

This Opinion Is Not a  
Precedent of the TTAB

Mailed: May 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Blue Nile, Inc.*  
*v.*  
*Brent Neale LLC*

Opposition No. 91239053

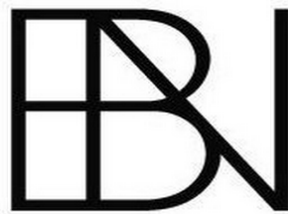
Grace Han Stanton, William C. Rava, and Kirstin E. Larson of Perkins Coie LLP  
for Blue Nile, Inc.

Randolph E. Digges, III, of Rankin, Hill & Clark LLP for Brent Neale LLC.

Before Zervas, Bergsman and Goodman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Brent Neale LLC (Applicant) seeks registration on the Principal Register of the  
mark BN (stylized), reproduced below, for “jewelry,” in International Class 14.<sup>1</sup>



<sup>1</sup> Application Serial No. 87384820 filed March 24, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and in commerce as of March 15, 2017.

The description of the mark in the application reads as follows:

The mark consists of the stylized letters ‘B’ and ‘N’ partially superimposed.

Blue Nile, Inc. (Opposer) opposed registration of Applicant’s mark on the grounds of likelihood of confusion and dilution under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c). In its Notice of Opposition, Opposer pled ownership of Registration No. 2523271 for the stylized letters “BN,” reproduced below, for “diamonds, jewelry,” in International Class 14.<sup>2</sup>



Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

#### I. 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.<sup>3</sup> The record also includes the testimony and evidence introduced by the parties listed below:

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<sup>2</sup> Registered December 25, 2001; renewed. The registration does not include a description of the mark.

<sup>3</sup> Therefore, it was unnecessary for Opposer to introduce a copy of Applicant’s application file. 18 TTABVue 336-348.

A. Opposer's testimony and evidence.

1. A notice of reliance on a copy of Opposer's pleaded registration printed from the USPTO Trademark Status and Document Retrieval (TSDR) system showing the current status of and title to the registration;<sup>4</sup>
2. A notice of reliance on copies of registrations owned by Opposer, but not pleaded in the Notice of Opposition, consisting in part of the stylized letters "BN";<sup>5</sup>
3. A notice of reliance on copies of registrations owned by Opposer, but not pleaded in the Notice of Opposition, consisting of the name "Blue Nile";<sup>6</sup>
4. A notice of reliance on copies of registrations owned by Opposer, but not pleaded in the Notice of Opposition, consisting of "ASTOR BY BLUE NILE";<sup>7</sup>
5. A notice of reliance on Applicant's responses to Opposer's first set of interrogatories;<sup>8</sup>
6. A notice of reliance on Applicant's supplemental responses to Opposer's first set of interrogatories;<sup>9</sup>
7. A notice of reliance on excerpts of Applicant's website;<sup>10</sup>
8. Testimony declaration of Jon Sainsbury, Opposer's Chief Strategy Officer and "President of International";<sup>11</sup> and
9. The rebuttal testimony declaration of Jon Sainsbury.<sup>12</sup>

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<sup>4</sup> 18 TTABVUE 14-20.

<sup>5</sup> 18 TTABVUE 34-155.

<sup>6</sup> 18 TTABVUE 158-265.

<sup>7</sup> 18 TTABVUE 268-299.

<sup>8</sup> 18 TTTABVUE 301-312.

<sup>9</sup> 18 TTABVUE 314-348. Applicant's supplemental responses to Opposer's first set of interrogatories that Applicant designated as confidential are posted on 19 TTABVUE.

<sup>10</sup> 18 TTABVUE 321-334.

<sup>11</sup> 20 TTABVUE.

<sup>12</sup> 23 TTABVUE.

B. Applicant's testimony and evidence.

1. Testimony declaration of Brent Neale Winston, Applicant's sole member;<sup>13</sup> and
2. A notice of reliance on sets of third-party registrations for similar letter combinations for jewelry products owned by different entities, including the specimens of use, purportedly to show that jewelry marks with the same letters but different stylizations are frequently used and registered by different entities.<sup>14</sup>

II. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a "real interest" in the proceeding and a "reasonable" basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposer established its standing to bring a Section 2(d) claim by properly introducing into evidence its pleaded registration showing active status and Opposer's ownership of such registration. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff's two prior registrations suffice to establish plaintiff's direct commercial interest and its

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<sup>13</sup> 21 TTABVUE.

<sup>14</sup> 22 TTABVUE.

standing); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015).

Once a plaintiff has shown standing on one ground, it has the right to assert any other ground in an opposition. *See Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its standing as to genericness ground of certification mark and was entitled to assert any other ground).

### III. Priority

Because Opposer's pleaded registration is of record, priority in the opposition proceeding is not at issue with respect to the mark and goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

### IV. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65

USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019), *quoting In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997), *quoting DuPont*, 177 USPQ at 567. “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018), *quoting In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). *See also M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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.”). *See also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for

which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”), *quoting Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

A. The similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its mark for jewelry and the description of goods in Opposer’s pleaded registration includes jewelry. Therefore, the goods are in part identical. Applicant, in its brief, concedes that the goods “are in part identical and highly related.”<sup>15</sup>

B. Established, likely-to-continue channels of trade and classes of consumers.

Because the goods described in the application and Opposer’s pleaded registration are in part identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”)); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United*

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<sup>15</sup> Applicant’s Brief, p. 17 (25 TTABVue 23).

*Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

Applicant, in its brief, “concedes where the goods are essentially the same, the channels of trade and classes of purchasers should be presumed to be the same.”<sup>16</sup> However, Applicant argues, without any evidence, that the sale of jewelry is unique because “jewelry is not sealed within packaging and displayed in that manner to consumers, who then make purchasing decisions on the basis of the mark shown on the packaging (i.e., jewelry is not akin to candy bars, cereal, and other packaged goods sold at retail).”<sup>17</sup> There are two problems with Applicant’s argument. First, “[a]ttorney argument is no substitute for evidence.” *Cai.*, 127 USPQ2d at 1799, quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). Without supporting testimony or other evidence regarding channels of trade or classes of consumers, we cannot include Applicant’s argument in our analysis.

Second, retailers do not sell all jewelry in the manner described by Applicant. Of course, high quality, high priced jewelry “is also kept away from consumers except when in the presence of a retail sales consultant (i.e., jewelry is typically locked away in a glass case, where it can be seen by consumers but not handled without a sales person present).”<sup>18</sup> However, the descriptions of goods are jewelry per se; they are not

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<sup>16</sup> Applicant’s Brief, p. 17 (25 TTABVUE 24).

<sup>17</sup> Applicant’s Brief, pp. 17-18 (25 TTABVUE 24-25).

<sup>18</sup> Applicant’s Brief, p. 18 (25 TTABVUE 25).



limited to high priced jewelry. We must compare Applicant's and Opposer's respective goods as the parties identified them in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Notwithstanding Applicant's argument (and evidence, if there were any) regarding the actual scope of the parties' commercial use of their marks, we may not limit, by resort to extrinsic evidence, the scope of goods as identified in Opposer's pleaded registration or Applicant's application. *E.g., Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

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

Applicant contends that the conditions under which and buyers to whom sales are made do not favor finding likelihood of confusion because "jewelry buyers, in general, are careful before they purchase jewelry."<sup>19</sup> Applicant's witness also testified that Applicant sells designer jewelry ranging in cost from \$1,000 to \$60,000.<sup>20</sup> As noted in the preceding section, the descriptions of goods are jewelry per se; they are not limited to high priced jewelry or designer jewelry. The jewelry includes low cost jewelry and costume jewelry that ordinary consumers may purchase on impulse. In this regard,

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<sup>19</sup> Winston Decl. ¶19 (21 TTABVUE 5).

<sup>20</sup> *Id.*

the applicable standard of care for a likelihood-of-confusion analysis is that of the least sophisticated consumer. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163 (precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”).

Therefore, this *DuPont* factor is neutral.

D. The lack of any reported instances of actual confusion.<sup>21</sup>

Applicant is unaware of any reported instances of actual confusion.<sup>22</sup> Presumably, Opposer is also unaware of any reported instances of actual confusion because if it were, it would have introduced testimony or evidence relating to actual confusion. Nevertheless, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period in the same markets as those served by Opposer under its marks. *Citigroup Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a significant opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red*

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<sup>21</sup> Our analysis of the lack of any reported instances of confusion includes *DuPont* factor 7 (the nature and extent of any confusion) and *DuPont* factor 8 (the length of time during and conditions under which there has been concurrent use without evidence of actual confusion).

<sup>22</sup> Applicant's response to Opposer's interrogatory No. 15 (18 TTABVUE 311); Winston Decl. ¶18 (21 TTABVUE 5).

*Carpet Corp. v. Johnstown Am. Enter. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Cent. Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

As noted above, we base our analysis of the second, third, and fourth *DuPont* factors, discussing the similarity or dissimilarity of the services, channels of trade, and consumer care, on the identifications of goods set forth in the application and Opposer’s pleaded registration. *See Stone Lion*, 110 USPQ2d at 1162. As such, we may not consider, in assessing these *DuPont* factors, evidence of how Applicant and Registrant are actually rendering their services in the marketplace. *Id.*

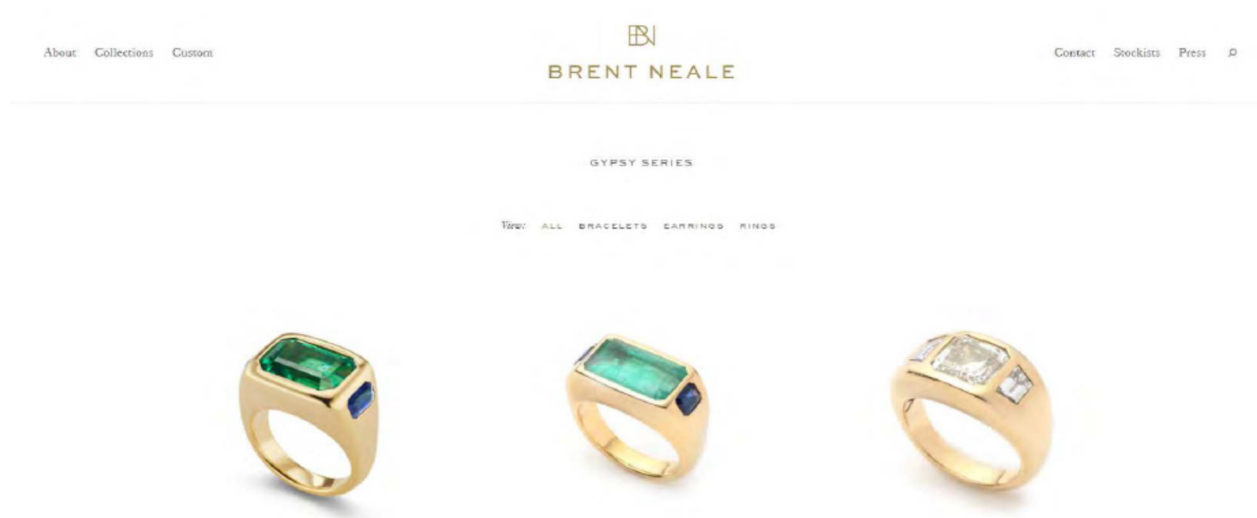
The seventh and eighth *DuPont* factors, by contrast — “[t]he nature and extent of any confusion” and “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *see du Pont*, 177 USPQ at 567 — requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mtg. Co.*, 2020 USPQ2d 10279\*6 (TTAB 2020). In this regard, we consider all of the evidence of record that may be relevant to the seventh and eighth *DuPont* factors.

Applicant first used the mark at issue at least as early as March 15, 2017.<sup>23</sup> Applicant’s mark appears on Applicant’s website (brentneale.com) that, on some days, has over 2,000 visitors and Applicant’s Instagram social media site that has

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<sup>23</sup> Winston Decl. ¶7 (21 TTABVUE 3).

over 18,000 followers.<sup>24</sup> We reproduce below a representative excerpt from Applicant's website displaying Applicant's mark:<sup>25</sup>



Applicant sells “designer jewelry” ranging in cost from a minimum of \$1,000 to as much as \$60,000.”<sup>26</sup>

Applicant identified the retailers listed below as selling its jewelry:

Applicant's jewelry can be purchased at retail stores in Alabama, California, Colorado, Florida, Illinois, Massachusetts, New York, North Carolina, Texas and Puerto Rico, and through a variety of online retailers including: Auverture ([www.auverture.com](http://www.auverture.com)); Barney's New York ([www.barneys.com](http://www.barneys.com)); ETC ([www.shopetcjewelry.com](http://www.shopetcjewelry.com)); Maisonette ([www.maisonette.com](http://www.maisonette.com)); Moda Operandi ([www.modaoperandi.com](http://www.modaoperandi.com)); Stacked x Reservoir ([www.reservoir-la.com](http://www.reservoir-la.com)); TWIST Online ([www.twistonline.com](http://www.twistonline.com)); and Threads Styling ([www.threadsstyling.com](http://www.threadsstyling.com)). None of the retail stores that sell Applicant's goods sell Opposer's goods, and none of the

<sup>24</sup> *Id.* at ¶¶11 and 16 (21 TTABVUE 4).

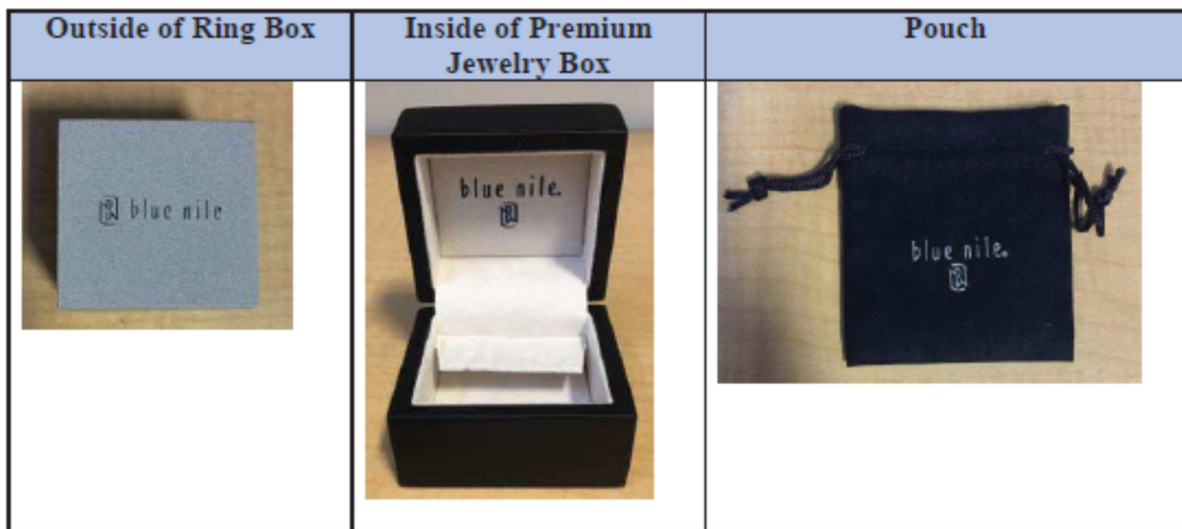
<sup>25</sup> 18 TTABVUE 325.

<sup>26</sup> Winston Decl. ¶¶12 and 19 (21 TTABVUE 4 and 5).

online retailers that sell Applicant's goods sell Opposer's goods.<sup>27</sup>

Applicant has been the subject of media attention in publications such as Vogue, W, Harper's, Elle, JCK, WWD, Wall Street Journal, The New York Times (Sunday Styles and T Magazine), and the New York Post.<sup>28</sup> Applicant did not include any examples of such media attention and Ms. Winston did not testify as to whether the authors referred to Applicant's mark.

Opposer has been using the mark in its pleaded registration since 2000.<sup>29</sup> It has sold only "high-quality" jewelry under its stylized BN mark.<sup>30</sup> "[W]hen a consumer purchases a piece of jewelry from [Opposer], it arrives in packaging bearing the BN Mark."<sup>31</sup> We reproduce representative examples of Opposer's packaging below:<sup>32</sup>



<sup>27</sup> Winston Decl. ¶14 (21 TTABVUE 4).

<sup>28</sup> *Id.* at ¶17 (21 TTABVUE 5).

<sup>29</sup> Sainsbury Decl. ¶3 (20 TTABVUE 3-4).

<sup>30</sup> *Id.* at ¶6 (20 TTABVUE 3).

<sup>31</sup> *Id.* (20 TTABVUE 3-4).

<sup>32</sup> *Id.* at ¶8 and Exhibit B (20 TTABVUE 4 and 68-74).

Opposer promotes its jewelry products through its social media accounts posted on Facebook, Twitter (18,000 followers), its YouTube channel, and Pinterest.<sup>33</sup> We reproduce below a representative excerpt from Opposer's Facebook page:<sup>34</sup>



We reproduce below a representative example of Opposer's Pinterest page:<sup>35</sup>



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<sup>33</sup> *Id.* at ¶13 (20 TTABVUE 7-8).

<sup>34</sup> *Id.* at ¶¶13 and 29 and Exhibit B (20 TTABVUE 7-8 and 14-15 and 238).

<sup>35</sup> *Id.* at ¶¶13 and 29 and Exhibit B (20 TTABVUE 7-8 and 14-15 and 248).

Opposer sells its jewelry through its website and its five retail store showrooms in the following locations: The Mall at Rockingham Park (Salem, NH), which opened in 2017; Roosevelt Field Mall (Garden City, NY), which opened in late 2015; Washington Square (Portland, OR), which opened in 2016, Tysons Corner Center (Tysons, VA), which opened in 2016; and Bellevue Square (Bellevue, WA), which opened in 2016.<sup>36</sup> In 2018, more than 200,000 consumers visited Blue Nile's various showrooms, with over 40,000 visitors to Roosevelt Field Mall, more than 60,000 visitors to Tysons Corner Center, more than 25,000 visitors to Washington Square, more than 50,000 visitors to Bellevue Square and more than 25,000 visitors to Rockingham Park.<sup>37</sup> We reproduce below a representative photograph of Opposer's storefront:<sup>38</sup>



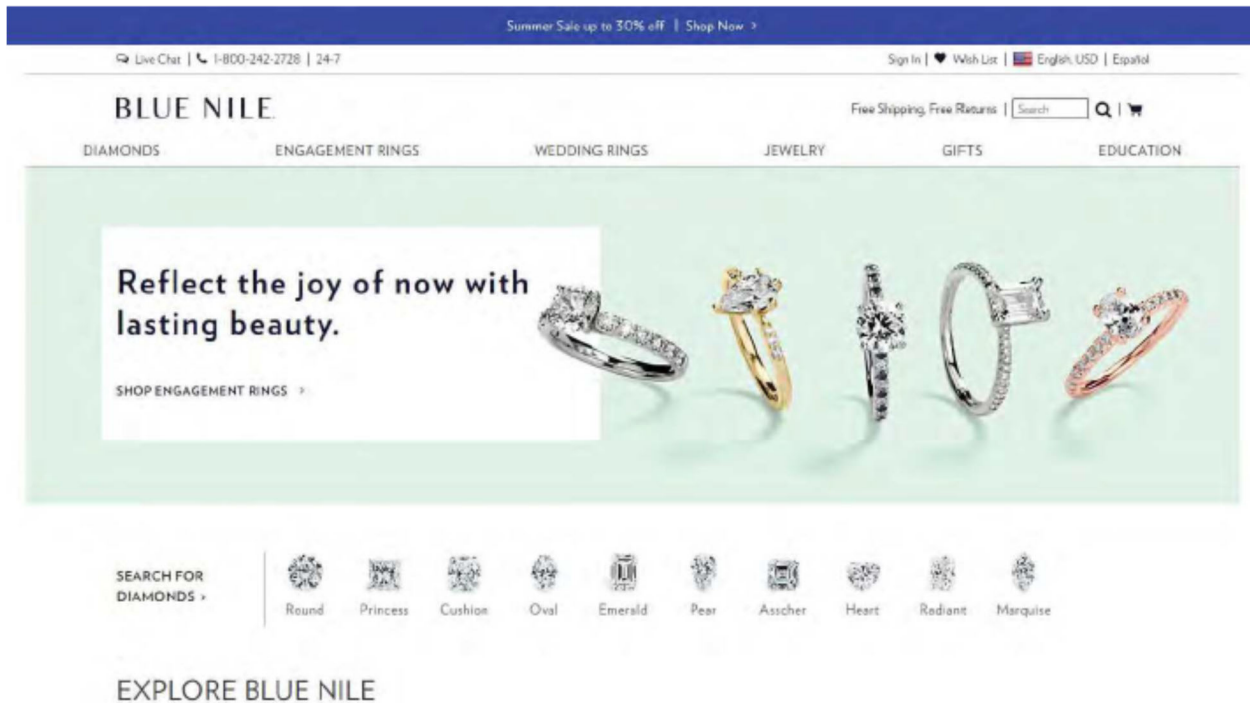
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<sup>36</sup> *Id.* at ¶22 (20 TTABVUE 11).

<sup>37</sup> *Id.* at ¶23 (20 TTABVUE 11).

<sup>38</sup> *Id.* at ¶23 and Exhibit K (20 TTABVUE 11 and 428).

More than 10 million unique visitors access Opposer's website per year.<sup>39</sup> Opposer did not provide any testimony or other evidence as to how many of those visitors are U.S. consumers. We reproduce below a representative sample of Opposer's website:<sup>40</sup>



With the exception of the displaying the marks at issue on jewelry, neither party displays the marks at issue as a standalone mark; the parties use their respective stylized BN marks in conjunction with their Blue Nile and Brent Neale trade names. Thus, when consumers are shopping for jewelry, the parties are promoting the trade names Blue Nile and Brent Neale, and, to a lesser extent rather, the stylized BN trademarks. In this regard, when consumers are shopping via social media, they encounter the parties through the trade names, not the marks at issue in the

<sup>39</sup> *Id.* at ¶24 (20 TTABVUE 12).

<sup>40</sup> *Id.* at ¶25 and Exhibit A (20 TTABVUE 12 and 19).



opposition. In addition, the parties do not advertise, market or sell their jewelry through the same retailers so that it is unlikely that consumers will encounter the marks of the parties at the same time. For these reasons, we find that there has not been a reasonable opportunity for confusion to occur and, therefore, these *DuPont* factors are neutral.

E. The strength of Opposer's mark.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. 2020) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is

the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

First, we analyze the inherent or conceptual strength of Opposer's mark on the spectrum of distinctiveness. Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 764 (2d Cir. 1976), formulated four categories of trademarks that lie along a spectrum. When arranged "in an ascending order which roughly reflects their eligibility for trademark status and the degree of protection accorded," these four categories are generic, merely descriptive, suggestive, and arbitrary or fanciful marks. *Id.* See also *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *Abercrombie* for the four categories of marks); *Chippendales*, 96 USPQ2d at 1684 (same).

The stylized letters BN are an arbitrary designation used in connection with jewelry and, therefore, they are an inherently strong mark.

We now turn to the commercial strength of Opposer's stylized letters BN. In its Notice of Opposition, Opposer alleges that the stylized letters BN "ha[ve] become famous for Opposer's Goods."<sup>41</sup> In its brief, Opposer contends that the stylized letters are famous for jewelry.<sup>42</sup> 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. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir.

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<sup>41</sup> Notice of Opposition ¶19 (1 TTABVUE 6).

<sup>42</sup> Opposer's Brief, p. 20 (24 TTABVUE 27).

2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

We may measure fame indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 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, Opposer has the duty to prove the fame of its mark clearly. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Finally, in the likelihood of confusion analysis, “fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

Opposer introduced the testimony and supporting evidence listed below to prove that its stylized BN mark is famous:

- Opposer has been using the stylized BN mark to identify its jewelry since July 2000;<sup>43</sup>

- Since 2012, Opposer has invested more than \$220 million in advertising under its trademarks, with more than \$70 million dedicated to visual media, which commonly includes the BN Mark, such as email campaigns, social media advertising, and display advertising, including print, store signage and Opposer's website;<sup>44</sup>

- Ten million unique visitors have accessed Opposer's website annually;<sup>45</sup>

- Opposer's Twitter account has 18,400 visitors;<sup>46</sup>

- More than two million customers have purchased Opposer's jewelry over the past 19 years since Opposer has been using the stylized BN mark;<sup>47</sup>

- Opposer's customers praise Opposer, with more than 90% giving Opposer a 4-star or higher rating out of 160,000 customer ratings, and in the form of feedback letters;<sup>48</sup>

- Opposer received more than 19 industry awards over the last 19 years it has been using the stylized BN mark, including garnering recognition by the following: Forbes' 100 Most Trustworthy Companies in America; Forbes' 200 Best Small

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<sup>43</sup> Sainsbury Decl. ¶7 (20 TTABVUE 4).

<sup>44</sup> *Id.* at ¶14 and Exhibits A, D, E, F, and K (20 TTABVUE 8, 19-64, 83-283, and 424-428).

<sup>45</sup> *Id.* at ¶24 (20 TTABVUE 12).

<sup>46</sup> *Id.* at ¶13 (20 TTABVUE 6-7).

<sup>47</sup> *Id.* at ¶15 (20 TTABVUE 8).

<sup>48</sup> *Id.* at ¶¶19-20 and Exhibit I (20 TTABVUE 9 and 302-417).

Companies List; Kiplinger's Best E-Tailer; and, Real Simple's Best Website for Jewelry;<sup>49</sup> and

- Opposer received media coverage for its jewelry, including by major news sources such as CNBC, Wall Street Journal, Bloomberg, Forbes, and Fox News.<sup>50</sup>

The persuasiveness of Opposer's evidence is dramatically reduced because, with the exception of the stylized BN mark appearing on the jewelry itself, every example of Opposer's use of the stylized BN mark includes Opposer's trade name, Blue Nile. *Compare Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d at 1306-07 ("the consumer is presented through the advertising and other promotional material with frequent references to the marked product standing alone and apart from the famous house mark" allowing the consumer to disassociate the product mark from the house mark). For example, Opposer's Exhibits A and D consisting of screen shots of Opposer's website do not even display Opposer's stylized BN trademark<sup>51</sup> and Opposer's Exhibit E consisting of screen shots of social media sites display the stylized letters BN in conjunction with the Blue Nile trade name.<sup>52</sup> Opposer's Exhibit F consisting of Opposer's website listing Opposer's awards and Exhibits G and H purportedly providing evidence of media coverage fail to refer to the stylized letters BN mark.<sup>53</sup>

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<sup>49</sup> *Id.* at ¶16 and Exhibit F (20 TTABVUE 8 and 280-283).

<sup>50</sup> *Id.* at ¶¶17-18 and Exhibits G and H (20 TTABVUE 7-8 and 285-300).

<sup>51</sup> 20 TTABVUE 19-64 and 83-232. Opposer introduced the screen shots displaying the stylized BN mark at 20 TTABVUE 234 and 236 in the upper right hand corner of the webpage that are so small Opposer had to superimpose arrows so it would be seen.

<sup>52</sup> 20 TTABVUE 238-278.

<sup>53</sup> 20 TTABVUE 280-300.

Even the “customer letters” posted on Opposer’s website where customers shorten Blue Nile to BN introduced to show that consumers recognize the BN trademark falls short because the vast majority of customer postings do not refer to BN.<sup>54</sup>

Viewing Opposer’s evidence as a whole and in its entirety, not only has Opposer failed to meet its burden of proving that its stylized BN mark is famous, Opposer has failed to prove that its stylized BN mark is commercially strong. Opposer has proven that it has a successful jewelry business and that it uses more than one mark. Based on the foregoing, we find that Opposer’s stylized BN mark lies in the middle of the spectrum from very strong to very weak. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Nevertheless, Opposer’s stylized BN mark is entitled to the broad scope of protection normally accorded an arbitrary mark.<sup>55</sup>

F. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity

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<sup>54</sup> Sainsbury Decl. ¶33 and Exhibit I (20 TTABVue 16 and 302-417).

<sup>55</sup> Fame for likelihood of confusion and dilution is not the same. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame “varies along a spectrum from very strong to very weak” while dilution fame is an either/or proposition — it either exists or it does not exist. *Id.* *See also Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion “[f]ame is relative . . . not absolute”). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1<sup>st</sup> 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.”). Accordingly, because Opposer failed to prove that its stylized BN trademark is famous for purposes of likelihood of confusion, Opposer falls far short of the quantum and quality of evidence required to prove that its stylized BN trademark is famous for purposes of dilution, and, therefore, we dismiss Opposer’s dilution claim.

or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“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.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721). See also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons*

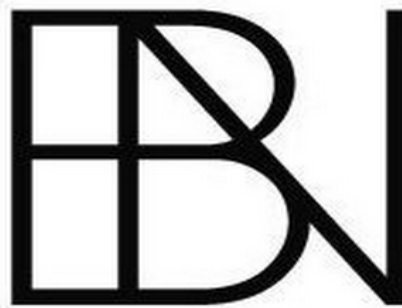
*Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are jewelry without restrictions as to channels of trade, classes of consumers, price or quality, the average customer is an ordinary consumer.

For convenience, we reproduce the marks, different stylizations of the letters BN, below:

Opposer's Mark



Applicant's Mark



The nature of stylized letter marks is that they are both visual and oral indicia, and we must weigh both in the context in which they occur. *See, e.g., Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 699 (CCPA 1980):

It must be remembered that [registrant's] trademark consists of highly stylized letters and is therefore in the



gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.

In *Georgia-Pacific*, the court observed that even if consumers could vocalize the letter portion of a design mark, the similarity of sound is not dispositive of whether there is likelihood of confusion. Because consumer view a design and do not speak it, we cannot treat a stylized letter design simply as a word mark. *In re Burndy Corp.*, 300 F.2d 938, 133 USPQ 196, 197 (CCPA 1962) (the marks, design marks based on the letter “B” have “great dissimilarities between them which can be fully appreciated only from seeing them.”). *See also In re Electrolyte Labs., Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

In *Textron Inc. v. Maquinas Agricolas “Jacto” S.A.*, 215 USPQ 162, 163-64 (TTAB 1982), the Board surveyed prior cases involving stylized letters and observed the following:

[H]ighly stylized, highly contrasting letter/design combinations tend to fall on the “no likelihood” side of the adjudicative balance and rather clear portrayals of the letters involved in the compared marks tend to result in “likelihood of confusion” findings.

In this regard, we find that the stylized letter marks at issue in this opposition are so highly stylized that they are akin to design marks and they are not similar.

Opposer contends that both marks use stylizations in which the letter “B” is prominently featured and eye-catching.<sup>56</sup> We disagree. Opposer’s mark prominently features the letter “B” but Applicant’s mark prominently features the letters “BN.”


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<sup>56</sup> Opposer’s Brief, p. 15 (24 TTABVue 22).

More importantly, however, just because one may perceive a specific letter does not remove the fact that the marks at issue are so highly stylized that consumers will distinguish between them based on their appearance. *See, e.g., In re Anderson Elec. Corp.*, 370 F.2d 593, 152 USPQ 245, 247 (CCPA 1967) (the letter “A”s are so highly stylized that the case must be decided on the basis of visual similarity); *Diamond Alkali Co. v. Dundee Cement Co.*, 343 F.2d 781, 145 USPQ 211 (CCPA 1965) (the letter “D”s are so stylized that they differ “radically” in appearance); *Burndy*, 133 USPQ at 197; *In re Rodix, Inc.*, 187 USPQ 255, 256 (TTAB 1975) (“it is not believed that persons familiar with or exposed in some manner to the registrant's distinctive “R” mark would be likely, upon encountering applicant’s likewise distinctive and different “R” mark, to equate the two or even form an association therewith.”); ; *In re Samuel M. Gertman Co., Inc.*, 180 USPQ 336 (TTAB 1973) (the stylized letter “G”s “are so distinctly different in appearance that they create separate and different commercial impressions which would obviate any reasonable likelihood of confusion or mistake as to the source of the products sold thereunder.”).

We find that the marks are not similar in appearance, connotation or commercial impression.

G. Conclusion.

Despite the facts that the goods are in part identical and we presume that the channels of trade and classes of consumers are the same, because the marks are not similar, we find that Applicant’s mark  for jewelry is not likely to cause

confusion with Opposer's registered mark  for, inter alia, jewelry. *See Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.").

**Decision:** The opposition is dismissed.