Mailed: October 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Advance Magazine Publishers Inc.
v.
Anna Goncharova

Opposition No. 91245771
Opposition No. 91253089
Opposition No. 91254140

Jordan LaVine and Eric R. Clendening of Flaster/Greenberg P.C.,
for Advanced Magazine Publishers Inc.

Anna Goncharova, pro se.

Before Bergsman, English, and Lebow,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Anna Goncharova (Applicant) seeks registration on the Principal Register of the marks listed below:

- WIRED, in standard character form, for the services set forth below:

> Fitness boot camps; Sports instruction services; Sports training services; Aerial fitness instruction; Athletic and sports event services, namely, arranging, organizing, operating and conducting marathon races; Coaching in the field of sports; Conducting fitness classes; Conducting of sports competitions; Consulting services in the fields of fitness and exercise; Counseling services in the field of

physical fitness; Instruction in the nature of general and electrical muscle stimulation fitness clinics; Instruction in the nature of general and electrical muscle stimulation fitness lessons; Officiating at sports contests; Organizing sporting events, namely, in the field of general and electrical muscle stimulation fitness; Organizing and conducting sporting events for the purpose of helping high school seniors earn a college scholarship in their respective sport; Organizing and conducting athletic competitions and games in the field of general and electrical muscle stimulation fitness; Organizing exhibitions for general and electrical muscle stimulation fitness; Organizing, arranging and conducting general and electrical muscle stimulation fitness events, the proceeds of which are donated to charity; Organizing, arranging, and conducting sports events; Organizing, conducting and operating general and electrical muscle stimulation fitness tournaments; Personal fitness training services; Personal fitness training services and consultancy; Personal fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; Personal trainer services; Personal training provided in connection with weight loss and exercise programs; Personal training services, namely, strength and conditioning training; Personal training services, namely, strength and conditioning training and speed training; Physical fitness assessment services; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness training of individuals and groups; Physical fitness training services; Providing fitness and exercise facilities; Providing fitness instruction services in the field of general and electrical muscle stimulation fitness, yoga, weight-loss; Providing fitness training services in the field of general and electrical muscle stimulation fitness, yoga, weight-loss; Providing an in-person fitness, sporting forum in the field of general and electrical muscle stimulation fitness; Providing classes, workshops, seminars and camps in the field of general and electrical muscle stimulation fitness; Providing facilities for general and electrical muscle stimulation fitness training; Providing general fitness and mixed martial arts

facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts; Providing group coaching and in-person learning forums in the field of leadership development; Providing personal fitness training for adults; Providing personal training and physical fitness consultation to corporate clients to help their employees make physical fitness, strength, conditioning, and exercise alterations in their daily living; Providing personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Rental of indoor recreational facilities for playing sports, sports training, and group recreation events; Training services in the field of personal and group training sessions including electrical muscle stimulation equipment, held indoors, in International Class 41;[1]

- WIRED.FIT, in standard character form, for the services set forth below:

Aerial fitness instruction; Athletic and sports event services, namely, arranging, organizing, operating and conducting marathon races; Coaching in the field of sports; Conducting fitness classes; Conducting of sports competitions; Consulting services in the fields of fitness and exercise; Counseling services in the field of physical fitness; Instruction in the nature of general and electrical muscle stimulation fitness lessons; Officiating at sports contests; Organizing exhibitions for general and electrical muscle stimulation fitness; Organizing sporting events, namely, in the field of general and electrical muscle stimulation fitness; Organizing and conducting sporting events for the purpose of helping high school seniors earn a college scholarship in their respective sport; Organizing, arranging and conducting sport events, the proceeds of which are donated to charity; Organizing, arranging, and conducting general and electrical muscle stimulation fitness events events [sic]; Organizing, arranging, and conducting sport events; Organizing, conducting and operating general and electrical muscle stimulation fitness tournaments; Personal fitness training services; Personal

[1] Application Serial No. 87745678 was filed on January 5, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's bona fide intention to use the mark in commerce. This application is the subject of Opposition No. 91245771.

fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; Personal fitness training services and consultancy; Personal trainer services; Personal training provided in connection with weight loss and exercise programs; Personal training services, namely, strength and conditioning training; Personal training services, namely, strength and conditioning training and speed training; Physical fitness assessment services; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness training services; Physical fitness training of individuals and groups; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Providing classes, workshops, seminars and camps in the field of general and electrical muscle stimulation fitness; Providing facilities for general and electrical muscle stimulation fitness tournaments; Providing facilities for general and electrical muscle stimulation fitness training; Providing fitness instruction services in the field of general and electrical muscle stimulation fitness, yoga, weight-loss, wellness; Providing fitness and exercise facilities; Providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts; Providing personal fitness training for adults; Providing an in-person fitness forum in the field of general and electrical muscle stimulation fitness; Rental of indoor recreational facilities for playing sports, sports training, and group recreation events; Sports instruction services; Sports training services; Training services in the field of general and electrical muscle stimulation fitness; Charitable services in the nature of providing fitness instruction in the field of general and electrical muscle stimulation fitness; Consulting services in the field of fitness training; Educational services, namely, providing training of fitness trainors [sic] for certification in the field of general and electrical muscle stimulation fitness; Fitness boot camps; Organization, arranging and conducting of sports competitions; Organizing and conducting athletic competitions and games in the field of general and

> electrical muscle stimulation fitness; Providing group coaching and in-person learning forums in the field of leadership development; Providing group coaching in the field of general and electrical muscle stimulation fitness; Providing personal training and physical fitness consultation to corporate clients to help their employees make physical fitness, strength, conditioning, and exercise alterations in their daily living; Providing personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Providing fitness training services in the field of general and electrical muscle stimulation fitness; Sports training services in the field of general and electrical muscle, in International Class 41.[2]

Applicant disclaims the exclusive right to use the word "Fit";

- WIRED and design, reproduced below, for the services set forth below:

> Fitness boot camps; Sports instruction services; Sports training services; Aerial fitness instruction; Athletic and sports event services, namely, arranging, organizing, operating and conducting marathon races; Coaching in the field of sports; Conducting fitness classes; Conducting of sports competitions; Consulting services in the fields of fitness and exercise; Counseling services in the field of physical fitness; Instruction in the nature of general and electrical muscle stimulation fitness clinics; Instruction in the nature of general and electrical muscle stimulation fitness lessons; Officiating at sports contests; Organizing sporting events, namely, in the field of general and electrical muscle stimulation fitness; Organizing and conducting sporting events for the purpose of helping high school seniors earn a college scholarship in their respective sport; Organizing and conducting athletic competitions and games in the field of general and electrical muscle stimulation fitness; Organizing exhibitions for general and electrical muscle stimulation fitness; Organizing,

[2] Application Serial No. 88502457 was filed on July 6, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's bona fide intention to use the mark in commerce. This application is a subject of Opposition No. 91253089.

arranging and conducting general and electrical muscle stimulation fitness events, the proceeds of which are donated to charity; Organizing, arranging, and conducting sports events; Organizing, conducting and operating general and electrical muscle stimulation fitness tournaments; Personal fitness training services; Personal fitness training services and consultancy; Personal fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; Personal trainer services; Personal training provided in connection with weight loss and exercise programs; Personal training services, namely, strength and conditioning training; Personal training services, namely, strength and conditioning training and speed training; Physical fitness assessment services; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness training of individuals and groups; Physical fitness training services; Providing fitness and exercise facilities; Providing fitness instruction services in the field of general and electrical muscle stimulation fitness, yoga, weight-loss; Providing fitness training services in the field of general and electrical muscle stimulation fitness, yoga, weight-loss; Providing an in-person fitness, sporting forum in the field of general and electrical muscle stimulation fitness; Providing classes, workshops, seminars and camps in the field of general and electrical muscle stimulation fitness; Providing facilities for general and electrical muscle stimulation fitness training; Providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts; Providing group coaching and in-person learning forums in the field of leadership development; Providing personal fitness training for adults; Providing personal training and physical fitness consultation to corporate clients to help their employees make physical fitness, strength, conditioning, and exercise alterations in their daily living; Providing personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Rental of indoor recreational facilities

for playing sports, sports training, and group recreation events; Training services in the field of personal and group training sessions including electrical muscle stimulation equipment, held indoors, in International Class 41.[3]

Applicant describes the mark as follows:

> The mark consists of the word "WIRED" in capital letters written in stylized font. The colors black and white in the drawing represent background, outlining, shading and/or transparent areas and are not part of the mark.
>
> Color is not claimed as a feature of the mark.

- WIRED, in standard character form, for the goods set forth below:

> Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Clothing, namely, athletic sleeves; Sport coats; Sport shirts; Sport stockings; Sports bra; Sports bras; Sports caps and hats; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports overuniforms; Sports pants; Sports shirts; Sports shoes; Sports singlets; Sports vests; Athletic tops and bottoms for fitness; Boots for sport; Bottoms as clothing; Combative sports uniforms; Fingerless gloves as clothing; Footwear not for sports; Headbands for clothing; Headwear for adults; Hoodies; Moisture-wicking sports bras; Moisture-wicking sports pants; Moisture-wicking sports shirts; Non-disposable cloth training pants; Pants

[3] Application Serial No. 88503918 was filed on July 8, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's bona fide intention to use the mark in commerce. This application is a subject of Opposition No. 91253089.

> for adults; Shirts for adults; Short sets; Shorts for adults; Sweatpants for adults; Sweatshirts for adults; Tops as clothing; Tops as clothing for adults; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts, blouses; Woven shirts for adults; Wrist bands as clothing; Wristbands as clothing, in International Class 25.[4]

Advance Magazine Publishers Inc. (Opposer) filed notices of opposition against the registration of Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks so resemble Opposer's WIRED marks for magazines as to be likely to cause confusion. Opposer pleaded ownership of the following registrations:

- Registration No. 1853612 for the mark WIRED, in typed drawing form, for "magazines relating to the digital revolution," in International Class 16;[5]

- Registration No. 1967076 for the mark WIRED and design, reproduced below, for "magazines about culture, lifestyle and technology," in International Class 16;[6]

[4] Application Serial No. 87978857 was filed on January 5, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's bona fide intention to use the mark in commerce. This application is the subject of Opposition No. 91254140.

[5] Registered September 13, 1994; second renewal.

Prior to November 2, 2003, "standard character" drawings were known as "typed" or "type-set" drawings. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012). A typed or typeset mark is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 807.03(i) (2022).

[6] Registered April 9, 1996; second renewal. The registration does not include a description of the mark.

● Registration No. 1997802 for the mark WIRED, in typed drawing form, for "transmission of messages and data via access to an interactive computer," in International Class 38;[7]

● Registration No. 2125872 for the mark WIRED, in typed drawing form, for "audio recording and production services," in International Class 41;[8]

● Registration No. 2150960 for the mark WIRED, in typed drawing form, for "books and magazines in the fields of culture, lifestyle and technology," in International Class 16;[9]

● Registration No. 2781551 for the mark WIRED, in typed drawing form, for "operating an Internet site which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services on the Internet," in International Class 35;[10]

● Registration No. 3078104 for the mark WIRED, in a stylized form reproduced below, for the services set forth below:

> Providing information about business and politics via a global computer network, in International Class 35; and
>
> Providing information about the digital revolution, technology, electronics and science via a global computer network, in International Class 42;[11]

[7] Registered September 3, 1996; second renewal.

[8] Registered December 30, 1997; second renewal.

[9] Registered April 14, 1998; second renewal.

[10] Registered November 2003; renewed

[11] Registered April 11, 2006; renewed.

WIRED

● Registration No. 3277604 for the mark WIRED STORE, in standard character form, for "retail store services featuring electronics, high-tech, and technology-related products including computer software and hardware; retail store services featuring electronics, high-tech, and technology-related products including computer software and hardware, available through interactive computer networks, wireless, mobile and satellite connections," in International Class 35.[12] Opposer disclaims the exclusive right to use the word "Store";

● Registration No. 3330206 for the mark WIRED, in standard character form, for "promoting the goods and services of others via wireless and mobile devices," in International Class 35, and "provision of information via wireless and mobile devices, satellite and cable and other means of digital and electronic transmissions, transmission of information via digital networks and electronic communications networks," in International Class 38;[13]

● Registration No. 3946175 for the mark WIRED, in standard character form, for "software applications for use in connection with smartphones, pda devices, tablet computers and other portable and handheld digital electronic devices, namely,

[12] Registered August 7, 2007; renewed.

[13] Registered November 6, 2007; renewed.

software for accessing, viewing, interacting with and downloading content from magazines and websites," in International Class 9;[14]

● Registration No. 4135739 for the mark WIRED and design, reproduced below, for the services set forth below:

> Providing information about business and politics via a global computer network, digital networks, wireless networks, in International Class 35; and
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> Providing information about technology, electronics and science via electronic and digital networks, in International Class 42;[15]

● Registration No. 4349717 for the mark WIRED SCIENCE, in standard character form, for "blogs and non-downloadable publications in the nature of articles and journals in the fields [sic] of science," in International Class 41.[16] Opposer disclaims the exclusive right to use the word "Science";

● Registration No. 4347147 for the mark WIRED, in standard character form, for "arranging and conducting educational conferences, organizing exhibition for educational purposes in the field of technology," in International Class 41;[17]

● Registration No. 5007970 for the mark WIRED BY DESIGN, in standard character form, for "arranging and conducting educational conferences; organizing

[14] Registered April 12, 2011; renewed.

[15] Registered May 1, 2012; renewed. The registration does not include a description of the mark.

[16] Registered June 11, 2013; Sections 8 and 15 declarations accepted and acknowledged.

[17] Registered Jun 4, 2013; Sections 8 and 15 declarations accepted and acknowledged.

exhibitions for educational purposes in the field of design; entertainment services in the nature of non-downloadable video series in the fields of technology, design and innovation, culture and science," in International Class 41;[18]

- Registration No. 5696105 for the mark WIRED AUTOCOMPLETE INTERVIEW, in standard character form, for "education and entertainment services, namely, a continuing web-based non-downloadable video series focused on celebrities answering the internet's most searched questions in the fields of celebrities, entertainment, and popular culture," in International Class 41.[19] Opposer disclaims the exclusive right to use the term "Autocomplete Interview";

- Registration No. 5740310 for the mark WIRED and design, reproduced below, for the services set forth below:

> Retail store services and online retail store services in the field of consumer electronics, household appliances, home theater equipment, photographic equipment, cellular phones, telecommunications products and services, information technology products, video equipment, audio equipment, portable electronic devices and related accessories, personal computers and other home office products, imaging equipment, digital equipment, video and electronic games, video and electronic game equipment and accessories, entertainment furniture, computer software, entertainment software, compact discs, dvds, audio and video recordings, ring tones, gift cards, books, magazines, batteries, automotive audio equipment, luggage, tote bags, travel accessories, apparel; retail store services featuring a wide variety of consumer goods; retail store services featuring electronics, high-tech, and technology-related

[18] Registered July 26, 2016. The Section 8 declaration of use was due July 26, 2022. To date, Opposer has not filed a declaration of use. The sixth month grace period expires January 26, 2023.

[19] Registered March 12, 2019.

> products including computer software and hardware, in International Class 35;[20]
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> 
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Opposer describes the mark as follows:

> The mark consists of the stylized wording "WIRED" set against square blocks.
>
> Color is not claimed as a feature of the mark.

● Registration No. 5808547 for the mark WIRED MASTERMINDS, in standard character form, for "education and entertainment services, namely, a continuing web-based non-downloadable video series focused on creators and experts demonstrating and explaining various aspects of their work," in International Class 41.[21]

Opposer also alleges prior common law rights in the mark WIRED in connection with a magazine "that focuses on technology, economy and politics."[22]

Finally, Opposer pleads that because its WIRED mark became famous prior to any date on which Applicant may rely, Applicant's marks are likely to dilute

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[20] Registered April 30, 2019.

[21] Registered July 16, 2019.

[22] Notice of Opposition ¶ 4 (1 TTABVUE 13).

Citations to the record and briefs refer to TTABVUE, the Board's online docket system.

Opposer also alleged that "Opposer and its predecessors have adopted and continuously used the WIRED mark in relation to various goods and services" and "[i]n addition, to its media use, Opposer's use of WIRED has been extended to various products." Notice of Opposition ¶¶ 1 and 7 (1 TTABVUE 12 and 13). Opposer's use of the term "various goods and services" and "various products" does not give Applicant sufficient notice as to what other goods and services Opposer is referring to form a basis of a common law pleading. Accordingly, Opposer has not pleaded common law use of the WIRED marks on anything other than a magazine "that focuses on technology, economy and politics."

Opposer's WIRED marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

Applicant, in her Answers, denied the salient allegations of the Notices of Opposition.

In a pretrial order dated July 10, 2020, the Board consolidated the oppositions. We refer to the record in Opposition No. 91245771 unless otherwise indicated.

I. The Record

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's applications.[23] The parties submitted the testimony and evidence listed below:

A. Opposer's testimony and evidence.

1. Notice of reliance on copies of Opposer's pleaded registrations printed from the USPTO Trademark Status and Document Retrieval (TSDR) system showing the current status of and title to the registrations;[24]

2. Notice of reliance on Applicant's admissions to Opposer's first set of requests for admission;[25]

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[23] Therefore, it was not necessary for Applicant to file a notice of reliance on Applicant's applications. (30 TTABVUE 2 and 31 TTABVUE 1350-1465).

[24] 35 TTABVUE.

[25] 37 TTABVUE 7-15.

Denials to admission requests cannot be submitted under notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i) ("[A]n admission to a request for admission … may be made of record in the case by filing … a copy of the request for admission and any exhibit thereto … together with a notice of reliance."). *See also Turdin v. Trilobite, Ltd.,* 109 USPQ2d 1473, 1477 (TTAB 2014) (concurrent use defendant's objection to submission of denial to admission request sustained; "rule does not extend to denials."); *Life Zone Inc. v. Middleman Group Inc.,* 87 USPQ2d 1953, 1957 (TTAB 2008) (denials to requests for admission

3. Notice of reliance on Applicant's responses to Opposer's first set of interrogatories;[26]

4. Notice of reliance on 11 purportedly representative articles published in The New York Times from January 3, 2000 to August 14, 2020, in which Opposer's WIRED trademark appears;[27]

5. Notice of reliance on 10 purportedly representative articles published in USA Today from May 3, 2019 to February 16, 2000, in which Opposer's WIRED trademark appears;[28]

6. Notice of reliance on 11 purportedly representative articles published in The Wall Street Journal from October 26, 2020 to June 5, 2001, in which Opposer's WIRED trademark appears;[29]

7. Notice of reliance on printouts from the TTABVUE database that purportedly show proceedings from 2007 to 2021 where Opposer successfully opposed an application or canceled a registration for a mark containing the term "WIRED";[30]

8. Testimony declaration of Gideon Lichfield, the Global Editorial Director at WIRED magazine;[31] and

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inadmissible). "[U]nlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. *Cf.* Fed. R. Civ. P. 36(b)." *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *1 n.9 (TTAB 2020); *Life Zone*, 87 USPQ2d at 1957 n.10. Accordingly, we consider only Applicant's admissions.

[26] 38 TTABVUE.

[27] 39 TTABVUE.

[28] 40 TTABVUE.

[29] 41 TTABVUE.

[30] 42 TTABVUE.

[31] 43 TTABVUE. Opposer is the owner of Condé Nast, a global mass media company that owns numerous media brands including Wired. Lichfield Testimony Decl. ¶ 1 (43 TTABVUE 2).

The Board posted the portion of the Lichfield testimony declaration designated confidential at 44 TTABVUE.

9. Testimony declaration of Hal Poret, President of Hal Poret, LLC, a company that designs, supervises, and analyzes consumer surveys, including trademark, trade dress, and advertising perception surveys.[32]

B. Applicant's testimony and evidence.

1. Notice of reliance on Opposer's supplemental responses to Applicant's interrogatories;[33]

2. Notice of reliance on Opposer's admissions to Applicant's requests for admission;[34]

3. Notice of reliance on 14 third-party registrations for marks containing the word "Wired" printed from the TSDR database;[35]

4. Notice of reliance on excerpts from third-party websites purportedly marketing, selling, and promoting goods and services under WIRED trademarks;[36]

5. Notice of reliance on a printout of Applicant's website <wired.fit/technology/> and of Applicant's fitness equipment provider's website <wiemspro.com/en/home/>;[37] and

6. Applicant's testimony declaration.[38]

[32] 36 TTABVUE.

[33] 47 TTABVUE.

[34] 48 TTABVUE.

[35] 49 TTABVUE.

[36] 50 TTABVUE.

[37] 51 TTABVUE.

[38] 52 TTABVUE. The Board posted the portions of Applicant's testimony declaration Applicant designated confidential at 53 TTABVUE.

II. Entitlement to a statutory cause of action

Entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277, at *4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

Opposer's use and registration of its WIRED marks establish that it is entitled to oppose the registration of Applicant's marks.[39] *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations "suffice to establish … direct commercial interest"; a belief in likely damage can be shown by establishing a direct commercial interest); *New Era Cap Co., Inc. v. Pro Era, LLC*,

[39] Notice of Opposition ¶¶ 1 and 7 (1 TTABVUE 12 and 13); 35 TTABVUE; Lichfield Testimony Decl. ¶¶ 5, 9, 13-14 (43 TTABVUE 3, 7-8).

2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that plaintiff uses its mark "is sufficient to support [plaintiff's] allegations of a reasonable belief that it would be damaged ….").

Applicant, in her brief, does not contest Opposer's entitlement to a statutory cause of action.

Once Opposer shows an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in an opposition proceeding. *See Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing shown on one ground, plaintiff has right to assert any other ground in proceeding); *Poly-Am., L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground). Accordingly, Opposer has demonstrated its entitlement to a statutory cause of action on grounds of both likelihood of confusion and dilution.

III. Priority

These same pleaded registrations, which Applicant has not counterclaimed to cancel, establish that priority is not an issue as to the marks and the goods and services covered by the registrations. *See 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)).

Applicant, in her brief, does not contest Opposer's prior use of its WIRED marks.

IV. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), 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.

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Whether a likelihood of confusion exists between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). "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 *DuPon*t 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." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.,* 41 USPQ2d at 1533).

"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). "Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.'" *In re Embiid,* 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *See also In re i.am.symbolic, llc,* 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) ("The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but 'may focus … on dispositive factors, such as similarity of the marks and relatedness of the goods.'") (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. The strength of Opposer's WIRED marks

To determine a mark's strength, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its recognition in the

marketplace. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength …."); *Bell's Brewery, Inc. v. Innovation Brewing,* 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. Sept. 2022 update) ("The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

Commercial strength may be measured indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

1. Inherent strength

Opposer has made of record 17 registrations comprising the word "Wired" in whole or in part. The MERRIAM-WEBSTER DICTIONARY (accessed October 3, 2022) defines

"Wired," inter alia, as "connected to a telecommunications network and especially the Internet."[40]

Gideon Lichfield, the Global Editorial Director for Wired magazine, testified that Opposer launched its WIRED magazine in 1993 covering topics related to the digital revolution.[41]

> Today, **Wired** is an American monthly magazine that covers topics such as technology, climate, personal health and fitness, global public health, cyber security, the economy, culture, politics, technology business, and the future of cities.[42]

Accordingly, WIRED is a suggestive mark inasmuch as it requires imagination, thought, or perception to connect the mark WIRED to some of the subject matter of the magazine (i.e., Internet related technology). In this regard, Opposer's WIRED registrations are registered on the Principal Register without a disclaimer of the word "Wired" or a claim of acquired distinctiveness. Suggestive marks are inherently distinctive and should be accorded the scope of protection to which inherently distinctive marks are entitled. *See Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 750 (TTAB 1986); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985)

[40] The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

[41] Lichfield Testimony Decl. ¶ 4 (43 TTABVUE 3).

[42] *Id.*

("[T]he fact that a mark may be somewhat suggestive does not mean that it is a 'weak' mark entitled to a limited scope of protection.").

Opposer, in its brief, agrees that its WIRED marks are suggestive.[43]

2. Commercial strength

Opposer pleaded and argued that its WIRED marks are famous.[44] Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.,* 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton,* 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.,* 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures for the goods and services identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods.,* 63 USPQ2d at 1305-06 and 1309. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable

[43] Opposer's Brief, pp. 26-27 (54 TTABVUE 32-33).

[44] Notice of Opposition ¶¶ 4, 8, and 18 (1 TTABVUE 13 and 15); Opposer's Brief, pp. 9-12 and 26-30 (29 TTABVUE 15-18 and 32-36).

types of goods and services. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

- extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;
- the number of consumers that Opposer solicits through its advertising throughout the year;
- local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and mentions in national publications;
- unsolicited media attention; and
- product placement in television and in movies.

Omaha Steaks Int'l, 128 USPQ2d at 1690-91.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to clearly prove the fame of its pleaded mark. *Coach Servs., Inc. v. Triumph Learning LLC,* 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC,* 82 USPQ2d 1901, 1904 (TTAB 2007)).

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

With this framework in mind, we turn to Opposer's evidence of fame listed below:

● Opposer first published WIRED magazine in 1993 covering topics related to the digital revolution;[45]

● WIRED magazine has approximately 3.5 million readers, 18 million digital users, 20.3 million social media followers, and WIRED videos have over 87 million views;[46]

● WIRED magazine's YouTube channel has approximately 8.31 million subscribers and its videos have accumulated over 2.6 billion video views;[47]

● Elon Musk, Bill Gates, Mark Zuckerberg, Brad Pitt, Jeff Bezos, Will Ferrell, Adam Savage, Jerry Seinfeld, George Lucas, and Serena Williams are some of the people who have appeared on the cover of WIRED magazine;[48]

● Serena Williams, Barack Obama, Jerry Seinfeld, Bill Gates, and Christopher Nolan have acted as guest editors and agreed to dedicate time to working with Opposer's editors to determine the issue contents and theme for issues of WIRED magazine;[49]

● WIRED references have appeared in pop culture media over the past decade. For example,

[45] Lichfield Testimony Decl. ¶ 4 (43 TTABVUE 3).
[46] Lichfield Testimony Decl. ¶ 10 (43 TTABVUE 7).
[47] Lichfield Testimony Decl. ¶ 21 (43 TTABVUE 9).
[48] Lichfield Testimony Decl. ¶ 12 (43 TTABVUE 8).
[49] Lichfield Testimony Decl. ¶ 12 (43 TTABVUE 8).

- The television show Jeopardy used WIRED magazine as an answer to a question;
- HBO's Last Week Tonight by John Oliver referred to WIRED magazine;
- TBS' Full Frontal with Samantha Bee referred to WIRED as a "nerd mag";
- The HBO series Silicon Valley referred to WIRED magazine;
- The 2015 film Ant-Man referred to WIRED magazine in its bonus features; and
- The 2008 filed Iron Man referred to WIRED magazine.[50]

● In 2015, WIRED magazine collaborated with Sports Illustrated for a 10-part video series concerning Super Bowl 100, the NFL, and insights into the game;[51]

● In February 2016, WIRED published an exclusive behind-the-scenes look at the new NFL stadium, Levi's Stadium, home of Super Bowl 50;[52]

● "In partnership with Porsche and Lucasfilm, Wired created a one-of-a-kind, custom video that provided viewers an exclusive, in-depth look into the concept and creation of the Porsche Taycan, highlighting the unique parallels between this vehicle and Lucasfilm's iconic Star Wars series.";[53]

[50] Lichfield Testimony Decl. ¶ 22 (43 TTABVUE 10).

[51] Lichfield Testimony Decl. ¶ 24 (43 TTABVUE 10).

[52] Lichfield Testimony Decl. ¶ 25 (43 TTABVUE 10).

[53] Lichfield Testimony Decl. ¶ 26 (43 TTABVUE 10).

● "Wired has [millions of] clicks per year to commerce from gear reviews and buying guides, averaging [thousands of] clicks per day. In 2019, these clicks generated approximately [millions of dollars] in sales.";[54]

● WIRED magazine's gross revenues from advertising from 2017 through 2020 have been in the tens of millions of dollars;[55]

● WIRED magazine's gross revenues for "consumer revenue (which includes digital subscriptions)" from 2017 through 2020 are in the millions of dollars;[56] and

● In an online aided awareness survey among U.S. consumers consisting of 300 respondents, 136 or 45.3% have seen or heard of WIRED magazine.[57] An "[a]ided awareness [survey] is when you actually show the mark at issue to the respondents and you see if they answer yes that they have seen or heard of this mark."[58] "The relevant universe for this survey consisted of U.S. consumers age 18 and older so that the survey could assess the rate of awareness of the WIRED mark among the general public."[59]

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[54] Lichfield Testimony Decl. ¶ 15 (44 TTABVUE 8) (confidential). Because Opposer designated the number of clicks and revenue generated as confidential, we refer to them in general terms.

[55] Lichfield Testimony Decl. ¶ 16 (44 TTABVUE 9) (confidential). Because Opposer designated its gross revenues from advertising revenues as confidential, we refer to them in general terms.

[56] Lichfield Testimony Decl. ¶ 16 (44 TTABVUE 9) (confidential). Because Opposer designated its gross revenues from consumer revenue as confidential, we refer to them in general terms.

[57] Poret Testimony Dep., pp. 31-34 and Exhibit 1 (36 TTABVUE 35-38 and 122).

[58] Poret Testimony Dep., pp. 14-15 (36 TTABVUE 18-19).

[59] Poret Testimony Dep., Exhibit 1 (36 TTABVUE 123).

In opposition to Opposer's testimony and evidence regarding the commercial strength of its WIRED marks, Applicant introduced "printouts of various websites marketing, selling, promoting goods and services under WIRED trademarks."[60] The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods and services. *DuPont,* 177 USPQ at 567; *In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018) ("Evidence of third-party use may reflect commercial weakness."). Applicant introduced excerpts from the following third-party websites:[61]

- Wired Technologies Electronic Systems (wiredtechsys.com) advertising design, sales, installation and service of commercial electronic systems;[62]
- Wired Technology Company (no url provided) advertising aerial videography;[63]

[60] 50 TTABVUE 4.

[61] Applicant also listed the following URLs but did not introduce excerpts from the websites themselves: wiredadvisor.com, wiredinvestors.com, hiphopwired.com, wiredco.com, wired-designs.com, wiredscore.com, wiredsearchgroup.com, and wiredtechco.com. Providing only a website address or hyperlink to Internet materials is insufficient to make such materials of record because of the transitory nature of Internet postings. Websites referenced only by addresses or hyperlinks may be modified or deleted at a later date without notification. *Safer v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). *See also In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (*citing In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)). To properly introduce Internet evidence into the record, a party must provide (1) an image of the webpage, (2) the date the evidence was downloaded or accessed, and (3) the complete URL of the webpage. *See Safer,* 94 USPQ2d at 1039; *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018). Accordingly, we will not consider the Internet URLs without a corresponding copy of the webpages. *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.14 (TTAB 2018) ("The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.").

[62] 50 TTABVUE 2.

[63] 50 TTABVUE 3.

- Wired (wiredthegame.com) an "atmospheric puzzle-platform game";[64]
- Wired Quartz men's wrist watch (amazon.com) (unavailable);[65]
- Wired (soundcloud.com) for what appears to be a streaming service;[66]
- Wired to Wear exhibit of wearable technology at the Chicago Museum of Science and Industry (msichicago.org);[67]
- Wired (windresistance.bigcartel.com) for what appears to be a fashion website;[68]
- Wired Gallery art gallery (thewiredgallery.com);[69]
- Wired Ice Cream (gol;dbelly.com);[70] and
- Wired Energy Drinks (wiredenergydrink.com).[71]

None of the above-noted websites are used in connection with magazines and Applicant has not demonstrated that the goods and services identified by the third-party marks are related to magazines or any of the other associated goods or services for which Opposer has registered its WIRED marks. Therefore, they do not diminish the commercial strength of the Opposer's WIRED marks. *Cf. Omaha Steaks Int'l*, 128 USPQ2d at 1694 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus "on goods shown to be similar"); *TAO Licensing,*

[64] 50 TTABVUE 8.
[65] 50 TTABVUE 9.
[66] 50 TTABVUE 10.
[67] 50 TTABVUE 11.
[68] 50 TTABVUE 12.
[69] 50 TTABVUE 13.
[70] 50 TTABVUE 15.
[71] 50 TTABVUE 16.

LLC v. Bender Consulting Ltd., 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields "have no bearing on the strength of the term in the context relevant to this case.").

Based on the evidence discussed above, we find that WIRED falls on the very strong side of the spectrum from very strong to very weak in connection with magazines covering the digital revolution, culture, lifestyle and technology, as well as for providing information about business, politics, technology, electronics, science, celebrities, entertainment and pop culture via the Internet. Considering the record as a whole (i.e., the WIRED marks are suggestive but are commercially strong), Opposer's marks are entitled to a broader scope of protection than is normally accorded to an inherently distinctive suggestive mark because of their commercial strength. *See Cadence Indus. Corp. v. Kerr,* 225 USPQ 331, 334 (TTAB 1985) (with sufficient sales, advertising and promotion thereof, a suggestive mark may well be categorized, despite its suggestive nature, as a strong mark).

B. The similarity or dissimilarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont,* 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is

sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

We reproduce below the marks at issue:

Opposer's Marks	**Applicant's Marks**
WIRED	WIRED
WIRED AUTOCOMPLETE INTERVIEW	WIRED.FIT
WIRED MASTERMINDS	

The dominant element of Opposer's marks is the word "Wired." With respect to the stylized and design marks, neither the style, nor the design elements, are sufficiently distinctive as to make a commercial impression separate and apart from the word "Wired." *See In re Serial Podcast, LLC,* 126 USPQ2d 1061 1073 (TTAB 2018) (having found that SERIAL is generic, the Board also found that the design elements in the marks reproduced below – their typeface and color of the letters and the rounded rectangular backdrops for each letter – are not inherently distinctive).

In addition, in the case of Opposer's WIRED and design marks, we accord the word WIRED greater weight because it is more likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because "[t]he word portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Aquitaine Wine USA*, 126 USPQ2d at 1184 (quoting *Viterra*, 101 USPQ2d at 1911).

With respect to the marks WIRED AUTOCOMPLETE INTERVIEW, WIRED MASTERMINDS, WIRED BY DESIGN, WIRED SCIENCE, and WIRED STORE, the word "Wired" is the dominant part of those marks for two reasons. First, the word "Wired" is the first part of the mark. The lead element in a mark has a position of prominence; it is likely to be noticed and remembered by consumers and so as to play a dominant role in the mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v.*

Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Second, the word "Wired" is that part of the marks that consumers will perceive as indicating source for the reasons below:

● In the registrations for the marks WIRED AUTOCOMPLETE INTERVIEW ("a continuing web-based non-downloadable video series focused on celebrities answering the internet's most searched questions"), WIRED STORE (retail store services), and WIRED SCIENCE ("blogs and non-downloadable publications in the nature of articles and journals in the field of science"), "Autocomplete Interview," "Store," and "Science" are descriptive and Opposer has disclaimed the exclusive right to use them. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("Given the descriptive nature of the disclaimed word 'Technologies,' the Board correctly found that the word 'Packard' is the dominant and distinguishing element of PACKARD TECHNOLOGIES."); *Dixie Rests.,* 41 USPQ2d at 1533-34 (disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks); *In re Code Consultants, Inc.,* 60 USPQ2d 1699, 1702 (TTAB 2001) (descriptive matter that is disclaimed often "less significant in creating the mark's commercial impression").

● Opposer registered the mark WIRED BY DESIGN for "arranging and conducting educational conferences; organizing exhibitions for educational purposes **in the field of design**; entertainment services in the nature of non-downloadable video series in the fields of technology, **design** and innovation, culture and science"

(emphasis added). The mark in its entirety suggests the nature of Opposer's educational services and video series thereby leaving consumers to focus on the word "Wired" for indicating source.

● Finally, with respect to the registration of the mark WIRED MASTERMINDS used in connection with "a continuing web-based non-downloadable video series focused on creators and experts demonstrating and explaining various aspects of their work," the MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed October 11, 2022) defines "Mastermind" as "a person who supplies the directing or creative intelligence for a project." "Masterminds" are the "creators and experts" who are the subject of the video series. Accordingly, "Masterminds" is suggestive of the services leaving the word "Wired" as the dominant part of the mark.

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Viterra Inc.*, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The same reasoning holds true with Applicant's mark WIRED.FIT. First, the word "Wired" is the first part of the mark and, therefore, has a position of prominence. Second, because WIRED.FIT is proposed for use in connection with, inter alia, fitness instruction, the word "Fit" is descriptive and Applicant has disclaimed the exclusive right to its use. Disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because consumers will tend to focus on the

more distinctive parts of marks. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *Dixie Rests.,* 41 USPQ2d at 1533-34); *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *Nat'l Data Corp.*, 224 USPQ at 752); *In re Code Consultants,* 60 USPQ2d at 1702 (disclaimed matter is often "less significant in creating the mark's commercial impression.").

With respect to Applicant's WIRED and design mark, the word "Wired" is the most prominent part of the mark. *See Aquitaine Wine USA,* 126 USPQ2d at 1184 (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 218 USPQ at, 200).

In this case, the word "Wired" is the common, dominant part of all the marks. The peripheral differences are not sufficient to distinguish the marks. *See In re Denisi,* 225 USPQ 624, 624 (TTAB 1985) ("[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences."). Therefore, we find the marks are identical or otherwise very similar in appearance and sound.

We now turn to the meaning and commercial impression engendered by the use of the word "Wired" in the marks. As discussed above, Opposer uses the word "Wired" to mean and create the commercial impression of being connected to the Internet. On the other hand, Applicant intends to use her marks in connection with, inter alia,

fitness services incorporating electrical muscle stimulation and athletic clothing.[72] The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed October 4, 2022) defines "Wired," inter alia, as "furnished with wires (as for electrical connections)." Accordingly, while Opposer's use of "Wired" means and engenders the commercial impression of being connected to the Internet, Applicant's proposed use of "Wired" means and engenders the commercial impression of being connected by wires or electrical connections. While the specific meaning and commercial impressions of the parties' marks are different, they share the similarity of "connection," either a connection to the Internet or an electrical connection.

We find that similarities of the marks outweigh the dissimilarities and, therefore, this *DuPont* factor weighs in favor of finding a likelihood of confusion.

A. The similarity or dissimilarity and nature of the goods and services, and established, likely-to-continue channels of trade

Applicant is seeking registration for her WIRED marks for fitness related services including electrical muscle stimulation fitness and for athletic clothing. Applicant's proposed fitness related services utilize "an integral muscle electrostimulation

[72] Because there are no limitations or restrictions in Applicant's description of goods for athletic clothing, we presume Applicant's athletic clothing include all goods of the type identified including athletic clothing used in connection with fitness services involving electrical stimulation. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC,* 81 USPQ2d 1887, 1893 (TTAB 2007).

system that includes suit/vest, device, APP and training"[73] "operated with IPAD [sic]."[74] Specifically,

> State of the art technology is designed to complete the body's naturally generated impulses and harmlessly engage the muscles to their full potential. Combined with a wireless feature and carefully crafted flexible suits Wired Fit offers the most accessible and comfortable experience of this new exceptional technology.[75]

We reproduce below a photograph of the electrical muscle stimulation system suit:[76]

The evidence discussed above sheds light on the meaning of Applicant's description of services. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410, 1413 (TTAB 2010) (considering extrinsic evidence to understand nature

[73] 51 TTABVUE 6.

[74] 51 TTABVUE 5.

[75] 51 TTABVUE 5.

[76] 51 TTABVUE 6.

of identified technical goods); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (considering extrinsic evidence where description of goods is somewhat vague). *See also Pharmacia Inc. v. Asahi Med. Co., Ltd.*, 222 USPQ 84, 85-86 (TTAB 1984) (the Board must be concerned that the uses and meanings of technical or scientific terms in the description of goods have been made clear to properly assess the relationship between the goods). We have considered Applicant's evidence for purposes of clarification and not as an improper attempt to restrict the goods and services as identified in the applications.

Opposer, on the other hand, uses and registered its WIRED marks for magazines covering the digital revolution, culture, lifestyle and technology, as well as providing information about business, politics, technology, electronics, science, celebrities, entertainment and pop culture via the Internet. In addition, Opposer has registered its WIRED and design mark  for retail store services and online retail services featuring electronics, high-tech, and technology-related products including computer software and hardware, as well as apparel.[77]

With respect to apparel, Opposer's WIRED retail and online retail store services feature apparel and Applicant is seeking to register her WIRED mark for a variety of

[77] Gideon Lichfield testified that "***Wired*** branded goods and services are sold at a variety of price points," "[Opposer] has spent substantial sums advertising and promoting its ***Wired*** products and services that are sold and provided under the ***Wired*** mark," and "[Opposer] markets and advertises its ***Wired*** branded content through print publications, social media, podcasts, online advertising, as well as audio, video, and digital content." Lichfield Testimony Decl. ¶¶ 16, 19, and 20 (43 TTABVUE 9). Except for magazines and providing information via the Internet, Opposer has not identified any other WIRED branded goods or services.

clothing items. These are competitive, inherently related goods and services. *See, e.g.*, *Detroit Athletic Co,* 128 USPQ2d at 1051 (sports apparel retail services and clothing are related because "[i]t is therefore 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.'"); *In re Hyper Shoppes (Ohio), Inc.,* 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir 1988) (furniture and general merchandise store services are related goods and services); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (jewelry and jewelry store services are related); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 866 (TTAB 1985) ("[T]here is little question that jewelry store services and jewelry are highly related goods and services."); *In re Jewelmasters, Inc.*, 221 USPQ 90 (TTAB 1983). *See also* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:25 ("Where the services consist of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sold through such a retail outlet.").

Because Applicant's clothing and Opposer's retail store services featuring apparel are inherently related, and there are no restrictions as to their channels of trade or classes of purchasers, we find they must be promoted in the same channels of trade and directed to the same purchasers. *Thomas*, 79 USPQ2d at 1023. *See also Detroit Athletic Co.,* 128 USPQ2d at 1052.

We now turn to whether Applicant's fitness related services are related to Opposer's goods or services. Opposer contends that because Opposer "has extensively covered fitness gear, apps, and technological devices over the past decade, including,

for example, fitness trackers, wireless earbuds for working out, running gear, electric bikes, weighted vests, and treadmills" and "has an entire section of its **WIRED** website titled GEAR that is dedicated to product reviews for various accessories, cameras, computers, gaming, headphones, home devices, tablets, and television," Applicant's fitness related services are related to Opposer's goods and services.[78]

> Accordingly, Applicant's personal fitness, exercise, and sporting services using advanced technology and athletic apparel are highly similar to Opposer's entertainment and editorial content concerning product recommendations for technology, personal fitness, running gear, and gadgets.[79]

Opposer argues, in essence, any subject Opposer's magazine or online services covers are potentially related goods or services.

We disagree because Opposer's contention comes too close to a claim of rights in gross. The general renown of Opposer's WIRED publication and online services is not sufficient in of itself to establish likelihood of confusion. If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

> The fame of the [plaintiff's] name is insufficient in itself to establish likelihood of confusion under 2(d). "Likely * * * to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold

[78] Opposer's Brief, p. 25-26 (54 TTABVUE 31-32).

[79] Opposer's Brief, p. 26 (54 TTABVUE 32).

> otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 U.S.C. 1052(d).

See also Recot, 54 USPQ2d at 1898 ("[F]ame alone cannot overwhelm the other du Pont factors as a matter of law.").

In this case, there is no testimony or evidence that Opposer sells WIRED branded products, nor is there any testimony or evidence that any third-party publishers sell products featuring the same mark as their publications. Opposer did not introduce any third-party registrations showing the mark used for publications or providing information or blogs through the Internet and for products featuring the same mark.[80] Finally, there is no evidence that consumers will mistakenly believe that products or services bearing the same mark as a publication or online information service emanate from the same source.

Opposer failed to meet its burden of proving that consumers will perceive Applicant's fitness related services and Opposer's publications and online information services emanate from a single source and, therefore, are related.

Likewise, Opposer failed to meet its burden of proving that the channels of trade and classes of consumers for Applicant's fitness services and Opposer's publications and online information services are similar.

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[80] Third-party registrations based on use in commerce that individually cover a number of different goods or services may have probative value to the extent that they serve to suggest that the listed goods or services are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *8 (TTAB 2019); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013); *In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785-86 (TTAB 1993);

B. Conclusion

As discussed above, we find that Opposer's WIRED marks are on the very strong side of the spectrum of from very weak to very strong and that Applicant's marks are similar to Opposer's marks. However, with respect to Applicant's applications for fitness services, we find that the differences in the goods and services are significant countervailing factors. *See Blue Man Prods. Inc. v. Tarman*, 75 USPQ2d 1811, 1819 (TTAB 2005), *rev'd on other grounds*, Civil Action No. 05-2037, 2008WL 6862402 (D.D.C. April 3, 2008); *Burns Philp Food Inc. v. Modern Prods. Inc.*, 24 USPQ2d 1157 (TTAB 1992), *aff'd unpub op.*, 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993). Therefore, we find that Applicant's mark WIRED (Serial No. 87745678 – Opposition No. 91245771), WIRED.FIT (Serial No. 88502457 – Opposition No. 91253089), and WIRED and design  (Serial No. 88503089 – Opposition No. 91253089) for fitness related services are not likely to cause confusion with Opposer's WIRED marks.

On the other hand, because of the strength of Opposer's WIRED marks, the similarity of the marks, the similarity of the goods and services and channels of trade, we find that Applicant's mark WIRED for clothing (Serial No. 87978857 – Opposition No. 91254140) is likely to cause confusion with Opposer's WIRED and design mark  for retail store and online retail store services featuring clothing.

V. Dilution

Dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B).[81] Dilution may be likely "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 43(c)(1).

The Federal Circuit, has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

(1) the plaintiff owns a famous mark that is distinctive;

(2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;

(3) the defendant's use of its mark began after the plaintiff's mark became famous; and

(4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs., 101 USPQ2d at 1723-24.

[81] Dilution by tarnishment "is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." Section 43(c)(2)(C) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(C). Inasmuch as the marks at issue are identical or otherwise very similar, Applicant uses her WIRED marks for fitness services and clothing, and there is no evidence that Applicant's WIRED marks harm Opposer's reputation, we focus our dilution analysis on dilution by blurring.

A. Fame for Dilution

A threshold question in a federal dilution claim is whether the plaintiff's mark is "famous." *Coach Servs.*, 101 USPQ2d at 1724. A mark is famous for dilution purposes "if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Section 43(c)(2)(A) of the Trademark Act, 15 U.S.C. § 43(c)(2)(A). There are four non-exclusive factors to consider when determining whether a mark is famous:

i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark.

iii. The extent of actual recognition of the mark.

iv. Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Id. *See also McDonald's Corp. v. McSweet LLC,* 112 USPQ2d 1268, 1286 (TTAB 2014).

While fame for likelihood of confusion is a matter of degree along a continuum, fame for dilution "is an either/or proposition" – it either exists or does not. *Coach Servs.*, 101 USPQ2d at 1724 (quoting *Palm Bay Imps.,* 73 USPQ2d at 1694). Accordingly, a mark can acquire "sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame." *Id.* (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d

1715, 1722 (TTAB 2007)). As the Federal Circuit observed, "It is well-established that dilution fame is difficult to prove." *Id.*

To achieve fame for purposes of dilution, the plaintiff's mark must be so well known as to have achieved the status of a household name. *See id.* at 1725 (COACH for high-end handbags and leather goods was not a "famous" mark for purposes of dilution because it has not attained the status of a household name); *Pure & Simple Concepts, Inc. v. I H W Mgm't Ltd.,* 857 F.App'x 652, 2021 USPQ2d 565, at *6 (Fed. Cir. 2021) (a mark is not famous for dilution unless it rises to the level of consumer recognition as a household name); *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.,* 102 USPQ2d 1187, 1197 (TTAB 2012).

Professor McCarthy posits that a threshold response in the range of 75% of the general consuming public is necessary to prove fame for purposes of dilution. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:106. *See also 7-Eleven Inc. v. Wechsler,* 83 USPQ2d at 1723, 1727-28 (BIG GULP for a large sized drink was found to be "famous" based in part on evidence of an unaided awareness by 73% of all consumers); *NASDAQ Stock Mkt., Inc. v. Antartica, S.R.L.,* 69 USPQ2d 1718, 1729, 1737 (TTAB 2003) (NASDAQ was found to be "famous" based in part on evidence of awareness by 80% of all investors).

Assuming arguendo that the duration, extent, and geographic reach of advertising and publicity of Opposer's WIRED marks and the amount, volume, and geographic extent of their sales offered under the marks meet the requirements for dilution fame,

the extent of recognition of the marks falls short of proving fame for dilution. For example,

● Opposer relies on the Poret awareness survey discussed above in the commercial strength section of the decision. Opposer's WIRED marks have a 45% aided awareness sufficient for establishing their commercial strength for likelihood of confusion but not dilution. Presumably general public unaided awareness of Opposer's WIRED marks is less than the 45% aided awareness;

● The third-party publication references to WIRED publications are not pervasive and do not reflect extreme renown. The third-party publications do nothing more than quote WIRED magazine as a source. They do not offer any evidence of actual recognition of the renown of the WIRED publications. For example,

- The New York Times (May 15, 2016)

> "I thought that was actually kind of boring, that search for perfection, she told Caitlan Roper of Wired magazine in 2014."[82]

- USA Today (July 18, 2016)

> His column, in plain, readable English but chock full of information useful for the geekiest of geeks, has won him legions of fans, critics and respect from the highest levels of Silicon Valley. Wired magazine once called him "The Kingmaker."[83]

- The Wall Street Journal (October 26, 2020)

> Mr. Biden responded: "The fact is, it's going to create millions of good-paying jobs, and these tax incentives for

[82] 39 TTABVUE 10.

[83] 40 TTABVUE 8.

> people to weatherize" are "going to make the economy much safer." Maybe he cribbed this from Al Gore in Wired magazine last year. "Now think about the Green New Deal," Mr. Gore wrote. "What it encompasses are two things we have to solve: the climate crises and the opportunity to create tens of millions of new jobs." That includes "retrofitting residential, commercial, and industrial buildings."[84]

● There is no evidence of Opposer receiving any awards or other recognition for its WIRED publications acknowledging the public's awareness of WIRED publications.

We find that Opposer's WIRED marks are not famous for purposes of dilution. Opposer therefore cannot prevail on its dilution claim and we dismiss it. *See Coach Servs., Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600, 1612 (TTAB 2010), *aff'd.,* 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

Decision: We sustain the Section 2(d) likelihood of confusion claim in Opposition No. 91254140 and refuse to register Applicant's mark WIRED for clothing, in International Class 25 (Serial No. 87978857).

We dismiss the Section 2(d) likelihood of confusion claim in Opposition No. 91245771 against the mark WIRED (Serial No. 87745678), in Opposition No. 9253089 for the mark WIRED.FIT (Serial No. 87745679), and in Opposition No. 91253089 for the mark WIRED and design (Serial No. 88503089) for fitness related services, in International Class 41.

We dismiss the Section 43(c) likelihood of dilution claim.

[84] 41 TTABVUE 8.