMART BALANCE mark GFASB022353
App's Exhibit 13	Total Media Spend 2007-2011 SMART BALANCE Deliveries GFA043236-37
App's Exhibit 17	SMART BALANCE Tracking Research, Wave 7 Tracking Full Report, December 13, 2010, GFA014065-GFA014182
App's Exhibit 18	SMART BALANCE RD Survey Results, June 20, 2009, GFA043239-GFA043272
Opprs' Exhibit 51	3/30/2010 E-mail attaching Project Best Life Landscape Omnibus Frozen Meals and Meal Replacements Full Report, March 29, 2009 GFA047579-GFA047607
Opprs' Exhibit 52	2/8/2010 E-mail re: frozen meals GFA028226-27
Opprs' Exhibit 53	SMART BALANCE Brand Extension Program presentation, February 3, 2010, GFA014829-GFA014987

B. Philip Johnson, Chief Executive Officer of Leo J. Shapiro & Associates and GFA Brands’ survey expert, taken on April 18, 2013, and filed with the Board on September 13, 2013, including Applicant’s Exhibits 1-5

Public Exhibits:

App’s Exhibit 1	H.J. Heinz Company Likelihood of Brand Confusion Between Smart Ones and Smart Balance Resulting from the Introduction of Smart Balance Frozen Meals, A Brand Confusion Survey, December 2011
App’s Exhibit 2	LJS Strategic Research, A Study of Likelihood of Confusion, April 2012, by Philip Johnson
App’s Exhibit 3	Philip Johnson, Curriculum Vitae
App’s Exhibit 4	“Critique of Likelihood of Brand Confusion Between Smart Ones and Smart Balance Resulting from the Introduction of Smart Balance Frozen Meals,” by Leon B. Kaplan
App’s Exhibit 5	Notice of Opposition, No. 91194974, filed 5/20/2010, ProMark Brands, Inc., Opposer v. GFA Brands, Inc., Applicant.

C. Timothy Kraft, Senior Vice-President, Associate General Counsel at GFA Brands, taken on April 26, 2013, and filed with the Board on September 13, 2013, including Applicant’s Exhibits 70-76

Public Exhibits:

App’s Exhibit 70	Photo of Simply Smart milk, GFA043166
App’s Exhibit 71	Photo of SMART BALANCE and Simply Smart milk products, GFA043120
App’s Exhibit 72	Photo of Kellogg’s SMART START, GFA043169
App’s Exhibit 73	Photo of Smartwater bottle, GFA043152
App’s Exhibit 74	Photo of Orville Redenbacher’s SMART POP! popcorn, GFA043172
App’s Exhibit 75	Photo of Heart Smart Bisquick, GFA043153

Confidential Exhibits:

App’s Exhibit 76	SMART BALANCE Brand Extension Program presentation, February 3, 2010, GFA014829-GFA014987
------------------	---

D. Leon Kaplan, President and CEO at Princeton Research and Consulting Center and GFA Brands’ survey expert, taken on April 23, 2013, and filed with the Board on September 13, 2013, including Opposers’ Exhibits 1-2

Public Exhibits:

Opprs’ Exhibit 1	<i>Weight Watchers Int’l, Inc., v. Stouffer Corp.</i> , 744 F. Supp. 1259, 19 U.S.P.Q. 2d 1321 (S. D. N.Y. Aug. 30, 1990)
Opprs’ Exhibit 2	<i>Weight Watchers Int’l, Inc., v. Stouffer Corp.</i> , 744 F. Supp. 1259, 19 U.S.P.Q. 2d 1321 (S. D. N.Y. Oct 12, 1990)

E. William Shanks, Investigations Manager and Designated Lead Investigator at Marksmen, Inc., taken on April 23, 2013, and filed with the Board on September 13, 2013, including Applicant’s Exhibits 6-13

Public Exhibits:

App’s Exhibit 6	Marksmen Report, July 15, 2011, GFA043139-GFA043143
App’s Exhibit 7	Marksmen Report documentation and spreadsheet, GFA043131-GFA043136
App’s Exhibit 8	Marksmen Report photos, GFA043108-GFA043124
App’s Exhibit 9	Marksmen Report, July 13, 2011, GFA043205-GFA043206
App’s Exhibit 10	Marksmen Investigative Report, June 30, 2011, GFA043187-GFA043192
App’s Exhibit 11	Photos of products purchased, GFA043145-GFA043160
App’s Exhibit 12	Photos of products purchased, GFA043161-GFA043173
App’s Exhibit 13	Photos of products purchased, GFA043174-GFA043185

II. GFA’S NOTICE OF RELIANCE

App’s Not. of Rel. Ex. 1	Trademark Status and Document Retrieval (“TSDR”) document for Applicant’s SMART BALANCE mark, Registration No. 2200663, showing a status as renewed as of May 9, 2009 (printed April 2, 2013) and indicating Applicant as the Current Owner
App’s Not. of Rel. Ex. 2	TSDR document for Applicant’s SMART BALANCE mark, Registration No. 2276285, showing a status as renewed as of September 16, 2009 (printed April 2, 2013) and indicating Applicant as the Current Owner

App's Not. of Rel. Ex. 3	TSDR document for Applicant's SMART BALANCE mark, Registration No. 2952127, showing a status as "Sections 8 and 15 combined declaration has been accepted and acknowledged" as of July 13, 2010 (printed April 2, 2013) and indicating Applicant as the Current Owner
App's Not. of Rel. Ex. 4	TSDR document for Applicant's SMART BALANCE mark, Registration No. 3649833, showing a status as registered as of July 7, 2009 (printed April 2, 2013) and indicating Applicant as the Current Owner
App's Not. of Rel. Ex. 5	TSDR document for Applicant's SMART BALANCE mark, Registration No. 3747526, showing a status as registered as of February 9, 2010 (printed April 2, 2013) and indicating Applicant as the Current Owner
App's Not. of Rel. Ex. 6	TSDR document for Applicant's SMART BALANCE mark, Registration No. 3865917, showing a status as registered as of October 19, 2010 (printed April 2, 2013) and indicating Applicant as the Current Owner
App's Not. of Rel. Ex. 7	TSDR document for Applicant's SMART BALANCE mark, Registration No. 3958463, showing a status as registered as of May 10, 2011 (printed April 2, 2013) and indicating Applicant as the Current Owner
App's Not. of Rel. Ex. 8	TSDR document for BISQUICK HEART SMART, a third-party registration, Registration No. 3140426
App's Not. of Rel. Ex. 9	TSDR document for HEART SMART, a third-party registration, Registration No. 3945900
App's Not. of Rel. Ex. 10	TSDR document for PLUMSMART, a third-party registration, Registration No. 2916503
App's Not. of Rel. Ex. 11	TSDR document for SIMPLY SMART, a third-party registration, Registration No. 2338871
App's Not. of Rel. Ex. 12	TSDR document for SMART DELI, a third-party registration, Registration No. 2773155
App's Not. of Rel. Ex. 13	TSDR document for SMART DOGS, a third-party registration, Registration No. 2686279
App's Not. of Rel. Ex. 14	TSDR document for SMART POP, a third-party registration, Registration No. 1874796
App's Not. of Rel. Ex. 15	TSDR document for SMART SAUSAGES, a third-party registration, Registration No. 3522138
App's Not. of Rel. Ex. 16	TSDR document for SMART START, a third-party registration, Registration No. 1555954
App's Not. of Rel. Ex. 17	TSDR document for GLACÉAU SMARTWATER, a third-party registration, Registration No. 3420245
App's Not. of Rel. Ex. 18	TSDR document for SMARTFOOD, a third-party registration, Registration No. 1367966

App's Not. of Rel. Ex. 19	TSDR document for SMARTNOURISH, a third-party registration, Registration No. 4183609
App's Not. of Rel. Ex. 20	TSDR document for SMART TASTE, a third-party registration, Registration No. 3592893
App's Not. of Rel. Ex. 21	TSDR document for SNACK SMART, a third-party registration, Registration No. 2107921
App's Not. of Rel. Ex. 22	General Mills' (http://www.generalmills.com/en/Brands/Baking_Products/Bisquick.aspx) and Betty Crocker's (http://www.bettycrocker.com/products/bisquick/products/bisquick_heart_smart) websites as of April 22, 2013
App's Not. of Rel. Ex. 23	Prego's website (http://www.prego.com/products/healthy-and-delicious/heart-smart-traditional) as of April 22, 2013
App's Not. of Rel. Ex. 24	Plum Smart's website (http://www.plumsmart.net/) as of April 22, 2013
App's Not. of Rel. Ex. 25	HP Hood LLC's website (http://www.hood.com/Products/prodListColl.aspx?id=862) as of April 22, 2013
App's Not. of Rel. Ex. 26	Lightlife Foods' website (http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Smart-Deli-Turkey) as of April 23, 2013
App's Not. of Rel. Ex. 27	Lightlife Foods' website (http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Veggie-Hot-Dogs) as of April 22, 2013
App's Not. of Rel. Ex. 28	Orville Redenbacher's website (http://www.orville.com/healthy-microwave-popcorn-smartpop) as of April 22, 2013
App's Not. of Rel. Ex. 29	Lightlife Foods' website (http://www.lightlife.com/Vegan-Food-Vegetarian-Diet/Smart-Sausages-Italian-Style) as of April 22, 2013
App's Not. of Rel. Ex. 30	Kellogg Co.'s website (http://www.kelloggs.com/en_US/SmartStart.html) as of April 22, 2013
App's Not. of Rel. Ex. 31	Glaceau's website (http://www.glaceau.com/) as of April 22, 2013
App's Not. of Rel. Ex. 32	Smartfood, Inc.'s website (http://www.smartfood.com) as of April 23, 2013
App's Not. of Rel. Ex. 33	Gerber's website (http://www.gerber.com/allstages/products/puree_baby_food/2nd_foods_purees_vegetable_risotto.aspx) as of April 22, 2013
App's Not. of Rel. Ex. 34	New World Pasta Company's website (http://ronzonismarttaste.newworldpasta.com/pasta_story.cfm) as of April 22, 2013
App's Not. of Rel. Ex. 35	Little Debbie's website (http://www.littledebbie.com/products/bars.asp) as of April 23, 2013
App's Not. of Rel. Ex. 36	Amazon.com, Inc.'s website American Diabetes Association and CanolaInfo, The Heart-Smart Diabetes Kitchen: Fresh, Fast, and Flavorful Recipes Made with Canola Oil, 2009, http://www.amazon.com/Heart-Smart-Diabetes-Kitchen-Flavorful-Recipes/dp/158040331X/ref=sr_1_24?s=books&ie=UTF8&qid=1364934746&sr=1-24 (accessed and printed on April 15, 2013)

App's Not. of Rel. Ex. 37	Amazon.com, Inc.'s website, Kathy Smart, Live the Smart Way: Gluten Free Cookbook, 2011, http://www.amazon.com/Live-Smart-Way-Gluten-Cookbook/dp/0987700308/ref=sr_1_45?s=books&ie=UTF8&qid=1364934872&sr=1-45 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 38	Amazon.com, Inc.'s website, Bettina Newman R.D., Lose Weight the Smart Low-Carb Way: 200 High-Flavor Recipes and a 7-Step Plan to Stay Slim Forever (Prevention Health Cooking), 2002, http://www.amazon.com/Lose-Weight-Smart-Low-Carb-Way/dp/B003D7JXIC/ref=sr_1_66?s=books&ie=UTF8&qid=1364935099&sr=1-66 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 39	Amazon.com, Inc.'s website, Margaret Pfeiffer, Smart 4 Your Heart Four Simple Ways To Easily Manage Your Cholesterol, 2009, http://www.amazon.com/Smart-simple-easily-manage-cholesterol/dp/0979962625/ref=sr_1_84?s=books&ie=UTF8&qid=1364935190&sr=1-84 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 40	Amazon.com, Inc.'s website, Mika Shino, Smart Bites for Baby: 300 Easy-to-Make, Easy-to-Love Meals that Boost Your Baby and Toddler's Brain, 2012, http://www.amazon.com/Smart-Bites-Easy---Make--Love/dp/0738215554/ref=sr_1_4?s=books&ie=UTF8&qid=1364934424&sr=1-4 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 41	Amazon.com, Inc.'s website, Sandra Woodruff, Smart Bread Machine Recipes: Healthy, Whole Grain & Delicious, 1994, http://www.amazon.com/Smart-Bread-Machine-Recipes-Delicious/dp/0806906901/ref=sr_1_11?s=books&ie=UTF8&qid=1364934424&sr=1-11 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 42	Amazon.com, Inc.'s website, Jane Kinderlehrer, Smart Chicken: 101 Tasty and Healthy Poultry Dishes, Plus Stuffings and Accompaniments, 1991, http://www.amazon.com/Smart-Chicken-Stuffings-Accompaniments-Kinderlehrer/dp/1557040737/ref=sr_1_93?s=books&ie=UTF8&qid=1364935526&sr=1-93 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 43	Amazon.com, Inc.'s website, Jane Kinderlehrer, Smart Cookies: 80 Recipes for Heavenly, Healthful Snacking, 1985, http://www.amazon.com/Smart-Cookies-Heavenly-Healthful-Snacking/dp/0937858625/ref=sr_1_101?s=books&ie=UTF8&qid=1364935587&sr=1-101 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 44	Amazon.com, Inc.'s website, Covert Bailey and Ronda Gates, Smart Eating: Choosing Wisely, Living Lean, 1996, http://www.amazon.com/Smart-Eating-Choosing-Wisely-Living/dp/039585492X/ref=sr_1_14?s=books&ie=UTF8&qid=1364934424&sr=1-14 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 45	Amazon.com, Inc.'s website, Jane Ibbetson, Smart Eating Made Simple, 2012, http://www.amazon.com/Smart-Eating-Made-Simple-Ibbetson/dp/1468566598/ref=sr_1_49?s=books&ie=UTF8&qid=1364934966&sr=1-49 (accessed and printed on April 16, 2013)

App's Not. of Rel. Ex. 46	Amazon.com, Inc.'s website, Carol Heading Munson, Smart Pressure Cooker Recipes, 1998, http://www.amazon.com/Pressure-Cooker-Recipes-Heading-Munson/dp/0806999853/ref=sr_1_40?s=books&ie=UTF8&qid=1364935432&sr=1-40 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 47	Barnesandnoble.com LLC's website, Mary Curtis, Eat Smart: Low - Fat Vegetarian CookBook, 2007, http://www.barnesandnoble.com/w/eat-smart-mrs-mary-curtis/1112402492?ean=9781257681631&itm=1&usri=9781257681631 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 48	Barnesandnoble.com LLC's website, Kate Wood, Eat Smart, Eat Raw: Creative Vegetarian Recipes for a Healthier Life, 2006, http://www.barnesandnoble.com/w/eat-smart-eat-raw-kate-wood/1113943087?ean=9780757002618&itm=1&usri=9780757002618 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 49	Barnesandnoble.com LLC's website, Graham Kerr, Graham Kerr's Smart Cooking, 1991, http://www.barnesandnoble.com/w/graham-kerrs-smart-cooking-graham-kerr/1000078238?ean=9780385420747&itm=1&usri=9780385420747 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 50	Barnesandnoble.com LLC's website, Maya Angelou, Great Food, All Day Long: Cook Splendidly, Eat Smart, 2010, http://www.barnesandnoble.com/w/great-food-all-day-long-maya-angelou/1100300048?ean=9780679604372&itm=1&usri=9780679604372 (accessed and printed on April 16, 2013)
App's Not. of Rel. Ex. 51	Barnesandnoble.com LLC's website, Henry Ford and Heart and Vascular Inst. Staff, Heart Smart Cookbook, 1994, http://www.barnesandnoble.com/w/heart-smart-cookbook-henry-ford/1015887423?ean=9780836280593&itm=1&usri=9780836280593 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 52	Barnesandnoble.com LLC's website, JoAnna M. Lund, The Heart Smart Healthy Exchanges Cookbook, 1999, http://www.barnesandnoble.com/w/heart-smart-healthy-exchanges-cookbook-joanna-m-lund/1100170456?ean=9780399524745&itm=1&usri=9780399524745 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 53	Barnesandnoble.com LLC's website, Julie Van Rosendaal, One Smart Cookie: All Your Favorite Cookies, Squares, Brownies and Biscotti...With Less Fat, 2007, http://www.barnesandnoble.com/w/one-smart-cookie-julie-van-rosendaal/1101996996?ean=9781552859124&itm=1&usri=9781552859124 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 54	Barnesandnoble.com LLC's website, Jane Kinderlehrer, Smart Baking Cookbook: Muffins, Cookies, Biscuits and Breads, 2002, http://www.barnesandnoble.com/w/smart-baking-cookbook-jane-kinderlehrer/1102505558?ean=9781557045225&itm=1&usri=9781557045225 (accessed and printed on April 17, 2013)

App's Not. of Rel. Ex. 55	Barnesandnoble.com LLC's website, Better Homes & Gardens, Smart Diet, 2000, http://www.barnesandnoble.com/w/smart-diet-better-homes-gardens/1008404626?ean=9780696211737&itm=1&usri=9780696211737 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 56	Barnesandnoble.com LLC's website, Alisa Fleming, SMART SCHOOL TIME RECIPES: The Breakfast, Snack, and Lunchbox Cookbook for Healthy Kids and Adults, 2010, http://www.barnesandnoble.com/w/smart-school-time-recipes-alisa-fleming/1026901529?ean=9780979128639&itm=1&usri=9780979128639 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 57	Barnesandnoble.com LLC's website, Andrew Rainier, The Smart Carb Diet Recipes, 2012, http://www.barnesandnoble.com/w/the-smart-carb-diet-recipes-andrew-rainier/1111647528?ean=9781105775802&itm=1&usri=9781105775802 (accessed and printed on April 17, 2013)
App's Not. of Rel. Ex. 58	Photo of BISQUICK HEART SMART product packaging
App's Not. of Rel. Ex. 59	Photo of HEART SMART product packaging
App's Not. of Rel. Ex. 60	Photo of PLUMSMART product packaging
App's Not. of Rel. Ex. 61	Photo of SIMPLY SMART product packaging
App's Not. of Rel. Ex. 62	Photo of SMART DELI product packaging
App's Not. of Rel. Ex. 63	Photo of SMART POP product packaging
App's Not. of Rel. Ex. 64	Photo of SMART START product packaging
App's Not. of Rel. Ex. 65	Photo of GLACÉAU SMARTWATER product packaging
App's Not. of Rel. Ex. 66	Photo of SMARTFOOD product packaging
App's Not. of Rel. Ex. 67	Photo of SMARTNOURISH product packaging
App's Not. of Rel. Ex. 68	Photo of SMART TASTE product packaging
App's Not. of Rel. Ex. 69	Photo of SNACK SMART product packaging
App's Not. of Rel. Ex. 70	Deposition of Marion Findlay, attached hereto as Exhibit 70, conducted on January 17, 2012 and exhibits nos. 1 through 11 thereto

APPENDIX C

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

PROMARK BRANDS INC. and H.J.
HEINZ COMPANY

**Opposition Nos. 91194974 (Parent)
and Opposition No. 91196358**

Opposers,

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**

v.

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**

GFA BRANDS, INC.,

Applicant.

APPENDIX OF CASES THAT DO NOT APPEAR IN THE U.S.P.Q.

Coach Servs. Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010); affd' 668 F.3d 1356 (Fed. Cir. 2012)

Companhia de Bebidas das Américas – Ambev v. The Coca Cola Co., Opposition No. 91178953, 2012 WL 1881492 (T.T.A.B. May 2, 2012)

IN-N-OUT Burgers v. Fast Lane Car Wash & Lube, Opposition No. 91183888, 2013 WL 3188897 (T.T.A.B. Mar. 14, 2013)

Nat'l Football League Properties, Inc. v. Prostyle, Inc. 57 F. Supp. 2d 665 (E.D. Wis. 1998)

Red Bull Gmbh v. Carl Cochran, Opposition No. 91152588, 2004 WL 2368486 (T.T.A.B. Sept. 29, 2004)

Societe Des Produits Nestle S.A. v. Midwestern Pet Foods, Inc., Opposition No. 91163853, 2011 WL 1495460 (T.T.A.B. March 31, 2011); affd' 685 F.3d 1046 (Fed. Cir. July 9, 2012)

Virgin Enterprises LTD. v. Moore, Opposition No. 91192733, 2012 WL 3992908 (T.T.A.B.

Aug. 31, 2012) Dated this 16th day of September, 2013.

/s/ Johanna M. Wilbert
David R. Cross
Marta S. Levine
Johanna M. Wilbert
Quarles & Brady LLP
411 East Wisconsin Avenue, Suite 2040
Milwaukee, Wisconsin 53202-4497
Telephone: (414) 277-5495
Facsimile: (414) 978-8942
Email: DRC@quarles.com
Email: marta.levine@quarles.com
Email: jwilbert@quarles.com

*Attorneys for Applicant,
GFA Brands, Inc.*

668 F.3d 1356

United States Court of Appeals,
Federal Circuit.

COACH SERVICES, INC., Appellant,
v.
TRIUMPH LEARNING LLC, Appellee.

No. 2011–1129. | Feb. 21, 2012.

Synopsis

Background: Holder of “COACH” mark appealed from decision of the United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2010 WL 3798519, dismissing its opposition to use-based applications to register mark “COACH” for educational materials used to prepare students for standardized tests.

Holdings: The Court of Appeals, O’Malley, Circuit Judge, held that:

[1] Board’s decision to exclude public corporation’s annual reports was not abuse of discretion;

[2] test preparation company’s use of mark was not likely to cause confusion;

[3] opposer failed to establish that its “COACH” mark for fashion accessories was famous for dilution purposes;

[4] opposer had standing to challenge company’s use of mark;

[5] substantial evidence supported Board’s decision that company’s use of mark was merely descriptive; and

[6] remand was warranted so Board could assess whether term had acquired secondary meaning.

Affirmed in part, vacated in part, and remanded.

West Headnotes (36)

[1] Trademarks

🔑 Scope of review

[382T Trademarks](#)
[382TVII Registration](#)
[382TVII\(B\) Proceedings Concerning Federal Registration](#)
[382Tk1315 Judicial Review or Intervention](#)
[382Tk1322 Scope of review](#)
Court of Appeals reviews Trademark Trial and Appeal Board’s legal conclusions de novo and its factual findings for substantial evidence.

[2] Trademarks

🔑 Scope of review

[382T Trademarks](#)
[382TVII Registration](#)
[382TVII\(B\) Proceedings Concerning Federal Registration](#)
[382Tk1315 Judicial Review or Intervention](#)
[382Tk1322 Scope of review](#)
Court of Appeals reviews evidentiary rulings by Trademark Trial and Appeal Board for abuse of discretion, and will reverse only if Board’s evidentiary ruling was: (1) clearly unreasonable, arbitrary, or fanciful; (2) based on erroneous conclusion of law; (3) premised on clearly erroneous findings of fact; or (4) record contains no evidence on which Board could rationally base its decision.

[3] Trademarks

🔑 Admissibility

[382T Trademarks](#)
[382TVII Registration](#)
[382TVII\(B\) Proceedings Concerning Federal Registration](#)
[382Tk1306 Evidence](#)
[382Tk1309 Admissibility](#)
Trademark Trial and Appeal Board’s decision to exclude public corporation’s annual reports as evidence of its annual sales figures and amount it expended in advertising, design, and promotion of its trademarked products was not abuse of discretion, even though reports were available on internet, where rule in effect at time of hearing precluded admission of corporate annual reports without authentication, corporation’s witness was not shown annual reports during her deposition and did not authenticate documents at issue, and documents

lacked identifying information such as online source and date accessed. 37 C.F.R. § 2.122(e).

[4] Trademarks

🔑 Scope of review

382T Trademarks

382TVII Registration

382TVII(B) Proceedings Concerning Federal Registration

382Tk1315 Judicial Review or Intervention

382Tk1322 Scope of review

Although Court of Appeals reviews Trademark Trial and Appeal Board's findings as to *DuPont* factors regarding likelihood of confusion in trademark infringement suit for substantial evidence, it reviews its overall determination of likelihood of confusion without deference. Lanham Act, § 2(d), 15 U.S.C.A. § 1052(d).

2 Cases that cite this headnote

[5] Trademarks

🔑 Strength or fame of marks; degree of distinctiveness

Trademarks

🔑 Appearance, sound, and meaning

Trademarks

🔑 Particular goods and services, relationship between

Trademarks

🔑 Trade channels; sales, advertising, and marketing

Trademarks

🔑 Persons confused; circumstances of sale

382T Trademarks

382TIII Similarity Between Marks; Likelihood of Confusion

382Tk1090 Nature of Marks

382Tk1092 Strength or fame of marks; degree of distinctiveness

382T Trademarks

382TIII Similarity Between Marks; Likelihood of Confusion

382Tk1093 Relationship Between Marks

382Tk1098 Appearance, sound, and meaning

382T Trademarks

382TIII Similarity Between Marks; Likelihood of Confusion

382Tk1100 Relationship Between Goods or Services Underlying Marks

382Tk1103 Particular goods and services, relationship between

382T Trademarks

382TIII Similarity Between Marks; Likelihood of Confusion

382Tk1107 Nature and Circumstances of Use of Marks

382Tk1110 Trade channels; sales, advertising, and marketing

382T Trademarks

382TIII Similarity Between Marks; Likelihood of Confusion

382Tk1112 Persons confused; circumstances of sale

Test preparation company's use of mark "COACH" for educational materials used to prepare students for standardized tests was not likely to cause confusion as to luxury good manufacturer's prior use of "COACH" mark for fashion accessories, and thus mark could be registered, even though prior mark was famous, marks were identical in sound and appearance, and classes of consumers might overlap, where prior mark brought to mind traveling by carriage, and applied-for mark brought to mind someone who instructed students, parties' goods were unrelated, and channels of trade were distinct. Lanham Act, § 2(d), 15 U.S.C.A. § 1052(d).

[6] Trademarks

🔑 Levels or categories of distinctiveness in general; strength of marks in general

382T Trademarks

382TII Marks Protected

382Tk1033 Levels or categories of distinctiveness in general; strength of marks in general

"Famous" mark is one that has extensive public recognition and renown. Lanham Act, § 2(d), 15 U.S.C.A. § 1052(d).

[7] Trademarks

🔑 Levels or categories of distinctiveness in general; strength of marks in general

382T Trademarks

382TII Marks Protected

[382Tk1033](#) Levels or categories of distinctiveness in general; strength of marks in general
In determining mark's fame, relevant factors include sales, advertising, length of use of mark, market share, brand awareness, licensing activities, and variety of goods bearing mark. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[8] Trademarks

 [Presumptions and burden of proof](#)

[382T](#) Trademarks
[382TVII](#) Registration
[382TVII\(B\)](#) Proceedings Concerning Federal Registration
[382Tk1306](#) Evidence
[382Tk1308](#) Presumptions and burden of proof
Party asserting that its mark is famous has burden to prove it. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[9] Trademarks

 [Strength or fame of marks; degree of distinctiveness](#)

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1090](#) Nature of Marks
[382Tk1092](#) Strength or fame of marks; degree of distinctiveness
Fame of prior mark is insufficient, standing alone, to establish likelihood of confusion precluding registration of mark. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[1 Cases that cite this headnote](#)

[10] Trademarks

 [Examination and comparison; construction as entirety](#)

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1093](#) Relationship Between Marks
[382Tk1097](#) Examination and comparison; construction as entirety
In conducting likelihood of confusion analysis, it is improper to dissect mark, and marks must be

viewed in their entirety. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[11] Trademarks

 [Examination and comparison; construction as entirety](#)

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1093](#) Relationship Between Marks
[382Tk1097](#) Examination and comparison; construction as entirety
In conducting likelihood of confusion analysis in trademark case, proper test is not side-by-side comparison of marks, but instead whether marks are sufficiently similar in terms of their commercial impression, such that persons who encounter marks would be likely to assume connection between parties. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[1 Cases that cite this headnote](#)

[12] Trademarks

 [Similarity or dissimilarity in general](#)

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1093](#) Relationship Between Marks
[382Tk1095](#) Similarity or dissimilarity in general
If parties' goods are closely related, lesser degree of similarity between marks may be sufficient to give rise to likelihood of confusion. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[13] Trademarks

 [Relationship Between Goods or Services Underlying Marks](#)

Trademarks

 [Trade channels; sales, advertising, and marketing](#)

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1100](#) Relationship Between Goods or Services Underlying Marks
[382Tk1101](#) In general

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1107 Nature and Circumstances of Use of Marks](#)

[382Tk1110 Trade channels; sales, advertising, and marketing](#)

When analyzing similarity of goods in trademark case, it is not necessary that parties' products be similar or even competitive to support finding of likelihood of confusion; instead, likelihood of confusion can be found if respective products are related in some manner and/or if circumstances surrounding their marketing are such that they could give rise to mistaken belief that they emanate from same source. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[1 Cases that cite this headnote](#)

[14] Trademarks

[🔑 Similarity or dissimilarity in general](#)

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1093 Relationship Between Marks](#)

[382Tk1095 Similarity or dissimilarity in general](#)

When trademarks would appear on substantially identical goods, degree of similarity necessary to support conclusion of likely confusion declines. Lanham Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

[15] Trademarks

[🔑 Reduction of Mark's Capacity to Identify; Blurring](#)

Trademarks

[🔑 Creation of Unfavorable Associations; Tarnishment](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1462 Reduction of Mark's Capacity to Identify; Blurring](#)

[382Tk1463 In general](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1465 Creation of Unfavorable Associations; Tarnishment](#)

[382Tk1466 In general](#)

To prevail on dilution claim under Trademark Dilution Revision Act (TDRA), plaintiff must show that: (1) it owns famous mark that is distinctive; (2) defendant is using mark in commerce that allegedly dilutes plaintiff's famous mark; (3) defendant's use of its mark began after plaintiff's mark became famous; and (4) defendant's use of its mark is likely to cause dilution by blurring or by tarnishment. Lanham Act, § 43(c)(1), [15 U.S.C.A. § 1125\(c\)\(1\)](#).

[2 Cases that cite this headnote](#)

[16] Trademarks

[🔑 Strength or fame of marks; degree of distinctiveness](#)

Trademarks

[🔑 Marks protected; strength or fame](#)

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1090 Nature of Marks](#)

[382Tk1092 Strength or fame of marks; degree of distinctiveness](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1468 Marks protected; strength or fame](#)

Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires more stringent showing, such that mark can acquire sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting more stringent requirement for dilution fame. Lanham Act, §§ 2(d), 43(c)(1), [15 U.S.C.A. §§ 1052\(d\), 1125\(c\)\(1\)](#).

[2 Cases that cite this headnote](#)

[17] Trademarks

[🔑 Marks protected; strength or fame](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1468 Marks protected; strength or fame](#)

To establish that mark is famous for dilution purposes, owner of allegedly famous mark must

show that its mark became famous prior to filing date of trademark application or registration against which it intends to file opposition or cancellation proceeding. Lanham Act, § 43(c)(1), [15 U.S.C.A. § 1125\(c\)\(1\)](#).

[3 Cases that cite this headnote](#)

[18] Trademarks

🔑 [Marks protected; strength or fame](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1468 Marks protected; strength or fame](#)

To establish requisite level of fame to warrant protection under Trademark Dilution Revision Act (TDRA), mark's owner must demonstrate that common or proper noun uses of term and third-party uses of mark are now eclipsed by owner's use of mark. Lanham Act, § 43(c)(1), [15 U.S.C.A. § 1125\(c\)\(1\)](#).

[1 Cases that cite this headnote](#)

[19] Trademarks

🔑 [Marks protected; strength or fame](#)

[382T Trademarks](#)

[382TVIII Violations of Rights](#)

[382TVIII\(B\) Dilution](#)

[382Tk1468 Marks protected; strength or fame](#)

Luxury good manufacturer failed to establish that its "COACH" mark for fashion accessories was famous, for dilution purposes, and thus that test preparation company's use of mark "COACH" for educational materials used to prepare students for standardized tests violated Trademark Dilution Revision Act (TDRA), even if manufacturer had sixteen federal trademark registrations, its sales exceeded \$1 billion per year, and its mark had achieved substantial degree of recognition among women ages 13–24, where many unsolicited media references to mark were limited to mentioning one of manufacturer's COACH products among other brands, and there was no evidence of brand awareness among women generally or among men. Lanham Act, § 43(c)(1), [15 U.S.C.A. § 1125\(c\)\(1\)](#).

[20] Federal Courts

🔑 [Trial de novo](#)

[170B Federal Courts](#)

[170BVIII Courts of Appeals](#)

[170BVIII\(K\) Scope, Standards, and Extent](#)

[170BVIII\(K\)1 In General](#)

[170Bk776 Trial de novo](#)

Standing is question of law that Court of Appeals reviews de novo.

[21] Administrative Law and Procedure

🔑 [Right of Review](#)

[15A Administrative Law and Procedure](#)

[15AV Judicial Review of Administrative Decisions](#)

[15AV\(A\) In General](#)

[15Ak665 Right of Review](#)

[15Ak665.1 In general](#)

Constitutional case and controversy restrictions on standing do not apply to matters before administrative agencies. [U.S.C.A. Const. Art. 3, § 2, cl. 1](#).

[22] Trademarks

🔑 [Persons entitled to oppose; standing; parties](#)

[382T Trademarks](#)

[382TVII Registration](#)

[382TVII\(B\) Proceedings Concerning Federal Registration](#)

[382Tk1290 Opposition](#)

[382Tk1294 Persons entitled to oppose; standing; parties](#)

To establish standing to oppose trademark registration, opposer must show: (1) real interest in proceeding; and (2) reasonable basis for believing that it would suffer damage if mark is registered. Lanham Act, § 13(a), [15 U.S.C.A. § 1063\(a\)](#).

[23] Trademarks

🔑 [Persons entitled to oppose; standing; parties](#)

[382T Trademarks](#)

[382TVII Registration](#)

382TVII(B) Proceedings Concerning Federal Registration
 382Tk1290 Opposition
 382Tk1294 Persons entitled to oppose; standing; parties
 To satisfy real interest requirement for standing to oppose trademark registration, opposer must have legitimate personal interest in opposition. Lanham Act, § 13(a), 15 U.S.C.A. § 1063(a).

[24] Trademarks

🔑 Grounds; issues

382T Trademarks
 382TVII Registration
 382TVII(B) Proceedings Concerning Federal Registration
 382Tk1290 Opposition
 382Tk1292 Grounds; issues
 Once party opposing trademark registration meets requirements for standing, it can rely on any statutory grounds for opposition. Lanham Act, §§ 2, 13(a), 15 U.S.C.A. §§ 1052, 1063(a).

[25] Trademarks

🔑 Persons entitled to oppose; standing; parties

382T Trademarks
 382TVII Registration
 382TVII(B) Proceedings Concerning Federal Registration
 382Tk1290 Opposition
 382Tk1294 Persons entitled to oppose; standing; parties
 Luxury good manufacturer had standing to challenge test preparation company's use of mark "COACH" for educational materials on descriptiveness grounds, even though it was not seeking to use mark descriptively, where manufacturer had established standing to challenge registration on grounds of likelihood of confusion and dilution. Lanham Act, § 13(a), 15 U.S.C.A. § 1063(a).

[26] Trademarks

🔑 Descriptive Terms or Marks

382T Trademarks
 382TII Marks Protected

382Tk1035 Descriptive Terms or Marks
 382Tk1036 In general
 Marks that are merely descriptive of goods and services are not entitled to protection. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[27] Trademarks

🔑 Descriptive Terms or Marks

382T Trademarks
 382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1036 In general
 Mark is merely "descriptive," and thus not entitled to protection, if it immediately conveys knowledge of quality, feature, function, or characteristic of goods or services with which it is used. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[28] Trademarks

🔑 Descriptive Terms or Marks

382T Trademarks
 382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1036 In general
 Mark may be merely descriptive even if it does not describe full scope and extent of applicant's goods or services. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[29] Trademarks

🔑 Descriptive Terms or Marks

382T Trademarks
 382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1036 In general
 Mark's descriptiveness is not considered in abstract, but instead must be considered in relation to particular goods for which registration is sought, context in which it is being used, and possible significance that term would have to average purchaser of goods because of manner of its use or intended use. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[30] Trademarks

🔑 [Scope of review](#)

382T Trademarks
 382TVII Registration
 382TVII(B) Proceedings Concerning Federal Registration
 382Tk1315 Judicial Review or Intervention
 382Tk1322 Scope of review
 Determination that mark is merely descriptive is factual finding that Federal Circuit reviews for substantial evidence. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[31] **Trademarks**

🔑 [Descriptive Terms or Marks](#)

382T Trademarks
 382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1036 In general
 Substantial evidence supported Trademark Trial and Appeal Board's decision that test preparation company's use of mark "COACH" for educational materials used to prepare students for standardized tests was merely descriptive, for purposes of determining whether it could be registered; company's use of term fell within scope of dictionary definitions of word "coach," and third parties used term in similar manner in connection with test preparation. Lanham Act, § 2, 15 U.S.C.A. § 1052.

[32] **Trademarks**

🔑 [Acquired distinctiveness; secondary meaning](#)

382T Trademarks
 382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1037 Acquired distinctiveness; secondary meaning
 Descriptive mark can be registered if it has acquired secondary meaning. Lanham Act, § 2(f), 15 U.S.C.A. § 1052(f).

[33] **Trademarks**

🔑 [Acquired distinctiveness; secondary meaning](#)

382T Trademarks

382TII Marks Protected
 382Tk1035 Descriptive Terms or Marks
 382Tk1037 Acquired distinctiveness; secondary meaning

To establish that descriptive mark has acquired secondary meaning, or acquired distinctiveness, applicant for trademark registration must show that in minds of public, primary significance of product feature or term is to identify product's source rather than product itself. Lanham Act, § 2(f), 15 U.S.C.A. § 1052(f).

[34] **Trademarks**

🔑 [Acquired distinctiveness and secondary meaning in general](#)

382T Trademarks
 382TII Marks Protected
 382Tk1029 Capacity to Distinguish or Signify; Distinctiveness
 382Tk1032 Acquired distinctiveness and secondary meaning in general

To determine whether mark has acquired secondary meaning, courts consider: advertising expenditures and sales success; length and exclusivity of use; unsolicited media coverage; copying of mark by defendant; and consumer studies. Lanham Act, § 2(f), 15 U.S.C.A. § 1052(f).

[35] **Trademarks**

🔑 [Determination and disposition](#)

382T Trademarks
 382TVII Registration
 382TVII(B) Proceedings Concerning Federal Registration
 382Tk1315 Judicial Review or Intervention
 382Tk1326 Determination and disposition

Trademark Trial and Appeal Board's failure to consider all pre-decision third-party use of term "coach" for educational materials undermined its analysis of whether term, as used by test preparation company in materials used to prepare students for standardized tests, had acquired secondary meaning, and thus required remand so that Board could assess extent to which those titles might cut against company's claim of substantially exclusive use, where Board found five titles of record that arguably related

to company's subject matter, but improperly disregarded them based on their publication dates, and there was no admissible testimony in record regarding company's earlier use of term in its catalogs and marketing. Lanham Act, § 2(f), 15 U.S.C.A. § 1052(f).

[36] Trademarks

🔑 [Alphabetical listing](#)

382T Trademarks

382TXI Trademarks and Trade Names

Adjudicated

382Tk1800 Alphabetical listing

COACH.

Attorneys and Law Firms

***1360** [Norman H. Zivin](#), Cooper & Dunham, LLP, of New York, NY, argued for appellant. With him on the brief was [Tonia A. Saylor](#).

[R. David Hosp](#), Goodwin Procter, LLP, of Boston, MA, argued for appellee. With him on the brief was [Anthony H. Cataldo](#). Of counsel was [John T. Bennett](#).

Before [NEWMAN](#), [O'MALLEY](#), and [REYNA](#), Circuit Judges.

Opinion

[O'MALLEY](#), Circuit Judge.

Coach Services, Inc. (“CSI”) appeals from the final decision of the Trademark Trial and Appeal Board (“the Board”) dismissing its opposition to Triumph Learning, LLC’s (“Triumph”) use-based applications to register the mark COACH for educational materials used to prepare students for standardized tests. The Board found that: (1) there was no likelihood of confusion between the parties’ COACH marks; (2) CSI failed to prove likelihood of dilution; and (3) although Triumph’s marks are merely descriptive, they have acquired secondary meaning, and thus are entitled to registration. *Coach Services, Inc. v. Triumph Learning LLC*,

96 U.S.P.Q.2d 1600 (T.T.A.B. Sept. 17, 2010) (“*Board Decision*”). For the reasons discussed below, we find no error in the Board’s decisions regarding likelihood of confusion and dilution, and thus affirm as to those grounds. With respect to the Board’s acquired distinctiveness analysis, however, we find that certain evidentiary errors require us to vacate and remand solely with respect to the Board’s determination of Triumph’s “substantially exclusive and continuous use” of its marks. Accordingly, we affirm-in-part, vacate-in-part, and remand this matter for further proceedings.

BACKGROUND

A. Triumph’s Use of the COACH Mark

Triumph publishes books and software used to assist teachers and students in preparing for standardized tests. Triumph claims that it has used the COACH mark in connection with its products since at least 1986. According to Triumph: (1) the “market for test preparation materials for state-sponsored standardized tests is highly specific and targeted”; and (2) much of the marketing takes place through face to face contact with sales representatives or in the form of direct mailings to previously identified educational department heads. Appellee’s Br. 6.

Triumph explains that, when Congress passed the No Child Left Behind Act in 2001, which mandated that all states administer standardized tests to monitor academic advancement, Triumph made additional investments in its marketing. It began focusing on the style of its brand and developed a mascot—a cartoon coach—and a slogan: “America’s best for student success.” Triumph invested significantly in its marketing efforts, and, according to Triumph, it has had substantial commercial success selling products under its COACH mark.

In December 2004, Triumph filed use-based applications for three marks: (1) the COACH word mark (Serial No. 78/535,642); (2) a stylized COACH mark (Serial No. 78/536,065); and (3) a COACH mark and design (Serial No. 78/536,143) (referred to collectively as “Triumph’s COACH marks”). The COACH mark with a design appears as follows:



*1361 Each of the applications is for the following goods in International Classes 9 and 16:

Computer software for use in child and adult education, namely, software to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams; prerecorded audio and video tapes in the field of child and adult education, featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 9; and

Printed materials in the field of child and adult education, namely, textbooks, workbooks, teacher guides and manuals, posters and flashcards, all featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 16.

Triumph's COACH marks were published for opposition on September 20, 2005.

B. CSI's COACH Marks

CSI advertises and sells a wide variety of “accessible luxury” products, including handbags, luggage, clothing, watches, eye glasses, and wallets. It has been using the COACH mark in connection with its products since at least December 28, 1961.¹ CSI owns sixteen incontestable trademark registrations for the COACH mark, all but one of which issued before Triumph's applications were filed in December 2004.

CSI sells its COACH products in its own 400 retail stores, in department stores, and over the Internet through its website. It also promotes its goods by catalogs. CSI advertises and markets its COACH line of products throughout the United

States using “magazine and newspaper ads, billboards and bus and phone kiosks.” Appellant's Br. 5. For example, CSI's COACH brand products have been advertised in national fashion publications, including *Elle*, *Vogue*, *Mademoiselle*, and *Vanity Fair*.

Although CSI's briefing to this court includes advertising and sales figures from 2000–2008, including a representation that its sales exceeded \$10 billion over that time frame, as discussed below, this evidence was not properly submitted to the Board and thus was not considered. In fact, the Board found that CSI introduced evidence of its advertising and sales only for 2008. Specifically, CSI introduced the testimony deposition of Carole P. Sadler, the former Vice President, General Counsel, and Secretary of CSI, who testified that, in 2008: (1) CSI's annual sales were roughly \$3.5 billion; and (2) CSI spent about “30–60 million a year” on advertising. Joint Appendix (“J.A.”) 3659–60.

To further support the popularity and commercial success of its COACH mark, *1362 CSI points to: (1) its joint marketing efforts with other popular brands, including LEXUS and CANON; (2) unsolicited media attention from the fashion press; (3) an internal market study conducted in June and July 2007 of persons between the ages of 18–24, which showed that the COACH brand had 96% aided awareness; and (4) the fact that CSI has taken steps to enforce its trademark rights against past infringers.

It is undisputed that CSI is not in the education or test-preparation industry, does not consider Triumph a competitor, and did not present any evidence of any actual confusion stemming from Triumph's use of the Coach mark in conjunction with its educational materials.

C. TTAB Opposition Proceedings

On March 17, 2006, CSI filed a Notice of Opposition opposing registration of all three of Triumph's COACH marks on grounds of likelihood of confusion under 15 U.S.C. § 1052(d) and dilution under 15 U.S.C. § 1125(c). On October 5, 2006, CSI amended its Notice to add a claim that COACH is merely descriptive when used on goods in the educational and test preparation industries, such that the mark is not registrable to Triumph pursuant to 15 U.S.C. § 1052(e).

On September 17, 2010, the Board issued a judgment dismissing CSI's opposition. Specifically, the Board found that there was: (1) no likelihood of confusion between the parties' marks; and (2) no likelihood of dilution of CSI's COACH mark for lifestyle goods by Triumph's COACH marks for educational materials. While the Board found that CSI's COACH mark was famous for likelihood of confusion purposes, it concluded that CSI failed to provide sufficient evidence of fame to support its dilution claim under the Trademark Dilution Revision Act of 2006 ("TDRA"), 15 U.S.C. § 1125(c). Finally, the Board held that, although Triumph's COACH marks were merely descriptive, they had acquired secondary meaning and thus were entitled to registration.

CSI timely appealed to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

STANDARD OF REVIEW

[1] We review the Board's legal conclusions *de novo* and its factual findings for substantial evidence. *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed.Cir.2003). Substantial evidence is “ ‘more than a mere scintilla’ and ‘such relevant evidence as a reasonable mind would accept as adequate’ to support a conclusion.” *Id.* (quoting *Consol. Edison v. Nat'l Labor Relations Bd.*, 305 U.S. 197, 229, 59 S.Ct. 206, 83 L.Ed. 126 (1938)).

DISCUSSION

CSI's primary arguments on appeal fall into three categories. It argues that the Board erred when it: (1) improperly balanced the factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A.1973), to find no

likelihood of confusion; (2) ignored substantial evidence showing that CSI's COACH mark was famous for dilution purposes, including corporate annual reports that CSI had attempted to introduce via a notice of reliance; and (3) found that Triumph's descriptive COACH marks have acquired distinctiveness.

In response, Triumph argues that the Board correctly found: (1) no likelihood of confusion “in light of the vast differences in the parties' respective goods, the channels of trade through which those goods are sold, and the vastly different commercial impressions made by the marks on consumers”; (2) no likelihood of dilution because CSI did not meet the stringent standards for fame under the TDRA and *1363 because “its mark has not become the principal meaning of the word ‘coach’ ”; and (3) that Triumph's marks have attained secondary meaning. Appellee's Br. 12–13.

For the reasons set forth below, we find Triumph's arguments regarding likelihood of confusion and likelihood of dilution well-taken. Because we find that the Board made evidentiary errors with respect to its acquired distinctiveness analysis, we vacate that portion of the Board's decision and remand for further proceedings on that issue alone.

A. Evidentiary Ruling Regarding CSI's Notice of Reliance

On appeal, CSI takes issue with the Board's decision to exclude the corporate annual reports it attempted to admit through a notice of reliance. According to CSI, the Board should have considered its 2000–2008 annual reports as evidence of CSI's annual sales figures and the amount it expended in advertising, design, and promotion of its COACH products. In response, Triumph argues that the Board properly struck the documents from the record because they were not submitted in accordance with the Board's rules and were not otherwise authenticated. We agree with Triumph.

[2] This court reviews evidentiary rulings for abuse of discretion. *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1390 (Fed.Cir.2010) (citing *Chen v. Bouchard*, 347 F.3d 1299, 1307 (Fed.Cir.2003)). We will reverse only if the Board's evidentiary ruling was: (1) “clearly unreasonable, arbitrary, or fanciful”; (2) “based on an erroneous conclusion[] of law”; (3) premised on “clearly erroneous findings of fact”; or (4) the record “contains

no evidence on which the Board could rationally base its decision.” *Id.* at 1390–91.

The Trademark Rules of Practice, which govern inter partes trademark proceedings before the Board, provide, in part, that “printed publications” which are “available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding ... may be introduced in evidence by filing a notice of reliance on the material being offered.” 37 C.F.R. § 2.122(e). Historically, corporate annual reports were not considered printed publications available to the general public and thus were not admissible via a notice of reliance without any authentication. *See Jeanne–Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 U.S.P.Q. 58, 59, n. 4 (T.T.A.B.1984) (“It is well settled that annual reports do not fall within the category of printed publications as contemplated” under the Trademark Rules.); *see also Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 12 U.S.P.Q.2d 1267, 1270 n. 5 (T.T.A.B.1989) (“[P]rinted material in the nature of annual reports is not considered printed publications available to the general public such that it may be relied on pursuant to Rule 2.122(e). Rather, such material must be introduced in connection with the deposition testimony of a competent witness.”); *VTech Holdings Ltd. v. Varian Semiconductor Equip. Assocs., Inc.*, Opp. No. 91156936, 2007 WL 2972233, at *4, 2007 TTAB LEXIS 245, at *11 (T.T.A.B. Sept. 21, 2007) (“Opposer’s corporate annual reports, newsletters and other house publications are not self-authenticating printed publications or official records and may not be made of record by notice of reliance. We sustain applicant’s objection to all such documents and shall give them no consideration.”) (internal citations omitted).

In a 2010 decision, however, the Board expanded the types of documents that can be introduced by way of a notice of reliance. *Safer Inc. v. OMS Investments Inc.*, 94 U.S.P.Q.2d 1031, 1039 (T.T.A.B.2010). In *Safer*, the Board held that:

***1364** *if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e) ... The Board will henceforth deem a document obtained from the Internet displaying a date and its source as presumptively true and genuine. Of course, the document must be publicly available. The date and source information on the face*

of Internet documents allow the nonoffering party the opportunity to verify the documents.

Id. (emphasis in original). In a footnote, the Board recognized that documents could be treated differently depending on their format. For example, “a corporate annual report available only in paper form may not be admissible through a notice of reliance because it is not a document in general circulation,” while a report “in digital form publically available over the Internet would be admissible through a notice of reliance because its publication on the Internet places it in general circulation.” *Id.* at 1039 n. 18.

Here, CSI’s First Notice of Reliance, which was dated October 20, 2008, listed its annual reports from 2002 to 2008.² Triumph objected on grounds that “annual reports may not be introduced through a notice of reliance, but must be introduced and authenticated by competent testimony.” *Board Decision*, 96 U.S.P.Q.2d at 1603. The Board, relying on *Trademark Rule 2.122(e)* and the related cases cited above, indicated that “corporate annual reports are not considered to be printed publications available to the general public.” *Id.* In a footnote, the Board acknowledged the recent *Safer* decision and found that, “[b]ecause the annual reports were not printed from the Internet, they may not be admitted into evidence pursuant to a notice of reliance.” *Id.* at 1603 n. 2 (citing *Safer*, 94 U.S.P.Q.2d at 1039 n. 18). The Board further noted that CSI did not have any witness testify to the authenticity of the reports. Accordingly, the Board sustained Triumph’s objection and gave CSI’s annual reports no consideration.

On appeal, CSI argues that the Board should have considered the annual reports in light of the *Safer* decision. According to CSI, because its annual reports from 2001 to 2008 were available online, the Board should have accepted the printed versions of the reports. In the alternative, CSI argues that, if the court agrees with the Board that the paper versions of the annual reports are not admissible via a notice of reliance, but that “identical copies printed off the Internet are admissible, Coach submitted the testimony of its Vice President and General Counsel that Coach’s sales and advertising information is reported publicly because it is a public company.” Appellant’s Br. 29–30.

The record reveals that CSI’s former Vice President and General Counsel—Carole Sadler—testified as follows:

Q. About how much does Coach spend on advertising every year?

A. Currently we spend about 30 to \$60 million a year. If you include design and promotional expenditures with advertising, it is closer to 125 million.

Q. Annually?

A. Annually, yes.

*1365 Q. And is that information available publicly?

A. Yes, it is in our annual report.

Q. What are Coach's sales approximately today?

A. About three-and-a-half billion dollars.

Q. Is that information available publicly?

A. Yes.

Q. Is Coach a public company?

A. Yes.

Q. So it reports that information publicly?

A. Yes.

J.A. 3659–60. According to CSI, this testimony corroborates that the advertising spending and sales figures from 2000 to 2008 are publicly available through the annual reports CSI proffered. It is undisputed, however, that Ms. Sadler was not shown the annual reports during her deposition and did not authenticate the documents at issue.

[3] Despite CSI's contentions to the contrary, we find that the Board's decision to exclude the annual reports is consistent with both the Trademark Rules and the Board's related case law. It is significant, moreover, that CSI submitted its Notice of Reliance in October 2008, and the Board did not decide *Safer* until 2010. At the time the Notice of Reliance was submitted, therefore, the Board's rules and existing case law were clear that corporate annual reports were not admissible via a notice of reliance. Even under the Board's *Safer* decision, moreover, CSI's printed versions of its annual reports could not be admitted into evidence pursuant to a notice of reliance because they lacked identifying information such as the online source and date accessed. Indeed, *Safer* specifically contemplated this situation where a corporate annual report is "inadmissible in paper form by way of a notice of reliance because it is not a document in general circulation whereas the same annual report in digital form, publicly available

over the internet, would be admissible through a notice of reliance because its publication on the internet places it in general circulation." Gary D. Krugman, *Trademark Trial & App. Board Prac. & Proc.* § 3.138 (2011).

With respect to Ms. Sadler's testimony, the Board found that her statements were limited to 2008 because she specified that her sales and advertising estimates were "current" estimates, and her deposition was taken in 2008. And, as Triumph notes and CSI concedes, the sales figure Ms. Sadler quoted during her testimony was for worldwide sales, not sales within the United States, and there was no indication as to whether the advertising figures quoted were limited to the United States. Simply put, there was no testimony authenticating the annual reports or independently establishing the information contained therein.

Although the Board's requirements for admission of evidence via a notice of reliance are specific, and do not mirror the Federal Rules of Evidence, they can be readily learned and easily satisfied. Because CSI offered only paper versions of its annual reports, which are not self-authenticating, we find that the Board did not abuse its discretion when it excluded those reports. Accordingly, we affirm the Board's evidentiary ruling.

B. Likelihood of Confusion

[4] Next, CSI argues that the Board erred in finding no likelihood of confusion under the factors articulated in *DuPont*. Likelihood of confusion is a legal determination based on underlying facts. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed.Cir.2000); see also *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1381 (Fed.Cir.2006) ("Likelihood of confusion is a question of law, based on *1366 findings of relevant underlying facts, namely findings under the *DuPont* factors."). Although we review the Board's findings as to the *DuPont* factors for substantial evidence, we review its overall determination of likelihood of confusion without deference. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342 (Fed.Cir.2004)

Under Section 2(d) of the Lanham Act, the Patent and Trademark Office ("PTO") may refuse to register a trademark if it is so similar to a registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Whether a likelihood of confusion exists

between an applied-for mark and a prior mark is determined on a case-by-case basis applying the thirteen non-exclusive factors set forth in *DuPont*.³ *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1349 (Fed.Cir.2011) (citation omitted). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed.Cir.2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed.Cir.2002) (citation omitted).

Here, the Board focused on the following *DuPont* factors: (1) the strength or fame of CSI's COACH marks; (2) the similarity of the goods; (3) the channels of trade; (4) the classes of consumers; and (5) the similarity of the marks in their entirety. The Board weighed each of these factors and found that there was no likelihood of confusion because the parties' marks “have different meanings and engender different commercial impressions,” and the goods involved “are not similar or related in any way.” *Board Decision*, 96 U.S.P.Q.2d at 1609.

[5] CSI argues that the Board failed to give proper weight to: (1) the fame of its COACH mark; (2) the identical nature of the parties' marks; and (3) the “overlap between the parties' goods and the overlap and lack of sophistication of the parties' customers.” Appellant's Br. 19. We address each of the challenged determinations in turn and find that they are supported by substantial evidence. After careful review and balancing of the *DuPont* factors, we conclude that the Board correctly found no likelihood of confusion.

1. Strength or Fame of CSI's Coach Mark

[6] The fame of the registered mark plays a “dominant” role in the *DuPont* *1367 analysis, as famous marks “enjoy a wide latitude of legal protection.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327 (Fed.Cir.2000); see also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1374 (Fed.Cir.2005) (“[A] strong mark ... casts a long shadow which competitors must avoid” (citation omitted)). A famous mark is one that has “extensive public recognition and renown.” *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed.Cir.2002) (citation omitted).

[7] [8] Fame for purposes of likelihood of confusion is a matter of degree that “varies along a spectrum from very strong to very weak.” *Palm Bay*, 396 F.3d at 1375 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed.Cir.2003)). Relevant factors include sales, advertising, length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark. *Recot*, 214 F.3d at 1326; see also *Bose*, 293 F.3d at 1371 (“[O]ur cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”). The party asserting that its mark is famous has the burden to prove it. *Leading Jewelers Guild, Inc. v. LJOH Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1904 (T.T.A.B.2007) (“It is the duty of a party asserting that its mark is famous to clearly prove it.”).

[9] It is well-established that fame is insufficient, standing alone, to establish likelihood of confusion. *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1374 (Fed.Cir.1983) (“Likely ... to cause confusion means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another.”) (internal quotations omitted). Although fame cannot overwhelm the other *DuPont* factors, we are mindful that it “deserves its full measure of weight in assessing likelihood of confusion.” *Recot*, 214 F.3d at 1328 (noting that “fame alone cannot overwhelm the other *DuPont* factors as a matter of law”).

To show the strength and fame of its mark, CSI introduced the following evidence before the Board:

- CSI began using the COACH mark at least as early as December 28, 1961.
- There are approximately 400 COACH retail stores throughout all 50 states.
- CSI's COACH products are sold by approximately 1,000 third-party retailers throughout the US.
- In 2008, CSI's annual sales were roughly \$3.5 billion.
- In 2008, CSI spent “about \$30–60 million a year” on advertising.
- CSI has advertised in magazines such as Elle, Vogue, Vanity Fair, and The New Yorker.

- CSI has advertised in newspapers in major metropolitan areas.
- CSI's COACH products have received unsolicited publicity from newspapers and magazines discussing fashion trends.
- CSI has been the subject of articles that refer to the renown of its products.
- CSI's internal brand awareness study, which issued in March 2008, showed a high level of awareness of the COACH brand for women between the ages of 13–24.
- CSI's COACH products are the subject of counterfeiting.

Based on this evidence, the Board found that CSI's COACH mark is famous for purposes of likelihood of confusion. Substantial evidence supports this finding. As discussed below, however, the Board found ***1368** that the other factors, on balance, dispel any likelihood of confusion between the parties' marks.

2. Similarity of the Marks

Under the next *DuPont* factor, the Board must consider the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” [476 F.2d at 1361](#). CSI argues that the substantial similarity of the marks should have weighed heavily in favor of likelihood of confusion. Triumph responds that, although the marks for both companies contain the word “Coach,” “when viewed in their commercial contexts, together with the relevant designs and in connection with their respective goods, they convey entirely different commercial impressions.” Appellee's Br. 36–37.

[10] It is well-established that it is improper to dissect a mark, and that marks must be viewed in their entirety. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed.Cir.1993) (“The marks are considered in their entirety, words and design.”); *see also Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 U.S.P.Q.2d 1782, 1792 (T.T.A.B.2002) (same). In some circumstances, however, “one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark.” *Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1905; *see also In re Nat'l*

Data Corp., 753 F.2d 1056, 1058 (Fed.Cir.1985) (“[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.”).

[11] [12] 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. *Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1905. In this fact-specific inquiry, if the parties' goods are closely related, a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion. *In re Inca Textiles, LLC*, 344 Fed.Appx. 603, 606 (Fed.Cir.2009) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed.Cir.1992)). Even where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity. *See Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820–21 (T.T.A.B.2005) (finding that BLUE MAN GROUP “has the connotation of the appearance of the performers” and that applicant's BLUEMAN mark “has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions”); *see also In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B.1987) (considering CROSSOVER for brassieres and CROSSOVER for ladies' sportswear and finding that, “[a]s a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance”).

Here, the Board found that, although the marks are identical in terms of sight and sound, they differ as to connotation and commercial impression. The Board stated that, in assessing connotation and commercial impression, “we are compelled to consider the nature of the respective goods and services.” *Board Decision*, 96 U.S.P.Q.2d at 1609 (citing *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470 (Fed.Cir.1997)). Applying this analysis, the Board found that:

***1369** Opposer's COACH mark, when applied to fashion accessories is clearly either arbitrary or suggestive of carriage or travel accommodations (e.g., stagecoach, train, motor coach, etc.) thereby engendering the commercial impression of a traveling

bag (e.g., a coach or carriage bag). On the other hand, applicant's COACH marks call to mind a tutor who prepares a student for an examination.

Id. Given the “completely different meanings and commercial impressions engendered by the marks,” the Board concluded that Triumph's COACH marks are not similar to CSI's COACH mark. *Id.*

As noted, Triumph's applications seek to register COACH in standard character form, COACH in a stylized font, and COACH with a mascot and the tagline “America's Best for Student Success.” It is undisputed that the word marks for both parties are identical in sound and appearance: they both use the word “Coach.” This fact is significant to the similarity inquiry. We, nevertheless, agree with the Board that, despite their undisputed similarity, the marks have different meanings and create distinct commercial impressions. This is particularly true given that the word “coach” is a common English word that has many different definitions in different contexts.

Specifically, we find that substantial evidence supports the Board's determination that Triumph's COACH mark, when applied to educational materials, brings to mind someone who instructs students, while CSI's COACH mark, when used in connection with luxury leather goods, including handbags, suitcases, and other travel items, brings to mind traveling by carriage. We agree with the Board that these distinct commercial impressions outweigh the similarities in sound and appearance, particularly since, as discussed below, the parties' goods are unrelated. *See Blue Man Prods., 75 U.S.P.Q.2d at 1820–21* (“We consider these differences in the connotations and the commercial impressions of the marks to outweigh the visual and phonetic similarity.”). Accordingly, this factor favors Triumph.

3. Similarity of the Goods

With respect to the *DuPont* factor assessing the similarity of the goods, the Board found, and we agree, that the parties' goods are unrelated. This factor requires a comparison between the goods or services described in the application and those described in the registration. *See M2 Software, 450 F.3d at 1382* (noting that, when reviewing the relatedness of the goods, this court considers “the applicant's goods as set forth

in its application, and the opposer's goods as set forth in its registration”).

[13] [14] When analyzing the similarity of the goods, “it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.” *7-Eleven Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1724 (T.T.A.B.2007)*. Instead, likelihood of confusion can be found “if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* When trademarks would appear on substantially identical goods, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Citigroup Inc. v. Capital City Bank Group, Inc., 637 F.3d 1344, 1355 (Fed.Cir.2011)* (citing *Century 21 Real Estate, 970 F.2d at 877*).

The Board found “clear and significant differences” between the parties' goods. *Board Decision, 96 U.S.P.Q.2d at 1608*. While Triumph's applications identify computer software and printed materials for *1370 use in preparing students for standardized exams, the various products identified in CSI's registrations include handbags, fashion accessories, luggage, and clothing. The Board further noted that, although CSI uses its mark on many different types of goods, it does not use COACH on educational products.

On appeal, CSI concedes that the parties' products are not the same, but contends that there is some overlap between their goods because it “has used the mark in connection with books and audio and videotapes and in connection with tote bags, caps and shirts.” Appellant's Br. 49. This alleged overlap does not help CSI's position, however, particularly since there is no evidence in the record regarding the sales or marketing of these items.⁴

Finally, although CSI argues that the parties' products are related because Triumph uses its marks on shirts, caps, and tote bags, the Board correctly noted that Triumph's applications do not seek to register its COACH marks for those items, and likelihood of confusion must be based on the goods identified in the application. *Board Decision, 96 U.S.P.Q.2d at 1608*. And, there is no evidence that Triumph sells these products, which, according to Triumph, are worn by its sales agents to market Triumph's test preparation materials.

Based on the foregoing, substantial evidence supports the Board's conclusion that the parties' goods are not related.

4. Channels of Trade and Classes of Customers

Next, we consider the similarity or dissimilarity of the trade channels in which the parties' goods are sold and the purchasers to whom the parties' goods are marketed. The Board correctly recognized that, because Triumph's description of goods is not limited to sales to educational professionals, the goods are presumed to travel in all normal channels and to all prospective purchasers for the relevant goods. See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1360–61 (Fed.Cir.2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”).

With respect to the trade channels, the Board noted that CSI sells its products through its 400 retail stores and through third-party retailers. It also advertises in newspapers, fashion magazines, and catalogs that target female consumers between the ages of 25–65 in all income brackets. For its part, Triumph markets its products through catalogs, direct mail, and personal sales representatives.

With respect to the classes of customers, CSI argues that customers of both products are ordinary consumers, including teachers, “who may buy the products at issue without a great deal of thought.” Appellant's Br. 48. The Board found, however, that Triumph targets educational professionals with responsibility for purchasing educational materials. The Board *1371 further found that, although educational professionals “may include females between the ages of 25–65,” the products are “not sold under circumstances likely to give rise to the mistaken belief that the products emanate from the same source.” *Board Decision*, 96 U.S.P.Q.2d at 1608. In fact, the Board found that educational professionals are likely to exercise a high level of care in making purchasing decisions, which would minimize likelihood of confusion.

Under these circumstances, the Board did not err in concluding that the goods are not related and the channels of trade are distinct. Although there could be some overlap in the classes of purchasers for the parties' products, we agree it is unlikely that, in the circumstances in which the products are sold, customers would associate CSI's COACH brand products with educational materials used to prepare

students for standardized tests. And, there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source. See *Sports Auth. Mich.*, 63 U.S.P.Q.2d at 1794 (“There is nothing in the record, however, to suggest that merely because the same consumer may purchase these items, such consumer would consider the goods as likely to emanate from the same source or have the same sponsorship.”). Accordingly, substantial evidence supports the Board's decision that this factor favors Triumph.

5. Balancing the *DuPont* Factors

The Board found that two of the *DuPont* factors weighed in favor of CSI, in whole or in part: (1) CSI's COACH mark is famous for likelihood of confusion; and (2) the classes of consumers may overlap. In contrast, the Board found that the following factors weighed in favor of Triumph: (1) the goods of the parties are not similar or related; (2) the goods move in different trade channels; (3) the marks used by the parties have different meanings and engender different commercial impressions; and (4) Triumph markets to sophisticated purchasers.⁵ After balancing these factors, the Board determined that no likelihood of confusion would arise between the parties' marks.

On appeal, CSI argues that the Board should have given more weight to its determination that its COACH mark was famous. As the Board correctly found, however, fame, while important, is insufficient standing alone to establish likelihood of confusion. On the record before us, and after weighing the relevant *DuPont* factors *de novo*, we agree with the Board that customer confusion is not likely between the parties' respective COACH marks. Although CSI's COACH mark is famous for likelihood of confusion purposes, the unrelated nature of the parties' goods and their different channels of trade weigh heavily against CSI. Absent overlap as to either factor, it is difficult to establish likelihood of confusion. Because the *DuPont* factors favoring Triumph outweigh the factors favoring CSI, the Board was correct in finding no likelihood of confusion.

C. Dilution

[15] The TDRA, which was signed into law on October 6, 2006, amended Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). It provides that:

the owner of a famous mark that is distinctive, inherently or through acquired ***1372** distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)(1). Therefore, to prevail on a dilution claim under the TDRA, a plaintiff must show that: (1) it owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

The TDRA defines dilution by blurring as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” **15 U.S.C. § 1125(c)(2)(B)**. Dilution by tarnishment is defined as “an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” **15 U.S.C. § 1125(c)(2)(C)**.

In its Opposition, CSI argued that Triumph's marks would blur the distinctiveness of its COACH mark and tarnish its reputation. On appeal, however, CSI abandons its dilution by tarnishment claim and focuses its arguments solely on blurring.⁶ The Board found that CSI could not succeed on its dilution claims because it failed to show that its COACH mark was famous for dilution purposes. For the reasons explained below, we agree. Because we find that CSI failed to prove fame for dilution, we need not address the other statutory factors courts can consider to determine whether a mark is likely to cause dilution by blurring.

1. Fame for Dilution

A threshold question in a federal dilution claim is whether the mark at issue is “famous.” Under the TDRA, a mark is famous if it “is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” **15 U.S.C. § 1125(c)(2)(A)**. By using the “general consuming public” as the benchmark, the TDRA eliminated the possibility of “niche fame,” which some courts had recognized under the previous version of the statute.⁷ See *Top Tobacco, LP v. N. Atl. Operating Co.*, 509 F.3d 380, 384 (7th Cir.2007) (noting that the reference to the general public “eliminated any possibility of ‘niche fame,’ which some courts had recognized before the amendment”). The TDRA lists four non-exclusive factors for courts to consider when determining whether a mark is famous:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
 - (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
 - (iii) The extent of actual recognition of the mark.
- *1373** (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A). Whether a mark is famous under the TDRA is a factual question reviewed for substantial evidence.

[16] Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. 4 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition* § 24:104 at 24–290 (4th ed. 2011) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic likelihood of confusion test.”). While fame for dilution “is an either/or proposition”—it either exists or does not—fame for likelihood of confusion is a matter of degree along a continuum. *Palm Bay*, 396 F.3d at 1374–75. Accordingly, a mark can acquire “sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” 7–*Eleven*, 83 U.S.P.Q.2d at 1722.

[17] It is well-established that dilution fame is difficult to prove. See *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d

1164, 1180 (T.T.A.B.2001) (“Fame for dilution purposes is difficult to prove.”); *Everest Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 763 (8th Cir.2005) (“The judicial consensus is that ‘famous’ is a rigorous standard.”); *see also* 4 *McCarthy*, § 24:104 at 24–286, 24–293 (noting that fame for dilution is “a difficult and demanding requirement” and that, although “all ‘trademarks’ are ‘distinctive’—very few are ‘famous’”). This is particularly true where, as here, the mark is a common English word that has different meanings in different contexts. Importantly, the owner of the allegedly famous mark must show that its mark became famous “prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding.” *Toro*, 61 U.S.P.Q.2d at 1174.

[18] As noted, fame for dilution requires widespread recognition by the general public. 15 U.S.C. § 1125(c)(2)(A). To establish the requisite level of fame, the “mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark.” *Toro*, 61 U.S.P.Q.2d at 1180.⁸ An opposer must show that, when the general public encounters the mark “in almost any context, it associates the term, at least initially, with the mark’s owner.” *Id.* at 1181. In other words, a famous mark is one that has become a “household name.” *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir.2004) (quoting *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir.2002)). With this framework in mind, we turn to CSI’s evidence of fame.

2. CSI Failed to Introduce Sufficient Evidence of Fame for Dilution

[19] The Board found that CSI’s evidence of fame was insufficient to support a dilution claim. On appeal, CSI argues that the same evidence establishing fame for likelihood of confusion also establishes fame for dilution purposes. Specifically, CSI argues that the Board disregarded: (1) sales and advertising figures for years 2000–2008; (2) its sixteen federal trademark registrations; (3) unsolicited media *1374 attention; (4) joint marketing efforts; (5) two Second Circuit decisions finding the Coach hangtag, which features the COACH mark, to be famous; and (6) CSI’s internal brand awareness survey showing awareness among 18–24 year old consumers. We address each category of evidence in turn. For the reasons set forth below, we find substantial evidence supporting the Board’s decision that CSI failed to show the requisite level of fame for dilution.

Turning first to CSI’s evidence of sales and advertising expenditures, CSI argues that the Board erred when it ignored the annual reports that were attached to a Notice of Reliance. As previously discussed, however, the Board correctly held that these reports were unauthenticated and thus inadmissible. The only sales and advertising figures in the record via Ms. Sadler’s testimony were for one year—2008—which, notably, is after Triumph filed its use-based applications in December 2004. We agree with the Board that this limited evidence of sales and advertising is insufficient to show fame. Even if the Board had considered the annual reports, moreover, such evidence, standing alone, would be insufficient. *See Toro*, 61 U.S.P.Q.2d at 1181 (“Merely providing evidence that a mark is a top-selling brand is insufficient to show this general fame without evidence of how many persons are purchasers.”).

With respect to CSI’s registrations, the Board found that the mere existence of federally registered trademarks is insufficient to show that the mark is famous for purposes of dilution because ownership of a registration is not proof of fame. On appeal, CSI argues that the Board erred in this determination because one of the statutory factors a court can consider in the fame analysis is whether the mark is registered on the principal register. *See* 15 U.S.C. § 1125(c)(2)(A)(iv). As Triumph points out, however, “[o]ne cannot logically infer fame from the fact that a mark is one of the millions on the Federal Register.” 4 *McCarthy*, § 24:106 at 24–310. While ownership of a trademark registration *is* relevant to the fame inquiry, and—to the extent the Board decision implies otherwise—the Board erred on this point, proof of registration is not *conclusive* evidence of fame.

With respect to media attention, the Board found that CSI’s evidence fell short of showing “widespread recognition of opposer’s mark [by] the general population.” *Board Decision*, 96 U.S.P.Q.2d at 1611. Specifically, the Board found that:

the vast majority of unsolicited media recognition for opposer’s COACH mark comprises a reference to one of opposer’s products as one of many different fashion buys or trends, and the news articles noting opposer’s renown are too few to support a finding that opposer’s mark has been transformed into a household name.

Id. On appeal, CSI argues that the Board ignored hundreds of unsolicited articles mentioning the COACH mark over

the years. CSI points to several examples, including the following:

- “In fact, Coach's growth ... has been phenomenal. When Sara Lee acquired the firm in 1985, its volume was about \$18 million. In Sara Lee's latest fiscal year, which ended last June 30, Coach's sales exceeded \$500 million. The name also resonates with consumers. The brand ranked eighth among the top 10 in accessories firms in the latest Fairchild 100 consumer survey of fashion labels, in 1995.” J.A. 3607 (Women's Wear Daily, May 5, 1997).
- “Coach, one of the top makers of status handbags in the United States ...” J.A. 3598 (The New York Times, Jan. 27, 1999).
- ***1375** • “Coach's creative director has helped transform the 60-year old company into a must-have American icon.” J.A. 3156 (Women's Wear Daily, June 2001).
- “Will Coach Become Too Popular? ... Coach, the maker and retailer of stylish handbags, just had a blowout season.... Clearly Coach has recorded some of the best growth numbers of any retailer or accessories maker in recent years.” J.A. 3543 (Business Week, Jan. 24, 2007).

Looking at the media attention in the record, there is certainly evidence that CSI's COACH mark has achieved a substantial degree of recognition. That said, many of the articles submitted are dated *after* Triumph filed its registration applications and thus do not show that CSI's mark was famous *prior* to the filing date. See *Toro*, 61 U.S.P.Q.2d at 1174 (“an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application” which it opposes). And, there is substantial evidence supporting the Board's determination that many of the references are limited to mentioning one of CSI's COACH products among other brands. Accordingly, even though there is some evidence of media attention, substantial evidence supports the Board's conclusion that the media evidence submitted fails to show widespread recognition.

With respect to joint marketing efforts, CSI argued that other popular brands, including LEXUS and CANON, have used the COACH mark in connection with their products. The Board found that CSI “failed to provide any testimony regarding the success of the joint marketing efforts and the effect of those efforts in promoting opposer's mark.” *Board Decision*, 96 U.S.P.Q.2d at 1611, n. 37. We agree. Without

evidence as to the success of these efforts or the terms of any contracts involved, they have little value here.

Next, the Board found that CSI's 2008 brand awareness study was “of dubious probative value” because it did not offer a witness with first-hand knowledge of the study to explain how it was conducted. *Id.* at 1611. The Board further noted that, although the study showed a high level of brand awareness among women ages 13–24, it provided no evidence of brand awareness among women generally, or among men. See *Top Tobacco*, 509 F.3d at 384 (noting that the TDRA eliminated the possibility of “niche fame” as a basis for finding a mark famous). And, the survey was conducted in 2007, several years after Triumph filed its applications. Given these circumstances, we find no error in the Board's decision to give this survey limited weight.

CSI also argues that the Board failed to adequately consider two Second Circuit decisions finding that the hangtag attached to its various handbags, which features the COACH mark, is distinctive. See *Coach Leatherware Co., Inc. v. AnnTaylor, Inc.*, 933 F.2d 162, 166 (2d Cir.1991) (finding that Coach's lozenge-shaped leather tags embossed with the name “Coach Leatherware,” which are attached to Coach's handbags by beaded brass chains, “have become distinctive and valuable through Coach's promotional efforts and by virtue of its upscale reputation”); see also *Coach, Inc. v. We Care Trading Co., Inc.*, 67 Fed.Appx. 626, 630 (2d Cir.2002) (affirming the jury's dilution verdict on grounds that “the jury's determination that the hang tag was famous and distinctive was not unreasonable” and “the substantial similarity of the two marks here coupled with the use of Coach's very distinctive hang tag shape amply justified the jury's verdict”). Although the Board did not specifically address these cases, we agree with Triumph ***1376** that they are unrelated and irrelevant, particularly because: (1) the 1991 case did not involve a dilution claim; and (2) both cases focus on the hangtag feature on CSI's handbags, not on the alleged fame of the COACH mark generally.

Based on the foregoing, we agree with the Board that CSI failed to provide sufficient evidence of fame for dilution purposes. Absent a showing of fame, CSI's dilution claim fails, and we need not address the remaining statutory factors for dilution by blurring.

Before moving on, we pause to emphasize the fact-specific nature of our holding today. While the burden to show fame in the dilution context is high—and higher than that for

likelihood of confusion purposes—it is not insurmountable. We do not hold that CSI could never establish the requisite level of fame for dilution purposes. We hold only that, on the record presented to it, the Board had substantial support for its conclusion that CSI's evidentiary showing was just too weak to do so here.

D. Whether Triumph's Marks Were Registrable

As an alternative ground for opposition, CSI argued that Triumph's COACH mark is merely descriptive and thus not registrable under 15 U.S.C. § 1052(e). The Board found that, although CSI had standing to oppose Triumph's applications on descriptiveness grounds, Triumph demonstrated that its COACH marks had acquired distinctiveness.

Both parties take issue with portions of the Board's decision on descriptiveness. For its part, Triumph argues that the Board incorrectly found that CSI had standing to oppose registration on descriptiveness grounds. In contrast, CSI argues that it had standing and that “there was no evidence in the record to support a finding that Triumph's descriptive ‘Coach’ marks have acquired distinctiveness.” Appellant's Br. 19. We address the parties' arguments in turn.

1. Standing

[20] [21] Standing is a question of law that this court reviews *de novo*. Under Article III of the United States Constitution, a plaintiff must show a “case or controversy” between the parties to establish standing. *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed.Cir.1999). The “case” and “controversy” restrictions do not, however, apply to matters before administrative agencies. *Id.* Instead, for an agency such as the PTO, standing is conferred by statute. Here, standing is conferred by Section 13 of the Lanham Act, which provides, in pertinent part, that “[a]ny person who believes that he would be damaged by the registration of a mark ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor.” 15 U.S.C. § 1063(a). The purpose of the standing requirement is “to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler.” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028–29 (C.C.P.A.1982).

[22] [23] In addition to meeting the broad requirements of Section 13, an opposer must satisfy two judicially-created standing requirements. *Ritchie*, 170 F.3d at 1095. Specifically, an opposer must show: (1) a “real interest” in the proceeding; and (2) a “reasonable basis” for believing that it would suffer damage if the mark is registered. *Id.* Under the “real interest” requirement, an opposer must have “a legitimate personal interest in the opposition.” *Id.* With respect to the second inquiry, the opposer's belief of damage “must have a reasonable basis in fact.” *Id.* at 1098 (citation and quotation omitted).

*1377 Here, the Board found that, “[b]ecause opposer's registrations are of record, opposer has established its standing.” *Board Decision*, 96 U.S.P.Q.2d at 1604. Although this case is unusual because CSI asserted likelihood of confusion, dilution, and mere descriptiveness, without asserting that it has the right to use the mark descriptively, the Board found “no question that opposer has established a real interest in preventing the registration of applicant's mark.” *Id.* at 1605. In reaching this decision, the Board noted that “standing and grounds may be related, but they are distinct inquiries.” *Id.* (citation omitted).

On appeal, Triumph argues that: (1) CSI's only witness testified that it would not be harmed from the “alleged descriptive nature” of Triumph's mark;⁹ (2) CSI “failed to establish that it uses the mark COACH in a descriptive fashion or in a manner to describe its goods”; and (3) because CSI does not have an interest in using the Triumph marks descriptively, it lacks standing to oppose Triumph's marks on descriptiveness grounds. Appellee's Br. 46–47. Triumph's arguments are not persuasive.

[24] As the Board noted in its decision, this court has previously found that, “[o]nce standing is established, the opposer is entitled to rely on any of the grounds set forth in section 2 of the Lanham Act which negate applicant's right to its subject registration.” *Jewelers Vigilance v. Ullenberg Corp.*, 823 F.2d 490, 493 (Fed.Cir.1987) (citation omitted); see also *Enter. Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 330 F.3d 1333, 1345 (Fed.Cir.2003) (“Once standing is established, in order to state a claim, an opposer must base its ground of opposition on a statutory claim found in the Lanham Act.”); see also *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1385–86 (T.T.A.B.1991) (noting that, once the opposer shows “a personal interest in the outcome of the case ... the opposer may rely on any ground that negates applicant's right to the registration sought”). Accordingly,

in this context, once an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in [15 U.S.C. § 1052](#).

[25] Triumph does not challenge CSI's standing to assert claims for likelihood of confusion and dilution, and instead focuses its standing arguments solely on CSI's descriptiveness challenge. There is no question that CSI has a personal stake in the outcome of the opposition and has asserted it will be harmed by registration of Triumph's marks. Therefore, any theory that would prevent Triumph from registering its marks would necessarily prevent the alleged harm to CSI. Because CSI has established a real interest and reasonable basis for believing registration of Triumph's marks will cause harm in the form of likelihood of confusion or dilution, it also has standing to assert a claim on descriptiveness grounds.

2. Mere Descriptiveness

[26] [27] [28] Marks that are “merely descriptive” of goods and services are not entitled to protection. *In re Abcor Dev. *1378 Corp.*, 588 F.2d 811, 813 (C.C.P.A.1978). A mark is merely descriptive “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed.Cir.2007) (“*Bayer*”) (citing *In re Gyulay*, 820 F.2d 1216, 1217 (Fed.Cir.1987)). A mark may be merely descriptive “even if it does not describe the ‘full scope and extent’ of the applicant's goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed.Cir.2004) (citation omitted).

[29] [30] It is well-established that “[d]escriptiveness of a mark is not considered in the abstract.” *Bayer*, 488 F.3d at 963–64. Instead, the mark must be “considered in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Id.* at 964. Evidence that a term is merely descriptive “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *Bayer*, 488 F.3d at 964 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed.Cir.1986)). A determination that a mark is merely descriptive is a factual finding that this court reviews for substantial evidence. *Bayer*, 488 F.3d at 964.

The Board found that COACH is merely descriptive when used in connection with educational materials used to prepare students for standardized tests because it “immediately conveys to purchasers the purpose of the materials.” *Board Decision*, 96 U.S.P.Q.2d at 1617. In support of this finding, the Board pointed to dictionary definitions of the word “coach,” which include: (1) “a private tutor who prepares a student for an examination”; (2) “a person who trains an athlete”; and (3) “to give instruction or advice in the capacity of a coach; instruct.” *Id.* at 1616–17. The Board also relied on evidence of third-party use of the term “coach.” For example, CSI introduced forty-three titles of books and software incorporating the word “coach,” including: “The Business Coach” and “My SAT Coach.” Based on the evidence of record, the Board concluded that the word “coach” is “a personification of the act of instructing or tutoring for an examination.” *Id.* at 1616–17.

[31] Substantial evidence supports the Board's decision that Coach is merely descriptive. Specifically, we agree that the dictionary definitions in the record, coupled with evidence of third parties that use the term “coach” to describe services that are similar to those identified in Triumph's application, support the Board's descriptiveness finding.

3. Secondary Meaning

Although the Board found that Triumph's marks were merely descriptive when used in connection with its goods, it concluded that Triumph provided sufficient evidence showing that its COACH marks had acquired secondary meaning through use in commerce.

[32] It is well-established that a descriptive mark can be registered if it has acquired secondary meaning. Section 2(f) of the Lanham Act provides, in part, that:

nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in

commerce for the *1379 five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f).

[33] [34] To establish secondary meaning, or acquired distinctiveness, an applicant must show that “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *In re Dial-A-Mattress Operating Co.*, 240 F.3d 1341, 1347 (Fed.Cir.2001) (citation omitted). To determine whether a mark has acquired secondary meaning, courts consider: advertising expenditures and sales success; length and exclusivity of use; unsolicited media coverage; copying of the mark by the defendant; and consumer studies. *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed.Cir.2005). Acquired distinctiveness is a question of fact which is “reviewed under the clearly erroneous standard.” *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1581 (Fed.Cir.1988).

As the Board noted, Triumph raised acquired distinctiveness as its sixth affirmative defense in its answer to CSI's amended notice of opposition. Based on the record before it, the Board made the following factual findings:

- Triumph is the largest publisher of educational materials for preparing for standardized tests and COACH is its primary trademark;
- Between 2003–2008, Triumph's advertising expenditures quadrupled and exceeded six figures;
- Between 2003–2007, Triumph's revenues have reached seven figures;
- Triumph has been promoting COACH as the name of its series of books since at least 1989.

Board Decision, 96 U.S.P.Q.2d at 1617. CSI challenged Triumph's evidence on grounds that: (1) there was no direct evidence of consumer recognition; (2) Triumph introduced and relied upon self-serving, uncorroborated testimony from its Vice President of Marketing: Jane Fisher; (3) Triumph's sales success is not necessarily indicative of acquired distinctiveness; (4) Triumph's use has not been substantially exclusive; and (5) Triumph did not present evidence of media recognition. The Board rejected each of these arguments and found that Triumph met its burden of showing that its COACH marks have acquired distinctiveness.

First, the Board stated that, contrary to CSI's contention, Triumph was not required to introduce a consumer survey and that the Board could determine consumers' reactions to the mark based on inferences from the record. Next, the Board found that Ms. Fisher's testimony was subject to cross-examination and found her testimony—which dealt with Triumph's advertising expenditures and revenue between 2003 and 2008—credible. The Board further found that Triumph's use of its COACH mark in connection with educational materials for preparing for standardized tests “is, and has been, substantially exclusive.” *Board Decision*, 96 U.S.P.Q.2d at 1619. And, the Board concluded that Triumph has been “promoting itself as the ‘Coach’ brand since 1989 through its references to ‘Coach series,’ ‘Coach Books and Software,’ and ‘the Coach.’ ” *Id.* Based on the foregoing, the Board found Triumph established its affirmative defense of acquired distinctiveness.

On appeal, CSI argues that Triumph's sales figures are insufficient to prove secondary meaning and that Triumph's use of the COACH mark is not “substantially exclusive,” particularly given that there was “evidence of 43 different book and software titles showing use of the designator ‘Coach’ for coaching materials.” Appellant's Br. 53–54. CSI also argues that, in finding that Triumph has used its COACH marks “since 1989,” the Board improperly relied on evidence it said it would not consider because it was not authenticated. *1380 Specifically, CSI argues that: (1) Triumph's witness, Ms. Fisher, lacked any personal knowledge of certain marketing documents because she was not working for Triumph at the time the materials allegedly were used; and (2) “review of the alleged brand since 1989 would show that Triumph did not seek to use ‘Coach’ as a ‘brand’ until Fall 2003.” Appellant's Reply 14. We address CSI's arguments in turn.

[35] With respect to the forty-three book and software titles not affiliated with Triumph that include the word “coach,” the Board found no evidence in the record as to their sales and that most of the titles do not relate to educational materials for preparing for standardized tests. Although the Board found five titles of record that arguably relate to Triumph's subject matter—including “A Writer's Coach”, “My SAT Coach”, and “My Word Coach”—it dismissed those titles at least in part on grounds that they were published *after* Triumph filed its applications in 2004. The Board cites no authority for its decision to disregard these titles based on their publication dates, and Triumph has offered none. Indeed, the Board has

previously noted that “[a]cquired distinctiveness and buyer recognition is to be tested in an opposition proceeding as of the date the issue is under consideration. The filing date is not a cutoff for any evidence developing after that time.” *Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, 1681 (T.T.A.B.2007) (citing *McCormick & Co. v. Summers*, 53 CCPA 851, 354 F.2d 668 (1966); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 U.S.P.Q.2d 1570, (T.T.A.B.1988)). We conclude that the Board's failure to consider all pre-decision third-party use of the term “coach” for educational materials undermines its secondary meaning analysis and requires remand so that the Board can assess the extent to which those titles might cut against a claim of “substantially exclusive use.”

With respect to Triumph's use of the COACH mark, the Board concluded that Triumph has been promoting itself as “the ‘Coach’ brand since 1989.” *Board Decision*, 96 U.S.P.Q.2d at 1619. Triumph offered Ms. Fisher's testimony to authenticate advertising materials dating back to the early 1990s. Because Ms. Fisher did not begin working for Triumph until July 2003, CSI objected to her testimony “regarding any matters other than the identification of business records prior to July 2003 on the ground that she lack[ed] personal knowledge about applicant's business prior to that date.” *Id.* at 1603. The Board sustained CSI's objection, stating that it would consider Ms. Fisher's testimony regarding pre-July 2003 matters “only for purposes of authenticating documents kept by applicant in the ordinary course of business.” *Id.*

On appeal, CSI argues that: (1) “there was no testimony authenticating these documents as business records of Triumph”; and (2) Ms. Fisher “had no personal knowledge of where, when, to whom and how many of the materials were distributed.” Appellant's Br. 55 n. 23. On these points, CSI is correct. Review of the relevant testimony reveals that Ms. Fisher identified certain catalogs, indicated that those catalogs were actually used to market and sell products,

and testified as to when the catalogs were used. Nowhere is a foundation laid to establish that the catalogs identified actually were prepared and kept as business records of Triumph. Given the Board's ruling excluding testimony by Ms. Fisher about marketing activities of which she had no personal knowledge, moreover, there is no admissible testimony in the record regarding the actual use of the catalogs or the fact of marketing prior to 2003. Accordingly, on remand, the Board must address the weight, if any, to be given to pre-July 2003 documents in the absence of any testimony authenticating *1381 them or addressing their use. The Board must then assess whether these apparent gaps in Triumph's proofs impact the Board's determination that the mark was in continuous use during any relevant period.

Because the Board's evidentiary errors call into question the validity of its secondary meaning analysis, we vacate the Board's decision solely on its finding of acquired distinctiveness and remand for further proceedings.

CONCLUSION

For the foregoing reasons, and because we find that CSI's remaining arguments are without merit, we affirm the Board's decision dismissing CSI's opposition on likelihood of confusion and dilution grounds. With respect to acquired distinctiveness, however, we vacate and remand for further proceedings consistent with this opinion.

**AFFIRMED–IN–PART, VACATED–IN–PART,
REMANDED**

Parallel Citations

101 U.S.P.Q.2d 1713

Footnotes

- 1 CSI claims that its predecessor first began using the COACH mark in 1957.
- 2 Although its Notice of Reliance listed its annual reports for 2002–2008, in its briefing, CSI argues that the Board should have considered its annual reports from 2001 to 2008. This discrepancy is irrelevant, however, given the Board's decision to exclude all of the reports on grounds that they were improperly introduced.
- 3 The *DuPont* factors include:
 - (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) 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. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated

purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark). (10) The market interface between applicant and the owner of a prior mark.... (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether de minimis or substantial. (13) Any other established fact probative of the effect of use.

DuPont, 476 F.2d at 1361.

- 4 As Triumph correctly points out, CSI provided no evidence as to the sales of these books, any marketing efforts, when the books were last sold, or whether CSI generated revenue from the books. For example, during Ms. Sadler's deposition, she testified that CSI has published books about its history including a book called “Portrait of a Leather Goods Factory.” J.A. 3647. On cross-examination, however, Ms. Sadler could not provide any information regarding the sales of this book or whether it was even sold by CSI. J.A. 3675–76. With respect to CSI's “audio and video tapes,” the record reveals that these are materials it prepares and provides to U.S. Customs to intercept counterfeit goods. There is no evidence that CSI sells these tapes.
- 5 Although the Board did not make any explicit findings on these *DuPont* factors, Triumph also points out that: (1) CSI provided no evidence of actual confusion between the marks; and (2) there was more than 20 years of concurrent use.
- 6 During oral argument, counsel for CSI specifically indicated that CSI is not pursuing a tarnishment claim on appeal. *See* Oral Argument at 0:49, available at <http://www.cafc.uscourts.gov/oral-argument-recordings/2011-1129/all> (“We are not pursuing a tarnishment claim on appeal ... we are going to limit it to blurring.”).
- 7 The previous version of the statute, prior to the 2006 revision, was the Federal Trademark Dilution Act of 1995 or “FTDA.”
- 8 Although the Board's *Toro* decision predates the TDRA, its discussion of fame for dilution purposes remains relevant.
- 9 During her deposition, Sadler testified as follows:
Q. You believe that a descriptive use of the word “Coach” by someone is going to cause your company harm?
A. No.
Q. So it is dilution and likelihood of confusion that would cause your company harm, correct?
A. Correct.
Mr. Zivin: Objection. Mischaracterization.
J.A. 3672: 4–13. We do not view this testimony as an admission that registration of Triumph's marks would not harm CSI.

2012 WL 1881492 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

COMPANHIA DE BEBIDAS DAS AMÉRICAS - AMBEV

v.

THE COCA COLA COMPANY

Opposition Nos. 91178953; 91180439; 91180442; 91183447; 91183448; 91183452; 91183464; 91183465;
91183467; 91185734; 91185739; 91185750; 91186620; 91186661; 91188229; 91188396; and 91189018 ¹

May 2, 2012

*[1](#) [W. Mack Webner](#) and [Jody H. Drake](#) of Sughrue Mion, PLLC for Companhia de Bebidas das Américas - AMBEV
[Bruce W. Baber](#) of King & Spalding LLP for The Coca-Cola Company

Before [Bucher](#), [Zervas](#), and [Shaw](#)

Administrative Trademark Judges

Opinion by [Shaw](#)

Administrative Trademark Judge

The Coca-Cola Company (“TCCC” or “applicant”) has filed seventeen applications for the following marks, all containing, *inter alia*, the term ZERO for use on “beverages, namely soft drinks; syrups and concentrates for the making of the same,” in International Class 32.

SPRITE ZERO ²

COCA-COLA ZERO ³

FANTA ZERO ⁴

COKE ZERO ⁵

VAULT ZERO ⁶

PIBB ZERO ⁷

COKE ZERO ENERGY ⁸

COKE ZERO BOLD ⁹

COKE CHERRY ZERO ¹⁰

CHERRY COCA-COLA ZERO ¹¹

COCA-COLA CHERRY ZERO ¹²

CHERRY COKE ZERO¹³

COCA-COLA VANILLA ZERO¹⁴

VANILLA COKE ZERO¹⁵

VANILLA COCA-COLA ZERO¹⁶

POWERADE ZERO¹⁷

FULL THROTTLE ZERO¹⁸

In each of these applications TCCC has claimed that ZERO has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

Companhia de Bebidas das Américas - AMBEV (“Ambev” or “opposer”) has opposed registration of each application on the same grounds, namely, that the term ZERO is merely descriptive and that the evidence of acquired distinctiveness is insufficient to permit registration on the Principal Register under Section 2(f).

Applicant, in its answer, denied the salient allegations of the notice of opposition. The case is fully briefed and an oral hearing was held on October 5, 2011.

The Record

The evidence of record, as fully referenced in the parties' briefs, is voluminous, consisting of the pleadings, the files of the involved applications, third party registrations of marks including the term ZERO, surveys and testimony depositions on behalf of opposer and applicant, respectively, all with accompanying exhibits, and numerous additional exhibits made of record by the parties' notices of reliance (NOR).

Opposer's Evidentiary Objections

*2 Ambev has made two objections to TCCC's evidence.

First, Ambev objects to the survey and testimony of TCCC's expert witness, Dr. Simonson, as improper rebuttal because he was identified only as a rebuttal witness, not as a witness for TCCC's case in chief.¹⁹

As background, we note that during its main testimony period, opposer introduced the testimony deposition of Dr. Thomas D. Dupont, former President of D2 Research, a company that specialized in designing and conducting surveys to measure consumer perception. Dr. Dupont, through D2 Research, conducted a survey to determine “the main function of the word “zero” . . . in the brand name Coca-Cola Zero.” Dupont testimony at 6.

Applicant introduced the testimony deposition of Dr. Alex Simonson, applicant's expert witness regarding surveys. Dr. Simonson was identified by applicant in its expert disclosures as a rebuttal witness. Applicant's Br. at 29. Dr. Simonson critiqued the survey conducted by Dr. Dupont and opined as to how the survey should have been conducted. Dr. Simonson also conducted a “standard secondary meaning survey as to ZERO.” *Id* at 12.

Ambev argues that the Simonson survey and testimony should be excluded because it constitutes improper rebuttal in that it did not “test the same question that was posed in the Ambev survey it purports to rebut.” Opposer's Br. at 7, n.2. Ambev is correct that TCCC identified Simonson as a rebuttal witness and therefore his survey and testimony should be limited to rebuttal. However, the rebuttal survey and testimony need not be limited to the same question that was posed in Ambev's survey. The purpose of rebuttal is to “introduce facts and witnesses appropriate to deny, explain or discredit the facts and witnesses adduced by the opponent. . . .” *Royal Crown Cola Co. v. Bakers Franchise Corp.*, 150 USPQ 698, 700 (TTAB 1966), *affirmed*, 160 USPQ 192, (CCPA 1969).

Because Dr. Simonson's survey and testimony regarding that survey are proper rebuttal to the extent that they bear on the validity and probative value of the Dupont survey, Ambev's objection is not well taken. Moreover, the fact that evidence might have been offered in chief does not preclude its admission as rebuttal. *Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 113 (TTAB 1981). Accordingly, we have considered the Simonson survey and testimony to the extent that they seek to “deny, explain or discredit” Ambev's survey and testimony. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1625 n.33 (TTAB 1989). To that extend, Ambev's objection is overruled.

*3 Second, Ambev objects to the portion of TCCC's notice of reliance that was filed on Ambev's responses to Applicant's Requests for Documents and Things. Opposer's Br. at 7, n.3. Ambev argues that responses to document requests are not admissible under a notice of reliance. TCCC responds that it is not relying on any documents produced but only upon Ambev's written responses, which are properly submitted through a notice of reliance. Applicant's Br. at 11, n.2.

Documents produced in response to document requests may not be submitted via a notice of reliance except to the extent they are admissible by notice of reliance under [Trademark Rule 2.122\(e\)](#) (printed publications and official records). Conversely, written responses to document production requests, for example, indicating that no responsive documents exist, may be submitted via a notice of reliance. *See L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 at n.5 (TTAB 2008). Since TCCC is only relying on Ambev's written responses, the objection is overruled.

Preliminary Issues

A. Whether Genericness was Tried by the Parties

As indicated above, opposer pleaded in its notice of opposition that the term ZERO is merely descriptive of applicant's goods and that opposer, by virtue of being in the beverage industry, “is in a position to use in the future the term ZERO descriptively in its ordinary descriptive sense in connection with its beverage products.” Notice of Opposition dated August 15, 2007. Ambev did not raise the issue of genericness in any of its seventeen notices of opposition. Ambev argues in its brief that that “ZERO defines a genus of soft drink and is incapable of becoming a trademark for Coke's colas and other soft drinks.” Opposer's Br. at 19. TCCC objects to this characterization of the issues before the Board on the ground that Ambev is raising the issue of genericness for the first time and the issue was neither pleaded nor litigated by the parties. Applicant's Br. at 38. TCCC's objection is well taken.

Since Ambev did not raise the issue of genericness in any of its notices of opposition, we may consider the issue only if we find that the issue was tried by the consent of the parties. Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. There must be no doubt that the non-moving party was aware that the issue was being tried. TBMP § 507.03(b) (3d ed. 2011) and cases cited therein.

We find no evidence that TCCC was aware that Ambev intended to argue genericness until opposer filed its brief. Ambev argues that the very nature of the term ZERO and TCCC's use of ZERO makes the issue “obvious.” Opposer's Reply Br. at 6. However, much of the evidence discusses ZERO only when used as part of phrases such as ZERO-CALORIE, or ZERO-CARB and not by itself, or even as used by TCCC, with its other marks such as COKE, SPRITE, and FANTA. Thus, we do

not find the issue to be as obvious as Ambev claims and it would be unfair to permit opposer to raise genericness at this late date. See *The U.S. Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 817 (TTAB 1986); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263, 266 (TTAB 1982). We conclude that genericness was not tried by either implied or express consent and is not an issue in this opposition.

B. Whether Mere Descriptiveness is an Issue in this Opposition

*4 TCCC states that one of the issues in this opposition is whether “the preponderance of the evidence establish[es] that ZERO in the TCCC ZERO marks either is suggestive (and inherently distinctive) or has acquired distinctiveness.” Applicant's Br. at 5. The suggestiveness (or inherent distinctiveness) of the term ZERO as part of TCCC's marks is not an issue in this opposition. All of TCCC's ZERO marks published showing a claim of acquired distinctiveness of the term ZERO under Section 2(f) of the Trademark Act. Publication under Section 2(f) is a concession that the relevant term or matter is not inherently distinctive. “Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute accepts a lack of inherent distinctiveness as an established fact.* *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (emphasis in original).

TCCC argues that its claim of acquired distinctiveness “was made in the alternative and did not constitute a concession by TCCC that ZERO, as used in the ZERO marks, is not inherently distinctive.” Applicant's Br. at 15. TCCC cites to TMEP § 1212.02(c) for support for this proposition but this section is of no avail. Section 1212.02(c) applies to the examination stage prior to publication and allows applicants to argue against a finding of descriptiveness while also submitting evidence of acquired distinctiveness. There is no evidence that TCCC complained to the Office after the Office published its applications that the Office had made a mistake showing that applicant claimed acquired distinctiveness in part as to the term ZERO. Having accepted publication of its ZERO marks under Section 2(f), TCCC may not now argue that ZERO is inherently distinctive or suggestive. *Yamaha*, 6 USPQ2d at 1005; TMEP Section 1212.02(c) (8th ed. 2011).

Accordingly, the only issue in this consolidated opposition is whether ZERO in each of TCCC's marks has acquired distinctiveness under Section 2(f).

The Parties

Ambev is a Brazilian company that manufactures and sells soft drinks and beers “throughout North and South America.” Opposer's Br. at 2. Ambev also has filed an application to register the mark GUARANA ANTARCTICA ZERO AÇÚCAR and design for soft drinks.²⁰

Applicant is The Coca-Cola Company, “the world's largest beverage company.” Applicant's Br. at 13. Beginning in 2005, applicant (hereinafter, “TCCC”) began marketing and selling COCA-COLA ZERO as well as SPRITE ZERO, FANTA ZERO, and number of other beverages, all including the term ZERO.

Standing

“Any person who believes that he would be damaged by the registration of a mark upon the principal register . . . may, file an opposition . . . stating the grounds therefor.” Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a). Thus, a party has standing to oppose in a Board proceeding if it can demonstrate a real interest in the proceeding. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), citing *Universal Oil Prods. Co. v. Rexall Drug and Chem. Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972).

*5 It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question

is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses. Thus, opposer as a competitor of applicant, is a proper party to challenge applicant's right of registration.

Federal Glass Co. v. Corning Glass Works, 162 USPQ 279, 282-83 (TTAB 1969). See also 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:11 (4th ed. 2007) (“Standing to oppose is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business.”).

Ambev has introduced evidence that it is a beverage company engaged in the marketing and sale of beverages in the United States and that it has filed an application for a trademark including the term ZERO for soft drinks. Ambev's application has been suspended pending the outcome of this proceeding. In view thereof, and because opposer's potential interest in using the term ZERO on beverages sold in the United States is sufficient to demonstrate that opposer has a real interest in this proceeding, opposer has established its standing.

Acquired Distinctiveness

As *Yamaha* explains, when matter proposed for registration under Section 2(f) is approved by the United States Patent and Trademark Office for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness by the applicant for registration. *Yamaha*, 6 USPQ2d at 1004. In an opposition, “the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f).” *Id.* “If the opposer does present its prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing. . . .” *Id.* However, under this analysis, the “ultimate burden of persuasion” is on the applicant. *Id.* Finally, the standard for applicant to meet is preponderance of the evidence, “although logically that standard becomes more difficult to meet as the mark's descriptiveness increases.” *Yamaha*, 6 USPQ2d at 1008.

*6 As discussed above, descriptiveness is not an issue given applicant's resort to Section 2(f) of the Trademark Act. Nonetheless, it is necessary to determine, at the outset, the degree of descriptiveness of ZERO as used in connection with the identified goods given that this determination will have a direct bearing on the amount of evidence necessary to show acquired distinctiveness. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. See *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. See, e.g., *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990).

There is no question that the beverage industry, including the soft drink industry, commonly uses the term ZERO in direct association with nutritional facts or the names of ingredients such as “calories,” “carbohydrates,” “carbs,” or “sugar” to identify the contents of soft drinks. Both parties have introduced ample evidence to show that terms such as “zero-calorie,” “zero-carb,” “zero-sugar,” and the like are widely used by soft drink manufacturers. The testimony of Mary Krizan, Ambev's witness who testified that she purchased numerous beverages bearing the term ZERO, disclosed products such as ROCKSTAR ZERO CARB energy drink; EATING RIGHT, a “zero calorie” enhanced water beverage; ZEVIA, a diet soda with “ZERO calories”; and PEPSI MAX, a “zero calorie cola.” Krizan Test. P. 5, Exh. Nos. 2, 18, 26, 64, and 72.

Ambev also introduced a number of third party trademark registrations for beverage marks including the disclaimed term ZERO such as “NO-CAL ZERO CALORIE SODA POP” and design (non-alcoholic beverages), “NO CARBS ZERO CALORIES” and design (drinking water with vitamins), “ZERO CALORIE SARATOGA SPLASH (flavored spring water beverages),”

and “ZERO CAL” and design (soft drinks). Ambev's second NOR, dated April 28, 2010. While we do not consider these registrations as evidence proving use, these third party registrations can be considered in the manner of a dictionary to show the descriptive nature of ZERO for soft drinks.

Similarly, TCCC introduced product samples for a number of its beverages featuring the term ZERO in direct association with nutritional ingredients, such as “zero calorie cola,” “zero sugar lemon lime soda,” and “zero calorie sports drink.” Baker Test., Exh. Nos. 1, 3, and 15.

***7** While the foregoing evidence demonstrates that ZERO is treated as merely descriptive when used in connection with the nutritional facts or the names of ingredients of a variety of beverages including soft drinks, some of the evidence of record is more ambiguous. During the examination of Serial No. 78580598 for the mark COCA-COLA ZERO, TCCC introduced a number of third party registrations for beverage marks including the term ZERO on the Principal Register without a disclaimer of ZERO. Thus, LACTO ZERO (milk), BRUT ZERO (sparkling wines), SUB ZERO (alcoholic drinks), ZERO MANIPULATION (wines), TRIPLE ZERO (tequila and liqueurs), and ZERO LIMIT (smoothies) are all registered for various beverages without a disclaimer of zero. Application Serial No. 78580598, applicant's Response to Office Action, dated October 3, 2005.

These instances tend to show that when ZERO is not used in direct association with beverage ingredients, the treatment of ZERO as merely descriptive is mixed, at best. The evidence indicates that while ZERO may describe the particular amount of an ingredient or the nutritional content, by itself, ZERO only describes a general absence of some ingredient normally present. Thus, we are convinced that while ZERO merely describes a feature or characteristic of soft drinks, it is not so highly descriptive as to identify a product category.

Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness. Moreover, the burden is particularly heavy when that use has not been exclusive. *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use not sufficient given similarity of configuration to other guitars).

We first consider opposer's claim that applicant's evidence is insufficient to establish acquired distinctiveness. Ambev argues that TCCC must prove acquired distinctiveness as of the date the Section 2(f) claim was made, and not as of the pendency of these proceedings. Opposer's Br. at 22. This is incorrect. It is well-settled that acquired distinctiveness and buyer recognition are to be tested in an opposition proceeding as of the date the issue is under consideration. The filing date or even the publication date is not a cutoff for any evidence developing after that time. Evidence of sales and advertising after the filing date of the application will be considered. See *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *Harsco Corp. v. Elec. Sci., Inc.*, 9 USPQ2d 1570 (TTAB 1988); and *Kaiser Aluminum & Chem. Corp. v. Am. Meter Co.*, 153 USPQ 419 (TTAB 1967).

***8** TCCC's eight years of continuous use since at least 2004 on SPRITE ZERO, COCA-COLA ZERO and the other ZERO marks is more than five years contemplated by Section 2(f), but this is not necessarily conclusive or persuasive on the showing of acquired distinctiveness. In prior cases involving usage of comparable or even longer duration, and with some of these uses even being coupled with significant sales and advertising expenditures (not to mention direct evidence of customers' perceptions), the Board or its primary reviewing court has found a failure to demonstrate acquired distinctiveness within the meaning of Section 2(f). See *In re Andes Candies, Inc.*, 478 F.2d 1264, 178 USPQ 156, 158 (CCPA 1973); and *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

Applicant's sales, on the other hand, suggest that applicant has enjoyed a substantial degree of success with its ZERO line of beverages. In application Ser. No. 78580598 for the mark COCA-COLA ZERO, TCCC identified sales in the two years preceding its 2007 claim of acquired distinctiveness as exceeding one billion dollars, with over one-third of that amount attributable to sales of COCA-COLA ZERO alone. By 2007, over fifty million 288-fluid ounce cases of COCA-COLA ZERO had been sold by Applicant. Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007; Baker Test. at 62, Exh. 19. These are significant numbers by any measure. Furthermore, according to the non-confidential portions of the Baker testimony, sales of the ZERO line of beverages, including COCA-COLA ZERO, SPRITE ZERO, PIBB ZERO, FANTA ZERO, and other ZERO beverages have increased in the ensuing years to over four billion dollars, with over eight hundred and sixty million cases of COCA-COLA ZERO being sold. Baker Test. at 67, 70.

Advertising expenditures since 2004 likewise are a substantial sum. By early 2007, TCCC claimed that it had spent in excess of one hundred fifty million dollars advertising and promoting its ZERO family of beverage products, which includes COCA-COLA ZERO, SPRITE ZERO, FANTA ZERO, VAULT ZERO, and PIBB ZERO, through a myriad of advertising and promotional channels. Applicant has spent over one hundred million dollars advertising and promoting COCA-COLA ZERO alone.

Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007. Again, we note that these are significant numbers by any measure. According to the non-confidential portions of the Baker testimony, TCCC's advertising expenditures for its entire line of ZERO line of beverages had risen to five hundred and thirty seven million dollars by mid-2010. Baker Test. at 111-112.

TCCC also has submitted a variety of advertising samples showing how the ZERO line of beverages is presented to consumers. The following representative example is from the Section 2(f) showing in application Serial No. 78580598:



*9 Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007. We agree with TCCC that such advertisements attempt to convey to the consumer that ZERO as used on the goods is intended to serve in a “trademark sense as part of the product brand name” and not merely as conveying nutritional information. Applicant's Br. at 21.

Both during examination and during this proceeding, TCCC submitted numerous articles demonstrating unsolicited media coverage of its ZERO line of marks. Most of these fall into the category of press releases picked up by media outlets or stories about marketing campaigns. Nevertheless, the articles show that the ZERO line of beverages and TCCC's numerous marketing campaigns have been widely discussed in the media.

Finally, both parties submitted surveys. Ambev introduced the survey and testimony deposition of Dr. Dupont who sought to determine “the main function of the word “zero” . . . in the brand name Coca-Cola Zero.” Dupont testimony at 6. The concern with the Dupont survey is that it is a survey more of meaning than source identification. The source identifying function of a trademark and the “main function” - as Dr. Dupont put it - of a word in that mark are not necessarily the same things. If, as Ambev argues, the term ZERO is merely descriptive, it would not be inconsistent for consumers to view the term ZERO as both describing a characteristic of COCA-COLA ZERO while still perceiving the term to be a source indicator. The “main function” premise of the survey and source identification are not mutually exclusive. Put another way, it is possible that a “main function” of ZERO in TCCC's marks is to identify a characteristic of applicant's goods, but consumers nevertheless may have come to recognize that applicant is the only entity that identifies the characteristic of its goods in that manner. It is not enough that consumers merely know that ZERO means “something” is missing from COCA-COLA ZERO. The survey needs to test whether consumers view ZERO in the marks as indicating a source of the goods.

TCCC's rebuttal survey was more on point. Rather than look for the "main function" of ZERO, the Simonson survey attempted to rebut the Dupont survey by determining whether ZERO in COCA-COLA ZERO served a trademark function. The Simonson survey examined acquired distinctiveness to see if ZERO was associated with one company or more than one company. Applicant's Br. at 26. Simonson found that 61% of respondents "perceive" that ZERO was associated with only one company as opposed to 6% for the term DIET. Simonson Test. pp. 56-57.

We find that the Simonson survey validates the significant sales and advertising numbers discussed above. Consumers have been exposed to TCCC's ZERO products and advertising on television, over the radio, via print media, and in every conceivable retail outlet. Billions of the products have been sold since 2004. Ambev's attempt to show that the ZERO marks have not acquired distinctiveness simply fails in light of the scope of TCCC's significant sales and marketing numbers.

*10 Opposer also argues that applicant has not enjoyed exclusive use of ZERO on beverages due to third-party use of ZERO on a variety of beverages as well. Opposer's Br. at 27. As an initial matter, there is no requirement that TCCC's use be entirely exclusive. It need only be substantially exclusive. The substantially exclusive standard makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Davoil, Inc.*, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999).

Opposer's evidence does not establish substantial third party use of ZERO in connection with soft drinks and/or syrups. While several third parties may have made use of ZERO in connection with beverages and numerous third parties have used "zero-calorie," "zero-carbs," and other such highly descriptive zero-formative phrases, such use does not undercut TCCC's claim of acquired distinctiveness. We find that the cumulative effect of TCCC's use of ZERO in connection with its line of beverages is so extensive that it qualifies as "substantially exclusive" as required under Section 2(f). *Kichler* at 1309.

We conclude that applicant's use has been substantially exclusive and that the evidence of record is sufficient to support registration on the Principal Register under Section 2(f).

DECISION: The oppositions are dismissed with prejudice.

Footnotes

- 1 Consolidated on May 5, 2008, December 24, 2008 and March 6, 2009.
- 2 Application Ser. No. 78316078, filed October 20, 2003, alleging first use anywhere and in commerce on September 13, 2004.
- 3 Application Ser. No. 78580598, filed March 4, 2005, alleging first use anywhere and in commerce on June 13, 2005.
- 4 Application Ser. No. 78620677, filed May 2, 2005, alleging a bona fide intent to use the mark.
- 5 Application Ser. No. 78664176, filed July 6, 2005, alleging first use anywhere and in commerce on June 13, 2005.
- 6 Application Ser. No. 78698990, filed August 24, 2005, alleging first use anywhere and in commerce on December 2, 2005.
- 7 Application Ser. No. 77097644, filed February 27, 2007, alleging first use anywhere and in commerce as July 2005.
- 8 Application Ser. No. 76674382, filed March 22, 2007, alleging a bona fide intent to use the mark.
- 9 Application Ser. No. 76674383, filed March 22, 2007, alleging a bona fide intent to use the mark.
- 10 Application Ser. No. 77175066, filed May 8, 2007, alleging first use anywhere and in commerce on January 29, 2007.
- 11 Application Ser. No. 77175127, filed May 8, 2007, alleging a bona fide intent to use the mark.
- 12 Application Ser. No. 77176279, filed May 9, 2007, alleging first use anywhere and in commerce on January 29, 2007.
- 13 Application Ser. No. 77176127, filed May 9, 2007, alleging a bona fide intent to use the mark.
- 14 Application Ser. No. 77176108, filed May 9, 2007, alleging a bona fide intent to use the mark.
- 15 Application Ser. No. 77176099, filed May 9, 2007, alleging a bona fide intent to use the mark.
- 16 Application Ser. No. 77257653, filed August 17, 2007, alleging a bona fide intent to use the mark.
- 17 Application Ser. No. 77309752, filed October 22, 2007, alleging first use anywhere and in commerce as May 2008.
- 18 Application Ser. No. 77413618, filed March 5, 2008, alleging a bona fide intent to use the mark.

- 19 Neither party challenged the qualifications of the other's expert; we therefore accept that both experts are qualified to offer expert testimony.
- 20 Application Ser. No. 77181474, filed May 15, 2007, pursuant to Section 1(b) of the Trademark Act.
2012 WL 1881492 (Trademark Tr. & App. Bd.)

End of Document

© 2013 Thomson Reuters. No claim to original U.S. Government Works.

2013 WL 3188897 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN-N-OUT BURGERS

v.

FAST LANE CAR WASH & LUBE, L.L.C.

Opposition No. 91183888 to application Serial No. 77234104

March 14, 2013

*1 Robert J. Lauson of Lauson and Tarver LLP for In-N-Out Burgers
Richard L. Schnake of The Law Firm of Neale & Newman LLP for Fast Lane Car Wash & Lube, LLC

Before Quinn, Cataldo and Hightower
Administrative Trademark Judges
Opinion by Cataldo
Administrative Trademark Judge:

Fast Lane Car Wash & Lube, L.L.C. (“applicant”) filed an application to register the mark IN & OUT CAR WASH, with “CAR WASH” disclaimed, on the Principal Register in standard characters, for “automobile cleaning and car washing; automobile washing; car washing; vehicle washing” in International Class 37.¹ Applicant filed the application based on use in commerce, pursuant to Trademark Act § 1(a), 15 U.S.C. § 1051(a), asserting first use anywhere and in commerce as of April 15, 2005.

Registration has been opposed by In-N-Out Burgers (“opposer”) on grounds of (1) priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and (2) dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).² Opposer, in its second amended notice of opposition, alleges that since as early as 1948, it has continuously used in interstate commerce the mark IN-N-OUT BURGERS in connection with drive-through restaurant services, and obtained a registration for its IN-N-OUT mark (Reg. No. 1085163) in connection with restaurant and carry-out restaurant services on February 7, 1978. Since that time, opposer has obtained registrations for marks containing the wording “IN-N-OUT” in standard characters as well as composite marks incorporating an arrow design and the wording “IN-N-OUT BURGER” for various menu items (Reg. Nos. 1522799, 1525982, 1101628, and 1101638) and promotional goods (Reg. Nos. 2217307, 1514689 and 1960015). Opposer also owns a composite mark incorporating an arrow design and the wording “IN-N-OUT BURGER” for financial sponsorship of race cars and race car drivers (Reg. No. 3367471³), and has subsequently acquired⁴ ownership of a registration for IN & OUT in standard characters in connection with motor vehicle body repairing and painting, which has been used in commerce since February 1981 (Reg. No. 1780587).

*2 Opposer alleges that as a result of such use, its marks have achieved a high degree of public recognition and renown, and have received extensive media attention. Opposer alleges, therefore, that applicant's use of its IN & OUT CAR WASH mark in connection with car wash and related services will likely lessen the capacity of opposer's marks to identify and distinguish opposer's services and goods, regardless of the presence or absence of competition between the parties, and is likely to cause confusion, mistake and deception.

In its answer, applicant has denied all of the salient allegations in the second amended notice of opposition.⁵

The Record

By rule, the record includes the pleadings and the file history of the subject application. [Trademark Rule 2.122\(b\)](#), 37 CFR § 2.122(b). In addition, the parties introduced the following testimony and evidence:

Opposer's evidence

1. Opposer's Notice of Reliance comprising ("Opp. NOR"):

- a. Transcript and exhibits from the discovery deposition of applicant's co-owner and Managing Member, Greg Byler, taken on August 26, 2011 ("Opp. Byler Test.").
- b. Transcript and exhibits from the discovery deposition of opposer's Vice President and General Counsel, Arnold Wensinger, taken on September 6, 2011 ("Opp. Wensinger Test.").
- c. Transcript and exhibits from the testimony deposition of Mr. Byler, taken on October 27, 2011 ("App. Byler Test.").
- d. Transcript and exhibits from the video conference testimony deposition of Mr. Wensinger, taken on September 21, 2010 ("App. Wensinger Test.").
- e. Applicant's response to opposer's request for admissions.
- f. Applicant's response to opposer's first set of interrogatories and requests for production of documents.
- g. Applicant's response to opposer's second set of interrogatories and requests for production of documents.
- h. Applicant's supplemental responses to opposer's first set of interrogatories and requests for production of documents.⁶
- i. Publicly available articles, documents, Internet materials and books relied upon to demonstrate opposer's use, fame, and association with cars and car-culture.

2. Opposer's Notice of Reliance in Rebuttal comprising ("Opp. Rebuttal NOR"):

- a. Publicly available articles and Internet materials relied upon to demonstrate the fame of opposer's marks through unsolicited word-of-mouth marketing.
- b. DVD entitled "California's Gold: In-N-Out Burger" relied upon to demonstrate the fame of opposer's marks through unsolicited word-of-mouth marketing.
- c. Third-party registrations relied upon to demonstrate that certain of applicant's types of services are offered alongside opposer's types of services.

*3 d. Third-party Internet evidence relied upon to demonstrate that certain of applicant's types of services are offered alongside opposer's types of services under common law marks.

Applicant's evidence

1. Transcript and exhibits from the trial deposition of Mr. Byler, taken on October 27, 2011 ("App. Byler Test." in opposer's 1(c) above).

2. Applicant's Notice of Reliance comprising ("App. NOR"):

- a. Excerpts from transcript and exhibits from the video conference deposition of Mr. Wensinger, taken on September 21, 2010 ("App. Wensinger Test." in opposer's 1(d) above).
- b. Specific requests from applicant's first request for admissions to opposer, deemed admitted because of opposer's failure to respond.
- c. Opposer's responses and objections to applicant's third set of interrogatories to opposer.
- d. Opposer's first supplementation of its responses and objections to applicant's second set of interrogatories to opposer.
- e. Opposer's responses and objections to applicant's second set of interrogatories to opposer.
- f. Opposer's supplementation of its responses and objections to applicant's revised first set of interrogatories and requests for production.
- g. Opposer's responses and objections to applicant's revised first set of interrogatories to opposer and applicant's first revised request for production.
- h. Publicly available Internet documents and articles relied upon to demonstrate the extent of actual recognition of opposer's marks, and that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States.
- i. Third-party registrations relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.
- j. Official TTAB records for opposer's oppositions against third-party marks relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.
- k. Official records from civil action proceedings in various U.S. district courts involving opposer, relied upon to demonstrate that opposer's marks are not famous because they are not widely recognized by the general consuming public of the United States, and the extent to which opposer is engaged in substantially exclusive use of its marks.⁷

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief.

Evidentiary Matters

Before addressing the merits of the case, certain evidentiary matters require our attention. Opposer has objected to applicant's reliance on survey evidence, third-party registrations, and prior oppositions initiated by opposer against third parties. We note that none of the evidence sought to be excluded or restricted with regard to the purpose for which it has been submitted is outcome determinative. Therefore, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say that we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

The Parties

Opposer

*4 Beginning in 1948, opposer began a regional chain of IN-N-OUT BURGER drive-through restaurants, which at the time of trial number 262 restaurants, exclusively within the states of California, Nevada, Utah, Arizona and Texas. Opp. Brief at p. 4; Opp. Wensinger Test. at 35, 134, 136-37. Opposer also sells gift cards, apparel, and collectibles through its store locations, catalogs and website. Opp. Brief at p. 4; Opp. Wensinger Test. at 88-91, 113-14, Exs. 640-644; App. Wensinger Test. at 36.

Opposer additionally is involved in the financial sponsorship of race cars and race car drivers,⁸ Opp. Wensinger Test. at 85, Ex. 637; App. Wensinger Test. at 49-51, Ex 10, as well as motor vehicle body repairing and painting through its controlled licensee. Sec. Amend. Opp. at para. 9; Opp. Wensinger Test. at 98-99, Ex. 649.

Applicant

Applicant began using its IN & OUT CAR WASH mark in commerce in April of 2005. App. Byler Test. at 7. Applicant is in the car wash business and owns two car wash facilities, the Joplin, Missouri facility that opened in 2005 and the Springfield, Missouri facility that opened in 2007. Applicant also is in the business of providing consulting services to car wash operators. *Id.* at 3-4, 7; Opp. Byler Test. at 23.

Mr. Byler had initially selected the mark "Fast Lane Car Wash & Lube" for applicant's business, but decided on IN & OUT CAR WASH instead because a "Fast Lane Car Wash" already existed nearby. App. Byler Test. at 26-27; Opp. Byler Test. at 26. Mr. Byler derived the concept of a faster car wash in response to a common complaint from consulting clients that car wash services operate slowly, so he sought a mark that conveyed a message of quick car wash services. App. Byler Test. at 3, 13-15, 26-27; Opp. Byler Test. at 55-57. He ultimately selected the IN & OUT CAR WASH mark because it suggests to consumers that their cars will be washed quickly, and that applicant's car wash services include the inside and outside of a vehicle. App. Byler Test. at 27; Opp. Byler Test. at 27. The only clearance search that Mr. Byler conducted when deciding on the IN & OUT CAR WASH mark was a search for available domain names, which only revealed a similar mark for a car wash in Canada. App. Byler Test. at 27-28; Opp. Byler Test. at 27-28. Mr. Byler had no knowledge of opposer until after applicant's car wash opened in Joplin, when a customer visiting from California asked him if he had ever heard of In-N-Out Burger.⁹ *Id.* at 24-26; Opp. Byler Test. at 29.

Applicant's car wash services feature cleaning services for the interior and exterior of vehicles, including detail cleaning. App. Byler Test. at 5, 28-30; Opp. Byler Test. at 25. The polishing services that applicant offers may involve rubbing some scratches off a car's painted surface; however, applicant's car wash services do not include repair of scratches, dent removal, windshield repair, or paint touchup. App. Byler Test. at 30-31; Opp. Byler Test. at 25-26.

*5 Until May 2008, applicant also provided lube services at its Joplin location, which involved basic maintenance of vehicles in a short amount of time, such as oil changes, fluid checks, transmission services, air filter changes, and tire setting. App. Byler Test. at 18; Opp. Byler Test. at 24-25.

Standing

In determining whether opposer has established its standing to bring this proceeding, we first consider whether opposer has proven that it is the owner of valid and subsisting registrations for its pleaded marks. In this case, opposer introduced a copy of Registration No. 1780587 under [Trademark Rule 2.122\(d\)\(1\)](#) with its second amended notice of opposition on January 4, 2010.¹⁰ Sec. Amend. Opp. at para. 9. Opposer indicates it submitted copies of its other nine pleaded registrations with its original and two amended notices of opposition. However, no copies of opposer's other pleaded registrations were made of record with its pleadings. Opposer further submitted a copy of its pleaded Registration No. 3367471 with its notice of reliance.

In its answer to the second amended notice of opposition, applicant admits to opposer's ownership of several of its pleaded registrations, but not to their status. Sec. Amend. Answer at paras. 2-9. As a result, applicant's admissions are insufficient to prove that opposer's pleaded registrations are valid and subsisting. In addition, applicant made of record copies of opposer's pleaded Registration Nos. 1085163, 1522799, 1525982, 1101628, 1101638, and 2217307 showing status and title to opposer as of 2007, and 3367471, showing status and title to opposer as of 2009. App. NOR. at 874-891. We observe that applicant submitted these registrations as part of the official records of lawsuits involving opposer and third parties during its assigned testimony period in November 2011 to demonstrate that the marks in opposer's pleaded registrations are not famous. However, none of this evidence calls into question opposer's ownership of these registrations or their status as of the date the referencing documents were created. Indeed, in their respective summaries of the record in their briefs, both opposer and applicant assert that opposer's pleaded registrations are of record and so treat them. (Opp. Brief at 2; App. Brief at 8).

We therefore accept that opposer's pleaded Registration Nos. 1780587, 1085163, 1522799, 1525982, 1101628, 1101638, 2217307 and 3367471 are valid and subsisting and that, as a result, opposer has established its standing with regard to the marks protected thereby and the goods or services recited therein.¹¹ See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1026-1027, 213 USPQ 185 (CCPA 1982).

Priority of Use

*6 Priority is not in issue in an opposition if an opposer establishes that it is the owner of a subsisting registration on the Principal Register. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Otter Products*, 105 USPQ2d 1252, 1254-55 (TTAB 2012), and cases cited therein. Because opposer established ownership of its above-listed registrations, priority is not an issue with respect to Registration Nos. 1085163, 1522799, 1525982, 1101628, 1101638, 2217307, 3367471 and 1780587.

We note that opposer has acquired rights to the mark in Registration No. 1780587 by assignment as a result of a purchase and license back agreement. Opposer is correct, and applicant does not dispute, that rights in this registration accrue to opposer. *Visa, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982). Therefore, opposer has established priority with respect to this registration, notwithstanding its acquisition by opposer subsequent to the commencement of this proceeding.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Family of marks not asserted

We begin by observing that opposer does not contend that all or a portion of the marks in its pleaded registrations constitute a family of marks. Therefore, we will determine the issue of likelihood of confusion based on the individual marks that are the subject of opposer's registrations of record.

Opposer's Registration No. 1780587

In our analysis, we will concentrate our discussion of the issue of likelihood of confusion on opposer's registration of record which is most similar to that of applicant, namely, Registration No. 1780587 for the mark IN & OUT (typed or standard characters) reciting "motor vehicle body repairing and painting" in International Class 37. If likelihood of confusion is found between the application at issue and this registration, it will be unnecessary to determine whether confusion is likely as to the remainder of opposer's registrations of record. Conversely, if likelihood of confusion is not found between the involved application and this registration, we would also find that confusion is not likely with opposer's remaining pleaded registrations, for the marks IN-N-OUT; IN-N-OUT and arrow design; and IN-N-OUT BURGER and arrow design, reciting:

*7 "restaurant services and carry-out restaurant services;"

"milk and French fried potatoes for consumption on or off the premises;"

"lemonade and soft drinks for consumption on or off the premises;"

"cheeseburgers, hamburgers, hot coffee and milkshakes for consumption on or off premises;"

"watches;"

"decals in the nature of bumper stickers, publications in the nature of house organs, gift certificates;"

"backpacks;"

"coffee mugs and thermal mugs;"

"shirts, baseball caps, letterman's jackets, and cooks aprons;" and

"financial sponsorship of race cars and race car drivers."

Fame of opposer's IN-N-OUT marks

We note that opposer has argued and introduced testimony and evidence that its IN-N-OUT marks are famous for its restaurant services and menu items. While, as discussed above, we are concentrating our likelihood of confusion analysis on opposer's Registration No. 1780587 for the mark IN & OUT (typed or standard characters) reciting "motor vehicle body repairing and painting," we nonetheless address opposer's assertions regarding fame of its marks as to restaurant services and the menu items served therein.

Fame plays a dominant role in the likelihood of confusion analysis due to the fact that famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as by the general reputation of the branded products and services. *Bose*, 63 USPQ2d at 1305-06, 1309. Although raw numbers of product and service sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

*8 Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Leading Jewelers Guild, Inc. v. LJOV Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Upon careful review of the record in this case, we find that although opposer has established that its marks are strong and have gained notoriety for its restaurant services and menu items, we are not persuaded that opposer's IN-N-OUT marks are famous for any of its goods or services.

Opposer's sales

Opposer operates 262 restaurant locations within five states, California, Nevada, Utah, Arizona and Texas, and does not have facilities in any other state. Opp. Brief at p. 4; Opp. Wensinger Test. at 35, 134. Opposer's only means for selling food is its 262 restaurant locations. Opp. Wensinger Test. at 113-114. However, opposer sells gift cards, apparel, and collectibles through its store locations, catalogs and website. Opp. Brief at p. 4; Opp. Wensinger Test. at 88-91, 113-14, Exs. 640-644; App. Wensinger Test. at 36.

Opposer states that because it is a private company, it is not required to, and does not, release annual sales figures.¹² Opp. Brief at p. 4. Therefore, opposer simply relies on Mr. Wensinger's testimony that opposer's sales figures on record are "significantly lower than actual," and that sales are routinely underrepresented when ranked alongside other nationally famous brands. Opp. Brief at p. 4; Opp. Wensinger Test. at 31-32, Ex. 608. For example, Mr. Wensinger explained that QSR Magazine ranked opposer only 48th nationally in overall sales in 2005, but that this rank is likely much lower than opposer's actual rank in yearly sales because opposer's sales per location are the highest in the United States. *Id.* Mr. Wensinger further testified that even though opposer's sales are strong, they are not near the level of sales of a restaurant chain such as McDonalds. Opp. Wensinger Test. at 129-30. With respect to its merchandising products, Mr. Wensinger testified that, for instance, less than 1% of its gross sales of logo merchandise were to consumers in Missouri and Arkansas (states in which opposer does not operate restaurants) between the years 2004 to 2008. App. Wensinger Test. at 37, 41-43.

Opposer does not offer any evidence to support its asserted sales figures or that its sales per location are indeed the highest in the United States. Moreover, Mr. Wensinger's testimony does not provide any market share context represented by its sales, making it very difficult for us to determine whether they are substantial for the purpose of determining fame. To the contrary, testimony that its system-wide sales are not near McDonald's comparable sales, and that its merchandise sales to Missouri and Arkansas only represent less than 1% of its gross merchandise sales, all indicate that opposer's sales are made to a limited market share of the general consuming public in the United States.

Opposer's marketing and advertising

*9 Mr. Wensinger testified that opposer's current advertising budget is just under \$10 million per year, and that it has spent a minimum of \$6.5 million per a year on conventional advertising over the past ten years. Opp. Brief at 5; Wensinger Test. at 21. Mr. Wensinger also testified that opposer's advertising is nationwide, through promotion for sporting events that are picked up for national broadcasts, as well as advertising on AM radio stations, social media outlets, opposer's website, and interstate highway billboards seen by drivers from all across the country. Opp. Brief at 5; Wensinger Test. at 23-25, Exs. 605-606.

Closer examination of Mr. Wensinger's testimony and related exhibits, however, indicate that opposer's radio and television advertising for 2005, which Mr. Wensinger testified is representative of opposer's media plan for the past ten years, appears to be limited to geographic areas local to opposer's business locations, such as Los Angeles, Las Vegas, and Phoenix. Opp. Wensinger Test. at 23-25, Ex. 605. Similarly, opposer's interstate billboards promote specific store locations and are strategically placed in close proximity to the respective locations with directional information. Opp. Wensinger Test. at 26, Ex. 606. Based on the evidence, consumers must be within the physical range of opposer's marketing efforts for exposure to the advertisements. While

non-local travelers to the area may be exposed to the advertisements, we cannot speculate as to the market share of the general consuming public in the United States that those travelers represent.

The same is true for Mr. Wensinger's testimony and evidence that opposer has 2,000,000 fans or "likers" on Facebook. Opp. Wensinger Test. at 28. There simply is no supporting evidence as to where those fans are located and what share of the relevant consuming public they represent for us to determine the question of fame. Presumably, a significant portion of opposer's Facebook fan-base represents consumers local to opposer's business establishments who are specifically familiar with opposer. It is impractical for us to determine fame based on the marketing evidence before us.

Opposer's word-of-mouth marketing

Mr. Wensinger testified that opposer focuses on the quality of its products and customer experience, which results in the word-of-mouth advertising that opposer seeks. Opp. Wensinger Test. at 38-39. For that reason, Mr. Wensinger testified that opposer's reputation is national in scope, even global with brand recognition reaching as far as Japan, the United Kingdom and Australia. Opp. Wensinger Test. at 46-47. However, Mr. Wensinger's testimony is wholly unsupported and speculative without evidence of specific context and reference.

Unsolicited media attention and celebrity recognition

The record demonstrates that opposer is the subject of very favorable and unsolicited attention from media sources and celebrities, and includes the following representative sample:

- ***10** 1. Ed Levine, *The Burger Takes Center Stage*, N.Y. Times, Jan. 15, 2003. Opposer's NOR, para. 5, Ex. 705 (See para. 3);
2. Raymond Sokolov, *The Best Burger*, Wall St. J., March 10, 2007. Opposer's NOR, para. 6, Ex. 706 (See para. 19);
3. *Winning Weight*, People Mag., Oct. 16, 2006. Opposer's NOR, para. 7, Ex. 707 (See para. 1);
4. Editorial board information page of Glamour Mag. in Nov., 2007. Opposer's NOR, para. 9, Ex. 709;
5. Monica Eng, *Fast Food that Even a Foodie Could Love*, Chicago Tribune, Oct. 4, 2005. Opposer's NOR, para. 10, Ex. 710 (See paras. 3-16);
6. Deb Peterson, *Local Pals Make Movie for Texas Film Festival*, St. Louis Post-Dispatch, Feb. 16, 2008. Opposer's NOR, para. 11, Ex. 711 (See para. 4); and
7. Bruce Horovitz, *In-N-Out Burger Gives Ad Business to Seattle Agency*, L.A. Times, Oct. 11, 1989. Opposer's NOR, para. 13, Ex. 713 (See paras. 1-9).

While the evidence certainly indicates that opposer has received favorable mention and recognition beyond its regional presence, it is not an indication of how significant that recognition is with the general consuming public overall. Consumers who do not read the specific articles, do not watch the specific Internet videos, and do not observe the celebrity attention that opposer and its marks receive cannot be presumed to be familiar with opposer and its marks. Again, opposer has not provided any evidence whatsoever demonstrating the level of recognition the general consuming population in the United States has of its marks.

As we noted in a case with some similarities (but a better developed record on fame):

Opposer certainly has enjoyed considerable success with its restaurants. Opposer's sales in the period 1986-1992 exceed \$3.3 billion, with 1992 sales of over \$614 million. Opposer traditionally spends 4% of its gross sales revenues on advertising. Opposer's figures for the period 1983-1990 show that opposer spent almost \$247.5 million on advertising, with expenditures in 1990 of \$39.2 million.

The evidence of record, when taken as a whole, indicates that opposer's star marks are well known in its specific area of operation, namely California, Arizona, Oregon and Nevada. In other words, the evidence does not establish that opposer's marks are nationally famous. Rather, opposer has established local notoriety in its trading area.

Carl Karcher Enters. Inc. v. Stars Rests. Corp., 35 USPQ2d 1125, 1130 (TTAB 1995).

Similarly, the totality of opposer's evidence in this case falls short of convincing us that opposer's IN-N-OUT marks are famous. While opposer undoubtedly enjoys a devoted following and business success, at least within its areas of operation, it has not clearly shown a level of recognition for its mark which would justify the heightened scope of protection afforded truly famous marks.

Decisions of other courts

*11 Finally, opposer relies on a decision by the Supreme Court of the Philippines and the Bureau of Legal Affairs findings that opposer's IN-N-OUT mark is famous. Opp. Brief at 6. However, a "decision by another court based upon a different record is not evidence in this proceeding." *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1665 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). By statute, this Board has the duty to decide the right to federal registration in an opposition. 15 U.S.C. § 1067(a). "This duty may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an opposition must be decided on the evidence of record." *Citigroup Inc.*, 94 USPQ2d at 1665.

Again, in view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of opposer, the party asserting that its marks are famous, to clearly prove it. Based on the evidence presented by opposer, we cannot conclude that its marks are famous for purposes of a likelihood of confusion analysis.

Inherent distinctiveness and mark strength

In addition to the fame or renown of a mark, we also consider the inherent distinctiveness of the mark, *i.e.*, where it fits in the continuum described as ranging from generic through fanciful. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ2d 759, 764 (2d Cir. 1976). While "the lines of demarcation ... are not always bright," *id.*, it is axiomatic that those marks which are highly distinctive are usually entitled to a broader scope of protection, while marks falling towards the other end of the spectrum typically enjoy little or no protection.

We find in this case that both opposer's and applicant's marks are suggestive in that they both convey a message about the respective services. That is, the marks both indicate to the prospective customer that the services are performed quickly, in particular that the customer can drive "in and out." App. Byler Test. at 27; Opp. Byler Test. at 27; Opp. Wensinger Test. at 78; App. Wensinger Test. at 12-13, 28, 30; App. NOR at para. 4, Ex. 804 (para. 53 therein); Opp. Brief at 21. In this respect, while both marks are inherently distinctive, they are less distinctive than purely arbitrary or fanciful marks. As a result, any similarity of the marks is less likely to cause confusion than would be the case if the marks were arbitrary or fanciful. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) ("Where a party chooses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.").

Third-party registrations for similar marks

*12 In our determination of the strength of opposer's marks, we have also considered applicant's evidence and arguments that "countless" marks containing various permutations of the terms "in and out" are in use by third parties. In this regard, applicant submitted third-party evidence in the nature of numerous registrations for marks consisting in whole or in part of the terms "in and out" for a wide variety of goods and services. However, the probative value of this evidence is limited because applicant presented no evidence concerning the extent to which these third-party marks are used in commerce. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Moreover, a review of the third-party registrations reveals that none recite goods or services that are particularly similar to those at issue in this case, and most recite goods and services that are quite different. Thus, applicant's evidence does not establish that there is widespread use of similar marks on related goods and services such that opposer's marks are weak and entitled to only a narrow scope of protection. This factor, therefore, is at best neutral or somewhat favors a finding of likelihood of confusion.

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression

We now turn to the first *du Pont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Id.* In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *See, e.g., In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); and *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.4 (TTAB 1987).

With these principles in mind, we begin our analysis by noting that applicant's IN & OUT CAR WASH mark fully incorporates as its distinctive portion opposer's mark, IN & OUT. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *See, e.g., Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re S. Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG for toy doll carriages and LITTLE LADY for doll clothing).

*13 The wording IN & OUT in both marks is identical in appearance and sound. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *See In re White Swan Ltd.*, 8 USPQ2d at 1535 (TTAB 1988); and *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007). The marks also share the same connotation of quick services, *i.e.*, getting "in and out" without delay.

However, because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the test for similarity cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just on part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); and *e.g., Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

Applicant contends that its mark, in its entirety, engenders a different commercial impression than that of opposer's mark. Applicant states that the wording "CAR WASH" in its mark is a significant distinguishing factor because the "in and out" element of the respective marks is weak. App. Brief at 26-27. However, the wording "CAR WASH" in applicant's mark clearly is generic for its services in this case, and thus incapable of functioning as an indicator of source to distinguish the source of its services from those of opposer. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); and *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). Thus, notwithstanding the suggestive nature of the wording IN & OUT, it is the dominant wording in applicant's mark and the sole feature of opposer's. Our primary reviewing court instructs us that "[t]here 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." *See In re National Data Corp.*, 224

USPQ at 751. For instance, “that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark....” *Id.* at 244 USPQ 751.

*14 We find, therefore, that the dominant and distinctive portion of applicant's mark is identical to opposer's mark and that, when viewed in their entirety, the marks IN & OUT and IN & OUT CAR WASH are more similar than dissimilar in appearance, sound, connotation and overall commercial impression. As a result, this *du Pont* factor favors a finding of likelihood of confusion.

The similarity or dissimilarity and nature of the services in the application and the services in opposer's registration

In determining whether services are related, this *du Pont* factor requires that we must consider the services as they are identified in the respective descriptions in the application and registration. *See, e.g., Paula Payne Prods. v. Johnson Publ'g Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973)*. It is not necessary that the services of applicant and opposer be similar or competitive to support a holding of likelihood of confusion. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. *Miss Universe L.P. v. Community Mktg. Inc., 82 USPQ2d 1562, 1568 (TTAB 2007)*.

Here, applicant is seeking to register its mark for “automobile cleaning and car washing; automobile washing; car washing; vehicle washing.”¹³ Meanwhile opposer, through its licensee, is engaged in “motor vehicle body repairing and painting.”¹⁴

Opposer relies on twenty-four¹⁵ third-party registrations and Internet evidence from eleven third parties to demonstrate that car washing services originate from the same source as vehicle body repairing and painting services. Opp. Brief at 20; Opp. Rebuttal NOR at paras. 17-40, 41-51, Exs. 817-840, 841-851. We note that a number of the third-party registrations are owned by foreign entities, and many of these in addition recite myriad goods and services in multiple classes. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered. *See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993)*. However, opposer's evidence includes approximately fifteen third-party registrations owned by fourteen different entities that are based on use in commerce and recite services including those identified by both parties herein.

We observe that third-party registrations are of very limited probative value on the issue of likelihood of confusion because they are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973)*. *See also In re the Dot Communications Network LLC, 101 USPQ2d 1062, 1067 (TTAB 2011)*. However, opposer additionally made of record the following Internet evidence in support of the relatedness of the services:

*15 1. Anthony's Car Wash and Detail Centers, at www.anthonyscarwash.com (last visited Nov. 16, 2011) (featuring car wash, detail, automotive, paint and body services). Opp. Rebuttal NOR at para. 41, Ex. 841.

2. Collision Masters, at www.collisionmasters.us/Index.html (last visited on Jan. 16, 2011) (no specific services identified other than collision). Opp. Rebuttal NOR at para. 42, Ex. 842.

3. Starbright Auto Body, at www.yelp.com/biz/starbright-auto-body-phoenix (last visited Jan. 16, 2011) (no specific services identified other than auto body). Opp. Rebuttal NOR at para. 43, Ex. 843.

4. Tidal Wave USA, at www.tidalwaveusa.com (last visited Jan. 16, 2011) (relevant exterior services include detailing, hand waxing, swirl free-buffing and scratch removal, headlight restoration, overspray/graffiti removal, paintless dent repair, bumper repair, “clear bra” paint protection film). Opp. Rebuttal NOR at para. 44, Ex. 844.

5. The Yard, at www.superiorcarcare.com/yard.html (last visited Jan. 16, 2011) (relevant services include hand car wash, hand wash & wax, exterior detail, interior detail, color sanding & paint correction, bumper repair, scratch repair, paint touch up, wheel & rim repair, paintless dent repair, windshield replacement, paint protection film). Opp. Rebuttal NOR at para. 45, Ex. 845.
6. Arapahoe Collision and Mechanical, at www.arapahoeauto.com/services.php (last visited Jan. 16, 2011) (detailing services include steam clean, blow out air vents, clean windows & mirrors, leather treatment, steam clean, buff, polish and wax exterior; collision repair services include mechanical repairs, paint matching, paintless dent removal, brake service, oil and filter changes). Opp. Rebuttal NOR at para. 46, Ex. 846.
7. T&J Auto Body, at www.tandjautobody.com (last visited Jan. 16, 2011) (no specific services listed other than fixing cars). Opp. Rebuttal NOR at para. 47, Ex. 847.
8. My Premium Car Wash, at www.mypremiumcarwash.com (last visited Jan. 16, 2011) (relevant services include hand wash, auto detailing, power washing, pressure cleaning). Opp. Rebuttal NOR at para. 48, Ex. 848.
9. Preston Auto Body, at www.sprestonautobody.com (last visited Jan. 16, 2011) (no specific services listed other than collision repair). Opp. Rebuttal NOR at para. 49, Ex. 849.
10. Berardi's Detailing, at www.berardisdetailing.com (last visited Jan. 16, 2011) (relevant services listed include auto detailing, auto body repair, auto painting, car repair, auto glass replacement, paintless dent removal). Opp. Rebuttal NOR at para. 50, Ex. 850.
11. River City Auto Body, at www.rivercityautobody.net (last visited Jan. 16, 2011) (no specific services listed other than repairs). Opp. Rebuttal NOR at para. 50, Ex. 850.

Based on the information available from the evidence of record, five of the above sources state that they offer car washing, cleaning or detail services in addition to auto repair or paint services. However, the probative value of such Internet documents is limited. While they can be used to demonstrate what the documents show on their face, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed. *See* TBMP § 704.08(b) and authorities cited therein. Thus, the Internet evidence made of record by opposer does not prove that the five above-noted entities actually provide car washing and cleaning services as well as car repair and painting services, but simply that the third parties responsible for the Internet postings of record state that such services are available therefrom.

***16** A party may increase the weight given website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. *Id.* However, opposer does not provide such testimony. Rather, Mr. Wensinger testified that, “the primary business of a car wash business is distinct from the primary business of a paint and body shop . . .,” and the washing of a vehicle would be incidental to the repair or painting of a vehicle. App. Wensinger Test. at 114. Thus, the testimony made of record in this case tends to support a finding that the parties' services are unrelated, and does not support opposer's evidence.

Determinations are reached based on the evidence of record. In this case, the evidence falls short of establishing that applicant's car wash services are in fact related to opposer's services. As a result, this *du Pont* factor favors a finding of no likelihood of confusion.

Channels of trade and classes of consumers

As is readily apparent, neither party's recitation of services contains any limitations as to their channels of trade or the purchasers to whom its services are marketed. As a result, and in accordance with our established case law, we must presume that applicant's services move in all channels of trade that are normal therefor and are available to all the usual purchasers thereof.

However, and as discussed above, opposer has failed to introduce sufficient evidence to support a finding that its services under its mark are related to applicant's services in its involved application. As such, we cannot presume that the channels of trade for its services are the same as or overlapping with those in which applicant's services may be encountered. Cf. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade.”).

Further, aside from incidental sales of opposer's ancillary merchandise in the State of Missouri in which applicant is located, neither the nature of the services themselves nor the evidence of record supports a finding that such services travel in common trade channels or are made available to the same customers.

Actual confusion

The final *du Pont* factor discussed by the parties is the lack of instances of actual confusion. Opposer acknowledges that there have been no instances of actual confusion. App. Wensinger Test. at 16-20. Applicant asserts that the absence of actual confusion for seven years at the time of trial suggests no likelihood of confusion. However, as has been said many times, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Furthermore, it has often been recognized that such evidence is very difficult to obtain. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012). Thus, while evidence of actual confusion would mitigate in favor of a finding of likelihood of confusion, the absence thereof is not as compelling in our determination. As a result, this *du Pont* factor is neutral, or at best, slightly favors applicant.¹⁶

Balancing the factors

*17 We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto. In balancing the relevant factors, we conclude that despite the similarities between the parties' marks, there is insufficient evidence that applicant's “automobile cleaning and car washing; automobile washing; car washing; vehicle washing” services are related to opposer's “motor vehicle body repairing and painting,” or that the services are offered in common channels of trade to the same classes of consumers. Based on the foregoing, opposer has not proved likelihood of confusion.

Dilution by Blurring

Opposer claims that use of applicant's mark would be likely to “lessen the capacity of [o]pposer's ... marks to identify and distinguish [o]pposer's services and goods.” Sec. Amend. Opp. at para. 13. In order to prevail on a claim of dilution, opposer must prove, as a threshold matter, that its mark became famous prior to applicant's first use. Trademark Act § 43(c)(1). As we have noted in other cases, “[f]ame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving “fame” for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of “fame” in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

As noted, we do not find opposer's marks famous for likelihood of confusion purposes. Since it is even harder to prove fame for dilution purposes, we need go no further; because opposer has not established that its marks are famous, it cannot prevail in its dilution claim.

Decision: The opposition to the registration of applicant's mark is dismissed.

Footnotes

- 1 Application Serial No. 77234104 was filed on July 19, 2007 and published for opposition in the *Official Gazette* on January 8, 2008.
- 2 Opposer also pleaded (1) mere descriptiveness based upon its assertion that the mark directly conveys information concerning the function, characteristics, qualities, purpose and underlying use of applicant's services within the meaning of Trademark Act § 2(e) (1), 15 U.S.C. § 1052(e)(1), and (2) that applicant's use of its mark in connection with the services set forth in the application is not use in "commerce" within the meaning of Trademark Act § 45, 15 U.S.C. § 1127. However, these claims are deemed waived because opposer failed to argue and present evidence with regard thereto at trial or in its briefs.
- 3 Opposer filed the application for Registration No. 3367471 on November 14, 2006, alleging a date of first use in commerce of 1985, and it matured to registration on January 15, 2008.
- 4 Opposer acquired ownership of Registration No. 1780587 on March 13, 2009, after commencement of this proceeding. *See* Assignment Reel/Frame 3952/0116.
- 5 Also, in its answer to the second amended notice of opposition, applicant asserts as affirmative defenses matters that are more in the nature of amplifications of its denials of opposer's claims and have been so construed. In addition, the exhibits to applicant's answer to the second amended notice of opposition are not evidence on behalf of applicant, except to the extent that they were identified and introduced in evidence during applicant's period for the taking of testimony. Trademark Rule 2.122(c); and TBMP §317 (October 2012).
- 6 Portions of the responses and documents have been designated "confidential." In this decision, we have endeavored to discuss those portions of the parties' testimony and evidence that truly contain confidential information only in general terms.
- 7 In response to an inquiry made by the Board, applicant's attorney has advised the Board that Exhibit 887 of applicant's Notice of Reliance was not made part of the record, and requested the Board to decide the case based on the existing record.
- 8 Mr. Wensinger has testified that opposer's financial sponsorship of race cars and race car drivers is not actually a service that opposer provides to customers, but is used to promote brand recognition for its restaurant services. *App. Wensinger Test.* at 53.
- 9 It is worth mentioning that the Mr. Byler's testimony about the conversation with this customer does not indicate that the customer was confused as to the source of applicant's car wash or believed applicant's car wash services were in any way related to opposer's drive-through restaurant services. Without testimony from the customer herself, which does not exist in the record, we cannot rely on the conversation for any other purpose than as evidence as to when Mr. Byler first learned of opposer.
- 10 Opposer submitted its second amended notice of opposition to plead ownership of this registration, acquired by assignment as discussed above.
- 11 Because neither party made of record copies of opposer's pleaded Registration Nos. 2285823 and 2291183, we will not consider them in our determination herein.
- 12 We note that opposer had the option of releasing its sales figures under protective order and seal of confidentiality. *See* TBMP § 412 (October 2012).
- 13 Opposer also argues that its services are related to applicant's oil change services. *Opp. Brief* at 20. However, since the application at issue does not recite oil change services, any relationship between oil change services and motor vehicle body repairing and painting services is irrelevant to our determination herein.
- 14 Opposer further argues that it is the original drive through restaurant, it sponsors auto race cars and drivers, and its image and advertisements are immersed in "car culture," and that, as a result of these activities, its core goods and services are related to those of applicant. Opposer points out in addition that both it and applicant rely upon automobile traffic for their business. Nonetheless, opposer acknowledges that it does "not have its associates wash any vehicles at [its] restaurants" and further that its sponsorship of race cars and drivers does not relate to car wash services. *Wensinger Test.* at 15-16, 52. In any event, we are not relying upon opposer's registrations reciting these goods and services and, as a result, the issue of their relationship to applicant's recited services is not before us.
- 15 The twenty-four third party registrations represent nineteen owners that identify both car washing or cleaning services and vehicle repair or painting services.
- 16 We further note that while the "territorial separation" of the regions in which opposer and applicant operate may be relevant to the absence of actual confusion, because both the involved application and cited registration are unrestricted as to their geographic scope, the question of geographic limitations is otherwise irrelevant to our determination herein.

2013 WL 3188897 (Trademark Tr. & App. Bd.)

End of Document

© 2013 Thomson Reuters. No claim to original U.S. Government Works.



KeyCite Yellow Flag - Negative Treatment

Declined to Extend by [Ironclad, L.P. v. Poly-America, Inc.](#), N.D.Tex.,
July 28, 2000

57 F.Supp.2d 665
United States District Court,
E.D. Wisconsin.

NATIONAL FOOTBALL LEAGUE PROPERTIES,
INC. and Green Bay Packers, Inc., Plaintiffs,

v.

PROSTYLE, INC. and Sheri
Tanner, Individually, Defendants.

No. 96–C–1404. | April 28, 1999.

Professional football team sued clothing seller for trademark dilution. On parties' motion in limine, the District Court, [Stadtmueller](#), Chief Judge, held that: (1) plaintiff's expert's survey results would be excluded as unreliable, but (2) any prejudice to plaintiff caused by professional football player's celebrity status did not outweigh probative value of his testimony on behalf of defendant.

Plaintiff's motion granted in part and denied in part; defendant's motion granted.

West Headnotes (3)

[1] Evidence

[Results of experiments](#)

157 Evidence

157IV Admissibility in General

157IV(E) Competency

157k150 Results of experiments

Trademark dilution plaintiff's expert's survey evidence, in which subjects were asked what, if anything, they thought of when they saw allegedly diluting shirts, would be excluded as unreliable; question was asked without further probing and without showing of any "control" shirt. [Fed.Rules Evid.Rule 702, 28 U.S.C.A.](#)

[12 Cases that cite this headnote](#)

[2] Evidence

[Results of experiments](#)

157 Evidence

157IV Admissibility in General

157IV(E) Competency

157k150 Results of experiments

Noncase-specific portion of otherwise excluded expert's report, regarding scientific underpinnings of trademark dilution law, was not of sufficient assistance to jury to warrant admission at trial of claim that defendants had diluted particular trademark. [Fed.Rules Evid.Rule 702, 28 U.S.C.A.](#)

[3] Evidence

[Tendency to mislead or confuse](#)

157 Evidence

157IV Admissibility in General

157IV(D) Materiality

157k146 Tendency to mislead or confuse

Any prejudice to trademark dilution plaintiff caused by professional football player's celebrity status did not outweigh probative value of his testimony on behalf of defendant. [Fed.Rules Evid.Rule 403, 28 U.S.C.A.](#)

Attorneys and Law Firms

*666 [Howard A. Pollack, Daniel T. Flaherty](#), Godfrey & Kahn, Milwaukee, WI, [Robert L. Raskopf](#), White & Case, New York City, for plaintiff.

[John P. Fredrickson](#), Nilles & Nilles, Milwaukee, WI, for defendant.

Opinion

ORDER

[STADTMUELLER](#), Chief Judge.

I. OVERVIEW

Plaintiffs, National Football League Properties, Inc. and Green Bay Packers, Inc., accuse defendants ProStyle, Inc. and Sheri Tanner of unlawfully capitalizing on the Packers' success by selling unauthorized Packer merchandise. In their

complaint, plaintiffs presented six counts for which they claimed relief: federal unfair competition under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); federal trademark infringement under § 32(1) of the Lanham Act, 15 U.S.C. § 1114(1); federal dilution under § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); deceptive advertising law under Wis.Stat. § 100.18(1); common law unfair competition; common law trademark infringement; misappropriation of trade secrets under Wis.Stat. § 134.90; and common law misappropriation of trade secrets. Plaintiffs sought a temporary restraining order and preliminary and permanent injunctions restraining defendants' use of plaintiffs' marks and ordering destruction of infringing materials, as well as damages, including treble damages for willful and deliberate infringement under the Lanham Act, double damages under Wis.Stat. § 100.18(1), and punitive damages under Wis.Stat. § 134.90(4).

On December 30, 1996, the court held a hearing on the motion for a temporary restraining order, and on January 2, 1997, the court denied the motion. On July 25, 1997, the court granted partial summary judgment for defendants on plaintiffs' claims of federal unfair competition, federal trademark infringement, state unfair competition, and state trademark infringement to the extent these claims were based upon unregistered common law trademarks. The court denied summary judgment for defendants on these claims to the extent they were based upon plaintiffs' registered trademarks. The court also granted summary judgment for defendants on plaintiffs' deceptive advertising claim under Wis.Stat. § 100.18(1). On May 19, 1998, the court denied plaintiffs' motion for reconsideration of that decision.

On July 31, 1998, the court considered each side's motions in limine and, inter alia, granted defendants' motion to exclude the expert report and survey of plaintiffs' expert Jacob Jacoby:

Defendants' fourth argument is that the survey's confusion question, "Do you think that, in order to put out this shirt, the company that put it out *did* need to get permission, did *not* need to get permission, or you have no thoughts about this?", improperly asked for a legal conclusion. In *Novo Nordisk of North America, Inc. v. Eli Lilly & Co.*, 96 Civ. 5787, 1996 WL 497018, 1996 U.S. Dist. LEXIS 12807 (S.D.N.Y. Aug. 30, 1996), a similar question formulated by Jacoby caused the court to "discard" his survey results. *Id.* at *26, 1996 WL 497018 *6. As in this case, Jacoby asked whether the producer of the product shown "had *667 to get authorization" to use another's marks. *Id.* at *26 n. 26, 1996 WL 497018 *6 n. 26. The court in *Novo Nordisk* rejected all survey answers to this question because it

"mistakenly ask[ed] respondents what they believe is the legal requirement (because of the use of the phrase 'had to'), rather than asking them merely whether they believed that the maker of the [product] did receive authorization to use the [marks]." *Id.* at *25 n. 24, 1996 WL 497018 *6 n. 24.

Plaintiffs respond that defendants are "nitpicking" and that Jacoby had to insert the phrase "need to get permission" or else most people would respond that they did not know whether or not the maker got permission to make the shirt. The court may have been more sympathetic to this position had Jacoby himself not formulated the same survey question rejected in *Novo Nordisk* and had that court not suggested to him what would have been acceptable. However, Jacoby apparently has not learned from his mistakes which, contrary to plaintiffs' assertions that Jacoby's surveys "have been universally relied upon" and have never been rejected by a court, seem to be numerous. *See, e.g., Novo Nordisk*, 1996 WL 497018, 1996 U.S. Dist. LEXIS 12807, at *26 n. 26; *ConAgra, Inc. v. Geo. A. Hormel & Co.*, 784 F.Supp. 700, 725–28 (D.Neb.1992) (holding that "the Jacoby study ... must be significantly discounted" because of "serious flaws in the study"), *aff'd*, 990 F.2d 368 (8th Cir.1993); *Weight Watchers Int'l, Inc. v. Stouffer Corp.*, 744 F.Supp. 1259, 1274 (S.D.N.Y.1990) (criticizing Jacoby study and noting that "[t]his is not the first time Jacoby's survey findings have been criticized"); *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F.Supp. 1058, 1070 (D.N.J.) (holding that a "number of flaws in the design of [Jacoby's] survey lead me to accord very little weight to its results"), *aff'd*, 834 F.2d 368 (3rd Cir.1987); *Smith v. Ames Dep't Stores, Inc.*, 988 F.Supp. 827, 834 (D.N.J.1997) (holding that "Dr. Jacoby's failure to consider data gleaned from actual consumers limits [his opinion's] value"); *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F.Supp. 279, 291 (S.D.N.Y.1997) (holding that because of flaws, "the Court assigns significantly reduced weight to the Jacoby Survey's results"); *Jim Beam Brands Co., Inc. v. Beamish & Crawford, Ltd.*, 852 F.Supp. 196, 199 (S.D.N.Y.1994) (holding that "Dr. Jacoby's study however, I find to have questionable value because his questions were leading"); *Indianapolis Colts, Inc. v. Metro. Baltimore Football Club Ltd. Partnership*, 34 F.3d 410, 416 (7th Cir.1994) (criticizing "tricks of the survey researcher's black arts" while assessing Jacoby survey); *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F.Supp. 198, 218–19 (D.Md.1988) (rejecting results of Jacoby survey as irrelevant); *Worthington Foods, Inc. v. Kellogg Co.*, 732 F.Supp. 1417, 1446 (S.D. Ohio

1990) (noting flaws in Jacoby study and holding that “the Court does not place great weight on Dr. Jacoby's study”).

Furthermore, defendants correctly point out that Jacoby's conclusion regarding confusion was not stated in terms of what consumers believed should have happened, as the survey question was stated, but instead was phrased in terms of what actually happened, i.e., that consumers believed “that such shirts *were* sponsored or authorized by the Green Bay Packers and/or the NFL.” Jacoby Report at 31 (emphasis added). As the court has said previously, it will not “accord trademark protection based upon the public's mistaken notion of the law.” July 25, 1997 Decision and Order at 26. Therefore, the court will grant defendants' motion in limine regarding all survey answers to the above question and any conclusions based on those answers. Because all four conclusions of the Jacoby study thus must be excluded from trial, the court will exclude his entire report and survey.

*668 *National Football League Properties, Inc. v. ProStyle, Inc.*, 16 F.Supp.2d 1012, 1018–19 (E.D.Wis.1998) (footnotes omitted). Despite excluding Jacoby's entire report and survey, the court did not preclude him from testifying because discovery was ongoing at that juncture. See *id.* at 1019.

A final pretrial conference was held on April 15, 1999, and a jury trial is set to commence on May 3, 1999. On April 20, 1999, defendants moved in limine once again, this time to exclude Jacoby's second expert report and the opinions stated therein. Defendants point out that in response to the court's previous decision excluding Jacoby's entire report and survey, Jacoby did not conduct a new survey but rather used the same survey data in a different way, allegedly to prove dilution under § 43(c) of the Lanham Act instead of secondary meaning and likelihood of confusion. To avoid the court's earlier objections to the survey, Jacoby pared the survey down to essentially one question (other than screening, clarifying, and categorizing questions): when respondents were shown several of defendants' products, they were asked, “What, if anything, do you think of when you see this shirt?” See Fredrickson Decl., Ex. 2 (“Jacoby's Second Report”) at 18.

On April 23, 1999, plaintiffs responded to defendants' second motion in limine and filed their own second motion in limine, seeking to exclude defendants' expert's testimony and report as well as trial and deposition testimony by defendants' witnesses Reggie and Sara White. The court will now consider each side's motion in limine.

II. DISCUSSION

A. Defendants' Motion in Limine

According to the recent Supreme Court decision *Kumho Tire Company, Ltd. v. Carmichael*, 526 U.S. 137, 119 S.Ct. 1167, 143 L.Ed.2d 238 (1999), the district court has a special “gatekeeping obligation” to ensure that all expert testimony “is not only relevant, but reliable.” *Id.* at 1174 (quoting *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 589, 113 S.Ct. 2786, 125 L.Ed.2d 469 (1993)). In this spirit, defendants ask the court to exercise its “gatekeeping obligation” to exclude Jacoby's second report and the opinions stated therein. The court is guided in this task by consideration of some or all of the following factors: whether Jacoby's “theory or technique ... can be (and has been) tested”; whether it “has been subjected to peer review and publication”; whether there is a high “known or potential rate of error” and whether there are “standards controlling the technique's operation”; and whether the theory or technique enjoys “general acceptance” within a “relevant scientific community.” *Daubert*, 509 U.S. at 593–94, 113 S.Ct. 2786.

[1] The court concludes that Jacoby's survey, even as edited to avoid the court's earlier criticisms of it, is seriously flawed. The main problem with the survey (as edited for the second report) is that it essentially asks only one question, “What, if anything, do you think of when you see this shirt?”, without further probing, see 5 J. McCarthy, *Trademarks and Unfair Competition* § 32:176 (1999) (“Without further probing, such a question may well be meaningless and irrelevant.”), and without showing any “control” shirt to any survey respondents or asking any control questions. See, e.g., *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F.Supp. 1103, 1123–24 (S.D.N.Y.1993) (holding that “both surveys contain a complete lack of controls rendering the data meaningless and having no evidentiary value”), *vacated pursuant to settlement*, 859 F.Supp. 80 (S.D.N.Y.1994); see also McCarthy, *supra*, § 32:187 (explaining need for controls to account for “background noise”); Shari Seidman Diamond, *Reference Guide on Survey Research*, in *Reference Manual on Scientific Evidence* at 249–252 (1994) (same); David H. Kaye & David A. Freeman, *Reference Guide on Statistics*, in *Reference Manual on Scientific Evidence* at 348–49 (1994) (“[O]utcome figures from a treatment group without *669 a control group reveal very little and can be misleading. Comparisons are essential.”). For example, the court finds it utterly unremarkable that more than half of Wisconsinites polled

shortly before the Packers' first Super Bowl appearance in nearly 30 years “thought of” the Packers when shown green and gold shirts that said “Green Bay Football” or “Green Bay P.” See Jacoby's Second Report at 26. The court surmises that, in this state and at such a time of Packer-related frenzy, the questioners could have shown the survey respondents a green and gold Blarney stone (an example of a non-diluting use) and more than half of them would have thought of the Packers.

Jacoby's failure to include a control group or question in his second expert report is puzzling for several reasons. First, Jacoby himself has emphasized in both his testimony in other cases and in his academic writing that using a control group in surveys is “absolutely necessary.” Jacob Jacoby, *Experimental Designs in Deceptive Advertising and Claim Substantiation Research*, 954 PLI/Corp 167, 176 (1991); see also Jacob Jacoby, Amy H. Handlin, & Alex Simonson, *Survey Evidence in Deceptive Advertising Cases Under the Lanham Act: An Historical Review of Comments from the Bench*, 954 PLI/Corp 83, 89 (1994) (emphasizing that “there can be no trustworthy or valid assessment of cause and effect unless surveys are intertwined with proper experimental designs (which, of necessity, involve the utilization of proper controls)”); *Graham Webb Int'l v. Helene Curtis Inc.*, 17 F.Supp.2d 919, 930 (D.Minn.1998) (Jacoby criticized the opposing party's expert's survey for “failure to use third party products as a control”).¹ Furthermore, when Jacoby has been asked to prepare surveys to test specifically for dilution in other cases, he has used controls. See *Hershey Foods Corp. v. Mars, Inc.*, 998 F.Supp. 500, 518 (M.D.Pa.1998).

Jacoby's failure to use controls in his second report is even more bedeviling considering that he had this control group information (however imperfect, as the court will discuss) in the survey data and in his first report but omitted it from his second report. In his first report, Jacoby noted that half of all survey respondents were shown defendants' products and half were shown fictitious control products saying, for example, “Ellison Bay Football” or “Ellison Bay P” instead of “Green Bay Football” or “Green Bay P.” See Fredrickson Decl., Ex. 1 (“Jacoby's First Report”) at 4. Because Jacoby had this control group information available to him but omitted it from his second report, it appears logical that he chose not to use it because it is not good news for plaintiffs: roughly 30% of Wisconsin respondents “thought of” the Packers when shown the Ellison Bay shirts (a figure that would be astounding to anyone who did not live through the all-encompassing Packermania that gripped Wisconsin in late 1996). See Fredrickson Decl., Ex. 8. Suddenly, the impressive 50%

or so of respondents making a mental association between defendants' products and the Packers (see Jacoby's Second Report at 25) shrinks to a net of roughly 20%,² a figure that the court surmises would be even lower had a less misleading and more similar control than “Ellison Bay” been used. See *Indianapolis Colts*, 34 F.3d at 415–16 (criticizing Jacoby's choice of the “Baltimore Horses” *670 as his control for Baltimore Colts as a “trick[] of the survey researcher's black arts”); see also *Cumberland Packing Corp. v. Monsanto Co.*, 32 F.Supp.2d 561, 575 (E.D.N.Y.1999) (criticizing survey in NatraTaste–NutraSweet trademark dispute because “not one of the controls has a name sounding remotely like NatraTaste”). In any event, the wide gap between the “dilution” figure plaintiffs would like to present to the jury, 50%, and the net figure that one arrives at after using even the deeply-flawed controls from Jacoby's first report, 20%, is reason enough for the court to exercise its gatekeeping function to exclude the survey evidence.³

Plaintiffs present several entirely feeble explanations for Jacoby's failure to employ any controls in his second expert report. First, they claim that the “what do you think of” survey question is a proper one to measure dilution because a similar “what do you think of” question was acceptable to the court in *WAWA Inc. v. Haaf*, 40 U.S.P.Q.2d 1629, 1632 (E.D.Pa.1996), *aff'd*, 116 F.3d 471 (3d Cir.1997). However, the WAWA opinion nowhere describes what questions were used in the survey in that case, contrary to plaintiffs' citation.⁴ Plaintiffs then argue that “dilution questions do not involve true controls within the discipline of survey research,” Plaintiffs' Brief in Opposition to Defendants' Motion in Limine to Exclude the Second Report of Jacob Jacoby and the Opinions Stated Therein (“Plaintiffs' Opposition Brief”) at 13, an argument directly contradicted by the fact that Jacoby has previously used controls specifically to show dilution, as the court has pointed out. See *Hershey Foods*, 998 F.Supp. at 518.

Plaintiffs next argue that “[t]he open-ended dilution question itself contains an infinite number of controls—in the very answers provided by respondents.” Plaintiffs' Opposition Brief at 13. Plaintiffs claim that answers that are entirely unrelated to the challenged indicia, such as “the beach, warmth, sports,” or “it's cheap,” are “automatically discounted, thereby enabling the open-ended questions to operate essentially as their own controls.” *Id.* If plaintiffs mean by “discounted” that these answers are somehow excluded from consideration, that is what Jacoby would call (and has called) a “serious problem,” because “[e]liminating

people whose answers we do not like means we have tampered with the base of qualified respondents, namely, the denominator that must be used when calculating the percentage of qualified respondents who were misled.” Jacob Jacoby, *Consumer Research in FTC versus Kraft (1991): A Case of Heads We Win, Tails You Lose?*, 954 PLI/Corp 149, 157 (1996). Even if this is not what plaintiffs mean by “discounted,” the court doubts whether a single-question survey could contain its own controls when the whole concept of the “control” is that there must be separation, e.g., into groups or between questions, and then comparison between the separated parts. See, e.g., Kaye & Freeman, *supra*, in *Reference Manual on Scientific Evidence* (1994) (“Comparisons are essential.”).

Plaintiffs finally argue that the “Ellison Bay” and other shirts are not true “control” *671 shirts in any event but instead are “comparison” shirts, because a true control shirt “would have used, for instance, ‘ELLISON LAKE M’ in blue and red.” Plaintiffs' Opposition Brief at 13. Aside from the irrelevance of this proposition, it is simply wrong—a control product must be “a product that is a non-infringing [in this case, non-diluting] product which is similar to the products at issue.” *ConAgra*, 784 F.Supp. at 728 (criticizing Jacoby study for lack of controls) (emphasis added); see also *Indianapolis Colts*, 34 F.3d at 415–16 (criticizing Jacoby's choice of the “Baltimore Horses” as his control for Baltimore Colts as a “trick[] of the survey researcher's black arts”); *Cumberland Packing*, 32 F.Supp.2d at 575 (criticizing survey because “not one of the controls has a name sounding remotely like NatraTaste”); *Nabisco v. Warner–Lambert Co.*, 32 F.Supp.2d 690, (S.D.N.Y.1999) (holding that plaintiffs' control product, Trident, was improper in survey measuring confusion between “Ice Breakers” and “Dentyne Ice” because control product “fails to capture the essence of the allegedly confusing quality at issue, namely the ‘Ice’ term or some variation of that theme”).

The court also notes that plaintiffs did not cite a single article or paper, or for that matter any authority whatsoever, to support any of the arguments in their opposition brief, which is another reason to reject them: “Nor, despite the prevalence of [this type of] testing, does anyone refer to any articles or papers that validate [the expert's] approach.” *Kumho Tire*, 526 U.S. at —, 119 S.Ct. at 1178.

The court has other concerns about the probativeness of Jacoby's survey evidence, especially in light of current developments in federal dilution case law. Recently, the

United States Court of Appeal for the Fourth Circuit held that survey evidence must show more than just consumers' mental associations:

If you seek to rely for proof of dilution only upon evidence of the mental impressions evoked in consumers upon viewing the marks, then those impressions must go beyond mere recognition of a visual similarity of the two marks to allow a reasonable inference that the junior mark's use has caused actual harm to the senior mark's selling or advertising power.

Ringling Bros. v. Utah Div. of Travel Development, 170 F.3d 449, 463. The court stated that a “skillfully constructed consumer survey” in a dilution case should be designed “not just to demonstrate ‘mental association’ of the marks in isolation, but further consumer impressions from which actual harm and cause might rationally be inferred.” *Id.* at 465 (citing Patrick M. Bible, *Defining and Quantifying Dilution under the Trademark Dilution Act of 1995: Using Survey Evidence to Show Actual Dilution*, 75 U.Colo.L.Rev. 295, 327–28 (1999)).

Although plaintiffs attempt to distinguish *Ringling Brothers* by pointing out that it involved non-competing products, unlike in this case, see *WAWA*, 40 U.S.P.Q.2d at 1632 (distinguishing a similar case for this reason), the First Circuit recently reached conclusions similar to those of the *Ringling Brothers* court about the necessity of showing actual harm in a dilution case that did involve competing products. See *I.P. Lund*, 163 F.3d at 49–50. Plaintiffs also argue that “where competitive products are at issue ... harm follows by definition from dilution, because there has been sale in commerce of Defendants' goods, in the amount of approximately \$600,000 of actual harm!” Plaintiffs' Opposition Brief at 11 (emphasis in original). However, the court cannot assume actual harm simply because defendants have made sales: “Certainly it is not plausible to think that Congress intended to protect [plaintiffs' marks] by simply assuming harm or damages based on the fact that the plaintiff will sell less if the defendant sells more.” *I.P. Lund*, 163 F.3d at 50. A simple tally of defendants' sales does not suffice to show “actual harm and cause.” *Ringling Bros.*, 170 F.3d 449, 465.

*672 Thus, pursuant to *Daubert* and *Kumho Tire*, the court will exclude Jacoby's survey evidence and any conclusions he has reached based on that evidence. Plaintiffs argue, however,

that the court need not exclude Jacoby's entire second report because it contains not only "conclusions, generated from the survey data, relating to dilution" (Section I of the report), which the court will exclude, but also "overall conclusions, based on Dr. Jacoby's extensive professional qualifications and experience as a social scientist and professor of marketing, concerning both dilution and likelihood of consumer confusion" (Section II of the report). Plaintiffs' Opposition Brief at 3–4. Defendants argue that Section II must be excluded because Jacoby's vague discussion in that section does not conclude with any opinion stated with "a reasonable degree of scientific certainty." *Lanza v. Poretti*, 537 F.Supp. 777, 785 (E.D.Pa.1982). For example, Jacoby asserts that among those who are familiar with the Packers, "some (likely small) proportion ... may exhibit neither dilution nor confusion" and "some larger proportion may exhibit confusion." See Jacoby's Second Report at 44.

[2] Section II of the second report is entitled "The Scientific Underpinnings of Trademark Law, with Particular Reference to Dilution and Confusion." *Id.* at 31. Throughout Section II, Jacoby mostly discusses general topics such as "how is everything that we know ... stored in our minds?" Regarding these general topics, the court finds, following *Kumho Tire* and *Daubert*, that this non-case-specific information, standing alone, will not be of sufficient assistance to the jury to warrant allowing it to be admitted at trial: "[T]he question before the trial court was specific, not general. The trial court had to decide whether this particular expert had sufficient specialized knowledge to assist the jurors 'in deciding the particular issues in the case.'" *Kumho Tire*, 526 U.S. at —, 119 S.Ct. at 1178 (citing 4 J. McLaughlin, *Weinstein's Federal Evidence* ¶ 702.05[1], at 702–33 (2d ed.1998); *Advisory Committee's Note on Proposed Fed.Rule Evid. 702, Preliminary Draft of Proposed Amendments to the Federal Rules of Civil Procedure and Evidence: Request for Comment* 126 (1998) (stressing that district courts must "scrutinize" whether the "principles and methods" employed by an expert "have been properly applied to the facts of the case")); *Daubert*, 509 U.S. at 591, 113 S.Ct. 2786 (holding that the court must consider "whether expert testimony proffered in the case is sufficiently tied to the facts of the case that it will aid the jury in resolving a factual dispute") (citations omitted).

The court also will exclude any references to the excluded survey in Section II, such as on pages 35 and 36 of the report where Jacoby discusses the survey and states that "it is my opinion that, with additional probing, a substantial number of additional respondents would have indicated that defendant's

garments made them think of the Green Bay Packers and/or the NFL through the Packers." *Id.* at 36.

Finally, regarding the case-specific conclusions Jacoby reaches in Section II,⁵ the *673 court may apply the *Daubert* factors to analyze the principles and methodology Jacoby used to reach these conclusions. *Daubert*, 509 U.S. at 595, 113 S.Ct. 2786 ("The focus, of course, must be solely on principles and methodology, not on the conclusions that they generate."). However, the generalized and unsupported nature of Jacoby's conclusions makes application of the *Daubert* factors difficult. See *Anderson v. F.J. Little Mach. Co.*, 68 F.3d 1113, 1119 (8th Cir.1995) ("Due to the conclusory nature of the engineer's expert affidavit and deposition, that determination is impossible.").⁶

The first *Daubert* factor is whether Jacoby's theories or techniques "can be (and ha[ve] been) tested." 509 U.S. at 593–94, 113 S.Ct. 2786. In this case, Jacoby's theories can and have been tested only in the most abstract way, in the sense that his statements about the general concepts of, for example, "spreading activation," "cognitive overload," and "information chunking" can and have been tested. The second factor is whether the theory "has been subjected to peer review and publication." *Id.* Again, Jacoby's theories satisfy this factor in only the most academic, non-case-specific way. The third factor is whether there is a high "known or potential rate of error" and whether there are "standards controlling the technique's operation." *Id.* Jacoby's unsupported statements fall short on this factor; indeed, the court does not know how his general statements could even be subject to a "rate of error" or any other scientific standard, for that matter. The final prong is whether the theory or technique enjoys "general acceptance" within a "relevant scientific community." *Daubert*, 509 U.S. at 593–94, 113 S.Ct. 2786. Again, if Jacoby's general statements satisfy this factor, they do so only in the most abstract sense.

Regardless of whether Jacoby's theories satisfy these four factors, "[h]elpfulness to the trier of fact remains the ultimate touchstone of admissibility." *Holbrook v. Lykes Bros. S.S. Co., Inc.*, 80 F.3d 777, 784 (3rd Cir.1996). The court alluded to this above in excluding the general, non-case-specific information in Jacoby's report as it stands alone. Because this non-case-specific information also bears little if any relation to the unsupported conclusions at the end of Jacoby's report, see *Kumho Tire*, 526 U.S. at —, 119 S.Ct. at 1179 (holding that "nothing in either *Daubert* or the Federal Rules of Evidence requires a district court to admit opinion evidence

that is connected to existing data only by the ipse dixit of the expert”) (citations omitted), the court concludes that Section II of Jacoby's report must be excluded from trial.

Therefore, the court will grant defendants' motion in limine to exclude the second report of Jacob Jacoby and the opinions stated therein. Because [Rule 37\(c\)\(1\)](#) and [Rule 26\(a\)\(2\) the Federal Rules of Civil Procedure](#) preclude an expert from testifying at trial regarding opinions not previously disclosed in an expert report, *see Ist Source Bank v. First Resource Fed. Credit Union*, 167 F.R.D. 61, 66–67 (N.D.Ind.1996); *Paradigm Sales, Inc. v. Weber Marking Sys., Inc.*, 880 F.Supp. 1247, 1252 (N.D.Ind.1995), the court will preclude Jacoby from offering expert testimony at trial.

B. Plaintiffs' Motion in Limine

Plaintiffs move the court to preclude the trial testimony, deposition testimony, and expert report of defendants' expert witness *674 John A. Bunge and the trial and deposition testimony of Reggie and Sara White. Because Bunge's expert report contains only his review and evaluation of Jacoby's survey, which has been excluded, and because defendants state in their opposition brief that they will not call Bunge at trial in any event, the court will grant this part of plaintiffs' motion in limine, exclude Bunge's report and deposition testimony, and preclude him from offering expert testimony at trial.

Plaintiffs contend that the court must exclude the trial and deposition testimony of Reggie and Sara White because its “probative value is substantially outweighed by the danger of unfair prejudice.” *See Fed.R.Evid. 403*. Plaintiffs argue that the Whites cannot offer any testimony having probative value because (1) Tanner is no longer pursuing her defamation claim against defendants, so the Whites' testimony regarding their opinion of Tanner's character is irrelevant; (2) plaintiffs accept the authenticity of the licensing agreements between Reggie White and defendants, so there is no need for him or any other player to testify to that fact; and (3) the Whites' relationship with Tanner came only after she conceived, designed, produced, and sold defendants' allegedly infringing merchandise. Plaintiffs argue that any probative value of the Whites' testimony is substantially outweighed by the unfair prejudice caused by their celebrity status in Wisconsin, which would tend to sway jurors and deflect attention away from the issues being tried.

Defendants respond that both Reggie and Sara White possess knowledge of the distribution or sale of defendants'

merchandise. Defendants allege that Sara White assisted with the operation of defendant ProStyle's business in the latter half of 1996, as she testified at the hearing on plaintiffs' motion for a temporary restraining order, and that by virtue of her involvement in the operation of Reggie White's All Pro Shop (“the Shop”), which defendant Sheri Tanner manages, Sara White can provide probative testimony regarding the relationship between the Shop and ProStyle. Defendants allege that Reggie White also has knowledge of the distribution or sale of defendants' merchandise by virtue of his involvement with the Shop and that other issues regarding his agreements with ProStyle besides the agreements' authenticity (which plaintiffs concede) may arise at trial. Regarding testimony the Whites could offer about Tanner's character, defendants argue that it may become relevant and admissible if Tanner's character for truthfulness is attacked at trial, *see Fed.R.Evid. 608(a)*, as it was at the summary judgment stage. *See Plaintiffs' Brief in Opposition to Defendants' Motion for Partial Summary Judgment at 23.*

[3] It appears to the court that both Reggie and Sara White may be able to contribute a wealth of probative testimony at trial. More importantly, regardless of the probativeness of their testimony, the court is not persuaded that calling a witness at trial is unfairly prejudicial simply because that witness happens to be a celebrity, and the court most certainly is not persuaded that any such prejudice could “substantially outweigh” the probativeness of the Whites' testimony. *See People v. Cox*, 53 Cal.3d 618, 280 Cal.Rptr. 692, 809 P.2d 351, 376 (1991) (“We decline to formulate a rule of admissibility premised on the extent to which a witness may or may not be known to the general public.”), *cert. denied*, 502 U.S. 1062, 112 S.Ct. 945, 117 L.Ed.2d 114 (1992). Therefore, the court will deny this part of plaintiffs' motion in limine.

III. CONCLUSION

For the aforementioned reasons, the court will grant defendants' motion in limine and will grant in part and deny in part plaintiffs' motion in limine.

Accordingly,

*675 **IT IS ORDERED** that defendants' motion in limine to exclude the second report of Jacob Jacoby and the opinions stated therein be and the same is hereby **GRANTED**; and

IT IS FURTHER ORDERED that plaintiffs' second motion in limine to preclude evidence be and the same is hereby **GRANTED** in part and **DENIED** in part.

Parallel Citations

52 Fed. R. Evid. Serv. 1254

Footnotes

- 1 However, despite Jacoby's emphasis on the importance of using controls, this is not the first time he has been criticized for not using them. In *ConAgra*, the district court "significantly discounted" Jacoby's survey for its lack of controls after Jacoby admitted that "it represented an omission, not having the control." 784 F.Supp. at 728.
- 2 In *The Gillette Company v. Wilkinson Sword, Inc.*, 89 CV 3586 (KMW), 1991 U.S. Dist. LEXIS 21006 (S.D.N.Y. Jan. 9, 1991), the court approved of Jacoby's use of this "subtraction" methodology. *See id.* at *20–21; *see also Reed–Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909 (7th Cir.1996) (affirming finding of no infringement where survey found 25% confusion but control found "noise" of 20%).
- 3 The court's selection of the "Green Bay" and "Ellison Bay" shirts as examples is being charitable to Jacoby—if one compares Jacoby's finding that "one out of three" respondents associated the defendants' third shirt (the player name and number shirt) with the Packers, *see* Jacoby's Second Report at 26, with the control figure of 22.1–30.4%, *see* Fredrickson Decl., Ex. 8, the gap is even smaller.
- 4 The court also notes that the WAWA opinion relied in its dilution analysis on the so-called "Mead factors" or "Sweet factors" (from Judge Sweet's concurrence in *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026 (2d Cir.1989)), an approach that has since been criticized by more recent federal appellate court decisions on the subject of federal dilution. *See Ringling Bros.–Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 463 (4th Cir.1999); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 49–50 (1st Cir.1998).
- 5 Jacoby's conclusions are that among those familiar with the Packers who come across defendants' products while shopping for a football style shirt, "some (likely small) proportion of these people may exhibit neither dilution nor confusion," "some larger proportion may exhibit confusion of one sort or another," and finally,

[I]f they were confused at the outset and then had this confusion rectified, or (2) if they were never confused but now came to believe that there were two independent entities that could put out or authorize merchandise using green and yellow and saying "Green Bay" that bore either a "P" (which made them think of the Green Bay Packers) or a yellow helmet (likewise, a Packers' association in context), or the numeral and surname of a player for the Green Bay Packers, then such people would experience what I understand to be trademark dilution. That is, for these people, there are now at least two independent entities in mind who can use these indicia. Thus, the value of the registered marks of the Green Bay Packers as single source identifiers have come to be diluted.

Jacoby's Second Report at 44.
- 6 Plaintiffs admit in their opposition brief that Jacoby said in his deposition that "scholarly research and theories can provide a reliable basis for predicting consumer responses, but that empirical data would be *required* to confirm consumers' reactions to a particular stimulus." Plaintiffs' Opposition Brief at 8 n. 7 (emphasis added). It is Jacoby's utter lack of empirical data in Section II that makes application of the *Daubert* factors difficult.

2004 WL 2368486 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

RED BULL GMBH

v.

CARL COCHRAN

Opposition No. 91152588 to application Serial No. 76302551 filed on August 22, 2001

September 29, 2004

Hearing: August 3, 2004

*1 Martin Greenstein of TechMark for Red Bull GmbH

Rod D. Baker of Peacock Myers & Adams, P.C. for Carl Cochran

Before Simms, [Hairston](#) and Bottorff

Administrative Trademark Judges

Opinion by [Hairston](#)

Administrative Trademark Judge:

Carl Cochran has filed an application to register the mark RED RAVE for “sports drinks.”¹

Red Bull GmbH (an Austria corporation) has opposed registration of applicant's mark, alleging priority and likelihood of confusion, Section 2(d) of the Trademark Act, as the ground for opposition. Opposer alleges that it is the owner of various marks that include the term RED BULL and/or the design of a red bull for energy drinks and other non-alcoholic beverages; that opposer is the owner of Registration No. 2,494,093 for the mark RED BULL for, inter alia, “sports drinks”²; that it is the prior user of the mark RED BULL for such goods; that it has extensively advertised its RED BULL sports drinks and the RED BULL mark is a valuable asset; and that applicant's mark, as applied to applicant's goods, so resembles opposer's mark as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant filed an answer wherein it denied the allegations of the notice of opposition.

Briefs have been filed and an oral hearing, attended by counsel for opposer, was held.

Opposer, as its case-in-chief, submitted the testimony deposition (with exhibits) of opposer's counsel Robert Sorensen, and opposer's notice of reliance on, inter alia, a certified copy of its pleaded Registration No. 2,494,093. Applicant submitted his testimony deposition (with exhibits), and a notice of reliance on printouts downloaded from the website www.bevnet.com. The printouts contain product reviews of thirteen soft drinks and energy drinks with names that contain the word “red.” As its rebuttal evidence, opposer submitted (pursuant to the parties' stipulation) a notice of reliance on information concerning oppositions opposer has filed against third parties.

We note that opposer, in its brief on the case, requests that the notice of opposition be amended to allege that (1) applicant's application is void ab initio because applicant did not make use of the mark prior to the filing date of the application and (2) applicant committed fraud in filing his application because the specimen of use was merely an artist's mock-up of packaging for applicant's goods and not a photograph or reproduction of an actual beverage can. Opposer maintains that it learned of these grounds during applicant's testimony deposition.

Applicant, in his brief, responded by arguing that the request to amend is untimely, that opposer has ignored the realities of the marketplace where use in commerce of a mark may be made in advance of sales, and that any mistake made by applicant in submitting his specimen was an innocent error and not fraud.

*2 We agree with applicant that the request to amend the opposition is untimely. Opposer failed to properly amend the opposition after it learned of the facts which opposer contends establish these claims. To allow opposer to raise the claims at this late date would be unfair surprise to applicant. Moreover, this is not a case where the pleadings can be deemed amended pursuant to [Fed. R. Civ. P. 15\(b\)](#) because neither of these issues was tried by the express or implied consent of applicant.

Because opposer has made of record a certified copy showing status and title of its pleaded registration, and because its likelihood of confusion claim is not without merit, we find that opposer has established its standing to oppose registration of applicant's mark. See: [Lipton Industries, Inc. v. Ralston Purina Company](#), 670 F.2d 1024, 213 USPQ 185 (CCPA 1082). Further, because opposer has made its pleaded registration of record, priority is not an issue in this case with respect to the mark and goods identified therein. See: [King Candy Co., Inc. v. Eunice King's Kitchen, Inc.](#), 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. [In re E. I. du Pont de Nemours & Co.](#), 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. [Federated Foods, Inc. v. Fort Howard Paper Co.](#), 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Opposer's witness, Mr. Sorensen, testified that RED BULL is an energy drink that has been sold in the United States since 1997. According to Mr. Sorensen, energy drinks improve physical endurance, emotional status, reaction speed, concentration, and generally help persons make it to the end of a long game or long evening. Opposer advertises its RED BULL energy drink by way of television and point of sale advertisements. Opposer sponsors sporting and entertainment events and "rave" parties which are all-night gatherings of young people involving dancing and socializing. Opposer introduced copies of news articles that refer to the consumption of its RED BULL energy drink at "rave" parties. Opposer's sales of RED BULL energy drinks in the United States for the years 2001 and 2002 totaled over 220 and 250 million units, respectively. For the same years, opposer's marketing expenditures were over \$130 and \$150 million, respectively.

Applicant, Carl Cochran, testified that he is a sales manager for National Distributing Company. Applicant's RED RAVE is also an energy drink and it is marketed primarily to 18-25 year olds. Applicant's products are sold in convenience stores, grocery stores, bars and nightclubs.

*3 Concerning first use of the mark, Mr. Cochran testified on direct examination as follows:

Q. And when did you first start making use of that [RED RAVE] trademark?

A. In August 2001.

Q. And what type of use did you make at that time?

A. At that time, it was for solicitation of distributors and customers and for basic generic press releases.

(Cochran, p. 8)

On cross-examination, Mr. Cochran testified that:

Q. And if I understand correctly, your use of Red Rave back on August 2001 you said was for solicitation of distributors and press releases?

A. Yes.

Q. When did you actually ship the product?

A. February of 2002.

Q. February 2002.

A. Yes.

(Cochran, p. 24)

....

Q. And I show you a copy of the specimen of use in your application.

A. Yes.

Q. What is that I'm looking at?

A. That's the Red Rave—the logo, the energy drink's logo.

Q. Is that from a can?

A. No. It was from the artwork.

Q. Just from the artwork.

A. Yes.

Q. So that's not actually used—the piece that's here is not from an actual can?

A. No.

Q. This was a mock up that you later applied to a can six months later?

A. Exactly.

(Cochran, pp. 52-53)³

Mr. Cochran testified that since February 2002 he has sold approximately 30,000 cases of RED RAVE. Further, he indicated that he was aware of opposer's RED BULL mark at that time he adopted his mark.

Insofar as the goods are concerned, there is no question that they are identical. The goods as identified in opposer's pleaded registration and applicant's application are sports drinks and both opposer and applicant characterize their goods as energy drinks. Further, in the absence of any restrictions in opposer's registration and applicant's application, we must presume that the goods are sold in all the normal channels of trade (e.g., convenience stores and grocery stores) to the same classes of purchasers,

namely ordinary consumers. In point of fact, Mr. Cochran testified that applicant's sports drinks are sold in these channels of trade.

Next we turn to a determination of what we find to be the key likelihood of confusion factor in this case, whether applicant's mark and opposer's mark, when considered in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impression.

When we compare the marks in terms of appearance, we find that they are significantly different. We recognize that the marks begin with the identical word RED. However, RAVE and BULL are common words which would be readily recognized as such and which are readily distinguishable from each other in terms of appearance. Thus, when the marks RED BULL and RED RAVE are considered in their entirety, we find that they are more dissimilar than similar in appearance.

Considering next the sound of the respective marks, we find that the differences in sound between the words RAVE and BULL suffice to render the marks different in terms of sound as a whole.

*4 Finally, when we compare the marks in terms of their respective meanings or connotations, we find that they are very different. Again, we recognize that the marks begin with the identical word RED. However, the remainder of the marks, RAVE and BULL are in no way similar in meaning. We judicially notice that the word "rave" is defined as a verb "to speak or write with wild enthusiasm" and as a noun "an all-night dance party, usually featuring electronically synthesized music."⁴ Purchasers encountering applicant's mark on his goods will likely ascribe one of these meanings to the word RAVE. The word BULL, on the other hand, connotes a male cow. Opposer's mark RED BULL does not connote wild enthusiasm or an all-night dance party, but rather a "red bull." Thus, we find that applicant's mark and opposer's mark are more dissimilar than similar in terms of meaning or connotation.

We are not persuaded by opposer's argument that the similarity in the commercial impression of the marks is increased by applicant's trade dress and the wording on applicant's can, which opposer contends is highly similar to its trade dress and the wording on its can. To the contrary, we find that applicant's trade dress is not at all similar to opposer's trade dress. Opposer's and applicant's beverage cans are reproduced below.



Applicant's mark RED RAVE is depicted in large letters and appears on a red background. The word RED is partially hidden and the word RAVE is stylized. Opposer's mark RED BULL is depicted in smaller block letters and appears on a blue and silver background. The design of two bulls also appears on opposer's can and no such design appears on applicant's can. The fact that both opposer's can and applicant's can bear "Lightly Carbonated", "Serve chilled", and the ingredient name "Taurine" does not increase the similarity in the commercial impression of the marks. This wording does not form part of either of the respective marks and is in the nature of informational wording that any manufacturer of this type of beverage should be free to use on its can. Further, we find that the phrase MIND-BODY-SOUL that appears on applicant's can is not so similar to the phrase VITALIZES BODY AND MIND that appears on opposer's can as to cause the parties' respective marks to be confused.

In reaching our finding of no likelihood of confusion, we have given little weight to the third-party evidence submitted by applicant with its notice of reliance. Applicant offered no evidence with respect to the extent of the third-party uses and this limited evidence does not establish that opposer's mark is weak.

We note that opposer pleaded in the notice of opposition that it has extensively advertised its RED BULL mark and that it has considerable goodwill in the mark. Opposer did not specifically allege that its mark is famous nor did it argue fame in its brief on the case. However, even assuming that opposer's RED BULL mark is famous as a result of extensive sales and advertising, we would nonetheless find no likelihood of confusion in this case due to the differences in the marks.

*5 In sum, notwithstanding the fact that the parties are using their respective marks on identical goods which are marketed in the same channels of trade to the same purchasers, we find that the marks are too different, especially in terms of their meanings or connotations and their overall commercial impressions to support a determination that confusion is likely. See: [Kellogg Co. v. Pack'em Enterprises Inc.](#), 14 USPQ2d 1545 (TTAB 1990), [aff'd](#), 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The opposition is dismissed. The application is hereby remanded to the Examining Attorney for reexamination with respect to whether the application is void ab initio.

Footnotes

- 1 Serial No. 76302551, filed on August 22, 2001, alleging August 1, 2001 as the date of first use of the mark and the date of first use of the mark in commerce.
- 2 Registration No. 2,494,093 issued on October 2001.
- 3 Section 45 of the Trademark Act states, in relevant part, that a mark is used in commerce on goods when “(a) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (b) the goods are sold or transported in commerce.” It appears from Mr. Cochran's testimony that he did not use the RED RAVE mark in commerce on or in connection with the goods prior to August 1, 2001, the filing date of the application. Thus, the parties are advised that if applicant ultimately prevails herein, applicant's involved application will be remanded to the Trademark Examining Attorney pursuant to [Trademark Rule 2.131](#) for reexamination with respect to the issue of whether the application is void ab initio.
- 4 [The American Heritage College Dictionary](#) (4th ed. 2002).

2004 WL 2368486 (Trademark Tr. & App. Bd.)

2011 WL 1495460 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

Societe Des Produits Nestle S.A.

v.

Midwestern Pet Foods, Inc.

Opposition No. 91163853 to application Serial No. 76563252 filed on November 21, 2003

March 31, 2011

Hearing: July 22, 2010

*1 [Thomas A. Polcyn](#) of Thompson Coburn LLP for Societe Des Produits Nestle S.A.
[Timothy D. Pecsénye](#) of Blank Rome LLP for Midwestern Pet Foods, Inc.

Before [Zervas](#), [Taylor](#) and [Wellington](#)

Administrative Trademark Judges

Opinion by [Taylor](#)

Administrative Trademark Judge:

Midwestern Pet Foods, Inc. has filed an application to register on the Principal Register the mark WAGGIN' STRIPS, in standard character format, for “pet food and edible pet treats” in International Class 31.¹

Registration has been opposed by Societe Des Produits Nestle S.A. (“opposer”) on the grounds of (1) priority and likelihood of confusion,² (2) dilution and (3) that applicant lacks a bona fide intent to use the mark in commerce. Opposer, in its first amended notice of opposition, specifically alleges that since as early as 1988, it has continuously used in interstate commerce BEGGIN' STRIPS as a trademark for dog snacks; that it is the owner of Registration No. 1529939 for the mark BEGGIN' STRIPS for “dog snacks”;³ and that it has promoted and sold its dog snacks under the BEGGIN' STRIPS mark prior to any alleged use by applicant of its applied-for mark. Opposer further alleges that as a result of its use, promotion and advertizing of its BEGGIN' STRIPS mark, the mark has become well known to the trade and to the public, and has accordingly acquired significant good will; and that prior to applicant's adoption of its mark, Opposer's BEGGIN' STRIPS mark was distinctive and became “famous” within the meaning of 15 U.S.C. § 1125(c). Opposer then alleges that applicant's WAGGIN' STRIPS mark so resembles its previously used, and not abandoned, BEGGIN' STRIPS mark as to be likely, when applied to applicant's listed goods, to cause confusion or to cause mistake or to deceive the public, or to cause dilution of the distinctive quality of opposer's mark.

Opposer also alleges that “upon information and belief,” applicant never had or no longer has a *bona fide* intention to use the applied-for mark in commerce in connection with any of the goods listed in the application.

Applicant, in its answer, admitted that it had yet to use its applied-for mark in commerce (Answer, ¶¶ 6 and 11), but otherwise denied the essential allegations of the notice of opposition.⁴

PRELIMINARY MATTERS

Motion to Strike

*2 On August 5, 2009, the Board deferred consideration of opposer's motion to strike one exhibit in applicant's notice of reliance. We now consider that motion which opposer renewed in its evidentiary brief. Opposer objects to Exhibit G, consisting of copies of packaging from applicant's competitors, arguing that these copies cannot be submitted by a notice of reliance.

In response, applicant contends that this material merely supplements the answer to a question in the May 5, 2009 testimony deposition of applicant's chief financial officer, Philip S. Montooth.⁵ Applicant further argues that “[i]nformation regarding the existence of these STRIP-denominated pet products was not provided by either party during discovery”; and that “[c]onsistent with [Federal Rule of Civil Procedure 26\(e\)](#), and as soon as Applicant became aware that discovery was incomplete, Applicant supplemented its discovery responses by submitting the aforementioned packaging in express support of the testimony....” Appl. resp to mot. to strike p. 2.

In reply, opposer argues that the contents of Exhibit G were not discussed and were not introduced as an exhibit during Mr. Montooth's deposition.

Documents and other evidence, not ordinarily admissible by notice of reliance, may be made of record with appropriate identifications and introduction by the witness during the course of a testimony deposition. See generally TBMP § 703.01(a) (2d ed. 2004). A review of the Montooth testimony reveals that although Mr. Montooth identified several third parties that he believed made such treats, he made no reference to, nor authenticated any product packaging for such or other third-party treats. The objected-to materials were not introduced by applicant during the deposition. Consequently, applicant is seeking in the first instance to make the third-party product packaging of record via the notice of reliance. Product packaging is neither an official record nor a printed publication as described in [Trademark Rule 2.122\(e\)](#) and is therefore not admissible by notice of reliance. See generally TBMP § 704.02.

Additionally, applicant's argument that the material was submitted to “supplement discovery” pursuant to [Fed. R. Civ. P. 26](#) is unavailing. Nothing in this record supports applicant's assertion that the material, if indeed responsive to propounded discovery, falls within any circumstance that would allow submission during applicant's testimony period by notice of reliance. See [Trademark Rule 2.120\(j\)](#).

Accordingly, opposer's motion to strike is granted and Exhibit G to applicant's notice of reliance will not be further considered.

Evidentiary Objections

Opposer, in its brief, raised three objections to Mr. Montooth's testimony and certain exhibits introduced at his deposition. We address each of the three objections below in turn.

*3 First, opposer objects to Exhibits 1-6⁶, and related testimony, as irrelevant because they do not show or relate to the mark at issue in this opposition.

In response, applicant argues that the evidence is relevant because it shows that applicant is capable of making, and does make, “strips” products similar to the type of goods to be sold under its applied-for mark. Thus, applicant contends, the packaging supports applicant's bona fide intent to the use the WAGGIN' STRIPS mark. Applicant also argues that the proffered packaging shows that the mock-up packaging submitted as Exhibit 7 to the Montooth testimony is consistent in appearance to its current product packaging, including applicant's consistent use of its PRO PAC house mark and logo.

Opposer's objection to exhibits 1-6 is overruled. The evidence is relevant to applicant's defense to both opposer's claims of likelihood of confusion and no bona fide intention to use the mark in commerce; in particular, the evidence relates to applicant's intent. To the extent that applicant is arguing that the packaging demonstrates applicant's “consistent” use of its house mark in connection with its other marks, it is irrelevant in this regard, because this proceeding only involves applicant's WAGGIN' STRIPS mark.

Second, opposer objects to Mr. Montooth's testimony regarding applicant's mock-up packaging for its WAGGIN' STRIPS mark. Opposer argues that the Board order issued October 17, 2008 states that "all information sought from Ms. Montgomery [an employee in applicant's graphic arts department and the creator of the mock-up packaging] during discovery but not produced by Applicant" would be stricken;⁷ that applicant now seeks to use Mr. Montooth as a proxy for Ms. Montgomery to introduce testimony about the mock-up packaging; and that introducing Mr. Montooth's testimony regarding the mock-up packaging is in contravention of the Board's order. Opposer also argues that the testimony about the circumstances surrounding applicant's selection of the WAGGIN' STRIPS mark was specifically solicited from Ms. Montgomery and should not now be allowed into evidence.

In response, applicant maintains that opposer is placing too much reliance on the October 2008 order, which simply states that applicant cannot refuse to produce Ms. Montgomery for deposition purposes and, at the same time, rely on her testimony. Applicant explains that in the Board's April 5, 2008 order denying opposer's motion to compel the discovery deposition of Ms. Montgomery, the Board ruled that the deposition of Ms. Montgomery was not justified because there is no information she could provide that had not already been provided by Mr. Montooth. Applicant contends that the testimony provided by Mr. Montooth at his testimony deposition was already produced during discovery, either in answer to Opposer's interrogatories or in Mr. Montooth's 30(b)(6) deposition which opposer has made of record.

***4** We overrule the objection. Although pursuant to the Board's order, applicant may not rely on any testimony from Ms. Montgomery, or any information sought from her but not produced, applicant is not foreclosed from relying on the testimony of Mr. Montooth regarding the mock-up packaging and applicant's selection of the WAGGIN' STRIPS mark because, as pointed out by applicant, this information was produced by applicant either in its responses to opposer's interrogatories or in Mr. Montooth's discovery deposition. *See* Opposer's Not. of Rel. Exh P-3, and Applicant's Not. of Rel. Exh. I.

Last, opposer objects to the Montooth Dep. Exhibits 8 and 9 (i.e., photographs of third-party pet treat product packaging), and related testimony. Opposer objects to the admissibility of these materials arguing that the exhibits are irrelevant as they do not relate to the marks at issue in this proceeding, and that the exhibits have not been properly identified and authenticated by Mr. Montooth because he has no personal knowledge related to the packaging.

In response, applicant contends that the evidence is relevant to show similar marks are in use in the industry; that opposer is objecting to evidence that opposer itself submitted into evidence; and that applicant authenticated its third party evidence in the same manner as opposer.

Evidence of third-party use of similar marks is relevant to applicant's defense of opposer's claim of likelihood of confusion and, in particular, the number and nature of similar marks in use on similar goods. In addition, Mr. Montooth testified that he is familiar with applicant's competitors' products and that he had seen the packaging in retail outlets. This testimony lays a sufficient foundation to introduce the packaging into the record. The objection is accordingly overruled and we will accord the third-party packaging the appropriate probative value.⁸

Applicant likewise raised numerous objections to opposer's notice of reliance as well as to the testimony and exhibits of opposer's witness, Juli Plassmeyer, brand director for Beggin' Strips. Indeed, applicant objected to nearly every question and/or answer with regard to Ms. Plassmeyer's testimony on direct examination. Most of the objections served no useful purpose and unnecessarily interrupted the flow of the deposition. We address below only those objections that were repeated with particularity in applicant's combined response to opposer's evidentiary objections and applicant's evidentiary objections.

First, applicant objects to, and seeks to strike, Plassmeyer Deposition Exhibits 3-43 and Exhibits P6-P132 to opposer's notice of reliance because this evidence was requested by applicant during discovery, but was not produced. Applicant specifically contends that "[g]iven that no documents were produced in response to Applicant's requests, Applicant was entitled to reasonably rely on Opposer's certification that no documents existed." Applicant's Combined Resp. to Opposer's Evidentiary

Objections and Applicant's Evidentiary Objections p. 7. Further, applicant seeks to strike Plassmeyer testimony Exhibits 16-18, 21-29 and 38-43, i.e., evidence of applicant's advertising, sales and marketing figures, on the additional ground that they are summary documents and opposer did not make the underlying documents available.⁹ Applicant also argues that opposer has not established that the summaries are accurate or that the underlying documents are themselves admissible.

*5 Opposer, in response, maintains that its testimony and exhibits should be admitted because: (i) the Plassmeyer testimony, in its entirety, is based on Ms. Plassmeyer's personal knowledge; (ii) the exhibits were either previously provided to applicant, available for inspection, not sought by applicant and/or properly objected to; and (iii) applicant failed to meet and confer or move to compel and the automatic disclosure requirements do not apply to this proceeding. "Applicant had full and fair opportunity for discovery of additional information however, Applicant chose not to inspect documents or make alternative arrangements to obtain copies." Opposer's response to Applicant's Evidentiary Brief p. 1.

Opposer particularly contends, with respect to Exhibit 43 of the Plassmeyer testimony, that it is a compilation showing BEGGIN' STRIPS brand awareness and is not a study conducted pursuant to this matter. Opposer explains that the chart was created from material that opposer uses in the ordinary course of business and does not provide information on the ultimate issue to be decided by the Board. Opposer further contends that even assuming that its discovery responses should have been supplemented, applicant's claim of prejudice is "suspect." Given applicant's disregard for the discovery process, opposer argues that it is unlikely that applicant would have come to inspect the data underlying Exhibit 43.

We first consider Exhibit 43 - a summary chart showing brand awareness among several pet treat brands compiled from data extrapolated from a 2004-2006 survey performed by the firm Millward Brown. This document is responsive to Applicant's Document Request No. 3, which sought "all documents that refer, relate to, or include surveys, marketing studies, focus group studies and polls regarding the BEGGIN' STRIPS Mark," and note that opposer responded "none at this time."

The duty to supplement a response is governed by [Fed. R. Civ. P. 26\(e\)](#). Under this rule, a party that has responded to a request for discovery has a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified by the rule. TBMP § 408.03 (2d. rev. March 2004). A responding party which, due to a failure to supplement its response to include newly acquired information, may not thereafter rely at trial on such information that was properly sought but not seasonably updated as required by [Fed. R. Civ. P. 26\(e\)](#).

We find opposer's objection to Exhibit 43 well taken. Applicant timely requested the production of survey/marketing study materials and opposer responded that, at the time, none existed. In the absence of a supplemental response, applicant had no reason to believe that any such material existed. In addition, we will not speculate as to whether applicant would, or would not, have inspected the materials if it knew such materials existed.

*6 Accordingly, Exhibit No. 43 to the Plassmeyer testimony deposition is here stricken.¹⁰

With regard to the objection to the remaining exhibits, opposer consistently indicated in its discovery responses that: (1) responsive documents would be produced at a mutually agreeable time and place; (2) the request was overbroad and unduly burdensome; (3) the documents sought were irrelevant; (4) the documents sought were privileged, subject to the work product doctrine or proprietary in nature prior to entry of a suitable protective agreement; and/or (5) the documents sought were equally available to applicant. That is, unlike its response to applicant's Document Requests Nos. 3 and 4, opposer did not state that no documents were in its possession or control. Additionally, with regard to the document request seeking documents relating to opposer's responses to applicant's first set of interrogatories, opposer responded that the interrogatories exceeded seventy-five in number. By these responses, and contrary to applicant's contention, opposer in no way led applicant to believe that no documents satisfied applicant's discovery requests. Since applicant was unsatisfied with opposer's failure to produce any documents in response to its requests, it was incumbent upon applicant to file a timely motion to compel or to modify its interrogatories to comply with the number limitation. Applicant, having failed to do so, has waived its right to object to such testimony and evidence on the ground that it was not produced during discovery. See [H.D. Lee Co. v. Maidenform Inc.](#), 87 USPQ2d 1715,

1719 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); and *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue the requested material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). In short, it was applicant's own inaction that prevented applicant from obtaining opposer's evidence prior to trial. Under these circumstances, applicant cannot assert prejudice.

In view of the foregoing, with the exception of Exhibit 43 to the Plassmeyer testimony deposition, applicant's objections are overruled.

*7 Last, citing, *inter alia*, *Toro Co. v. Torohead*, 62 USPQ2d 1164, 1174 (TTAB 2001), applicant objects to opposer's evidence supporting the fame of its mark, and seeks to strike Plassmeyer test. Exhs. 16-20 and 30-43 and Exhibits P11-24, P30-74, P124-127 and P129-132, arguing that the documents are dated after the November 21, 2003 filing date of applicant's intent-to-use application.

We overrule this objection as it is essentially directed to the probative value to be accorded this evidence. Moreover, opposer's notice of opposition includes claims of likelihood of confusion and dilution. Although most of the evidence may not be particularly probative of the factor of fame with respect to opposer's dilution claim, because fame of a party's mark is not static, this evidence is relevant (and the probative value more fully discussed, *infra*) to the issue of likelihood of confusion. The Board generally accepts and considers evidence related to likelihood of confusion for the period up to the time of trial, and this includes evidence of the fame of a plaintiff's mark.

As to each party's remaining objections to the other's testimony based on relevancy, lack of foundation, improper testimony and leading questions, they principally relate to the probative value to be accorded the testimony in question. While not addressed specifically, we overrule them are mindful of them and have accorded the relevant testimony the appropriate probative value.¹¹

THE RECORD

In light of the foregoing, the record consists of the pleadings and the file of application Serial No. 76563252. In addition, during its assigned testimony periods, opposer submitted the testimony deposition of Juli Plassmeyer, with exhibits 1-42 and 44-46; opposer's three notices of reliance (all filed on March 16, 2009) on: (a) a status and title copy of its pleaded Registration No. 1529939¹²; (b) applicant's responses to certain of opposer's discovery requests; (c) official records in the nature of a copy of a third-party complaint filed by applicant's predecessor-in-interest and copies of four third-party registrations; and (d) printed publications in the nature of newspaper and magazine articles; and opposer's rebuttal notice of reliance submitting dictionary definitions of "beg" and "wag."

During its assigned testimony period, applicant submitted the testimony declaration, with exhibits 1-9, of Philip Montooth, applicant's chief financial officer; and applicant's notice of reliance on (a) copies of applications and registrations owned by applicant; (b) copies of third-party registrations; (c) dictionary definitions of the terms "wag" and "beg"; (d) opposer's responses to applicant's interrogatories and document requests; and (e) portions of the Rule 30(b)(6) discovery deposition of applicant "so as to make not misleading" what was offered by opposer in its notice of reliance on portions of that deposition.

*8 Both parties filed briefs on the case, including a reply brief by opposer, and an oral hearing was held.

DISCUSSION

Opposer's Standing and Priority of Use

Because opposer has properly made pleaded Registration No. 1529939 of record, we find that opposer has established its standing to oppose registration of applicant's mark. See [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and [Lipton Industries, Inc. v. Ralston Purina Co.](#), 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's Registration No. 1529939 is of record, Section 2(d) priority is not an issue in this case as to the mark therein and goods covered thereby. See [King Candy Co. v. Eunice King's Kitchen, Inc.](#), 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Turning now to our discussion of the issue of likelihood confusion, our determination thereof is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in [In re E. I. du Pont de Nemours & Co.](#), 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by §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).

Fame

We begin our likelihood of confusion analysis with the *du Pont* factor which requires us to consider evidence of the fame of opposer's mark and to give great weight to such fame if it exists. See [Bose Corp. v. QSC Audio Products Inc.](#), 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); [Recot Inc. v. Becton](#), 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and [Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.](#), 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a “dominant role in the process of balancing the *DuPont* factors,” [Recot](#), 214 F.3d at 1327, 54 USPQ2d at 1456, and “[f]amous marks thus enjoy a wide latitude of legal protection.” *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, “[a] strong mark ... casts a long shadow which competitors must avoid.” [Kenner Parker Toys](#), 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one “with extensive public recognition and renown.” *Id.*

*9 [Bose Corp. v. QSC Audio Products Inc.](#), 63 USPQ2d at 1305.

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Id.* at 1309. This information, however, should be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the products, etc.). *Id.* at 1305-1306 and 1309.

We now consider the evidence introduced by opposer to establish that its BEGGIN' STRIPS mark is famous, and note that much of it has been designated as confidential and, where necessary, will be referred to only in general terms. We also point out that while, at first blush, opposer's evidence appears to overwhelmingly support the fame of its BEGGIN STRIPS mark, much of it suffers from inconsistencies or insufficient context. In particular, although opposer's witness, Ms. Plassmeyer, testified that opposer has had tremendous sales of dog snacks under the mark, this testimony is a marked departure from its response to Interrogatory No. 8 wherein opposer indicated that its sales were only in the “hundreds of thousands of dollars.”¹³ Opposer's proffered advertising expenditure figures are similarly inconsistent¹⁴ and, additionally, are absent context. Although applicant pointed out these inconsistencies in the sales and advertising figures, both during the Plassmeyer testimony and in the evidentiary brief that accompanied its main brief, opposer never addressed the inconsistencies. Because of the unexplained discrepancies in the sales and advertising figures, this evidence has little probative value - we do not know which ones are accurate. In addition, since opposer's market share information is primarily based on sales information that we have found inconsistent, it, too, is not especially probative.

We further find the Plassmeyer testimony, and accompanying Exhibit 21, regarding opposer's annual "Beggin' FSI [free standing inserts] impressions"¹⁵ from 2000 to 2008 of limited probative value. Although Ms. Plassmeyer testified that the inserts were distributed "nationwide," there is no testimony (or exhibits) concerning any specifics such as the particular newspapers, the areas of distribution and the length of time distributed, e.g., once or over the ten year period. That is to say, on this record, we cannot ascertain what Ms. Plassmeyer meant by "nationwide" distribution.

We likewise find the evidence of annual television "impressions"¹⁶ from 2000-2008, excluding 2007 lacks context. While Ms. Plassmeyer testified that the "impressions" were compiled from Nielsen data maintained by opposer and reviewed by her in the course of her employment, the summary information is hearsay because the Nielsen data is not maintained by her and the compilation was not prepared by her. Moreover, her testimony, and supporting exhibit No. 18, fail to indicate what percentage of the "gross impressions" refers to discrete impressions or the viewing markets of those impressions. As proffered, the impressions could refer to a limited number of households located in limited geographic locations. The evidence of the annual impressions of the BEGGIN' STRIPS[®] Barkus Pet Parade (discussed more fully below) for the years 2004-2008 also has limited probative value. Although opposer provided a breakdown by television media outlets and viewers, the information only covers the 2007 parade, and the air dates of February 13, 2007 and February 16, 2007. Plassmeyer test. pp. 81-96, Exhs. 27 through 29.

***10** Other evidence in the record is probative of the length of use and renown of opposer's mark. Opposer has used its BEGGIN' STRIPS mark since at least as early as 1988. Plassmeyer test. pp. 17-19. Goods bearing the BEGGIN' STRIPS mark have been sold and distributed throughout the United States. Plassmeyer test. pp. 125-126. Opposer uses a variety of media outlets to advertise and promote the BEGGIN' STRIPS mark, including newsprint, magazines, television, radio and direct mailing. Plassmeyer test. pp. 47, 54-55 and 60-61. Commercials featuring opposer's BEGGIN' STRIPS mark have been copied by fans and placed on the video sharing website www.YouTube.com. Plassmeyer test. pp. 46-47. In 2008, there were over 36,000 visits to opposer's website, www.beggingtime.com, by which opposer advertises its BEGGIN' STRIPS mark. Plassmeyer test. p. 61. For the sixteen years preceding the Plassmeyer deposition, opposer has sponsored the BEGGIN STRIPS[®] Barkus Pet Parade in St. Louis, Missouri, an event which receives nationwide media exposure. Plassmeyer test. pp. 80-105, exhs. 27-29, and e.g., not. of rel., exhs. P 11-24, 30, 33 and 51. In addition, opposer has received unsolicited media coverage in, for example, the [Chicago Sun Times](#), [Albuquerque Journal](#), [Greensboro News & Record](#), [St. Louis Post-Dispatch](#) and [The Boston Herald](#), albeit primarily with regard to either the Barkus Pet Parade or a "stupid dog trick" contest, which appears to have at one time been an event sponsored by opposer. Opposer's not. of rel. Exhs. 30-132.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. [Leading Jewelers Guild Inc. v. LJOW Holdings LLC, 82 USPQ2d 1901, 1904 \(TTAB 1961\)](#). In this case, while opposer has demonstrated that its mark has achieved at least a high degree of recognition, because of inconsistencies and lack of context, the evidence is not sufficient to support a finding that the mark is famous and thus entitled to the extensive breadth of protection accorded a truly famous mark.

Nonetheless, based on the record, we find opposer's BEGGIN' STRIPS mark distinctive and strong and entitled to a broad scope of protection. In coming to this determination, we have considered all of the evidence relevant thereto, including applicant's evidence, more fully discussed *infra*, of third-party uses of various "GIN," "GGIN," "GGIN'" and "N'" formative marks.

Similarity of the Goods and Services/Trade Channels/Purchasers

We next consider the *du Pont* factors which pertain to the similarity or dissimilarity of the goods, channels of trade and classes of purchasers. It is well settled that likelihood of confusion is determined on the basis of the goods as identified in the application and in the pleaded registration. [Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 \(Fed. Cir. 2002\)](#). Where the goods in the application and pleaded registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed

that in scope the identification encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. [In re Elbaum, 211 USPQ 639, 640 \(TTAB 1981\)](#).

*11 As for the goods, applicant's goods are identified as “pet food and edible pet treats” and opposer's goods are identified as “dog snacks.” We find applicant's pet food and edible pet treats are so broadly identified as to encompass opposer's dog snacks. As such, we find them legally identical.

Further, in the absence of any limitations in applicant's application and opposer's pleaded registration as to channels of trade and classes of purchasers, we must presume that the identical goods will be sold in the same channels of trade and to the same classes of purchasers. See [In re Elbaum, 211 USPQ at 640](#). Indeed, applicant does not contend otherwise and its brief is silent on these issues. Indeed, these identical goods could be sold side by side in the same supermarkets or pet supply stores.

The *du Pont* factors of relatedness of the goods, channels of trade and classes of purchasers thus favor opposer.

Conditions of Sale

With respect to the conditions under which the parties' goods are or will be purchased, we note that the goods are or will be relatively inexpensive items, either priced or to be priced at as little as \$2¹⁷, which would be purchased by ordinary consumers who will exercise no more than ordinary care in making their purchasing decisions.

Thus, this *du Pont* factor favors opposer.

The Marks

We now turn to a consideration of the marks, keeping in mind that when marks would appear on identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. [Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 \(Fed. Cir. 1992\)](#). In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See [Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 \(Fed. Cir. 2005\)](#).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See [Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 \(TTAB 1975\)](#). That is, the purchaser's fallibility of memory over a period of time must be kept in mind. See [Grandpa Pidgeon of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 \(CCPA 1973\)](#); and [Spoons Restaurant Inc. v. Morrison Inc., 23 USPQ2d 1735 \(TTAB 1991\)](#); *aff'd unpub'd* (Fed. Cir., June 5, 1992).

*12 With these principles in mind, we compare applicant's mark WAGGIN' STRIPS with opposer's mark BEGGIN' STRIPS. Applicant argues that its mark differs from opposer's mark:

Given that WAGGIN' and BEGGIN', the beginning-dominant portions of Opposer's and Applicant's marks are so dissimilar, coupled with the fact that the shared portion “STRIPS” is generic, and given that the appearance, sound, connotation, and commercial impression of the mark WAGGIN' STRIPS is completely separate and distinct from Opposer's mark BEGGIN' STRIPS, consumers are not likely to believe Applicant's WAGGIN' STRIPS pet treats and Opposer's BEGGIN' STRIPS dog snacks emanate from the same source.

Applicant's br. p. 22.

We disagree. Comparing the marks first in terms of appearance, we find that they look similar to the extent that both have the same format, structure and syntax; both being comprised of two words, the first word in each ending in "GGIN" and the second in each being the word STRIPS. Although the words BEGGIN' and WAGGIN' include different-first two letters, they nonetheless look similar to the extent that both are six letter words, include "GGIN" as the final four letters and use an apostrophe in place of the final letter "g" of present participle forming suffix "ing." Further, even though the word STRIPS is admittedly descriptive and has been disclaimed in each case, that does not remove the word from each mark or reduce its contribution to the overall look of each mark. We also note that the fact that applicant seeks registration of its mark in standard character format, as is opposer's registered mark, means that neither party is limited to any particular manner of display. See [Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 \(CCPA 1971\)](#) (When a word mark is registered in typed form, the Board must consider all reasonable modes of display that could be represented.). Thus, both parties could display their marks in similar lettering. The similarities in appearance overshadow the differences.

In terms of sound, we find the marks to be similar in rhythm and cadence, both having three syllables, the final two of which would be pronounced the same. While "wag" and "beg" sound different, they only comprise a single syllable of each mark. In their entireties, the marks sound similar.

As regards connotation, since both parties' goods include edible pet treats, the term "strips" would mean the same thing in relation to both marks. In addition, both "WAGGIN' and BEGGIN' evoke images of, albeit somewhat different, dog behaviors.¹⁸ As such, both marks, as a whole, connote types of treat that elicit certain canine behavior.

Applicant has argued that the marks have "decidedly" separate and distinct meanings. Citing to the Plassmeyer testimony deposition, applicant particularly argues that opposer's mark conveys the message that BEGGIN' STRIPS means "bacon strips" while its mark, by contrast, contains no wordplay and communicates no direct or hidden meaning of "bacon." Applicant br. p. 18 citing Plassmeyer test. p. 141. The evidence, however, is not conclusive that consumers understand BEGGIN' STRIPS only to mean bacon strips. Indeed, even if BEGGIN' STRIPS is understood by some consumers to mean "bacon strips," as just noted, the plain meaning of BEGGIN' STRIPS is of strips treats intended to elicit certain canine behavior, and that same connotation can be attributed to applicant's WAGGIN' STRIPS mark. Moreover, applicant cited only to a portion of Ms. Plassmeyer's response. As revealed by her complete response noted below, Ms. Plassmeyer stated that the word Beggin' is also intended to convey "excited dog behavior."

***13 Q.** (By Mr. Braunel) What do you intend to convey with the word "Beggin'" as shown on the Beggin' Strips Bag?

A. Well, the word "Beggin'" -- we have done a lot of consumer research, the word "Beggin'" has kind of a dual meaning, which is great. So it conveys bacon. So bacon strips, obviously it looks like a piece of bacon so it conveys that. As well as it conveys the dogs excitement. He is begging to get them. He is very excited to get them. He is enthusiastic to get them."¹⁹

Further, in considering the meanings of the marks, we must consider the meaning of opposer's mark not only when heard, but also when read. When read, the meaning conveyed by BEGGIN' STRIPS is not "bacon strips." As such, notwithstanding the dual connotations that may be attributed to opposer's mark, Ms. Plassmeyer's testimony is consistent with our finding that both opposer's mark and applicant's mark have very similar connotations.

In terms of commercial impression, we find the marks are very similar. They are two-word marks which are constructed in the same way. They both begin with similarly spelled words that describe attributes of dog behavior and end with the identical word STRIPS. This significant similarity in the basic format and structure of the two marks simply outweighs the differences in the first words of the two marks.

While admittedly there are differences in the parties' marks when viewed on a side-by-side basis, we nonetheless conclude that the marks, when considered in their entireties are substantially similar in appearance, sound, connotation and commercial impression. Simply put, the similarities between the marks outweigh the differences.

Before leaving this discussion, we address the following additional arguments made by applicant. First, we find unavailing applicant's contention that in determining whether the marks are similar we must consider that opposer's BEGGIN' STRIPS mark is generally used in connection with the Purina house mark and checkerboard design and, that if applicant ever uses the WAGGIN' STRIPS mark, it will likely do so in connection with Applicant's PRO PAC mark and dog face logo. "[I]t is settled that a product label can bear more than one trademark without diminishing the identifying portion of each portion." *Fort James Operating Co. v. Fort Royal Paper Converting, Inc.*, 83 USPQ2d 1624, 1629 (TTAB 2007), citing *The Proctor & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 474 (TTAB 1976). The issue of likelihood of confusion in this case involves applicant's applied-for mark WAGGIN' STRIPS and opposer's pleaded mark BEGGIN' STRIPS. See *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539 (TTAB 1972).²⁰ We have therefore not considered the additional marks that have or may appear on the parties' products.

*14 We also are not persuaded by applicant's arguments that "logic dictates that consumers familiar with Opposer's BEGGIN' line of products [under the line extension marks BEGGIN' TIME, BEGGIN' CHEW, BETTIN' LITTLES, BEGGIN' WRAPS, BEGGIN' CANADIAN CUTS, ITS BEGGIN' TIME and THERE'S NO TIME LIKE BEGGIN' TIME] are likely to believe that a mark that does NOT include the term "BEGGIN'," e.g., WAGGIN' STRIPS, JUMPIN' STRIPS or JOGGIN' STRIPS, must emanate from a source other than Opposer." (Appl. br. p. 22 (emphasis supplied)). As just stated, we must compare the marks as they appear in applicant's application and the pleaded registration.

Furthermore, to the extent that applicant and, for that matter, opposer have relied on a variety of cases to bolster their respective contentions that the marks are or are not similar, as is often noted by the Board and the Courts, each case must be decided on its own merits. See *In re Nett Designs Inc.*, 236 F.3d 1339, 51 USPQ2d 1564, 1566 (Fed.Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTQAB 2001). Here, for the reasons discussed above, the marks are substantially similar in appearance, sound, connotation and commercial impression.

In view thereof, the *du Pont* factor of similarity/dissimilarity of the mark favors opposer.

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

In further support of its contention that there is no likelihood of confusion between the marks, applicant has made of record various used-based third-party registrations which include the suffixes "GIN," "GGIN," "GIN'," "GGIN'," or "N'" in combination with other matter, or incorporate pet characteristics such as wag, beg, wiggle or bark, primarily for pet food and pet treats, to show that the "-GGIN'" portion of opposer's is weak and entitled to a narrow scope of protection or that it is common to incorporate animal characteristics in pet food/pet treat marks. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ("little weight is to be given such registrations in evaluating whether there is likelihood of confusion."). Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace and, as a result, are able to distinguish between the "-GGIN'" marks based on slight differences between them. Nor are they proof that consumers are able to distinguish between various animal characteristic marks.

*15 Moreover, of the forty registrations submitted, four are expired (Registration Nos. 2836520, 2631655, 2832081 and 2178965). Another nine are for marks which are more dissimilar to opposer's BEGGIN' STRIPS than is applicant's and cover dissimilar goods and/or services (Registration No. 2350531 for the mark WAGGIN' WEAR and design for leashes and collars, Registration No. 2313808 for the mark WAGGIN' CORRAL for kennels for animals, Registration No. 1073731 for the mark

KITTY DIGGIN'S for absorbent material used for small animal litter, Registration No. 2874758 for the mark WALK THE DOG TAIL WAGGIN' PET CARE for dog walking and pet sitting, Registration No. 3120549 for the mark GROOM WAGGIN MOBILE PET GROOMING for animal grooming, Registration No. 1978406 for the mark WAGGIN' WHEELS for home pet sitting, Registration No. 3224598 for the mark TAILS R WAGGIN MOBILE PET GROOMING and design for mobile non-med pet grooming, Registration No. 2995927 for the mark RESCUE WAGGIN for charitable fundraising and Registration No. 3309646 for the mark EMERGENCY RELIEF WAGGIN for charitable services, namely providing transportation via commercial vehicle, of pet food and supplies to pet animal rescue. The remaining twenty-seven registrations are for marks more dissimilar to opposer's BEGGIN' STRIPS mark than is applicant's mark, although they pertain to similar goods (for example, Registration Nos. 3296383, 3228640, 3428776, 3456757 and 3296382 - owned by the same entity - for marks including the term WAGGIN' TRAIN BRAND, Registration No. 2815161 for the mark BARK N BAC'N, Registration No. 3378068 for the mark CHICK 'N' CHEDDAR, Registration No. 2861354 for the mark BAC'N BAC'N, Registration No. 3227464 for the mark UNCLE JIMMY'S HANGIN' BALLS, Registration No. 3083560 for the mark BAK'N TREATS, Registration No. 2945321 for the mark BAK'N DELIGHTS, Registration No. 2875964 for the mark BAC'N CHEESE and Registration No. 3082854 for the mark BEGGAR'S CHOICE).²¹

Applicant has also made of record copies of third-party product packaging showing third-party marks for strips-type dog treats. The packaging is for marks that are more dissimilar to opposer's mark than is applicant's and applicant has provided no evidence as to the extent of such third-party use. Accordingly, the packaging, being evidence of third party use, has little probative value. *See e.g., Fort James Operating v. Fort Royal Paper Converting, supra.*

We thus find that applicant's evidence does not establish that there is widespread use of similar marks for pet treats such that opposer's mark is weak, or otherwise justify the registration of another confusingly similar mark.

Applicant's Intent

Last, opposer maintains that "Applicant knew of Nestle's BEGGIN' STRIPS mark before applicant adopted its WAGGIN' STRIPS mark and yet adopted it anyway."²² Appl. br. p. 21. Opposer also contends that applicant copied Nestle's mark when creating preliminary mock-up packaging, and that that copying strongly suggests an intent to trade on Nestle's reputation. Although there is some similarity between opposer's product packaging and applicant's mock up packaging with respect to the depiction of the product itself, applicant has yet to finalize any packaging design and, further, its mock-up design closely resembles packaging that applicant already uses in commerce for other pet treat products. Moontooth test. pp. 19-29, Exhs. 1-7. We therefore are not persuaded that applicant copied opposer's packaging. In addition, applicant's prior knowledge of the opposer's mark, in and of itself, does not constitute bad faith. See [Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ 1307 \(Fed. Cir 1989\)](#). [Ava Enterprises, Inc. V. Audio Boss USA, Inc., 77 USPQ2d 1783 \(TTAB 2006\)](#). On this record, opposer did not establish that applicant intentionally sought to trade on opposers' good will or otherwise has acted in bad faith in seeking to register the applied-for mark.

***16** Even so, it is settled that one who adopts a mark similar to the mark of another for the same or closely related goods does so at his own peril. [W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc. 190 USPQ 308 \(TTAB 1976\)](#).

Conclusion

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion. After balancing the relevant factors, we conclude that confusion is likely between opposer's BEGGIN' STRIPS mark and applicant's WAGGIN' STRIPS mark. We do so principally because the goods are identical, the channels of trade and classes of purchasers are the same, and the marks are similar in appearance, sound, connotation and commercial impression.

DILUTION

We now consider opposer's dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. The fame that must attach to a mark for it to be eligible under the dilution provisions of the Trademark Act is greater than that which qualifies a mark as famous for the *du Pont* analysis of likelihood of confusion. *Toro Co. v. ToroHead Inc.*, 61 at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) (“[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection.”). Since we have already found that, on this record, opposer's BEGGIN' STRIP mark does not have the *du Pont* analysis fame, then it would follow that it does not have the fame necessary for a dilution claim.²³ Having found so, we need not reach the other factors in a dilution analysis.

BONA FIDE INTENTION TO USE THE MARK

We finally consider opposer's claim that applicant does not have a bona fide intention to use its mark in commerce. Opposer contends that “[t]he admitted absence of the slightest documentation of intent to use WAGGIN' STRIPS as a trademark demonstrates Applicant's lack of bona fide intent to use the mark.” Opposer further explains that applicant has conducted no market research, no manufacturing activities and no promotional activities in connection with its WAGGIN' STRIPS mark. For these reasons, opposer maintains that the Board should rule applicant' application void.

Trademark Act Section 1(b), [15 U.S.C. § 1051\(b\)](#), states that “a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce” may apply for registration of the mark. A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d at 1355. Opposer has the burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods.

*17 In this case, we find that opposer has not met its burden of demonstrating applicant's lack of a bona fide intent to use the mark. Although the documentary evidence consists solely of mock-up product packaging, applicant's witness, Mr. Montooth, has testified to applicant's general practice when selecting a trademark for a new product, and there is no indication that the practice was not followed. *Montooth test.* pp. 16-19, and 40. Mr. Montooth testified that due to the large costs related to manufacturing and launching new pet food and treat products, applicant does not fully develop the product or packaging until the application has been allowed to register by the United States Patent and Trademark Office. *Appl. br.* p. 6, citing *Montooth test.* pp. 16-19. Furthermore, because applicant's mark had yet to clear the application process, statements made by applicant during discovery do not negate applicant's bona fide intent to use the WAGGIN' STRIPS mark in commerce.²⁴

Unlike the applicant in [Commodore Electronics Ltd. v. CBM Kabushiki Kaisha](#), 26 USPQ2d 1503 (TTAB 1993), here applicant is not only a competitor in the pet treat industry with the capability to manufacture strips, but applicant currently manufactures other strips-type products and does not have numerous intent-to-use applications pending for the same goods.

Decision: The opposition is sustained as to opposer's priority and likelihood of confusion claim and dismissed as to its dilution and no bona fide intention claims.

Footnotes

- 1 Serial No. 76563252, filed on November 21, 2003, with an allegation of a bona fide intention to use the recited goods in commerce. The term “strips” has been disclaimed.
- 2 As confirmed by opposer's counsel at the oral hearing held in connection with this matter, opposer's assertion in the first amended notice of opposition that applicant's mark “falsely suggests a connection with Opposer” was in intended to be a part of opposer's claim of likelihood of confusion, and we have considered it as such.
- 3 Registration No. 1529939 issued March 14, 1989, renewed. The registration includes a disclaimer of the word “Strips.”

- 4 Applicant also asserted the affirmative defense of unclean hands. However, since this defense was not pursued at trial, it is considered withdrawn and will not be further considered. In addition, the remaining enumerated “affirmative defenses” merely amplify applicant’s denials of the claims asserted in the first amended notice of opposition.
- 5 The question and response (emphasis supplied) from the Montooth testimony is as follows:
Q. Can you identify those competitors that you recall that make strips treats?
 A. There are a number of strip treats out there. Milk-bone makes a bacon - a bacon strip treat. Loving Pet makes a number of treats. Beef Eaters makes a number of strip treats. Bravo makes a number. Ol’oy makes some strip treats. Dollar General has a brand. I believe PETCO and PetSmart also have a brand of strip treats. ...
 (Montooth test. p. 32).
- 6 Exhibits 1-6 consists of packaging of various pet treat products sold by applicant under marks other than the applied-for mark WAGGIN’ STRIPS.
- 7 The ruling was made in a decision on a motion to strike the declaration of Cynthia Montgomery filed in support of applicant’s motion for summary judgment and in defense of opposer’s cross-motion for summary judgment. The Board ruled that “having refused to produce Ms. Montgomery for a deposition, arguing that any information she had is cumulative or irrelevant, applicant cannot now fairly rely on Montgomery’s testimony” (October 17, 2008 order p. 10). The Board further stated that “at trial, applicant may not seek to introduce into evidence Ms. Montgomery’s testimony, and/or information sought from Ms. Montgomery during discovery but not produced by applicant.” *Id* at fn. 4.
- 8 In any event, the packaging identified as Exhibit G to Mr. Montooth’s testimony had already been made of record by opposer and may be considered for whatever value it has. See Plassmeyer Exh. 44.
- 9 Applicant’s additional argument that the summary documents are not the best evidence is not well taken since applicant had the opportunity to review the underlying documents. See e.g., *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 859 (TTAB 1981 (Summary exhibits were not excluded when a party “made no demand for the detailed records from which the summaries were prepared, although they were available.”).
- 10 We add that even if we had considered this material, it would not have changed the outcome. Because Ms. Plassmeyer did not have firsthand knowledge to testify about the brand awareness survey undertaken by Milward Brown, the compilation document has little probative value.
 In addition, applicant pointed to two other discovery requests to which opposer responded “none” or “none at this time.” These requests are Document Request No. 4, which sought documents and information which refer or relate to instances of actual confusion, or the absence of such confusion, between the BEGGIN’ STRIPS Mark and the WAGGIN’ STRIPS Mark, and Interrogatory Request No. 5. We note, however, that applicant’s application is based on intent-to-use and, because applicant did not make its Interrogatories of record, the information sought by Interrogatory Request No. 5 is unknown.
- 11 Opposer’s motion to strike references in applicant’s brief to the relative size of the parties and incomplete hypotheticals as immaterial and impertinent is denied.
- 12 Although the title and status information regarding Registration No. 1529939 became outdated during the course of this proceeding, we have, in accordance with Board practice, reviewed the electronic records of the Office and note that ownership remains with opposer and that the registration is currently subsisting, having been renewed for a period of ten years on March 4, 2009.
- 13 Applicant’s not. of rel. exh. H.
- 14 *Id.*
- 15 Ms. Plassmeyer indicated that “[i]mpressions are defined in this case by distribution. So they take the circulation of the newspapers and times that by, you know, or add that all up basically to get your impressions across the country.” Plassmeyer test. p. 69.
- 16 Ms. Plassmeyer, in her deposition, stated that “[i]mpressions is [sic] basically the number of people that have seen the commercial times the number of times they have seen it. So that sets the impressions.” Plassmeyer test. p. 55.
- 17 Plassmeyer test. pp 122-123; and Applicant’s Not. of rel. exh. I.
- 18 Both applicant and opposer have made definitions of the terms “wag” and “beg” of record. We have set forth the most pertinent below, both taken from *Webster’s Third New International Dictionary* (3rd ed. 1981) and made of record by applicant in its Not. of rel. Exh. F:
 “wag” **5a**: to move with a wagging or wobbling motion: WADDLE <a dog *wagging* down the street> **b** *of an animal*: to wag the tail <a pack of dogs - they fawned, they *wagged*, they growled - Helen Howe>
 (p. 2568);
 “beg” **4**: to obtain release of esp. by entreaty ~ iv ... 3 *of a dog or other pet animal*: to make a formalized gesture of request, esp.: to sit erect on the haunches with the forepaws raised
 (p. 198).
- 19 Plassmeyer test. p. 141.

- 20 We also point out that the issue of likelihood of confusion before the Board concerns registrability rather than use. For this reason, the infringement cases cited by applicant in support of its position that the Board should consider product packaging are readily distinguishable.
- 21 Applicant also submitted six use-based third-party registrations (i.e., Registration No. 2515898 for MEATY STRIPS, Registration No. 2867508 for LICKETY STRIPS, Registration No. 3250022 for SCHMACKOS BAKON STRIPS, Registration No. 3277971 for CHICKEN STRIPS, Registration No. 3133006 for BREATH-EZE BREATH STRIPS and Registration No. 2935635 for TASTY STRIPS) that include the term “STRIPS” for pet food or dental care products to show that it, too, merits very little weight in the overall likelihood of confusion analysis. We note that these registrations either include a disclaimer of the terms “strips,” are registered on the supplemental register, or the term is incorporated in a unitary design. As discussed earlier, even though matter may be descriptive, that does not reduce its contribution to the overall look of a mark. More importantly, none of these registrations include both the terms “strips” and “beggin” or any variation thereof.
- 22 Nestle is one of opposer's predecessor companies, and the name Nestle was used by opposer at times during the course of this proceeding to refer to itself.
- 23 We are compelled to comment that even if we had found that the evidence of record demonstrated fame for likelihood of confusion purposes, it would not have been considered particularly probative to show fame for dilution purposes. This is so because opposer would have had to show that its mark was famous prior to the filing date of applicant's intent-to use application. *Toro Co. v. Torohead, supra*. Here, the overwhelming majority of evidence relating to opposer's fame is dated thereafter.
- 24 During discovery, Applicant stated “Applicant has not decided to use the name on pet food and edible treats. The name has not been and may never be used.” Opposer's not. of rel. exh. P-2, Applicant's answer to Interrogatory No. 27.

2011 WL 1495460 (Trademark Tr. & App. Bd.)

2012 WL 3992908 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

VIRGIN ENTERPRISES LIMITED

v.

STEVEN E. MOORE

Opposition No. 91192733
to application Serial No. 77695546

August 31, 2012

Hearing: April 10, 2012

filed on March 20, 2009

*1 [Joseph V. Norvell](#), [Joseph T. Kucala, Jr.](#), and [Sarah E. Dale](#), of Norvell IP LLC for Virgin Enterprises Limited
Steven E. Moore, pro se

Before [Holtzman](#), [Bergsman](#) and [Wellington](#)

Administrative Trademark Judges

Opinion by [Bergsman](#)

Administrative Trademark Judge:

Steven E. Moore (“applicant”) filed a use-based application on the Principal Register for the mark VIRGINFARMS and design, shown below, for “agricultural grains for planting; agricultural seeds; bulbs for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use,” in Class 31.



Applicant disclaimed the exclusive right to use the term “VIRGIN FARMS.”

Virgin Enterprises Limited (“opposer”) filed a notice of opposition against the registration of applicant’s mark on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, [15 U.S.C. § 1052\(d\)](#), and dilution pursuant to Section 43(c) of the Trademark Act, [15 U.S.C. § 1125\(c\)](#). Opposer alleged ownership and prior use of forty-seven trademark and service mark registrations that constitute or include the word “VIRGIN.”¹ For purposes of this opposition, we focus on the following six registrations for VIRGIN and VIRGIN-formative marks, because these marks are the closest to applicant’s mark and cover goods and services that, when considered vis-à-vis the applied-for mark and identified goods, are most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Group Ltd.*, [93 U.S.P.Q.2d 1243, 1245 \(TTAB 2010\)](#).

1. Registration No. 1851817 for the mark VIRGIN, in typed drawing form, for the following services:²
Transportation of goods and passengers by road and air, freight transportation services; travel agency services, in Class 39; and

Bars; retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges, in Class 42;

*2 2. Registration No. 2770775 for the mark VIRGIN MOBILE, in typed drawing form, for the following goods and services:³ Mobile telephones, telephones and modems, and accessories therefor, namely, batteries; battery chargers; cigarette lighter adapters; hands-free headsets; carrying cases and belt clips, in Class 9;

Providing directory information via telephone, in Class 35; and

Telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the Internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the Internet, in Class 38;

3. Registration No. 2808270 for the mark VIRGIN ATLANTIC, in typed drawing form, for “transportation of and arranging transportation of goods and passengers by road and air; freight transportation services by air; transportation of human beings by means of land vehicles; chauffeur services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; operation of aircraft for others,” in Class 39;⁴

4. Registration No. 3188282 for the mark VIRGIN, in standard character form, for “alcoholic beverages, namely, vodka and wine,” in Class 33;⁵

5. Registration No. 3472228 for the mark VIRGIN UNITE, in standard character form, for the following services:⁶ Developing promotional campaigns for business; promoting public awareness of the need for businesses to have a positive impact on the communities and environment in which they operate and work together with the social sector to drive long term social change including making investments in emerging markets to accelerate positive social change through economic development; charitable services, namely, organizing and coordinating programs for the sick, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who are bereaved, children in need or at risk, those with sexual problems, and underprivileged communities, and organizing and conducting volunteer programs and community service projects; business management and administration services in connection with a charity, in Class 35;

Charitable fund raising; charitable financial services for those in need, namely, accepting and administering monetary charitable contributions; financial sponsorship of fund raising events and events designed to raise the profile of charitable and social issues, in Class 36; and

Educational services, namely, conducting summits, conferences, lectures and seminars in the field of social change and charitable and social issues; training services in the field of social change and charitable and social issues; organizing community sporting and cultural events; educational services, namely, providing classes, lectures, seminars, workshops, and discussion groups in the fields of sickness, health problems, homelessness, drug use, disabilities, abuse, bereavement, children's needs, sexual problems, and poverty to young people, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who have been bereaved, children in need or at risk, those with sexual problems, and underprivileged communities; charitable services, namely, academic mentoring of children from underprivileged communities and young people, in Class 41; and

*3 6. Registration No. 3541731 for the mark VIRGIN AMERICA, in standard character form, for the following services:⁷

Air transportation; freight transportation services by means of air, ship, truck, and rail; airport passenger and baggage check-in services; airport services, namely, ticketing and boarding services; travel services, namely, booking seating arrangements for airline passengers; air transportation services featuring frequent flyer miles as a bonus program for frequent air travelers; providing flight arrival and departure information; and transportation reservation services, in Class 39; and

Onboard in-flight entertainment services, namely, distributing movies, TV programs, and audio programs, and providing temporary use of video games, software and personal monitors for viewing the same, in Class 41.

With respect to its claim of likelihood of confusion, opposer alleged that applicant's mark VIRGINFARMS and design so resembles opposer's VIRGIN trade names and marks as to be likely to cause confusion. With respect to its dilution claim, opposer alleged that its VIRGIN mark was famous prior to applicant's filing date of March 20, 2009, and that the registration of applicant's mark is likely to dilute the distinctive quality of opposer's VIRGIN and VIRGIN-formative marks.

Applicant, in his answer, denied these allegations in the notice of opposition. Applicant also asserted several affirmative defenses, but did not pursue any of them by motion or at trial. The affirmative defenses, therefore, are deemed waived and given no further consideration.

Evidentiary Matters

A. Exhibits to the Answer.

Applicant attached six exhibits to his answer to the notice of opposition, consisting of five state trademark registrations and a state certificate to brand livestock. For such material, [Trademark Rule 2.122\(c\)](#) provides that “an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.” [37 C.F.R. § 2.122\(c\)](#); *see* Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 317, 704.05 (3d ed., rev. 2012). Applicant did not testify during the testimony period. Opposer has objected to the exhibits. Opposer's objection is sustained and we give no consideration to these exhibits.

B. Opposer's Submissions of Printed Publications on DVDs and CD-ROMs.

On October 22, 2010, opposer filed a notice of reliance on a significant volume of printed publications as evidence, submitted on seven DVDs (totaling more than 180,000 digital files), and on July 12, 2011, opposer submitted certain exhibits to testimonial depositions on CD-ROMs. Applicant has raised no objections to these submissions, either as to format or substance of material.

*4 [Trademark Rule 2.126](#) governs form of submissions. [37 C.F.R. § 2.126](#). For some time prior to August 31, 2007, the Board permitted certain submissions on CD-ROM. The Board deleted from [Trademark Rule 2.126](#) the option of filing submissions in CD-ROM format by amendment to Rule 2.126, effective August 31, 2007. ⁸ [Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242 \(Aug. 1, 2007\)](#) (codified at 37 C.F.R. pt. 2). The amended rule was applicable to all cases pending or commenced on or after that date. [72 Fed. Reg. at 42,242](#). Part three of the Federal Register notice of the final package of the rule change is titled “Removal of Option to Make Submissions on CD-Rom,” and states the basis for the rule change was that file submissions in CD-ROM form “have presented technical problems for the ESTTA/TTABIS systems.” [72 Fed. Reg. at 42,247](#). The section reporting on comments includes the following response:

The Office is willing to reconsider allowing submissions by CD-ROM in inter partes trademark proceedings if technology eventually will allow such submissions to be efficiently incorporated in the Board's electronic proceeding files. The removal of the option to file materials on CD-ROM is adopted in this final rule.

72 Fed. Reg. at 42, 256. This Federal Register notice has been posted on our website since it was published. Accordingly, all submissions of printed publications on CD-ROMs and DVDs⁹ are not evidence in this proceeding and have not been considered in this decision.¹⁰

C. Statements in Applicant's Brief.

Applicant made a number of statements in his brief, including statements on the now-excluded exhibits to his pleading. “Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest.” TBMP § 704.06(b). Applicant submitted no testimony or evidence during the testimony period. Opposer has objected to this material as inadmissible, in accordance with Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). We have considered applicant's brief mindful that factual statements, without supporting evidence properly made of record, are without value.

D. Exhibits to the Reply Brief.

*5 Opposer attached evidence to its reply brief. “Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.” TBMP § 704.05(b); *see, e.g., Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 U.S.P.Q.2d 1112, 1116 (TTAB 2009); *Bass Pro Trademarks, L.L.C. v. Sportsman Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 1848 (TTAB 2008); *see* 37 C.F.R. § 2.123(l) (“Evidence not obtained and filed in compliance with these sections will not be considered.”). Accordingly, the evidence attached to opposer's reply briefs has been given no consideration.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant's application file. In addition, opposer introduced the following testimony and evidence:

1. Notice of reliance on the following items:
 - a. Photocopies of opposer's pleaded registrations printed from the electronic database records of the U.S. Patent and Trademark Office, showing that the registrations are subsisting and owned by opposer (Opposer's Exs. 1-44);
 - b. Photocopies of 67 non-precedential Board decisions involving oppositions brought by opposer and granted in favor of opposer (Opposer's Exs. 45-111); and
 - c. Photocopies of 62 court judgments in civil actions filed by opposer and granted in favor of opposer (Opposer's Exs. 112-173).
2. Testimony deposition of Christine Choi, Director of Corporate Communications for Virgin Management USA, an affiliate company of opposer, with attached exhibits (Dep. Exs. 1-5, 11-12, 14-41).
3. Testimony deposition of Mark James, Intellectual Property Manager for Virgin Management Limited, an affiliate company of opposer, with attached exhibits (Dep. Exs. 1-3, 36-37, 39, 40, and 42-56).

Applicant did not introduce any testimony or evidence during his testimony period. As noted above, applicant has not properly entered any evidence to the record. The parties briefed the case, and opposer requested and appeared at an oral hearing. Applicant did not attend the testimony depositions or the hearing.

Standing

As opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982).

Priority

As opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods and services covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974).

Likelihood of Confusion

*6 Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

A. The Fame of Opposer's Marks.

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

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as by the general reputation of the branded products and services. *Bose*, 63 U.S.P.Q.2d at 1305-06, 1309. Although raw numbers of product and service sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1904 (TTAB 2007).

Opposer submitted the following testimony and evidence to prove the fame of its VIRGIN and VIRGIN-formative marks:¹¹

1. Mr. James testified that Virgin Atlantic Airways Ltd. ("VAA") is one of opposer's trademark licensees operating in the United States.¹² Mr. James testified that VAA generated over \$450 million in U.S. sales of Virgin-branded goods and services in 2006, over \$450 million in 2007, \$383 million in 2008, and \$302 million in 2009.¹³ Mr. James did not provide any specifics as to the type or kind of goods and services sold by VAA under the Virgin brand. Mr. James testified that VAA "spends approximately \$10 million each year to advertise in the U.S."¹⁴

*7 2. Mr. James testified that Virgin America Inc. ("VAI") is another of opposer's trademark licensees operating in the United States.¹⁵ As for the sales generated in the United States by VAI of Virgin-branded goods and services, Mr. James testified that "from August 2007 until June 2010, it was approximately \$1.3 billion."¹⁶ Mr. James did not provide any specifics as

to the type or kind of goods and services sold by VAI under the Virgin brand. For advertising and promotion in the United States, Mr. James testified that in 2007, VAI spent approximately \$12 million, in 2008, approximately \$11 million, and in 2009, approximately \$15 million.¹⁷

3. Mr. James testified that Virgin Mobile USA, LLC (“VMU”) is another of opposer's trademark licensees operating in the United States.¹⁸ Mr. James testified that VMU generated over \$1.1 billion in U.S. sales of Virgin-branded goods and services in 2006, \$1.3 billion in 2007, \$1.3 billion in 2008, and, for 2009, “up until the third quarter, it was \$937 million.”¹⁹ Mr. James did not provide any specifics as to the type or kind of goods and services sold by VMU under the Virgin brand. Mr. James testified that VMU “spends on average more than \$20 million each year” to promote Virgin-branded phone products and services.²⁰

4. Mr. James testified that one of opposer's licensees, Virgin Entertainment Group, Inc., operated nineteen Virgin Megastores in the United States from 1992 until June 2009, with store locations including New York, Denver, Los Angeles and San Francisco, retailing “a wide range of Virgin-branded products,” including “clothing products, such as T-shirts and sweatshirts, bags, electronic products, playing cards, glasses [and] jewelry.”²¹ Mr. James testified that these retail store services generated more than \$197 million in U.S. sales of Virgin-branded goods and services in 2006, \$188 million in 2007, \$186 million in 2008, and \$153 million in 2009.²² For advertising and promotion in the United States, Mr. James testified Virgin Megastores “spent more than \$10 million in 2006, and almost \$10 million in 2007, and for the period from 2008 until June 2009, it was almost \$15 million.”²³

5. Mr. James authenticated a VAA press release of October 13, 2010, mentioning its selection as “‘Best Domestic Airline’ among U.S. carriers” in *Condé Nast Traveler's 2010 Readers' Choice Awards*.²⁴

6. Mr. James authenticated an advertisement for VAA that appeared in a 2010 issue of the *New Yorker* magazine.²⁵

*8 7. Ms. Choi authenticated articles and that were printed in national publications between 2007 and 2008, including the *Washington Post*, the *New York Times*, *Scientific American*, *Time* magazine, the *New Yorker*, *Bloomberg Businessweek*, which referenced VIRGIN and VIRGIN-formative marks.²⁶

8. Ms. Choi authenticated a DVD containing 126 digital clips from various nationally aired programs that aired between 2005 and 2009 on broadcast networks and cable television channels, including ABC, CBS, CNBC, Fox News, MSNBC, NBC and PBS.²⁷

Opposer provided no supporting evidence or testimony regarding comparable statistics of sales and advertising figures of its leading competitors or its ranking in market share in respective product and service categories, and has provided little probative evidence of the general reputation or critical assessments in the consumer marketplace of the products and services branded with VIRGIN and VIRGIN-formative marks.

As for the printed publications, broadcast clips, and promotional video of record, many of these submissions show and contain references to VIRGIN and VIRGIN-formative marks, but nevertheless these have no or very little independent probative value, as these marks are only seen briefly or are mentioned only in passing. Generally, the goods and services branded with the marks are not the direct subject of the submissions. For example, opposer submitted a television clip from the *Late Show with David Letterman*, which aired on March 2, 2005.²⁸ The five-minute clip features a skit about the first solo nonstop unrefueled aircraft flight around the world. The flight was sponsored by opposer's founder and chairman, Richard Branson,²⁹ and the aircraft, which was owned and operated by the late Steve Fossett, was the Virgin Atlantic *GlobalFlyer*.³⁰ Letterman jokes, “I don't know much about aviation, but I do know this is absolutely a pointless exercise. This couldn't be a more pointless exercise. Me sitting down in this chair advances the cause of aviation more than this guy flying around the world solo. It means nothing.”

The joking continues, and as Letterman says that the flight is reported to be over New York right then, a Virgin-branded toy airplane, pulled by a very visible wire, flies behind Letterman and across the set. There is no mention of VIRGIN in the segment. This clip is representative of the passing references to VIRGIN in many of the evidentiary submissions.

Opposer also argues that a prior finding by the U.S. Court of Appeals for the Second Circuit that its VIRGIN mark is a famous mark is “solid [precedent] upon which the Board may rely.”³¹ However, opposer is incorrect; a “decision by another court based upon a different record is not evidence in this proceeding.” *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q.2d 1645, 1665 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011). By statute, this Board has the duty to decide the right to federal registration in an opposition. 15 U.S.C. § 1067(a). “This duty may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an opposition must be decided on the evidence of record.” 94 U.S.P.Q.2d at 1665.

*9 Similarly, opposer argues that we should find fame for its VIRGIN and VIRGIN-formative marks by extension of finding fame for Richard Branson, stating that he “is a globally recognized personality synonymous with the VIRGIN marks,” and as such, argues that Virgin-branded goods and services serve as secondary source indicators for Branson.³² Opposer supports this argument with evidence of appearances by Branson and coverage of him via multiple forms of media. However, opposer cites to no caselaw to support its argument and the evidence fails to establish that the consumers purchasing Virgin-branded goods and services are even aware of the relationship between Branson and the goods and services at the time of purchase. Thus, there is neither fact nor governing or persuasive caselaw in the record to support opposer's argument.³³

Despite these failings in the evidence submitted by opposer, based on the volume of sales and advertising expenditures of the Virgin-branded goods and services, the variety of goods and services bearing the mark, and the collective evidence presented that demonstrates achieved commercial success, a high degree of renown, and widespread exposure of the general public to opposer's VIRGIN and VIRGIN-formative marks in print and digital media, we find that the VIRGIN and the VIRGIN-formative marks are famous for purposes of likelihood of confusion for a wide variety of consumer goods and for services in the entertainment, telecommunications, transportation and travel fields.

Even though we have found that opposer has proven that its VIRGIN and VIRGIN-formative marks are famous for purposes of likelihood of confusion, fame alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle opposer to a right in gross, and that is against the principles of trademark law. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps., Co.*, 703 F.2d 1372, 217 U.S.P.Q. 505, 507 (Fed. Cir. 1983). Accordingly, we must consider all relevant *DuPont* factors for which evidence has been introduced.

B. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the first *DuPont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *E.g.*, *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (TTAB 1987). While marks must be compared in their entireties in the comparison analysis, if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *E.g.*, *In re Dakin's Miniatures, Inc.*, 59 U.S.P.Q.2d 1593, 1596 (TTAB 1999).

*10 In comparing the marks, we are mindful that the test for similarity is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *E.g.*, *Sakrete, Inc. v. Slag Processors, Inc.*, 305 F.2d 482, 134 U.S.P.Q. 245, 247 (C.C.P.A. 1962). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc.*

v. Oliver & Winston, Inc., 207 U.S.P.Q. 335, 344 (TTAB 1980). We are also mindful that famous marks enjoy wide latitudes of legal protection. *E.g.*, *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). “As a mark’s fame increases, the [Trademark] Act’s tolerance for similarities in competing marks falls.” *Id.*

With these principles in mind, we begin our analysis by finding that the respective marks are similar in appearance and sound because they share the identical term “VIRGIN,” which we take judicial notice is defined, *inter alia*, as follows:

- adj. 1. Of, relating to, or being a virgin; chaste. 2. Being in a pure or natural state; unsullied: *virgin snow*.
3. Unused, uncultivated, or unexplored: *virgin territory*. 4. Existing in native or raw form; not processed or refined.³⁴

Depending on commercial context, the term “VIRGIN” would likely describe or suggest natural, uncultivated, and unprocessed goods and services to the relevant consumer. In this case, the relevant customers who would encounter both applicant’s goods and opposer’s goods and services would be purchasers of agricultural grains, seeds, bulbs and similar products for planting and related agricultural purposes.

Applicant’s mark incorporates opposer’s entire VIRGIN mark. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *See, e.g.*, *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 U.S.P.Q. 105, 106 (C.C.P.A. 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 U.S.P.Q. 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re S. Bend Toy Mfg. Co.*, 218 U.S.P.Q. 479, 480 (TTAB 1983) (LIL’ LADY BUG for toy doll carriages and LITTLE LADY for doll clothing); *Helga, Inc. v. Helga Howie, Inc.*, 182 U.S.P.Q. 629, 630 (TTAB 1974) (HELGA for women’s clothing and HELGA HOWIE for women’s clothing); *In re Hepperle*, 175 U.S.P.Q. 512, 512 (TTAB 1972) (applicant’s mark ACAPULCO GOLD for suntan lotion is likely to cause confusion with ACAPULCO for lipstick and powder). In addition, VIRGIN is the first or only term in all the marks, which often supports finding that marks are similar. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”); *e.g.*, *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (“The presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar.”).

*11 However, because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the test for similarity cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *e.g.*, *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

Applicant contends that his mark, in its entirety, engenders a different commercial impression than any of opposer’s marks of record. Applicant states that the mark “VIRGINFARMS” denotes “soil’s return to an undefiled state, which allows for the growth of nutrient dense foods, for human consumption, and seeds for the next planting season.”³⁵ During prosecution of the application, applicant agreed to disclaim both terms of his mark. Supporting applicant’s contention regarding the mark’s commercial impression, we take judicial notice that “VIRGIN SOIL” is defined as “soil in its natural state as distinguished from soil or land that has been plowed or otherwise altered by humans for cultivated crops or other uses.”³⁶ It would appear to be applicant’s position that the literal elements of his mark describe a characteristic and purpose of the goods. On the other hand, applicant contends that none of opposer’s marks “is descriptive of any of [its] numerous products.”³⁷ We have previously found that differences in connotation can outweigh visual and phonetic similarities. *E.g.*, *Coach Servs. Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600, 1609 (TTAB 2010), *aff’d* 668 F.3d 1356, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012) (finding “COACH” for educational materials calls “to mind a tutor who prepares a student for examination,” while “COACH” for leather handbags,

fashions, and accessories is “arbitrary or suggestive of carriage or travel accommodations”); *Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820-21 (TTAB 2005) (finding that while the marks were very similar in appearance and pronunciation, opposer's “BLUE MAN GROUP” conjured the image of the performers, while applicant's “BLUE MAN” mark made no such connotation for cigarettes or tobacco, and these differences outweighed the similarities); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (finding “PLAYERS” for shoes engenders a different commercial impression from “PLAYERS” for underwear).

*12 Contrary to applicant's contention, we find that applicant's mark is suggestive, and opposer's marks include both suggestive and arbitrary marks. Applicant's “VIRGINFARMS” in relation to his listed goods is suggestive of organic farming. Some of opposer's marks, for example, “VIRGIN ATLANTIC” for transportation and tour conducting services, suggest venturing to the unexplored. While we do not agree with opposer's assertion that applicant's “use of a descriptive term after VIRGIN increases the likelihood of confusion,”³⁸ we do find that the root term of applicant's and opposer's marks, VIRGIN, is a term that means unsullied, uncultivated and unexplored, and that all the marks engender a similar connotation based on this meaning. In addition, we have already found that the VIRGIN and VIRGIN-formative marks are famous marks for purposes of likelihood of confusion. The fame of VIRGIN magnifies the significance of the similarities of the mark. Balancing both the similarities and differences between the marks, and giving due weight to the fame of opposer's marks, we find that the marks are similar.

C. The similarity or dissimilarity and nature of the goods in the application and the goods and services in opposer's registration, likely-to-continue channels of trade and classes of consumers.

In determining whether goods and services are related, the second *DuPont* factor requires that we must consider the goods and services as they are identified in the respective descriptions in the application and registrations. *E.g.*, *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973). It is not necessary that the goods and services of applicant and opposer be similar or competitive to support a holding of likelihood of confusion. It is sufficient that the goods and services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. *Miss Universe L.P. v. Community Mktg. Inc.*, 82 U.S.P.Q.2d 1562, 1568 (TTAB 2007).

In addition, we must accord “full weight to the fame of a famous mark when analyzing likelihood of confusion between products that [are] not closely related.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1898 (Fed. Cir. 2000). For example, in *McDonald's Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, 1898 (TTAB 1990), we found opposer's restaurant services, food and beverages, and promotional toy and game products sufficiently related to applicant's hand-crafted teddy bears, based on opposer's showing that it distributed an extremely large number of various toys under the famous MCDONALD'S and MC-formative marks as promotional items and incentive awards in connection with its restaurant services, such that those encountering applicant's bears under its MCTEDDY mark would assume they originated or were associated with opposer. In *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 U.S.P.Q.2d 1835, 1842-43 (TTAB 1989), we found relatedness of opposer's jewelry and household goods and related retail services under its famous TIFFANY mark and applicant's automobiles under its CLASSIC TIFFANY mark, based on opposer's showing that applicant's advertising associated its mark with luxury and references to jewelry, which it established created a nexus with its goods, reputation and goodwill, sufficient to create a mistaken belief that applicant's goods were associated with or sponsored by opposer.

*13 Here, there are clear and significant differences between applicant's goods and the various goods and services identified in opposer's registrations of record. Applicant is seeking to register his mark for “agricultural grains for planting; agricultural seeds; bulbs for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use.” The scope of these goods is grains, seeds and related items used for planting, and the explicit limitation of these products is that they are for agricultural purposes and not for human consumption. Meanwhile, opposer has VIRGIN and VIRGIN-formative marks registered in connection with a variety of goods and services, generally summarized as musical recordings, printed materials in the entertainment field,

writing instruments, playing cards, clothing, non-alcoholic and alcoholic beverages, cosmetics and body care preparations, cell phones, small electronics, articles of luggage and carrying bags, jewelry, transportation services, restaurant and bar services, mail order catalog and retail store services, advertising and public relations services, photography services, printing services, travel agency services, insurance and financial services, charitable fundraising services, computerized communication and transmission services, body care services, online computer game services, educational services in the social issue and charity fields, organizing sporting and cultural activities, and library facility services.

Determinations are reached based on the evidence of record. Unlike the evidence identified in the *McDonald's* and *Tiffany & Co.* decisions, opposer has not shown that applicant's goods would be related to opposer's goods and services in the mind of the relevant consuming public, or that applicant's use of the mark will lead consumers to believe that applicant's goods are associated with or sponsored by opposer, based on the fame of opposer's VIRGIN and VIRGIN-formative marks. Opposer asserts that the evidence supports a relationship between applicant's goods and its goods and services because all include "agricultural aspects and influence agricultural production."³⁹ To support this assertion, it provides the following example:

[T]he Virgin Group's airport lounges and airlines might purchase and serve sunflower seeds from VirginFarms. There can be no doubt that a Virgin Group⁴⁰ airline passenger who receives a package of VirginFarms' sunflower seeds will be confused as to the source of those seeds. Likewise, VirginFarms' grains and seeds might be used in the production of biofuels by the Virgin Group's licensees or, worse, their competitors.⁴¹

***14** However, the record evidence does not support opposer's assertion. First, there is no evidence that applicant is seeking to use his mark in connection with edible sunflower seeds, as this application lists items limited to agricultural use only; therefore, the confusion theorized in this example for opposer's airline passenger would not result if this application proceeded to registration. Second, opposer has introduced no evidence to establish that seeds for agricultural purposes could be used in the production of biofuels, and there is no evidence that applicant is seeking to use its mark in connection with any grains and seeds that are potentially capable of being used in the production of biofuels; therefore, again, there is nothing in the record to support the theorized harm to opposer should this application proceeded to registration.

The third *DuPont* factor involves how and to whom the goods and services at issue are sold or marketed. We must determine, therefore, whether there is likely to be an overlap between the respective purchasers and users of the goods and services of the parties. *Elec. Design & Sales v. Elec. Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1390 (Fed. Cir. 1992). Since applicant's description of goods is limited to agricultural purposes, the listed goods travel in only those normal channels involving goods for agricultural purposes. However, since those consumers buying seeds and like products for agricultural purposes would also likely buy phones and travel, these consumers may encounter both sets of marks. *In re Elbaum*, 211 U.S.P.Q. 639, 640 (TTAB 1981); see *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 U.S.P.Q. 139, 139-40 (C.C.P.A. 1958). Opposer's registrations have no limitations as to trade channels or classes of purchasers.

The vast difference between grains for planting, spores, and seeds for agricultural use and all of opposer's goods and services would not be lost on average purchasers, let alone those agricultural customers who buy agricultural seeds and grains for commercial planting and farming. By limiting his goods to those for agricultural planting purposes, applicant has limited its channels of trade to those that are unlikely to include opposer's listed goods and services. Moreover, while opposer asserts that its goods and services include agricultural aspects and influence agricultural production, opposer has not provided evidence that supports this assertion in the record.⁴² While some of opposer's submissions through its notices of reliance relate to agricultural production, especially outside of the United States, printed publications and broadcast programming clips may not be used to prove the truth of the matters asserted therein, as that would constitute reliance on hearsay. Thus, we have no basis on which to conclude that the relevant purchasers would believe that applicant's goods are associated with or sponsored by opposer.

*15 Though not directly argued, opposer suggests that since the Virgin Group uses the VIRGIN and VIRGIN-formative marks in connection with “a vast array of goods and services,”⁴³ and the “public has an expectation that the Virgin Group will introduce new and different products and services on a regular basis,”⁴⁴ agricultural seeds and related goods for planting are within opposer's natural expansion of trade. Since opposer did not introduce any evidence supporting its invocation of the doctrine of natural expansion, we have not resorted to this analysis when considering the relatedness of the goods and services in this case.⁴⁵

When a mark is famous, the degree of relatedness of the goods need not be as great. See *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1897-98 (Fed. Cir. 2000). However, there must be something more than just a similarity of marks to show this relatedness or, again, the owner of a famous mark would have a right in gross. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps., Co.*, 703 F.2d 1372, 217 U.S.P.Q. 505, 507 (Fed. Cir. 1983). We find that the goods and services at issue are not related and that the channels of trade are distinct.

Thus, the second and third *DuPont* factors, regarding the similarity or dissimilarity of the goods and services and likely-to-continue channels of trade favor applicant.

D. The conditions under which and buyers to whom sales are made (i.e., impulse vs. careful, sophisticated purchasing).

Considering the particular nature of applicant's goods, we have no doubt that purchasing decisions would not be made impulsively or carelessly, as purchasing grains, seeds, bulbs and other goods used to yield successful farming and agricultural growth would be a purchase of some deliberation and analysis.

In addition, even though professional farmers exercising a higher degree of care are not immune to trademark confusion, the circumstances of purchasing such items would reduce source confusion. Thus, this fourth *DuPont* factor favors applicant.

E. Balancing the factors.

While our findings for purposes of likelihood of confusion are that opposer's marks are famous and the marks are similar, opposer is not entitled to a right in gross. Opposer has failed to show that the respective goods and services are similar, let alone related. Meanwhile, applicant's goods move in agricultural fields, while opposer's would not. Thus, we find that applicant's use of his VIRGINFARMS mark for “agricultural grains for planting; agricultural seeds; bulbs for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use” is not likely to cause confusion with opposer's VIRGIN and VIRGIN-formative marks as used in connection with the listed goods and services in its registrations of record.

Dilution

*16 In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Trademark Dilution Revision Act of 2006 (“TDRA”) provides for a cause of action for the dilution of famous marks. 15 U.S.C. §§ 1063, 1125(c). The TDRA states that:

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

15 U.S.C. § 1125(c)(1).

Opposer contends that the marks are so similar, “dilution by blurring is inevitable.”⁴⁶ Section 43(c)(2)(B) of the TDRA states the following:

‘[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

[15 U.S.C. § 1125\(c\)\(2\)\(B\)](#).

With respect to fame, the dilution analysis requires our consideration of the following issues in determining opposer's dilution claim:

1. Whether VIRGIN is a famous mark;
2. Whether VIRGIN became famous prior to the filing date of applicant's application (March 20, 2009); and
3. Whether VIRGINFARMS and design is likely to cause dilution by blurring of the distinctiveness of VIRGIN and VIRGIN-formative marks.

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

Although we have found VIRGIN famous for purposes of opposer's likelihood of confusion claim, we must now determine whether VIRGIN is famous in the context of a dilution claim. Fame for dilution purposes is a distinct concept from fame for likelihood of confusion purposes, with dilution fame requiring a more stringent showing. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1724 (Fed. Cir. 2012). Likelihood of confusion fame “varies along a spectrum from very strong to very weak,” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003), while dilution fame is an “either-or” proposition--it either exists or it does not. 101 U.S.P.Q.2d at 1724. The bar for establishing dilution fame is set extremely high. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1170 (TTAB 2001).

*17 In *Toro*, we stated that “[f]ame for dilution purposes is difficult to prove,” as to establish the requisite level of fame, the “mark's owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark.” 61 U.S.P.Q.2d at 1180.⁴⁷ An opposer must show that, when the general public encounters the mark “in almost any context, it associates the term, at least initially, with the mark's owner.” *Id.* at 1181. Evidence to show the transformation of a term into a truly famous mark may include recognition by the other party, intense media attention, and surveys. *Id.* In short, an opposer must show that its marks have become “household terms which almost everyone is familiar.” *Id.*

Opposer's evidence fails to meet the *Toro* threshold showing of fame. First, the printed publication articles and broadcast clips do not show Virgin-branded goods and services as the subject or focus, and thus, the media evidence fails to show a widespread recognition of opposer's marks to the general population. Most of the broadcast clips reference or show the VIRGIN marks in passing or inconsequentially. For example, in a television clip of five-minutes and forty-three seconds, which aired on CBS's “The Early Show” on February 9, 2007, regarding a \$25-million prize offered by former Vice President Al Gore and Richard Branson to seek a solution to global warming, the only reference to VIRGIN is to inform viewers that Branson is the CEO and chairman of Virgin Group; there is not a single reference to Virgin-branded goods and services.⁴⁸ Similarly, in a television clip of four-minutes and twenty-two seconds, which aired on CNN's “Anderson Cooper 360°” on May 24, 2007, regarding Branson's participation on an Arctic expedition, the only reference to VIRGIN is to inform viewers that Branson is the CEO of Virgin Atlantic.⁴⁹ Most of the evidence consisting of printed publications similarly is not about a broad variety of Virgin-branded goods and services, but rather initiatives and investments in which Branson is a participant or leader. Second, opposer

did not submit survey evidence of brand recognition and awareness.⁵⁰ Third, applicant has not stated that it recognized opposer as famous.

An example of the quantum and quality of sufficient evidence to establish dilution fame is the evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 U.S.P.Q.2d 1718 (TTAB 2003). In that decision, we found that the NASDAQ mark was famous for its stock market services. The record included market studies demonstrating that the awareness of opposer's stock market among investors reached more than 80% in 1999 from just above 20% in 1990. 69 U.S.P.Q.2d at 1729. Opposer introduced evidence that its NASDAQ-branded website received seven million daily views, its daily market results appeared in hundreds of newspapers, broadcasting stations and websites, and its NASDAQ-listed companies received separate and significant media coverage as NASDAQ traded companies. *Id.* In view of the foregoing, we find that opposer has not established that VIRGIN is famous for dilution purposes.

***18** On this record, opposer cannot prevail on its dilution claim because we have found that opposer has not met its burden of proving that its VIRGIN marks are famous for purposes of dilution. Nevertheless, for purposes of completeness, we discuss whether the VIRGIN marks were capable of being famous prior to the filing date of applicant's application, and dilution by blurring and tarnishment.

B. When were opposer's marks capable of being famous based on the evidence?

In the event that this case is appealed and the reviewing court finds that based on opposer's record, the VIRGIN and VIRGIN-formative marks are famous, we find that such fame has been established prior to the filing date of the application (March 20, 2009).

Based on Mr. James' testimony regarding opposer's sales and advertising expenditures of VAA, VAI, and VMU regarding Virgin-branded goods and services, we would be able to find that opposer's mark became famous prior to the filing date of the application.

C. Whether VIRGINFARMS and design is likely to cause dilution by blurring of the distinctiveness of the VIRGIN and VIRGIN-formative marks.

The Board may look to all relevant facts in determining whether applicant's VIRGINFARMS mark will blur the distinctiveness of opposer's VIRGIN and VIRGIN-formative marks. The Trademark Act provides the following guidance:

In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

1. The degree of similarity between the mark or trade name and the famous mark.

In analysis of dilution by blurring, marks are compared under the test for similarity for likelihood of confusion purposes. *Nike Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1030 (TTAB 2011). As in the analysis provided *supra*, we find that the marks are more similar than dissimilar.

Because we find that the marks are similar, this factor favors opposer.

2. The degree of inherent or acquired distinctiveness of the famous mark.

As indicated previously, VIRGIN is a suggestive term when used in connection with agricultural planting goods, and is inherently distinctive in connection with opposer's listed goods and services. Accordingly, because VIRGIN is inherently distinctive, this dilution factor favors opposer.

3. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

*19 Opposer has introduced evidence of trademark opposition and infringement action litigation consisting of 67 non-precedential Board decisions and 62 court judgments in the United States.⁵¹ Opposer also introduced evidence of its trademark licensing in the United States.⁵² This evidence demonstrates opposer's enforcement efforts and measures to have substantially exclusive use of VIRGIN and VIRGIN-formative marks. Thus, we conclude that opposer has maintained substantially exclusive use of the VIRGIN and VIRGIN-formative mark, and therefore, this dilution factor favors opposer.

4. The degree of recognition of the famous mark.

This congressionally mandated factor seems redundant in view of the fact that opposer must establish that its mark is famous as a prerequisite for establishing a dilution claim. Nevertheless, we must consider this factor in accordance with the statute. We conclude, therefore, that the degree of recognition of the famous mark requires us to determine the level of fame acquired by the famous mark. In other words, once the mark is determined to be famous as a prerequisite for dilution protection, we must apply a sliding scale to determine the extent of that protection (*i.e.*, the more famous the mark, the more likely there will be an association between the famous mark and the defendant's mark).

As indicated above, we have found that VIRGIN is famous for purposes of likelihood of confusion, but not for purposes of dilution. Thus, VIRGIN has not acquired an extraordinary degree of recognition such that it "is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods and services" such that the mark has become part of the vernacular. *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d at 1180-81. Accordingly, we find that this dilution factor favors applicant.

5. Whether the user of the mark or trade name intended to create an association with the famous mark.

Opposer failed to present any evidence demonstrating that applicant intended to create an association with its VIRGIN and VIRGIN-formative marks. There no evidence showing that applicant tried to create an association with opposer's mark. In view thereof, this dilution factor favors applicant.

6. Any actual association between the mark or trade name and the famous mark.

Opposer failed to present any evidence demonstrating that there is any actual association between applicant's VIRGINFARMS mark and its VIRGIN and VIRGIN-formative marks. Since we have no evidence on which to conclude that potential customers

of applicant's products would make any association between the parties' marks when used on their respective products and in connection with opposer's services, this dilution factor favors applicant.

7. Balancing the factors.

The finding that opposer's VIRGIN and VIRGIN-formative marks are not famous for purposes of dilution, the fact that there is no evidence demonstrating any association between the parties' marks, and the fact that there is no evidence that applicant intended to create an association with opposer's mark outweigh the similarities of the marks and the distinctiveness and substantially exclusive use of opposer's VIRGIN and VIRGIN-formative marks. Based on the record before us, opposer has not demonstrated that the registration of applicant's VIRGINFARMS mark will dilute its VIRGIN and VIRGIN-formative marks by blurring.

D. Dilution by tarnishment.

***20** There is no evidence in this record suggesting that opposer's VIRGIN and VIRGIN-formative marks will suffer any negative association by applicant's use of his mark. In view of the foregoing, opposer has failed to prove its claim of dilution by tarnishment.

Decision: The opposition is dismissed with prejudice.

Footnotes

- 1 Opposer did not plead a family of marks.
- 2 Issued August 30, 1994; first renewal.
- 3 Issued October 7, 2003; Sections 8 and 15 affidavits accepted and acknowledged. Opposer disclaimed the exclusive right to use the word "MOBILE."
- 4 Issued January 27, 2004; Sections 8 and 15 affidavits accepted and acknowledged.
- 5 Issued December 19, 2006.
- 6 Issued July 22, 2008.
- 7 Issued December 2, 2008. Opposer disclaimed the exclusive right to use the term "AMERICA."
- 8 Notice has been posted on the Trademark Trial and Appeal Board webpage of the U.S. Patent and Trademark website, at <http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>, along with a posted chart summarizing the rule changes, http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf.
- 9 We take judicial notice that Digital Video Discs (DVDs) are CD-ROMs capable of storing significantly larger amounts of data. WEBSTER'S NEW WORLD DICTIONARY OF COMPUTER TERMS 180 (8th ed. 2000).
- 10 Based on a sampling of the submissions on these DVDs and CD-ROMs, it would appear that even if we were to have considered the materials identified in the notice of reliance as Exhibit Nos. 174 and 175, and Exhibits 6, 7, 8, 9, 10, and 13, to testimonial depositions, these submissions would not have changed the outcome of our decision.
- 11 As discussed *supra*, all submissions by opposer of printed publications on CD-ROMs and DVDs are in contravention of our rules and have not been considered as evidence.
- 12 James Dep. 13:16-13:17, Oct. 19, 2010.
- 13 James Dep. 26:20-27:10.
- 14 James Dep. 30:21-30:23.
- 15 James Dep. 13:24-13:25.
- 16 James Dep. 27:23-27:25.
- 17 James Dep. 31:7-31:10.
- 18 James Dep. 14:5-14:6.
- 19 James Dep. 28:14-28:22.
- 20 James Dep. 31:24-32:04.
- 21 James Dep. 30:2-12, 35:14-23.
- 22 James Dep. 29:8-29:23.

- 23 James Dep. 32:10-32:14.
- 24 James Dep. 21:10-21:14.
- 25 James Dep. 33:15-33:17 (Dep. Ex. 54).
- 26 Choi Dep. 25:25, 26:11, 32:16, 35:4, 35:24, 44:23, Oct. 18, 2011 (Dep. Exs. 15, 16, 20, 22-23, 31).
- 27 Choi Dep. 18:21-19:23 (Dep. Ex. 11).
- 28 Dep. Ex. 11 (*Late Show with David Letterman* (CBS television broadcast Mar. 2, 2005)).
- 29 James Dep. 38:13-38:16.
- 30 *Steve Fossett*, THE COLUMBIA ENCYCLOPEDIA (6th ed. 2008) (online edition).
- 31 Opposer's Br. 33 (citing *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 67 U.S.P.Q.2d 1420 (2d Cir. 2003)).
- 32 Opposer's Br. 34; Reply Br. 7.
- 33 *But cf. Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 60 U.S.P.Q.2d 1633, 1646 n.7 (6th Cir. 2001) (finding that the renown of Charles and Ray Eames as the designers of a chair that became an iconic piece of modern American furniture does not automatically mean that consumers understand that the chair is manufactured by plaintiff).
- 34 AM. HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1921 (4th ed. 2006).
- 35 Applicant's Br. 4-5.
- 36 DELMAR'S AGRISCIENCE DICTIONARY WITH SEARCHABLE CD-ROM 249 (2000).
- 37 Applicant's Br. 7.
- 38 Opposer's Br. 36.
- 39 Opposer's Br. 38.
- 40 In its brief, opposer defined "Virgin Group" as the collective of opposer along with its licensees and affiliates. Opposer's Br. 6.
- 41 Opposer's Br. 38.
- 42 In its brief, opposer mentions the Virgin Group's Sow-A-Seed program, and asserts that applicant "may very well sell the seeds used" in the program, which it states "turns vacant pieces of land into thriving veggie gardens." Opposer's Br. 8, 21. No evidence regarding the existence of this program in the United States is of record.
- 43 Opposer's Reply Br. 14.
- 44 Opposer's Br. 8.
- 45 "Before the doctrine of natural expansion may be invoked by opposer, it must be shown that the new goods, *i.e.*, the extension of the line of business from that which pre-existed applicant's arrival, evolved from the manufacturing and marketing activities of opposer and did not result from the acquisition of a new business by a diversifying company. The burden is on opposer to present evidence that is persuasive of the fact that the new business represents an expansion of, and not merely an unrelated addition to, the business that opposer conducted prior to the first use of applicant's mark on the goods for which applicant is seeking a registration. Without such evidence of a natural expansion, opposer would be asserting the dreaded right in gross to a mark." *Sheller-Globe Corp. v. Scott Paper Co.*, 204 U.S.P.Q. 329, 333-34 (TTAB 1979) (internal citations omitted).
- 46 Opposer's Br. 46.
- 47 Although the *Toro* opinion predates the TDRA, its analysis remains relevant.
- 48 Dep. Ex. 11 (*The Early Show* (CBS television broadcast Feb. 9, 2007)).
- 49 Dep. Ex. 11 (*Anderson Cooper 360°* (CNN television broadcast May 24, 2007)).
- 50 We are aware that opposer is not required to introduce a survey to establish that its mark is famous for purposes of our dilution analysis and we are not making a requirement.
- 51 James Dep. 10:6-12:6; Opposer's Exs. 1-111.
- 52 James Dep. 12:9-16:20 (Dep. Ex. 46A).

2012 WL 3992908 (Trademark Tr. & App. Bd.)