

This Opinion is Not a
Precedent of the TTAB

Mailed: June 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Barnaby Ltd.

v.

Be Goods LLC

Opposition No. 91241053
Cancellation No. 92068505
(Consolidated)

Sheila Fox Morrison and Steven E. Klein of Davis Wright Tremaine LLP,
for Barnaby Ltd.

Christopher J. Day and Janna B. Day of Day Law Firm,
for Be Goods LLC.

Before Taylor, Lykos, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Be Goods LLC (“Applicant”)¹ owns a Supplemental Register registration of the standard character mark SWEET VIBRATIONS (VIBRATIONS disclaimed) for “Sex

¹ Although these consolidated proceedings involve both an opposition and a cancellation, we will refer to Be Goods LLC as “Applicant” and Barnaby Ltd. as “Opposer” in this opinion because that is the nomenclature used by the parties in their briefs.

toys; Adult sexual stimulation aids, namely, vibrators,” in International Class 10,² and seeks registration on the Principal Register of the standard character mark SWEET VIBRATIONS (VIBRATIONS disclaimed) for “Adult marital and sexual aids, namely, massagers, vibrators and stimulators,” in International Class 10.³

Barnaby Ltd. (“Opposer”) petitions to cancel Applicant’s registration and opposes Applicant’s application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s SWEET VIBRATIONS mark so resembles Opposer’s registered standard character mark GOOD VIBRATIONS for “adult sexual aids, namely, artificial phalli,” in International Class 10,⁴ and “retail and mail order services, featuring, sexually oriented products such as marital aids, electronic devices media and books,” in International Class 42,⁵ as to be likely, when used on or in connection with the goods identified in Applicant’s registration and application, to cause confusion, to cause mistake, or to deceive.

The Board consolidated the cancellation and opposition proceedings, designating Opposition No. 91241053 as the “parent” case. 7 TTABVue 2 (Opposition No. 91241053 and Cancellation No. 92068505).⁶ The case is fully briefed. We dismiss the opposition and deny the petition for cancellation.

² Registration No. 5319043 issued on October 24, 2017.

³ Application Serial No. 87664722 was filed on October 30, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on claimed first use of the mark and first use of the mark in commerce at least as early as May 20, 2017.

⁴ Registration No. 3631427 issued on June 2, 2009 and has been renewed. The renewed registration covers other goods that are not at issue in these proceedings.

⁵ Registration No. 2040239 issued on February 25, 1997 and has been renewed.

⁶ Citations in this opinion to the briefs, record, and other materials in these consolidated proceedings refer to TTABVue, the Board’s online docketing system. *Turdin v. Tribolite*,

I. Record

The record includes the pleadings,⁷ the file histories of Applicant's registration and application, by virtue of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1),⁸ Opposer's pleaded Registration No. 2040239 for the standard character mark GOOD VIBRATIONS for "retail and mail order services, featuring, sexually oriented products such as marital aids, electronic devices media and books," and Registration No. 3631427 for the standard character mark GOOD VIBRATIONS for, inter alia, "adult sexual aids, namely, artificial phalli," by virtue of Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), and the following materials submitted by the parties during trial:

Opposer:

- The testimony declaration of Clint Dennis, Opposer's Senior Director of Marketing ("Dennis Decl."), and Exhibits 1-7 thereto, 13-14 TTABVUE;⁹

Ltd., 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. Unless otherwise indicated, citations are to the TTABVUE docket in the parent case.

⁷ Applicant denied the material allegations in Opposer's Notice of Opposition and Petition for Cancellation, and did not assert any affirmative defenses.

⁸ Citations in this opinion to the file histories of the registration and application are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁹ Mr. Dennis's declaration was submitted in redacted and unredacted versions because Opposer designated certain information in the declaration as "Confidential Attorneys' Eyes Only" under the Board's Standard Protective Order. The unredacted version appears at 12 TTABVUE, while the redacted (public) version appears at 13 TTABVUE. We will cite Mr. Dennis's declaration by paragraph and exhibit number (i.e., "Dennis Decl. ¶ 8; Ex. 1").

- Opposer’s First Notice of Reliance and Exhibits 8-57 thereto, consisting of dictionary definitions, thesaurus and Wikipedia entries, and third-party registrations, 14 TTABVUE;
- Opposer’s Second Notice of Reliance and Exhibits 58-63 thereto, consisting of pages from Applicant’s website and Applicant’s responses to certain of Opposer’s discovery requests, 15-16 TTABVUE;¹⁰
- Opposer’s Third Notice of Reliance and Exhibits 64-117 thereto, consisting of media articles, book excerpts, and a Wikipedia entry about Opposer and its products and services, and the involved goods and services, 17 TTABVUE; and
- Opposer’s Fourth Notice of Reliance and Exhibit 118 thereto, consisting of documents regarding the renewal of Opposer’s pleaded Registration No. 3631427, 19 TTABVUE.

Applicant:

- Applicant’s Notice of Reliance and Exhibits 1-9 thereto, consisting of dictionary definitions, and pages from reference works regarding The Beach Boys’ song *Good Vibrations*, 18 TTABVUE.

II. Evidentiary Issues

Applicant asserts two evidentiary objections. First, Applicant argues that

¹⁰ Opposer’s Second Notice of Reliance was submitted in redacted and unredacted versions because Applicant designated certain discovery responses as “Confidential Attorneys’ Eyes Only” under the Board’s Standard Protective Order. The unredacted version appears at 15 TTABVUE, while the redacted (public) version appears at 16 TTABVUE.

Opposer's evidence includes a number of unauthenticated internet publications and similar articles which Opposer cites in an effort to establish the fame of Opposer's mark. To the extent Opposer has offered internet materials and other exhibits for the purpose of proving the *truth* of any matter stated therein, Applicant objects to these materials as inadmissible hearsay.

22 TTABVUE 6.

Second, Applicant objects to Mr. Dennis's testimony on the ground that he "states that he has been employed by Opposer only since April, 2018" and that "[w]ith respect to any facts or events relating to the time period before his hire date, Mr. Dennis could not have 'first-hand knowledge.'" *Id.* Applicant further objects that the statements in his declaration that he either has "first-hand knowledge of the facts set forth in this declaration, or I have derived the information from records maintained by Good Vibrations in the ordinary course of business," Dennis Decl. ¶ 1, "constitute inadmissible hearsay." *Id.* Applicant argues that "[s]pecifically, with respect to Opposer's sales and advertising figures, Mr. Dennis does not provide any foundation to suggest this information is derived from records maintained by Opposer in the ordinary course of business." *Id.* Applicant "objects to consideration of Opposer's sales and advertising figures on the grounds of hearsay and lack of proper foundation." *Id.* at 6-7 (citing Fed. R. Evid. 401, 803(6)).

Opposer responds to Applicant's objections in Opposer's reply brief. Opposer argues that its Internet materials and articles are self-authenticating and were properly made of record under notice of reliance, 23 TTABVUE 17, and that Applicant's hearsay objection is not well taken because the materials "are not introduced to prove the 'truth of the statements contained therein,' but to show . . .

public exposure and recognition” of Opposer’s mark, and are not hearsay when used for that purpose. *Id.*

With respect to Applicant’s objections to the Dennis declaration, Opposer argues that “Applicant’s objection is without basis [because] Mr. Dennis is Opposer’s Senior Director of Marketing” and his declaration states that “I either have first-hand knowledge of the facts set forth in this declaration, or I have derived the information from records maintained by Good Vibrations in the ordinary course of business.” *Id.* Opposer contends that Mr. Dennis’s testimony established that he has personal knowledge of the matters to which he testified on the basis of his broad job responsibilities as Senior Director of Marketing, and the need to be thoroughly familiar with this history of Opposer and its GOOD VIBRATIONS mark. *Id.* at 17-18.

Opposer also argues that “Applicant has waived its objection by failing to raise it earlier because it ‘might have been obviated or removed if presented at that time.’” *Id.* at 18 (quoting TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 707.03(c) (June 2019)). Opposer argues that “had Applicant timely raised its objection at the time Mr. Dennis’s declaration was filed, Opposer could have sought to further supplement Mr. Dennis testimony with additional foundational facts to the extent they were necessary.” *Id.*

We overrule Applicant’s objections to Opposer’s Internet and article evidence. Although Applicant claims that “Opposer’s evidence includes a number of unauthenticated internet publications,” 22 TTABVUE 6, Applicant does not identify

any Internet evidence that does not meet the requirements for self-authentication set forth in *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031 (TTAB 2010). Applicant's purported hearsay objection is superfluous because the Board has long held that Internet materials and articles "are admissible only to show what has been printed, not the truth of what has been printed." *Id.* at 1040.

We also overrule Applicant's objections to Mr. Dennis's declaration. The Board recently addressed objections similar to those asserted by Applicant here in *Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 (TTAB 2020).¹¹ In *Moke*, the applicant objected in its brief to a testimony declaration filed by the opposer on two grounds: (1) the declarant failed to lay a proper foundation for the admission of sales records attached to his declaration under the business records exception to the rule against hearsay, and (2) the declarant's testimony about the history of the prior use of Opposer's mark by its predecessor-in-interest was hearsay. The applicant had exercised its right under Trademark Rule 2.123(c), 37 C.F.R. § 2.123(c), to cross-examine the declarant, but had not raised the objections during the declarant's examination. *Id.* at *6.

In ruling on the objections, the Board held that "[a]s a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived," *id.* at *4 (quoting *Nahshin v. Prod. Source Int'l, LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013)), while "[o]bjections to . . . testimony, on substantive grounds, such as that the

¹¹ The *Moke* decision issued after briefing in this case was complete, but we must apply the law in effect at the time of our decision. We find the *Moke* panel's analysis to be instructive in our disposition of Applicant's objections here.

proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly.” *Id.* (quoting TBMP Section 707.04). The Board found that the applicant had waived its objection that the declarant had failed to lay a foundation for the admission of the business records attached to his declarant by “fail[ing] to assert its objection promptly after Opposer introduced the . . . declaration into evidence.” *Id.* at 6. The Board overruled the applicant’s objection to the declarant’s “generalized testimony that he had been aware of Mini Mania’s MOKE branded products for years before asking to purchase a ‘moke-style’ vehicle in 2016” because it was “not hearsay because he is testifying about his personal knowledge,” but sustained the applicant’s hearsay objection to the portion of the declarant’s testimony “based . . . on what his lawyers told him.” *Id.*

Applicant’s objection here that “with respect to Opposer’s sales and advertising figures, Mr. Dennis does not provide any foundation to suggest this information is derived from records maintained by Opposer in the ordinary course of business,” 22 TTABVUE 6, is similar in nature to the objection to the introduction of such records via declaration in *Moke*. As in *Moke*, we find that Applicant’s objection here is procedural and has been waived because Applicant did not promptly object to the lack

of foundation following receipt of Mr. Dennis's declaration.¹² *See Moke*, 2020 USPQ2d 10400, at *4-7.

The Board's decision on the merits of the objections to the declarant's testimony regarding prior use in *Moke* suggests that hearsay objections to testimony generally are substantive, not procedural, and are thus not waived if asserted for the first time in a party's brief rather than during any remaining time in the applicable trial period or within the time to request cross-examination of a declarant. *But see City Nat'l Bank v. OPGI Mgmt. GP Inc.*, 106 USPQ2d 1668, 1672-73 (TTAB 2013) (with respect to petitioner's objections to respondent's witness's testimony regarding any events occurring prior to his employment with respondent beginning in May 2008, petitioner "timely raised objections as to 'lack of foundation' when [the witness] testified to matters involving respondent prior to May 2008" by objecting throughout the witness's trial deposition). We need not decide that issue, however, because we find that Mr. Dennis sufficiently established his competence to testify to pre-employment matters based on his acquired personal knowledge of those matters.

As noted above, Applicant argues that Mr. Dennis could not have "first-hand knowledge" "[w]ith respect to any facts or events relating to the time period before his hire date," 22 TTABVue 6, but "first-hand knowledge," by which Applicant seems to mean knowledge derived from direct personal observation of "facts or events relating to the time period before his hire date," is not required under the Federal

¹² Mr. Dennis was the only witness that Opposer offered at trial, but we need not address whether Opposer could have cured the alleged deficiencies in his testimony "because Applicant failed to raise its procedural defect promptly." *Moke*, 2020 USPQ2d 10400, at *7.

Rules of Evidence. If it were, it would be increasingly difficult to establish facts regarding the historical use of a mark the longer the period of use, because it would be increasingly unlikely that there would be a witness who personally observed the use of the mark decades ago. Personal knowledge is what Rule 602 of the Federal Rules of Evidence requires, and it is clear that personal knowledge can be acquired by a review of files and record in the course of a witness's employment and the discharge of his or her job duties.

As the Board observed in *City Nat'l Bank*,

there may be some difficulty for a company involved in a trademark dispute to produce witnesses with personal knowledge of the company's use of its trademarks, especially if such use dates back many years. In certain cases, testimony by a person that his job responsibilities require him to be familiar with the activities of the company that occurred prior to his employment may be sufficient to lay a foundation for his subsequent testimony.

City Nat'l Bank, 106 USPQ2d at 1673. We find that this is such a case.

Rule 602 of the Federal Rules of Evidence provides that "[e]vidence to prove personal knowledge may consists of the witness's own testimony." Fed. R. Evid. 602. Mr. Dennis testified without contradiction that he either has "first-hand knowledge of the facts set forth in this declaration," or has "derived the information from records maintained by [Opposer] in the ordinary course of business," Dennis Decl. ¶ 1; that as Senior Director of Marketing, he is "responsible for all aspects of [Opposer's] marketing and branding, including but not limited to sales, marketing, and distribution of the products to be sold by [Opposer] under its GOOD VIBRATIONS mark;" and that as part of his responsibilities as Senior Director of Marketing, he is

“required to be thoroughly familiar with and [has] developed extensive knowledge about, the history of [Opposer] and its GOOD VIBRATIONS mark.” Dennis Decl. ¶ 2. We find that Mr. Dennis’s testimony regarding his job duties and responsibilities is sufficient to establish his personal knowledge regarding events prior to his employment with Opposer. *Cf. City Nat’l Bank*, 106 USPQ2d at 1673 (finding that respondent had not shown that its witness’s position as in-house counsel “required him to have knowledge, let alone knowledge of the particular details, of the matters for which he was testifying and which predated his employment,” and that respondent did not show how certain of his testimony “regarding the content and appearance of respondent’s intranet site for the years preceding 2008” was the “type of information [that] would necessarily be obtained through the normal course of his employment as in-house counsel.”). We will consider Mr. Dennis’s declaration for whatever probative value it may have on the issue of likelihood of confusion.

III. The Parties

Opposer and Applicant are competitors in what Opposer calls the “sexually oriented products” business, which involves the sale of adult toys and sexual aids such as vibrators, pulsators, dildos, and similar products. Dennis Decl. ¶¶ 3, 5; 16 TTABVUE 4-8 (Applicant’s website), 18-19 (Applicant’s Responses to Opposer’s Requests to Admit Nos. 20-22, 24-27), 33-36 (Applicant’s Responses to Opposer’s Interrogatory Nos. 1, 3, 9-10, 15). Opposer has been in that business under the GOOD VIBRATIONS mark since 1977. Dennis Decl. ¶¶ 6-7. Applicant appears to have been

in the same business under the SWEET VIBRATIONS mark since 2017. 16 TTABVUE 34 (Applicant's Response to Opposer's Interrogatory No. 9).

IV. Standing

A threshold issue in every inter partes case is the plaintiff's standing to challenge registration. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.2d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). "To have standing, a plaintiff must have a real interest, i.e., a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged" by registration or continued registration of the involved mark. *TiVo Brands, LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1102-03 (TTAB 2018) (citing *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999)).

Opposer asserts its standing to oppose Applicant's application and to seek cancellation of Applicant's registration based on Opposer's prior use and registration of the GOOD VIBRATIONS mark. 21 TTABVUE 27.¹³ Opposer properly made of record its registrations of its GOOD VIBRATIONS mark pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), by attaching to its Notice of Opposition and Petition for Cancellation copies of information regarding the registrations from the USPTO's electronic databases showing the current status and Opposer's ownership of the registrations. 1 TTABVUE 7-12 (Opposition No. 91241053); 1 TTABVUE 9-14 (Cancellation No. 92068505). The registrations give Opposer a real interest in both proceedings and a reasonable belief that it will be damaged by registration or

¹³ Applicant does not dispute Opposer's standing.

continued registration of Applicant's mark. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). We find that Opposer has standing in both proceedings.

V. Analysis of Likelihood of Confusion Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its § 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its mark and that Applicant's use of its mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of the goods identified in its registration and application. *Cunningham*, 55 USPQ2d at 1848.

A. Priority

In the opposition proceeding, because Opposer's pleaded registrations are of record, and Applicant did not counterclaim to cancel them, priority is not in issue with respect to the goods and services identified in the registrations. *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)).

In the cancellation proceeding, however, “where both parties own registrations, priority is in issue.” *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at

*4 (TTAB 2019) (quoting *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1474 (TTAB 2014)). To prove priority, Opposer cannot rely solely on the fact that its registrations are of record, but it must prove proprietary rights in its GOOD VIBRATIONS mark prior to Applicant's proven date of first use.

Although Opposer may rely on the filing dates of the applications that matured into its registrations as its dates of constructive use of the mark, *see, e.g., Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1141 (TTAB 2013), because Applicant's registration is on the Supplemental Register, Applicant cannot rely on the filing date of the application that matured into its registration to establish a constructive use priority date. Section 26 of the Trademark Act, 15 U.S.C. § 1094, provides that "registrations on the supplemental register shall not be subject to or receive the advantages of section[] . . . 1057(c)," which provides that

[c]ontingent on the registration of a mark on the principal register . . . the filing of an application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect . . . against any other person except for a person whose mark has not been abandoned and who, prior to such filing—(1) has used the mark; (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

15 U.S.C. § 1057(c).

In response to Opposer's interrogatories, Applicant stated that its first use of its SWEET VIBRATIONS mark for "sex toys" or "vibrators," the goods identified in its Supplemental Register registration, was May 20, 2017. 16 TTABVUE 34 (Applicant's

Response to Opposer's Interrogatory No. 9). Opposer's constructive use dates for its Registration Nos. 3631427 and 2040239 are April 6, 2006 and January 31, 1996, respectively, which are long before the stated May 20, 2017 first use date. We find that Opposer has established priority in the cancellation proceeding.

B. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (*DuPont* "articulated thirteen factors to consider when determining likelihood of confusion"). "Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered," *id.* (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)), but all 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) (internal quotation omitted)). A single *DuPont* factor may be dispositive in a particular case. *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *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 [or services] and differences in the marks.”). Opposer discusses these key factors, 21 TTABVUE 24-25, 32-35, 36-41; 23 TTABVUE 5-13, as well as the third *DuPont* factor regarding channels of trade, *DuPont*, 177 USPQ at 567, 21 TTABVUE 25, 35; the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567, 21 TTABVUE 25-26, 36; the fifth *DuPont* factor, the “fame of the prior mark,” *DuPont*, 177 USPQ at 567, 21 TTABVUE 19-24, 29-31; 23 TTABVUE 14-16; and the eighth *DuPont* factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567, 21 TTABVUE 41-42. Opposer also argues that all doubts on the issue of likelihood of confusion must be resolved in its favor as the senior user. 21 TTABVUE 42.

Applicant argues that “[t]his case hinges on whether Applicant’s SWEET VIBRATIONS mark is confusingly similar to Opposer’s GOOD VIBRATIONS mark.” 22 TTABVUE 5. Applicant also argues that Opposer’s mark is not famous under the fifth *DuPont* factor, *id.* at 7-11, that the mark “is a descriptive and conceptually weak term as applied to Opposer’s goods and services because it merely describes a feature of those goods” and because the record “contains evidence that third parties use ‘vibrations’ to describe a feature of vibrators,” *id.* at 10, and that there is no evidence of actual confusion. *Id.* at 15. Applicant does not address the second, third, or fourth *DuPont* factors.

1. Fame of Opposer's Mark

We begin with the fifth *DuPont* factor, the “fame of the prior mark (sales, advertising, length of use),” *DuPont*, 177 USPQ at 567, because the “[f]ame of an opposer’s mark, if it exists, plays a ‘dominant role in the process of balancing the *DuPont* factors.’” *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). “A mark ‘with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)). “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.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

“While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion 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 *Palm Bay Imps.*, 73 USPQ2d at 1694). In placing the GOOD VIBRATIONS mark on that spectrum, our “applicable viewpoint is that of the relevant market,” not that of the general public. *Id.* (citing *Palm Bay Imps.*, 73 USPQ2d at 1694 (“Fame for confusion purposes arises as long as

a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator,” and “a mark’s renown within a specific product market is the proper standard”). Opposer offers retail and mail order services under the GOOD VIBRATIONS mark that feature sexually oriented products such as marital aids, electronic devices, and books, Dennis Decl. ¶ 4,¹⁴ and sells “GOOD VIBRATIONS-branded adult toys and sexual aids,” Dennis Decl. ¶ 3, including what is identified in Opposer’s Registration No. 3631427 as “artificial phalli.”¹⁵ We agree with Opposer that the relevant market for purposes of assessing the strength of its mark is “purchasers of retail store services featuring sexually oriented products such as marital aids and sex toys” 21 TTABVue 30.

“Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion.” *Omaha Steaks*, 128 USPQ2d at 1689-90 (quoting *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)). There is no such evidence in the record here, but “the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the

¹⁴ Mr. Dennis testified that the “phrase ‘marital aid’ has long been used in the field of sexual oriented products as a euphemism for sex toys.” Dennis Decl. ¶ 5.

¹⁵ The Board may take judicial notice of dictionary definitions, including definitions from online dictionaries, for various purposes, including to clarify the meaning of words in the identifications of goods or services in a registration or application. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). We take judicial notice that the word “phalli” is the plural of the noun “phallus,” which means “a symbol or representation of the penis.” MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on June 2, 2020). Mr. Dennis testified that these goods are known colloquially as dildos. Dennis Decl. ¶ 5.

length of time those indicia of commercial awareness have been evident.” *Id.* at 1689-90 (quoting *Bose*, 63 USPQ2d at 1305).

Because we must determine the likelihood of confusion at the time of trial, fame, if it exists, is also determined as of the time of trial. *See, e.g., Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014)); *cf. Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1049 (Fed. Cir. 2018) (finding that Board erred in relying on survey conducted five years before the close of trial to support its finding of acquired distinctiveness).

Opposer argues that through its “long and extensive use and substantial sales of retail and mail order services featuring adult oriented products, Opposer’s distinctive GOOD VIBRATIONS mark has become extremely well-known to consumers,” 21 TTABVUE 21, and is famous. *Id.* at 30. Opposer cites its use of the mark since 1977; its operation of nine retail outlets; its outreach to consumers through distribution of a mail order catalog; the operation of its website at goodvibes.com; the operation of a Good Vibrations Antique Vibrator Museum within its retail location on Polk Street in San Francisco, California; its presence on social media; the nature and extent of its advertising and promotional efforts; its receipt of awards and media coverage; and its gross revenues from the sale of sexually oriented products. *Id.* at 19-24, 30-31.

Applicant responds that the “record contains no credible, probative evidence that would tend to establish [that] Opposer’s GOOD VIBRATIONS mark enjoys any level of fame.” 22 TTABVUE 8. Applicant notes that Opposer’s retail outlets are

concentrated in the San Francisco Bay Area in California and near Boston, Massachusetts; that Opposer's sales and advertising figures "are not impressive in and of themselves" and have been given no context within Opposer's industry; that the awards received by Opposer also have no context and that there is no "evidence regarding the criteria or meaning of those 'awards,' nor any evidence that even a single relevant consumer would be aware of the existence of any of those 'awards;'" *id.* at 9, and that the probative value of the media articles regarding Opposer and its mark "is diminished by the fact that they are not particularly recent." *Id.* As noted above, Applicant also contends that Opposer's mark is conceptually weak because of the weakness of the word "vibrations," which Applicant argues "merely describes a feature" of Opposer's goods and services and is used by third parties to describe a feature of vibrators. *Id.* at 10.¹⁶

a. Length of Use

Mr. Dennis testified that the GOOD VIBRATIONS mark has been in continuous use by Opposer and its predecessors in interest since at least as early as 1977, Dennis Decl. ¶ 6, a period of 42 years as of the time of trial in 2019. On its face, that is a substantial period of use, but we must consider what the record shows about the

¹⁶ We reject this argument. Even if the record showed that the word VIBRATIONS in Opposer's mark, which has not been disclaimed in its registrations, has some descriptive significance in relation to Opposer's goods and services, we must presume that Opposer's mark as a whole is at least suggestive because Opposer's registrations of GOOD VIBRATIONS issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006) ("A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.").

nature and extent of Opposer's activities during that period, including "the volume of sales and advertising expenditures of the goods [and services] traveling under the mark," *Bose*, 63 USPQ2d at 1305, because what matters is "the length of time those indicia of commercial awareness have been evident." *Id.*¹⁷ As discussed below, Mr. Dennis provided revenue figures only for the period between 2009 and 2018, and advertising figures only for the period between 2014 and 2018, and there is very little evidence in the record regarding Opposer's operations during the 32 years between 1977 and 2009.

Mr. Dennis's declaration includes a chart listing the locations and periods of operation of Opposer's stores. Dennis Decl. ¶ 8. Opposer currently operates nine stores, but between 1977 and 1994, Opposer operated a single store, at two successive locations, in San Francisco, California. Between 1994 and 2002, Opposer operated two stores, the original one in San Francisco and a second in Berkeley, California. Between 2002 and 2006, Opposer operated three stores, after adding a second store

¹⁷ The *Bose* court summarized the length of use of marks, and the level of sales and advertising during the period of use, in the following cases: *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1902 (Fed. Cir. 1989) (NINA RICCI for perfume, clothing and accessories: \$200 million in sales and over \$37 million in advertising over 27 years); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (HUGGIES for diapers: over \$300 million in sales over 9 years, and \$15 million in advertising in one year); *Specialty Brands Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (SPICE ISLANDS for teas, spices and seasonings: \$25 million annually in sales for spices, \$12 million in sales between 1959 and 1981 for tea, and several million in advertising over 40 years); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 392-93 (Fed. Cir. 1983) (GIANT FOOD for supermarket services and food products: sales over \$1 billion in one year, and "considerable amounts of money" expended in advertising over 45 years of use); *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 USPQ 504, 506 (CCPA 1962) (MR. PEANUT design for nuts and nut products: \$350 million in sales and \$10 million in advertising over 10 years). *Bose*, 63 USPQ2d at 1305-06.

in San Francisco in 2002. Opposer added a fourth store, in Brookline, Massachusetts, in 2006. Opposer's five other stores were each opened at some point after 2009, with three having opened after 2012.

In what Mr. Dennis characterizes as a nationwide market for sexually oriented products, Dennis Decl. ¶¶ 24-26, Opposer's geographic "footprint" has always been extremely small, as it has been limited to stores in the greater San Francisco Bay Area and near Boston, Massachusetts.¹⁸ Opposer operated a total of only four stores in these two areas before 2009, and currently operates only nine, and, as discussed below, more than 70% of Opposer's revenues since 2009 have been from brick-and-mortar world sales, Dennis Decl. ¶ 17, through which the GOOD VIBRATIONS mark is exposed to consumers through signage of the sort depicted below and in other manners:

¹⁸ We take judicial notice that the cities of Cambridge and Brookline in Massachusetts, in which Opposer's only non-Bay Area stores are located, are near Boston and are about four miles apart from one another. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *7 (TTAB 2020) (taking judicial notice of the distance between addresses in the California cities of Los Angeles and San Diego).



19



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The small number of stores and their tight geographic concentration reduce the impact of the decades of retail use of the GOOD VIBRATIONS mark on the mark's possible fame. *Omaha Steaks*, 128 USPQ2d at 1691 (fame of OMAHA STEAKS mark supported by sales of goods bearing the mark in “seventy-five stores in twenty-five states, including New York, Illinois, Florida, Georgia, Ohio, Kentucky, Missouri,

¹⁹ Dennis Decl. ¶ 8; Ex. 1 (Polk Street store in San Francisco, California).

²⁰ Dennis Decl. ¶ 8; Ex. 1 (John F. Kennedy Street store in Cambridge, Massachusetts).

Nebraska, California, Colorado, Nevada, Arizona, Texas, Pennsylvania, and New Jersey.”).

With respect to Opposer’s pre-2009 activities, Mr. Dennis testified that Opposer began distribution of a mail order catalog in 1985, Dennis Decl. ¶ 9, and launched its website at goodvibes.com in 1995. Dennis Decl. ¶ 10. He testified that the catalog was published on a quarterly basis and “at its peak [was] sent to over 52,000 addresses” and permitted customers to order products via regular mail. Dennis Decl. ¶ 9. He did not state when the “peak” was, or the extent of any sales generated through the mail order catalog, and he did not establish how long the catalog was distributed, stating only that it “has been discontinued as the majority of customers have transitioned to purchase their products online through the Good Vibrations website.” Dennis Decl. ¶ 11.²¹ He also did not testify about the extent of pre-2009 sales through Opposer’s website, or the number of visitors to the website prior to 2013. Dennis Decl. ¶ 12.

b. Sales and Advertising

Opposer’s revenues and advertising expenditures were designated “Confidential-Attorney’s Eyes Only” under the Board’s Standard Protective Order. Dennis Decl. ¶¶ 17, 20. We will honor those designations, but will discuss the relevant figures in general terms because doing so is necessary to give the parties, readers of this

²¹ Mr. Dennis authenticated archived pages from the website “as it appeared in November 1996,” Dennis Decl. ¶ 10; Exs. 2.1-2.7, which he claimed “provided information on the GOOD VIBRATIONS mail order catalogue and retail locations.” Dennis Decl. ¶ 10. A page entitled “Ordering,” which provided “General Order Information” about how orders could be placed, stated that mail orders could be placed by printing the order form available under a link and sending it with payment to Opposer’s San Francisco store. Dennis Decl. ¶ 10; Ex. 2.5. Another page stated that paper catalogs (apparently the referenced mail order catalogs) were available on request. Dennis Decl. ¶ 10; Ex. 2.6.

opinion, and any reviewing court an explanation of the basis for our finding on the issue of the fame of Opposer's mark. *See, e.g., Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016).

Mr. Dennis testified about Opposer's annual gross revenues from sales through its brick-and-mortar stores and its website between 2009 and 2018. Dennis Decl. ¶ 17. He described the revenues as being "earned from sales of retail services featuring sexually oriented products such as marital aids, electronic devices, etc. under the GOOD VIBRATIONS service mark in the United States" Dennis Decl. ¶ 17. In 2009, Opposer's total revenues from sales through its stores and website were in the high seven figures. For each subsequent year from 2010 to 2018, revenues from sales through both channels of trade were just into eight figures. Total revenues for the 10-year period between 2009 and 2018 were slightly into nine figures. Revenues from sales through Opposer's stores accounted for nearly 73% of Opposer's total revenues during that period.

Mr. Dennis also testified about Opposer's annual advertising expenditures between 2014 and 2018. Dennis Decl. ¶ 20. He stated that Opposer's advertising and promotional efforts were "via multiple channels, including but not limited to print, online and via social media, video (broadcast via the Internet), and trade shows," Dennis Decl. ¶ 18, but did not specify the print or social media in which Opposer's advertisements have appeared, which omission reduces the probative value of his testimony about the raw expenditures. *Omaha Steaks*, 128 USPQ2d at 1690 (fame of OMAHA STEAKS mark supported in part by testimony that Opposer's extensive

print advertising had appeared “in national magazines, including *Time*, *Newsweek*, *Playboy*, and *PC Magazine*, and newspapers, including *USA Today*, the *Wall Street Journal*, the *New York Times*, and the *LA Times*”).

Opposer’s advertising expenditures in the year 2014 were in the mid-six figures, but its expenditures for each of the subsequent four years were considerably lower. Between 2015 and 2017, annual expenditures were in the very low six figures, and in 2018 they were in the very high five figures. Total expenditures for the five-year period were in the very high six figures, with nearly half of them attributable to 2014 alone. Dennis Decl. ¶ 20.

Opposer makes no effort to place its revenue and advertising figures in the context of the overall market for sexually oriented products in the United States, arguing in its reply brief that the Federal Circuit held in *Omaha Steaks* that “evidence of ‘market share’ is not required to show the strength and fame of a mark.” 23 TTABVUE 15. Opposer also cites a non-precedential Board decision, *Paramount Int’l Exp. Ltd. v. Q’Sai Co.*, Opp. No. 91221593 (TTAB Sept, 15, 2017), which it describes as “finding that notwithstanding failure to provide ‘context’ evidence, finding that mark was famous was still warranted.” *Id.* at 15-16.

We do not read *Omaha Steaks* as holding that it is never necessary to contextualize sales and advertising figures to show a mark’s strength. The Federal Circuit has “consistently accepted statistics of sales and advertising as indicia as fame,” and “when the numbers are large, [has] tended to accept them without any further supporting proof.” *Bose*, 63 USPQ2d at 1306. Here, however, the numbers are

not large, at least in comparison to those that have supported fame findings in multiple Federal Circuit and Board cases.²² *See, e.g., Omaha Steaks*, 128 USPQ2d at 1690 (fame of OMAHA STEAKS mark supported by advertising expenditures of \$45 million in 2011 and over \$50 million in 2012 and 2013 and by evidence that during the holiday season, plaintiff processes 100,000 orders per day); *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark for loudspeaker systems supported by \$50 million in annual sales and \$5 million in annual advertising); *Nina Ricci*, 12 USPQ2d at 1902 (fame of NINA RICCI mark for fragrance products supported by \$350 million in retail sales and around \$37 million in advertising and sales promotion expenditures between 1981 and 1986); *Kimberly-Clark Corp.*, 227 USPQ at 542 (fame of HUGGIES mark for diapers supported by over \$300 million in sales and \$15 million in advertising in the year 1982 alone); *AutoZone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (fame of petitioner's AUTOZONE mark supported by use of mark for over 23 years, sales through over 4,000 retail stores, advertising expenditures of over \$750 million during 23-year period of use, and sales totaling \$6.8 billion in 2008 alone, with the Board finding that although petitioner had "not placed its sales and advertising figures in context," such context was "not necessary here in view of the volume of sales and advertising expenditures and the

²² The numbers in the oldest three Federal Circuit cases summarized below would be much larger if expressed in current dollars.

fact that petitioner’s advertising reaches over 90% of the U.S. population numerous times each year.”).²³

Given the levels of Opposer’s sales figures and advertising expenditures, to show that its mark is famous in the sexually oriented products industry, Opposer must show that its sales and advertising have been at a level vis-à-vis its competitors sufficient to cause its GOOD VIBRATIONS mark to stand out from its competitors’ marks. *Bose*, 63 USPQ2d at 1309 (noting that a “tiny percentage of the market share for the product or a small share of advertising revenues for the product market could undermine the weight given to the figures for assessment of fame,” while “[l]arge market shares of product sales or large percentages of advertising expenditures in a product line would buttress claims to fame.”); cf. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2009) (opposer’s claim to have captured 75% of relevant medical products market supported finding of niche fame within that market, but Board noted that opposer’s advertising figures were “not

²³ Opposer’s sales and advertising figures also pale in comparison to those in the non-precedential *Paramount Int’l* case that Opposer cites. Non-precedential decisions are not binding on the Board, *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120-21 (TTAB 2012), but the *Paramount Int’l* does not aid Opposer in any event. In that case, the opposer showed that it had sold over 153 million cases of water and had spent \$137 million in advertising during the 11 years prior to trial, 34 TTABVUE 7 (Opposition No. 91221593), and its witness testified that it was “the number one brand of bottled water in the United States.” *Id.* at 8. The Board found that there was “no context from which to determine the accuracy of the figures in Opposer’s media data sheet, which was apparently prepared at Opposer’s behest,” and that it was “unclear how Opposer defines ‘premium’ bottled water brands, how many products fit in that category or even what being ‘number one’ in that category means with respect to the bottled water market as a whole.” *Id.* at 9. Nevertheless, the Board found that because the opposer’s “marketing expenditures are substantial and its unit sales figures are impressive,” *id.*, its FIJI mark was “commercially famous for a premium quality bottled water.” *Id.* at 10.

particularly impressive” and that “the problem that we have in assessing the effectiveness of the advertising expenditures is that there is no testimony or evidence regarding whether opposer’s advertising expenditures are large or small vis-à-vis other comparable medical products.”). Opposer has not shown the significance of its sales and advertising figures within the sexually oriented industry in the United States, which the record indicates is quite substantial in size.

Mr. Dennis testified that the “prospective purchasers of retail and mail order services featuring sexually oriented products such as marital aids, electronic devices, media and books comprise a wide variety of consumers, due to adult toys and sexual aids being a popular item for adults in the United States,” Dennis Decl. ¶ 24, and that “[a]dult toys and sexual aids can be bought by the general public online or off the shelf via retail and mass merchandisers (including CVS, Walmart and Amazon.com).” Dennis Decl. ¶ 26. We can infer from the availability of these goods through CVS, Walmart, and Amazon.com, and from their sale under numerous marks, Dennis Decl. Exs. 3-5, 7,²⁴ that there is a large market for these goods in the United States, but we have no sense whatsoever of Opposer’s position within it. “Market share is but one way of contextualizing ad expenditures or sales figures,” *Omaha Steaks*, 128 USPQ2d at 1690, but Opposer offers neither that metric nor any other to show the significance of its revenue and sales figures vis-à-vis those of its competitors.

²⁴ Opposer made of record more than 30 third-party registrations of marks covering goods and services in Opposer’s industry. 21 TTABVUE 12-13 (citing Opposer’s First Notice of Reliance Exs. 24-57 (14 TTABVUE 83-198)). Opposer also notes that with respect to the target market for the goods, “Applicant identifies the type and class of consumer for personal vibrators simply as ‘[a]dults.’” *Id.* at 25 (citing 16 TTABVUE 36 (Applicant’s Response to Opposer’s Interrogatory No. 15)).

c. Media Coverage and Other Evidence

Opposer offers a variety of other forms of evidence to show the fame of its mark, including the number of visits to its website; its operation of the Good Vibrations Antique Vibrator Museum; its social media presence; awards and other recognition that it has received; “significant unsolicited, third-party nationally publicity for its retail services . . . provided under the GOOD VIBRATIONS mark, including being featured on major news networks CNN and Fox News and in nationally read publications such as *Cosmopolitan*, *Marie Claire*, *Men’s Health*, *Redbook*, *Bustle*, and *Self*,” 21 TTABVUE 22; and media coverage of Opposer and its goods and services, including the recommendation of its products by sex therapist Dr. Ruth Westheimer. *Id.* at 22-23.

We turn first to the media coverage. Opposer made of record 50 articles, three book excerpts, and a Wikipedia entry, that feature or mention Opposer, 17 TTABVUE 10-206 (Exs. 64-117), and Mr. Dennis testified that Opposer’s mark has been “featured on major news networks CNN and Fox News and in nationally read publications such as *Cosmopolitan*, *Marie Claire*, *Men’s Health*, *Redbook*, *Bustle* and *Self*.” Dennis Decl. ¶ 22. The articles and book excerpts are listed by title, publication, and publication date in Opposer’s main brief, 21 TTABVUE 14-16, but Mr. Dennis provided no particulars for the claimed coverage on CNN and Fox News or in the listed national magazines, including what it involved or when it occurred, or examples of such publicity, and we have given his unsupported testimony on these matters no weight on the issue of the fame of Opposer’s mark. *Cf. Omaha Steaks*, 128

USPQ2d at 1690-91 (accepting witness testimony regarding exposure of OMAHA STEAKS mark on television programs and in movies).

Opposer argues that the 50 articles “refer to and acknowledge the renown of Opposer’s retail store services featuring sexually oriented products.” 21 TTABVUE 22. The probative value of news articles as evidence of fame is limited because, as Opposer acknowledges in response to Applicant’s hearsay objection, “[a]lthough news articles may be used as evidence for what they show on their face, they may not be relied on for truth of the statements contained therein.” *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 (TTAB 2018) (citing Fed. R. Evid. 802 and *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (“A printed publication is only admissible for what it shows on its face; unless it falls within an exception to the hearsay rule it will not be considered to prove the truth of any matter stated in the publication.”)); *see also Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005), *rev’d on other grounds*, 2008 WL 6862402 (D.D.C. April 3, 2008).²⁵ Insofar as none of the exceptions to the rule against hearsay apply, we cannot consider the articles to prove the truth of any matter stated therein. “However, such materials are frequently competent to show, on their face, matters of relevance to trademark claims (such as public perceptions), regardless of whether the

²⁵ Opposer also acknowledges the limited use to which articles may be put when it argues in its reply brief that an article about The Beach Boys’ song *Good Vibrations* submitted by Applicant “(like the other internet printouts Applicant submitted) is only competent evidence that some segment of the public interested in the particular style of music covered by *Rolling Stone* (Rock ‘N Roll) may have been exposed to the magazine’s rankings at some point and time. It is not evidence that the song is, in fact, one of the ‘greatest songs of all time’ or famous (or even well-known) among consumers of Opposer’s goods and services.” 23 TTABVUE 13.

statements are true or false.” *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014). Nonetheless, as discussed below, there are specific problems with the articles that reduce their probative value on the fame of Opposer’s mark, with some of the articles suffering from more than one of the problems.

First, a majority of the articles are quite dated. Fifteen appeared prior to 2000,²⁶ and another 16 appeared between 2000 and 2010.²⁷ Only 19 appeared within the past 10 years.²⁸ Because we must determine the fame of the GOOD VIBRATIONS mark as of the time of trial in 2019, the age of many of these articles significantly reduces their probative value on that issue, as the exposure of the mark to readers of articles many years ago tells us relatively little, if anything, about how the mark is perceived today.

²⁶ These articles appeared in 1992 (*San Francisco Examiner, Philadelphia Inquirer*); 1993 (*Miami Herald, South Florida Sun Sentinel*); 1994 (*San Francisco Examiner, South Florida Sun-Sentinel* (two), *Los Angeles Daily News*); 1995 (*Chicago Tribune, San Francisco Chronicle, The Women’s Review of Books*); 1996 (*Buffalo News, San Francisco Chronicle*); and 1997 (*Contra Costa Times, Pittsburg Post-Gazette*). 17 TTABVUE 16-18, 24-27, 60-61, 76-79, 94-98, 105-06, 125-29, 142-43, 147-48, 152-62, 174-76, 204-06.

²⁷ These articles appeared in 2000 (*New York Post*); 2002 (*Chicago Reader, Chicago Tribune*); 2003 (*Mountain Xpress, San Francisco Chronicle* (two)); 2004 (*The Louisville Courier Journal, Grand Rapids Press, Newark Star Ledger*); 2006 (*Boston Herald*); 2007 (*Missoula Independent, Chicago Tribune*); 2008 (*The Louisville Courier Journal, Kansas City Star*); 2009 (*Wisconsin State Journal*); and 2010 (*Life Science Weekly*). 17 TTABVUE 19-21, 32-36, 41-51, 102-04, 107-20, 123-24, 130-33, 177-79, 192-94, 198-203.

²⁸ These articles appeared in 2011 (*Redding Record Searchlight, Oakland Tribune*); 2012 (*Tampa Bay Times, The Arizona Republic, Chicago Tribune*); 2013 (*Brookline TAB*); 2014 (*U.S. News & World Report, San Francisco Business Times, Endgadget HD*); 2015 (*The Commercial Dispatch* (Columbus, Mississippi), *Business N.H. Magazine*); 2016 (*Huffington Post, U-Wire*); 2017 (*The Seattle Times, State News Service, Endgadget HD, Glamour Magazine, San Francisco Chronicle*); and 2018 (*San Francisco Chronicle*). 17 TTABVUE 10-12, 13-15, 22-23, 28-31, 37-40, 62-64, 85-93, 99-101, 121-22, 144-46, 149-51, 163-73, 180-91, 195-97.

Four such articles illustrate why the stale evidence is problematic. Opposer argues, in the present tense, that it “is frequently recommended as a trusted retailer of vibrators, including by preeminent sex therapist Dr. Ruth Westheimer in her syndicated advice column,” 21 TTABVUE 22, but Opposer bases this argument on recommendations in columns that appeared in publications between 1993 and 1995, about a quarter century before trial in 2019.²⁹ In 2019, there were undoubtedly many prospective purchasers of Opposer’s goods and services who were not even alive when “Dr. Ruth” made the cited recommendations. Such purchasers, as well as older ones, would have no reason to be aware of, much less to retrieve and read, her advice columns, or other articles mentioning Opposer, that appeared 20 or more years ago.

Rule 803(16) of the Federal Rules of Evidence provides an exception to the rule against hearsay set forth in Rule 802 for “[a] statement in a document that was prepared before January 1, 1998, and whose authenticity is established.” Fed. R. Evid. 803(16). The 15 pre-1998 articles in the record arguably qualify as such “ancient documents,” but we find that those articles are simply too remote in time to have any significant probative value regarding whether Opposer’s mark is famous today even if we accepted them as substantive evidence of the truth of the matters stated in them. We further find that the 16 articles that appeared between 2000 and 2010 also

²⁹ 17 TTABVUE 60-61, 105-06, 142-43, 147-48. In two of the articles, “Dr. Ruth” also advised her reader to contact either Opposer, or another company, to purchase a vibrator. *Id.* at 105-06 (“To purchase a vibrator, write to: Good Vibrations . . . or Eve’s Garden”), 142-43 (“There are several discreet mail-order companies that I recommend which have a large selection. You can write for a catalog to Eve’s Garden . . . or Good Vibrations”). These articles are also examples of ones in which Opposer is mentioned together with one or more of its competitors, which we discuss in more detail below.

have limited probative value on the issue of the current recognition of Opposer's mark.

Second, a number of the post-2000 articles appear to be from regional, local, or specialized publications, including the *Mountain Xpress* (Buncombe County, North Carolina), the *Grand Rapids Press* (Grand Rapids, Michigan), the *Missoula Independent* (Missoula, Montana), the *Wisconsin State Journal* (Madison, Wisconsin), *Life Science Weekly*, the *Redding Record Searchlight* (Redding, California), the *Brookline TAB* (Brookline, Massachusetts), *Endgadget HD*, *The Commercial Dispatch* (Columbus, Mississippi), *Business N.H. Magazine*, *U-Wire*, and *State News Service* (Las Vegas, Nevada). These publications “are not likely to be seen by large numbers of the general public,” *Blue Man Productions*, 75 USPQ2d at 1817, or by large numbers of consumers of sexually oriented products. “We consider these articles to be of extremely limited value in proving the fame of [O]pposer's mark.” *Id.*³⁰

Third, several of the post-2000 articles simply mention Opposer in passing in the course of discussing broader subjects. These include a April 22, 2000 *New York Post* article, which notes that “Good Vibrations, a San Francisco-based manufacturer is planning to air-lift a load of marital aids to” Alabama if a state ban on local sales of such products were reinstated by a federal appeals court;³¹ a March 16, 2004 *Grand*

³⁰ Several of the post-2000 articles are from publications in the two metropolitan areas where Opposer has stores. These articles presumably would be read primarily by consumers in those areas, and they have limited probative value in showing that Opposer's mark is well known elsewhere in the United States. *Blue Man Productions*, 75 USPQ2d at 1817-18.

³¹ 17 TTABVUE at 19-21.

Rapids Press article regarding the sexual practices of older Americans, which states that one particular sex educator “refers people to the Good Vibrations sex catalog;”³² a October 1, 2011 *Oakland Tribune* article discussing various businesses in the East Bay, including Opposer;³³ a April 22, 2012 *Tampa Bay Times* article about Earth Day, in which the author mentions a “pitch” that he received from Opposer urging consumers to “green your bedroom with ecorotic® toys and body products from Good Vibrations, the original women-owned, adult toy retailer”;³⁴ a July 1, 2017 *Glamour* magazine article that answers numerous questions regarding sex and mentions that in 1976 Opposer’s founder Joani Blank wrote “Good Vibrations, a guide to orgasming with a vibrator—or, in seventies speak, ‘buzzing off’”;³⁵ and a September 5, 2018 *San Francisco Chronicle* article discussing the history and current situations of several “legacy” retailers in the San Francisco Bay Area, including Opposer.³⁶ We find that these articles have little probative value on the strength of Opposer’s mark because they do not feature Opposer or its mark. *Blue Man Productions*, 75 USPQ2d at 1817-18.

Fourth, a larger number of the post-2000 articles mention Opposer together with one or more competitors, often in the course of discussing broader subjects. These include a March 20, 2002 *Chicago Tribune* article discussing the availability of

³² *Id.* at 112-16.

³³ *Id.* at 195-97.

³⁴ *Id.* at 89-90.

³⁵ *Id.* at 163-73.

³⁶ *Id.* at 99-101.

information regarding sex on the Internet, which mentions early2bed.com, the website of “Early to Bed, a women-oriented erotic boutique in Chicago,” and lists Opposer’s website as among sources of such information;³⁷ a January 21, 2003 *San Francisco Chronicle* article regarding the rise of the city’s adult-entertainment business, which discusses Opposer and its new Polk Street store, as well as what the article calls a “well-established rival,” Blowfish, an online and catalog retailer, and a second local competitor, Xandria.com of Brisbane, California;³⁸ a May 2, 2003 *San Francisco Chronicle* article discussing “[t]wo San Francisco companies specializing in adult merchandise – Good Vibrations and MyPleasure – [that] saw online orders from military personnel abroad surge during the troop buildup in the Persian Gulf and the outbreak of hostilities in Iraq”;³⁹ an April 29, 2007 *Chicago Tribune* article regarding the chemicals in sex toys, which mentions Opposer and other companies;⁴⁰ a March 14, 2008 *Kansas City Star* article about the founder of Wink, a sex toys shop in Kansas City, Missouri, who lived “in San Francisco and visited Good Vibrations, a similar store offering sexual information and products, and decided it was needed in the Kansas City area” and who contemplated having another person “take over the day-to-day retail operations so she can work full time with Joani Blank, founder of Good Vibrations and a writer and educator in sexuality”;⁴¹ a June 4, 2012 *Arizona Republic*

³⁷ *Id.* at 198-203.

³⁸ *Id.* at 130-33.

³⁹ *Id.* at 102-04.

⁴⁰ *Id.* at 192-94.

⁴¹ *Id.* at 177-79.

article discussing the impact of the book *Fifty Shades of Grey* on sales in sex shops across the country, which mentions Opposer and four other retailers;⁴² a July 29, 2012 *Chicago Tribune* article also discussing the impact of *Fifty Shades of Grey*, which states that “[a]t San Francisco-based Good Vibrations, sales of bondage sex toys have increased 65 percent and erotica 50 percent since ‘Fifty Shades’ rose to the top of the best-seller lists this spring,” and discusses another retailer and a manufacturer of sex toys;⁴³ a March 27, 2014 *U.S. News & World Report* article quoting a “co-founder of Babeland, a sex toy retailer with locations in Seattle and New York” that “[s]tores such as Babeland and San Francisco-based Good Vibrations are ‘missionary’ in their intent,” and mentioning other companies with stores in Portland and Baltimore;⁴⁴ an August 27, 2014 *Endgadget HD* article about the Hitachi Magic Wand sex toy, which the article states was first available at Eve’s Garden and later at Opposer’s first store;⁴⁵ an October 1, 2015 *Business NH Magazine* article discussing OhMiBod, a New Hampshire sex toy company, which states that the company “sells on Brookstone and Amazon as well at female-friendly specialty stores, such as Good Vibrations in Brookline, Three Wicked Women in Rye and CS Boutique in Portland, Maine”;⁴⁶ a July 8, 2016 *Huffington Post* article stating that “[v]ibrators and other sex toys designed to enhance sensation are available from companies like Good Vibrations or

⁴² *Id.* at 91-93.

⁴³ *Id.* at 149-51.

⁴⁴ *Id.* at 13-15.

⁴⁵ *Id.* at 188-91.

⁴⁶ *Id.* at 144-46.

even Amazon”;⁴⁷ and a July 25, 2017 *Seattle Times* article discussing the acquisition of Babeland by “Bay Area adult-toys purveyor Good Vibrations” and the history of the companies’ operations.⁴⁸ We find that these articles have little probative value on the strength of Opposer’s mark because they identify Opposer as simply one of many companies in the sexually oriented products business. *Cf. Safer*, 94 USPQ2d at 1042 (fame or public renown of opposer’s DEER AWAY mark for repellant could not be inferred from studies in which “DEER AWAY was one of many repellants identified in the studies” and “was in no way singled out as a particularly well-known product.”).

Opposer relies most heavily on the articles that refer to Opposer as a “famous” or “legendary” business, or contain other positive statements regarding its reputation or recognition in the sexually oriented products industry. 21 TTABVUE 22-23. Three of the articles pre-date 2000,⁴⁹ and we accordingly give them very little weight regarding the fame of Opposer’s mark in 2019. Several of these post-2000 articles

⁴⁷ *Id.* at 10-12.

⁴⁸ *Id.* at 22-23.

⁴⁹ *Id.* at 94-96 (January 25, 1996 *San Francisco Chronicle* article touting “[a]nother Famous Ess Eff First! Good Vibrations, the sexcessful sex toy store, has gone on the World Wide Web with ‘the first on-line Vibrator Museum,’ which includes ‘the wooden crank vibrator Queen Victoria might have used.’ Unfortunately, the Queen is unavailable for comment and Prince Albert is still in the can”); 174-76 (November 11, 1995 *San Francisco Chronicle* article discussing the results of a study of the demographics of the market for sex toys, and quoting “Joani Blank, owner for 20 years of the pioneering Good Vibrations store in San Francisco, where vibrators are the primary items for sale,” as stating that “I applaud these findings” and that “we need more studies. I’d like to know the profile of people who do not use them. But this helps show that sex toys are not just for fringe people. Sex is all-American”); 204-06 (May 1, 1995 *Women’s Review of Books* article reviewing the book *The Woman-Centered Economy: Ideals, Reality, and the Space in Between*, which review discusses feminist-run businesses, and states that “Good Vibrations, San Francisco’s famous feminist sex store, changed from a sole proprietorship owned by Joani Blank to a worker-owned business”).

have been discussed above in connection with other deficiencies in Opposer's evidence, but they do not establish the renown of Opposer's mark in any event.

These post-2000 articles are a June 14, 2002 *Chicago Reader* article discussing the owner of Early to Bed, described as "Chicago's first woman-owned sex shop," whom the article states served "an unofficial apprenticeship at Good Vibrations, San Francisco's legendary woman-owned adult boutique";⁵⁰ the January 21, 2003 *San Francisco Chronicle* article regarding Opposer's new store on Polk Street and mentioning two of Opposer's Bay Area competitors, which describes Opposer as a "pioneering sex-toy merchant";⁵¹ a September 2, 2003 Mountain Xpress article about the author's visit to four adult bookstores and sex shops in Buncombe County, North Carolina, in which he states that "[w]hen all is said and done, however, the only really shocking thing about Buncombe County's adult-bookstore scene is the total lack of anything resembling an explicitly feminist- or sexologist-style establishment à la San Francisco's well-known - and well-respected - Good Vibrations";⁵² a February 11, 2004 *Newark Star-Ledger* article regarding romantic foods for Valentine's Day and a cookbook entitled "InterCourses" about foods that are aphrodisiacs, which states that "'InterCourses' is the only cookbook sold by the legendary San Francisco sex toy shop Good Vibrations";⁵³ a May 31, 2007 *Missoula Independent* article about global warming, which states that the "famed adult store chain Good Vibrations announced

⁵⁰ *Id.* at 107-08.

⁵¹ *Id.* at 130-33.

⁵² *Id.* at 49-51.

⁵³ *Id.* at 117-20.

they would no longer sell products containing ‘phthalates, controversial chemical plasticizers believed by some to be hazardous to humans and the environment alike’;⁵⁴ a December 14, 2010 *Life Science Weekly* article regarding products for romance during long winter nights from “Good Vibrations, the woman-focused retailer trusted for more than three decades to provide a comfortable, safe environment for finding sexy and educational materials to put the spice back in the bedroom”;⁵⁵ a February 6, 2011 *Redding Record Searchlight* article regarding Valentine’s Day gifts stating that “[i]f you want to add a little more spice to your Valentine’s Day evening, the Bay Area’s famed Good Vibrations can help bring some playful fun to the bedroom” through the I Dare You card game;⁵⁶ the June 4, 2012 Arizona Republic article regarding the impact of the book *Fifty Shades of Grey*, which describes Opposer as “a leading online retailer of adult toys”;⁵⁷ an October 13, 2015 *Commercial Dispatch* article reviewing the book *The Sex & Pleasure Book: Good Vibrations Guide to Great Sex for Everyone*, which begins “[t]he famous Good Vibrations store was founded in San Francisco in 1977, selling sex toys and

⁵⁴ *Id.* at 109-111.

⁵⁵ *Id.* at 123-24.

⁵⁶ *Id.* at 121-22.

⁵⁷ *Id.* at 91-93.

vibrators”;⁵⁸ and an October 13, 2017 San Francisco Chronicle article discussing San Francisco’s Top 10 “heritage” retailers, including Opposer.⁵⁹

The characterizations of Opposer in these articles as “legendary,” “pioneering,” “well-known and well respected,” “famed,” or “famous,” do not establish that Opposer and its mark are, in fact, famous, *Blue Man Productions*, 75 USPQ2d at 1815, and “can only be considered as the author[s] view[s]” *Id.* We accord them some weight, however, because they exposed the authors’ views to readers, although, as noted above, a number of the publications in which the views appeared are regional or specialty publications that Opposer has not shown were widely distributed to prospective purchasers.

Opposer also relies on three excerpts from books published in 2012 and 2013,⁶⁰ and a Wikipedia entry.⁶¹ The book excerpts differ from many of the newspaper and magazine articles because the books are not works that appear to have wide general circulation. All three books appear to be in the nature of academic studies of the sexually oriented products industry rather than works that we can safely assume were read widely by consumers, and Opposer provides no information to the contrary.

⁵⁸ *Id.* at 62-64. Mr. Dennis’s declaration provides no information regarding this book, which the article describes as having been self-published by Opposer, apparently in or about 2015, and the book is not mentioned on the pages from Opposer’s website that are attached to his declaration.

⁵⁹ *Id.* at 180-84.

⁶⁰ *Id.* at 52-59 (*Commodity Activism Cultural Resistance in Neoliberal Times* (New York University Press 2012)); 65-75 (*The Feminist Porn Book The Politics of Producing Pleasure* (The Feminist Press at the City University of New York 2013)); 134-41 (*New Sociologies of Sex Work* (Routledge 2012)).

⁶¹ *Id.* at 80-84.

This alone reduces their probative value on the issue of the fame of Opposer's mark. *Cf. Safer*, 94 USPQ2d at 1042 (Board could not infer fame of mark mentioned in university-sponsored reports and studies in the absence of evidence of their circulation). At the same time, the book excerpts are similar in nature to many of the articles discussed above, and similarly deficient, because they simply mention Opposer as well as competitors in the course of discussing other broader subjects.

The excerpt from *Commodity Activism Cultural Resistance in Neoliberal Times* discusses female-owned businesses. It states that “a number of feminist sex toy businesses have joined together since 1996 in declaring the month of May a nationwide celebration of masturbation,” that Opposer conceived of “Masturbation May,”⁶² that Opposer was founded several years after Eve's Garden was founded in New York,⁶³ and that “[b]y the early 1990s, Good Vibrations had developed a national reputation as a clearinghouse for sexual information and a leader in the alternative sex vending movement.”⁶⁴ The excerpt also states that “businesses based on the Good Vibrations model of retailing—an educationally oriented and quasi-therapeutic approach to selling sex toys—can be found in dozens of cities across the country and in other countries too,” naming as examples Babeland, Early to Bed in Chicago, and Self-Serve in Albuquerque, among others.⁶⁵

⁶² 17 TTABVUE 55.

⁶³ *Id.* at 58.

⁶⁴ *Id.* at 59.

⁶⁵ *Id.*

The excerpt from *The Feminist Porn Book* relates the author's experience in selling porn on the floor of a Babeland store in New York in 2001. She describes Babeland as "part of a much larger network of sex-positive retailers whose raison d'être is providing customers—especially women—with quality products and accurate information in warm and welcoming retail environments."⁶⁶ Named as part of the "much larger network" are Opposer, Eve's Garden, Self-Serve, and Sugar in Baltimore.⁶⁷ Opposer and "its sister stores" are described as "launching pads for a number of sex-positive writers, sex toy manufacturers, and pornographers who have gone on to leave their own sex-positive stamps on the world."⁶⁸ The excerpt goes on to identify some of Opposer's former employees who founded other companies,⁶⁹ and to describe Opposer's formation, early operations, and status as a model for other stores and an early seller of porn and provider of sexual education.⁷⁰

The excerpt from *New Sociologies of Sex Work* characterizes Opposer as having ushered in a new dawn of sex toy retailing and having created a new model of retailing that became a "prototype for other women-owned and oriented businesses" in the United States, including Babeland, Smitten Kitten in Minneapolis, Early to Bed, Self-Serve, and Sugar.⁷¹ The bulk of the article "discusses the genesis and

⁶⁶ *Id.* at 68-69.

⁶⁷ *Id.* at 69-70.

⁶⁸ *Id.* at 70.

⁶⁹ *Id.*

⁷⁰ *Id.* at 72-75.

⁷¹ *Id.* at 135.

circulation of the Good Vibrations model,”⁷² with frequent references to Opposer, former employees, and Opposer’s “sister stores.”⁷³

The Wikipedia entry discussing Opposer, like all Internet evidence, can be considered only for what it shows on its face, not for the truth of matters such as Opposer’s revenue, number of employees, and historic operations, that appear in the pages. “Internet evidence, similar to printed publications, is only admissible for what it shows on its face, and because it does not fall within the exception to the hearsay rule, will not be considered to prove the truth of any matter stated therein.” *WeaponX Performance Prods. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1041 (TTAB 2018) (quotation omitted). We afford the Wikipedia entry some probative value on the issue of strength, however, to the extent that it shows that Opposer has achieved recognition significant enough that a Wikipedia entry devoted to it has been created.

Mr. Dennis also testified that Opposer “has a significant presence on social media,” with “popular accounts on social media platforms” such as Facebook, Twitter, Instagram, Pinterest, and YouTube, Dennis Decl. ¶ 19; that Opposer “has received multiple awards recognizing the superior retail services it offers under the GOOD VIBRATIONS mark,” including “XBIZ Awards – Retailer of the Year – Chain – 2018; XBIZ Awards – Retailer of the Year –Boutique – 2015 & 2016; Dig This Awards – Winner – Sex/Lingerie – 2014; SW Weekly, Best of SF, 2018; AVN Novelty Business

⁷² *Id.* at 136.

⁷³ *Id.* at 136-40.

‘O’ Award for ‘Outstanding Online Retailer’—2009 and 2010; the AVN Award of Excellence—2013; and the AVN Hall of Fame -2011,” Dennis Decl. ¶ 21; that Opposer’s website has received between 2.2 million and 3.3 million unique visitors annually since 2014, Dennis Decl. ¶ 12; and that since 2012 Opposer has “operated the GOOD VIBRATIONS Antique Vibrator Museum within its San Francisco Polk Street store location,” which he describes as “a tourist destination in its own regard, featured in travel guides such as *Frommer’s*, *Atlas Obscura* and *Roadtrippers*.” Dennis Decl. ¶ 15; Exs. 6.1-6.3.

Many companies have “a significant presence on social media,” but this alone does not make their marks famous. Mr. Dennis does not state the reach or exposure of Opposer’s social media accounts in terms of their number of followers, “likes,” or other metrics, or provide the basis for his claim that they are “popular.” Without such context, his testimony about Opposer’s social media presence has little probative value. *See Omaha Steaks*, 128 USPQ2d at 1690 (noting that opposer’s witness specified that opposer had more than 300,000 Facebook followers).

With respect to the industry awards that Opposer has received, Mr. Dennis does not describe their nature, how many companies are eligible to receive them and actually receive them, the criteria for their award and, most importantly, the extent of consumers’ knowledge of the awards.⁷⁴ Without such context, his testimony

⁷⁴ Mr. Dennis does not state whether Opposer has done anything to publicize its status as the recipient of these awards, Dennis Decl. ¶ 21, but the recent pages from Opposer’s website in the record do not identify Opposer as their recipient. Dennis Decl. Ex. 3.1-4.2. By contrast, the website of Lovehoney, one of Opposer’s competitors, offers the Desire vibrator, which the website touts as having been “Voted Best Quiet Vibrator 2019 by Women’sHealth.” Dennis Decl. Ex. 6.4.

regarding the awards does not establish that Opposer's mark is famous, but only that Opposer's "products [and services] are perceived to be of high quality or are recognized only by industry groups." *Spier Wines (Pty) Ltd. v. Shepherd*, 105 USPQ2d 1239, 1245 (TTAB 2012).

Mr. Dennis's testimony regarding the number of annual visitors to Opposer's website establishes that many people visit the site each year and, as noted above, because about 30% of Opposer's sales are online, we can infer that at least some of the visitors purchased goods through Opposer's website. The number of such visitors is quite modest, however, in comparison to such figures in cases in which marks have been found to be famous. *See Weider Publ'ns*, 109 USPQ2d at 1354 (three million monthly unique visitors and other evidence supported finding that opposer's SHAPE mark was famous); *AutoZone*, 100 USPQ2d at 1361-62 (3.4 million visitors per month and other evidence supported finding that petitioner's AUTOZONE mark was famous). We find that the number of annual visitors to Opposer's website has little probative value regarding the fame of its mark.⁷⁵

Finally, Opposer's operation of the Good Vibrations Antique Vibrator Museum within its San Francisco Polk Street store location since 2012 similarly has little

⁷⁵ Applicant argues that this evidence is deficient because there is "[n]o evidence whether any of those 'visits' resulted in a sale, no evidence regarding the percentage those of [sic] 'visits' that were human generated vs. automated 'bot' generated, no evidence regarding the percentage of those 'visits' that lingered rather than immediately bounced, and no evidence regarding the percentage of those 'visits' from people looking for vibrators vs. people searching for the lyrics to the truly-famous Beach Boys *Good Vibrations* hit song." 22 TTABVUE 9. Applicant cites no authority that such granular detail regarding website visits is even collectible, much less that it must be provided to make them probative of the fame of a mark. The number of visitors is what is generally probative of a mark's strength.

probative value regarding the fame of its mark. Although Opposer made of record several articles about the museum, Dennis Decl. Exs. 6.1-6.3, and pages about the museum from Opposer's website at antiquevibratormuseum.com, Dennis Decl. Ex. 6.4, we do not know the number of visitors to the museum (or the museum-specific website), or the extent, if any, to which the museum visitors were separate from customers visiting the store itself.

d. Conclusion Regarding Strength of Opposer's Mark

For the reasons discussed above, and based on the record as a whole, we find that Opposer did not clearly prove that its GOOD VIBRATIONS mark has achieved the level of fame of the marks in the cases that it cites, 21 TTABVUE 30-31,⁷⁶ and the cases that we discuss. As noted above, however, the fifth *DuPont* factor does not involve a binary choice where "fame either does or does not exist," *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, and we must place Opposer's GOOD VIBRATIONS mark along the "spectrum from very strong to very weak." *Id.* We therefore find, on the basis of the record as a whole, that Opposer proved that its mark has some renown

⁷⁶ One of those cases is the Board's non-precedential decision on remand from the Federal Circuit's decision in *Joseph Phelps Vineyards*. 21 TTABVUE 31 (citing *Joseph Phelps Vineyards LLC v. Fairmont Holdings, Inc.*, Canc. No. 92057240, 2019 WL 140540, at *5 (TTAB Jan. 3, 2019)). Opposer argues that the Board's finding that the petitioner's INSIGNIA mark had "achieved, overall, a significant level of fame among consumers of wine," *id.* (quoting *Joseph Phelps Vineyards*, 2019 WL 140540, at *5), was based on "Petitioner's 40 years of use, significant annual sales since 2009, receipt of several awards, and articles referencing Petitioner's mark in general and industry publications." *Id.* We are not bound by this non-precedential decision, and must determine whether Opposer's mark is famous based on the record in this case. We note, in any event, that in *Joseph Phelps Vineyards*, the petitioner's annual sales figures were significantly higher than Opposer's here, and were sustained over a period almost twice as long as the period for which Opposer reported its sales, and that the petitioner's sales figures were given context by the other evidence of record in that case.

and is entitled to more than “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017). The fifth *DuPont* factor thus slightly supports a finding of a likelihood of confusion.

2. Similarity or Dissimilarity of the Goods and Services, and the Channels of Trade

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of the goods in Applicant’s application and registration, and the identification of goods and services in Opposer’s registrations. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

It is “not necessary that the goods [and services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.* (quoting *7-Eleven*, 83 USPQ2d at 1724). Goods may be related to services, and it is

“well established that ‘confusion may be likely to occur from the use of the same or similar marks for *goods*, on the one hand, and for *services* involving those goods, on the other.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1207.01(a)(ii)).

As noted above, Applicant does not address the second and third *DuPont* factors in its brief. The record shows that certain of the involved goods in the opposition are legally identical, and in the cancellation, the goods identified in Applicant’s registration are sold in the same channels of trade through which the services identified in Opposer’s registration are provided.

“We begin with the identifications of goods and services in the registration[s] and application under consideration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019). The goods in Applicant’s application are identified as “Sex toys; Adult sexual stimulation aids, namely, vibrators,” and the goods in Applicant’s registration are identified as “Adult marital and sexual aids, namely, massagers, vibrators and stimulators.” Opposer’s registrations cover goods identified as “adult sexual aids, namely, artificial phalli,” and services identified as “retail and mail order services, featuring, sexually oriented products such as marital aids, electronic devices media and books.”

Applicant admitted that the “sex toys” identified in its application encompass the “artificial phalli” identified in Opposer’s Registration No. 3631427, 16 TTABVUE 19 (Applicant’s Response to Opposer’s Request to Admit No. 26), and those goods are thus legally identical. The “retail and mail order services” featuring “sexually-

oriented products such as marital aids” identified in Opposer’s Registration No. 2040239 expressly involve the sale of “marital aids,” which is a category of goods that is described in Applicant’s registration as including “massagers, vibrators and stimulators.” The services in Opposer’s Registration No. 2040239 thus feature the sale of at least one of the goods, “vibrators,” that is identified in both Applicant’s application and registration.⁷⁷ *Cf. Country Oven*, 2019 USPQ2d 443903, at *5 (“It is a matter of common knowledge that retail bakery shops sell bakery products.”). “We find that the identifications in the application and registration[s] themselves support finding the goods and services are related.” *Id.* at *6.

Opposer also made of record more than 20 active third-party registrations of marks for both online retail store services in the field of sexually oriented products,⁷⁸ and vibrators, which are identified in Applicant’s application and registration. 14 TTABVUE 83-168. They are “relevant to show that the goods and services are of a type that may emanate from a single source under one mark.” *Country Oven*, 2019 USPQ2d 443903 at *8 (citations omitted).

As noted above, the goods identified in Applicant’s application are legally identical to the goods identified in Opposer’s Registration No. 3631427, and the second *DuPont* strongly supports a finding of a likelihood of confusion in the opposition. With respect

⁷⁷ We need not consider the relatedness of each good in Applicant’s application and registration to the goods and services identified in Opposer’s registrations. “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application [and registration].” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

⁷⁸ These goods are identified by various terms in the identifications.

to the cancellation, Opposer must be deemed to be “engage[d] in retail services that sell goods of the type produced by” Applicant, *Detroit Athletic Co.*, 128 USPQ2d at 1051, and the Federal Circuit has “held that confusion is likely where one party engages in retail services that sell goods of the type produced by the other party, as here.” *Id.* (citing *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (finding similarity between furniture and “general merchandise store services,” and rejecting the distinction between goods and services as having “little or no legal significance.”)). The second *DuPont* also supports a finding of a likelihood of confusion in the cancellation.

There are no restrictions on the channels of trade or classes of consumers for the involved goods identified in Applicant’s application, and the legally identical goods in Applicant’s application and Opposer’s Registration No. 3631427 “are presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). The third *DuPont* factor strongly supports a finding of a likelihood of confusion in the opposition.

There are also no restrictions on the channels of trade or classes of consumers for the involved goods identified in Applicant’s registration. They are “presumed to be sold in all normal channels to all the normal classes of purchasers.” *Detroit Athletic*, 128 USPQ2d at 1052. Because those channels include the “retail and mail order services, featuring, sexually oriented products” identified in Opposer’s Registration

No. 2040239, the “trade channels for each mark overlap,” *id.*, and the third *DuPont* factor also supports a finding of a likelihood of confusion in the cancellation.

3. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *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*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019)).

The proper test regarding similarity “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 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

Because certain of the goods in Applicant’s application and in Opposer’s Registration No. 3631427 are legally identical, the degree of similarity between the marks necessary to find a likelihood of confusion in the opposition is reduced. *See, e.g., Viterra*, 101 USPQ2d at 1912; *Mighty Leaf Tea*, 94 USPQ2d at 1260; *Century 21*

Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

a. The Parties' Arguments

Opposer argues that “[w]hen compared in appearance, Opposer’s GOOD VIBRATIONS mark and Applicant’s SWEET VIBRATIONS mark are similar in that they both have the same format, structure and syntax; both being comprised of two words, the first word in each being a short adjective and the second in each being the identical word VIBRATIONS.” 21 TTABVue 37. Opposer further argues that “[a]lthough the words GOOD and SWEET include different letters, they nonetheless look similar to the extent that both are short four/five letter words, include double letters as the only vowels (‘OO’ vs. ‘EE’) and function as an adjective modifying the second term” and that “VIBRATIONS is more substantive and anchoring.” *Id.* Opposer concludes that “the similarities in appearance overshadow the differences.” *Id.* at 38.

With respect to sound, Opposer argues that “the marks share the same rhythm and cadence, both having four syllables, the final three of which would be pronounced the same.” *Id.* Opposer concedes that “‘good’ and ‘sweet’ sound different,” but argues that they “only comprise a single syllable of each mark.” *Id.*

Opposer focuses primarily on the marks’ similarity in meaning. Opposer argues that “[b]oth marks are formed by pairing an adjective with the identical noun VIBRATIONS, in the plural form,” and that “the term ‘vibrations’ has a common recognized meaning of ‘a characteristic emanation, aura, or spirit that infuses or vitalizes and that can be intuitively sensed or experienced’ or ‘a psychological

response especially to aesthetic or emotional stimuli,” and that the phrase “good vibrations” has been defined as a “general emotional feeling one has from another person or a place, situation, etc.’.” *Id.* (quoting [DICTIONARY.COM](http://www.dictionary.com)).

Opposer argues that the “placement of the adjective GOOD before VIBRATIONS further reinforces the connotation of VIBRATIONS to mean a general, emotional feeling or atmosphere that is intuitively sensed.” *Id.* at 39. Citing various dictionary definitions of the adjective “good,” Opposer argues that “when read in its entirety, Opposer’s GOOD VIBRATIONS mark conveys a meaning of a positive, pleasant, favorable, or pleasurable emotional feeling or an atmosphere that is intuitively sensed or experienced by someone.” *Id.*

The gist of Opposer’s argument for the marks’ similarity in meaning is that the “substitution of the term SWEET for GOOD in Applicant’s SWEET VIBRATIONS mark does not create a meaning or connotation that differs from the meaning and connotation of Opposer’s GOOD VIBRATIONS mark.” *Id.* Opposer bases this claim on multiple dictionary definitions of the adjective “sweet,” and its claim that “good” and “sweet” are synonyms “[w]hen used in the context of emotional and extrasensory phenomena.” *Id.* at 40 n.3. Opposer argues that these meanings of the word “sweet” cause Applicant’s mark to “convey[] the identical meaning of a positive, pleasing, agreeable or ‘very good’ emotional feeling or atmosphere that is intuitively sensed or experienced by someone.” *Id.* at 39-40. Opposer also argues that the marks “are constructed in the same way,” as “both begin with short adjectives that are synonymous with pleasing, agreeable and gratifying and end with the identical word

VIBRATIONS,” and that “to the extent either mark has a dominant portion, it is the more distinctive shared term VIBRATIONS.” Opposer concludes that “[t]his significant similarity in the basic format and structure of the two marks, as well as the shared dominant term VIBRATIONS, simply outweighs the [sic] any minor differences in the first words of the two marks.” *Id.*

Applicant responds that “SWEET VIBRATIONS and GOOD VIBRATIONS do not look the same, do not sound the same, and do not convey the same meaning or commercial impression.” 22 TTABVUE 11. According to Applicant, “the differing overall appearance, sound, connotations and commercial impressions of Applicant’s mark and Opposer’s mark outweigh any similarities between the marks.” *Id.*

Like Opposer, Applicant focuses primarily on the marks’ connotations and commercial impressions. Applicant argues that the words GOOD and SWEET in the marks are their dominant portions because those words are the first terms in the marks and because the second word VIBRATIONS in the marks is weak and less significant, 22 TTABVUE 12-13, because it describes a function of vibrators. *Id.* at 14.

Applicant further argues that the “commercial impression created by SWEET VIBRATIONS is different than the commercial impression created by GOOD VIBRATIONS,” *id.*, because the words “good” and “sweet” are not regularly recognized synonyms, *id.*, and because GOOD VIBRATIONS creates a unique commercial impression as the title of a song by The Beach Boys. *Id.* Applicant claims that “it is difficult to imagine the consumer that would encounter Opposer’s GOOD

VIBRATIONS mark and not draw an immediate connection to the Beach Boys’ classic hit.” *Id.* Applicant argues that its “SWEET VIBRATIONS mark creates no such association or commercial impression,” *id.*, because the word “sweet” has a different meaning and different antonyms from the word “good.” *Id.* Applicant concludes that “[s]weet’ and, correspondingly, ‘SWEET VIBRATIONS,’ is simply not interchangeable in meaning with ‘good’ or ‘GOOD VIBRATIONS.’” *Id.*

In its reply brief, Opposer suggests that the marks have no dominant portion because they are “unitary phrases,” 23 TTABVue 9, but argues alternatively that if the marks have dominant elements, they are the shared word VIBRATIONS, not the words GOOD and SWEET. *Id.* at 5. According to Opposer, VIBRATIONS is suggestive, not descriptive, as used in Opposer’s mark, because it “refers to a non-specific emotional feeling or ‘aura,’” because Opposer “sells a range of goods, such as dildos and stimulators, that do not vibrate,” and because the words SWEET and GOOD are neither “a fanciful or arbitrary term” nor otherwise more significant or source-identifying than VIBRATIONS. *Id.* at 7.

Opposer’s reply brief also attacks Applicant’s reliance on The Beach Boys’ song *Good Vibrations* to fix the meaning of Opposer’s mark. Opposer argues that the “fact that the phrase ‘Good Vibrations’ may refer to a single creative work by The Beach Boys in another context has absolutely no bearing on the primary meaning of the phrase when used in connection with Opposer’s wholly different goods and services.” *Id.* at 12. Opposer also claims that Applicant “has failed to provide competent evidentiary support for its claim that The Beach Boys song is either famous or so

ubiquitous that consumers of” its goods and services “would immediately think of ‘The Beach Boys,’ rather than the meaning of the phrase ‘good vibrations’ when they encounter Opposer’s GOOD VIBRATIONS mark.” *Id.* As noted above, Opposer argues that the contents of the articles and other Internet materials on which Applicant relies are hearsay when offered for their truth. *Id.* at 13.⁷⁹ Opposer concludes that

the “Good Vibrations” song by The Beach Boys [sic] wholly irrelevant to the issues in the instant proceedings and does not alter or discount Opposer’s showing that the parties’ marks, when viewed in their entirety and in the context of the parties’ identical and/or highly related goods and services, have a highly similar meaning and commercial impression.

Id.

b. Analysis of Similarity

We first address the parties’ disagreement regarding whether the marks have a dominant portion and, if they do, what it is. The marks must be considered in their entirety, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *Detroit Athletic*, 128 USPQ2d at 1050 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

⁷⁹ Opposer hedges a bit on this position, however, as it cites the contents of two of the articles to support its claim that the *Good Vibrations* title did not create “a new primary meaning for the phrase.” 23 TTABUVE 11-12.

We agree with Applicant that to the extent that its SWEET VIBRATIONS mark has a dominant portion, it is the word SWEET, which is the first word in the mark and modifies the word VIBRATIONS, which has been disclaimed in both its application and Supplemental Register registration as merely descriptive of a feature of the goods identified as vibrators. *See id.* at 1049-50. We find, however, that Opposer's mark GOOD VIBRATIONS does not have a dominant portion. Opposer argues that "the marks in question are unitary phrases," 23 TTABVUE 9, and as discussed below, we find that Opposer's GOOD VIBRATIONS mark is a unitary phrase that is recognized in the American English vernacular, such that neither element has more significance than the other in fixing its meaning. We will compare the marks in their entireties without giving greater or lesser weight to specific elements in either mark.

With respect to appearance, we are unpersuaded by Opposer's arguments that the marks are similar because "both [are] comprised of two words, the first word in each being a short adjective and the second in each being the identical word VIBRATIONS," and because "[a]lthough the words GOOD and SWEET include different letters, they nonetheless look similar to the extent that both are short four/five letter words, include double letters as the only vowels ('OO' vs. 'EE') and function as an adjective modifying the second term." 21 TTABVUE 37. The first argument could also be made with respect to GOOD VIBRATIONS and BAD VIBRATIONS, which are clearly dissimilar in appearance (and otherwise), and the second argument could also be made with respect to GOOD VIBRATIONS and

FLEET VIBRATIONS, which are likewise clearly dissimilar. Although both marks end in VIBRATIONS, the differences in the lead words GOOD and SWEET make the SWEET VIBRATIONS mark appear dissimilar to the GOOD VIBRATIONS mark when the SWEET VIBRATIONS mark is viewed by a consumer familiar with the GOOD VIBRATIONS mark.

As to sound, we reject Opposer's argument that GOOD VIBRATIONS and SWEET VIBRATIONS are similar because each has "four syllables, the final three of which would be pronounced the same." *Id.* at 38. The "final three" syllables in the marks are, of course, the word VIBRATIONS. As with appearance, there is some similarity in the marks' sound because both end in VIBRATIONS, but that similarity is outweighed by the marks' dissimilarity in their entireties. Opposer concedes that the marks' lead words "'good' and 'sweet' sound different," *id.*, and we find that those differences are sufficient to make the SWEET VIBRATIONS mark sound dissimilar to the GOOD VIBRATIONS mark when the SWEET VIBRATIONS mark is heard by a consumer familiar with the GOOD VIBRATIONS mark.

The key issue, to which the parties devote most of their attention, is the similarity of the marks in meaning. The linchpin of Opposer's argument is the claimed similarity of the adjectives "good" and "sweet." As noted above, Opposer argues that GOOD and SWEET are synonyms when they modify VIBRATIONS, causing the marks in their entireties to "convey[] the identical meaning of a positive, pleasing, agreeable or 'very good' emotional feeling or atmosphere that is intuitively sensed or experienced by someone." 21 TTABVUE 39-40. We disagree.

“An individual relies on the recollection of the various marks that he or she has previously seen in the marketplace,” *In re Information Builders Inc.*, 2020 USPQ2d 10444, at *6 (TTAB 2020) (citation omitted), and, as noted above, the average consumer ordinarily has “a general rather than specific impression of marks.” *i.am.symbolic*, 127 USPQ2d at 1630. Here, however, the general impression of Opposer’s mark GOOD VIBRATIONS is likely to be quite specific because the record shows that “good vibrations” is a familiar phrase in colloquial American English.

Opposer argues that the word “vibration” has been defined as a “general emotional feeling one has from another person or a place, situation, etc.,” 21 TTABVUE 38 (quoting DICTIONARY.COM (giving as an example of the meaning of “vibrations” the sentence “I usually get good vibrations from him”)), and that “the definitions of record, including usage examples, illustrate that phrases such as ‘good vibrations’ and ‘good vibes’ have long been in usage.” 23 TTABVUE 11.⁸⁰ Opposer also acknowledges that its mark is identical to the title of The Beach Boys’ song *Good Vibrations*. *Id.* at 11-12. We note in that regard that “the members of this panel independently and spontaneously viewed the [mark] as reminiscent” of *Good Vibrations*. *In re Preifert Mfg. Co.*, 222 USPQ 731, 733 (TTAB 1984) (noting that the panel in that Section 2(e)(1) case had “independently and spontaneously viewed the mark HAY DOLLY as reminiscent of the famous Broadway hit ‘HELLO DOLLY’”). We have no doubt, based

⁸⁰ DICTIONARY.COM defines the noun “vibration” as “[m]eaning ‘intuitive signal about a person or thing’ [that] was popular late 1960s, but has been recorded as far back as 1899.” 14 TTABVUE 17. We take judicial notice that DICTIONARY.COM also defines the phrase “good vibes,” which is used in Opposer’s domain name goodvibes.com, as “a slang phrase for the positive feelings given off by a person, place, or situation.” (dictionary.com, last accessed on June 2, 2020).

in part on the evidence regarding the song adduced by Applicant, that many American consumers, particularly the large cohort of Baby Boomers in the U.S. population, would also immediately view Opposer's GOOD VIBRATIONS mark as reminiscent of the title of The Beach Boys' song, and that for such consumers the mark would evoke the song's music and lyrics. *Cf. Harry Winston*, 111 USPQ2d at 1428 (materials such as articles and Internet webpages "are frequently competent to show, on their face, matters of relevance to trademark claims (such as public perception), regardless of whether the statements [in such materials] are true.").

As discussed above, the parties dispute the song's significance on the issue of similarity of the marks, but even if we accept Opposer's arguments that its founder did not adopt its mark to "reference or invoke the song," 23 TTABVUE 11, and that "there is no evidence that The Beach Boys coined the phrase 'Good Vibrations' or created a primary meaning for the phrase that did not previously exist," *id.*, and reject Applicant's argument that "it is difficult to imagine the consumer that would encounter Opposer's GOOD VIBRATIONS mark and not draw an immediate connection to the Beach Boys' classic hit," 22 TTABVUE 15, the song has probative value on the issue of how Opposer's mark would be understood and recalled by consumers. The song's lyrics, which include the refrains "I'm pickin' up good vibrations, she's giving me excitations," "Good good good good vibrations," and "Gotta keep those lovin' good vibrations a happenin' with her," 18 TTABVUE 24, use the phrase "good vibrations" in its colloquial sense to describe a positive "general emotional feeling one has from another person or a place, situation, etc.'" 21

TTABVUE 38. The *Good Vibrations* title and lyrics thus corroborate what Opposer acknowledges, that the phrase “good vibrations” has “long been in usage,” 23 TTABVUE 11, and accordingly is familiar to most Americans. *Cf. Guantanamera Cigar Co. v. Corparcion Habanos, S.A.*, 729 F. Supp. 2d 246, 98 USPQ2d 1078, 1082 (D.D.C. 2010) (in reversing Board decision sustaining opposition to registration of GUANTANAMERA for cigars on the ground that the mark was primarily geographically deceptively misdescriptive, the District Court agreed that the Board had properly found that the history of the 1960s folk song *Guantanamera* “reinforces the geographic connection [of the mark] to Guantanamo and Cuba.”). While it is possible that some consumers of Opposer’s goods may view Opposer’s mark as a double entendre, we find that because Opposer’s mark consists of the familiar phrase “good vibrations” and, for many consumers, the title of the song *Good Vibrations*, most consumers are likely to recall the mark distinctly and only in its colloquial sense. Indeed, as Opposer puts it, the “GOOD VIBRATIONS mark conveys a recognized meaning of a positive, pleasant, favorable, or pleasurable emotional feeling or an atmosphere that is intuitively sensed or experienced by someone.” 23 TTABVUE 9.

Unlike GOOD VIBRATIONS, Applicant’s mark SWEET VIBRATIONS is not a familiar phrase with a familiar meaning.⁸¹ We thus must determine how it would likely be understood by purchasers of the goods identified in Applicant’s registration

⁸¹ There is no use of “sweet vibrations” comparable to that of “good vibrations” in the multiple definitions of the word “sweet” in the record. 14 TTABVUE 18-34; 18 TTABVUE 10-12.

and application respectively as “Sex toys,” “vibrators,” and “massagers, vibrators and stimulators.”

We begin with the word VIBRATIONS that appears in both marks. In the context of the goods with which Applicant’s mark as a whole is used, the word “VIBRATIONS” does not have the figurative meaning that it has in Opposer’s mark. Opposer acknowledges that

[a]s evidenced by the dictionary definitions of record, the word VIBRATION has multiple meanings that can be easily segregated into two categories: (1) those pertaining to physical occurrences, which meanings include “the act of vibrating”, “the state of being vibrated”, and “the oscillating, reciprocating, or other periodic motion of a rigid or elastic body or medium forced from a position or state of equilibrium” and (2) those pertaining to emotional and extrasensory phenomena, which meanings include “a general emotional feeling one has from another person or a place, situation, etc.” and “a supernatural emanation, bearing good or ill [sic], that is sensed by or revealed to those attuned to the occult.”

23 TTABVUE 6.⁸² As the word VIBRATIONS is used in Applicant’s mark and for Applicant’s vibrators and other identified goods, its meaning fits squarely into Opposer’s first category of “pertaining to physical occurrences,” including “the act of vibrating,” “the state of being vibrated,” and “the oscillating, reciprocating, or other periodic motion of a rigid or elastic body or medium forced from a position or state of equilibrium.” That meaning is buttressed by the USPTO’s treatment of the word in the context of Applicant’s mark.

⁸² Applicant made of record a definition of “vibrator” as “a device, instrument, mechanism, attachment, or organ that vibrates or causes vibration or oscillation, such as . . . a vibrating electrical appliance used in massage or for sexual stimulation” 18 TTABVUE 14 (MERRIAM-WEBSTER DICTIONARY).

During prosecution of the application that matured into Applicant's registration, Applicant was "required to disclaim '**VIBRATIONS**' because such wording appears to be generic in the context of applicant's goods and/or services,"⁸³ based on dictionary definitions of the word "vibrations" as "the action of vibrating; the state of being vibrated or in vibratory motion" such as "(1) oscillation (2): a quivering or trembling motion."⁸⁴ During prosecution of the opposed application, Applicant was similarly required to disclaim "VIBRATIONS" because "the wording merely describes a feature of applicant's goods, namely, that the goods make vibrations" based on a dictionary definition of "vibrations" as "the act of vibrating."⁸⁵

Most of the goods identified in Applicant's registration and application, and particularly Applicant's "vibrators," use "the action of vibrating" to achieve their intended purpose, which, in the colorful words of a portion of Applicant's website submitted by Opposer, is to "help you find your big 'O'." 16 TTABVUE 9.⁸⁶ As with Opposer's mark, it is possible that some consumers of Applicant's goods may view the word VIBRATIONS in Applicant's mark as a double entendre that connotes both "the action of vibrating" and a "general emotional feeling one has from another person or a place, situation, etc.," 21 TTABVUE 38, but we find that it is far more likely that

⁸³ June 28, 2017 Office Action at TSDR 1 (Application Serial No. 87390512).

⁸⁴ *Id.* (citing MERRIAM-WEBSTER DICTIONARY (merriam-webster.com)).

⁸⁵ February 13, 2018 Office Action at TSDR 1 (Application Serial No. 87664722).

⁸⁶ Mr. Dennis's declaration shows that at least one third-party's sex toys are marketed through use of the word "Vibrations" to describe their "action of vibrating." Dennis Decl. Ex. 7.2 ("Trojan Vibrations Divine Multi Speed Vibrating Massager," "Trojan Vibrations Hot Spot Vibrating Ring," "Trojan Vibrations Ultra Touch Intense Personal Massager," "Trojan Vibrations Vibrating Bullet," "Trojan Vibrations Vibrating Pulse Intimate Massager," "Trojan Vibrations Fingertip Massager").

VIBRATIONS would be viewed by most consumers in its literal, not figurative, sense, as describing a feature of the goods, as the USPTO has twice concluded.

The word SWEET in Applicant's mark is commonly used in American English, and has well understood meanings. *Cf. Cooper's, Inc. v. Asahi Kasei Kogyo K.K.*, 153 USPQ 573, 573 (TTAB 1967) (PAIR KNIT and POWER-KNIT found to be dissimilar for clothing because "PAIR' and 'POWER' are common words in everyday use with pronunciations and meanings which, according to any dictionary, are materially different."). Opposer devotes considerable attention to finding a meaning of "sweet" that is synonymous with "good," 21 TTABVUE 39-40, while Applicant counters that "[n]one of the dictionary definitions for 'good' reference the word 'sweet,'" 22 TTABVUE 14, and that "the word 'sweet' is defined as 'being, inducing, or marked by the one of the five basic taste sensations that is usually pleasing to the taste and typically induced by sugars (as sucrose and glucose)," and has as antonyms the words "sour" or "bitter," which "contrast[s] with 'good' whose antonym is 'bad.'" *Id.* at 15.

We agree with Opposer that the taste-related meaning of "sweet" advanced by Applicant does not apply in the context of Applicant's goods, as there is no evidence that they are tasted or ingested. We find, in the context of Applicant's goods, that the most applicable of the many definitions of "sweet" in the record is "pleasing to the senses," 14 TTABVUE 18 (AMERICAN HERITAGE DICTIONARY),⁸⁷ in particular, the sense of touch to which Applicant's vibrators and other goods are directed. In the

⁸⁷ The MERRIAM-WEBSTER THESAURUS lists "good" as a synonym of "sweet" in the context of a subsidiary definition of "sweet" as "giving pleasure or contentment to the mind or senses." 14 TTABVUE 66.

context of Applicant's SWEET VIBRATIONS mark as a whole, the word SWEET causes the mark to connote the tactile pleasure that Applicant's website calls the "big 'O" and that is the desired end result produced by the vibrations of Applicant's "g-spot rockin' vibrators," 16 TTABVUE 9, and other goods when they are applied to the erogenous areas of the body.

That is a different and much earthier connotation than the connotation of GOOD VIBRATIONS as "a positive, pleasing, agreeable or 'very good' emotional feeling or atmosphere that is intuitively sensed or experienced by someone." 21 TTABVUE 39-40. The connotation of SWEET VIBRATIONS is tangible and palpable; the connotation of the familiar expression GOOD VIBRATIONS is abstract and atmospheric. Simply put, when the two marks are considered in their entireties, they give off different "vibes." We find that the marks are different in connotation and commercial impression.

Because the marks differ in appearance, sound, and connotation and commercial impression, the first *DuPont* factor weighs strongly against a finding of a likelihood of confusion.

4. Conditions of Purchase

"The fourth DuPont factor considers '[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing.'" *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). In *Stone Lion*, the Federal Circuit recognized that "Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'" *Id.* at 1163 (quoting *Gen. Mills*, 100 USPQ2d at 1600).

Applicant admits that its goods “are typically purchased by ordinary consumers exercising no more than ordinary care,” 16 TTABVUE 17 (Applicant’s Response to Opposer’s Request to Admit No. 10), but Opposer goes further and argues that “adult toys and sexual aids are often impulse purchases,” and that “[b]ecause adult toys and sexual aids are inexpensive impulse items and consumers do not exercise a high degree of care in their purchasing decisions, the conditions of purchase weigh in favor of finding a likelihood of confusion.” 21 TTABVUE 36.

The record does not show that adult toys and sexual aids are typically impulse purchase items due to their low cost or otherwise. Mr. Dennis acknowledged as much when he testified that “the typical consumer” of the involved goods and services “is a member of the general public who possesses no specialized knowledge or expertise with regard to retail services featuring adult toys and sexual aids and who exercises no more than ordinary care in making their purchases.” Dennis Decl. ¶ 25. He further testified, without elaboration, that “adult toys and sexual aids are often impulse purchases,” Dennis Decl. ¶ 25, and stated that “[a]dult toys and sexual aids can be bought by the general public online or off the shelf via retail and mass merchandisers (including CVS, Walmart and Amazon.com) under conditions in which consumers will not take great care in making their purchase,” Dennis Decl. ¶ 26, and that “[a]dult toys and sexual aids are typically priced at retail anywhere from under \$10 to more than \$25 per items.” Dennis Decl. ¶ 27; Exs. 7.1-7.3.

The record shows that the prices for the goods identified in Opposer’s registrations and Applicant’s registration and application vary significantly. Applicant’s website

offers sex toys from as low as \$12 to as high as \$170, Dennis Decl. Exs. 3.1-3.2, and the goods range in price from as low as \$6.95 to as high as \$219.99 on third-party websites, Dennis Decl. Exs. 5.2-5.3, 7.1, and from as low as \$8.99 to as high as \$238.99 on retailer websites. Dennis Decl. Exs. 7.2-7.3.

Because the involved identifications of goods are not limited to any particular price points, we must assume that they include low-priced goods, but low prices per se are not determinative of whether goods are impulse purchase items. “[T]he significance of the price of applicant’s products must be weighed against other factors such as the type of product” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1744 (TTAB 2014) (finding that low prices of dietary supplements “do not necessarily imply a low degree of consumer care in the selection of [the goods] where the prospective consumers would be expected to exercise a reasonable degree of care regarding the products that they ingest to improve their health.”). *See Recot*, 54 USPQ2d at 1898 (“When products are relatively low-priced **and** subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”) (emphasis added); *cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1933 (TTAB 2011) (“ice cream bars and fruit bars are inexpensive products and by their very nature, are impulse purchase items.”).

Vibrators and similar products are personal items used by consumers for the sexual stimulation of their private parts.⁸⁸ Opposer’s website states that its

⁸⁸ The intimate nature of the goods is illustrated by pages on both Opposer’s and Applicant’s websites. One page on Opposer’s site advertises the \$129 Moxie vibrator by We-Vibe as

“Customer Service Representatives are highly trained and very knowledgeable about the products we carry” and that “we can help you select the products that are right for you.” Dennis Decl. Ex. 3.3. The website also displays multiple reviews by consumers who took the time to discuss their personal experiences with Applicant’s products, Dennis Decl. Exs. 4.1, 5.1, and promotes a \$16 Bliss Bullet vibrator as having “an easy to use dial control that allows you to customize your sensational experience from ‘mmm’ mild to ‘wow’ wild!” and as being “[p]erfect for first time vibe users and aficionados alike” Dennis Decl. Ex. 4.1. Contrary to Mr. Dennis’s conclusory testimony, Dennis Decl. ¶ 25, this evidence strongly suggests that even the least sophisticated purchasers of the goods, such as the “first time vibe users” mentioned on Opposer’s website, would not typically buy them “impulsively or carelessly, as would be the case of a child purchasing candy or a toy.” *Inter IKEA Sys.*, 110 USPQ2d at 1744 (quoting *Stouffer Corp. v. Health Valley Natural Foods, Inc.*, 1 USPQ2d 1900, 1902 (TTAB 1986)). We find that the typical purchaser of the involved goods is likely to exercise ordinary care, and that the fourth *DuPont* factor is neutral in our analysis of a likelihood of confusion.

follows: “Enjoy sexy and discreet vibrations anywhere you like with this wearable, Bluetooth-controlled vibrator. Slender and contoured, Moxie slips easily and comfortably under your clothes.” Dennis Decl. Ex. 3.1. Another page promoting Opposer’s vibrators and pulsators states that “[v]ibrators are a fantastic way to explore your sexuality, either through solo play or with a partner.” Dennis Decl. Ex. 3.2. Applicant’s home page states that “Sweet Vibrations is an adult boutique that delivers innovative intimate lifestyle products that give its customers a moment [or moments] of complete sexual bliss.” 16 TTABVUE 5.

5. Absence of Evidence of Actual Confusion

The eighth *DuPont* factor is “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Guild Mortg.*, 129 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). Applicant’s argument on this factor is notable for its brevity: “The record contains no evidence of actual confusion between Opposer’s GOOD VIBRATIONS mark and Applicant’s SWEET VIBRATIONS mark.” 22 TTABVUE 15. Opposer argues that there has been insufficient opportunity for actual confusion to have occurred because “in the short two-year period in which Applicant’s mark has allegedly been in use, sales under the mark have been minimal.” 21 TTABVUE 41. We agree. “In the absence of a significant opportunity for actual confusion to have occurred, the absence of actual confusion is of little probative value in this case.” *Barbara’s Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007). The absence of evidence of actual confusion is due at least in part “to the minimal scope of applicant’s actual use of [its] mark in the marketplace.” *Id.* We find that the eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

6. Balancing the *DuPont* Factors

The first *DuPont* factor weighs strongly against a finding of a likelihood of confusion. The second and third *DuPont* factors strongly support a finding of a likelihood of confusion in the opposition and also support such a finding in the cancellation, and under the fifth *DuPont* factor, Opposer’s GOOD VIBRATIONS mark is entitled to somewhat more than the normal scope of protection to which an

inherently distinctive mark is entitled. The fourth and eighth *DuPont* factors are neutral.

Any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. In fact, in some cases, a single factor, particularly the first factor, may be dispositive. *Pack'em Enters.*, 21 USPQ2d at 1144-45. We find that the marks are sufficiently dissimilar in meaning and commercial impression that confusion is unlikely even taking into account the reduced degree of similarity required for confusion to be likely in the opposition, and we conclude that the first *DuPont* factor is so pivotal as to outweigh the other factors discussed above in our analysis of the likelihood of confusion in both proceedings. *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *13 (TTAB 2020) (citing *Champagne Loius Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998); and *Pack'em Enters.* 21 USPQ2d at 1144-45). Accordingly, we find that Opposer did not prove, by a preponderance of the evidence in either proceeding, that confusion is likely.

Decision: The Notice of Opposition in Opposition No. 91241053 is dismissed and the Petition for Cancellation in Cancellation No. 92068505 is denied.