

This Opinion is not a
Precedent of the TTAB

Mailed: April 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pandora Jewelry, LLC

v.

Pandora's Makeup Box Inc.

Opposition No. 91196078
against Serial No. 77604365

William R. Hansen, Bridget A. Short and Suzanna M.M. Morales of Fox Rothschild LLP,
for Pandora Jewelry, LLC.

Scott W. Johnston and Sandra Lindemeier of Merchant & Gould PC,
for Pandora's Makeup Box Inc.

Before Richey, Deputy Chief Administrative Trademark Judge, and Bucher and Lykos,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pandora's Makeup Box Inc., a Canadian corporation (hereinafter "Applicant"),
seeks registration on the Principal Register of the mark **PANDORA'S** (*in standard
character format*) for

cosmetics, namely, lipsticks, eye pencils, lip pencils, eye
shadow, mascara, lip gloss, blush, pressed and loose
powder, cosmetic foundations, cover sticks and nail polish
(*Based upon Intent to Use and also on § 44(e)*) in
International Class 6;

cosmetic boxes sold containing cosmetics (*Based only upon Intent to Use*) also in International Class 6; and

retail store services, online retail store services, and mail order catalog services featuring cosmetics, cosmetic implements and cosmetic boxes” (*Based only upon Intent to Use*) in International Class 35.¹

Pandora Jewelry, LLC, a Maryland Limited Liability Company (hereinafter “Opposer”), having U.S. headquarters in Columbia, Maryland, by its amended pleading, alleges that Applicant’s mark so resembles Opposer’s previously used marks **PANDORA** and **PANDORA JEWELRY**, used on a variety of jewelry products, men’s and women’s watches and sunglasses, and as part of Opposer’s promotional programs, in connection with mirrored compacts, umbrellas, totes, jewelry boxes, key rings, luggage tags, pens, t-shirts and aprons, and in connection with retail store services, as well as the marks in the following registrations:



for “jewelry” in International Class 14;²



for “jewelry” in International Class 14;

“pamphlets, brochures, catalogs in the field of jewelry; paperboards; non-textile paper labels; paper and plastic packaging bags; advertisement poster boards of paper and cardboard” in International Class 16;³ and

¹ Application Serial No. 77604365 was filed on October 30, 2008. This application is based in part on Applicant’s Canadian Registration No. TMA610307.

² Registration No. 3065374 issued on March 7, 2006; Section 8 affidavit accepted. No claim is made to the exclusive right to use the word “Jewelry” apart from the mark as shown.

³ Registration No. 3613181 issued on April 28, 2009. The mark consists of a stylized icon used in the place of the letter “O” within the word “Pandora.”



for “jewelry” in International Class 14;

“pamphlets, brochures, catalogs in the field of jewelry; paperboards; non-textile paper labels; paper and plastic packaging bags; advertisement poster boards of paper and cardboard” in International Class 16; ⁴

that when used in connection with Applicant’s identified goods and services, it is likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

I. Preliminary Matter

Applicant asserted in its amended answer that Opposer is estopped from contending herein that the goods and services of the parties are related or that confusion is likely between the respective marks because Opposer had submitted arguments to the contrary to the Canadian Intellectual Property Office in conjunction with an application pending in Canada. As we understand what happened in the Canadian proceeding, Opposer herein (then Applicant) argued that there was no likelihood of confusion between its **PANDORA** mark for jewelry and the **PANDORA’S** mark of Applicant herein as applied to makeup. Specifically, Applicant contends that Opposer made arguments then based on the contention that makeup and jewelry were not related products.

However, “information and decisions relative to trademark disputes in foreign jurisdictions are not controlling on a determination of a party’s right to register in

⁴ Registration No. 3640357 issued on June 16, 2009. The mark consists of the word “Pandora” positioned above the words “Unforgettable Moments”; a stylized icon is used in the place of the letter “O” within the word “Pandora.”

the United States.” *Boston Chicken Inc. v. Boston Pizza Int’l, Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999).

Even without this broad prohibition, if we looked into the rationale for applying the doctrine of judicial estoppel in any given litigation in the United States, Applicant has not demonstrated that the requirements of judicial estoppel have been met. A requirement of the doctrine is that Opposer – the party taking the inconsistent position herein – must have benefited from that tactic in Canada. Inasmuch as Opposer lost in the Canadian proceeding, there is no benefit to Opposer from its alleged inconsistent position, and hence, the doctrine seems inapplicable here. As we read Ms. Kirsch’s testimony,⁵ we find no evidence of Opposer having made a factual admission of non-relatedness of the goods and services involved in this record. We know only that Opposer raised a challenge to Applicant’s Canadian registration and lost. Given the timing of this Canadian proceeding and Applicant’s U.S. filing, we find no reliance upon Opposer’s asserted prior inconsistent statements or prejudice in this case as a result of such reliance.

Moreover, any statements made by Opposer in the Canadian case are not treated as admissions that, for example, the parties’ goods herein are not related. Certainly, Opposer’s litigation posture in a trademark proceeding in another nation’s jurisdiction does not show that Opposer has in any way waived its objections to the U.S. registration now sought by Applicant. Hence, we find that Opposer’s previous statements in another proceeding have limited probative value herein. Under no circumstances, may a party’s opinion, earlier or current, relieve

⁵ See Kirsch Dep. at 108-113 and Kirsch Ex. 20, 60 TTABVue at 314-19, 527-32 of 547.

this panel of the burden of reaching our own ultimate conclusion on likelihood of confusion based upon the entire evidence in the record before us. This is a duty that cannot be delegated by adopting the prior arguments of Opposer in a foreign proceeding. See *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1281 (TTAB 2009), *aff'd* 415 Fed. Appx. 222 (Fed. Cir. 2010).

Finally, should we consider Opposer's prior contrary arguments to be relevant and competent for any purpose herein, we find they would not be dispositive of the present case. At most, we could consider these comments as facts "illuminative of shade and tone in the total picture confronting the decision maker," but nothing more than that. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978); see also *Stabilisierungsfonds fur Wein v. Zimmermann-Graeff KG*, 209 USPQ 434, 436 (TTAB 1980) (finding opposer's contrary opinions in prosecution while opposition was pending "strongly illuminate the shade and tone of the total picture").

II. The Record

Pursuant to Trademark Rule 2.122(b), the record includes Applicant's application file and the pleadings.

A. Opposer's Evidence

Opposer properly introduced the testimony deposition of Jody Christian, Opposer's Director of Marketing,⁶ Jeffrey Taylor, Opposer's Director of Accounting,⁷ and Laurie McDonald, Opposer's Director of Sales Strategy.⁸

Opposer also introduced the following evidence via a Notice of Reliance filed on February 20, 2013, consisting of certified copies of Opposer's federal registrations for its **PANDORA** mark,⁹ relevant excerpts from Applicant's responses to Opposer's interrogatories;¹⁰ TTABVue printouts from various previous opposition proceedings;¹¹ copies of samples of articles, unsolicited media references and advertisements from periodicals of general circulation and from the Internet for the period of 2008 through 2012;¹² copies of national magazines showing the scope of Opposer's promotional efforts;¹³ copies of third-party, use-based registrations covering both cosmetics and jewelry, along with copies of actual specimens of use in

⁶ This deposition was conducted on February 13, 2013 (hereinafter "Christian Dep.") along with Exhibits 1-37 ("Christian Ex."), marked "Highly Confidential." 49 TTABVue at 8-196, 197-928 of 928; 50 TTABVue at 2-19, 20-79 of 477.

⁷ This deposition was also conducted on February 13, 2013 (hereinafter "Taylor Dep.") along with Exhibits 38-40 ("Taylor Ex."), marked "Highly Confidential." 48 TTABVue at 1-92, 93-96 of 97; 50 TTABVue at 80-125, 126-69 of 477.

⁸ This deposition was conducted on February 14, 2013 (hereinafter "McDonald Dep.") along with Exhibits 41-73 ("McDonald Ex."), marked "Highly Confidential." 50 TTABVue at 170-222, 223-477 of 477.

⁹ Opposer's Ex. A, 38 TTABVue 38-52 of 52.

¹⁰ Opposer's Exs. B & C, 38 TTABVue at 3-13 of 52; 33 TTABVue; 35 TTABVue; 43 TTABVue.

¹¹ Opposer's Exs. D-F, 31 TTABVue at 3-11 of 125.

¹² Opposer's Ex. G, 31 TTABVue at 12-121 of 125.

¹³ Opposer's Ex. H, I & J, 31 TTABVue at 122-125; 36 TTABVue at 2-95 of 95; and 37 TTABVue at 3-8 of 535.

commerce;¹⁴ copies of printouts from the webpages of third-party websites demonstrating that Applicant's and Opposer's respective goods and services are of a type that may emanate from the same source;¹⁵ copies of the covers and relevant excerpts from magazines of general circulation displaying cosmetics and jewelry in the same article or advertisement on adjacent pages;¹⁶ copies of decisions of the World Intellectual Property Organization ("WIPO") Arbitration and Mediation Center in Uniform Domain Name Dispute Resolution Procedure ("UDRP") matters involving Opposer's **PANDORA** trademark;¹⁷ copies of relevant excerpts from the website of Authentic Beauty;¹⁸ and printouts of Applicant's blog.¹⁹

Opposer also relies upon the materials submitted in its Notice of Reliance in Rebuttal filed on May 27, 2014, including screen-prints of pages taken from Opposer's U.S. website; copies of mythology book excerpts discussing the fable of Pandora; and additional parts from Opposer's responses to Applicant's discovery requests based upon Opposer's statement that these additional excerpts should in fairness be considered so as to make not misleading what was offered by Applicant. *See* 37 C.F.R. § 2.120(j)(4).²⁰

¹⁴ Opposer's Ex. K, 37 TTABVue at 9-535 of 535.

¹⁵ Opposer's Ex. L, 41 TTABVue at 3-143 of 143.

¹⁶ Opposer's Ex. M, 39 TTABVue at 2-88 of 89.

¹⁷ Opposer's Ex. N, 40 TTABVue at 2-115 of 116.

¹⁸ Opposer's Ex. Q, 32 TTABVue at 22-28 of 28.

¹⁹ [pandorasmakeupboxblog](#), Opposer's Ex. R, 34 TTABVue at 3-11 of 11.

²⁰ Opposer's Exs. S-U, 64 TTABVue at 13-34 of 34.

B. Applicant's Evidence

Applicant introduced the testimony deposition of Susan Kirsch,²¹ Applicant's president, owner, and creator, and Corinne Russell Williams, of Facade Beauty (Houston, TX).²²

Applicant properly made of record evidence via a notice of reliance filed on April 11, 2014, including copies of Certificates of Registration and status reports;²³ a screen-print of Opposer's website²⁴ and an entry from the online version of *COLLINS ENGLISH DICTIONARY*;²⁵ and portions of Opposer's responses to Applicant's discovery requests.²⁶

III. The Parties

A. Applicant

Susan Kirsch founded Pandora's Makeup Box in 2000. Ms. Kirsch also owns a professional makeup studio called Kirsch Makeup Studio. In August 2000, Ms. Kirsch received a sample of the **PANDORA'S** makeup product she had developed from a packaging manufacturer called Cosmopack, followed by shipments of a couple thousand more units during the remainder of 2000. The **PANDORA'S** mark

²¹ On January 23, 2014, Applicant took the deposition of Susan Kirsch upon written questions (hereinafter "Kirsch Dep.") along with Applicant's Exhibits 1-21[b] ("Kirsch Ex."); 60 TTABVue at 208-510, 511-547 of 547.

²² This deposition was conducted on May 9, 2013 (hereinafter "Williams Dep.") along with Applicant's Exhibits 1 and 21[a]-25 ("Williams Ex."); 60 TTABVue at 28-134, 135-207 of 547.

²³ Applicant's Exs. A & B, 57 TTABVue at 12-89 of 97.

²⁴ Applicant's Ex. C, 57 TTABVue at 91 of 97.

²⁵ Applicant's Ex. D, 57 TTABVue at 93-94 of 97.

²⁶ Applicant's Exs. F & G, marked "Confidential," 58 TTABVue at 3-353 of 353.

was screen-printed on the top of the boxes. Shortly after receiving these products from Cosmopack, Ms. Kirsch sent about 100 units to Ms. Corinne Williams, of Facade Beauty in Houston, Texas, and ultimately shipped Ms. Williams a total of 500 **PANDORA'S** compacts. Ms. Williams sold these units from her makeup studio in Houston. Ms. Kirsch also allegedly sold **PANDORA'S** makeup products to other customers in the United States. Ms. Kirsch obtained a Canadian trademark registration for the **PANDORA'S** mark in 2004, listing a first use date of 2000. Ms. Kirsch began selling **PANDORA'S** makeup products to U.S. consumers at retail via an Internet website beginning in 2009.

B. Opposer

Per Enevoldsen and his wife Winnie began making jewelry in their small jeweler's shop in Copenhagen, Denmark in 1982.²⁷ From these humble beginnings, **PANDORA** has grown into a world-wide enterprise. Opposer is tied into these roots of more than thirty years through its predecessor-in-interest and affiliated companies. In 2002, one of Pandora's early Danish founders came to the United States and started marketing jewelry by showing samples from the trunk of his car. In 2003, Opposer was incorporated in the United States to market and sell **PANDORA** brand jewelry through Opposer's retail partners.²⁸

²⁷ 49 TTABVue at 424 of 928 [PJ004810];

²⁸ 49 TTABVue at 214 of 928 [PJ005109].

In short, Opposer concentrates on charm bracelets, rings, earrings and necklaces of handmade Danish design, using a proprietary threading system²⁹ that permits charms to be placed evenly within three bracelet segments in any order desired. Accordingly, Opposer's customers can easily customize their bracelets by selecting from hundreds of handcrafted sterling silver, 14K gold, and Murano glass charms. Opposer states as its mission "To offer women across the world a universe of high-quality, hand-finished, modern, genuine jewelry products at affordable prices."³⁰ In the space of a dozen years, Opposer has grown exponentially in this country, and has now built one of the most recognizable jewelry brands in the U.S. market.³¹

IV. Standing

Opposer has demonstrated that it is the owner of its pleaded registrations and that the registrations are valid and subsisting. Because opposer's registrations are of record, Opposer has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

²⁹ U.S. Pat. No. 7,007,507 issued on March 7, 2006; see "The Opportunist," "No more Pending" Pandora's Patent is Here!" 49 TTABVue at 835 of 928 [PJ011808]; see also "Pandora Bracelet Anatomy 101," *Id* at 854 [PJ011798]; *Id.* at 206, 250, 304, 352, 467 [PJ005101, PJ004966, PJ002207, PJ002456, PJ004853].

³⁰ 49 TTABVue at 204, 248 of 928 [PJ005099, PJ004964].

³¹ 49 TTABVue at 258, 262-254, 739, 744 of 928 [PJ004974, 78-80, PJ004040, 45]; 50 TTABVue at 280-85 of 477, [PJ006038-43].

V. Priority

Priority is not in issue in view of Opposer's ownership of several valid and subsisting registrations as to the marks and goods identified therein. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).³²

Opposer has also demonstrated its prior common law rights in the "Pandora" service mark used in connection with retail store services featuring jewelry and other fashion accessories. Opposer introduced **PANDORA** brand jewelry into thirty retail jewelry stores in at least twenty-four states during 2003, including the operation of "shop-in-shop" retail locations³³ within larger department stores. Opposer's first concept store opened in 2007.³⁴ All of this pre-dates Applicant's filing date, the earliest constructive use date that Applicant can claim under these circumstances.

³² Applicant claims it used its **PANDORA'S** mark in the United States in 2000, giving it priority over Opposer's 2003 date of entry into U.S. commerce. We have reviewed carefully the entire record herein, including combing through the testimony of Ms. Williams and Ms. Kirsch (60 TTABVue), studying Ms. Kirsch's sales receipts and contact information (61 and 62 TTABVue), and going over the actions taken in Ms. Kirsch's pursuit of the design, trade dress, manufacture and subsequent shipments of empty Pandora's Makeup Boxes to Ms. Williams (63 TTABVue). Even if these transactions were ones we had to consider in reaching our determination herein, the delivery of these products to Ms. Williams in 2000 looks much more like an intra-company transfer of product rather than the type of arms-length transaction that would constitute use in commerce under the Lanham Act. However, as Opposer has suggested in its reply brief, Applicant would have us fall "through the Looking Glass." Applicant has not sought to cancel, in whole or part, any of Opposer's federal trademark registrations for the mark **PANDORA**. In a proceeding such as the one at bar, the rule enunciated above in *King Candy* directs us to balance these equities by favoring Opposer's long-standing registrations against another party (even one claiming to be the prior user in the U.S.) who delays too long in electing to seek registration in the United States. *See King Candy, Inc.*, 182 USPQ at 110-11.

³³ 49 TTABVue at 226 of 928 [PJ05111-13].

³⁴ *Id.* at 222-25 of 928 [PJ05117-20].

VI. Likelihood of Confusion

The critical issue in this proceeding is likelihood of confusion. Opposer must establish by a preponderance of the evidence that there is a likelihood of confusion. We base our determination under Section 2(d) of the Lanham Act upon an analysis of all of the probative evidence of record bearing on the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We discuss all the relevant *du Pont* factors below.

A. Fame

Given the dominant role that the fame of a prior mark plays in our likelihood of confusion determination, we turn first to the fame of Opposer’s pleaded **PANDORA** mark. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Because of the wide latitude of legal protection accorded a famous mark and the dominant role fame plays in the likelihood of confusion analysis, the party asserting fame must clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *See Palm*

Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed Cir. 2005). This type of fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services marketed under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1308.

Applicant argues that Opposer has failed to show that its **PANDORA** mark is famous inasmuch as it has not submitted survey evidence demonstrating its level of fame. Applicant also points to the suggestive nature of the term **PANDORA** Opposer's allegedly competing in a crowded field of "Pandora-formative" marks, and that Opposer's claimed registrations all involved marks having some degree of stylization.

Opposer's jewelry products are sold through a nationwide network of retailers. This includes independent, third-party, multi-brand jewelry stores as well as national chains such as Jared. Retailers also include gift stores and department stores such as Nordstrom and Bloomingdale's. Since 2007, Opposer has also been offering **PANDORA** brand jewelry and merchandise exclusively through a growing chain of franchisees operating **PANDORA** concept stores. Opposer's retail presence in the United States has grown from thirty retail outlets in 2003 to almost three thousand outlets a dozen years later.

Opposer's successes are built around maintaining a consistent brand image and experience in both the multi-brand retail setting and its concept stores. Opposer

employs cooperative advertising programs with its retailers by using local print and television advertising as well as national television advertisements with partners such as Jared jewelry. Opposer has sponsored the nationally-televised **PANDORA** Unforgettable Holiday Moments on Ice to help raise brand awareness during the key holiday shopping period, and finds strategic product placement opportunities for **PANDORA** jewelry products in television programs and films.

Since 2004, Opposer has consistently promoted the **PANDORA** brand in local magazines and newspapers and through nationally-circulating print publications with traditional print advertisements as well as “advertorial” sections. Prominent advertisements have been placed regularly in national magazines such as *Glamour*, *Elle*, *Vogue*, *Marie Claire*, *Oprah*, *People*, *Shape* and *InStyle*.

Opposer has also described the myriad ways in which it promotes the **PANDORA** brand through online marketing efforts. These include targeted web advertising and Opposer’s own website. A limited number of retailers do enjoy online distribution rights and sell **PANDORA** jewelry over the Internet. Opposer launched a bimonthly digital *Pandora Magazine*, highlighting the complementary role Opposer’s jewelry can play with all the latest color trends and fashions in clothing and cosmetics. Opposer maintains the “Pandora Club” – a free-to-join Pandora jewelry enthusiast society whose members enjoy sneak peeks at upcoming lines and are notified of special promotions or events in their areas.³⁵ Opposer also utilizes social media, including Facebook, Twitter, YouTube, Pinterest, Instagram, etc., to promote the **PANDORA** brand.

³⁵ 49 TTABVue at 465, 741 of 928 [PJ004851, PJ004042].

We find that Opposer has been most successful in quickly creating an outsized place for itself within the retail jewelry industry in the United States. Taking a promising concept designed to capture symbolically life's unforgettable moments supported by fine craftsmanship, it has strategically built excellent visibility for itself through the use of advertising, editorial coverage and celebrities, while maintaining an Internet presence that matches well the quality of the product and the paradigm-changing aspirations of Opposer's founders.

Opposer has used effectively national glossy magazines directed to women. Various places in the record one finds reports on Opposer's planned media campaigns projected for each upcoming month,³⁶ followed by a review of the resulting media coverage.³⁷ Some hits include unsolicited media exposure tied to awards, industry publications, store openings, etc.³⁸ Opposer has also mastered the use of advertorials, of which there are several in the record stressing the affordability and fun of its charm bracelets. For example, the popular theme of "One Charm for Every Unforgettable Moment" was the subject of an advertorial included within an *Elle* magazine issue:

³⁶ *Id.* at 846, 857, 881, 897 of 928 [PJ011729, 81, 90, PJ011680]; 50 TTABVue at 389-99 [PJ06146-56].

³⁷ 49 TTABVue at 899-905 of 928 [PJ014359-64]; 50 TTABVue at 401-05 PJ06159-63].

³⁸ *See e.g.*, 49 TTABVue at 900-28 of 928 [PJ014360-87].



This approach is also coordinated seamlessly with widespread media appearances or endorsements by celebrities, including Oprah Winfrey, Diane Von Furstenberg, Nicole Kidman, Tyra Banks, Catherine Zeta Jones, Melissa Ethridge, Goldie Hawn, Venus Williams, Misty May-Treanor & Kerri Walsh Jennings, Martina McBride, Christiane Amanpour, Hillary Rodham Clinton, Mary Robinson, Thelma Golden, Jane Goodall, Mukhtar Mai, etc.⁴⁰ Opposer stays in the public eye with the **PANDORA** Unforgettable Holiday Moments on Ice television show, with *inter alia*, silver medalist and five-time U.S. Dance Champion, Ben Agosto.⁴¹ Similarly, Opposer partners with U.S. Olympic gymnast Aly Raisman as a spokesperson for the **PANDORA** brand.⁴²

³⁹ 49 TTABVue at 699-706 of 928. *See also* Opposer's Ex. 24, 49 TTABVue at 723-39 of 928 [PJ007601-16] for another advertorial (picturing a day in the life of a woman wearing Pandora jewelry) called "In the Moment" in another issue of *Elle* magazine.

⁴⁰ 49 TTABVue 284, 608-619, 635, 853 of 928 [PJ005001, PJ004888-99, PJ011847, PJ011797].

⁴¹ *Id.* at 64, 782 of 928 [PJ012622].

⁴² *Id.* at 64 of 928.

Opposer has managed to garner goodwill and keep itself in the limelight with its “Charmed Giving” program,⁴³ by supporting: various charitable causes, including: fighting breast cancer;⁴⁴ supporting the Mississippi Hurricane Recovery Fund for relief after Hurricane Katrina;⁴⁵ *Glamour* magazine’s annual Women Of The Year” awards;⁴⁶ Empowering Hands;⁴⁷ Habitat for Humanity;⁴⁸ Institute for One World Health;⁴⁹ Doctors without Borders; as well as cooperative efforts with retailers to support local schools charities, and other service organizations.⁵⁰

Although the actual expenditures on marketing and advertising within the United States and the actual annual sales figures in the United States are contained in confidential filings, suffice it to say that Opposer’s level of promotional activity and the resulting volume of sales in recent years are quite impressive. In the space of a dozen years, Opposer has grown in the United States from a single person hawking items of jewelry from the trunk of a car, to become one of the most recognizable jewelry brands in the U.S. market.⁵¹

⁴³ *Id.* at 281, 742, 745 of 928 [PJ004997, PJ004043, 46-47]; 50 TTABVue at 399-401 of 477 [PJ06157-59].

⁴⁴ 49 TTABVue at 238, 282, 425, 682, 745, 910 of 928 [PJ005133, PJ004998, PJ004811, PJ004072, PJ004046, PJ014270].

⁴⁵ *Id.* at 683, 844 of 928 [PJ004073 PJ011788].

⁴⁶ *Id.* at 239, 285, 684, 745, 853 of 928 [PJ005134, PJ005002, PJ004074, PJ004046, PJ011797].

⁴⁷ *Id.* at 240, 684, 745 of 928 [PJ005135, PJ004074, PJ004046].

⁴⁸ *Id.* at 240, 683, 745 of 928 [PJ005135, PJ004073, PJ004046].

⁴⁹ *Id.* at 283, 745 of 928 [PJ004999, PJ004046].

⁵⁰ *Id.* at 622, 626, 682-84, 745-46, 844 & 910 of 928 [PJ004902, 06, PJ004072-74, PJ004046-47, PJ011788 & PJ014370].

⁵¹ *Id.* at 216-18 of 928 [PJ005111-13];

Along the way, **PANDORA** jewelry was named, in 2008, as the “Hottest Brand” in the jewelry field by *InStore* magazine. The *InStore* methodology measures critical categories in which Opposer excels, such as print advertising in national consumer magazines, total unique website visitors, as well as Facebook and other social media activity among both casual and more engaged fans.⁵² Huge increases in sales volume have resulted in an equally significant growth in its base of loyal customers. With Opposer having found ever more ways in which to engage and connect with the buying public, the trade press has paid close attention to Opposer’s steady climb in rankings over the past dozen years. Over the past half-dozen years, Opposer has maximized its usage of new digital platforms with vigorous activity on all forms of social media, including Facebook,⁵³ Twitter,⁵⁴ YouTube,⁵⁵ Pinterest, etc., in order to promote the **PANDORA** brand. Certainly an incredibly high volume of unique Internet hits, Facebook likes and shares, tweets and other web postings are compelling evidence of the fame of a retailer’s mark. *See Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

In addition to raw statistics as to the order of magnitude of the sales and the advertising expenditures of the goods and services traveling under the **PANDORA** mark, Opposer has offered some context in which to evaluate the relative

⁵² *Id.* at 748 of 928 [PJ004049]. For a similar ranking conducted by *InDesign*, see also Opposer’s Ex. 34, 49 TTABVue at 816-27 of 928 [PJ00426-37]; 49 TTABVue at 905-08 [PJ014365-68].

⁵³ See Opposer’s Ex. 31, 49 TTABVue at 776-801 of 928 [PJ012616-41].

⁵⁴ See Opposer’s Ex. 32, 49 TTABVue at 802-12 of 928 [PJ012642-52].

⁵⁵ See Opposer’s Ex. 33, 49 TTABVue at 813-15 of 928 [PJ012653-55].

positioning of Opposer within the jewelry industry and the success of its promotional efforts.

Opposer's brand tracking surveys (e.g., brand funnel figures from 2007 to 2011, as well as subsequent developments) show an impressive growth in both unaided and aided awareness of the **PANDORA** jewelry brand. At the time the record closed in this case, Pandora was quite strong compared with all the national and international brands against which it benchmarks. In fact, Opposer submitted evidence that its **PANDORA** and **PANDORA JEWELRY** marks represent the number two recognized brand of jewelry in the United States (behind Tiffany) based upon an industry index of sales and overall visibility.⁵⁶ These tracking surveys appear to us to be a relevant matrix of the success of Opposer's nation-wide efforts: advertising in using print magazines, national television advertising, frequent unsolicited media hits, celebrity endorsements, online media successes, cooperative advertising with retailers, partnering with charities, the opening of a significant number of concept stores, and the like.⁵⁷

Opposer has been appropriately vigilant in protecting its **PANDORA** marks against likelihood of confusion. This includes final decisions of this tribunal (e.g., Opposition Nos. 91201787, 91199271 and 91204261)⁵⁸ as well as copies of two dozen decisions of the World Intellectual Property Organization ("WIPO") Arbitration and Mediation Center in Uniform Domain Name Dispute Resolution Procedure

⁵⁶ McDonald Dep. at 145, 50 TTABVue at 222 of 477.

⁵⁷ *Id.* at 139-40, 50 TTABVue at 216-17 of 477.

⁵⁸ Opposer's Exs. D, E and F, 31 TTABVue at 3-11 of 125; [Opp. 91201787](#), [Opp. 91199271](#) and [Opp. 91204261](#).

(“UDRP”) matters involving Opposer’s **PANDORA** trademark and service mark (with copies printed from the WIPO’s online Internet archive on February 6, 2013).⁵⁹

In sum, we find that Opposer has established that its **PANDORA** mark is, for purposes of the likelihood of confusion analysis, famous for a variety of jewelry products, including its signature charm bracelets, as well as for retail store services featuring jewelry and other fashion accessories. This factor weighs heavily in favor of a finding of likelihood of confusion.

B. The Marks

Next, we turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1692. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

In its brief, Applicant argues that Opposer has dissected its own marks, ignoring some features and finding others to be dominant. Moreover, Applicant finds it significant that its own mark is in the possessive form. By contrast, Opposer asserts

⁵⁹ Opposer’s Ex. N, 40 TTABVue at 3-114 of 116.

that despite this possessive form, Applicant's mark is virtually identical in sight, sound and meaning to Opposer's marks.

While Applicant is correct that the marks must be compared in their entireties. "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). As argued by Opposer, although its registered marks include additional wording or stylizations, the consistent and dominant portion of all of Opposer's registered marks is "Pandora." The smaller tagline, "Unforgettable Moments," the highly descriptive term "Jewelry," and the small crown design do not detract from the prominence of the word "Pandora" in all of Opposer's registrations. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012) ("In the case of a composite mark containing both words and a design, 'the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed'" (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983)); *L.C. Licensing, Inc. v. Cary Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) ("[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods."); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011) ("Further, CCB's applications disclaim 'Bank' and when a mark consists of two or more words, some of which are disclaimed, the word not disclaimed is generally regarded as the dominant or critical term."). In practice, Opposer's presentation emphasizing only

its **PANDORA** name and mark has remained consistent since its introduction into the United States in 2003.

Hence, the dominant, source-indicating portions of both parties' marks are identical: **PANDORA**. We find that Applicant's adoption of the possessive form of **PANDORA (PANDORA'S)** is not a source-identifying distinction. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004) (“[T]he dominant feature of Chatam's mark, **GASPAR** [in **JOSE GASPAR GOLD**], is also the dominant feature of the registered mark, **GASPAR'S** [in **GASPAR'S ALE**], albeit in possessive form. Thus, the Board correctly perceived that **GASPAR** and **GASPAR'S** convey a similar appearance, sound, connotation, and commercial impression.”); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (**McKenzie's vs. McKenzie**).⁶⁰

In addition, because Applicant applied to register its mark in standard character format without limitations as to any particular font style, size, or color, we therefore must consider that Applicant's mark might be used in any stylized display or color scheme, including one that is similar or identical to any lettering style used by opposer. *Citigroup Inc.* 98 USPQ2d at 1259; *Weider Publ'ns, LLC*, 109 USPQ2d at 1355.

Accordingly, we agree with Opposer that in all important respects, the marks are highly similar as to appearance, sound, connotation and overall commercial

⁶⁰ While we can only consider the mark as it appears in the application, we note that a testimony exhibit introduced through Applicant's principal shows that on its website, Applicant used the mark **PANDORA** (in the context of a named hyperlink called “SHOP PANDORA”) without the possessive form. Kirsch Dep. at 75, Kirsch Ex. 11 [PMB000320], 60 TTABVue at 5, 281 of 547.

impression, and this important *du Pont* factor weighs strongly in favor of finding a likelihood of confusion herein.

C. The similarity or dissimilarity of established, likely-to-continue trade channels

Opposer submitted for the record copies of what appear to be the Valentine's Day issue of various national women's magazines⁶¹ that would have been available on newsstands at the time Opposer was preparing its Notice of Reliance in January and February of 2013:



⁶¹ 49 TTABVue at 236, 280 of 928 [PJ05131, PJ004996];

⁶² *InStyle*, February 2013, Opposer's Ex. M, 39 TTABVue at 29, 31-33, 36-38 of 89 [PJ013214, 16-18, 21-23].



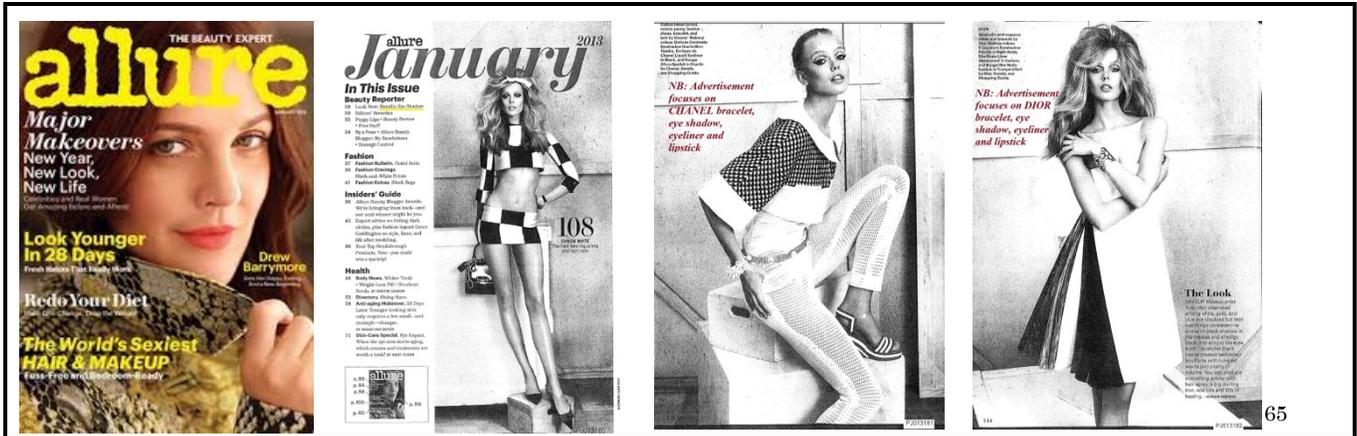
← Dress, earrings and necklace, **Gucci**. Before applying color, perfect your lip shade with **Estée Lauder** Double Wear Stay-in-Place Lip Pencil in Red. ⁶³



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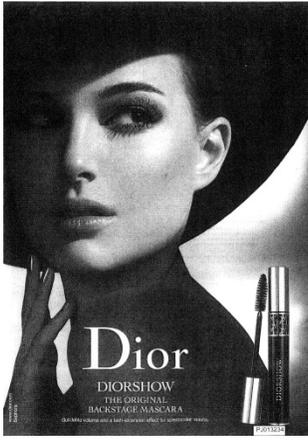
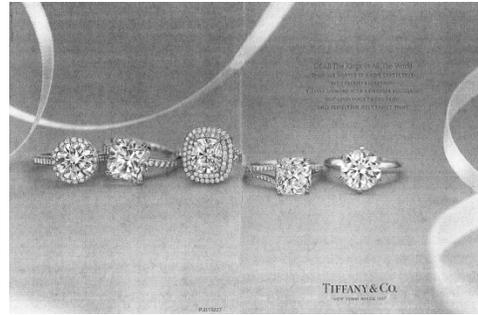
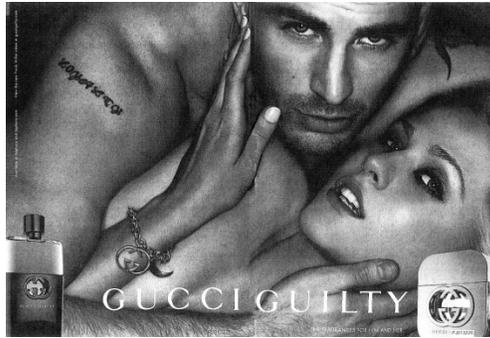
⁶³ Harper's Bazaar, February 2013, Opposer's Ex. M, 39 TTABVue at 2, 12-14 of 89 [PJ013183, PJ013193-95].

⁶⁴ Elle, February 2013, Opposer's Ex. M, 39 TTABVue at 19-27 of 89 [PJ013204-12].



⁶⁵ Allure, January 2013, Opposer's Ex. M, 39 TTABVue at 63-66 of 89 [PJ013279-82].

⁶⁶ Marie Claire, February 2013, Opposer's Ex. M, Opposer's Ex. 23; 39 TTABVue at 39, 42-43, 45, 47, 49-50, and 54 of 89, and 49 TTABVue at 707-23 of 928 [PJ013240, 43-44, 46, 48, 50-51, & 55].



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- 10** Charles David \$66
- 11** Pina by Ann Goodman \$111
- 12** Zink by Ben Frestonland \$48
- 13** Charles David \$76
- 14** A.L. Maer \$81
- 15** Charles David \$85
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- 17** Charles David \$85
- 18** Zink by Ben Frestonland \$85
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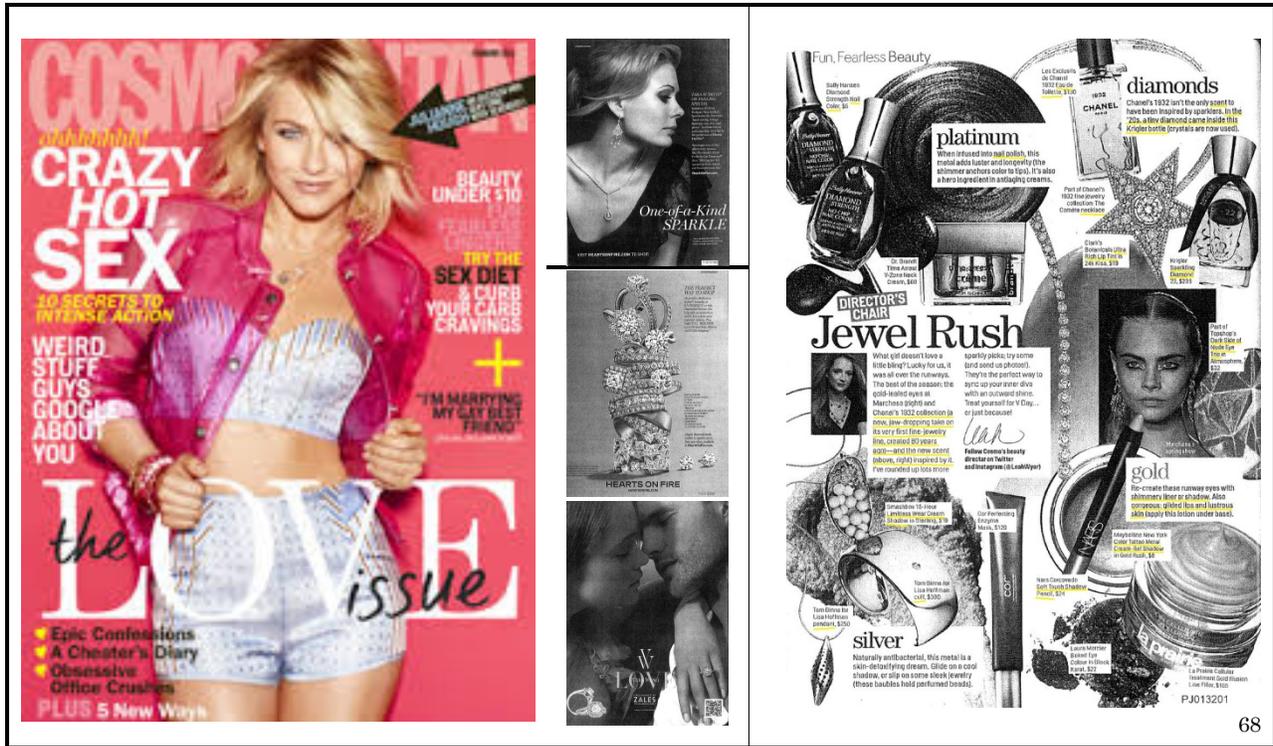
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- 25** A.L. Maer \$81
- 26** Charles David \$85
- 27** Zink by Ben Frestonland \$81
- 28** Charles David \$85
- 29** Zink by Ben Frestonland \$85
- 30** Charles David \$85

67 Lucky, February 2013, Ex. M, 39 TTABVue 73-88 of 89 [PJ013224-39].



Neither Applicant nor Registrant has placed any restrictions on their respective channels of trade. The record confirms that both are available in retail stores,

⁶⁸ *Cosmopolitan*, February 2013, Opposer's Ex. M, 39 TTABVue at 55-61 of 89 [PJ013196, PJ013199-202].

⁶⁹ *Shape*, January/February 2013, Ex. M, 39 TTABVue at 67, 71-72 of 89 [PJ013256, 60-61].

whether online or through traditional brick-and-mortar shops within department stores or in Opposer's concept stores. Hence, we find that this *du Pont* factor favors a finding of a likelihood of confusion.

D. The conditions under which and buyers to whom sales are made

The parties agree that the retail prices of Applicant's products are not expensive.⁷⁰ However, Applicant argues that the vast majority of Opposer's products are expensive, creating discerning consumers. There is certainly ample evidence in the record that Opposer's best customers have relatively high levels of disposable income,⁷¹ and many of the end-product bracelets can cost several thousand dollars.⁷² The concept behind Opposer's classic yet modern bracelet is "one charm for every unforgettable and charmed moment in your life."⁷³ It seems that many consumers have quickly embraced Opposer's concept of "affordable luxury" products. Opposer posits that its individual charms cover a wide array of price points from \$25 to over \$500 (e.g., gold with diamonds or precious stones).⁷⁴

The way the product is created, a woman buying for herself, another woman, a man buying for a woman can buy small pieces of product over time. So if you're spending \$50 on a specific occasion, it seems like a much smaller purchase but in the end a woman can end up with

⁷⁰ See Kirsch Dep. at 120-121.

⁷¹ 49 TTABVue at 234, 278 of 928 [PJ005129, PJ004994].

⁷² *Id.* at 649-63 [PJ002271-84].

⁷³ Or "Life has its Moments, Make them Unforgettable." 49 TTABVue at 53 of 928 [PJ002457].

⁷⁴ 49 TTABVue at 741 of 928 [PJ004042]; McDonald Dep. at 115, 50 TTABVue at 206 of 477.

a bracelet for several hundred dollars. She can end up with a bracelet for several thousand dollars.⁷⁵

In any case, this extensive record confirms that the “sweet spot” of the majority of Opposer’s sales is in the \$35 to \$50 range.⁷⁶ This system allows consumers to make multiple purchases – each of which is relatively small – but that then add up over time into a customized bracelet incorporating numerous individual charms chosen from among more than 800 unique pieces.⁷⁷ Since most of the involved products of both parties are relatively inexpensive, we find that they could be deemed individually to be impulse purchases.

Similarly, both Applicant and Opposer have targeted as their primary demographic women aged 18 to 55. As noted earlier, Opposer partnered with U.S. Olympic gymnast Aly Raisman as a spokesperson for the PANDORA brand. Meanwhile, Applicant has featured Ms. Raisman and her Olympic teammates in its blog.⁷⁸ This episode further demonstrates that both parties seek to promote their products through similar channels of trade to the same class of purchasers.

Accordingly, the parties are offering their goods and services to the same classes of ordinary consumers. Hence, this *du Pont* factor weighs in favor of a finding of likelihood of confusion herein, as contended by Opposer.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ McDonald Dep. at 114-115, 50 TTABVue at 205-06 of 477; 49 TTABVue at 246 of 928 [PJ04962].

⁷⁸ See [pandorasmakeupboxblog](#). Christian Dep. at 114-115; Christian Ex. 23; Opp. NOR, Ex. R at PJ012795.

E. The Goods and Services

We turn next to the *du Pont* factor that focuses on the relationship of the goods and services described in the affected application to the goods and services identified in Opposer's pleaded registrations and for which Opposer has shown prior common law usage. *Cunningham*, 55 USPQ2d at 1846; *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

It is well established that the goods and services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). It is sufficient that the respective goods and services of the parties are related in some manner, or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *Id.*, *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). The issue, of course, is not whether purchasers would confuse the goods or services, but rather whether there is a likelihood of confusion as to the source of the goods and services. *See In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *see also J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965) ("The confusion involved, of course, is not a confusion of goods but a confusion of business ...").

Applicant in briefing the case has focused primarily on the absence of any cognizable relationship between jewelry and makeup. In fact, it appears as if

Applicant would have us conclude that there is an established rule in U.S. trademark law that makeup and jewelry *cannot* be related goods. And that retail store services in the field of cosmetics are *obviously not* related to retail store services in the field of jewelry. There is no such legal tenet, and based on all of our legal precedent, the answer to this question is one of fact, not one determined by way of a *per se* rule.

Specifically, Applicant posits that jewelry is a fashion accessory totally unrelated to makeup, which is a personal care item that could be said to be closely related to other personal care items, such as face wash, lotion, and the like. Applicant cites to *American Hygienic Laboratories, Inc. v. Tiffany & Co.*, 12 USPQ2d 1979 (TTAB 1989) for the proposition that usage in connection with products such as jewelry, crystal, and china could not be relied upon to establish priority with respect to the specific cosmetic and toiletry products in its application. As in *American Hygienic*, Applicant argues that Opposer's priority in the case at bar rests solely upon registrations for jewelry and other closely related goods – all of which Applicant argues are totally unrelated to its makeup. Applicant concludes in its brief that Opposer's alleged proof of a relationship between makeup product and jewelry rests on several instances where third-party registrations cover both goods. Applicant argues that this showing is insufficient to conclude that consumers in the marketplace would regularly expect such a combination for such disparate goods.

By contrast, Opposer argues that it is common for cosmetics and jewelry to originate from the same source. In support of this position, Opposer placed into the record representative third-party registrations where the same companies – from

discount outlets to department stores to *haute couture* labels –were offering both types of goods under the same mark:



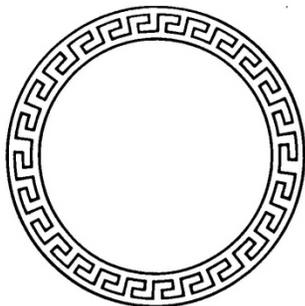
for “cosmetics and fragrances” in International Class 3;
“jewelry, jewelry made of precious metal, costume jewelry, watches, rings, necklaces, bracelets and earrings” in International Class 14;⁷⁹

CHANAV

for “colognes, perfumes and cosmetics” in International Class 3;
“real and imitation jewelry” in International Class 14;⁸⁰

**FOREIGN
EXCHANGE**

for “fragrances, eau de toilette, perfume, face and body lotions and creams, cosmetics, body and beauty care cosmetics, non-medicated skin care preparations” in International Class 3;
“jewelry, watches, clocks” in International Class 14;⁸¹



for “cosmetics, including night and day creams, cleaning preparations for the care of the face and body, bath-foam, shaving foam, aftershaves, foundation makeup, nail polish, deodorants for men and women, hand and body soaps, hair shampoos and rinses, hair spray, toothpaste, and fragrances, namely perfume, toilet water and essential oils for personal use for men and women” in International Class 3;

“articles made of precious metals and alloys of precious metals, with or without precious stones, namely rings, necklaces, bracelets, brooches, earrings, tie clips, cuff-links, diamonds, jewel cases, watches, clocks, chronometers, watch cases, costume jewelry, parts and fittings for all the aforesaid goods” in International Class 14;⁸²



for “cosmetics, including night and day creams, cleaning preparations for the care of the face and body, bath-foam, shaving foam, aftershaves, foundation makeup, nail polish, deodorants for men and women, hand and body soaps, hair shampoos and rinses,

⁷⁹ Registration No. 4168095 issued on July 3, 2012. The mark consists of a stylized stamp in the shape of a circle with the words “Henri Bendel” in a stylized font in the center and the words “New York” underneath. No claim is made to the exclusive right to use the term “New York” apart from the mark as shown.

⁸⁰ Registration No. 4006732 issued on August 2, 2011.

⁸¹ Registration No. 4216919 issued on October 2, 2012. No claim is made to the exclusive right to use the word “Foreign” apart from the mark as shown.

⁸² Registration No. 3199127 issued on January 16, 2007; Section 71 affidavit accepted & Section 15 affidavit acknowledged.

hair spray, toothpaste, and fragrances, namely perfume, toilet water and essential oils for personal use for men and women” in International Class 3;

“articles made of precious metals and alloys of precious metals, with or without precious stones, namely rings, necklaces, bracelets, brooches, earrings, tie clips, cuff-links, diamonds, jewel cases, watches, clocks, chronometers, watch cases, costume jewelry, parts and fittings for all the aforesaid goods” in International Class 14;⁸³



for “perfumery articles, namely, perfumes, essential oils for personal use, eau-de-toilette, *eaux de* cologne, cosmetics, namely, body creams, toning lotions for the body, face and hands, soap, shaving creams, foams and gels, after-shave lotions, shaving soaps, bath lotions, bath gels, bath milks, bath oils, bath beads, bath crystals, bath powders, and bath salts” in International Class 3;

“precious metals and their alloys and items made from precious metals or coated with precious metals, namely, craftwork objects in the nature of figures and figurines, smokers articles of precious metals, namely, ashtrays, cigar and cigarette cases, snuffboxes, dinnerware excluding cutlery, tie pins, cufflinks, belt buckles, pendants, key rings, jewelry, bijouterie, precious stones, timepieces, and chronometric instruments, namely, clocks, watches, pocket watches, pendulum clocks, small clocks, alarm clocks, stopwatches, dials for clock-and-watch-making, watch glasses, boxes for timepieces, chests for timepieces, caskets and cases for timepieces and jewelry, and buckles for watchstraps of precious metals” in International Class 14;⁸⁴



for “cosmetics and skin care products, namely, face cream, night face cream, lip dye, lip gloss, body lotion, face spray, room fragrance spray, perfume, cologne, skin creams and skin lotions, scented lip gloss” in International Class 3;

“jewelry, jewelry bracelets, rings, earrings, necklaces and jewelry chains, brooches, and charms” in International Class 14;⁸⁵

⁸³ Registration No. 3194501 issued on January 2, 2007; Section 71 affidavit accepted & Section 15 affidavit acknowledged.

⁸⁴ Registration No. 3112215 issued on July 4, 2006; Section 71 affidavit accepted & Section 15 affidavit acknowledged.

⁸⁵ Registration No. 3084865 issued on April 25, 2006; Section 8 affidavit accepted and Section 15 affidavit acknowledged. The mark consists of a stylized flower design.

**BROOKS
BROTHERS**

for, *inter alia*, “cosmetics and toiletries, namely, emery boards, cologne, cologne spray, after-shave lotion, after-shaving balms, shaving cream, shampoo, body lotion, body gel, fragrances for personal use, body creams, shower gels, skin cleansing cream, and skin and body lotions for personal use” in International Class 3; “watches, watchbands, clocks, key chains made of precious metal, and jewelry” in International Class 14;⁸⁶



for “shampoos; hair conditioners; body lotions; cosmetics; foundations; face powders; compacts containing makeup; facial concealers; lipsticks; lip balms; eye shadow; eye liners; mascara; blush; eye-make-up remover; skin cleansers; lotions for face and skin; creams for face, body and skin; moisturizers for face, body and skin; masks and facial and body scrubs; bath foams; bubble baths; body scrubs; exfoliant creams; perfumery; colognes; essential oils for personal use; non-medicated toiletries; shaving preparations” in International Class 3; “jewelry, imitation jewelry and jewelry of precious metal and stones, namely, necklaces, bracelets, ankle bracelets, earrings, rings, lockets, chains, watches, pocket watches, charms, cuff links, tie pins” in International Class 14;⁸⁷

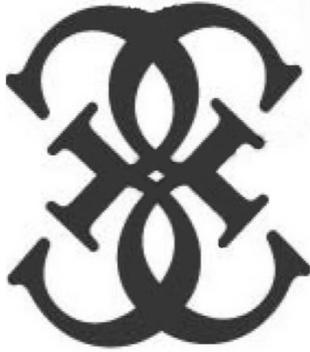


for “perfumes, toilet water, perfume water, colognes; pre-shave and aftershave lotions” in International Class 3; “Jewelry and costume jewelry; articles made of precious metals or coated therewith, namely, rings, bracelets, necklaces, earrings; clocks and watches; watch straps and watch bracelets; lapel pins, cufflinks, tie clips, tie pins, tie fasteners, namely, tie slides and tie bars; replacement parts for all the aforesaid goods” in International Class 14;⁸⁸

⁸⁶ Registration No. 3029206 issued on December 13, 2005; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁸⁷ Registration No. 3372858 issued on January 22, 2008; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁸⁸ Registration No. 3290811 issued on September 11, 2007; Section 8 affidavit accepted and Section 15 affidavit acknowledged.



for, *inter alia*, “soaps, perfumes, cosmetics, hair lotions” in International Class 3;
“jewelry and watches; bracelets, earrings, rings, necklaces, tie clips, lapel pins, cuff links, key rings, watch bands, wrist watches” in International Class 14;⁸⁹

JA

for, *inter alia*, “toilet soaps; perfumes; essential oils for personal use; cosmetics; namely, mascaras, lipsticks, foundations and eye liners; and dentifrices” in International Class 3;
“jewelry; costume jewelry; clocks and watches” in Int. Class 14;⁹⁰

DISNEY

for “non-medicated toiletries, cosmetics, dentifrices” in International Class 3;
“jewelry, watches, clocks, jewelry boxes not made of precious metals” in International Class 14;⁹¹

Bella Couture

for “bar soap; bath crystals; bath oil; bath oils; bath soaps; blush; body creams; body lotions; body powder; body scrub; bubble bath; cologne; cosmetics; eau de toilette; essential oils; essential oils for personal use; eye shadow; face powder; foundation; lip gloss; lipstick; liquid soap; make-up; mascara; perfume; perfumery; room fragrances; shower gel; skin moisturizer; toilet water” in International Class 3;
“bracelets; cufflinks; earrings; gemstones; jewelry; necklaces; pendants; pins; precious stones; rings; jewelry chains” in International Class 14;⁹²

ATSURO TAYAMA

for “soaps, namely, facial, hand and body soaps and shampoos; perfumery; cosmetics, namely, face lotion, face cream, lipstick, eyeliner and rouge, hair lotions; dentifrices” in International Class 3;
“jewelry, namely, earrings, cuff-links, belt buckles, tie pins, necklaces, pendants, bracelets and rings; precious and semi-precious stones, namely, emeralds, sapphires, corals, pearls,

⁸⁹ Registration No. 3261860 issued on July 10, 2007; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁹⁰ Registration No. 1724877 issued on October 20, 1992; second renewal.

⁹¹ Registration No. 4042815 issued on October 18, 2011.

⁹² Registration No. 3549267 issued on December 23, 2008; Section 8 affidavit accepted.

EMPORIO ARMANI

crystals, diamonds, jade and rubies; watches and clocks” in International Class 14;⁹³

for “perfumes, toilet water, personal and body deodorants, essential oils for personal use, body lotions, shower gel, bubble bath, hair shampoos, hair sprays, hair lotions, bath oils, bath pearls, skin soaps, aftershave lotions, cosmetic pencils, foundation make-up, face powders, talcum powder, rouges, lipsticks, mascaras, skin cleansing creams, skin cleansing lotions, sun screen reparation, nail polish remover, face creams, body creams, hand creams, dentifrices, dental gels, non-medicated salts for bath and shower, toilet soaps, shampoos” in International Class 3; “earrings, jewelry rings, pendants, jewelry chains, jewelry pins, diadems, medallions, cufflinks, tie clips, watches, clocks, chronometers, watch straps; jewelry and watch cases made of precious metals, trays and ashtrays of precious metals, cigarette boxes of precious metals, napkin rings of precious metals” in International Class 14;⁹⁴

STELLA MCCARTNEY

for, *inter alia*, “soaps, namely, skin soap, and body soap, perfumery, and cosmetics” in International Class 3; “jewelry” in International Class 14;⁹⁵

YANBAL

for “cologne, perfume, after shave lotion, talcum powder, bath gel and bath foam lotion, toilet soap, lipstick, lip pencil, eyeliner pencil and applicator, eye shadow, mascara, compact containing face powder, compact containing powder blush, rouge pencil, gel and cream rouge, nail enamel and nail polish remover, cuticle remover and cuticle cream, skin cleansing cream, lotion and gel, liquid facial cleanser, skin cleansing grains, liquid astringent/toning lotion, cream and lotion moisturizer, massage cream, facial masque, eye and hand cream, body lotion, facial line smoother, hair shampoo, lotion and cream hair conditioner, deodorant/anti-perspirant, mouth wash, feminine deodorant spray and foot talc” in International Class 3; “jewelry-namely, necklaces, earrings, bracelets, rings and pins” in International Class 14;⁹⁶

⁹³ Registration No. 2598214 issued on July 23, 2002; renewed.

⁹⁴ Registration No. 2296365 issued on November 30, 1999; renewed. The design element of the mark consists of a stylized eagle. The English translation of the word “Emporio” is “Store.”

⁹⁵ Registration No. 3069625 issued on March 21, 2006; Section 8 affidavit accepted.

⁹⁶ Registration No. 1241758 issued on June 14, 1983; second renewal.

See e.g., *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100 (TTAB 2007) (finding that third-party registrations have probative value to suggest that the goods are a type that emanate from a single source). See also *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). In addition to the above copies of the registrations, Opposer placed into the record images of third-party specimens of use filed with the United States Patent and Trademark Office (for example, by Henri Bendel, Versace, Société Civile, Repossi, Alex and Ani, Kimora Lee Simmons, Brooks Brothers, Stella McCartney, Atsuro Tayama, Emporio Armani, Jun Ashida, and Yanbal), showing the same registered marks used in connection with labels or trade dress of goods in both the cosmetics and jewelry fields.⁹⁷

Additionally, Opposer included screen-prints of websites from national retailers (limited to the first half of the alphabet) that offer both jewelry and cosmetics under the same brand⁹⁸ such as Aéropostale (cosmetics and charm bracelets),⁹⁹ Armani (lip stains, cosmetic cases and bracelets),¹⁰⁰ Avon (lipstick and bracelets),¹⁰¹

⁹⁷ Opposer's Ex. K, 37 TTABVue.

⁹⁸ Opposer's Ex. L, 41 TTABVue.

⁹⁹ aeropostale.com/ as captured by Opposer on January 16, 2013.

¹⁰⁰ armani.com/ as captured by Opposer on January 15, 2013, and [giorgioarmani](http://giorgioarmani.com/) as captured by Opposer on January 23, 2013.

¹⁰¹ shop.avon.com/1 and shop.avon.com/2 as captured by Opposer on January 16, 2013. 49 TTABVue 123-24 of 928. Jody Christian of Pandora, who has years of experience in the jewelry industry and has frequently attended trade shows confirmed that celebrity brands (e.g., Jessica Simpson) as well as Avon and other nationally-known gift brands offered cosmetics and personal care products along with jewelry. Christian Dep. 50 TTABVue at 115-117 of 427. For various references to the trade shows in which Opposer participates, see also 49 TTABVue at 242, 286-87, 636-48, 837-38, 855, 861-62 of 928 [PJ05137, PJ005003-

Burberry (cosmetics and jewelry),¹⁰² Chanel (makeup, cosmetics, bracelets, jewelry and watches),¹⁰³ Christian Dior (makeup, beauty, jewelry),¹⁰⁴ Dolce & Gabbana (makeup, beauty, jewelry),¹⁰⁵ Forever 21 (makeup, beauty, jewelry),¹⁰⁶ H&M (cosmetics, makeup and jewelry),¹⁰⁷ and Nordstrom (cosmetics, makeup and jewelry).¹⁰⁸

Furthermore, as seen above in our discussion of trade channels where we reproduced copies of advertisements in glossy, national women's magazines, the *Cosmopolitan* page called "Jewel Rush" (reproduced above) discusses a series of personal and beauty care items inspired by metallic themes (e.g., platinum, , gold, silver and diamonds) drawn from jewelry. In fact, it highlights the "**Chanel's 1932** collection (a new jaw-dropping take on its very first fine jewelry line, created 80 years ago) – and the new scent ... inspired by it. The *Allure* magazine above contains adjoining advertisements for **Chanel** as well as **Dior** bracelets, eye shadow, eyeliner and lipsticks.

The graphic evidence of the close relationship of cosmetics and beauty care products to jewelry seen repeatedly in the pages of these magazines is corroborated

04, PJ005407-11, PJ004903-04, PJ004219-22, PJ003628-29, PJ011811-12, PJ011799 PJ011785-86].

¹⁰² us.burberry.com/jewellery/, us.burberry.com/lips/ and us.burberry.com/skin/, as captured by Opposer on January 16, 2013.

¹⁰³ chanel.com/, as captured by Opposer on January 16, 2013.

¹⁰⁴ dior.com, as captured by Opposer on January 16, 2013.

¹⁰⁵ dolcegabbana.com/ and dolcegabbanamakeup.com/ as captured by Opposer on January 16, 2013.

¹⁰⁶ forever21.com/, as captured by Opposer on January 16, 2013.

¹⁰⁷ hm.com/, as captured by Opposer on January 16, 2013.

¹⁰⁸ nordstrom.com/, as captured by Opposer on January 16, 2013.

by the testimony of witnesses for both parties who agreed that in many large department stores (Nordstrom, Bloomingdales, and Saks Fifth Avenue etc.), the makeup counters are often located quite closely to the jewelry counters. Perfume is a natural progression for all jewelry brands.¹⁰⁹ We note that Opposer's "Pandora magazine" contains beauty tips on makeup, nails, lips, and hair styling. Moreover, Opposer's parent Pandora A/S is currently attempting to extend protection of its International Registration to the United States for the mark **PANDORA** for a variety of goods and services including "perfumery."¹¹⁰

Given the fame of Opposer's **PANDORA** Brand and the virtual identity of the parties' marks, the relatedness of the goods weighs heavily in favor of Opposer. *See In re Concordia Int'l Forwarding Com.*, 222 USPQ 355, 1983 (TTAB 1983) ("[I]t is important to note that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they

¹⁰⁹ McDonald Dep. at 107, 50 TTABVue at 199 of 477.

¹¹⁰ Opposer's Ex. P, 32 TTABVue at 3-21 of 28. Opposer is a wholly-owned subsidiary of Pandora A/S. We note that Registration No. 4333461 issued to Opposer's parent, Pandora A/S, on May 14, 2013, for the mark **PANDORA** for "sunglasses; spectacles; spectacle cases; optical articles, namely, eyeglass chains, eyeglass cords" and "goods in precious metals and alloys thereof, namely, diamonds, brilliants, precious stones, jewelry, cufflinks, tie pins, watches, clocks, watch straps, cases and boxes especially designed for clocks and jewelry; diamonds; brilliants; precious stones; ornaments in precious metals or coated therewith not included in other classes; jewelry; cufflinks and tiepins; watches; clocks; watch straps; bijouterie coated with precious metals; cases and boxes especially designed for clocks and jewelry" in International Class 14.

This '461 Reg. was the child application of Opposer's Application Serial No. 79069628 for the mark **PANDORA** for "perfumery" in International Class 3, and "advertising and promotional activities; assistance with business management and business administration; assistance with the handling of office functions; wholesale and retail store services featuring jewelry and other fashion accessories; sales promotion for others" in International Class 35. This '628 application is suspended in the Trademark Examining Operations pending the outcome of the involved Application Serial No. 77604365.

are being used in order to support a holding of likelihood of confusion.”); *Kohler Co.*, 82 USPQ2d at 1110; *Weider Publ’ns.*, 109 USPQ2d at 1355.

Opposer’s retail store services – through its concept stores in shopping malls and its shop-in-shop locations in large department stores – are at the heart of Opposer’s operations. The record shows that: there is a close relationship between makeup, cosmetics and beauty care products on the one hand and jewelry on the other; that these respective types of goods are marketed in the same magazines and merchandised through the same trade channels; that makeup counters in department stores are often located quite closely to jewelry counters, and that in the virtual world of online shopping, even these physical spatial differences disappear; and that the parties are targeting the same demographic for gifts and purchases from the same pot of discretionary income. Accordingly, we find that Applicant’s recited retail store services are related to Opposer’s retail store services featuring jewelry and other fashion accessories.

Accordingly, this *du Pont* factor also favors a finding of likelihood of confusion.

F. The variety of goods on which a mark is used

As noted above, we find that makeup is indeed related to jewelry. We have seen that other well-established brands offer both jewelry and cosmetics under the same brand. Perhaps not surprisingly, Opposer has followed the example of other leading brands in this field by enhancing its jewelry universe and then

planning to add new categories of products by embracing, *inter alia*, cosmetics and fragrances as natural expansions to its core business.¹¹¹

Over the years, Opposer has noted a broadening of the scope of its competition as well as a perceptible shift to men buying its jewelry items during the holidays¹¹²:

“We compete against flowers, chocolates, perfumes, cosmetics, books, lingerie. We’re in a much larger gifting market. Initially, when Pandora was introduced, women were buying this product for themselves. Now, we can see that the majority of purchases are driven through gifts. So its women buying for other women and men buying for women.¹¹³

As seen in Mr. McDonald’s testimony, Opposer sees itself as competing in the “gift industry.” Opposer explains that the gift industry includes a large category of products dependent upon consumers having sufficient discretionary income. For example, other personal style items often advertised and sold in close proximity to jewelry and perfume include boutique apparel, scarves and other clothing accessories, other bath and body product, and handbags.¹¹⁴

In fact, Opposer itself has already extended the use of its **PANDORA** brand to market a range of non-jewelry goods. In the past, Pandora has introduced

¹¹¹ McDonald Dep. at 105-08, 50 TTABVue at 197-200 of 477. *See also* Mission 1: Product Development, *Id.* at 292 of 477 [PJ006050].

¹¹² McDonald Dep. at 114, 50 TTABVue at 205 of 477.

¹¹³ *Id.*

¹¹⁴ See 49 TTABVue at 671, 675 of 928 [PJ004061, 65].

On the other side of this litigation, we note that Applicant itself claims to have moved into the fragrance area by marketing a perfume in combination with its nail polish product, and has allegedly sold scarves as well. Kirsch Dep. at 116, 188, 60 TTABVue at 322, 394 of 547; Opp. Ex. R , 34 TTABVue at 4-7 of 11, [PJ012789-92].

sunglasses,¹¹⁵ watches¹¹⁶ and apparel¹¹⁷ into its product mix. Related goods such as women’s accessories, cosmetics and fragrances are also natural points of expansion for a jewelry brand – not only because of their typical close proximity at common points of sale such as department stores, but also because they all compete in this larger “gift market.” Inasmuch as the majority of Opposer’s goods are purchased as gifts, such expansions simply make good business sense.¹¹⁸

As to promotional products, Opposer has also developed and offers a variety of non-jewelry items for sale to its retail partners.¹¹⁹ Opposer has distributed as promotional items mobile tags,¹²⁰ umbrellas,¹²¹ jewelry rolls¹²² and purse hangers,¹²³ jewelry cases,¹²⁴ aprons,¹²⁵ pens¹²⁶ and key rings.¹²⁷ As for one high volume promotional item of relevance to the case at bar, we note that Pandora has

¹¹⁵ 49 TTABVue at 893 of 928 [PJ011676]. McDonald Dep. at 97-98, 104-05, 50 TTABVue at 193-94, 196-87 of 477.

¹¹⁶ 49 TTABVue at 527-37, 781 of 928 [PJ012023-32, PJ012621]; McDonald Dep. at 104-05, 50 TTABVue at 196-97 or 477.

¹¹⁷ 49 TTABVue at 850, 858 of 928 [PJ011782, 94].

¹¹⁸ McDonald Dep. at 104-107, 113-15, 50 TTABVue at 196-99, 204-06 of 477.

¹¹⁹ 50 TTABVue at 415 of 477 [PJ006173]; Christian Dep. at 130-139; Christian Exs. 29-30.

¹²⁰ 50 TTABVue at 198 of 477.

¹²¹ 49 TTABVue at 774 of 928 [PJ013953], 50 TTABVue at 198 of 477.

¹²² 49 TTABVue at 757, 874 of 928 [PJ013938, PJ011722].

¹²³ *Id.* at 874 of 928 [PJ011722].

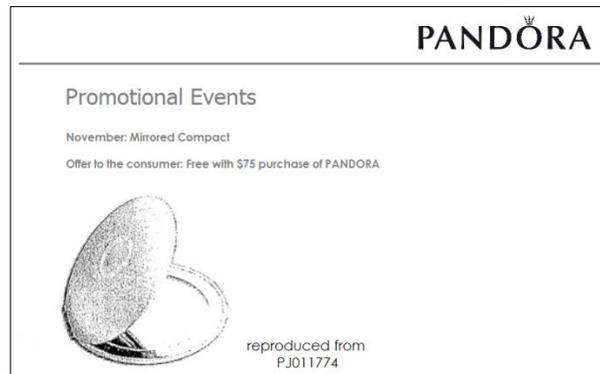
¹²⁴ *Id.* at 760 of 928 [PJ013941], McDonald Dep. at 104-05, 50 TTABVue at 196-97 of 477; 50 TTABVue at 198 of 477.

¹²⁵ 49 TTABVue at 756 of 928 [PJ013937].

¹²⁶ *Id.* at 772 of 928 [PJ013953].

¹²⁷ McDonald Dep. at 104-05, 50 TTABVue at 196-97 of 477.

distributed *hundreds of thousands of mirrored compacts* as premiums to its customers.¹²⁸



Hence, consumers in the marketplace having a relatively high awareness of Opposer's house mark on jewelry have also seen the **PANDORA** mark used in connection with a wide array of non-jewelry items, including most significantly for our purposes herein, a mirrored compact.

G. The number and nature of similar marks in use on related goods

This *du Pont* factor focuses on the usage by third-parties of similar marks in connection with related goods or services in the marketplace. Such evidence demonstrates that customers have become conditioned by a plethora of similar marks to distinguish between different marks on the basis of minute distinctions. *Palm Bay Imps*, 73 USPQ2d at 1694.

In this context, Applicant argues that “[m]any third parties use marks containing the term **PANDORA**.” Applicant argues that its copies of many of these registrations involve statements of use, as well as a search report detailing the numerous uses of the term **PANDORA** on the Internet and as registered business

¹²⁸ Opposer's Ex. 30, 49 TTABVue at 775, 866 of 928 [PJO11774]; Christian Dep. at 139, 50 TTABVue at 14 of 477.

names. As a result, Applicant argues that these sources are reflective of widespread actual use, thereby diminishing the commercial strength of Opposer's **PANDORA** mark.

By contrast, Opposer points out that most of the registrations on which Applicant relies have expired or been cancelled, and that furthermore, third-party registrations are not evidence of third-party use. We agree with Opposer that absent evidence of actual use, third-party registrations have little relevance since they are not proof that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d. 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the United States Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011); *In re Hub Distributing Inc.*, 218 USPQ 284, 286 (TTAB 1983). At best for Applicant's position of no likelihood of confusion, this is a neutral factor.

H. An absence of actual confusion

Applicant argues that contemporaneous usage of the parties' respective marks within the United States over the past decade without any evidence of actual confusion is powerful evidence that its trademark has not resulted in a likelihood of confusion.

By contrast, Opposer points out that under Section 2(d) of the Lanham Act, it is required to show a likelihood of confusion, not actual confusion. Evidence of actual confusion is notoriously difficult to prove. *Time Warner Enter. Co. v. Jones*, 65

USPQ2d 1650, 1662-63 (TTAB 2002). Accordingly, it is not necessary for Opposer, as a plaintiff in this *inter partes* proceeding, to show instances of actual confusion in order to establish likelihood of confusion. Furthermore, we agree with Opposer that the extent of Applicant's actual use in the United States is most unclear. Applicant's evidence supporting its claim of use in the United States is incomplete as to the nature, duration, manner and extent of any such use of Applicant's mark on the goods and services covered by the involved application. As Ms. Kirsch concedes, Applicant is a "small brand building a business, so our product is not so easy to find."¹²⁹ During the course of this litigation, Applicant has made no proffer as to the monetary amount it has spent to promote the sale of its goods and services in the United States. Similarly, we cannot determine the volume of Applicant's sales of its goods or services within the United States during this period, but do question whether Applicant's goods have been advertised and distributed in such numbers that the alleged absence of actual confusion is legally significant in this case. Under these circumstances, the absence of any proof of actual confusion is not surprising. At best for Applicant, this *du Pont* factor is also neutral in our final determination of likelihood of confusion.

I. The extent of potential confusion

Although Applicant continues to argue there is no showing in this record of a likelihood of confusion, in the alternative, Applicant contends that even if there were such a showing, the extent of such confusion would be minimal. By contrast,

¹²⁹ Kirsch Dep. at 68, 60 TTABVue at 274 of 547.

Opposer argues that should Applicant's mark proceed to registration, the potential harm to Opposer is great.

In this vein, Opposer paints a scenario where one of Applicant's retail stores "featuring cosmetics, cosmetic implements and cosmetic boxes," and trading as **PANDORA'S**, could be located in the same shopping mall as one of Opposer's **PANDORA** concept stores. Or both could find themselves leasing a shop-in-shop space adjacent to each other within a large department store.

As seen above, over the past dozen years, Opposer has invested a great deal of time, effort, and money in building its famous **PANDORA** brand. From the humble beginnings in 2002 of sales out of the trunk of a car, Opposer has built one of the most recognized jewelry brands in the United States.¹³⁰ Should Applicant's mark – nearly identical to Opposer's famous mark – be allowed to register for related goods and services, the potential for consumer confusion and damage to Opposer is manifest.

VII. Conclusion

We disagree with Applicant's vocal remonstrations that it represents a tiny David caught up in a battle to the death with Goliath. We have indeed seen corporate bullying, and this is not such a case. Rather, on this record, we find that in the relatively short time frame of a dozen years, Opposer has streaked upward along a remarkable trajectory. It has timely registered its marks, and played by the rules. At the time Applicant filed the involved application in the United States, Opposer's epic ascent here was well on its way.

¹³⁰ McDonald Dep. at 145, 50 TTABVue at 222 of 477.

We remind Applicant that our primary reviewing court has held repeatedly that whenever fame exists, it “plays a ‘dominant’ role in the process of balancing the *du Pont* factors.” *Recot*, 54 USPQ2d at 1897. Famous marks enjoy wide latitude of legal protection since they are more likely to be remembered and associated with a single source in the public mind than is the case with weaker marks. For this reason, a famous mark “casts a long shadow which competitors must avoid.” *Palm Bay Imps.*, 73 USPQ2d at 1694; *Recot*, 54 USPQ2d at 1897 (quoting *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)); *Loreal S.A. v. Marcon*, 102 USPQ2d 1434, 1437 (TTAB 2012) (“[E]xtreme deference [is] accorded to a famous mark in terms of the wide latitude of legal protection it receives ...”). As a corollary, well-settled law teaches that as the fame or strength of a mark increases, the closeness of the relationship between the respective goods and services necessary to support a conclusion of likelihood of confusion declines. *Bose* 63 USPQ2d at 1308-10.¹³¹

Here, Opposer has established that it has a conceptually strong and famous mark. Applicant’s mark is substantially the same as Opposer’s famous mark. The

¹³¹ Applicant is convinced that Opposer chooses to litigate cases like this one against the much smaller Applicant rather than taking on **Pandora** Internet radio, for example (see Applicant’s brief at 9), because Applicant is an easier target. In this context, we note that Opposer does not own proprietary rights to the English-language word “Pandora” *in gross*. This fits with the oft-quoted aphorism in trademark law about the distance between “bananas and bulldozers.” In keeping with that fact, Opposer may not fear a loss in revenues from its U.S. operations should Pandora Internet radio do exceedingly well, or contrariwise, fall totally out of favor with its online listeners or advertisers. By contrast, it is a different story to contemplate that the goodwill that Opposer has built in the United States around its **PANDORA** jewelry brand over the past dozen year could well be diminished or damaged by likely confusion with the registration of Applicant’s **PANDORA’S** mark covering makeup and retail services in the field of cosmetics.

parties' actual channels of trade and marketing conditions are the same, Applicant's goods and services are related to Opposer's registered goods, and finally, Opposer has demonstrated its common law usage on a variety of non-jewelry goods and on retail store services as of a date prior to Applicant's constructive date of first use. To the extent Applicant points to other *du Pont* factors such as the absence of any showing of actual confusion, this factor is, at best for Applicant's position herein, neutral. In weighing all of the *du Pont* factors, we find that should Applicant's mark proceed to registration, the potential harm to Opposer is great.

Decision: The opposition is hereby sustained, and registration of Applicant's **PANDORA'S** mark under Section 2(d) of the Lanham Act is refused.