

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: August 19, 2021

Mailed: January 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
—

*Alzheimer's Disease and Related Disorders Association, Inc.*

*v.*

*Alzheimer's New Jersey*

—  
Opposition No. 91245121  
—

Shima S. Roy of Baker & McKenzie LLP, for Alzheimer's Disease and Related Disorders Association, Inc.

Joseph M. Franck and Lisa D. Taylor of Inglesino, Webster, Wyciskala & Taylor, LLC, for Alzheimer's New Jersey.

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**Notice of Correction**

By the Board:

On December 31, 2021, the Board mailed a final decision in this proceeding sustaining the opposition. It has come to the Board's attention that page 5 of the decision erroneously indicated that the opposition was dismissed, and misidentified the professional role of Opposer's first witness. Attached hereto is a corrected form of the December 31, 2021 decision.

The time for filing an appeal or commencing a civil action by either party regarding the Board's decision continues to run from the mailing date of the December 31, 2021 decision. *See* Trademark Rule 2.145(d)(1), 37 C.F.R. § 2.145(d)(1).

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for Alzheimer's Disease and Related Disorders Association, Inc.

Joseph M. Franck and Lisa D. Taylor of Inglesino, Webster, Wyciskala & Taylor,  
LLC, for Alzheimer's New Jersey.

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Before Mermelstein, Coggins, and Lebow,  
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Alzheimer's New Jersey ("Applicant") seeks registration on the Principal Register  
of the composite mark shown at right for

Charitable foundation services, namely, providing fundraising activities to support medical research and procedures for those in need; Charitable fundraising; Charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Alzheimer's care and research; Charitable fundraising



services for Alzheimer's care and research; Charitable fundraising services; Charitable fundraising services by means of organizing and conducting special events; Charitable fundraising services by means of organizing walks and other special events for Alzheimer's; Charitable fundraising services for promoting research, education and other activities relating to Alzheimer's care and research; Charitable fundraising to support Alzheimer's care and research; Charitable services, namely, fundraising services by means of organizing special events for Alzheimer's care and research; On-line charitable fundraising, in International Class 36.<sup>1</sup>

According to the application, the colors purple and white are claimed as features of the mark; and ALZHEIMER'S, NEW JERSEY, and the pictorial representation of the state of New Jersey are disclaimed.<sup>2</sup>

In the Amended Notice of Opposition,<sup>3</sup> Alzheimer's Disease and Related Disorders Association, Inc. ("Opposer") opposes registration of Applicant's mark on the bases of likelihood of confusion under Section 2(d) and dilution under Section 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) & 1125(c). Opposer claims ownership of Registration No. 4122255 on the Principal Register for the standard-character mark

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<sup>1</sup> Application Serial No. 87797112 was filed on February 14, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as September 1, 2017.

<sup>2</sup> The application also contains the following description of the mark: "The mark consists of [a] purple background with stylized white wording 'Walk to Fight Alzheimer's' in Oswald Bold font all in capital letters with the white colored wording 'Walk to' appearing above the white colored term 'Fight' which appears above the white colored term 'Alzheimer's'. To the left of the wording 'Walk to Fight Alzheimer's' is the depiction of a pair of purple sneakers with white untied shoe laces and white toes with a purple outline of the sneakers on each of the sneakers."

<sup>3</sup> 20 TTABVUE. Citations to the record and briefs reference TTABVUE, the Board's online docket system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, \*2 n.1 (TTAB 2020).

WALK TO END ALZHEIMER'S (with WALK and ALZHEIMER'S disclaimed) for

Charitable fundraising, namely, raising money to support educational and informational programs on Alzheimer's disease and to support scientific research on Alzheimer's disease; charitable fundraising services in the nature of a pledged walkathon, in International Class 36;<sup>4</sup>

and prior common law use since September 1, 2011 of the composite mark shown at right (the "logo mark"), for which Opposer has filed application Serial No. 88209214 reciting the same services as in its registration, and in which WALK, ALZHEIMER'S, and ASSOCIATION have been disclaimed.<sup>5</sup>



In its answer, Applicant denied the salient allegations of the Amended Notice of Opposition and alleged that the claims are barred under the prior registration or *Morehouse* defense, see *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969), based on Applicant's ownership of the following two registered marks:

- Registration No. 5053635 for the standard-character mark WALK TO FIGHT ALZHEIMER'S (with WALK and ALZHEIMER'S disclaimed) for

Charitable fundraising; Charitable fundraising services; Charitable fundraising services by means of running and walking events; Charitable fundraising services by means

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<sup>4</sup> Registration No. 4122255 was registered April 3, 2012; Sections 8 and 15 combined declaration accepted and acknowledged.

<sup>5</sup> Board records indicate that Opposer's application Serial No. 88209214 is currently subject to an opposition proceeding filed by Applicant on the ground of misuse of the federal registration symbol. The proceedings are in different procedural postures with different substantive issues and have not been consolidated. As discussed later in this decision, Applicant did not raise the affirmative defense of misuse of the federal registration symbol in this proceeding.

of organizing and conducting special events; Charitable fundraising services for promoting research, education and other activities relating to Alzheimer's; Charitable fundraising to support Alzheimer's research and care; Charitable foundation services, namely, providing fundraising activities to support medical research and procedures for those in need; Charitable services, namely, fundraising services by means of organizing special events for Alzheimer's; Memorial fundraising; On-line charitable fundraising, in International Class 36; and

- Registration No. 5373234 for the composite mark shown below (with



ALZHEIMER'S NEW JERSEY, the depiction of the State of New Jersey, WALK, and ALZHEIMER'S (disclaimed) for

Charitable fundraising; Charitable fundraising services; Charitable fundraising services by means of running and walking events; Charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Alzheimer's research and care; Charitable fundraising services by means of organizing and conducting special events; Charitable fundraising services by means of organizing walks and other special events for Alzheimer's care and research; Charitable fundraising services for promoting research, education and other activities relating to Alzheimer's; Charitable fundraising services for support of Alzheimer's research and care; Charitable fundraising to support Alzheimer's research and care; Charitable foundation services, namely, providing fundraising activities to support medical research and procedures for those in need; Charitable services, namely, fundraising services by means of organizing special events for Alzheimer's research and care; On-line charitable fundraising, in International Class 36.

The colors purple, green and white are claimed as a feature of the mark.<sup>6</sup>

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<sup>6</sup> Applicant also asserted laches, estoppel, and acquiescence as affirmative defenses in its Answer but did not pursue them as individual or separate defenses (apart from the

As Applicant succinctly states in its brief, “[t]he substantive issues before the Board in this proceeding are (1) whether Opposer has established that Applicant’s Mark is likely to cause confusion [with Opposer’s marks]; (2) whether Opposer has established that Applicant’s Mark is likely to dilute Opposer’s Marks; and (3) whether . . . Applicant’s *Morehouse* defense[] mandate[s] dismissal of Opposer’s Opposition.”<sup>7</sup> The case is fully briefed. An oral hearing was held on August 19, 2021. For the reasons explained below, we sustain the opposition.

## I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s application. The parties introduced the testimony and evidence listed below:

### A. Opposer’s Testimony and Evidence

- Testimony declaration of Mary Faley Garza, Opposer’s Operations Lead for Development, with Exhibits A-T (25 TTABVUE);

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*Morehouse* defense) in its final brief, so they are waived. *See TPI Holdings, Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1413 n.28 (TTAB 2018); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014).

While Applicant asserted in its answer a non-commercial use exception to the dilution ground under Section 43(c)(3)(C), 15 U.S.C. § 1123(c)(3)(C), it too was not pursued and is otherwise inapplicable to this proceeding. *See N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1508-09 (TTAB 2015); *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1298 (TTAB 2010).

Applicant also raised a litany of other purported affirmative defenses, but they are mere amplifications of its denials and not true affirmative defenses, so we do not address them as such. *See, e.g., DeVivo v. Ortiz*, 2020 USPQ2d 10153, at \*1 (TTAB 2020). Likewise, we do not address the “defense” of failure to state a claim, which was not pursued. *See John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010).

<sup>7</sup> Applicant’s Brief, p. 4 (54 TTABVUE 11).

- Rebuttal testimony declaration of Ms. Garza, with Exhibits A-N (50 TTABVUE);
- Testimony declaration of Wendy Vizek, Opposer’s Senior Director of Constituent Events, with Exhibits A-AA (30-31 TTABVUE);
- Testimony declaration of Rachel Fuller, Opposer’s Vice President, Marketing, with Exhibits A-T (35 TTABVUE);
- Cross-Examination Deposition Transcript of Kenneth Zaentz, Applicant’s President and CEO, with Exhibits 1-22 (51 TTABVUE);
- First Notice of Reliance on USPTO electronic database records for Registration No. 4122255 and application Serial No. 88209214 (27 TTABVUE);
- Second Notice of Reliance on Applicant’s responses to Interrogatory Nos. 7, 10 & 11, and Requests for Admission Nos. 1, 2, 33, & 51 (28 TTABVUE);
- Third Notice of Reliance on various materials printed from the Internet and one printed publication (29 TTABVUE); and
- Fourth Rebuttal Notice of Reliance on materials printed from Applicant’s website and Applicant’s Facebook and Instagram pages (49 TTABVUE).

B. Applicant’s Testimony and Evidence

- Testimony declaration of Kenneth Zaentz, with Exhibits A-CC (37 TTABVUE);
- First Notice of Reliance on Opposer’s Responses to Request for Admission Nos. 14-16, 26, 28, 30, 32-34, 36-38, 40, 42, 44-46, 48-54, & 56, and Interrogatory Nos. 1-8, 10, 12-19, & 21; various “produced documents”<sup>8</sup>; dictionary definitions; an Internet article; and documents from a judicial proceeding in New Jersey (38 TTABVUE);

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<sup>8</sup> The Notice of Reliance does not specify whether the documents were produced by Applicant or Opposer, nor to which specific discovery request they pertain, but a few of the documents appear to be Applicant’s. A party may not rely on its own documents produced during discovery unless they are self-authenticating or are otherwise properly authenticated by declaration or affidavit. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.11 (2021) and authorities cited therein.

- Second Notice of Reliance on USPTO electronic database records for Applicant's pleaded Registration Nos. 5053635 & 5373234, and four unpleaded registrations on the Supplemental Register also owned by Applicant for composite marks incorporating the words ALZHEIMER'S NEW JERSEY and the outline of the state of New Jersey (39 TTABVUE);
- Third Notice of Reliance on third-party registrations, documents purporting to show third-party use of walk-related marks and materials, and documents purporting to show third-party use of the color purple and "walk to" marks (40 TTABVUE); and
- Fourth Notice of Reliance on USPTO electronic database records for additional third-party registrations (41 TTABVUE).

## II. Evidentiary Issues

Before considering the merits of the case, we discuss the parties' objections to certain evidence.

### A. Opposer's Objections

Opposer objects to Exhibits G and H to the testimony declaration of Kenneth Zaentz<sup>9</sup> comprising a motion hearing transcript, final judgment orders, and an appellate order with transcript of the bench decision, relating to the determination of a beneficiary (as between Applicant and Opposer) in two New Jersey state probate matters. Applicant argues that the exhibits are relevant to this opposition proceeding because, among other things, they demonstrate the nature of the Applicant and Opposer's relationship.<sup>10</sup>

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<sup>9</sup> 52 TTABVUE 55-56 (objection); 37 TTABVUE 52-83 (Ex. G) & 84-112 (Ex. H).

<sup>10</sup> 54 TTABVUE 66.



The motion hearing transcript (in the *Morris* estate proceeding) does not qualify as an official record as there is no indication that it was ever filed with the court.<sup>11</sup> *Cf. 7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.3 (TTAB 2007) (party's file copy of document from Board proceeding does not constitute official record); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (same). However, the court orders are acceptable and admissible as official records under Trademark Rule 122(e), 37 C.F.R. § 2.122(e), and we will allow that portion of the decision transcript (in the *DeConca* estate proceeding) for which the court indicated that it was "putting [its] decision on the record."<sup>12</sup> Nonetheless, the admissible documents are in no way binding on us as they were based on the record before those courts and deal with matters of probate. We sustain Opposer's objection to the hearing transcript from Exhibit G, but overrule the objection to the other matter.

#### B. Applicant's Objections

Applicant objects to numerous exhibits introduced by Opposer under the theory that the documents were responsive to at least one of the following three requests for discovery but not provided:

Request No. 3. Documents relating to the strength of the Opposer's mark, or public recognition, including, without limitation, surveys, questionnaires, reports, or market studies;

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<sup>11</sup> At any rate, we would not accept the arguments contained in that motion hearing transcript as evidence of the proof of any fact because the matter constitutes hearsay. 7 Fed. R. Evid. 801(c). As Applicant concedes, the transcript does "not contain any testimony." 55 TTABVUE 66.

<sup>12</sup> 37 TTABVUE 98

Request No. 4. All forms of advertisement and other promotional materials which demonstrate Opposer's use of Opposer's Mark inside and/or outside of the United States; and

Request No. 8. Identify and produce any and all documents that will be presented at Trial.<sup>13</sup>

Opposer argues that many of the documents to which Applicant objects relate to third-party publications, Applicant's own website, and Applicant's own social media pages which were not within Opposer's possession, custody, or control.<sup>14</sup> This is an acceptable excuse for several of the exhibits. *See Société des Produits Nestlé S.A. v. Taboada*, 2020 USPQ2d 10893, \*7 (TTAB 2020) (citing *Pioneer K.K. v. Hitachi High Tech. Am., Inc.*, 74 USPQ2d 1672, 1680 (TTAB 2005)); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013) (no obligation to search for and produce third-party material).

As a general comment to Request No. 8, there is no requirement that an adverse party provide in discovery any and all documents on which it intends to rely; it need produce only those documents that are validly part of initial or pre-trial disclosures, or have been requested pursuant to a valid discovery request; thus, a party is not precluded from making evidence of record simply because it was not provided to the adverse party during discovery. *See e.g., Carefirst of Md. Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005); *Time Warner Ent. Co. v. Jones*,

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<sup>13</sup> *See* 54 TTABVUE 58-63, 71-72.

<sup>14</sup> 56 TTABVUE 29.

65 USPQ2d 1650, 1656 (TTAB 2002). We therefore deny Applicant's objections based on Request No. 8.

We also note that in response to Request Nos. 3 and 4, Opposer directed Applicant to Opposer's website and stated that "[s]ubject to its general and specific objections, Opposer will produce responsive, non-privileged documents, if any exist."<sup>15</sup> Opposer did not respond that no such documents existed. Rather, Opposer stated that it would produce documents related to strength, public recognition, and advertisements, "if any," and objected to providing such documents on certain specific grounds. Fed. R. Civ. P. 34(b)(2)(B)-(C); *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, \*9-10 (TTAB 2019) (in responding to document requests "a party must state whether or not it has responsive documents in its possession, custody or control and, if it does, state the documents will be produced by a specified date or they are being withheld, based on a claim of privilege or a specified objection"). Applicant could have filed a motion to compel proper responses and challenge Respondent's objections if it so desired, but it did not. See *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

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<sup>15</sup> 54 TTABVUE 71.

As to Applicant's objection to Opposer's annual report submitted as Vizek Ex. T, and the fiscal year 2020 media plan submitted as Fuller Ex. N, Opposer explains that the documents were not in existence until after discovery closed. While the better practice would have been for Opposer to supplement its discovery responses when the sought-after documents came into its possession, we decline to apply the sanction of estoppel for failure to supplement discovery. Had Applicant objected promptly after Opposer's testimony declaration and exhibits were filed, this procedural objection could have been cured. *See Société des Produits Nestlé v. Taboada*, 2020 USPQ2d 10893 at \*7; *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014).

Applicant also objects to nine portions of the cross-examination of Mr. Zaentz as beyond the scope of his direct testimony declaration which Applicant argues was limited to six general topics.<sup>16</sup> Opposer counters that Applicant grossly oversimplifies Mr. Zaentz's declaration, which comprised 105 paragraphs and included 30 exhibits.<sup>17</sup> It appears that most of the cross-examination is related to subjects in Mr. Zaentz's declaration. Since we are capable of discerning admissible and relevant trial testimony from non-admissible trial testimony, including scope of examination, we overrule Applicant's objection and give the cross-examination testimony the appropriate probative weight it deserves. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017); *Hunt Control Sys. Inc. v.*

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<sup>16</sup> 54 TTABVUE 63-65.

<sup>17</sup> 56 TTABVUE 40.

*Koninkijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011) (“[T]he Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.”).

### III. Entitlement to a Statutory Cause of Action

A plaintiff’s entitlement to a statutory cause of action, formerly referred to as “standing,”<sup>18</sup> must be established in every inter partes case before the Board. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, \_\_\_ U.S. \_\_\_ (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)), *reh’g en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *petition for cert. denied* (Oct. 4, 2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Spanishtown Enters. v. Transcend Res.*, 2020 USPQ2d 11388 at \*1-2. A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by registration of the mark. *See Peterson v.*

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<sup>18</sup> Board decisions previously analyzed the requirements of Section 13 of the Trademark Act, 15 U.S.C. § 1063, under the rubric of statutory “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, \*1-2 (TTAB 2020).

*Awshucks SC, LLC*, 2020 USPQ2d 11526, at \*6 (TTAB 2020) (citing *Corcamore*, 2020 USPQ2d 11277, at \*6-7); *Spanishtown Enters.*, 2020 USPQ2d 11388, at \*1.

The parties are no strangers to each other. For thirty years, between 1985 and 2015, Opposer and Applicant were affiliated;<sup>19</sup> and since 1998 the parties' relationship was governed by a Statement of Relationship which, inter alia, granted to Applicant a non-exclusive license to use Opposer's trademarks.<sup>20</sup>

Opposer's entitlement "is established with respect to its likelihood of confusion and dilution claims by its registration [of the standard-character mark WALK TO END ALZHEIMER'S] . . . which the record shows to be valid and subsisting, and owned by Opposer."<sup>21</sup> *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d at 1501 (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). See also *Primrose Ret. Cmty., LLC v. Edward Rose Sr. Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (standing established based on pleaded registration made of record).



Opposer's entitlement is also established through use of its logo mark  as demonstrated by the uncontradicted declaration testimony of, inter alia, Ms. Garza, Opposer's Vice President, Marketing, who attests that Opposer has been using the logo mark in connection with charitable fundraising, including a pledged walkathon, for Alzheimer's educational and informational programs and scientific research on

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<sup>19</sup> Zaentz Decl. ¶ 11, 31 (37 TTABVUE 6, 9).

<sup>20</sup> Id. ¶ 12; Ex. A, Statement of Relationship ¶ 6.1(a) (37 TTABVUE 6, 26).

<sup>21</sup> 27 TTABVUE 148-152 (registration).

Alzheimer's disease since at least as early as September 1, 2011.<sup>22</sup> *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*4 (TTAB 2019) (standing established by testimony, with exhibits, of use of confusingly similar mark); *Grand Canyon W. Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008) (standing established by testimony as to prior use of similar mark); *see also Liqwacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value).

We find the foregoing unrebutted testimony sufficient to establish that Opposer has a real interest in this proceeding and is not a mere intermeddler. Testimony of a party alone is sufficient to create an entitlement to bring a statutory cause of action. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009); *Panda Travel Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1793 (TTAB 2009).

#### IV. Prior Registration Affirmative Defense


As noted above, Applicant raised a prior registration affirmative defense. The prior registration defense, also known as a *Morehouse* defense, is an equitable doctrine that applies where an applicant owns a prior registration for the same or substantially identical mark for the same or substantially identical goods or services

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<sup>22</sup> Garza Decl. ¶¶ 16, 19-21 (25 TTABVUE 8-9).

that are the subject mark and goods or services of the later application. *Morehouse Mfg. Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). In such case, “the opposer cannot be further injured because there already exists an injurious registration,” and therefore the additional registration does not add to the injury. *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); *Mag Instrument, Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1711 (TTAB 2010).

We quickly dispatch this defense because for *Morehouse* to be applicable, it requires that the plaintiff not be able to cancel the prior registration. *See Morehouse*, 160 USPQ at 717 (“Implicit in this [defense] are the corollaries that if opposer cannot procure the cancellation of the existing registration it cannot prevent the granting of the second registration; that there is no added damage from the second registration of the same mark if the goods named in it are in fact the same; and that if there is no added damage, there is no ground for sustaining the opposition.”). Here, Applicant

relies on its prior Registration No. 5373234 for the composite mark  which was registered on January 9, 2018.<sup>23</sup> Inasmuch as the registration is less than five years old, it is still possible for Opposer to procure cancellation under Section 2(d) of the Trademark Act. 15 U.S.C. § 14 (Cancellation). *See Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018) (“Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), provides a ground for cancellation of a registration that has been on the

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<sup>23</sup> 54 TTABVUE 21-27 (argument); 39 TTABVUE 68, 71 (registration).



Principal Register for fewer than five years on the basis of a petitioner’s ownership of a mark or trade name previously used in the United States . . . and not abandoned, and a likelihood of confusion.”) (cleaned up). *Cf. Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (*Morehouse* defense not available if opposing party also petitions to cancel the earlier registration). Accordingly, we find that the *Morehouse* defense is unavailable to Applicant in this proceeding.<sup>24</sup>

## V. Analysis of Section 2(d) 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).

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<sup>24</sup> Were Registration No. 5373234 more than five years-old, we would find *Morehouse* inapplicable on substantive grounds because the prior and current marks are not the same or substantially identical, a determination based on a comparison of the marks in their entireties. “No part of the mark can be ignored in comparing the marks as a whole.” *O-M Bread v. U.S. Olympic Comm.*, 36 USPQ2d at 1045 (internal citation omitted). Here, when the marks are compared in their entireties, we notice immediately that there is no background in the prior mark, the colors purple, green, and white are features of that mark and duly claimed as such, and the largest literal element (i.e., the word “fight”) is presented in green and therefore visually emphasized. However, the later mark is presented with all-white lettering and elements against a solid purple background, the colors purple and white are claimed as features of the mark, and there is no green and consequently no additional emphasis on “fight.” *See Mag Instrument*, 96 USPQ2d at 1711 (“the two marks must be ‘substantially identical,’ meaning that they are either literally identical or legally equivalent.”); *S&L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1226 (TTAB 1987).

### C. Priority

In an opposition under Section 2(d), priority may be satisfied with a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at \*3 (TTAB 2020) (citing *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002)).

#### 1. Opposer's Registered Standard-Character Mark

As noted above, Opposer made of record its valid and subsisting pleaded Registration No. 4122255 on the Principal Register for the standard-character mark WALK TO END ALZHEIMER'S for "charitable fundraising, namely, raising money to support educational and informational programs on Alzheimer's disease and to support scientific research on Alzheimer's disease; charitable fundraising services in the nature of a pledged walkathon,"<sup>25</sup> and Applicant did not counterclaim to cancel it, so "priority is not at issue for the mark[ ] and the [services] . . . identified in" that registration. *New Era Cap v. Pro Era*, 2020 USPQ2d 10596, at \*9 (citing *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)). Indeed, Applicant specifically states that "[it] does not challenge Opposer's priority with respect to Opposer's [standard-character m]ark."<sup>26</sup>


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<sup>25</sup> See 27 TTABVUE 148-152 (registration).

<sup>26</sup> 54 TTABVUE 20.

## 2. Opposer's Unregistered Logo Mark



Opposer also pleaded use of its logo mark  in connection with the same services identified in the registration since at least as early as September 1, 2011.<sup>27</sup> Applicant argues that inasmuch as “Opposer’s [logo m]ark is not registered and is the subject of an ongoing opposition that seeks to prevent the registration of Opposer’s [logo m]ark . . . Opposition No. 91253700. Therefore, it is respectfully submitted that priority has not been firmly established with respect to Opposer’s [logo m]ark.”<sup>28</sup> That is all Applicant says on the matter in its brief.

As noted earlier, Applicant’s opposition to Opposer’s logo mark in pending Opposition No. 91253700 claims misuse of the federal registration symbol. An allegation that a party misused the federal registration symbol with the fraudulent intent to deceive the consuming public may be asserted as a “species of the equitable affirmative defense of unclean hands.” *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007). Applicant’s original answer, filed January 3, 2019, in this proceeding did not allege misuse of the federal registration symbol as a defense.<sup>29</sup> Similarly, Applicant’s answer to the amended notice of opposition, filed June 18, 2020 – six months after Applicant filed Opposition No. 91253700 against Serial No. 88209214 for Opposer’s pleaded logo mark<sup>30</sup> – did not allege misuse of the

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<sup>27</sup> Amended Notice of Opposition ¶ 4 (20 TTABVUE 3).

<sup>28</sup> 54 TTABVUE 20. That is all Applicant says on the matter of priority of Opposer’s logo mark.

<sup>29</sup> See 4 TTABVUE (Answer).

<sup>30</sup> Opposition No. 91253700 was filed January 29, 2020, and Applicant originally alleged as its sole ground an unrecognized claim that the declaration to the power of attorney filed

federal registration symbol as a defense;<sup>31</sup> nor did Applicant move to amend its answers to allege this defense. Further, Applicant made no attempt to prove the unpleaded misuse defense in this proceeding, and the parties have not tried the unpleaded defense by implied consent within the context of the current proceeding.

We also note that Applicant's original notice of opposition in Opposition No. 91253700 was dismissed for failure to state a claim, but Applicant was allowed time in which to correct its defective pleading. Applicant took that opportunity on August 27, 2020 – which was after the first testimony period had closed in this proceeding<sup>32</sup> – and repleaded fraudulent misuse of the federal registration as the sole ground for opposition. Inasmuch as Applicant did not plead the misuse defense in this proceeding, Applicant did not substantively argue or attempt to prove the defense in this proceeding, and the parties did not try the defense by implied consent, we will not consider the misuse defense in the context of this proceeding.

At trial, Ms. Garza provided uncontroverted testimony, with supporting historical financial exhibits, that Opposer has used the logo mark in connection with charitable fundraising, including a pledged walkathon, for Alzheimer's educational and informational programs and scientific research on Alzheimer's disease since at least

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during the prosecution of the application “is improper” in that it states that Opposer “is the owner of a mark that is sought to be renewed” even though the mark “has never been registered and as such is not currently eligible for renewal.” *See* 1 TTABVUE 3-4 in Opposition No. 91253700.

<sup>31</sup> *See* 4 TTABVUE (Answer to Amended Notice of Opposition).

<sup>32</sup> *See* 19 TTABVUE 18 (trial scheduling order).

as early as September 1, 2011.<sup>33</sup> Similarly, Ms. Vizek, Opposer’s Senior Director of Constituent Events, provided uncontroverted testimony, with representative website pages, that Opposer has used the logo mark for peer-to-peer fundraising walk events, corporate sponsorships, and donations since 2011.<sup>34</sup> Ms. Fuller, Opposer’s Vice President, Marketing, also declared that Opposer began using the logo mark in association with fundraising events as early as September 2011, and provided representative samples of print advertising and website pages displaying the logo mark in connection with fundraising services as far back as 2013.<sup>35</sup> In addition, Applicant admitted in response to Request for Admission No. 2 that Opposer’s “use of [its] goods and services in connection with Opposer’s [logo m]ark predates Applicant’s use of Applicant’s goods and services in connection with Applicant’s [m]ark.”<sup>36</sup>

Because Opposer attempts to establish priority based on common law use, its logo mark must be distinctive, inherently or otherwise. *See Towers v. Advent Software, Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43-45 (CCPA 1981). In this case, both parties have treated the logo mark as inherently distinctive (as indeed it seems to be), and there is no evidence of record to indicate otherwise.<sup>37</sup> We therefore

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<sup>33</sup> Garza Decl. ¶¶ 16, 19-21; Exs. C-F (25 TTABVUE 8-9, 247-57).

<sup>34</sup> Vizek Decl. ¶¶ 11-12, 14-15, 18; Exs. A-C (30 TTABVUE 6-8, 20-32).

<sup>35</sup> Fuller Decl. ¶¶ 21, 28; Exs. C & F (35 TTABVUE 8, 10, 23-24, 37-57).

<sup>36</sup> 28 TTABVUE 14.

<sup>37</sup> While Applicant argues that both of Opposer’s mark are “inherently and conceptually weak” (54 TTABVUE 43) in the context of the fifth *DuPont* factor, *see In re E. I. du Pont de*

consider Opposer's logo mark to be inherently distinctive for purposes of our likelihood of confusion determination. *See Wet Seal Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (absent argument or evidence from applicant, opposer's mark deemed distinctive). In view of the testimony and evidence of record, we find that Opposer has proved its priority of use of the distinctive logo mark in connection with charitable fundraising services, including fundraising in the nature of a pledged walkathon, in connection with raising awareness and funds for Alzheimer's care, support, and research.

#### D. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *DuPont*, 177 USPQ at 567, cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also Majestic Distilling Co.*, 65 USPQ2d at 1203. "In discharging this duty, the thirteen *DuPont* factors 'must be considered' 'when [they] are of record.'" *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case."

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*Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), Applicant does not appear to argue that the logo mark as a whole is not distinctive.

*Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, \*3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1406-07).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l v. Kappa Books, Inc.*, 64 USPQ2d at 1380).

For the sake of economy, we confine our analysis to the issue of likelihood of confusion between Applicant’s mark and Opposer’s pleaded logo mark because this mark is the most similar to Applicant’s mark.<sup>38</sup> If we dismiss the opposition based on this common law mark, we would not sustain the opposition based on Opposer’s

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<sup>38</sup> In its brief, Applicant acknowledged that “[p]ragmatically . . . the most noticeable elements of Applicant’s Mark and Opposer’s [logo m]ark are in the design elements.” 54 TTABVUE 33. Similarly, at the oral hearing Applicant acknowledged that Opposer’s common law logo mark is more similar to Applicant’s mark than Opposer’s standard-character mark.

pleaded Registration No. 4122255 for the mark WALK TO END ALZHEIMER'S, in standard characters. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

1. Similarity or Dissimilarity of the Services and Channels of Trade

We begin with the second and third *DuPont* factors, which respectively consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). We assess the *DuPont* factors of the similarity or dissimilarity of the services and their trade channels based on the actual services for which Opposer has demonstrated prior common law rights and the services as they are identified in the application. *See Detroit Athletic Co.*, 128 USPQ2d at 1052; *In re Dixie Rests.*, 41 USPQ2d at 1534; *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

a. The Services

As discussed above, Opposer has demonstrated rights based on prior use of the logo mark  in connection with charitable fundraising services, including fundraising in the nature of a pledged walkathon, for raising awareness and funds for Alzheimer's care, support, and research.<sup>39</sup> Applicant's services, as identified in the

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<sup>39</sup> *See* discussion of priority in the logo mark above at section V.A.2. *See also, e.g.*, Fuller Decl. Ex. F (35 TTABVUE 45) (act.alz.org: “Held annually in more than 600 communities



application, include “charitable fundraising services for Alzheimer’s care and research” and “charitable fundraising services by means of organizing walks and other special events for Alzheimer’s.” For purposes of our analysis, we focus on these particular services listed in the application and, in this regard, point out that if we find these respective services related, we need not further consider whether the other services identified in the application also are related to the Opposer’s services. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application or registration). In view thereof, Applicant’s argument that it provides additional services, such as help to those in need,<sup>40</sup> is of no import. We find the parties’ charitable fundraising services for Alzheimer’s care and research, and their fundraising in the nature of walks for Alzheimer’s, are legally identical such that the second *DuPont* factor strongly supports a finding of a likelihood of confusion.

b. The Channels of Trade

Because Opposer relies on its common law rights, for the purposes of this analysis Opposer can claim only those channels of trade and classes of consumers which it has

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nationwide, [Opposer’s] Walk to End Alzheimer’s® is the world’s largest event to raise awareness and funds for Alzheimer’s care, support and research.”).

<sup>40</sup> 54 TTABVUE 40.

established on the record. We cannot rely on a presumption that because the services are legally identical in part they move in the same channels of trade. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (no presumptions attach to unregistered common law mark). Instead, Opposer's common law rights in its logo mark for charitable fundraising services "are limited to the actual . . . channels of trade for which it uses its mark." *Hunter Indus., Inc. v. Toro Corp.*, 110 USPQ2d 1651, 1661 (TTAB 2014). *See also Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1512 (TTAB 2000) (noting that opposer's channels of trade were limited to its common law uses).

Applicant attempts to limit its trade channels by arguing its emphasis is on "local programs and services in New Jersey." However, we observe that "[t]here are no limitations as to channels of trade or classes of purchasers in the identification of [services] in [A]pplicant's application," and it "therefore is presumed that [A]pplicant's [services] move in all channels of trade normal for those [services], and that they are available to all classes of purchasers for those [services]." *Hunter Indus. v. Toro Corp.*, 110 USPQ2d at 1661. *See also Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015).<sup>41</sup>

Opposer argues that circumstances surrounding the marketing of the parties' respective marks are identical because the marks "are used and displayed in the same manner – that is, on marketing material promoting their respective walk events and

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<sup>41</sup> Moreover, in its response to Interrogatory No. 10, Applicant did not limit its services to New Jersey. 28 TTABVUE 9.

on their respective websites.”<sup>42</sup> Specifically, Opposer argues that both parties “display their marks on their respective websites, where participants and donors are encouraged to donate and register for the events,” “use their respective marks on social media to promote their walk events,” and “use the marks on apparel and event items.”<sup>43</sup> Contrary to Opposer’s claim, however, the Internet itself is not a distinct “channel of trade.” The Board has long recognized that the “Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet,” *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (quoting *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007)), and that “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1743 (TTAB 2014) (quoting *Parfums de Coeur*, 83 USPQ2d at 1021).

While we find that the channels of trade for the involved services do not overlap merely because they are offered on the Internet, we find they are offered through at least one of the same social media platforms. In addition, we find there is some potential overlap in trade channels and consumers where the parties’ services are legally identical and the identification of services in the involved application has no restrictions on channels of trade or classes of consumers. *See e.g., Bell’s Brewery*, 125 USPQ2d at 1345 (Board found that Applicant’s unrestricted identification for beer

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<sup>42</sup> 52 TTABVUE 33.

<sup>43</sup> 52 TTABVUE 27.

will move in all channels of trade normal for such goods, which includes Opposer's common law trade channels for beer). Accordingly, because of the potential overlap, the third *DuPont* factor supports a finding of a likelihood of confusion.

## 2. Purchase Conditions and Consumer Sophistication

The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at \*7 (TTAB 2020) (quoting *DuPont*, 177 USPQ at 567).

Opposer argues that “[i]t is undisputed that the participants who encounter Opposer's Marks and Applicant's Mark are identical – that is, without limitation as to age, education, or socio-economic background,”<sup>44</sup> and that the participants who encounter the parties' marks at their walking events “are of all ages, educational backgrounds, and socioeconomic status.”<sup>45</sup> On cross-examination, Mr. Zaentz stated that the people who encounter Applicant's mark come from a wide range of ages, educational backgrounds, and socioeconomic status.<sup>46</sup> Ms. Garza testified that based on her own experience over the past sixteen years, participants “range in age from young children to elderly men and women, come from all socio-economic backgrounds, and have an equally wide range of education,” and she observed that “[n]ot surprisingly, the level of care taken by such prospective participants and participants

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<sup>44</sup> 52 TTABVUE 31.

<sup>45</sup> 52 TTABVUE 32-33.

<sup>46</sup> 51 TTABVUE 58-59.

also ranges greatly.”<sup>47</sup> The record demonstrates that Opposer’s donation program includes raising money with \$5 “casual for a cause” stickers, \$1 bracelets, and even via money canisters in which “everyone” can donate their “spare change.”<sup>48</sup>

Applicant argues that its “consumers are sophisticated, make substantial contributions, rely on direct communications, and put substantial thought into their contributions including augmenting their wills and estate documents to ensure that the Applicant receives the proper donations.”<sup>49</sup> In support of this argument, Applicant points to the two New Jersey probate proceedings, but points to no evidence as to the range of donations it solicits or accepts, nor what the usual or customary donation amount might be. Applicant’s website claims that “[s]ixty-eight percent of New Jersey residents now know someone impacted by Alzheimer’s disease and other dementias.”<sup>50</sup> If that is accurate, it is unreasonable to base a finding of consumer sophistication on just two people who named Applicant as a beneficiary in their estate planning documents. The record demonstrates that any donor may simply click a link on Applicant’s Facebook page to donate to Applicant.<sup>51</sup> Mr. Zaentz testified that “Applicant’s donors do not act upon impulse but on careful and sophisticated examination and communications with Applicant,”<sup>52</sup> and based his statement on the

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<sup>47</sup> 50 TTABVUE 14.

<sup>48</sup> Vizek Decl. Ex. F (30 TTABVUE 51).

<sup>49</sup> 54 TTABVUE 42.

<sup>50</sup> 51 TTABVUE 140.

<sup>51</sup> 51 TTABVUE 29, 148.

<sup>52</sup> Zaentz Decl. ¶ 91 (37 TTABVUE 19).

fact that Applicant engages in “local fundraising,” “local New Jersey support,” and “building relationships and emphasizing that the funds will be used to support local programs and services in New Jersey.”<sup>53</sup> However, as discussed above, there is no local or state-level limitation in Applicant’s services or to the way it may advertise its services.

One of Applicant’s mail fliers directs fundraising participants to “[a]sk friends, family and colleagues to support your efforts by making a donation to your team” and explains that “[y]our supporters can donate to you and/or your team online, by mail, or even by giving their money directly to you.”<sup>54</sup> We are not convinced by Applicant’s arguments that its donors are sophisticated. The lack of evidence of sophistication is profound, and the record demonstrates that Applicant accepts donations in many formats from virtually anyone. Precedent requires that we base our decision on the least sophisticated potential purchasers. *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”).

We find that the fourth *DuPont* factor favors a likelihood of confusion because the parties’ fundraising services are directed at least in part to the general public, who may decide to purchase a bracelet or sticker, or even donate their spare change, for purposes of supporting a participant who walks to raise money for Alzheimer’s care and research. Consumers offering these relatively inexpensive donations would

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<sup>53</sup> Id. at ¶¶ 88-89 (37 TTABVUE 18).

<sup>54</sup> Zaentz Ex. O (37 TTABVUE 532, 533).

exercise much less care, if any, than those drafting estate planning documents when donating money in conjunction with the fundraising programs forming the parties' services. It is common knowledge that many charitable contributions are made by members of the public who are not particularly sophisticated. Moreover, there are many levels of charitable contributions and levels of attention paid by contributors to the nature of the receiving charity and what affiliations it may or may not have.

### 3. The Strength of Opposer's Mark


We next consider the fifth and sixth *DuPont* factors because the strength of Opposer's logo mark potentially affects the scope of protection to which it is entitled. "In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery*, 125 USPQ2d at 1345 (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)). The fifth *DuPont* factor, the "fame" of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar services, *DuPont*, 177 USPQ at 567, may be considered in tandem to determine the strength of Opposer's logo mark and the scope of protection to which it is entitled. *Bell's Brewery*, 125 USPQ2d at 1345.

"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*, 957 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). "In determining the strength of a mark, we consider both its

inherent strength, based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition of the mark.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*30 (TTAB 2021); *New Era*, 2020 USPQ2d 10596, at \*10. “The first enquiry focuses on the inherent potential of the [mark] at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.” *Chutter*, 2021 USPQ2d 1001, at \*30 (quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update)).

a. Conceptual Strength



Opposer’s common law logo mark is . It is comprised of multiple literal elements and multiple design elements in the colors purple and white.

The first and largest literal element of the mark is WALK TO END ALZHEIMER’S in large, all capital letters.<sup>55</sup> Because WALK TO END ALZHEIMER’S is also registered, in standard characters, on the Principal Register for charitable funding raising services with no claim of acquired distinctiveness under Section 2(f), we presume it is inherently distinctive and, at worst, is suggestive of Opposer’s services. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the

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<sup>55</sup> 27 TTABVUE 8.



validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”).

The second literal element is ALZHEIMER’S ASSOCIATION which is presented in smaller letters, and appears subordinate to the much larger literal element in both position and size. By the nature of these words, this literal element appears to be descriptive of the services.

Two design elements, both significant and large, are the purple background rectangle and the stylized white arrow. The arrow is integrated with and a carrier for the literal WALK TO END ALZHEIMER’S element. The arrow itself appears comprised of multiple elements: a large, thick shaft, and a triangular head containing a geometric pattern in alternating purple and white.

A third, small design element appears to be a stylized link between the words ALZHEIMER’S ASSOCIATION.

Applicant argues that Opposer’s logo mark is “inherently and conceptually weak,”<sup>56</sup> and introduced several third-party registrations to demonstrate that the WALK and WALK TO literal elements and the color purple are weak. If there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some non-source identifying significance which undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co.*

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<sup>56</sup> 54 TTABVUE 43.

*KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Applicant’s evidence includes the following use-based third-party registrations covering charitable fundraising services or promoting public awareness:<sup>57</sup>

Registration No. 4835215: AVON 39 THE WALK TO END BREAST CANCER  
Registration No. 5156996: BOOT WALK TO END CANCER.  
Registration No. 77846970: NEDA WALK  
Registration No. 4683395: WALK FOR ALZHEIMER’S (and design)  
Registration No. 4707539: WALK TO END GENOCIDE  
Registration No. 5298552: WALK TO END HYDROCEPHALUS  
Registration No. 4518513: WALK TO END LUPUS NOW



Registration No. 4840712: — RUNNING TO BEAT PANCREATIC CANCER —  
Registration No. 3856551: PURPLE STRIDE

Opposer argues that Applicant’s attempt to establish the relevance of most of these registrations is misguided because they are directed to other, distinct causes but not Alzheimer’s.<sup>58</sup> However, considering these registrations, and noting that Opposer’s standard-character registration disclaims WALK and ALZHEIMER’S, we find that the WALK TO END ALZHEIMER’S literal portion of Opposer’s logo mark

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<sup>57</sup> 41 TTABVUE 7, 60, 225, 517, 667, 763, 827, 338, & 377, respectively.

<sup>58</sup> 52 TTABVUE 40.

suggests the nature of Opposer's services and has some conceptual weakness. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, 'third party registrations are similar to dictionaries showing how language is generally used.'") (Internal citation omitted); *Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be "persuasive evidence"). *See also Juice Generation*, 115 USPQ2d at 1675 (third-party registrations are relevant to prove that some segment of a mark has a normally understood and well-recognized meaning). We do not, however, find that Applicant has demonstrated that the color purple is conceptually weak. Applicant's submission of just a single registration containing the color purple and another that includes the word PURPLE is a far cry from the quantum of evidence necessary for showing that the color has a "a normally understood and well-recognized descriptive or suggestive meaning." *Juice Generation*, 115 USPQ2d at 1674.

Opposer's logo mark is comprised of several elements, including colors. Applicant's attempt to demonstrate conceptual weakness of WALK and the color purple might be expected because those are also two elements of Applicant's proposed mark. However, Applicant has done little to demonstrate that the overall conceptual strength of Opposer's logo mark as a whole is weak.

b. Commercial Strength

i. Fame under the 5th *DuPont* Factor

Turning to commercial strength, we first examine the alleged fame of Opposer's logo mark under the fifth *DuPont* factor. "Market strength is the extent to which the relevant public recognizes a mark as denoting a single source." *Chutter*, 2021 USPQ2d 1001, at \*30. "In other words, it is similar to acquired distinctiveness." *Id.* "The proper standard is the mark's 'renown within a specific product market,' and 'is determined from the viewpoint of consumers of the product,' and not from the viewpoint of the general public." *Id.*, at \*31 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35).

The Board has explained that

[c]ommercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the mark; and the general reputation of the goods or services.

*New Era*, 2020 USPQ2d 10596, at \*10-11.

To demonstrate the fame of its mark, Opposer submitted a variety of evidence showing that since at least 2011 Opposer has regularly and continuously used the logo mark in interstate commerce in connection with charitable fundraising services, including fundraising in the nature of a pledged walkathon, for raising awareness and funds for Alzheimer's care, support, and research. Opposer introduced evidence

that its fundraising walk is its “signature fundraising campaign,”<sup>59</sup> is held annually in more than 600 communities nationwide, and is the world’s largest event to raise awareness and funds for Alzheimer’s care, support, and research.<sup>60</sup> Opposer’s fundraising walk was ranked, in terms of fundraising dollars, as the fifth most successful walk-based fundraiser in the U.S. in 2016, grossing more than \$82 million; and, for the three years immediately prior to trial was consistently ranked as the third most successful, raising \$89 million 2017, \$96 million in 2018, and \$98 million in 2019.<sup>61</sup> Opposer uses its logo mark “prominently” in association with its fundraising walk.<sup>62</sup> Since 2011, Opposer’s walk has raised over \$500 million in charitable funds through donations and product sales, and more than two million people have participated in the events all across the U.S.<sup>63</sup> Applicant attempts to downplay these rankings and the amount of money raised by comparing them to the two walks that rank above Opposer,<sup>64</sup> but Opposer counters that the importance of the rankings is to provide context for the figures disclosed by Opposer vis-à-vis other walk-based events, and to demonstrate that Opposer consistently ranks in the top five and top three nationally of all walk-based events by fundraising dollars.<sup>65</sup>

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<sup>59</sup> Fuller Decl. ¶ 10 (35 TTABVUE 6).

<sup>60</sup> Fuller Decl. ¶ 22; Ex. F (35 TTABVUE 8, 45).

<sup>61</sup> Vizek Decl. ¶¶ 51-52; Exs. V-Y (30 TTABVUE 18; 31 TTABVUE 54, 59, 62, 67).

<sup>62</sup> Fuller Decl. ¶ 25 (35 TTABVUE 8).

<sup>63</sup> Garza Decl. ¶¶ 22-23 (25 TTABVUE 9-10). Opposer’s product sales figures are confidential, so we only generally acknowledge that the bulk of Opposer’s charitable funds come from non-sales donations.

<sup>64</sup> 54 TTABVUE 45.

<sup>65</sup> 56 TTABVUE 9-10.

Opposer introduced evidence that it has invested a few million dollars a year in national television, digital, and print advertising since 2013, with a cumulative amount in the low tens of millions of dollars.<sup>66</sup> The spending included television advertising with NBC, ABC, The Weather Channel, and CNN; digital advertising on Google Display Network, Youtube, and Google AdWords platforms; and print magazine advertising in People, Time, Parade, and Better Home and Gardens.<sup>67</sup>

Opposer has received unsolicited media coverage in numerous independent local and nationwide publications and media, including The Chronicle of Philanthropy, Atlantic Weekly, and the Denver Broncos website;<sup>68</sup> and submitted evidence demonstrating that an appreciable percentage of the general population is aware of Opposer's fundraising walk and brand.<sup>69</sup>

"Market share is but one way of contextualizing ad expenditures or sales figures," *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (citing *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002)), but because Opposer's modest advertising figures are nowhere close to the figures in cases in which marks have been found to be famous under Section 2(d),<sup>70</sup> "some context in which to place

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<sup>66</sup> Fuller Decl. ¶ 31 (35 TTABVUE 11-14).

<sup>67</sup> Fuller Decl. ¶ 31 (35 TTABVUE 11-14).

<sup>68</sup> Fuller Decl. ¶ 32 (35 TTABVUE 14-15).

<sup>69</sup> Fuller Decl. ¶¶ 33-37; Ex. T (35 TTABVUE 15-16; 125-27).

<sup>70</sup> See *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark supported by annual advertising expenditures of more than \$5 million over the 17 years of use of the mark prior to 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000) (fame of the opposer's FRITO-LAY mark shown by expenditures in 1996 of about \$80 million and other evidence, including the facts that "[i]n any given year, over 90 percent of American

[Opposer's] raw statistics is reasonable," *Bose*, 63 USPQ2d at 1309, even taking into account that Opposer claims that approximately a quarter of the general population is aware of its brand.

Opposer provided some context, and we find that its logo mark has achieved some commercial strength; but, we cannot say that it has attained such a high level apparently achieved by the two highest walk-based fundraisers, at least in terms of fundraising dollars. The first- and second-position walks for the past several years have eclipsed Opposer's haul. *Cf. Omaha Steaks*, 128 USPQ2d at 1690 (finding that the opposer had "provided considerable contextual evidence of the type of advertisements and promotions it uses to gain sales," including "national radio and television campaigns, free-standing print campaigns, and mention 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," television promotions on "Fox & Friends,' 'Hell's Kitchen,' 'Celebrity Apprentice,' and 'The View,'" "features of Omaha Steaks products on 'The Oprah Winfrey Show,' 'The Ellen DeGeneres Show,' 'Food Factory,' 'Unwrapped,' and

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households purchase at least one FRITO-LAY brand product" and that "FRITO-LAY products enjoyed a greater than 50 percent market share in the estimated \$12.1 billion domestic snack chip industry."); *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); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (fame of HUGGIES mark supported by \$15 million in advertising in the year 1982 alone); *Auto Zone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (fame of AUTOZONE mark supported by advertising expenditures of over \$750 million during 23-year period of use, with the Board finding that although the 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 fact that petitioner's advertising reaches over 90% of the U.S. population numerous times each year.").

‘Military Makeover,’” and “unsolicited movie and TV allusions to Omaha Steaks”); *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35 (finding that the opposer had provided evidence that its “INSIGNIA wine is renowned in the wine market and among consumers of fine wine” in the form of numerous articles lauding the wine and its producer, and evidence that INSIGNIA wine had been served at the White House).

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

We next examine the sixth *DuPont* factor, which “considers ‘[t]he number and nature of similar marks in use on similar goods.’” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *DuPont*, 177 USPQ at 567). “[E]vidence of the extensive registration and use of a term by others can be powerful evidence of the term’s weakness.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (citing *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674).

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). Third-party uses may bear on the commercial weakness of a mark, *Tao Licensing*, 125 USPQ2d at 1057, and may be “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).



Applicant introduced several examples of third-party uses of the color purple in marks used with charitable fundraising or awareness services for Alzheimer's. The examples include:<sup>71</sup>



While the Alzheimer's-related third-party marks reproduced just above incorporate the color purple – and two also contain WALK – they also contain

<sup>71</sup> 40 TTABVue 76, 77, 85, 93, 98, & 102.

additional elements that cause them to be less similar to Opposer's mark than Applicant's mark is and reduce their probative value. *Cf. In re Inn at St. John's*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) (discussing limited probative value of registrations of words that are not identical to the words in the cited mark). We do not find that Opposer's logo mark has been weakened to the extent Opposer's mark includes the color purple which is a large visual portion of its mark.

Applicant also introduced evidence of other third-party uses of the color purple and "walk to" marks for fundraising services for several non-Alzheimer's-related health issues.<sup>72</sup> However, they are of very limited probative value. *Omaha Steaks*, 128 USPQ2d at 1695 (where the parties' goods were identical meat products, third-party uses on other food products were "properly understood as having no real probative value for the analysis at hand.").

"Considering the record as a whole, including evidence pertaining to both inherent and commercial strength," and taking into account that portions of Opposer's logo mark are separately registered for fundraising services and are thus presumed to be at least suggestive, that the mark as a whole has been shown to have modest commercial strength, and that the examples of third-party uses have limited probative value, Opposer's common law logo mark for fundraising services is appropriately placed slightly off center on the "strong" portion of the spectrum. We accord Opposer's logo mark a slightly increased scope of protection.

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<sup>72</sup> *See generally*, 40 TTABVUE 103-185.

#### 4. 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. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

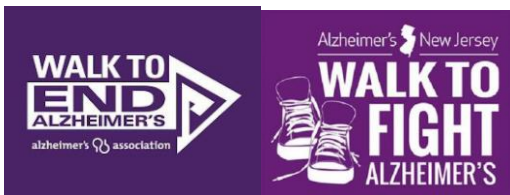
The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (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).

Opposer argues that the parties’ marks have identical commercial impressions because they are both clearly directed to walks to combat Alzheimer’s disease, contain dominant purple backgrounds which encapsulate core wording presented in large white capital letters, share core words with the only difference being similar action words END and FIGHT, and contain structural similarity with identical placement

of WALK TO above an action word (END or FIGHT) with ALZHEIMER'S in smaller capital letters underneath the action word.<sup>73</sup>

Applicant argues that the words should be accorded greater weight, each mark contains additional wording that is not present in the other mark, its large wording is off-centered while Opposer's wording is uniformly centered, much of the wording is merely descriptive of the services, and Opposer's arguments are, in essence, a collateral attack on Applicant's prior registration of the standard-character mark WALK TO FIGHT ALZHEIMER'S.<sup>74</sup>

It is not surprising that the parties focus on different elements of the marks, pointing out what is similar (Opposer) or what is different (Applicant). As in most cases, there will be similarities and differences between the marks, especially when they are viewed side-by-side. The differences are apparent when the marks are placed next to each other and studied:



However, the proper test is not a side-by-side consideration. When we step away from the side-by-side comparison and view the marks in their entirety, we are struck by the similar appearances, commercial impressions, and connotations made by the marks. Applicant concedes that “the most noticeable elements of [the parties’ marks]

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<sup>73</sup> 52 TTABVUE 28-29.

<sup>74</sup> 54 TTABVUE 30-31.

are in the design elements.”<sup>75</sup> Stepping back and viewing each mark as a whole, the purple backgrounds with dominating large capital lettering with white as the only and starkly contrasting color creates a similar appearance and similar impression on the viewer. The impression and connotation is further increased when the large wording is read, with each mark referencing – and suggesting – a walk related to Alzheimer’s. These are the dominating elements contributing to the overall appearances and similar commercial impressions and connotations. Although Applicant has attempted to demonstrate that the word WALK and the color purple are weak, as discussed above, the combination of the large and similar visual and literal elements leads to quite similar appearances, commercial impressions, and connotations.

We acknowledge Applicant’s lengthy analysis of the different details between the marks, including that the color purple is different in each mark; however, the similarity of the appearances, commercial impressions, and connotations of the marks created by the visual prominence of the purple and white, accompanied by large wording pertaining to an Alzheimer’s-related walk, outweighs the smaller differences, especially when we keep in mind “the fallibility of memory over a period of time” and that the “average” purchaser “normally retains a general rather than a specific impression of trademarks.” *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of

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<sup>75</sup> 54 TTABVUE 33.

memory”) (cleaned up); *Chutter*, 2021 USPQ2d 1001, at \*35; *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The differences are further minimized because, where the services are legally identical, as they are in part in this case, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. See *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Coach Servs.*, 101 USPQ2d at 1721); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

As indicated above, similarity in any one of the elements of appearance, sound, connotation, or commercial impression may be sufficient to find the marks confusingly similar. *Inn at St. John’s*, 126 USPQ2d at 1746. We find similarity in three: the marks have similar appearances, create similar commercial impressions and convey similar connotations when used in connection with legally identical services. Accordingly, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

#### 5. Actual confusion

We next turn to the seventh *DuPont* factor (nature and extent of any actual confusion) and the related eighth *DuPont* factor (extent of the opportunity for actual confusion). “Evidence of actual confusion, where it exists, would of course be highly probative of a likelihood of confusion.” *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at \*19 (TTAB 2020), *aff’d in relevant part, vacated*

*in part*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021) (citing *Edom Labs.*, 102 USPQ2d at 1553) (“The existence of actual confusion is normally very persuasive evidence of likelihood of confusion and undercuts any possible claim that the marks are so dissimilar that there can be no likelihood of confusion.”)). “Properly introducing instances of actual confusion into the record and persuading the trier of fact as to the probative value of such evidence is [Opposer’s] burden.” *Id.*

Opposer submitted no direct evidence of actual confusion. Instead, it posits that seven social media posts of photographs showing participants at Applicant’s fundraising walks wearing clothing displaying Opposer’s marks evidences some level of confusion as to the sponsorship or source of Applicant’s walk.<sup>76</sup> We do not think the photographs entitled to nearly the weight Opposer urges. Opposer’s argument implies that participants in one fundraising walk or donors to one Alzheimer’s-related organization would never intentionally wear a shirt identifying one organization while participating in another walk sponsored by a different Alzheimer’s-related organization. The argument is dubious, at best.

As Applicant states, neither party has identified any instances of actual confusion.<sup>77</sup> Of course, “evidence of actual confusion is not required in order to establish likelihood of confusion,” *Wet Seal v. FD Mgmt.*, 82 USPQ2d at 1642 n.23, and the seventh *DuPont* factor is thus neutral in our analysis of the likelihood of confusion.

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<sup>76</sup> 52 TTABVUE 45; *see also* Zaentz’s Cross-Exam. Exs. 14-18 & 21-22 (51 TTABVUE 175-84 & 189-92).

<sup>77</sup> 54 TTABVUE 53.

Applicant argues that the parties have been disaffiliated for more than five years, and there has been no known actual confusion.<sup>78</sup> No evidence of actual confusion was submitted. The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d at 1287 (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred).

Here, Applicant testified that it has used its mark since September 1, 2017. That was just four years ago. Applicant did not submit any evidence demonstrating the advertising it has expended on its services, nor the cumulative amount of donations it raised since starting use of its mark.<sup>79</sup> Thus, it is impossible to ascertain the extent of consumer exposure or recognition of Applicant's mark so as to make a determination whether any real opportunity for actual confusion to have occurred.

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<sup>78</sup> 54 TTABVUE 53.

<sup>79</sup> While Applicant may have raised "nearly \$750,000" in 2017, *see* Zaentz Decl. ¶ 87 (37 TTABVUE 18), no information was provided for any other year. For context, we note that Applicant's 2017 amount is less than one percent of Opposer's gross donations that year. Based on that number alone, we cannot say that there has been a real opportunity for actual confusion to have occurred.



We find that the eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

6. Thirteenth Factor - Applicant's intent

Bad faith, or intent to confuse, falls under the thirteenth *DuPont* factor, "any other established fact probative of the effect of use." See *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[A] party which knowingly adopts a mark similar to one used by another for related goods [or services] should not be surprised to find scrutiny of the filer's motive." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). "[W]here there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First Int'l Servs. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. See, e.g., *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.") (quotation omitted).

Opposer argues that Applicant had a bad faith intent in adopting Applicant's newest mark by changing the color scheme of an existing mark to diverge from its "signature colors" of purple, green, and white to adopt an all purple-and-white color

scheme.<sup>80</sup> Opposer also argues that as a former licensee and user of Opposer's marks Applicant "was indisputably familiar with" Opposer's mark when Applicant applied to register the subject mark.<sup>81</sup>

After careful consideration of Opposer's arguments and the evidence on this factor, we are not persuaded that Applicant adopted its mark in bad faith or that Applicant's intent weighs against Applicant in our likelihood of analysis in this case. As noted above, mere knowledge of the existence of Opposer's mark does not, in and of itself, constitute bad faith. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989); *Ava Enters., Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). In order to demonstrate that Applicant's application was filed in bad faith, Opposer must show that Applicant intentionally sought to trade on Opposer's good will, and the record evidence is insufficient to support this contention. Thus, the thirteenth *DuPont* factor based on bad faith adoption is neutral.

#### 7. Summary of Likelihood of Confusion

We have found that the services are in-part legally identical, with overlapping channels of trade and classes of consumers; donors include members of the general public who are not sophisticated and may contribute but spare change to support Alzheimer's-related organizations; Opposer's mark has achieved some commercial strength, and is entitled to a slightly increased scope of protection; the marks have similar overall appearances and create similar commercial impressions when used in

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<sup>80</sup> 52 TTABVUE 43.

<sup>81</sup> 52 TTABVUE 41.

connection with legally identical services; there is no evidence of actual confusion, and the record does not demonstrate whether there has been a real opportunity for actual confusion to have occurred; and the record evidence is insufficient to support a contention that Applicant adopted the subject mark in bad faith.

## VI. Decision

The opposition to registration of the mark in Application Serial No. 87797112 is sustained on the ground of likelihood of confusion under Section 2(d), and registration to Applicant is refused.

Because we have found for Opposer on its likelihood of confusion claim, we need not reach the merits of its dilution claim under Trademark Act Section 43(c). *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1172 (TTAB 2013).