

This Opinion is Not a
Precedent of the TTAB

Mailed: December 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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RLP Ventures, LLC

v.

Heising-Simons Foundation

—
Opposition No. 91246949 (Parent)
—

Heising-Simons Foundation

v.

RLP Ventures, LLC

—
Opposition No. 91247701 (Child)
—

Williard A. Stanback of Willard Alonzo Stanback PC, for RLP Ventures, LLC.¹

Nate A. Garhart of Farella Braun Martel LLP, for Heising-Simons Foundation.

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Before Adlin, Allard, and Myles,
Administrative Trademark Judges.

Opinion by Myles, Administrative Trademark Judge:

This is a consolidated case comprising Opposition Nos. 91246949 and 91247701.²

In Opposition No. 91246949, RLP Ventures, LLC (“Opposer” or “RLP”) opposes

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¹ RLP Ventures, LLC filed a revocation of power of attorney for Mr. Stanback on November 18, 2021, and later filed a power of attorney again appointing Mr. Stanback as attorney of record on September 14, 2023.

² The Board previously consolidated these oppositions and designated Opposition No. 91246949 as the parent case. 18 TTABVUE in Opposition No. 91246949 and 15 TTABVUE in Opposition No. 91247701. Unless otherwise noted, citations in this opinion refer to the

Heising-Simons Foundation’s (“Applicant” or the “Foundation”) application for the standard character mark AMERICAN MOSAIC JOURNALISM PRIZE for “Nonprofit services, namely the awarding of fellowships and monetary prizes in the field of journalism” in International Class 36,³ on the sole ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its two prior, pleaded Registration Nos. 5335465 and 5409856 for the mark MOSAEC for information and entertainment services,⁴ and its alleged prior common law use of the same mark.

record in the parent case in TTABVUE, the Board’s online docketing system. *See New Era Cap. Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, the citation form in this opinion is in a form provided in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the Lexis database. Practitioners should adhere to the practice set forth in TBMP § 101.03. Precedential decisions of the Board, and precedential decisions of the Federal Circuit involving Board decisions that issued January 1, 2008, or after may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

³ Application Serial No. 87719916, filed December 13, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). “JOURNALISM PRIZE” is disclaimed.

⁴ “Providing information in the field of temporary lodging and accommodations for travelers; Providing information, news and commentary in the field of dining” in International Class 43 for Registration No. 5335465; and “Entertainment services, namely, providing information by means of a global computer network in the fields of celebrities, entertainment, and popular culture; Entertainment services, namely, providing on-line reviews of entertainment, film, fine arts, museums, literature, culture, music, sports, fashion, theater, and dance; Providing a website featuring entertainment information in the field(s) of entertainment, film, fine arts, museums, literature, culture, music, sports, fashion, theater, dance, and news; Providing information, news and commentary in the field of entertainment; Providing information,

RLP also pleads ownership of a prior-filed pending application for the standard character mark MOSAEC for “Fundraising services, by means of sharing profits from the sale of socially responsible products with not-for-profit organizations, schools, and civic groups; Charitable fundraising services for namely, raising funds to support programs related to engagement in entertainment, film, fine arts, museums, literature, culture, music, sports, fashion, theater, dance, culinary, recreation and leisure activities; On-line business fundraising services” in International Class 36.⁵

In its amended answer, the Foundation denies the salient allegations in the notice of opposition.⁶

The Foundation asserted counterclaims to cancel each of RLP’s pleaded registrations in Opposition No. 91246949 and opposed registration of RLP’s pending application in Opposition No. 91247701; however, the Foundation did not support its counterclaims in Opposition No. 91246949 or its claims in Opposition No. 91247701 with evidence, and in its trial brief, it states that it “does not intend to further prosecute cancellation of [RLP’s] Registrations or the opposition to the registration of [RLP’s] Application.”⁷ The Foundation’s counterclaims in Opposition No. 91246949

news and commentary in the field of recreation and leisure activities; Provision of information relating to children’s entertainment” in International Class 41 for Registration No. 5409856. Section 8 declarations filed May 14, 2024 and May 28, 2024, respectively.

⁵ Application Serial No. 87469079, filed May 31, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use of the mark and first use in commerce at least as early as May 1999.

⁶ The Board’s December 13, 2022 order construed the Foundation’s first affirmative defense alleging no likelihood of confusion as a mere amplification of the Foundation’s denial of RLP’s likelihood of confusion claim and struck the Foundation’s second, third, fourth, and fifth affirmative defenses. 43 TTABVUE 3-4 n.7.

⁷ 66 TTABVUE 6.

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and claims in Opposition No. 91247701 are therefore waived or forfeited. *See Gen. Mills v. Fage Dairy Processing Indus. SA*, Opp. No. 91118482, 2011 TTAB LEXIS 280, at *2 n.1 (TTAB 2011) (“Claims, counterclaims, or defenses which are not argued in a party’s brief are considered waived.”), *judgment set aside on other grounds*, 2014 TTAB LEXIS 5 (TTAB 2014) (not precedent); *J.S. Paluch Co., Inc. v. Irwin*, Opp. No. 91062097, 1982 TTAB LEXIS 53, at *8 n.4 (TTAB 1982) (abandonment counterclaim not supported by evidence or raised in brief waived).

The only remaining claim is therefore RLP’s claim of likelihood of confusion in Opposition No. 91246949. Opposer, as the plaintiff, bears the burden of establishing its entitlement to a statutory cause of action and likelihood of confusion by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, Can. No. 92042871, 2007 TTAB LEXIS 47, at *7 (TTAB 2007).

I. The Foundation’s Motion to Reopen

As last reset by the Board’s May 9, 2023 order, the Foundation’s 30-day testimony period was set to close on September 1, 2023.⁸ On September 5, 2023, the Foundation filed an additional notice of reliance and testimony declaration contemporaneously with a motion to reopen its testimony period to accept the late-filed evidence and testimony.⁹ RLP did not oppose the motion. *See* Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a). The Foundation’s motion to reopen is therefore **granted** as conceded and

⁸ 47 TTABVUE 7.

⁹ 57-59 TTABVUE.

the Foundation's September 5, 2023 testimony declaration and notice of reliance are accepted as timely and have been considered.

II. The Record and Evidentiary Matters

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed applications and RLP's pleaded registrations that were subject to the counterclaims. In addition, RLP made the following of record during its opening testimony period:

- RLP's first notice of reliance¹⁰ on: (1) USPTO's Trademark Status & Document Retrieval (TSDR) database records for RLP's pleaded application and registrations and the Foundation's involved application;¹¹ (2) copies of the Foundation's discovery responses;¹² and (3) copies of Internet printouts.¹³

¹⁰ 48-49 TTABVUE (public version) and 51-52 TTABVUE (confidential).

¹¹ 48 TTABVUE 11-72. As explained above, these files are automatically of record and RLP's submission thereof was unnecessary.

¹² *Id.* at 74-375. Denials to requests for admission cannot be submitted under notice of reliance, and the Foundation's responses to RLP's requests for admission are therefore considered only to the extent they contain admissions. *See* Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). Written responses to requests for production of documents introduced through notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents. *See McGowen Precision Barrels, LLC v. Proof Research, Inc.*, Can. No. 92067618, 2021 TTAB LEXIS 167, at *7 n.6 (TTAB 2021). RLP also submitted its own disclosures and discovery responses. A party may not submit its own written disclosures or discovery responses under notice of reliance, except to the extent necessary to make not misleading the discovery responses submitted by the inquiring party. Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5). RLP's submission of its own initial disclosures and discovery responses are therefore not considered.

¹³ Internet printouts bearing both the URL and date of access are admissible under notice of reliance pursuant to Trademark Rule 2.120(e)(2), but only for what the documents show on their face. *See WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 TTAB LEXIS 72, at *11 (TTAB 2018). RLP also filed numerous documents that are not Internet materials, official records, or printed publications. There is no provision in the Trademark Rules that allows for introduction by notice of reliance of one's own produced documents, unless they are printed publications, Internet materials, or official records, and therefore we have not considered these documents. *See* Trademark Rule

- The testimony declaration of RLP's owner and Principal, Ramona Prioleau;¹⁴
- The testimony declaration of Samantha Miller, "director of partnership programs for a non-profit," who attaches copies of email communications;¹⁵
- The testimony declaration of Kescia I. Prioleau, a Special Education Teacher/Applied Behavioral Analysis Provider, who attaches copies of a letter signed by Ramona Prioleau, a "New Journalist Application," a "Mentoring Agreement," a document titled "The MOSAEC Experience," and a document titled "The Business of Publishing;"¹⁶
- The testimony declaration of Dr. Pamela Perry, a physician, who attaches a copy of RLP's website.¹⁷

The Foundation made the following of record during its trial period:

- The Foundation's first notice of reliance containing: (1) copies of third-party registrations,¹⁸ (2) copies of third-party websites,¹⁹ (3) copies of settlement agreements between RLP and third-parties,²⁰ (4) copies of third-party webpages showing use of the phrase "American Mosaic,"²¹ and (5) a dictionary definition of "mosaic" obtained from dictionary.com;²²
- The testimony declaration of Nate A. Garhart, the Foundation's counsel;²³

2.122(e), 37 C.F.R. § 2.122(e); *see also* Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii).

¹⁴ 53 TTABVUE 2-10.

¹⁵ *Id.* at 11-18.

¹⁶ *Id.* at 19-29.

¹⁷ *Id.* at 30-34. RLP filed "confidential" copies of all of its testimony declarations at 50 TTABVUE. The confidential versions and public versions are identical and even redact the same information.

¹⁸ 54 TTABVUE 11-42.

¹⁹ *Id.* at 44-112.

²⁰ *Id.* at 114-36.

²¹ *Id.* at 138-244.

²² *Id.* at 246-56.

²³ *Id.* at 257-62 and 56 TTABVUE (the Foundation submitted the same declaration twice).

- The Foundation’s second notice of reliance attaching additional examples of third-party websites;²⁴ and
- The supplemental testimony declaration of Mr. Garhart.²⁵

On rebuttal, RLP submits the following:

- RLP’s second notice of reliance,²⁶ attaching, inter alia: (1) copies of its disclosures and discovery requests;²⁷ (2) Internet printouts;²⁸ (3) copies of TSDR records for third-party registrations;²⁹ (4) copies of pages obtained from RLP’s website and RLP’s Instagram page;³⁰ (5) a copy of the entry for mosaic.com from the WHOIS database at godaddy.com;³¹ (6) official records;³² and (7) webpages from store.mosaec.com;³³ and
- The second testimony declaration of Ramona Prioleau, who purports to authenticate “particular portions of Exhibit U.”³⁴

As an initial matter, we find it necessary to address RLP’s filing and presentation of evidence during trial. First, RLP filed numerous exhibits that were submitted both as exhibits to a notice of reliance and a testimony declaration. Certain documents may be admissible under notice of reliance alone under Trademark Rule 2.122(d), (e),

²⁴ 59 TTABVUE.

²⁵ 58 TTABVUE.

²⁶ 62 TTABVUE (public) and 61 TTABVUE (confidential).

²⁷ *Id.* at 78-216 and 745-863.

²⁸ *Id.* at 866-1218. RLP again filed other documents that are not Internet materials, official records, or printed publications, and are therefore inadmissible under notice of reliance.

²⁹ *Id.* at 1220-47.

³⁰ *Id.* at 1251-54 and 1267-76.

³¹ *Id.* at 1255-60.

³² *Id.* at 1261-62.

³³ *Id.* at 1263-66.

³⁴ 63 TTABVUE (public) and 64 TTABVUE (confidential). Paragraphs 1-9 and 29-43 are duplicative of paragraphs 1-9 and 29-43 of the first testimony declaration of Ramona Prioleau at 53 TTABVUE 2-10. “Exhibit U” corresponds to Exhibit U in RLP’s first and second notices of reliance. RLP re-attaches some of the same exhibits to the rebuttal declaration of Ramona Prioleau, presumably the “particular portions of Exhibit U” she purports to authenticate.

or (g), 37 C.F.R. §§2.122(d), (e), and (g). Documents and other evidence that are not self-authenticating or admissible under notice of reliance (or that are offered to prove the truth of the matter asserted therein), may be submitted if sufficiently authenticated by testimony. If a party submits evidence with a testimony declaration or affidavit, as was the case here, it is duplicative to submit the same evidence separately under notice of reliance. Doing so needlessly expands the trial record and increases the burden on the Board in reviewing the duplicative evidence.³⁵ Of course, the materials accompanied by testimony are admissible for the truth of the matters asserted, while materials submitted via notice of reliance are not.

RLP also failed to heed the Board's advice in its December 13, 2022 order denying the parties' cross-motions for summary judgment, because RLP again resubmitted the files for the involved and pleaded applications and each of RLP's pleaded registrations. As explained in the Board's order, the file of each application or registration against which a notice of opposition, petition to cancel, or counterclaim is filed is automatically of record by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). RLP's submission of these files during its trial period (and again in its rebuttal trial period) was unnecessary.

Additionally, despite being specifically advised that its filing with its summary judgment motion of what appeared to have been the entirety of the parties' initial disclosures, discovery requests, and discovery responses, without indicating in its

³⁵ During its trial period, the Foundation also submitted testimony declarations identifying documents submitted under notice of reliance and providing the identical information set forth under the notice of reliance. The Foundation did not re-file all of the exhibits, however.

brief which requests or responses were relevant was unproductive, RLP did so **again** at trial. As further explained above, much of this evidence is inadmissible under notice of reliance and, with respect to those discovery requests that are admissible under notice of reliance, RLP has failed to explain the relevancy of any particular responses in its brief. *See* Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g) (“For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding.”).

RLP also refiled nearly all of the evidence it submitted during its opening trial period during its rebuttal period. Once evidence has been properly made of record, it may be referred to by either party. Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). It was therefore not necessary for RLP to resubmit the same evidence during its rebuttal period.

Finally, RLP also submitted a “confidential” version of nearly all of its trial testimony and evidence, both in its opening trial period and its rebuttal trial period. While some of the confidential filings contain additional documents or pages that have been omitted from the public versions, RLP also filed “confidential” copies of evidence that contains no redactions and no confidential information or documents that were not included in the public version. For example, each of RLP’s “confidential” testimony declarations is identical to the publicly filed version. As a result, a significant portion of RLP’s evidence was submitted four separate times.³⁶ RLP’s

³⁶ Moreover, as detailed above, much of the evidence submitted by RLP (in quadruplicate) was not admissible under notice of reliance at all.

duplication of evidence unnecessarily and significantly increased the trial record and the burden on the Board in reviewing the evidence.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1372 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where doing so is within the zone of interests protected by the statute, and the party has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303-05 (Fed. Cir. 2020).

As explained above, the record includes TSDR printouts of RLP's pleaded registrations that support a plausible likelihood of confusion claim. RLP's entitlement to a statutory cause of action is therefore established. *See, e.g., Look Cycle Int'l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Can. No. 92079409, 2024 TTAB LEXIS 289, at *7-8 (TTAB 2024); *New Era Cap*, 2020 TTAB LEXIS 199, at *16-17 (pleaded registrations establish statutory entitlement to bring opposition).

IV. Trademark Act Section 2(d)

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits 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 [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive[.]” In order to prevail on its likelihood of confusion claim under Trademark Act Section 2(d), RLP must establish that confusion is likely by a preponderance of the evidence. *New Era Cap*, 2020 TTAB LEXIS 199, at *8.

A. Priority

A party may establish its prior proprietary rights in a mark through ownership of a registration, through actual use, or through use analogous to trademark use. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

1. RLP’s Registrations and Prior Pending Application

As noted above, RLP’s pleaded registrations are of record, and the Foundation did not pursue its counterclaims to cancel the pleaded registrations at trial. Priority is therefore not at issue for the services identified in the pleaded registrations. *See King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1402-03 (CCPA 1974); *Nkanginieme v. Appleton*, Opp. No. 91256464, 2023 TTAB LEXIS 64, at *4-8 (TTAB 2023) (“Opposer’s registration removed priority as an issue.”).

RLP’s pending application, subject to Opposition No. 91247701, is also of record and, as noted above, the Foundation did not pursue its notice of opposition against RLP’s pending application at trial. RLP may rely on the May 31, 2017 filing date of that application for purposes of proving priority as to the services identified in the application, but judgment would be contingent upon the ultimate issuance of a registration to Opposer. *See Compagnie Gervais Danone v. Precision Formulations*

LLC, Opp. No. 91179589, 2009 TTAB LEXIS 1, at *4 (TTAB 2009) (citing *Larami Corp. v. Talk to Me Programs Inc.*, Opp. No. 91085987, 1995 TTAB LEXIS 13, at *14 n.7 (TTAB 1995) (constructive use provisions of Section 7(c) may be used defensively or offensively, but judgment is contingent upon the ultimate issuance of a registration)).

2. RLP's Common Law Rights³⁷

RLP also relies on prior common law rights in the MOSAEC mark for services that fall outside the scope of its pleaded registrations and pending application. Specifically, in its notice of opposition, RLP pleads prior use of its MOSAEC mark in connection with “a commerce, social media and content entity ... used to advance personal, educational, and career goals and in schools for philanthropic purposes,” and in connection with “the issuance of awards and for journalism.”³⁸

To establish prior common law rights, RLP must prove by a preponderance of the evidence that its common law rights in its pleaded MOSAEC mark “were acquired before any date upon which applicant may rely.” *DowntownDC Bus. Improvement Dist. v. Clarke*, Opp. No. 91275100, 2024 TTAB LEXIS 412, at *38 (TTAB 2024) (citing *Araujo v. Framboise Holdings Inc.*, 99 F.4th 1377, 1380 (Fed. Cir. 2024)). The Foundation’s involved application was filed on December 13, 2017. The Foundation “may rely without further proof upon the filing date of its application as a constructive

³⁷ Although RLP also pleads prior use of MOSAEC as a trade name, in its trial brief, RLP relies on the same evidence in support of its claim of priority based on trade name use as its claim of priority based on service mark use. 65 TTABVUE 8, 15. For this reason, we address all of RLP’s evidence purporting to show prior use together in this section.

³⁸ 1 TTABVUE 4-7, notice of opposition ¶¶ 1, 3, 9.

use date for purposes of priority.” *Rapid Inc. v. Hungry Marketplace, Inc.*, Opp. No. 91236033, 2022 TTAB LEXIS 260, at *18-19 (TTAB 2022). The Foundation does not allege actual use of its mark prior to its filing date. Accordingly, in order to prevail on its claim based on its common law rights, RLP must establish use prior to December 13, 2017.

Under Trademark Act Section 45, “a mark shall be deemed to be in use in commerce...on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...” 15 U.S.C. § 1127; *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1380 (Fed. Cir. 2015). “Such use may be established by: (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed as a service mark in advertising the services, which encompasses marketing and promotional materials.” *In re WAY Media, Inc.*, Ser. No. 86325739, 2016 TTAB LEXIS 201, at *3 (TTAB 2016). A mark also must be used in a manner that creates in the minds of potential consumers a direct association between the mark and the services. *In re Cardio Grp., LLC*, Ser. No. 86840860, 2019 TTAB LEXIS 153, at *3 (TTAB 2019) (“[T]here must be something which creates in the mind of the purchaser an association between the mark and the services activity.”) (internal quotation omitted).

“In considering priority, ‘we look at the evidence as a whole, as if each piece of evidence were part of a puzzle which when fitted together, establishes prior use.’” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, Opp. No. 91212312, 2017 TTAB LEXIS

201, at *68-69 (TTAB 2017) (quoting *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 1125-26 (Fed. Cir. 1994)). Oral testimony that is “sufficiently probative” may be sufficient to establish priority. *Id.* at *36 (citing *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 130 (CCPA 1965)). “Oral testimony is strengthened by corroborative documentary evidence.” *Id.* (citing *Elder Mfg. Co. v. Int’l Shoe Co.*, 194 F.2d 114, 118 (CCPA 1952)).

As noted above, while RLP submitted thousands of pages of testimony and evidence, much of it was inadmissible under notice of reliance and duplicative. RLP’s trial brief does little to identify the relevant evidence or to cite to particular pages in the record, and many of RLP’s citations to the record appear incorrect. We have made our best efforts to identify the evidence upon which RLP purports to rely in its trial brief in determining priority.

We turn first to RLP’s claim of common law rights in the MOSAEC mark for awards for journalism. In support thereof, RLP submitted the testimony declaration of Ramona Prioleau, the founder and Principal of RLP. “[I]t is well-settled that the ‘oral testimony even of a single witness may be adequate to establish priority, but only if it is sufficiently probative.’” *Kemi Organics, LLC v. Gupta*, Can. No. 92065613, 2018 TTAB LEXIS 149, at *23-24 (TTAB 2018) (quoting *Exec. Coach Builders*, 2017 TTAB LEXIS 201, at *36). “Such testimony should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.” *Id.* at *24 (cleaned up). “Oral testimony is, of course, always strengthened by corroborating documentary evidence...but [w]hile it is

certainly preferable for a party's testimony to be supported by corroborating documents, the lack of documentary evidence is not fatal." *Id.* (cleaned up).

Here, Ms. Prioleau's declaration is utterly lacking in any detail concerning the purported use of RLP's mark in connection with journalism awards. The entirety of Ms. Prioleau's testimony regarding RLP's purported journalism awards services is that "[f]rom a functional aspect, the MOSAEC® Mark and MOSAEC trade name is used by [RLP] in America for the issuance of awards and for journalism" and that RLP has a "long, extensive, and continuous use of the MOSAEC® Mark and MOSAEC trade name in America for the issuance of awards for journalism."³⁹ No other information is provided, such as the purported date of first use of the pleaded mark with these services, let alone any other detail regarding the nature of the services. Ms. Prioleau's testimony is vague and indefinite and therefore of limited probative value. The two conclusory sentences in Ms. Prioleau's declaration are therefore insufficient, standing alone, to establish by a preponderance of the evidence that RLP has prior use of its MOSAEC mark in connection with journalism awards services. *See Mars Generation, Inc. v. Carson*, Opp. No. 91224726, 2021 TTAB LEXIS 386, at *22-23 (TTAB 2021) (probative value of testimony is significantly undermined by witness' utter lack of detail); *H. Betti Indus., Inc. v. Brunswick Corp.*, 1981 TTAB LEXIS 75, at *25-26 (TTAB 1981) (vague, indefinite, and inconsistent testimony not accompanied by documentary evidence inadequate to support priority claim).

³⁹ 53 TTABVUE 8-9, Ramona Prioleau Decl. ¶¶ 33 and 37.

In its trial brief, RLP argues that it has “long, extensive, and continuous use of the MOSAEC® Mark and MOSAEC trade name in America for the issuance of awards and for journalism (See exemplars in See 51 TTABVUE 569-888; and 52 TTABVUE).”⁴⁰ The entry at 51 TTABVUE is the confidential version of RLP’s notice of reliance at 48 TTABVUE and only consists of 694 pages; therefore, the citation to this entry appears to be incorrect. Additionally, page 569 is one page in the middle of an exhibit that appears to be entirely unrelated to RLP’s claimed use of MOSAEC for the issuance of awards. Entry 52 is a confidential filing consisting of 249 pages of documents submitted only under notice of reliance, only one page of which has any potential bearing on the services claimed. A copy of this document was also filed as part of the public record at 49 TTABVUE 62 and therefore we do not treat it as confidential.⁴¹ The document is a single sheet with the heading “MOSAEC Journalism Awards” with thirteen items in a numbered list, e.g., “2010 – Athena Prix d’Excellence – Katie Couric, CBS News.” This document is not admissible under notice of reliance, but rather must be properly authenticated by testimony. *See, e.g. Gen. Mills, Inc*, 2011 TTAB LEXIS 280, at *12-13 (TTAB 2011).

In her rebuttal testimony declaration, Ramona Prioleau attempts to authenticate this document and other documents submitted solely under notice of reliance during RLP’s opening testimony period.⁴² This is improper. Testimony purporting to

⁴⁰ 65 TTABVUE 15.

⁴¹ As explained above, RLP submitted most of its evidence in identical form under seal.

⁴² 63 TTABVUE 7-10. Ramona Prioleau’s declaration also fails to identify any of the individual documents with sufficient particularity. Instead of referencing documents by the TTABVUE entry number and page number, or even by page number in the document, Ms.

authenticate evidence establishing RLP's alleged prior common law rights is part of RLP's case-in-chief and therefore this testimony and evidence constitutes improper rebuttal. *See Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, Opp. No. 91101304, 2000 TTAB LEXIS 577, at *10-13 (TTAB 2000) (sustaining objections to testimony that should have been submitted as part of plaintiff's case-in-chief). In any event, even if we were to consider the untimely attempt to authenticate the document, Ramona Prioleau's rebuttal testimony declaration does not, in fact, authenticate the document. Instead, Ramona Prioleau merely testifies that the document "is a true and correct copy of a list of MOSAEC JOURNALISM AWARDS from 2010 to 2022 that I provided Applicant as Opposer's founder in response to Applicant's discovery request."⁴³ Ms. Prioleau has therefore only testified that the list was produced to Applicant, not that RLP, in fact, offered services of providing awards to journalists under the MOSAEC mark. Tellingly, Ms. Prioleau never testifies that any of the numbered items on the list are even awards given by RLP, or that there were any services rendered to journalists.

Next, we consider RLP's pleaded common law use of its mark in connection with "a commerce, social media and content entity ... used to advance personal, educational, and career goals and in schools for philanthropic purposes." In support

Prioleau simply identifies individual documents as "[i]ncluded in Exhibit U," with a brief description of the document, e.g., "true and correct copies of sales trackers reflecting handwritten notes of purchases of goods from MOSAEC or donations to MOSAEC that I wrote as RLP's founder." *Id.* at 7-10. We may not guess at which documents are which. This is yet another example of RLP's ineffective presentation of evidence.

⁴³ *Id.* at 9, ¶ 26(p).

thereof, RLP again relies on the declaration of Ramona Prioleau, who again avers in merely conclusory fashion that “The MOSAEC platform has also been used to advance personal, educational, and career goals and in schools for philanthropic purposes.”⁴⁴ Ramona Prioleau’s declaration again fails to identify any dates of use or any details about the nature of these “services.” RLP also directs us to the declaration of Samantha Miller, who identifies herself as “director of partnership programs for a non-profit,”⁴⁵ and who testifies that she has “been familiar with RLP’s MOSAEC-platform since 1998 as a social media and e-commerce entity...to advance personal, educational, and career goals and in schools for philanthropic purposes.”⁴⁶ Ms. Miller does not explain what RLP’s “platform” is precisely, or explain how the “platform” advances “personal, educational, and career goals and in schools for philanthropic purposes.”

Ms. Miller also testifies that Ramona Prioleau mentored her while she was a student, that she referred students to Ramona Prioleau “in support of Opposer’s services,” that she attended an editorial meeting in 1999 where “Opposer described Opposer’s services...and Opposer’s planned involvement with students and schools,” and that Ms. Miller invited Ramona Prioleau to a student networking event in 2010 where she “described [RLP’s] services.”⁴⁷ Ms. Miller attaches copies of redacted emails to her declaration; however, none of these emails contain the MOSAEC mark.

⁴⁴ 53 TTABVUE 8, Ramona Prioleau Decl. ¶ 29.

⁴⁵ Ms. Miller does not identify the non-profit.

⁴⁶ *Id.* at 11, Samantha Miller Decl. ¶ 4.

⁴⁷ *Id.* at 12-13, Miller Decl. ¶¶ 5-9.

Moreover, even assuming that the emails describe events at which Ramona Prioleau described RLP's services, this information does not establish that RLP was, in fact, offering and rendering such services under the MOSAEC mark. Indeed, Ms. Miller's declaration states that in 1999, RLP described its **planned** services, not services that were currently being rendered.

Finally, Ms. Miller also states that “[d]uring the period from 1998 to date, I have referred students, educators, and administrators to [RLP] in relation to its educational, mentoring, and other philanthropic services, including for writing guidance and instruction.”⁴⁸ RLP also submits the testimony declaration of Kescia I. Prioleau, who, using nearly identical language, also testifies that she referred “students, educators, administrators, and non-profits” to RLP for its purported educational and mentoring services.⁴⁹ Again, neither declaration references the MOSAEC mark or explicitly states that the services were offered, only that each witness “referred” students to RLP.

Kescia Prioleau does, however, provide more information concerning the claimed mentoring services and states that she “received a mailing that described [RLP’s] educational and mentoring services” in May 1999 that “was similar to the document attached as Exhibit A,” and as shown below:⁵⁰

⁴⁸ *Id.* at 13, Miller Decl. ¶ 12.

⁴⁹ *Id.* at 21, Kescia Prioleau Decl. ¶ 13.

⁵⁰ *Id.* at 20, Kescia Prioleau Decl. ¶ 11.



May 10, 1999

As Memorial Day approaches, we are gearing up for a busy summer. This summer, MOSAEC will continue to expand its platform alongside offering **FREE** one-to-one instruction and guidance for new journalists and we will extend our services to other students that seek career guidance and mentoring services.

For more on our services, please see the enclosed materials. Please share them within your organization and to family and friends.

With all that we have planned, we are relying on contributions from supporters like you to continue to do our important work.

Please consider contributing once again by purchasing our merchandise or by contributing by check or by credit card online to MOSAEC.

Warmest regards,

Ramona

MOSAEC™ • A Division of KLF Ventures, LLC • Times Square Station • P.O. Box 2605
New York, NY 10108 • Phone: (212) 694-5300 • Fax: (212) 690-2871 • Ld: www.mosaec.com

The mailing includes an application form, a “Mentoring Agreement,” and a page titled “The MOSAEC Experience,” which states in pertinent part that the program will offer “Project-based mentoring and career guidance.”⁵¹

As explained above, testimony that is not indefinite, contradictory or inconsistent may be sufficiently probative, even in the absence of documentary evidence. *Kemi Organics, LLC*, 2018 TTAB LEXIS 149, at *23-24. That is not the case here. First, the testimony of each of these witnesses is identical or nearly identical, and mirrors the vague language of the notice of opposition. Where declarations from different

⁵¹ *Id.* at 23-28.

witnesses are “essentially identical in form and were clearly not composed individually” they are “less persuasive than statements expressed in the declarants’ own words.” *In re Pohl-Boskamp GmbH*, Ser. No. 85007428, 2013 TTAB LEXIS 7, at *36 (TTAB 2013); *see also Mag Instr. Inc. v. Brinkmann Corp.*, Opp. No. 91163534, 2010 TTAB LEXIS 322, at *67-68 (TTAB 2010) (finding declarations “nearly identical in wording and thus do not appear to have been prepared in the signers’ own words” to have “little persuasive value”).

More importantly, the testimony of RLP’s witnesses is contradicted by the limited documentary evidence submitted by RLP. First, both of these witnesses aver that they have referred students to RLP for mentoring services since 1998. However, the exhibit attached to Kescia Prioleau’s declaration contains a letter dated May 10, 1999 and states that “[t]his summer, MOSAEC **will** continue to expand its platform alongside offering FREE one-to-one instruction and guidance for new journalists and we **will** extend our services to other students that seek career guidance and mentoring services.”⁵² The document therefore suggests that Opposer had not yet begun offering the claimed services as of May 1999, while Kescia Prioleau and Ms. Miller both allege to have referred students to Opposer’s mentoring services in 1998.⁵³ These declarations, which are inconsistent with the very small number of documents provided by RLP, therefore have little persuasive value.

⁵² *Id.* at 23 (emphasis added).

⁵³ Opposer was not incorporated until February 5, 1999. 62 TTABVUE 1261.

Even accepting the statements in the declarations at face value, the letter and mentorship agreements are, at most, advertising future services. Section 45 of the Trademark Act also requires that the services actually be “rendered.” 15 U.S.C. § 1127. *See, e.g. Couture*, 778 F.3d at 1381; *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1360 (Fed. Cir. 2009). The only testimony that services were actually rendered is from Ms. Miller, who does not state that RLP actually provided mentorship services under the MOSAEC mark, but only that Ramona Prioleau provided mentoring services in 1998. Indeed, the majority of the unauthenticated documents relied upon by RLP consist of email communications with Ramona Prioleau, with no reference to the MOSAEC mark. Ramona Prioleau’s own declaration also tellingly fails to explicitly state that RLP has offered mentoring services under the MOSAEC mark.⁵⁴

RLP claims to have been offering mentoring services under its MOSAEC mark for approximately twenty-four years, yet has produced only a couple of documents constituting advertising for planned, future services from 1999 and no definitive testimony. While the absence of documentary evidence is not necessarily determinative in any given case, the lack of documentary evidence that the services were ever actually rendered, coupled with the indefinite, conclusory, and contradicted

⁵⁴ In her rebuttal declaration, Ramona Prioleau does testify that the “mentoring agreement” attached to the Miller declaration is one that she “prepared as the Opposer’s founder related to mentoring services offered under the MOSAEC mark.” 63 TTABVUE 9, ¶ 26(i). As discussed above, RLP’s alleged prior common law rights are part of RLP’s case-in-chief and this statement is therefore improper rebuttal testimony. In any event, the statement also lacks specifics regarding the purported mentoring services, when they were offered, or whether they were ever actually rendered.

averments, compels us to afford these witnesses' declarations little probative value. *See, e.g. Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 TTAB LEXIS 437, at *30 (TTAB 2017) (“The presence of business records would strengthen the case that these transactions occurred in the ordinary course of trade, and the absence of such records does the opposite.”). *See also Elder Mfg. Co.*, 194 F.2d at 332 (“Oral testimony is obviously strengthened by corroborative documentary evidence.”).

Moreover, RLP must demonstrate that the alleged services were “performed as a regular or recurring activity associated with the mark...” *DeVivo v. Ortiz*, Opp. No. 91242863, 2020 TTAB LEXIS 15, at *10 (TTAB 2020) (quoting *Giersch v. Scripps Networks, Inc.*, Can. No. 92045576, 2009 TTAB LEXIS 72, at *12 (TTAB 2009) (declining to find prior use for “decorating or home improvement services” when the services were only occasionally performed)); *see also* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* ¶ 16:9 (5th ed. Sep. 2024 update) (“To establish ownership and priority of use of a mark, the user must establish not only that at some date in the past it began use of the mark, but that there has been a continuity of use up to the present.”) (footnotes omitted). RLP has failed to establish by a preponderance of the evidence that the services were ever rendered, let alone as a regular or recurring activity.

For the reasons discussed, we find that RLP has not proven prior common law use of the MOSAEC mark for journalism awards or for educational or mentoring services.

Accordingly, we confine our analysis of the likelihood of confusion claim to RLP's pleaded registrations and prior-filed application.

V. Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is based on an analysis of all of the probative facts of record that are relevant to the factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont* factors"). In making our determination, we consider all *DuPont* factors for which there is argument and evidence of record. *Look Cycle Int'l*, 2024 TTAB LEXIS 289, at *10 (citing *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) ("In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis."). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns, Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1406-07 (Fed. Cir. 1997)). Any single factor may control a particular case. *Id.*

Two key *DuPont* factors in every Section 2(d) claim are the first two factors regarding the similarity or dissimilarity of the marks and the similarity or dissimilarity of the goods or services. *Herbko Int'l*, 308 F.3d at 1165; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.”).

In its trial brief, RLP addresses the following *DuPont* factors: the similarity of the marks, the similarity of the services, and the channels of trade and consumers. The Foundation contests RLP’s arguments on these factors and also addresses the purported weakness of RLP’s mark and the nature and extent of actual confusion and the length of concurrent use without actual confusion.

A. Strength of RLP’s MOSEAC Mark

Because it affects the scope of protection to which RLP’s MOSAEC mark is entitled, we first address the strength or weakness of this term. *DuPont*, 476 F.2d at 1361; *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (“Two of the *DuPont* factors (the fifth and sixth) consider strength.”). In determining the strength or weakness of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial or marketplace strength. *Spireon, Inc.*, 71 F.4th at 1362 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength...and its marketplace strength...”). Here, the Foundation argues that RLP’s MOSAEC mark is both conceptually and commercially weak under the sixth *DuPont* factor.

To determine the conceptual strength of RLP’s mark, we evaluate its intrinsic nature, that is, where the mark lies “along the generic-descriptive-suggestive-arbitrary or fanciful continuum of words.” *In re Davia*, Ser. No. 85497617, 2014 TTAB

LEXIS 214, at *11 (TTAB 2014). Because RLP's pleaded registrations are registered on the Principal Register, we presume that they are inherently distinctive for the services for which the marks are registered. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 91118587, 2006 TTAB LEXIS 330, at *62 (TTAB 2006) (a "mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods").

The Foundation argues that RLP's mark is a misspelling of MOSAIC⁵⁵ and argues that MOSAIC is conceptually weak because it is a commonly used term. In support thereof, the Foundation submits a dictionary definition of "mosaic," which is defined as "a picture or decoration made of small, usually colored pieces of inlaid stone, glass, etc."⁵⁶ The Foundation argues that if MOSAEC is seen as a phonetic equivalent to "mosaic," as RLP contends, that the term "impl[ies] some manner of difference and diversity in thought or otherwise..."⁵⁷ The Foundation has not identified any evidence in the record to support this argument, nor explained in any meaningful manner how this meaning is applicable to RLP's services. The Foundation also states that RLP contends that MOSAEC is "an acronym for 'more style, art, entertainment and

⁵⁵ Although the Foundation argues that MOSAEC is the phonetic equivalent of MOSAIC, "[t]here is no correct pronunciation of a trademark." *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, Opp. No. 91159335, 2006 TTAB LEXIS 20, at *10 (TTAB 2006).

⁵⁶ 54 TTABVUE 246 (Dictionary.com).

⁵⁷ 66 TTABVUE 15.

culture”;⁵⁸ however, the Foundation has not pointed to anything in the record to support this contention, nor have we been able to identify any such evidence or argument.

The Foundation also points to fifteen third-party registrations for MOSAIC or MOSAIC-formative marks in the name of thirteen different owners to show conceptual weakness of the word MOSAIC. Third-party registrations may be relevant to show that a mark, or “some segment of the [mark] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that the [mark] is relatively weak.” *Juice Generation*, 794 F.3d at 1339 (internal citation and quotation marks omitted). Even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976).

Two of the registrations identified by the Foundation have been cancelled.⁵⁹ Cancelled or expired registrations have no probative value other than to show that they once issued. 15 U.S.C. § 1057(b). Of the remaining thirteen registrations (by eleven different owners), only two registrations, Registration No. 4849517 for



MOSAIC VIRGINIA and Registration No. 5466954 for A Stronger Jewish Future. Together., each

⁵⁸ *Id.* at 11.

⁵⁹ Registration Nos. 5053594 and 5897231.

registered for services in the field of charitable fundraising, are even arguably related to RLP's services in its pending application. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1325-26 (Fed. Cir. 2018) (finding the Board erred in considering third-party marks for dissimilar goods). These third-party registrations are insufficient to show that the mark is conceptually weak. *See, e.g. In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *12 (TTAB 2018), *aff'd*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (four third-party registrations and no third-party uses were “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in the Federal Circuit's decisions in *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015) and *Juice Generation*, 794 F.3d at 1334).

Turning next to commercial strength, the commercial strength of a mark rests on the extent to which “a significant portion of the relevant consuming public...recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1324-25 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)). “The number and nature of third-party uses of similar marks for similar goods [or services]” may constrict the scope of protection of a mark. *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *24 (TTAB 2022) (quoting *DuPont*, 476 F.2d at 136).

The Foundation introduced copies of twenty-one websites showing use of marks consisting of or containing the word MOSAIC for a variety of goods and services that purportedly diminish the commercial or marketplace strength of RLP's mark.⁶⁰ The Foundation argues that these examples show the commercial weakness of RLP's mark, because they are for "related services delivered over [RLP's] identical channel of trade, the Internet."⁶¹ This evidence suffers from the same defect as the Foundation's third-party registration evidence because most of the examples do not demonstrate use of MOSAIC on services shown to be related to those of Opposer. We have carefully reviewed the third-party evidence and identified the following as the most pertinent to RLP's services: (1) the website mosaic.nj.com using MOSAIC in connection with a website providing news and information about, among other things, "Food & Culture;"⁶² and (2) MOSAIC, a student journalism page from The Mercury News at mercurynews.com/tag/mosaic, featuring, among other things, information about music.⁶³ These limited third-party uses fall far short of establishing that MOSAIC (or MOSAEC) is weak for RLP's identified services.

The Foundation also argues that we should consider coexistence agreements with third parties also using marks containing the word MOSAIC as evidence that RLP's mark is weak.⁶⁴ The coexistence agreements identified by the Foundation involve

⁶⁰ 59 TTABVUE 5-43.

⁶¹ 66 TTABVUE 19-20.

⁶² 59 TTABVUE 9-13.

⁶³ *Id.* at 17-22.

⁶⁴ 66 TTABVUE 21.

different marks and services not at issue here. “Each case must be decided on its own facts and the differences are often subtle ones.” *Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc.*, 530 F.2s 1396, 1399 (CCPA 1976) (citation omitted). The coexistence agreements, which reflect the unique circumstances in those cases, do not bear on whether confusion is likely in this case.

Nothing in the record compels us to reduce the scope of protection afforded RLP’s MOSAEC mark and we find that it is entitled to the scope of protection normally afforded an inherently distinctive mark. *See Bell’s Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 TTAB LEXIS 452, at *20 (TTAB 2017) (finding Opposer’s marks entitled to “the normal scope of protection to which inherently distinctive marks are entitled.”). Accordingly, the sixth *DuPont* factor is neutral.

B. Similarity or Dissimilarity of the Marks

We turn next to the first *DuPont* factor, which assesses the similarity or dissimilarity of the marks. *DuPont*, 476 F.2d at 1361. We analyze “the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, 2014 TTAB LEXIS 214, at *4).

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, 1373 (Fed. Cir. 2018) (quoting *Coach Servs.*, 668 F.3d at 1368) (internal quotation and citations omitted). “The focus is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks.” *L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at *16 (TTAB 2012).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (CCPA 1974)). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

RLP argues that the Foundation's mark incorporates the entirety of RLP's MOSAEC mark, albeit with a different spelling, that MOSAIC and MOSAEC are phonetic equivalents, that MOSAIC is the dominant portion of the Foundation's mark, and that the words AMERICAN and the disclaimed phrase JOURNALISM PRIZE are insufficient to dispel any likelihood of confusion.⁶⁵

In response, the Foundation argues that MOSAEC and MOSAIC are not the same, and that the phrase "AMERICAN MOSAIC" has a distinct meaning that conveys a different connotation and commercial impression than MOSAIC alone.⁶⁶ Specifically, the Foundation argues that "the term 'American Mosaic' is a coined term used by numerous third parties to specifically refer to the varied makeup of these United States."⁶⁷ In support of its argument, the Foundation submits numerous examples of third-party websites using "American Mosaic" to refer to the diverse and multi-cultural makeup of the United States. Pertinent examples include:

- "THE AMERICAN MOSAIC series provides a platform for interdisciplinary research and learning in Ethnic Studies and American history," inviting users to "Explore The American Mosaic in four unique subject areas:" The African American Experience, the Asian American Experience, the American Indian Experience, and the Latino American Experience (abc-clio.com/American-mosaic);⁶⁸
- A podcast titled "An American Mosaic," with a description that reads: "America is a Mosaic of ideas, dreams, hopes, desires, communities, family, culture and places' (American-mosaic.com);⁶⁹

⁶⁵ 65 TTABVUE 14-17.

⁶⁶ 66 TTABVUE 12-13.

⁶⁷ *Id.*

⁶⁸ 54 TTABVUE 138-48.

⁶⁹ *Id.* at 149-55.

- “The American Mosaic Project studies what brings Americans together, what divides us, and implications of our diversity for our political and civic life” (cla.umn.edu/sociology/research-collaboration/collaboration-opportunities/American-mosaic-project-amp);⁷⁰
- “The American Mosaic PAC...is committed to increasing the diversity of our Congress by electing exceptional people who are truly representative of our America...[and] reflects the diversity of the people they represent...” (americanmosaicpac.com);⁷¹
- “American Mosaic: An NYC Exploration with Your Family,” “Journey into the past and explore the present with your family in NYC, where the city’s iconic spots create a mosaic of influences from around the globe.” (roadscholar.org/find-an-adventure/21019/American-mosaic-an-nyc-exploration-with-your-family);⁷²
- “American Mosaic is our weekly program about music, pop culture and life in the United States” (learningenglish.voanews.com/a2734015.html);⁷³
- “Building the American Mosaic: A Report from the President’s Advisory Commission on Asian Americans and Pacific Islanders,” which explains that the commissions’ “effort has evolved into our vision of the American Mosaic, in which different parts of the nation are strengthened and united into a larger, cohesive union, which becomes stronger through shared prosperity and equal opportunity for all Americans;” (Obamawhitehouse.archives.gov/sites/default/files/docs/American-mosaic_digital.pdf);⁷⁴
- Griffin Museum of Photography “My American Mosaic series honors America’s rich multicultural heritage through diverse portraits. The ‘melting pot’ metaphor is being replaced by new metaphors like ‘mosaic’ which suggest an integration that blends yet preserves each culture’s unique qualities rather than promoting one homogenous culture.” (griffinmuseum.org/show/American-mosaic);⁷⁵

⁷⁰ *Id.* at 156-58.

⁷¹ *Id.* at 167.

⁷² *Id.* at 171-74.

⁷³ *Id.* at 175.

⁷⁴ *Id.* at 177-226.

⁷⁵ *Id.* at 229-35.

- An article titled “From Melting Pot to Salad Bowl from Cultural Savvy states that “[t]he old ‘melting pot’ metaphor is giving way to new metaphors such as ‘salad bowl’ and ‘mosaic,’ mixtures of various ingredients that keep their individual characteristics;” (culturalsavvy.com/understanding_american_culture.htm);⁷⁶ and
- “The view from the melting pot: American Mosaic,” *The Christian Science Monitor*, by William Keough: “Perhaps instead of a melting pot...we might more accurately call America a vast mosaic, in which colorful individual pieces are fitted together to make a single picture.” (csmonitor.com/1980/1001/100102.html).⁷⁷

We find that this evidence is sufficient to demonstrate that AMERICAN MOSAIC is a unitary phrase and has a different meaning and commercial impression than “mosaic” alone or RLP’s MOSAEC mark. While “mosaic” calls to mind a picture,⁷⁸ the Foundation’s mark connotes the multiculturalism of America.

Moreover, while “JOURNALISM PRIZE” has been disclaimed, “[t]he disclaimed elements of a mark ... are relevant to the assessment of similarity. ... This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.” *Shen Mfg. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (internal citation omitted). Moreover, the Foundation’s mark uses an alternate spelling of RLP’s mark. Most importantly, the parties’ marks have a different connotation and commercial impression. For these reasons, when compared overall, the marks are more dissimilar than similar in appearance, sound, connotation and commercial impression, and this factor therefore weighs against a finding of a likelihood of confusion.

⁷⁶ *Id.* at 236-39.

⁷⁷ *Id.* at 240-44.

⁷⁸ 54 TTABVUE 246 (Dictionary.com).

C. Relatedness of the Services, Channels of Trade, and Classes of Consumers

Under the second and third *DuPont* factors, respectively, we 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.” *Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at *20 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303 (Fed. Cir. 2018) and *DuPont*, 476 F.2d at 1361). It is sufficient for a finding of likelihood of confusion if relatedness is established between the Foundation’s services and any item in the identification of services for RLP’s pleaded registrations or pending application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1339 (CCPA 1981).

RLP does not argue that any of the services in its pleaded registrations or pending application are related to the services in the Foundation’s involved application. Rather, RLP relies entirely on its alleged prior common law rights in the MOSAEC mark for journalism awards, which RLP contends are identical to the Foundation’s “awarding of fellowships and monetary prizes in the field of journalism.” As we held above, however, RLP failed to prove its prior use in connection with journalism awards services. RLP makes no effort to argue that the services in RLP’s pleaded registrations and pending application are similar to the Foundation’s services and has produced no evidence to show that the services are related, such as evidence that

any other company offers both parties' services under the same mark.⁷⁹ *Cf. Charger Ventures*, 64 F.4th at 1382. Nor is there anything on the face of the identification of services themselves that suggests they are related. As a result, the second *DuPont* factor weighs against finding a likelihood of confusion.

With respect to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers, *see Detroit Athletic Co.*, 903 F.3d 1303, RLP has again relied solely on its allegation of prior common law rights for journalism awards services. RLP again submits no evidence pertaining to this *DuPont* factor with respect to any of the services in its pleaded registrations or pending application. As a result, the third *DuPont* factor also weighs against finding a likelihood of confusion.

D. Concurrent Use and Actual Confusion

Under the seventh *DuPont* factor, we consider the nature and extent of any actual confusion, and under the eighth *DuPont* factor, we consider the extent of the opportunity for actual confusion. The Foundation argues that it has been offering its

⁷⁹ In support of its argument that the parties' services are identical or closely related, RLP cites, in general, the "Prioleau Decl." 65 TTABVUE 17. RLP also cites to 51 TTABVUE 569-888, which appears to be a mistake, because the confidential filing at 51 TTABVUE only contains 694 pages. Finally, RLP cites generally to 52 TTABVUE without pointing us to any particular portions of the 250-page confidential filing. As explained above, much of this evidence was improperly submitted under notice of reliance and is inadmissible, but in any event, none of the evidence supports RLP's argument that the parties' identified services are related.

services under its involved mark for nearly seven years with no known instances of actual confusion.⁸⁰

In assessing these factors, we “look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mortg. Co.*, 2020 TTAB LEXIS 17, at *19. The absence of any reported instances of confusion is “meaningful only if the record indicates appreciable and continuous use by [A]pplicant of its mark for a significant period of time in the same markets as those served by [O]pposer under its mark[].” *Gillette Can. Inc. v. Ranir Corp.*, Opp. No. 91082769, 1992 TTAB LEXIS 24, at *19 (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*, Opp. No. 91157982, 2007 TTAB LEXIS 9, at *14 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred).

While the Foundation argues in its brief that the Foundation has been offering its services under its involved mark for seven years, the record is devoid of any evidence to support this argument. Attorney arguments do not constitute evidence. *See Enzo Biochem Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). There is no information in the record establishing that the Foundation has used its involved mark let alone the market conditions under which such use has occurred. As a result, we are unable to gauge whether there has been a meaningful opportunity for actual

⁸⁰ 66 TTABVUE 23.

confusion to have occurred in the marketplace. Accordingly, the seventh and eighth *DuPont* factors are neutral.

E. Balancing the factors

Having made findings on all of the relevant *DuPont* factors for which there is argument and evidence, we assess these findings to determine if, on balance, confusion is likely. *Charger Ventures LLC*, 64 F.4th at 1383-84. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). Here, the first *DuPont* factor, the similarity of the marks, weighs against a finding of likelihood of confusion. Similarly, the services are not related, the trade channels and classes of customers do not overlap, and therefore the second and third *DuPont* factors weigh against a finding of likelihood of confusion. The remaining *DuPont* factors discussed above are neutral. Weighing these factors, we find that RLP has failed to prove by a preponderance of the evidence that confusion is likely.

Decision: Opposition Nos. 912469469 and 91247701 are each dismissed, and the Foundation’s counterclaims in Opposition No. 91246949 are denied.