

<p>This Opinion is Not a Precedent of the TTAB</p>
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Mailed: March 18, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pumpernickel Associates, LLC

v.

Ningbo Panera Lighting Co., Ltd.

Opposition No. 91272857

Rebecca J. Cantor and Erica Klazmer of Brooks Kushman P.C. for Pumpernickel Associates, LLC.

David Silver of Bayramoglu Law Offices LLC for Ningbo Panera Lighting Co., Ltd.

Before Heasley, Larkin, and Myles,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Ningbo Panera Lighting Co., Ltd. (“Applicant”) has filed two applications to register the standard-character mark PANERALUX on the Principal Register for goods ultimately identified as follows:

Data processing apparatus; computer programs, recorded for use in database management, use in electronic storage of data; couplers being data processing equipment; optical character readers; integrated circuit cards used for smart cards; humanoid robots with artificial intelligence; Downloadable mobile phone application software for use in

database management, use in electronic storage of data; Smart glasses for data processing; pedometers; Face recognition equipment, namely, optical face scanners; weighing machines; measures, namely, tape measures; flashing safety lights used for luminous signals; signal lanterns, namely, optical signal lanterns; signals, luminous or mechanical, namely, luminous traffic signals; light-emitting electronic luminous pointers; anti-interference devices for electricity, namely, filters for radio interference suppression; smartphones; protective films adapted for smartphones; cabinets for loudspeakers; microphones; headphones; electronic book readers; cinematographic cameras; photography darkroom lamps; flashlights for use in photography; surveyors' levels; speed checking apparatus for vehicles, namely, speed indicators for vehicles; hydrometers; teaching apparatus, namely, teaching robots; measuring devices, electric, namely, electric lasers for measuring; probes for scientific purposes; optical lamps; optical apparatus and instruments, namely, optical inspection apparatus; optical condensers; materials for electricity mains, namely, electric cables and wires; semi-conductors; light-emitting diodes (LED); junction boxes for electricity; transformers for electricity; switches, electric; electric control panels; light dimmers used for regulators, electric; lighting ballasts; remote control apparatus, namely, remote control transmitter for radio-controlled devices; optical fibres being light conducting filaments; fire extinguishers; X-ray apparatus not for medical purposes; protection devices for personal use against accidents, namely, gloves for protection against accidents; clothing for protection against fire; theft prevention installations, electric, namely, theft alarms; smoke detectors; eyeglasses; battery chargers; batteries, electric; photographic slides; decorative magnets, in International Class 9;¹ and

Light bulbs; lamps; Lighting apparatus, namely, lighting installations; chandeliers; ceiling lights; laboratory lamps; safety lamps, namely, LED Safety lamps; luminous tubes for lighting; miners' lamps; electric lights for Christmas

¹ Application Serial No. 90165765 was filed on September 8, 2020 under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based on Applicant's Chinese Registration No. 34306236, which issued on July 7, 2019. Applicant states in the application that "[t]he wording 'PANERALUX' has no meaning in a foreign language."

trees; luminous house numbers; searchlights; street lamps; aquarium lights; diving lights; light-emitting diodes (LED) lighting apparatus, namely, LED (light emitting diode) lighting fixtures; string lights for festive decoration; lights for vehicles; headlights for automobiles; automobile lights being lights for vehicles; lanterns for lighting; cooking apparatus and installations, namely, cooking ranges; kettles, electric; freezers; refrigerators; air purifying apparatus and machines; extractor hoods for kitchens; heating apparatus, namely, heating apparatus for vehicles; steam generating installations; heating installations; faucets; sanitary apparatus and installations, namely, urinals being sanitary fixtures; solar thermal collectors used for heating; disinfectant apparatus, namely, apparatus for disinfecting water; water purifying apparatus and machines; radiators, electric, in International Class 11.²

Pumpernickel Associates, Ltd. (“Opposer”) opposes both applications under Sections 2(a), 2(d), and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(a), 1052(d), and 1125(c), on the grounds that Applicant’s marks falsely suggest a connection with Opposer, are likely to cause confusion with respect to Opposer’s registered and common-law PANERA marks, and are likely to dilute the distinctiveness of Opposer’s allegedly famous PANERA marks.

² Application Serial No. 90165881 was filed on September 8, 2020 under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based on Applicant’s Chinese Registration No. 34294127, which issued on June 28, 2019. Applicant states in the application that “[t]he wording ‘PANERALUX’ has no meaning in a foreign language.”

The case is fully briefed.³ We dismiss the opposition.⁴

I. Record and Evidentiary Issue

The record consists of the pleadings,⁵ the file histories of the opposed applications, by virtue of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following materials submitted by the parties:⁶

³ Citations in this opinion to the briefs and other materials in the record refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 WL 2853282, at *1 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. Opposer's redacted main brief appears at 42 TTABVUE and its reply brief appears at 46 TTABVUE. Applicant's redacted brief appears at 45 TTABVUE. Unredacted versions of Opposer's main brief and Applicant's brief containing information designated as confidential under the Board's Standard Protective Order appear at 43 TTABVUE and 44 TTABVUE, respectively.

⁴ As part of an internal Board pilot program on possibly broadening acceptable forms of legal citation in Board cases, the citation form in this opinion is in a form provided in Section 101.03(a) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") (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 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 cites the Westlaw legal database ("WL") and, in the initial full citation of a case, also identifies the number of the Board proceeding where it is available. The Board's decisions that have issued since 2008 are available in TTABVUE and many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading Room by entering the same information. Practitioners should also adhere to the practice set forth in TBMP § 101.03(a).

⁵ The operative pleadings are Opposer's Notice of Opposition, 1 TTABVUE, and Applicant's Answer to Opposer's Notice of Opposition. 4 TTABVUE. In its Answer, Applicant denied the salient allegations in Opposer's Notice of Opposition and asserted five self-styled "Affirmative Defenses," *id.* at 4-5, and a purported "Reservation of Rights" to amend its Answer. *Id.* at 6. The six "Affirmative Defenses" are mere amplifications of Applicant's denials of Opposer's allegations of likelihood of confusion, a false suggestion of a connection, and likelihood of dilution, not true affirmative defenses, "and will be treated as such." *JNF LLC v. Harwood Int'l Inc.*, Canc. No. 92070634, 2022 WL 4379238, at *1 n.8 (TTAB 2022). The purported "Reservation of Rights" is "improper under the federal rules because it does not give fair notice of the affirmative defense." *Keystone Consol. Indus., Inc. v. Franklin Inv. Corp.*, Canc. No. 92066927, 2024 WL 3771168, at *1 n.5 (TTAB 2024).

⁶ Prior to trial, Applicant moved to exclude certain witnesses identified in Opposer's pretrial disclosures whom Opposer had not been previously identified. 20 TTABVUE. The Board granted the motion "to the extent that Opposer may not take the testimony of the witnesses

Opposer

- Opposer's Notice of Reliance on the file histories of its three pleaded Registration Nos. 2288311, 2806259, and 4934852 (Exs. 1-3); the Declaration of Michelle Ormes and Exhibits A-S thereto ("Ormes Declaration" or "Ormes Decl.") (Ex. 4); the Declaration of Stacy Duffy and Exhibits A-B thereto ("Duffy Declaration" or "Duffy Decl.") (Ex. 5); the Declaration of Jami Closser and Exhibit A thereto (Ex. 6) ("Closser Declaration" or "Closser Decl."); the Declaration of Jessica Hesselschwerdt and Exhibits A-I thereto ("Hesselschwerdt Declaration" or "Hesselschwerdt Decl.") (Ex. 7); the Declaration of Mark Wooldridge and Exhibits A-K thereto ("Wooldridge Declaration" or "Wooldridge Decl.") (Ex. 8); the Declaration of Opposer's survey expert Hal Poret and Exhibits A-D thereto ("Poret Declaration" or "Poret Decl.") (Ex. 9); Applicant's Responses to Opposer's Request for Admissions Nos. 1-6 (Ex. 10); Applicant Responses to Opposer's Interrogatory Nos. 1, 4-6, 8, and 22 (Ex. 11); Internet materials (Exs. 12-18); and documents produced by Applicant (Exs. 19-20); 28 TTABVUE 8-186; 29 TTABVUE 2-583; 30 TTABVUE 2-206; 31 TTABVUE 2-242; 32 TTABVUE 2-333; 32 TTABVUE 2-181; 34 TTABVUE 2-315 (unredacted confidential materials); 35 TTABVUE 2-67 (unredacted confidential materials); 36 TTABVUE 2-5 (unredacted confidential materials); and 37 TTABVUE 2-113; and
- Opposer's Rebuttal Notice of Reliance on the Reply Declaration of Michelle Ormes ("Ormes Reply Declaration" or "Ormes Reply Decl.") (Ex. 21) and Internet materials (Exs. 22-23), 41 TTABVUE 2-16.

Applicant

- Testimonial Declaration of Applicant's founder and general manager Jianfeng Yang ("Yang Declaration" or "Yang Decl.") and Exhibits N19-N26, 40 TTABVUE 2-181; and
- Applicant's Notice of Reliance on Opposer's discovery responses (Exs. N1-N11), Internet materials (Exs. N12, N15, N18), the results of searches regarding Applicant's mark in China and the United States (Exs. N13-N14), and a co-existence agreement between Opposer and another user of a

at issue unless Applicant has an opportunity to take discovery depositions of the witnesses at issue prior to resumption of trial herein." 24 TTABVUE 5-6. Applicant moved for reconsideration of the Board's order, arguing that reopening discovery to permit Applicant to depose the newly-identified witnesses was improper, 25 TTABVUE 4-8, but the Board denied the request for reconsideration. 27 TTABVUE 4.

Panera mark and evidence of use of the party's mark (Exs. N16-N17), 39 TTABVUE 2-102; 38 TTABVUE 2-14 (unredacted confidential materials).

Evidentiary Objection

Applicant objects in its brief that “Opposer’s notice of reliance fails to comply with the requisite description for **any** of the proffered evidence,” 45 TTABVUE 9 (emphasis in bold here in italics in Applicant’s brief), because a “notice of reliance must specifically identify not just the broad categories, but the specific elements of such categories that the evidence is intended to support or refute.” *Id.* (citations omitted). According to Applicant, “Opposer merely states that each and every piece of evidence and declaration submitted is ‘offered in support of Opposer’s claims for likelihood of confusion, dilution by blurring, and false suggestion of a connection.’” *Id.* at 10. Applicant “objects to Opposer’s disregard of the required rules for trial procedure and objects to Opposer’s use of its insufficiently specified evidence.” *Id.*

Applicant acknowledges that “the failure to adequately specify the purposes of the intended evidence is considered a curable defect,” *id.*, but claims that “the Board may sua sponte decline to consider the proffered evidence if the notice of reliance does not specify the relevance of the materials and identify the issues.” *Id.* at 11 (quoting *Safer, Inc. v. OMS Invs., Inc.*, Opp. No. 91176445, 2010 WL 985355, at *10 (TTAB 2010)). Applicant requests that “the Board at the very least uses [sic] its ability to sua sponte decline to consider Opposer’s improperly submitted evidence.” *Id.*

In its reply brief, Opposer argues that any failure to specify the relevance of materials submitted under a notice of reliance “is a **curable procedural defect**.” 46 TTABVUE 7 (emphasis supplied by Opposer). Opposer notes that Applicant “waited

almost **six months** to raise this potential evidentiary defect, did not file any motions regarding this potential issue, and untimely raised this for the first time in its response brief leaving no option for Opposer to cure this potential defect.” *Id.* at 8 (emphasis supplied by Opposer). Opposer concludes that “Applicant’s objections to Opposer’s notice of reliance should be denied as untimely and, therefore, waived.” *Id.*

We agree with Opposer. As Applicant effectively acknowledges, “[o]bjections to testimony or to a notice of reliance grounded in asserted procedural defects are waived unless raised promptly, when there is an opportunity to cure.” *Barclays Cap. Inc. v. Tiger Lily Ventures Ltd.*, Opp. No. 91219477, 2017 WL 4512466, at *2 (TTAB 2017) (considering timely filed motion to strike notice of reliance for lack of specific descriptions of relevance of attached evidence). *See also Flame & Wax, Inc. v. Laguna Candles, Inc.*, Canc. No. 92072343, 2022 WL 3083070, at *5 (TTAB 2022) (“As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived”) (internal quotation marks and quotations omitted)). Applicant failed to timely object to the claimed deficiencies in Opposer’s Notice of Reliance by filing a motion to strike after the Notice of Reliance was filed, and it thus waived any such objections. We overrule Applicant’s tardy objection and will consider Opposer’s Notice of Reliance.

II. The Parties and Their Marks

Opposer Pumpernickel Associates, LLC is owned by Pumpernickel, Inc. and Panera, LLC. Closser Decl. ¶ 3 n.1 (31 TTABVUE 189. Opposer owns and operates a large chain of fast-casual restaurants under the PANERA and PANERA BREAD

marks, which offer baked goods and restaurant and catering services that include myriad prepared foods and drinks for breakfast, lunch, and dinner. Ormes Decl. ¶ 4 (29 TTABVUE 512-13). Opposer also offers its restaurant goods and services and certain collateral goods via its websites and company-owned and franchised brick-and-mortar world locations, and certain PANERA-branded products are sold in third-party grocery stores and by online retailers such as Amazon. Ormes Decl. ¶ 7 (29 TTABVUE 513).

Applicant is a company headquartered in the People's Republic of China. Its primary business is selling lighting products, and it has displayed and sold such goods in the United States since at least 2011 under the marks PANERA and PANERA LIGHTING, which are not at issue in this case. Yang Decl. ¶¶ 3, 8, 17; Exs. N19, N20 (40 TTABVUE 2-4, 9-68). Applicant does not sell food or provide catering services. Yang Decl. ¶ 25 (40 TTABVUE 5).

This case is not the parties' first encounter involving their respective trademarks, as Opposer "has engaged in multiple disputes with Applicant in several countries outside the United States." Ormes Reply Decl. ¶ 4 (41 TTABVUE 7).⁷ In that regard, Applicant's founder and general manager Jianfeng Yang testified without contradiction that "Applicant has received registrations or protection for Applicant's 'PANERA LIGHTING' or 'PANERALUX' trademarks, or both, in numerous countries worldwide, including New Zealand, Australia, Japan, the EU, China, Egypt, Iran, the

⁷ Opposer stated in discovery that it "first became aware of Applicant in or about 2018 in connection with applicant's trademark application in China." 39 TTABVUE 19 (Resp. to Int. No. 17).

UK, Singapore, the Philippines, Russia, Indonesia, Norway, Switzerland, Vietnam, Argentina, Malaysia, Brazil, and South Korea.” Yang Decl. ¶ 21 (40 TTABVUE 5).

III. Entitlement to a Statutory Cause of Action

“Entitlement to a statutory cause of action must be established in every inter partes case.” *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 WL 1638376, at *3 (TTAB 2024). “A party in the position of plaintiff may oppose an application where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the opposer must have a reasonable belief in damage that is proximately caused by registration of the mark.” *Id.* “Proof of [a] plaintiff’s entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case even if, as here, the defendant does not contest the plaintiff’s entitlement.” *Sabhnani v. Mirage Brands, LLC*, Canc. No. 92068086, 2021 WL 6072822, at *6 (TTAB 2021). Opposer must prove its entitlement to a statutory cause of action by a preponderance of the evidence. *DowntownDC Bus. Improvement Dist. v. Clarke*, Opp. No. 91275100, 2024 WL 4449409, at *1 (TTAB 2024).

Opposer argues that its pleaded registrations of its PANERA marks “establish standing inasmuch as they support Opposer’s direct commercial interest in whether marks incorporating Opposer’s entire mark for overlapping goods are allowed to

register and Opposer's reasonable belief it will suffer harm as a result due to dilution, likelihood of confusion and/or false suggestion of a connection." *Id.*⁸

As noted above, Opposer properly made of record electronic records from the database of the United States Patent and Trademark Office ("USPTO") regarding its pleaded registrations of PANERA marks. 28 TTABVUE 9-20; 29 TTABVUE 3-13, 288-98). These registrations form the basis of a likelihood of confusion claim that is not wholly without merit, and thus establish Opposer's entitlement to oppose Applicant's applications. See *N.Y. Yankees P'Ship v. IET Prods. & Servs., Inc.*, Opp. No. 91189692, 2015 WL 2455162, at *3 (TTAB 2015) ("Opposer's standing is established with respect to its likelihood of confusion and dilution claims by its registrations for its . . . marks . . . , which the record shows to be valid and subsisting, and owned by Opposer"). "Once Opposer has proven its entitlement to a statutory cause of action on one pleaded ground, it has established its entitlement for any other ground." *Spotify AB v. U.S. Software Inc.*, Opp. No. 91243297, 2022 WL 110251, at *9 (TTAB 2022).

IV. Opposer's Dilution Claim⁹

We begin with Opposer's claim of likelihood of dilution by blurring under Section 43(c) of the Trademark Act because if Opposer establishes all elements of that claim, it can prevail "regardless of the presence or absence of actual or likely confusion [or]

⁸ "We now refer to what previously had been called 'standing' as 'entitlement to a statutory cause of action.' But our prior decisions and those of the Federal Circuit interpreting 'standing' under §§ 13 and 14 remain applicable." *Sabhnani*, 2021 WL 6072822, at *6 n.14.

⁹ Opposer has used and registered the marks PANERA and PANERA BREAD. Opposer focuses its dilution claim on the PANERA mark.

of competition.” 15 U.S.C. § 1125(c)(1). “Dilution does not involve confusion of the public, but rather provides extraordinary protection to owners of ‘the select class of marks – those with such powerful consumer association that even non-competing uses can impinge on their value.’” *Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, Opp. No. 91247034, 2023 WL 4261426, at *17 (TTAB 2023) (quoting *Toro Co. v. ToroHead Inc.*, Opp. No. 114061, 2001 WL 1734485, at *18 (TTAB 2001)).

To prevail on its dilution claim, Opposer must show that:

(1) it owns a famous mark that is distinctive;¹⁰ (2) Applicant is using a mark in commerce that allegedly dilutes Opposer’s famous mark; (3) Applicant’s use of its mark began after Opposer’s mark became famous; and (4) Applicant’s use of its mark is likely to cause dilution by blurring or tarnishment.

Id.

The “threshold question in a federal dilution claim is whether the mark at issue is ‘famous.’” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012). The requirement of proof of ownership of a “famous” mark is an exacting one following the 2006 amendment of the dilution provisions of the Trademark Act through the Trademark Dilution Revision Act (“TDRA”). “Under the TDRA, a mark is famous 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.’” *Id.* (quoting 15 U.S.C. § 1125 (c)(2)(A)). “By using the ‘general consuming public’ as the

¹⁰ We find that Opposer’s PANERA mark is distinctive for the goods and services for which it has been registered because was “registered on the Principal Register without a claim of acquired distinctiveness, and is therefore presumed distinctive.” *Advance Mag. Publishers*, 2023 WL 4261426, at *18 (citation omitted).

benchmark, the TDRA eliminated the possibility of ‘niche fame,’ which some courts had recognized under the previous version of the statute.” *Id.* (citation omitted).

Opposer “has the burden of establishing that its mark has become famous.” *Chanel, Inc. v. Makarczyk*, Opp. No. 91208352, 2014 WL 2531211, at *6 (TTAB 2014). “It is well-established that dilution fame is difficult to prove,” *Coach Servs.*, 668 F.3d at 1373, because “[a]n opposer must show that, when the general public encounters the mark ‘in almost any context, it associates the term, at least initially, with the mark’s owner,’” *TiVo Brands LLC v. Tivoli, LLC*, Opp. No. 91221632, 2018 WL 6921323, at *7 (TTAB 2018) (quoting *Coach Servs.*, 668 F.3d at 1373 (quoting *Toro*, 2001 WL 1734485, at *19)), and that the mark has “become a ‘household term [with] which almost everyone is familiar.” *Id.* at *12. To be entitled to protection against dilution, we must determine whether Opposer’s PANERA mark 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.” *Advance Mag. Publishers*, 2023 WL 4261426, at *18 (quoting *N.Y. Yankees P’ship*, 2015 WL 2455162, at *3 (quoting 15 U.S.C. § 43(c)(2)(A)). “Fame” for purposes of eligibility of a mark for protection against dilution “is an either/or proposition—fame either does or does not exist” *Joseph Phelps Vineyards LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)).¹¹

¹¹ Applicant argues in the portion of its brief discussing Opposer’s dilution claim that Opposer has not shown that the mark enjoys “any recognition beyond being a restaurant.” 45 TTABVUE 15. According to Applicant, “Opposer has simply failed to provide any evidence of

To determine whether Opposer's PANERA mark is famous, we consider:

- (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; and
- (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. (quoting 15 U.S.C. § 1125(c)(2)(A)).

We must first determine when Applicant began using its PANERALUX mark in the United States because that is the date by which Opposer must show that its PANERA mark had become famous. 15 U.S.C. § 1125(c)(1).¹² Applicant filed the opposed applications on September 8, 2020. In the absence of “evidence of [A]pplicant’s use we must determine if [O]pposer’s mark became famous ‘prior to the filing date of the trademark application[s] . . . against which it . . . file[d] an opposition’” *Chanel*, 2014 WL 2531211, at *13 (quoting *Coach Servs.*, 668 F.3d at 1373).

Applicant’s founder and sole trial witness Jianfeng Yang did not specify when Applicant began using the PANERALUX mark in the United States, testifying instead that “[i]n 2007, Applicant and Applicant’s Affiliates created the

any recognition outside the food service industry.” *Id.* at 15-16. We interpret these arguments as reflecting Applicant’s position that Opposer has not shown that the PANERA mark is famous for purposes of eligibility for protection against dilution.

¹² If Opposer shows that its PANERA mark was famous when Applicant began use of its PANERALUX mark, Opposer must also show that its PANERA mark “is famous at the time the [dilution] claim is adjudicated.” *TiVo Brands*, 2018 WL 6921323, at *13.

‘PANERALUX’ trademark for use in connection with high-end lighting related products for the global market, including but not limited to the United States” and that “Applicant decided to register the ‘PANERALUX’ trademark in China in 2018 and applied for registration in the U.S. in 2020.” Yang Decl. ¶ 17 (40 TTABVUE 4). Applicant stated in discovery, however, that “[s]tarting in 2019, Applicant launched the high-end brand PANERALUX for lighting related products to the global market, including the United States,” Applicant’s Resp. to Opposer’s Int. No. 1 (33 TTABVUE 104). Opposer made Applicant’s response of record, 22 TTABVUE 104, and cites it as evidence that “Applicant claims use of the PANERALUX mark in the United States since 2019.” 42 TTABVUE 27. Opposer then argues that its PANERA mark “became famous well before Applicant’s claimed date of first use in 2019,” *id.* at 34, and “sustained fame after 2019,” *id.* at 35, claiming specifically that “[b]y 2018, Opposer (via company-owned locations and franchises) had PANERA bakery cafes in 43 states” and that “[i]n 2018, Opposer began offering nationwide delivery services, completing over 28 million orders in the first year.” *Id.* at 30. Opposer similarly argues in its reply brief that “there is ample evidence Opposer’s PANERA mark attained fame prior to Applicant’s claimed date of first use for PANERALUX in the US and has continued to maintain this fame.” 46 TTABVUE 9.

Because Opposer treated 2019 as the date of first use of the PANERALUX mark in the United States, and argued that its PANERA mark had become famous by then, we will use 2019 as the relevant date for our analysis. As discussed below, much of Opposer’s evidence post-dates 2019. Such evidence would be relevant on Opposer’s

dilution claim to prove that Opposer's mark was famous at the time of trial, *TiVo Brands*, 2018 WL 6921323, at *13, but such fame matters only if Opposer first establishes that its mark was famous by 2019. *See Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 WL 1827031, at *13 (TTAB 2014) (opposer's "evidentiary showing is not sufficient to show that opposer's mark is famous for purposes of dilution because most of the evidence points to events that occurred after the filing date of applicant's application.").

A. The Duration, Extent, and Geographic Reach of Advertising and Publicity of the PANERA Mark

Opposer argues that "[f]rom receiving significant publicity from major national publications to investing substantially in advertising, Opposer's marketing efforts have resulted in the PANERA brand becoming a household name." 42 TTABVUE 13.

Opposer's primary witness in support of its claim of "investing substantially in advertising" was Jami Closser, who testified that since December 2022, she has been Manager II of Accounting at Panera, LLC, which co-owns Opposer. Closser Decl. ¶ 1 (31 TTABVUE 189).¹³ Ms. Closser provided confidential figures for what she

¹³ "Rule 602 of the Federal Rules of Evidence provides that a 'witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter,'" *Sabhnani*, 2021 WL 6072822, at *5 (quoting Fed. R. Evid. 602), and that "[e]vidence to prove personal knowledge may consist of the witness's own testimony." *Id.* (quoting Fed. R. Evid. 602). The Closser Declaration lacks any express statement that Ms. Closser has personal knowledge of the matters to which she testified, and it is not self-evident that she has personal knowledge by virtue of her job duties, for a little more than two years, as "Manager II of Accounting," in which she "prepare[s] and review[s] assigned journal entries, account reconciliation, and account analyses while maintaining strong Internal Control procedures." Closser Decl. ¶ 2 (31 TTABVUE 189). *See City Nat'l Bank v. OPGI Mgmt. GP Inc.*, Canc. No. 92050730, 2013 WL 3168094, at *5-6 (TTAB 2013) (discussing when personal knowledge of the historical use of a mark may be inferred from a

described as Opposer's "Total Marketing Spend (USD)" for the years 2018-2022. Closser Decl. ¶ 3 (31 TTABVUE 189-90).¹⁴ She attached as Exhibit A a table showing that the "Total Marketing Spend" during this period consisted of a combination of expenditures by Opposer and its franchisees in what the table called the "NAF: National advertising fund" and "LAF: Local advertising fund." Closser Decl. ¶ 3; Ex. A (31 TTABVUE 192). She did not break out the "Total Marketing Spend" by category of expenditure on the various types of advertising and promotion described by Opposer's other witnesses.

Ms. Closser also testified, in the present tense, that Opposer "invests hundreds of millions per year in the United States advertising and marketing PANERA-branded goods and services." Closser Decl. ¶ 3 (34 TTABVUE 3). The dollar amount expended

witness's job duties). Ms. Closser testified that Opposer "invests" certain amounts "per year in the United States advertising and marketing PANERA-branded goods and services, Closser Decl. ¶ 2 (31 TTABVUE 189), and she provided specific confidential figures for the years 2018-2022 without specifying how those figures were derived or whether she was familiar with them by virtue of her job duties. Applicant did not challenge Ms. Closser's testimony on this basis, however, so we will consider it for whatever probative value it may have. As noted below, there are similar issues regarding the personal knowledge of some of Opposer's other witnesses, but Applicant similarly did not challenge their testimony on that basis, so we will consider their testimony for whatever probative value it may have.

¹⁴ Opposer designated these figures, and other evidence germane to its three claims, as confidential. "Confidentiality designations do not provide absolute immunity from public disclosure of materials so designated." *Kohler Co. v. Honda Giken Kogyo K.K.*, Opp. No. 91200146, 2017 WL 6547628, at *5 (TTAB 2017) (citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, Canc. No. 92057394, 2016 WL 3357265, at *4 n.21 (TTAB 2016) (the Board must be able to discuss the record evidence in its opinions unless there is an overriding need for confidentiality) and Trademark Rule 2.116(g), 37 C.F.R. 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party")). Where possible, we will discuss information designated as confidential in general terms consistent with our need to discuss the record in the course of explaining our decision.

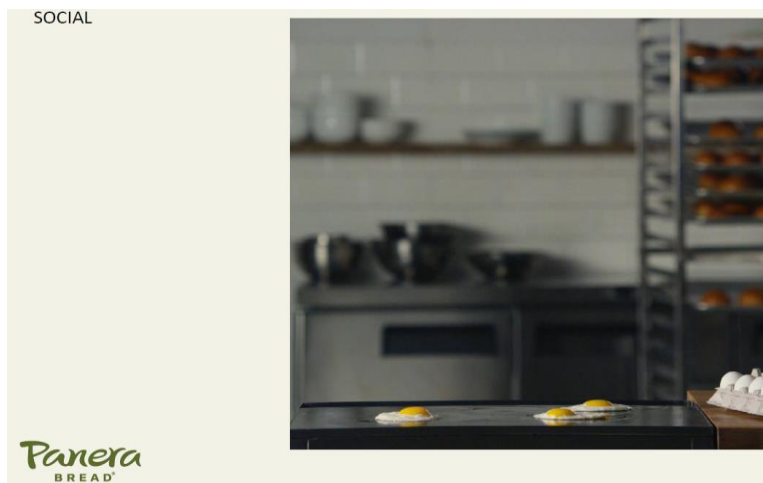
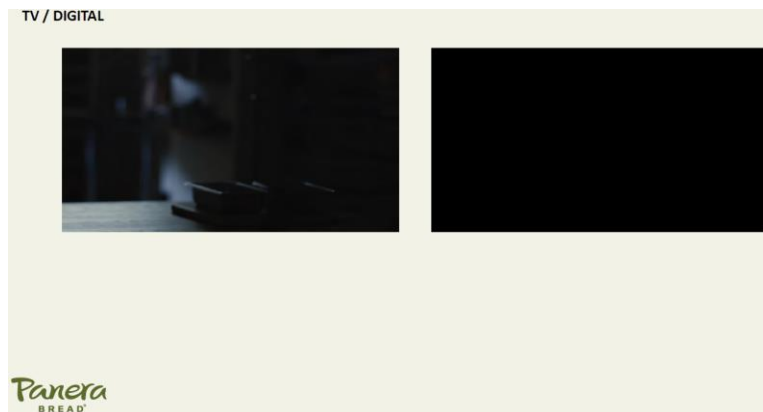
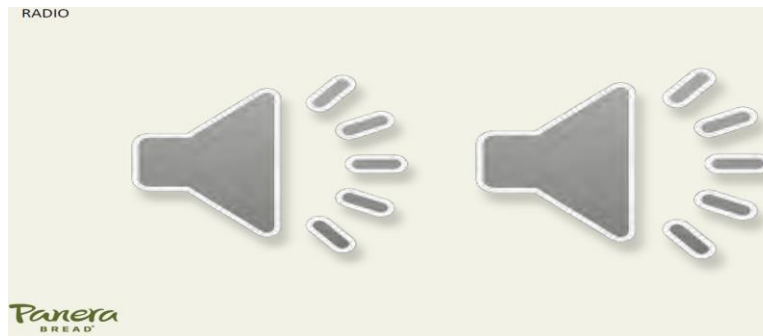
in the United States in 2018 was in the very low-nine figures.¹⁵ Closser Decl. ¶ 3 (34 TTABVUE 3-4).

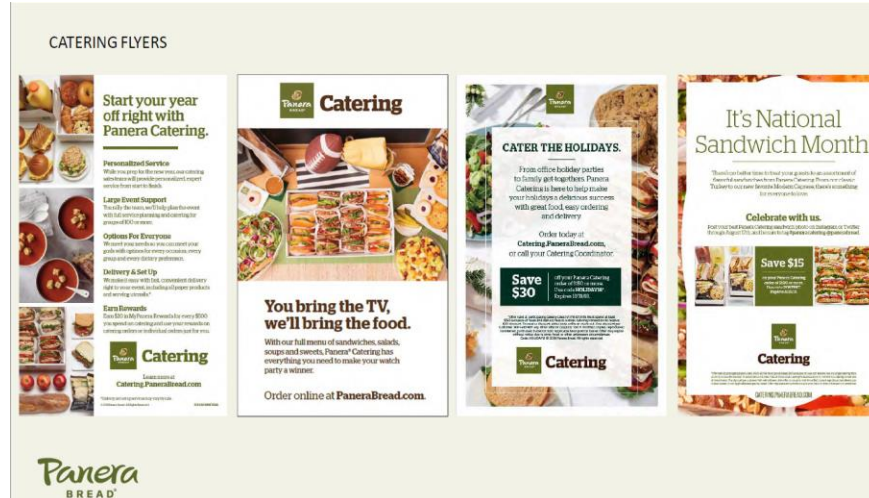
Michelle Ormes, the Vice President of Brand Marketing and Design at Panera, LLC since November 2022, Ormes Decl. ¶ 1 (29 TTABVUE 512), testified about the nature of Opposer’s advertising. She explained that Opposer “extensively advertises via various mediums, including billboards, print and digital ads, television, radio, and its website.” Ormes Decl. ¶ 11 (29 TTABVUE 515). She described Exhibits A and J to her Declaration as “representative advertisements distributed by Pumpernickel Associates and/or licensees from 2018-2023.” Ormes Decl. ¶ 11; Exs. A, J (29 TTABVUE 512, 518-30; 30 TTABVUE 85-131).

Exhibit A contains pages from Opposer’s websites that bear a 2023 copyright notice, 29 TTABVUE 519-26, and a May 2023 article on the NBC website. *Id.* at 527-29. Exhibit J consists of a series of pages captioned “Marketing Assets by Year 2018-2023.” The pages for 2018 are shown below:



¹⁵ Ms. Closser testified that the figures from 2018-2022 “represent the advertising and marketing spend for the United States and Canada,” but that “less than one percent of the annual totals were directed to Canada.” Closser Decl. ¶ 3 n.2 (31 TTABVUE 189).





Ormes Decl. Ex. J (30 TTABVUE 88-93).

Ms. Ormes also testified that Opposer “has been active on social media platforms since at least 2006,” and has 3 million likes and 2 million followers on Facebook, 54,300 followers and over 10 million views on Pinterest, 522,000 followers on Instagram, 440,000 followers on Twitter (now X), and 14,000 subscribers on YouTube. Ormes Decl. ¶ 10; Ex. I (29 TTABVUE 515; 30 TTABVUE 62-84). Exhibit I to her Declaration shows various social media pages downloaded in April 2023.

Jessica Hesselschwerdt, the Senior Director of Public Relations at Panera, LLC since November 2021, Hesselschwerdt Decl. ¶ 1 (31 TTABVUE 194), testified that “[i]n addition to the conventional advertising of PANERA goods and services discussed in Michelle Ormes’ declaration, Pumpnickel engages in joint advertising and partnerships with major global brands and celebrities.” She listed a number of

partnerships with celebrities, all of which occurred after 2018. Hesselschwerdt Decl. ¶ 3; Exs. A-D (31 TTABVUE 199-242; 32 TTABVUE 2-29; 42 TTABVUE 19).

The testimony of Opposer's witnesses regarding Opposer's advertising and promotion has very little probative value regarding whether the PANERA mark was famous by 2019. Although Opposer argues that it "has extensively advertised its goods and services under the PANERA mark for almost 30 years," 42 TTABVUE 30, Ms. Closser provided Opposer's expenditures for only one year prior to 2019. *Cf. N.Y. Yankees P'Ship*, 2015 WL 2455162, at *5 (criticizing the opposer's evidence of its sales figures because the opposer "specified neither how much of [the sales] was from the time frame most relevant for dilution - - that is, before Applicant filed its applications in 2008 . . .").

In addition, as the Federal Circuit noted more than 20 years ago, there is a "very large number of restaurants in this country," *In re Coors Brewing Co.*, 343 F.3d 1340, 1346 (Fed. Cir. 2003), and Ms. Closser provided no information about how Opposer's expenditures in 2018 (or at any point) compared to those of its numerous competitors in the restaurant business. Some such comparison is necessary to understand the relative significance of Opposer's very low nine-figure expenditure in 2018. *Cf. Starbucks U.S. Brands, LLC v. Ruben*, Opp. No. 91156879, 2006 WL 402564, at *8 (TTAB 2006) (finding in 2006 that the STARBUCKS mark was "one of the most famous brands in the world" and a "truly famous mark" based in part on promotional expenditures between 2001 and 2004 of more than \$150 million); *Chanel*, 2014 WL 2531211, at *8 (finding that the opposer's advertising expenditures in the United

States exceeded \$275 million between 2000-2007, that the opposer expended more than \$50 million in 2008 alone, and that the opposer expended over \$200 million between 2009-2012).¹⁶

Ms. Ormes authenticated pages from 2018 showing examples of out-of-home, radio, television, digital, social media, and point-of-purchase advertising displaying the PANERA mark, but she did not provide any information about the extent, frequency, exposure, and geographic reach of that advertising in that year. She also did not provide any evidence identifying the print and electronic media in which Opposer advertised prior to 2019. *Cf. Spotify*, 2022 WL 110251, at *5 (finding that the opposer “advertises on major television broadcast and cable networks including ABC, NBC, CBS, FOX and ESPN, as well as national radio networks including Westwood One and Urban One”); *Chanel*, 2014 WL 2531211, at *7 (finding that the CHANEL mark appeared in “magazines devoted to fashion such as *Vogue*, *Glamour*, *Harper’s Bazaar* and *Elle*,” as well as “men’s magazines such as *GQ*, *Men’s Journal* and *Golf Digest*” and “general interest magazines such as *People*, *Vanity Fair* and *The New Yorker* and newspapers with a large, general circulation such as *The New York Times*”).

Ms. Ormes’ testimony about Opposer’s social media presence appears to reflect Opposer’s followers, subscribers, and viewers as of 2023 rather than at any point prior

¹⁶ In *Starbucks*, the Board found that the STARBUCKS mark was famous for purposes of the opposer’s likelihood of confusion claim and did not reach the opposer’s dilution claim. There is no doubt, however, that the mark would have qualified for protection against dilution based on the Board’s findings that STARBUCKS was “one of the most famous brands in the world” and a “truly famous mark.” *Starbucks*, 2006 WL 402564, at *8.

to 2019.¹⁷ Ms. Hesselschwerdt’s testimony about joint advertising and partnerships similarly appears to pertain solely to the period after 2019.

We find on this record that the first fame factor does not support a finding that the PANERA mark had achieved dilution-level fame by 2019.

B. The Amount, Volume, and Geographic Extent of Sales of Goods or Services Offered Under the PANERA Mark

Opposer argues that “[p]erhaps the best indicator of the success of the PANERA brand is its extremely high sales volume” 42 TTABVUE 20. Opposer’s primary witness regarding its sales was Mark Wooldridge, the Senior Vice President, Controller, and Chief Accounting Officer at Panera, LLC since January 1, 2015. Wooldridge Decl. ¶ 1 (32 TTABVUE 327).¹⁸ Mr. Wooldridge testified that “PANERA-branded sales have in fact grown consistently as shown below where revenues (including company-owned revenues, franchise royalties, and other product sales) of

¹⁷ Moreover, the 2023 social media figures to which Ms. Ormes testified compare unfavorably to such figures from other cases in which marks were found to be famous. *See, e.g., Spotify*, 2022 WL 110251, at *4 (SPOTIFY mark found to be famous in part based on 23.3 million “likes” on Facebook, 5.3 million followers on Instagram, 3.5 followers on Twitter (now X), 1 million followers on LinkedIn, and 1 million followers on YouTube).

¹⁸ Ms. Ormes testified that Opposer has used the PANERA mark in connection with restaurant services and other goods and services since 1997. Ormes Decl. ¶ 3 (29 TTABVUE 512).

\$363.7 million in 2003 grew to approximately \$2.385 billion just 10 years later in 2013. Wooldridge Decl. ¶ 6 (32 TTABVUE 328). He referred to the chart shown below:

Year	Total Revenue (USD)
2003	363,700,000
2004	479,100,000
2005	640,300,00
2006	829,000,000
2007	1,066,700,000
2008	1,298,900,000
2009	1,353,500,000
2010	1,542,500,000
2011	1,822,000,000
2012	2,130,100,000
2013	2,385,000,000

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Wooldridge Decl. ¶ 6: Ex. H (32 TTABVUE 328-29; 33 TTABVUE 3-13).²⁰ Mr. Wooldridge appears to have obtained these figures from a Fourth Quarter 2013 Panera Bread Press Kit, Wooldridge Decl. Ex. H (33 TTABVUE 3-13), and he did not explain how they were derived or the basis for his familiarity with them.²¹

Mr. Wooldridge also testified that “[f]rom 2018-2022, PANERA-branded sales (including company-owned revenues, franchise royalties, and other product sales) in

¹⁹ Stacy Duffy, the Senior Director, Loyalty and Recurring Revenue Program Lead at Panera, LLC, testified that the MyPanera loyalty rewards program began in 2009 and was one of the earliest guest loyalty programs in the restaurant industry, with more than 52 million members as of March 2023. Duffy Decl. ¶ 3 (31 TTABVUE 175).

²⁰ Opposer did not designate these figures as confidential. Mr. Wooldridge testified that a tiny fraction of these figures was attributable to sales in Canada. Wooldridge Decl. ¶¶ 5-6, nn.3-4 (34 TTABVUE 16).

²¹ In that regard, Mr. Wooldridge is not listed in the 2013 Press Kit as part of Panera Bread’s management team. Wooldridge Decl. Ex. H (33 TTABVUE 6-11).

the United States” totaled in the very low-ten figures annually. Wooldridge Decl. ¶ 6 (34 TTABVUE 16). He did not provide any sales figures for the period from 2014-2016, and with respect to 2017, he testified only that “[b]y 2017, over \$1 billion of PANERA-branded sales were derived from its digital platforms (app, kiosk, and web).” Wooldridge Decl. ¶ 7; Ex. J (32 TTABVUE 329; 33 TTABVUE 20-24).

With respect to the geographic extent of Opposer’s sales, Opposer cites Ms. Ormes’ testimony in claiming that “by 2018 there were PANERA-branded bakery cafes in at least 43 states.” 42 TTABVUE 21 (citing Ormes Decl. ¶ 9; Ex. H (29 TTABVUE 514-15; 30 TTABVUE 49)).²² Ms. Ormes in turn cited a May 2, 2018 article in *Bustle* that stated that “Panera just announced it will deliver nationwide to 43 states and 897 cities” Ormes Decl. ¶ 9; Ex. H (30 TTABVUE 49).²³

Opposer’s evidence on this fame factor has some significant issues that reduce its probative value. Opposer’s 22 years of use of the PANERA mark as of 2019, while not insubstantial, compare unfavorably to the periods of use of multiple marks, including

²² Mr. Wooldridge did not testify about the number of Panera Bread bakery-cafes in the United States at any time prior to 2019. Instead, he testified that “[a]s of April 2023, there were 2140 Panera Bread-bakery cafes across 47 states plus the District of Columbia,” and that as of April 2024, “there are approximately 2180 company and franchise bakery-cafes in 48 states plus the District of Columbia.” Wooldridge Decl. ¶ 3; Ex. A (32 TTABVUE 327-28, 330-33). Exhibit A listed 14 states, and the District of Columbia, in which there were 10 or fewer locations, and there were no locations in Alaska or Hawaii. Wooldridge Decl. Ex. A (32 TTABVUE 330-33).

²³ Ms. Ormes has held her position as Vice President of Brand Marketing and Design at Panera, LLC, in which she is “responsible for leading Panera’s internal creative and print production functions, as well as leading Brand/Marketing Campaign development for off-premise and culinary testing,” only since November 2022. Ormes Decl. ¶ 1 (29 TTABVUE 512). It is not clear that she was even employed by Panera, LLC in 2018, or whether she did more than simply recount what is said in the May 2018 *Bustle* article.

the MCDONALD'S and STARBUCKS marks of two of Opposer's competitors,²⁴ that have qualified as famous for purposes of eligibility for protection from dilution. *See, e.g., McDonald's Corp. v. McSweet, LLC*, Opp. No. 91178758, 2014 WL 5282256, at *4 (TTAB 2014) (MCDONALD'S mark used in the United States for nearly 60 years as of 2014); *Starbucks*, 2006 WL 402564, at *4 (STARBUCKS mark used in the United States for 35 years as of 2006); *Chanel*, 2014 WL 2531211, at *7 (CHANEL mark used in the United States for more than 80 years as of 2014); *Advance Mag. Publishers*, 2023 WL 4261426, at *3 (VOGUE mark used in the United States for more than 100 years as of 2023); *Coach Servs.*, 668 F.3d at 1361 (COACH mark used in the United States for more than 50 years as of 2012).²⁵

Opposer's geographic footprint as of 2019 was not insubstantial,²⁶ but it compares unfavorably to the geographic footprints of some owners of famous marks, again including Opposer's competitors McDonald's and Starbucks. *Cf. Starbucks*, 2006 WL 402564, at *4 (finding that "Starbucks has grown to well over 5,000 company-owned

²⁴ Articles on the cnbc.com and cnn.com websites made of record by Opposer listed or referred to McDonald's, Dunkin', Taco Bell, and Starbucks as among Opposer's many competitors, Hesselschwerdt Decl. Ex. G (32 TTABVUE 93-101, 126-31), and an article on the *Fortune* website made of record by Opposer described Starbucks as Opposer's "rival." Hesselschwerdt Decl. Ex. G (32 TTABVUE 205).

²⁵ Opposer cites the Board's non-precedential decision in *Coca-Cola Co. v. Hoff*, Opp. No. 91244286, 2021 WL 1997436 (TTAB May 14, 2021) ("*Hoff*"), in which the Board found that the script Coca-Cola mark was famous, as a comparable case with respect to Opposer's evidence under the second fame factor. 42 TTABVUE 32. In *Hoff*, the Board noted that "[n]o one living today had been born when Opposer first sold products bearing a form of the Coca-Cola Script Mark" more than 130 years ago. *Hoff*, 2021 WL 1997436, at *11.

²⁶ An August 2019 article on the website of today.com described Opposer and McDonald's as "[t]wo of America's biggest restaurant chains," Ormes Decl. Ex. R (31 TTABVUE 4), but it appears that McDonald's geographic footprint was then considerably larger than Opposer's.

and licensed stores throughout the United States” and that “[t]ens of millions of customers are exposed to the STARBUCKS mark every day”); *McDonald’s*, 2014 WL 5282256, at *7 (finding in 2014 that McDonald’s operated 14,000 restaurants in the United States that served 26 million people per day); *see also Nike, Inc. v. Maher*, Opp. No. 91188789, 2011 WL 3828723, at *9 (TTAB 2011) (finding in 2011 that “[s]ales of products bearing the JUST DO IT mark have occurred in every state in the United States”); *Spotify*, 2022 WL 110251, at *11 (finding in 2015 that the opposer “had more monthly SPOTIFY users than most U.S. states had residents” and in 2022 that “a large percentage of Americans are users of or subscribers to Opposer’s SPOTIFY goods and services.”).

Opposer argues that its “sales and revenues are either comparable to or exceed amounts the Board has found sufficient to establish fame,” 42 TTABVue 32, citing *TiVo Brands, Hoff*, and *Nike. Id.* The sales figures in *TiVo Brands* (worldwide annual sales during the years 2011-2015 between \$526 million to \$690 million, and estimated worldwide sales in 2017 between \$810 and \$830 million) cover only four years as to which Mr. Wooldridge testified (2011-2013 and 2017), but Opposer’s sales figures for that period exceed the *TiVo Brands* figures. The sales figures in *Hoff* (annual revenues for beverage sales of \$1.8 billion and total net revenues of \$10 billion) cover the period between 2015 and 2019, and thus include only two years (2017 and 2018) prior to 2019 as to which Mr. Wooldridge testified. The \$1 million dollars in sales through Opposer’s digital platform in 2017 is not comparable to the counterpart figures in *Hoff*, but the 2018 figure to which Mr. Wooldridge testified in general terms

is comparable. In *Nike*, net sales of products bearing the JUST DO IT mark “at the retail level approximate[d] \$175 million,” *Nike*, 2011 WL 3828723, at *9, but it is not clear what period prior to 2011 was referenced. In any event, Opposer’s pre-2011 sales exceeded that amount.

The fact that Opposer’s sales figures were comparable to or even exceeded the figures in these three cases involving different goods and services does little to establish the probative value of Opposer’s sales figures. It is self-evident that the “very large number of restaurants in this country,” *Coors*, 343 F.3d at 1346, generate billions and billions of dollars in annual sales, but the record contains no information about how Opposer’s pre-2019 slices of that enormous pie compared to the slices of its numerous competitors. We note, however, that Opposer’s sales revenues of \$479,100,00 in 2004 were only about 12% of rival Starbucks’ 2004 sales revenues. *Starbucks*, 2006 WL 402564, at *5 (finding that “[i]n 2004 alone, Starbucks’ sales revenues reached \$4 billion.”).

Opposer’s sales figures for the periods 2003-2013 and 2017-2018 are impressive in absolute terms. “Without more context within which to evaluate these figures, however, we consider this factor to be neutral.” *TiVo Brands*, 2018 WL 6921323, at *8 (citing *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1375 (Fed. Cir. 2002) (“some context in which to place raw statistics is reasonable.”)). Cf. *Bullshine Distillery LLC v. Sazerac Brands, LLC*, ___ F.4th ___, 2025 WL 778163, at *4 (Fed. Cir. Mar. 12, 2025) (rejecting the plaintiff’s argument that the similarities in its fame evidence to the fame evidence in *Bose* showed the fame of its mark for purposes of its

likelihood of confusion claim because “fame is a question of fact that requires a case by case analysis” and “context is still relevant to the analysis of fame” even though “a particular type of context is not required” (citations omitted)).

C. The Extent of Actual Recognition of the PANERA Mark

“Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used.” *Spotify*, 2022 WL 110251, at *11 (quoting *TiVo Brands*, 2018 WL 6921323, at *8). To show actual recognition, Opposer cites awards and media coverage that Opposer has received, the number of visitors to Opposer’s websites and mobile apps, and a consumer survey. 42 TTABVue 33.

Opposer’s Media Coverage and Awards

Opposer argues that its “devotion to providing convenient, ‘crave worthy’ food has been recognized by many major, national publications, including Business Wire, Fortune, CNN, Fox Business, Reuters, Forbes, Yahoo Finance, People, and Bustle.” *Id.* at 14. According to Opposer, there “is extensive, consistent third-party media coverage of Opposer’s many PANERA-branded products, initiatives, and accomplishments by a broad range of publications.” *Id.* at 15. Opposer provides a table

of what it calls a “representative sample from 2017 – 2023” of such media coverage.

Id. at 15-16. The 10 of the 23 articles in the table that pre-date 2019 are listed below:

Year	Article Title	Publication
2017	“Panera Bread Says It Hit \$1 Billion Digital Sales Target	Fortune
2018	“Panera Bread is Expanding Its Unique Delivery Services, and It Just Might Be Brilliant. Here’s Why”	Inc.
2018	“Panera is reinventing bread as ‘health’ as sandwich chains like Quiznos and Subways struggle to survive”	Insider
2018	“Move Your Cheese-Loving Butt: Panera Just Rolled Out A Bacon Mac and Cheese”	Delish
2018	“Panera Now Has Barbecue Mac and Cheese”	Daily Meal
2018	“Taking Aim at Competitors, Panera Asks FDA to Define An ‘Egg’”	Forbes
2018	“Panera Bread launches new digital video series on food transparency”	FastCompany
2018	“Panera Now Has A Make-Your-Own Mac and Cheese Bar”	Delish
2018	“Panera Bread Bakes Plans For Growth By Investing in Customer Relevance And Personalization	Forbes
2018	“Panera rolls out breakfast delivery”	Food Business News

Hesselschwerdt Decl. Ex. G (32 TTABVUE 42-241, 295-96). The Hesselschwerdt Declaration contains a similar table of what the witness called “substantial third-party media coverage of [Opposer’s] many products, initiatives, and accomplishments by a broad range of publications.” Hesselschwerdt Decl. ¶ 7 (31 TTABVUE 196-97). Nine of the 22 articles pre-date 2019. All but one are listed in the table in Opposer’s main brief.

We have reviewed all of the articles made of record by Opposer, including those that post-date 2018. They portray Opposer as an innovative, tech-savvy, and socially-responsible seller of high-quality, “clean” food, but none of them refer to the PANERA mark in a manner reflecting actual public recognition of the mark’s fame, such as by referring to the mark as “well known,” “famous,” or a “household name.” *Cf. Spotify*,

2022 WL 110251, at *11 (discussing “media reports which refer to SPOTIFY as ‘well known’ and a ‘household name’”); *TiVo Brands*, 2018 WL 6921323, at *8 (noting a *Los Angeles Times* article describing TIVO as having “near household-name recognition” and other articles describing TIVO as an “iconic brand,” “revolutionary,” and a “pioneer product”); *Nike*, 2011 WL 3828723, at *7 (discussing articles showing that the JUST DO IT mark “has made its way into the popular culture”);²⁷ *Chanel*, 2014 WL 2531211, at *9 (noting articles in the *Atlanta Journal Constitution* and the *Los Angeles Times* describing CHANEL as “the brand famous for high-end accessories” and the “pinnacle of luxury”).

As noted above, Opposer has also received a number of industry awards and recognitions, several of which pre-date 2019. We reproduce below a table of such awards and recognitions set forth in the Hesselschwerdt Declaration:

²⁷ Opposer argues hyperbolically that the PANERA brand “is also part of pop culture,” 42 TTABVue 9, based on the post-2018 celebrity and brand partnerships noted above. There is no equivalence between whatever exposure the PANERA mark received through such cross-marketing, and the “pop culture” references to marks in articles discussed in other cases. In *Nike*, the articles included statements that Nike’s “Just Do It” advertising slogan is one of those rare gems that have transcended advertising to enter popular culture and language,” and “Nike dominates the U.S. athletic shoe industry, testimony to a marketing machine so successful that the company’s ‘Just Do It’ slogan and ‘swoosh’ logo are part of U.S. pop culture.” 2011 WL 3828723, at *7. See also *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, Opp. No. 91177415, 2010 WL 595586, at *14 (TTAB 2010) (famous CITIBANK mark “was the subject of two parodies on *Saturday Night Live*”), *aff’d*, 637 F.3d 1344 (Fed. Cir. 2011); *Chanel*, 2014 WL 2531211, at *10 (“The CHANEL brand name and its founder, Coco Chanel, have been the subject of numerous fiction and non-fiction books.”).

Date	Publication/Organization	Recognition
2010	Zagat	Most Popular Large Restaurant Chain
2015, 2016	Reputation Institute	US RepTrak 100, No. 1 in hospitality industry in 2015
2016	Fast Casual	Top 100 Movers and Shakers
2016, 2017	Fortune	World's Most Admired Companies
2016, 2018	Moosylvania	Top 100 Millennial Brands
2019	People Food Awards 2019: The Best Supermarket Products of the Year	Best Coffee
2020	Incisiv/Limited Service Restaurant Digital Maturity Benchmark	No. 2 for Digital Performance
2021	Fast Company	The World's Most Innovative Companies
2021	Fast Company	The 10 Most Innovative Dining Companies
2022	Inc.	20 Most Purpose-Driven Brands
2022	Worth	10 Most Sustainable Companies

Hesselschwerdt Decl. ¶ 8 (31 TTABVUE 197). We discuss below the pre-2019 awards and recognitions.

A 2010 Zagat Survey named Panera Bread “the Most Popular large restaurant chain in the United States.” 32 TTABVUE 318. Panera Bread “topped the list of 90 restaurants in this category (defined as chains with less than 5,000 locations).” *Id.* “Survey responses separately rated each chain’s food, facilities and service on Zagat’s signature 30-point scale” and “[m]ore than 6,500 diners participated in the 2010 survey.” *Id.*²⁸ Opposer’s preeminent popularity in 2010 vis-à-vis 90 of its large restaurant chain competitors obviously was no small accomplishment and reflected favorably on the quality of Opposer’s restaurants at that time, but the 2010 Zagat Survey has little probative value in our analysis of whether by 2019 the PANERA

²⁸ According to a statement attributed to Opposer’s CEO in connection with receiving the award, Opposer received this recognition the previous year as well, 32 TTABVUE 318, but the 2010 Zagat Survey is the only such survey the record.

mark was a household term with which almost everyone was familiar. The 2010 Survey measured the relative popularity of specific identified restaurants among restaurant patrons, not how well-known the PANERA mark was to the general public.

A June 2015 Reputation Institute press release touted “its inaugural list of America’s top 50 most reputable hospitality companies,” and listed Panera at the top of the “top 10 companies in the hospitality industry in 2015.” *Id.* at 325. The Reputation Institute, which described itself as the “world’s leading consulting and advisory firm for reputation,” *id.* at 326, explained the derivation of the list as follows:

Reputation Institute conducted more than 50,000 interviews with the US general public in 10 2015. The RepTrak® model is the gold standard for reputation measurement, providing a one-of-a-kind measurement of how the public views the world’s best-known companies, examining 15 stakeholder groups in more than 25 industries and more than 50 countries for more than 7,000 companies.

Id.

In a 2015 report captioned “Ranking the Brands,” *id.* at 264-72, the Reputation Institute stated that it “measure[d] the corporate reputations of the largest U.S. companies based on consumers’ trust, esteem, admiration and good feeling about a company. It assigned each company a score—0 to 100—based on responses and then ranked them.” *Id.* at 265. Panera Bread was ranked ninth in the 2015 report. *Id.* In the 2016 report, *id.* at 273-81, Panera Bread had dropped to 73rd. *Id.* at 279.

As with the 2010 Zagat Survey, the 2015 and 2016 Reputation Institute reports have little probative value in our analysis of whether by 2019 the PANERA mark had

become a household term with which almost everyone was familiar. The 2015 and 2016 reports measured the reputation of specific identified brands, including PANERA, not how well-known the PANERA mark was to the general public.

A 2016 report on the website of FastCasual.com captioned “2016 Fast Casual Top 100 Movers and Shakers” and subtitled “Innovative restaurant brands and executives shaping the fast casual segment, *id.* at 320-24,²⁹ “rated brands on growth and sales, but also on innovation across several categories, including technology, design, customer experience, sustainability, and menu offerings.” *Id.* at 321. Panera Bread was rated #4, one place ahead of the Tropical Smoothie Café. *Id.* at 322.

The report stated that

[t]o help narrow down the choices this year, we accepted self-nominations, requiring each brand to answer a variety of questions about their businesses. Besides gaining a lot of quantitative knowledge via growth stats to back up what we already knew — the growth of the industry is on fire — this info also helped judges narrow down the hundreds of nominations. The panel settled on 75 brands and 25 executives to round out the final Top 100.

Id. at 321. The 2016 Fast Casual report measured metrics other than brand recognition, and it appears that it did so based not on surveying actual consumers, but instead relying on unidentified judges who reviewed internal and external nominations of companies. The report tells us nothing about whether the PANERA mark had become famous by 2019.

²⁹ It appears that a “fast casual” restaurant is one that does not provide full service. See *Peterson v. Awshucks SC, LLC*, Canc. No. 92066957, 2020 WL 7888976, at *8 (TTAB 2020).

Fortune magazine listed Opposer as one of the “World’s Most Admired Companies” in reports in 2016 and 2017. The reports contain no explanation of the criteria for the listings or the methodology by which, and persons by whom, companies were selected and ranked. 32 TTABVUE 243-51. Both listings contain a section captioned “Key Attributes of Reputation,” which include “Innovation,” “People Management,” “Use of Corporate Assets,” “Social Responsibility,” “Quality of Management,” “Financial Soundness,” “Long-Term Investment Value,” “Quality of Products/Services,” and “Global Competitiveness.” *Id.* at 244, 248. It appears from the bare bones information in the rankings that Opposer was ranked as the fifth most admired company in the “Food Services” industry in both years. *Id.* at 245, 248. Being among the most “admired” companies in the food service business is again no small accomplishment, but the 2016 and 2017 reports measured customer admiration of specific identified brands, including PANERA, not how well-known the PANERA mark was to the general public.

Opposer was also listed as the 81st out of 100 brands in the “2016 Top 100 Millennial Brands: A Moose Tracker Report” and as the 92nd out of 100 brands in the Moose Tracker “Top 100 Brands for Millennials | 2018” report. *Id.* at 251-63. The 2016 report stated that

[e]ach year, we survey up to 1,500 consumers and provide them with the opportunity to tell us their “three favorite brands”—completely unaided. Those answers are then followed up with specific questions on how and why they are connecting and participating. . . . The top 100 report is a ranking of consumer favorites along with an example that illuminates their success in a bite-sized paragraph.

Id. at 252. For the 2018 Report, Moose Tracker “asked more than 1,500 millennials (defined as 16 to 36 years old) to select their favorite brands.” *Id.* at 256.

The surveys reflected in the Moose Tracker reports elicited the respondents’ “favorite” brands on an unaided basis, that is, they asked respondents to name their favorite brands without prompting, and they thus reflect, to at least some degree, the respondents’ top-of-mind familiarity with the PANERA mark. But according to U.S. Census data as of 2015, millennials were only slightly more than 25% of the U. S. population,³⁰ and we have no information about the favorite top-of-mind brands of the rest of the population in 2016 and 2018.³¹ We find that the 2016 and 2018 Moose Tracker reports have relatively little probative value with respect to whether PANERA was a household name prior to 2019 among the entire “general consuming public of the United States.” 15 U.S.C. § 1125 (c)(2)(A).

Brand value rankings can support a finding that a mark has achieved dilution-level fame. *See, e.g., Chanel*, 2014 WL 2531211, at *10 (finding that the “CHANEL mark has been consistently ranked as one of the most recognized and famous brands in the United States” and “has appeared in the top 100 international brands as ranked by Interbrand and reported in BusinessWeek each year between 2001 and 2009”); *Citigroup*, 2010 WL 595586, at *14 (CITIBANK mark ranked as the 13th most

³⁰ The Board may take judicial notice of U.S. Census information, *Ricardo Media, Inc. v. Inventive Software, LLC*, Opp. No. 91235063, 2019 WL 3956987, at *8 (TTAB 2019), and we take judicial notice that as of 2015, millennials numbered 83.1 million in the United States. (census.gov/newsroom/archives/2015-pr/cb15-113.html (last accessed on March 17, 2025)).

³¹ We discuss below that Opposer’s consumer survey did not test the sort of unaided awareness that was tested in the Moose Tracker surveys.

valuable brand by BusinessWeek magazine between 2001-2004, with an estimated brand value in excess of \$13 billion, and as the ninth most valuable brand with a value in excess of \$31 billion in the 2006 BrandZ Top 100 Brand Ranking); *Spotify*, 2022 WL 110251, at *5 (SPOTIFY mark ranked No. 92 on Interbrand's list of the "Best Global Brands 2019" and ranked in the same year as second, behind APPLE and ahead of ANDROID and DISNEY, on Prophet's United States "Brand Relevance" list). With the exception of the Moose Tracker rankings, which are limited demographically, the brand rankings offered by Opposer do not reflect brand recognition, the metric for both brand value and dilution fame. We find that Opposer's recognition and awards evidence does not establish that by 2019, PANERA was a household name among the general public.

Visitors to Opposer's Website

Opposer argues that "[y]et another indicator of general consumers' familiarity with the PANERA brand is the fact that from 2019 to 2022, there were over 130-150 million daily unique visitors to Opposer's PANERA websites and mobile apps." 43 TTABVUE 33. This evidence all post-dates 2018 and thus tells us nothing about whether the PANERA mark was famous by 2019.

The Poret Survey

Opposer argues that the "fame survey conducted by survey expert Hal Poret revealed that 91.3% of the general consuming public recognize the PANERA mark, which he characterized as 'very high' and a 'powerful[] demonstrat[ion]' of fame." 42 TTABVUE 32-33 (emphasis supplied by Opposer). Opposer argues that "Mr. Poret's

findings exceed the percentages courts [sic] have deemed sufficient to establish fame.”

Id. at 33 (citation omitted).

Applicant responds that:

Opposer attempts to hide its limited recognition by claiming that the survey conducted by Opposer’s expert, Hal Poret, demonstrates that the consuming public recognizes Opposer’s Marks. However, Opposer intentionally omits in its explanation that Mr. Poret’s survey is specifically and intentionally limited to restaurants. Nothing in the report extends to fame beyond the restaurant industry, and the declaration of Mr. Poret specifically identifies that the survey was conducted in relation to “restaurants”. . . Such a survey creates severely inflated recognition results and provides no insight whatsoever into how consumers would view Applicant’s Marks and any connection to Opposer consumers might have when seeing or hearing Applicant’s Marks for entirely different and unrelated goods. Opposer claims it is “unrefuted” that Opposer’s Marks are famous for the general public, but that is not what Mr. Poret’s survey shows. Mr. Poret’s survey only shows that Opposer is highly recognized as a restaurant and nothing more. Opposer’s reliance on Mr. Poret’s survey as evidence that Opposer’s Marks would suffer dilution is severely flawed.

45 TTABVUE 16.

In its reply brief, Opposer argues that Mr. Poret “has been recognized as a qualified survey expert by this Court [sic] and whose surveys have been accepted many times by the Board.” 46 TTABVUE 9.³² Opposer rejects Applicant’s arguments

³² Opposer cites two non-precedential Board decisions in which Mr. Poret was qualified as a survey expert. 46 TTABVUE 9-10 (citing *Combe Inc. v. Marke Enters., LLC*, Opp. No. 91214779, 2021 WL 1263059, at *15 (TTAB Mar. 31, 2021) and *Luxco, Inc. v. Everwild Spirits, LLC*, Opp. No. 91268045, 2023 WL 2889715, at *6 (TTAB Mar. 24, 2023)). Neither case appeared in the listing in Mr. Poret’s report of cases within the past four years in which he provided trial or deposition testimony, 33 TTABVUE 48-53, and neither case involved a dilution survey. We discuss below his fame surveys in these cases and in one additional non-precedential dilution case in which he conducted a survey.

regarding the methodology of the survey, arguing that the survey showed a very high level of recognition of the PANERA mark among the general public. *Id.* at 10-11.

Mr. Poret has previously been found by the Board to be qualified as a survey expert, *see, e.g., Kohler*, 2017 WL 6547628, at *45, and we find that based on his experience, education, and training, he is qualified to offer his opinion, based on his survey, regarding the fame of the PANERA mark for purposes of eligibility for protection against dilution.

Mr. Poret testified that his survey “followed a well-accepted and highly standard survey format for testing whether or not a mark is famous. The format involves showing respondents a mark and asking whether or not respondents have ever seen or heard of the mark in order to test the level of recognition of the mark.” Poret Decl. ¶ 13 (33 TTABVUE 32). He explained that “[a]ll respondents were shown and asked about the PANERA Mark in the context of restaurants,” Poret Decl. ¶ 15 (33 TTABVUE 32),³³ and that “[r]espondents were prompted as follows:

On the next screens, you will be shown and asked about some names that you may or may not have seen or heard before in connection with restaurants.

For each name, please tell us whether or not you have ever seen or heard of any restaurant with that name.

³³ Mr. Poret testified that a total of 300 respondents aged 18 or older participated in the survey, Poret Decl. ¶ 12 (33 TTABVUE 32), and that “[t]here were no screening questions requiring purchase of any particular products or services.” Poret Decl. ¶ 31 (33 TTABVUE 36). Although Mr. Poret included six respondents (2% of all respondents) who worked for Panera, Poret Decl. ¶ 34 (33 TTABVUE 38), we find that the survey universe and the sample drawn from that universe appropriately consisted of members of the general public.

For any question you are asked, if you have no opinion or do not know, please indicate so. Please do not guess.

Poret Decl. ¶ 19 (33 TTABVUE 33) (underscoring in original; bolding added).³⁴

Mr. Poret testified that “[n]ext, all respondents were asked the following question: ‘Have you ever seen or heard of any restaurant with the following name?’ Beneath the question, respondents were randomly shown one of the seven names identified above. Beneath the name respondents could select one of the following options:

- Yes, I have
- No, I have not
- Not sure/Don’t know”

Poret Decl. ¶ 21 (33 TTABVUE 34).

Mr. Poret’s report included the following table of results:

Proportion That Has Seen or Heard of Each Name - All Respondents		
N=300	N	%
CHIPOTLE	291	97.0%
PANERA	274	91.3%
CHECKERS	221	73.7%
POTBELLY	114	38.0%
SWEETGREEN	47	15.7%
GRAINSPOT	12	4.0%
TROUBA	10	3.3%

Poret Decl. ¶ 26 (33 TTABVUE 35).³⁵

³⁴ Mr. Poret testified that “[t]he term ‘restaurants’ was selected because it is a very broad category that encompasses a great variety of food service establishments, including fine dining and other types of full-service restaurants.” Poret Decl. ¶ 20 (33 TTABVUE 33). As noted above, Opposer operates “fast-casual” restaurants, which are neither fine-dining nor full-service restaurants.

³⁵ It is noteworthy that if Mr. Poret’s survey shows that the PANERA mark had achieved dilution-level fame by September 2022, Opposer did two of its competitors a huge favor, as the survey also shows that the CHIPOTLE mark is even more famous, with 97% aided recognition, and that the CHECKERS mark may also enjoy dilution-level fame, with almost

Mr. Poret concluded that “[b]ased on these results it is my opinion that the PANERA mark is famous in the context of federal trademark law, in that 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.” Poret Decl. ¶ 59 (33 TTABVUE 44-45).

Mr. Poret’s survey is problematic for two primary reasons. First, the survey was conducted between September 16 and September 23, 2022. Poret Decl. ¶ 46 (33 TTABVUE 41). The survey results thus reflect a “snapshot” of consumer recognition of the PANERA mark in September 2022, not as of 2019. That fact alone is not fatal, but it does seriously limit the survey’s probative value because Mr. Poret’s opinion regarding the fame of the PANERA mark, based on the survey and expressed in the present tense in the April 1, 2024 Poret Declaration, Poret Decl. ¶ 59 (33 TTABVUE 44-45), does not address whether the PANERA mark was famous by 2019.³⁶ *Cf. Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, Opp. No. 91166701, 2010 WL 2513872, at *11 (TTAB 2010) (finding that “inasmuch as one of the elements that opposer must prove under the likelihood of dilution claim is whether the mark THE OTHER WHITE MEAT became famous prior to the 2004 filing date of applicant’s involved

74% aided recognition. *See Campari Am. LLC v. Skyyguard, Corp.*, 2023 WL 5950076, at *11 (TTAB Sept. 11, 2023) (non-precedential case discussing a Poret dilution survey) (“Professor McCarthy posits, and our precedent is consistent with the proposition, that a threshold response in the range of 75% of the general consuming public is necessary to prove fame for purposes of dilution”).

³⁶ Unlike evidence of dilution fame, “the Board generally accepts and considers evidence related to fame of the plaintiff’s mark up to the time of trial when considering likelihood of confusion.” *Promark Brands Inc. v. GFA Brands, Inc.*, Opp. No. 91194974, 2015 WL 1646447, at *17 (TTAB 2015).

application, the Northwestern Study of 2000 is timely evidence to address this critical question”); *Chanel*, 2014 WL 2531211, at *10 (finding that the opposer’s consumer recognition survey evidence was “particularly persuasive” because “[o]ver the past six years, for internal business purposes, opposer has commissioned multiple consumer surveys demonstrating that its mark CHANEL is extremely well known and enjoys an unusually high degree of unaided and aided recognition” and that the “fact that these surveys were commissioned prior to the instant litigation and were used in the ordinary course of business increases their probative value”); *Campari*, 2023 WL 5950076, at *11 (discussing Poret dilution survey conducted in 2017, prior to the 2018 date by which the opposer had to prove that the involved SKYY mark for vodka had achieved dilution-level fame).³⁷

Second, the survey’s key question is problematic because respondents were shown “a mark and ask[ed] whether or not [they] have ever seen or heard of the mark.” Poret Decl. ¶ 13 (33 TTABVUE 32). The survey thus tested “aided” rather than “unaided” awareness of the PANERA mark. *See Chanel*, 2014 WL 2531211, at *10 n.10 (“‘Unaided’ awareness indicates that the survey participant spontaneously mentions the CHANEL brand name without prompting; ‘aided’ awareness means that the survey participant responds ‘yes’ when asked whether he or she is aware of the CHANEL brand name); *Citigroup*, 2010 WL 595586, at *14-15 nn.57, 64 (“Unaided

³⁷ The *Campari* case, in which Mr. Poret submitted a testimony declaration in April 2021 regarding a fame survey that he conducted in 2017, also does not appear in the listing of cases within the past four years in which he provided trial or deposition testimony. 33 TTABVUE 48-53.

awareness is a respondent's unprompted response (e.g., in the financial field, which brands come to mind?),” while “‘Aided awareness’ is presenting the respondent with the name of the brand and asking whether the respondent has heard of the brand”).

Mr. Poret has previously tested both aided and unaided awareness in Board surveys. In the *Combe* case cited by Opposer to establish Mr. Poret's bona fides as an expert, 46 TTABVUE 9-10, he tested both unaided and aided awareness of the VAGISIL mark. *Combe*, 2021 WL 1263059, at *15. In finding that the VAGISIL mark was famous for likelihood of confusion purposes, the Board noted 38.7% awareness of the mark when respondents were “asked, unaided, to list all brands of vaginal care products” they have ever seen, and 90% aided awareness. *Id.*³⁸ By contrast, in the *Campari* case, the Board found that the 24% of “respondents that identified SKYY in an unaided awareness question about vodka products is not indicative of dilution-level fame.” *Campari*, 2023 WL 5950076, at *11. Unlike Mr. Poret's surveys in the *Combe* and *Campari* cases, his survey in this case provides no information about the level of unaided awareness of the PANERA mark.

“In general, the Board has discouraged heavy reliance on aided awareness to prove fame.” *Promark Brands*, 2015 WL 1646447, at *13 (citing *Carefirst of Md., Inc. v. Firsthealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 WL 2451671, at *16-17 (TTAB 2005), *aff'd*, 479 F.3d 825 (Fed. Cir. 2007)). In *Promark Brands*, the Board

³⁸ In *Luxco*, the other non-precedential case cited by Opposer to establish Mr. Poret's expertise, the Board accepted Mr. Poret's aided awareness survey, which found that “the level of awareness for EVERCLEAR as a brand name to be 72.5% amongst all alcohol consumers,” as evidence of the fame of the mark for likelihood of confusion purposes. *Luxco*, 2023 WL 2889715, at *6.

considered a consumer survey offered to show the fame of the opposer's mark for likelihood of confusion purposes. The survey showed 82% aided awareness of the SMART ONES mark "among individuals who had purchased a frozen meal from the frozen food section of a supermarket in the previous 30 days." *Id.* The opposer's expert "measured aided awareness by prompting potential survey respondents with a list of 6 trademarks for frozen meals, including 'SMART ONES,' and asking them which products they had heard of previously." *Id.* The Board held that because the survey questions "recited the SMART ONES mark among the 6 suggested responses, we find the results of [the] aided awareness question to lack significant evidentiary value on the question of fame." *Id.* See also *Carefirst*, 2005 WL 2451671, at *17 ("[I]t is unaided awareness that is most significant. . . One should not be permitted to so heavily rely on aided awareness, that is, awareness after the brand has been prompted, to show fame (e.g., 'Have you ever heard of CAREFIRST?')" (citing J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION ("MCCARTHY"), § 32:173 (4th ed. 2004))).

In most precedential dilution cases, the Board has required a sufficiently high level of unaided awareness, either alone or coupled with aided awareness, to show dilution-level fame of a mark. *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431984, at *14 (TTAB 2007) (finding that 73% unaided awareness of the opposer's BIG GULP mark among all consumers showed that the mark was famous); *Chanel*, 2014 WL 2531211, at *10 (relying in part on the opposer's "multiple consumer surveys demonstrating that its mark CHANEL is extremely well known and enjoys an unusually high level of unaided and aided recognition"); *Nike*, 2011 WL 3828723,

at *11 (noting that “unaided surveys” showed broad public recognition of the JUST DO IT mark); *Citigroup*, 2010 WL 595586, at *14 (finding that CITIBANK mark was famous based in part on tracking studies showing that in 1983, the mark “had a 68% level of unaided awareness that grew to 90-95 percent in the studies done in the 1990s.”).³⁹ Mr. Poret’s 2022 survey in this case tells us nothing about the unaided awareness of the PANERA mark among the general public as of 2022, or, more pertinently, as of 2019.

For the reasons discussed above, the third and “most significant of the four elements set forth in the Act to determine fame,” *Spotify*, 2022 WL 110251, at *11, does not support a finding that the PANERA mark had achieved dilution-level fame by 2019.

D. Whether the PANERA Mark is Registered

This factor favors Opposer because its PANERA mark has been registered on the Principal Register for various goods and services since 2004. 29 TTABVUE 3-13

³⁹ In *Nat’l Pork Bd.*, a 2010 dilution case, the Board credited a pre-litigation aided awareness tracking survey that asked whether respondents “recognized a slogan and whether they could correctly attribute it to a brand, product or industry,” and that assessed “the strength of THE OTHER WHITE MEAT [slogan] in comparison with other well-known slogans.” *Nat’l Pork Bd.*, 2010 WL 2513872, at *11. The Board also noted that the tracking study was probative of fame because its results were “reported on by various media, which mentioned the position of the mark THE OTHER WHITE MEAT as the fifth most recognized advertising slogan in the United States among the general adult public at the time.” *Id.* at *17. To the extent that the pre-litigation aided awareness tracking study per se was relied on by the Board in *Nat’l Pork Bd.* to show the fame of THE OTHER WHITE MEAT mark, we note that the decision predated the *Promark Brands* decision in 2015, which held that aided awareness surveys should not be relied on heavily to show the fame of a mark for likelihood of confusion purposes, where the burden of showing fame is lower than it is in a dilution case. If aided awareness surveys should not be relied on heavily to show fame for likelihood of confusion purposes, a fortiori they should not be relied on to prove dilution-level fame, which “requires a more stringent showing.” *TiVo Brands*, 2018 WL6921323, at *7 (quotation omitted).

(Registration No. 2806259), 288-98 (Registration No. 4934852). This is the least significant fame factor, however; millions of distinctive marks are registered on the Principal Register, but “very few are ‘famous.’” *Chanel*, 2014 WL 2531211, at *7 (quoting MCCARTHY, § 24:104 (4th ed. 2014)).

E. Summary

Only the least significant fame factor supports a finding that the PANERA mark was famous by 2019. The first factor and the most significant third factor do not support a finding that the PANERA mark was famous by 2019, and the second factor is neutral. We find that Opposer failed to show that by 2019, the PANERA mark had “become a ‘household term [with] which almost everyone is familiar,” *TiVo Brands*, 2018 WL 6921323, at *12 (quotation omitted), and had earned entry into “the select class of marks – those with such powerful consumer association that even non-competing uses can impinge on their value. . . .” *Advance Mag. Publishers*, 2023 WL 4261426, at *17. Because Opposer did not prove the threshold element of its dilution claim, it cannot prevail on that claim, and the claim is dismissed with prejudice with respect to both applications.

V. Opposer’s Likelihood of Confusion Claim

Section 2(d) of the Trademark Act 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 of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

“To prevail on its Section 2(d) claim, Opposer must show by a preponderance of the evidence that it has either a registration of or priority in its [PANERA] mark, and that Applicant’s use of its mark is likely to cause confusion, mistake, or deception regarding the source of the [goods] identified in its Application[s].” *Sage Therapeutics*, 2024 WL 1638376, at *4.

A. Priority

Because Opposer’s pleaded registrations of PANERA are properly of record and Applicant did not counterclaim to cancel them, priority is not an issue with respect to those registrations and the goods and services identified in them. *Id.*

B. Likelihood of Confusion

Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is argument and evidence. *See, e.g., 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.” *Sage Therapeutics*, 2024 WL 1638376, at *5 (citing *Citigroup*, 637 F.3d at 1355) (“Not all of the *DuPont* factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case”)

(internal quotation and quotation marks omitted)).⁴⁰ “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *Id.* (citations omitted).

Opposer argues that “[t]here can be a likelihood of confusion even if every factor does not favor the Plaintiff.” 42 TTABVUE 43. According to Opposer, “the most relevant factors include: (1) the fame of the PANERA Marks; (2) the similarities between the PANERA Marks and the PANERALUX Marks; and (3) the relatedness of the goods and services.” *Id.* at 44. Opposer devotes most of its argument to these factors. *Id.* at 44-51. Opposer also discusses the third factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 476 F.2d at 1361, 42 TTABVUE 51-52, and the fourth factor, the “conditions under which and buyers to whom sales are made, i. e. ‘impulse’ vs. careful, sophisticated purchasing,” *DuPont*, 476 F.2d at 1361, 42 TTABVUE 52, and provides a bullet-point treatment of factors 6-12, which Opposer argues either favor Opposer or are neutral. *Id.* at 52-53.⁴¹

⁴⁰ As the Federal Circuit explained in *Citigroup*, the “TTAB is not required to discuss every *DuPont* factor and may find a single factor dispositive.” *Citigroup*, 637 F.3d at 1355.

⁴¹ Opposer argues that the sixth factor, the “number and nature of similar marks in use on similar goods,” *DuPont*, 476 F.2d at 1361, and the twelfth factor, the “extent of potential confusion, i.e., whether *de minimis* or substantial,” *id.*, favor Opposer because “[t]here is no record evidence that the term PANERA is dilute[d] for restaurant goods or services or any other goods or services” 42 TTABVUE 52. The sixth factor is typically asserted by defendants because it potentially allows them “to contract [the] scope of protection [of the plaintiff’s mark] by adducing evidence of” third-party marks. *Made in Nature*, 2022 WL 2188890, at *11. Applicant does not invoke the sixth factor, and it is thus inapplicable. The twelfth factor is also inapplicable under Opposer’s theory. Finally, the fact that “[t]here are no agreements between the parties regarding their respective marks,” 42 TTABVUE 53, which Opposer claims invokes the tenth factor, the “market interface between applicant and the owner of a prior mark,” *DuPont*, 476 F.2d at 1361, is irrelevant and the tenth factor is inapplicable.

Applicant acknowledges that “Opposer’s focus is on the fame of Opposer’s Marks, the similarity of the marks, and the similarity of the goods,” but “contends that there are other substantially important factors, including but not limited to the length of concurrent use and lack of actual confusion.” 45 TTABVUE 35. Like Opposer, Applicant focuses primarily on the first, second, and fifth factors, *id.* at 36-40, but also discusses the third and fourth factors, *id.* at 40-41, the eighth factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 476 F.2d at 1361, 45 TTABVUE 41-42, the ninth factor, the “variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark),” *DuPont*, 476 F.2d at 1361, 45 TTABVUE 42-45, and the eleventh factor, the “extent to which applicant has a right to exclude others.” *DuPont*, 476 F.2d at 1371, 45 TTABVUE 43.

1. The Strength of the PANERA Mark⁴²

“Before we evaluate the similarity or dissimilarity of the parties’ marks, we first consider the strength of Opposer’s asserted marks” because “the fifth *DuPont* factor enables Opposer to prove that its pleaded marks are entitled to an expanded scope of protection by adducing evidence of ‘[t]he fame of the prior mark (sales, advertising, length of use).’” *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022

⁴² As the Board noted recently, “[w]hile *DuPont* factor five specifies the ‘fame’ of the mark, the Court of Appeals for the Federal Circuit also considers the ‘strength’ of the mark under that factor.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at *9 n.39 (TTAB 2023) (citation omitted). Because we have found above that Opposer’s PANERA mark is not “famous” within the meaning of Section 43(c)(1) of the Trademark Act, and because “likelihood of confusion fame ‘varies along a spectrum from very strong to very weak,’” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *Palm Bay Imps.*, 396 F.3d at 1374-75), we will generally use the term “strength” in connection with Opposer’s Section 2(d) claim.

WL 2188890, at *11 (TTAB 2022) (quoting *DuPont*, 476 F.2d at 1361). “The strength of Opposer’s marks affects the scope of protection to which they are entitled. Thus, we consider Opposer’s marks’ conceptual strength, based on the nature of the marks themselves, and their commercial strength, based on marketplace recognition of the marks.” *Id.* at *12 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1350-51 (Fed. Cir. 2010)).

a. Conceptual Strength

The conceptual strength of Opposer’s PANERA mark is a function of the nature of the mark itself. *Monster Energy*, 2023 WL 417620, at *10. As noted above, the registrations of Opposer’s PANERA marks issued on the Principal Register without a showing of acquired distinctiveness, and thus the marks are treated as inherently distinctive for all of the goods and services for which they have been registered. Applicant has submitted no evidence of the conceptual weakness of the PANERA marks. We find that the PANERA marks are conceptually strong for the goods and services for which they have been registered.

b. Commercial Strength

Unlike dilution fame, which “is an either/or proposition— fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *Palm Bay Imps.*, 396 F.3d at 1374-75).⁴³ Again unlike dilution fame, likelihood of confusion strength

⁴³ Thus, 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.’” *Coach Servs.*, 668 F.3d at 1373 (quoting *7-Eleven*, 2007 WL 1431084, at *7).

involves a market-specific inquiry focused on whether a “significant portion of the relevant consuming public recognizes the mark as a source indicator.” *Monster Energy*, 2023 WL 417620, at *11.

A mark may be commercially strong in connection with some goods and services, but not in connection with others. *Id.* For example, in *Monster Energy*, the opposer sold energy drinks under the MONSTER ENERGY mark and also operated a restaurant under a MONSTER mark, and opposed registration of ICE MONSTER for restaurant services. The opposer’s argument for the strength of its mark as applied to restaurant services was based on the evidence of the strength of its mark for energy drinks. *Id.* The Board found that the opposer’s MONSTER ENERGY mark was admittedly famous for energy drinks, but separately assessed the strength of the MONSTER mark for restaurant services, finding that the opposer’s use of MONSTER in that regard “has not resulted in any notable commercial strength of the mark in connection with those services.” *Id.* at *12.

As discussed below in connection with the second *DuPont* factor, Opposer argues that it “offers many products and services beyond ‘restaurant services,’” 42 TTABVUE 50, and it relies primarily on those other goods and services to show relatedness. *Id.* at 48-51. As in *Monster Energy*, we will separately address the strength of the PANERA mark in connection with Opposer’s other identified goods and services.

Commercial strength may be measured indirectly “by the volume of sales and advertising expenditures in connection with the goods sold under the marks, for example, and other factors such as length of time of use of the mark;

widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services

Monster Energy, 2023 WL 417620, at *11.

Applicant all but concedes that the PANERA mark is famous for restaurant services for purposes of Opposer's likelihood of confusion claim by not disputing Opposer's arguments under the fifth *DuPont* factor. 45 TTABVUE 36 ("[T]he fame of Opposer's [mark] should only extend, if at all, to the restaurant industry and no further . . . Opposer's fame alone, especially as it would extend only to the restaurant industry and no further, is not sufficient on its own to establish a likelihood of confusion."). Opposer's non-survey evidence in support of its claim that its mark had achieved dilution-level fame by 2019 discussed above, augmented by its post-2018 evidence regarding sales, advertising, and media recognition up to the time of trial in 2024, shows that the PANERA mark is very strong commercially in connection with restaurant services.

The commercial strength of the PANERA mark for Opposer's collateral goods and services is another matter. Opposer argues that its "bakery-cafe services, websites, loyalty and gift cards, and mobile phone applications directly overlap with and/or are related to a number of Applicant's listed goods," 42 TTABVUE 48, and that it "even sells or offers merchandise including products primarily used in the kitchen (e.g., drinkware, dinnerware, and kitchen accessories) as well as products unrelated to food, e.g., the BAGuette bag, pool floats, gift cards, and bikes." *Id.* at 50.

Like many businesses, Opposer offers loyalty and gift cards and a mobile app, and sells collateral merchandise bearing its mark. Opposer has registered the PANERA

mark for “coffee mugs,” “plastic drinking cups,” “caps,” “shirts,” “t-shirts,” “sweat shirts,” and “hats,” based on claimed first use of the PANERA mark on those goods in 1997, 29 TTABVUE 3 (Registration No. 2806259), as well as for “magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards that may be redeemed for or used towards the purchase of menu items; downloadable mobile application for ordering food,” based on claimed first use of the PANERA mark in 2009. *Id.* at 288-89 (Registration No. 4934852).

Ms. Ormes was Opposer’s witness regarding the sale of collateral merchandise. She authenticated the specimens attached to Opposer’s pleaded registrations, which she testified “accurately depict PANERA merchandise locations, loyalty cards, advertisements, and goods and services,” including various goods for which Opposer has registered the PANERA mark. Ormes Decl. ¶ 17; Ex. S (29 TTABVUE 517, 31 TTABVUE 77-78, 80, 97-98, 109-12, 124, 153, 164).

Ms. Ormes also testified that Opposer “offers Panera-brand merchandise via The Panera Shop, including clothing, bags, drinkware and dinnerware, and kitchen accessories.” Ormes Decl. ¶ 14; Ex. O (29 TTABVUE 516; 30 TTABVUE 166-70). Opposer announced the “launch of its first-ever online merchandise storefront, The Panera Shop, where, for the very first time, fans of the brand can score a variety of ‘Carb Couture’ inspired by famous menu items,” in an April 26, 2023 press release. Ormes Decl. Ex. H (30 TTABVUE 167).

Ms. Ormes further testified that “[s]everal items sold at The Panera Shop have either gone viral or received extensive media coverage,” Ormes Decl. ¶ 14; Ex. O (29

TTABVUE 516) including the “BAGuette bag, the iconic green handbag shaped as a baguette, [which] went viral and received substantial press coverage from several media outlets including Glamour and Delish, selling out following a presale.” Ormes Decl. ¶ 15; Ex. P (29 TTABVUE 516; 30 TTABVUE 172-95).

Ms. Ormes did not testify regarding the duration or extent of sales of any collateral merchandise bearing the PANERA mark either prior to or after the launch of The Panera Shop in 2023. The record is thus devoid of evidence probative of the commercial strength of the PANERA mark for collateral merchandise, and “[w]e have no basis for finding [PANERA] to be a commercially strong mark for” any goods or services other than restaurant services. *Monster Energy*, 2023 WL 417620, at *12.

Opposer’s PANERA mark is conceptually and commercially strong for restaurant services, and the fifth *DuPont* factor weighs heavily in favor of a conclusion that confusion is likely with respect to those services, but the “fame of [the] mark does not extend to” the other goods and services for which the mark is registered. *Monster Energy*, 2023 WL 417620, at *13. With respect to those other goods and services, Opposer’s PANERA mark is entitled only “to the protection accorded a conceptually strong mark.” *Id.*

2. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, “[w]e consider the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Sage Therapeutics*, 2024 WL 1638376, at *5. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.*

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Id.* (quoting *Coach Servs.*, 668 F.3d at 1368). “The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, Ser. No. 86916778, 2018 WL 3993582, at *4 (TTAB 2018). Under the forward-confusion theory pursued by Opposer, the average purchaser here is a consumer of the Class 9 and Class 11 goods identified in the applications, which could include importers, wholesalers, engineers, and retailers, Yang Decl. ¶ 31 (40 TTABVUE 6), as well as end users.

Opposer argues that the standard-character PANERA and PANERALUX marks are similar because Opposer’s mark PANERA is the dominant portion of Applicant’s mark PANERALUX, 42 TTABVUE 46, and “the addition of the term -LUX in this case does not sufficiently distinguish the PANERA and PANERALUX marks given that -LUX is a descriptive term and there is no additional element or other factor that gives Applicant’s marks a distinct commercial impression.” *Id.* at 47. Opposer also argues that Applicant’s PANERALUX mark incorporates Opposer’s PANERA mark in its entirety. *Id.*

Applicant responds that the -LUX suffix in its mark is not descriptive and that the marks as a whole have different connotations because “Opposer’s use of Opposer’s Marks and clear marketing tactics have created a connotation of relating to bread

and food, which is exactly the connotation Opposer intended its marks to have,” while “Applicant has identified the origins of ‘pan’ and ‘era’ and ‘lux’ as referring to high quality goods that last a long time.” 45 TTABVUE 37.

In its reply brief, Opposer argues that Applicant conceded in its brief that the -LUX suffix “is a shorthand for ‘luxury,’” 46 TTABVUE 18 (quoting 45 TTABVUE 8), and that both of Applicant’s drawings of its standard-character PANERALUX mark “display the marks at issue as ‘PaneraLux.’” *Id.*

We agree with Opposer that “PANERA” is the dominant portion of Applicant’s PANERALUX mark. PANERA is, after all, Applicant’s primary mark, Yang Decl. ¶¶ 3-4, 11 (40 TTABVUE 2-3), and it is the first portion of Applicant’s PANERALUX mark. We further agree with Opposer that PANERA and PANERALUX are quite similar in appearance, sound, and connotation and commercial impression. The first *DuPont* factor weighs heavily in favor of a conclusion that confusion is likely.

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

The second and third *DuPont* factors respectively consider “[t]he similarity or dissimilarity and nature of the goods and services as described in an application or registration,” and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhnani*, 2021 WL 6072822, at *9 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306-08 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361)).

a. Similarity or Dissimilarity of the Goods and Services

Applicant’s two applications contain goods in different classes, so we must consider whether Opposer showed relatedness with respect to both the Class 9 goods

in Serial No. 90165765 and the Class 11 goods in Serial No. 90165881. *Cf. N. Face Apparel Corp. v. Sangyang Indus. Co.*, Opp. No. 91187503, 2015 WL 6467820, at *11 (TTAB 2015) (“Because each class in Applicant’s multi-class application is, in effect, a separate application, we consider each class separately, and determine whether Opposer has shown a likelihood of confusion with respect to each.”); *In re OSF Healthcare Sys.*, Ser. No. 88706809, 2023 WL 6140427, at *5 (TTAB 2023) (examining attorneys and applicants “should discuss the evidence of relatedness on a class-by-class basis”). Likelihood of confusion may be found as to entirety of the class in each application if it exists as to any good in that class. *Sabhnani*, 2021 WL 6072822, at *9 n.17 (citations omitted).

“The goods or services need not be identical or even competitive to find a likelihood of confusion.” *Heil Co. v. Tripleye GmbH*, Opp. No. 91277359, 2024 WL 4925901, at *33 (TTAB 2024) (citing *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000)). “They need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Id.* (quoting *Coach Servs.*, 668 F.3d at 1369 (internal quotation and quotation marks omitted)).

As Opposer acknowledges, “[e]vidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-

based registrations of the same mark for both applicant's goods and the goods listed in the cited registration." 42 TTABVUE 50 (quoting *In re Ox Paperboard, LLC*, Ser. No. 87847482, 2020 WL 4530517, at *6 (TTAB 2020) (internal citation omitted)). In addition, "[t]he applications[s] and registration[s] themselves may provide evidence of the relationship between the [goods and] services." *Monster Energy*, 2023 WL 417620, at *7 (citation omitted).

"We begin with the identifications of [goods and] services in the registration[s] and application[s] under consideration." *OSF Healthcare*, 2023 WL 6140427, at *5 (quoting *In re Country Oven, Inc.*, Ser. No. 87354443, 2019 WL 6170483, at *3 (TTAB 2019)). Opposer argues, 42 TTABVUE 48, that two registrations of the PANERA mark cover the following goods and services that are related to certain specific goods in Applicant's applications: (1) "coffee mugs and plastic drinking cups" and "restaurant and catering services," 29 TTABVUE 3-4 (Registration No. 2806259), and (2) "magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards that may be redeemed for or used towards the purchase of menu items," "downloadable mobile applications for ordering food," and "restaurant, cafe and catering services." *Id.* at 288-89 (Registration No. 4934852).⁴⁴

We must construe the goods and services identified in Opposer's two registrations "as broadly as reasonably possible 'to include all [goods and services] of the nature and type described therein,'" *OSF Healthcare*, 2023 WL 6140427, at *5 (quoting *In re*

⁴⁴ Opposer also argues relatedness as to certain goods for which the PANERA mark is not registered, including "dinnerware," "kitchen accessories," and "products unrelated to food, e.g., the BAGuette bag, pool floats, gift cards, and bikes." 42 TTABVUE 50.

Solid State Design, Inc., Ser. No. 87269041, 2018 WL 287909, at *6 (TTAB 2018)), and we “must resolve any ambiguities regarding their coverage in favor of [Opposer] ‘given the presumption afforded the registration[s] under Section 7(b)’ of the Trademark Act.” *Id.* (quoting *In re C.H. Hanson Co.*, Ser. No. 77983232, 2015 WL 6121759, at *5 (TTAB 2015) (citing 15 U.S.C. § 1057(b)).

Applicant’s two applications contain numerous goods, but Opposer argues relatedness as to only a handful. Opposer highlights those goods in its main brief as follows:

PANERALUX (App. No. 90165765) Class 9: data processing apparatus; **computer programs, recorded for use in database management, use in electronic storage of data**; couplers being data processing equipment; optical character readers; **integrated circuit cards used for smart cards**; humanoid robots with artificial intelligence; **Downloadable mobile phone application software for use in database management, use in electronic storage of data**; Smart glasses for data processing; pedometers; Face recognition equipment, namely, optical face scanners; weighing machines; measures, namely, tape measures; flashing safety lights used for luminous signals; signal lanterns, namely, optical signal lanterns; signals, luminous or mechanical, namely, luminous traffic signals; light-emitting electronic luminous pointers; anti-interference devices for electricity, namely, filters for radio interference suppression; smartphones; protective films adapted for smartphones; cabinets for loudspeakers; microphones; headphones; electronic book readers; cinematographic cameras; photography darkroom lamps; flashlights for use in photography; surveyors’ levels; speed checking apparatus for vehicles, namely, speed indicators for vehicles; hydrometers; teaching apparatus, namely, teaching robots; measuring devices, electric, namely, electric lasers for measuring; probes for scientific purposes; optical lamps; optical apparatus and instruments, namely, optical inspection apparatus; optical condensers; materials

for electricity mains, namely, electric cables and wires; semi-conductors; light-emitting diodes (LED); junction boxes for electricity; transformers for electricity; switches, electric; electric control panels; light dimmers used for regulators, electric; lighting ballasts; **remote control apparatus, namely, remote control transmitter for radio-controlled devices**; optical fibres being light conducting filaments; fire extinguishers; X-ray apparatus not for medical purposes; protection devices for personal use against accidents, namely, gloves for protection against accidents; clothing for protection against fire; theft prevention installations, electric, namely, theft alarms; smoke detectors; eyeglasses; battery chargers; batteries, electric; photographic slides; decorative magnets⁴⁵

PANERALUX (App. No. 90165881) Class 11: light bulbs; lamps; Lighting apparatus, namely, lighting installations; chandeliers; ceiling lights; laboratory lamps; safety lamps, namely, LED Safety lamps; luminous tubes for lighting; miners' lamps; electric lights for Christmas trees; luminous house numbers; searchlights; street lamps; aquarium lights; diving lights; light-emitting diodes (LED) lighting apparatus, namely, LED (light emitting diode) lighting fixtures; string lights for festive decoration; lights for vehicles; headlights for automobiles; automobile lights being lights for vehicles; lanterns for lighting; **cooking apparatus and installations, namely, cooking ranges; kettles, electric; freezers; refrigerators**; air purifying apparatus and machines; **extractor hoods for kitchens**; heating apparatus, namely, heating apparatus for vehicles; steam generating installations; heating installations; faucets; sanitary apparatus and installations, namely, urinals being sanitary fixtures; solar thermal collectors used for heating; disinfectant apparatus, namely, apparatus for disinfecting water; water purifying apparatus and machines; radiators, electric

42 TTABVUE 25-26 (emphasis supplied by Opposer).

⁴⁵ Although Opposer highlights the Class 9 goods identified as “remote control apparatus, namely, remote control transmitter for radio-controlled devices,” Opposer offers no argument elsewhere in its briefs that these goods are related to any of Opposer’s goods or services. *See* 42 TTABVUE 47-51.

The gist of Opposer's argument under the second *DuPont* factor is that "[s]ome of the proposed goods are either identical, adjacent, or closely related to Opposer's goods." *Id.* at 50. Opposer identifies and discusses those goods as follows:

PANERA Marks are registered in Class 9 for, among other things . . . "magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards," and a "downloadable mobile application for ordering food." . . . And Opposer operates a number of PANERA-formative websites. . . . Consequently, Opposer's . . . loyalty and gift cards, and mobile phone applications directly overlap with and/or are related to a number of Applicant's listed goods including (1) "computer programs, recorded for use in database management an electronic storage of data," (2) "Integrated circuit cards used for smart cards," (3) "Downloadable mobile phone application software for use in database management, use in electronic storage of data," and (4) "cooking apparatus and installations, namely, cooking ranges; freezers; refrigerators; extractor hoods for kitchens."

Id. at 48.

Opposer argues that "Applicant's goods could be viewed as originating from Opposer" because in "both applications, the Applicant filed for broad and/or kitchen-specific goods" and "Opposer offers many products and services beyond 'restaurant services.'" *Id.* at 50. Opposer claims that it "sells Panera-branded packaged goods through grocery stores and online retailers, offers a mobile app with of daily unique visitors, and even sells or offers merchandise including products primarily used in the kitchen (e.g., drinkware, dinnerware, and kitchen accessories) as well as products unrelated to food, e.g., the BAGuette bag, pool floats, gift cards, and bikes." *Id.* According to Opposer, "[m]any of these goods and services are listed in Opposer's pleaded registrations and are or have been available via Opposer's websites including

The Panera Shop,” *id.* at 50-51, and thus “Applicant’s broad and/or kitchen-specific goods in Class 11 (i.e., cooking apparatus and installations, namely cooking ranges; kettles, electric; freezers; refrigerators; extractor hoods for kitchens; and faucets)” and “broad and potentially overlapping other goods in Class 9 (e.g., ‘computer programs, recorded for use in database management an electronic storage of data,’ ‘Integrated circuit cards used for smart cards,’ and ‘Downloadable mobile phone application software for use in database management, use in electronic storage of data’) could be viewed by consumers as originating from Opposer.” *Id.* at 51.

Opposer concludes that “[a]s consumers could view Applicant’s goods as originating from Opposer’s famous PANERA brand (or at minimum view the goods and/or services as adjacent), especially given that the dominant elements of the marks are identical, this factor also weighs in Opposer’s favor.” *Id.*

Applicant responds that “Opposer only makes sweeping conclusory statements that the goods are overlapping and closely related as both parties provide cooking and kitchen-specific goods. However, Opposer’s broad categorization is the exact type general term that is insufficient for a finding of a likelihood of confusion.” 45 TTABVUE 38 (citation omitted). Applicant argues that

[a]s much as Opposer would love to stretch what are considered to be related goods, magnetically encoded loyalty and gift cards are not the same as computer programs for database management and storage of data. Opposer provides absolutely no explanation as to how its loyalty cards are in any way programs that manage data as opposed to just a scannable card usable in Opposer’s restaurants.

...

The same goes for the downloadable mobile applications. Opposer makes no attempt whatsoever to actually explain how the downloadable mobile applications are related. Applicant's is for database management and storage of data, while Opposer's is simply to order food. Simply being "downloadable mobile applications" is insufficient by itself to show a relatedness of the goods as there are mobile applications for a myriad of unrelated purposes.

Id. at 18-19.

According to Applicant, "[o]utside of coffee mugs and plastic drinking cups, Opposer's registrations do not identify any dinnerware or kitchen accessories" and "Opposer's claim of selling dinnerware and kitchen accessories should be summarily ignored, especially considering Opposer could not even be bothered to even attempt to name any specific products." *Id.* at 19-20. Applicant further argues that "Opposer utterly fails to provide any actual analysis as to why any of the goods would be considered related other than conclusively stating they are 'cooking and kitchen-specific goods.' Such a broad interpretation is simply not supported by the law." *Id.* at 20.

Finally, Applicant argues that as a factual matter

Opposer has provided no third-party registrations showing both Applicant's goods and Opposer's goods are provided under the same marks, no evidence that the goods are generally encountered by consumers together, no evidence from any news articles or computer databases showing the relevant goods are used together, and no evidence that there is any relation of the goods in the minds of the consuming public. There is nothing in the record that would establish any proper relation of the goods of the parties in this proceeding.

Id. at 22.

Opposer's two cited registrations of the PANERA mark cover the following goods and services that Opposer argues are related to the specific goods identified in Applicant's applications: (1) "coffee mugs and plastic drinking cups," "clothing, namely, caps, shirts, t-shirts, sweat shirts, and hats," and "restaurant and catering services," 29 TTABVUE 3-4 (Registration No. 2806259), and (2) "magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards that may be redeemed for or used towards the purchase of menu items," "downloadable mobile applications for ordering food," and "restaurant, cafe and catering services." *Id.* at 288-89 (Registration No. 4934852).

We begin with Opposer's restaurant services, which Opposer argues in passing are related to the "cooking apparatus and installations, namely, cooking ranges; freezers; refrigerators; extractor hoods for kitchens" identified in Applicant's Class 11 application. 42 TTABVUE 48. Opposer simply concludes, without citing any evidence or providing any explanation, that these goods "could be viewed as originating from Opposer." *Id.* at 51. It is self-evident that restaurants use "cooking apparatus and installations, namely, cooking ranges; freezers; refrigerators;" and "extractor hoods for kitchens" in the course of providing restaurant and catering services,⁴⁶ but that fact alone does not make those goods and restaurant services related. *In re St. Helena Hosp.*, 774 F.3d 747, 753 (Fed. Cir. 2014) ("the mere fact that goods and services are 'used together' does not, on its own, show relatedness") (citing *Shen Mfg. Co. v. Ritz*

⁴⁶ There is no evidence that these goods bear the same marks under which restaurant services are rendered, or are even visible to consumers of restaurant services when they are used.

Hotel, Ltd., 393 F.3d 1238, 1244 (Fed. Cir. 2004) (“[T]he test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue . . . can be related in the mind of the consuming public as to the origin of the goods” (internal quotation omitted)). We agree with Applicant that there is no evidence that Opposer “sell[s] any actual kitchen appliances” of the sort identified in Applicant’s Class 11 application, 45 TTABVue 19, and there is similarly no evidence that other restaurants sell these goods under the same marks under which they provide their restaurant services. There is also no evidence that Opposer or other restaurants sell (or even use) the Class 9 goods identified as (1) “computer programs, recorded for use in database management and electronic storage of data,” (2) “Integrated circuit cards used for smart cards,” or (3) “Downloadable mobile phone application software for use in database management, use in electronic storage of data.”

Where, as here, the relatedness of goods and services is “not evident, well-known or generally recognized,” “‘something more’ than the mere fact that the goods and services are ‘used together’” is required. *St. Helena Hosp.*, 774 F.3d at 753-54 (citing *Shen Mfg.*, 393 F.3d at 1244). *See also Coors*, 343 F.3d at 1345-46 (finding that the fact that “some restaurants sell private label beer” does not alone imply that consumers will assume that beer served in a restaurant has the same source of origin as the restaurant services).

On this record, we find that Opposer’s restaurant services, catering services, and bakery-cafe services are unrelated to any of the goods in Applicant’s two applications

under both the conventional standard for relatedness and the more exacting “something more” standard.

With respect to the relatedness of (1) the various goods for which Opposer has registered the PANERA mark or the goods that Opposer sells without the benefit of a registration, and (2) the Class 9 and Class 11 goods in the two applications, Opposer offers nothing more than conclusions, and argument of counsel, which is “no substitute for evidence.” *Iron Balls Int’l Ltd. v. Bull Creek Brewing, LLC*, Canc. No. 92079099, 2024 WL 2844425, at *26 (TTAB 2024) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (internal quotation omitted)).

As noted above, the language of the parties’ respective identifications of goods and services “may provide evidence of the relationship between the [goods and] services,” *Monster Energy*, 2023 WL 417620, at *7 (citation omitted), if, for example, the goods in one identification encompass, or are encompassed by, the goods in the other identification. Opposer refers to “broad, overlapping goods,” 42 TTABVUE 25, but makes no effort to explain why any of the goods identified in its registrations and in the two applications overlap or are otherwise related on the face of the language of the identifications when they are given their full scope. Opposer merely concludes that its “loyalty and gift cards, and mobile phone applications directly overlap with” the “computer programs, recorded for use in database management an [sic] electronic storage of data,” *id.*, “integrated circuit cards used for smart cards,” *id.*, “[d]ownloadable mobile phone application software for use in database management, use in electronic storage of data,” *id.* at 25-26, and “cooking apparatus and

installations, namely, cooking ranges; freezers; refrigerators;” and “extractor hoods for kitchens.” *Id.* at 26.

With respect to the respective “cards” identified in Opposer’s registration and in the Class 9 application, Opposer does not accurately describe its cards, which are not merely “loyalty and gift cards,” *id.* at 25, but rather “magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards **that may be redeemed for or used towards the purchase of menu items**” (emphasis added). There is nothing on the face of the goods identified in the Class 9 application as “integrated circuit cards used for smart cards” showing that “integrated circuits cards used for smart cards” “directly overlap with” “magnetically encoded loyalty cards, incentive cards, reward cards, and gift cards that may be redeemed for or used towards the purchase of menu items” when the respective identifications are given their full scopes. *Cf. OSF Healthcare*, 2023 WL 6140427, at *12 (criticizing the examining attorney for not focusing on the actual language of the involved identification of services, but instead broadening and generalizing it).

The “downloadable mobile applications **for ordering food**” identified in Opposer’s registration similarly do “directly overlap with” the “downloadable mobile phone application software **for use in database management, use in electronic storage of data**” identified in the Class 9 application when the respective identifications are given their full scopes because the respective apps have entirely different fields of use (emphasis added).

Finally, Opposer does not even try to explain how the goods identified in the Class 9 application as “computer programs, recorded for use in database management and electronic storage of data” “directly overlap” with any of the goods identified in Opposer’s registrations, which have nothing to do with either “database management” or the “electronic storage of data.”

We find that none of the goods identified in Opposer’s registrations overlap with any of the specified goods identified in Applicant’s applications by virtue of the language in the respective identifications when they are given their full scope.

As Opposer acknowledges, 42 TTABVUE 50, relatedness may also be shown by a variety of types of extrinsic evidence, including third-party registrations covering the involved goods and services, third-party websites offering the involved goods and services, and witness testimony, but the record is devoid of any such evidence of relatedness. We find that none of Opposer’s cited goods or services are related to any of the Class 9 and Class 11 goods specifically discussed by Opposer, or to any of the other identified goods. The second *DuPont* factor weighs heavily in favor of a conclusion that confusion is not likely with respect to both applications.

b. Similarity or Dissimilarity of the Channels of Trade

Opposer argues that “certain of the parties’ goods are identical, and the parties’ registrations and applications do not contain any limits regarding channels of trade or classes of purchasers.” 42 TTABVUE 51. According to Opposer, “at least as to those goods that directly overlap, the Board must presume the parties’ goods and services travel through [sic] same channels of trade to the same types of consumers.” *Id.* Opposer also argues that “both parties sell their goods and/or services directly to end

consumers,” *id.*, and that “Applicant’s goods are also available directly to consumers through Amazon and Applicant’s website” *Id.* at 52.

Opposer’s arguments are all meritless. We have found above that the involved goods and services are not similar, much less “identical,” and the presumption urged by Opposer applies “only if and to the extent the goods at issue are identical or, at a minimum, closely-related.” *DeVivo v. Ortiz*, Opp. No. 91242863, 2020 WL 1227592, at *14 (TTAB 2020) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)). The fact that both parties’ registrations contain no restrictions on classes of consumers, such that the goods and services could be sold to end users as well as others in the chain of distribution of the identified goods and services, does not establish that the classes of consumers are the same, because “end users” are not a distinct and identifiable class of consumers. Finally, the fact that the goods and services are offered through the Internet does not mean that the channels of trade overlap. *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 WL 16646840, at *24 (TTAB 2022) (“the mere fact that Applicant and Opposer have their own Internet websites advertising and offering their goods is not a sufficient basis to find overlapping trade channels”) (citing *Parfums de Coeur, Ltd. v. Lazarus*, Opp. No. 91161331, 2007 WL 683784, at *10 (TTAB 2007) (“the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade”); *Inter IKEA Sys.*, 2014 WL 1827031, at *10 (rejecting the opposer’s theory that “any goods or services sold through retail stores, catalogs or over the Internet move

through the same channels of trade and, therefore, for all intents and purposes, all goods and services potentially move through the same channels of trade”)).

Opposer did not show that the channels of trade for the involved goods and services overlap or are otherwise at all related, and the third *DuPont* factor weighs heavily in favor of a conclusion that confusion is not likely with respect to both applications.

4. Other *DuPont* Factors

As noted above, the parties discuss many other *DuPont* factors, which we discuss below to the extent that there is argument and evidence directed to them and they are applicable on the record here.

a. Consumer Sophistication and Degree of Purchasing Care

The fourth *DuPont* factor “concerns the ‘conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.’” *In re Samsung Display Co.*, Ser. No. 90502617, 2024 WL 3451873, at *7 (TTAB 2024) (quoting *DuPont*, 476 F.2d at 1361).

Opposer argues that “both parties’ products are relatively inexpensive” and “this *DuPont* factor weighs heavily in favor of Opposer.” 42 TTABVUE 52.⁴⁷ Applicant argues that its products are generally sold to “professionals, such as importers, wholesalers, engineers, and retailers,” 45 TTABVUE 40, although it concedes that “some end consumers may purchase goods” *Id.* Applicant also argues that its

⁴⁷ As noted above, under Opposer’s forward-confusion theory, we are concerned with the sophistication and purchasing habits of consumers of Applicant’s goods.

“products are not so inexpensive as to be purchased on impulse, as the goods are specialized goods rather than routine purchases.” *Id.* at 41. Applicant concludes that “[c]onsumers buying more expensive [sic] will take more care in their purchases, as will professionals such as importers, wholesalers, engineers, and retailers[.] Therefore, this factor also weighs in favor of Applicant.” *Id.*

The record is sparse with respect to evidence regarding the purchasing habits of consumers of the goods identified in the opposed applications. As noted above, the identifications of Applicant’s goods do not contain any class-of-consumer restrictions, so we must assume that the identified goods could be sold to end users as well as to others in the chain of distribution.

The Yang Declaration is silent regarding the prices of the goods identified in the applications and the purchasing habits of their consumers. It is self-evident from the nature of many, if not most, of the goods identified in the applications, such as the cooking apparatuses and installations, that such goods are major purchases that are likely to be relatively expensive and unlikely to be purchased on impulse, but there are other goods in the identifications, such as light bulbs, cables, and wires, that may include less expensive goods but still require purchaser attention to assure compatibility of use. *Cf. Sock It to Me, Inc. v. Fan*, Opp. No. 91230554, 2020 WL 3927605, at *10 (TTAB 2020) (unrestricted identification of “socks” includes goods that may be inexpensive and subject to impulse purchase).

Opposer has not shown that any of the goods identified in the two applications are likely to be purchased on impulse, while Applicant has not shown that all of the

identified goods are sold only to sophisticated purchasers or are purchased with a high degree of care. We find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion with respect to both applications.

b. Absence of Evidence of Actual Confusion

“Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of” the parties’ marks. *Keystone Consol. Indus.*, 2024 WL 3771168, at *25 (TTAB 2024).

The seventh and eighth *DuPont* factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *DuPont* factor, that there has been a significant opportunity for actual confusion to have occurred.

Id. (citations omitted). “Under the eighth *DuPont* factor, we ‘look at actual marketplace conditions, to the extent that there is evidence of such conditions of record.’” *Id.* (quoting *In re Guild Mortg. Co.*, Ser. No. 8670944, 2020 WL 1639916, at *8 (TTAB 2020)).

As discussed above, Applicant argues, and we have found, that Applicant’s goods and Opposer’s goods and services are unrelated and are not sold in overlapping or otherwise related channels of trade. As a result, there has not “been a significant opportunity for actual confusion to have occurred,” *id.*, and we find that the seventh and eighth *DuPont* factors are neutral in our analysis of the likelihood of confusion with respect to both applications.

c. The Ninth *DuPont* Factor

“The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used.” *DeVivo*, 2020 WL 1227592, at *16 (citing *DuPont*, 476 F.2d at 1361). “If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *Id.*

Opposer argues that “[i]t is indisputable that Opposer uses the PANERA Marks in connection with a myriad of restaurant and food services as well as packaged goods and branded merchandise.” 42 TTABVUE 53. Applicant responds that “Opposer is claiming a ‘myriad’ of goods and services, but fails to actually identify any actual variety in its goods and services beyond its food and restaurant related goods.” 45 TTABVUE 42.

As discussed above, the involved goods and services are unrelated, and Opposer has provided no or only minimal information about its sales of its various collateral goods. We find that the ninth *DuPont* factor is neutral in our analysis of the likelihood of confusion with respect to both applications. *See DeVivo* (plaintiff’s claimed uses of her mark on children’s books, T-shirts, tank tops, sweatshirts, hoodies, coffee mugs, stickers, postcards, greeting cards, tote bags and informational and educational services in the STEM fields “insufficient to persuade us that Opposer has used her mark on a variety of goods and that this *DuPont* factor favors a finding of likelihood of confusion”).

d. The Eleventh *DuPont* Factor

“The eleventh *DuPont* factor considers ‘the extent to which applicant has a right to exclude others from use of its mark on its goods.’” *Monster Energy*, 2023 WL 417620, at *20 (quoting *DuPont*, 476 F.2d at 1361). “The applicant’s right to exclude is a right appurtenant to the applicant’s trademark use.” *Id.* “In a likelihood of confusion determination, ‘applicant’s right to exclude’ considers applicant’s place in the market and any resulting consumer perception as defined by the applicant’s trademark use, insofar as that use is reflected in the mark and goods described in the application[s].” *Id.*

Opposer argues that “[t]here is no record evidence Applicant’s use of PANERALUX has reached ‘an appreciable level of consumer recognition’ such that it has the right to exclude others from using its mark.” 42 TTABVUE 53 (quoting *McDonald’s*, 2014 WL 5282256, at *17).

Applicant responds that it

has a right to protect its own mark for its own goods that it has registered in numerous other countries (New Zealand, Australia, Japan, the EU, China, Egypt, Iran, the UK, Singapore, the Philippines, Russia, Indonesia, Norway, Switzerland, Vietnam, Argentina, Malaysia, Brazil, and South Korea) and to protect its own “panera” brand that Applicant has been building without issue for nearly two decades and has been building in the United States without issue for over a decade. Applicant’s “Paneralux” marks are unique to Applicant and Applicant has a right to exclude others from using Applicant’s Marks in the United States for similar goods, particularly in the lighting industry.

45 TTABVUE 43.

Applicant's apparently unchallenged use of the PANERA mark in the United States, and its registrations of its PANERALUX mark in foreign countries, are not probative of Applicant's "place in the market and any resulting consumer perception as defined by the applicant's trademark use, insofar as that use is reflected in the [PANERALUX] mark and goods described in the application[s]." *Monster Energy*, 2023 WL 417620, at *20. We find that the eleventh *DuPont* factor is neutral in our analysis of the likelihood of confusion with respect to both applications.

5. Balancing the *DuPont* Factors

"The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there is evidence and argument; [and to] 'explain the results of that weighing,' and 'the weight [we] assigned to the relevant factors.'" *Heil Co.*, 2024 WL 4925901, at *37 (cleaned up) (quoting *In re Charger Ventures LLC*, 65 F.4th 1375, 1384 (Fed. Cir. 2023)). "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark[s]." *Id.* (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010)).

With respect to both applications, the first and fifth *DuPont* factors weigh heavily in favor of a conclusion of a likelihood of confusion, while the second and third *DuPont* factors weigh heavily in favor of the opposite conclusion. The other applicable *DuPont* factors for which there is evidence and argument are neutral with respect to both applications.

Under the fifth factor, we have found above that the PANERA mark is very strong commercially and conceptually for restaurant services, and such strength "plays a 'dominant' role in the *DuPont* analysis, as famous marks 'enjoy a wide latitude of

legal protection.” *Coach Servs.*, 668 F.3d at 1366-67 (quoting *Recot, Inc. v. M.C. Becton*, 213 F.3d 1322, 1327 (Fed. Cir. 2000)). At the same time, of course, “[i]t is well-established that fame is insufficient, standing alone, to establish likelihood of confusion.” *Id.* at 1367 (citing *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps.*, 703 F.2d 1372, 1374 (Fed. Cir. 1983) (“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.”) (internal quotations omitted)). “[F]ame alone cannot overwhelm the other *DuPont* factors as a matter of law.” *Id.* (quoting *Recot*, 214 F.3d at 1328).

As discussed above, Opposer failed to show that its restaurant services are related to the Class 9 and Class 11 goods in the two applications, and Opposer relied almost entirely on its use of its PANERA mark on collateral goods to show relatedness. We have found above that the PANERA mark does not enjoy “any notable commercial strength . . . in connection with these [goods].” *Monster Energy*, 2023 WL 417620, at *12. The strength of the PANERA mark for restaurant services thus plays less of a role in our overall *DuPont* analysis than it would in the case of goods or services that were not completely unrelated to restaurant services. *Cf. Monster Energy*, 2023 WL 417620, at *11 (fame of MONSTER ENERGY mark for energy drinks not probative of the likelihood of confusion with respect to restaurant services).

Under the first factor, the PANERA and PANERALUX marks are quite similar, and this *DuPont* factor weighs heavily in favor of a conclusion that confusion is likely, but it does not compel such a conclusion where other *DuPont* factors weigh heavily in

favor of the opposite conclusion. *See, e.g., Mini Melts, Inc. v. Reckitt Benckiser LLC*, Opp. No. 91173963, 2016 WL 3915987, at *16 (TTAB 2016) (finding that “[n]otwithstanding the virtual identity of the marks, the obvious and significant differences between ice cream and pharmaceutical products persuade us that confusion is unlikely to occur among consumers in the marketplace”). We give less weight to the close similarity of the marks here given the “obvious and significant differences” between Opposer’s goods and services and Applicant’s goods discussed in connection with our finding under the second *DuPont* factor that the involved goods and services are dissimilar.

“Any of the *DuPont* factors may play a dominant role,” *Heil Co.*, 2024 WL 4925901, at *38, and “even a single factor may be dispositive.” *Id.* On this record, the second and third *DuPont* factors outweigh the first and fifth factors. It is unlikely that consumers of the various Class 9 and Class 11 PANERALUX goods identified in the two applications will believe that those goods originate with, or are sponsored or authorized by, the owner of the PANERA mark for restaurant services and various collateral goods and services, because Applicant’s goods and channels of trade are simply too far afield from Opposer’s restaurant services and collateral goods and their channels of trade for confusion to be anything more than “a mere theoretical possibilit[y].” *Mini-Melts*, 2016 WL 3915987, at *16 (quoting *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992) (internal quotations omitted)). *See also M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1385 (Fed. Cir. 2006) (in dismissing an opposition, holding that the Board properly gave greater

weight to the dissimilarity of the goods and channels than to the similarity of the marks and the fanciful nature of the opposer's mark).

Because Opposer failed to show a likelihood of confusion with respect to the PANERALUX mark in either opposed application, it cannot prevail under Section 2(d), and that claim is dismissed with prejudice as to both applications.

VI. Opposer's False Suggestion of a Connection Claim

Opposer's final claim is under Section 2(a) of the Trademark Act, the pertinent portion of which "prohibits registration on either the Principal or Supplemental Register of 'matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols.'" *In re Leathernecks Motorcycle Club Int'l, Inc.*, Ser. No. 90498154, 2024 WL 2863442, at *1 (TTAB 2024) (quoting 15 U.S.C. § 1052(a)).

A false suggestion of a connection has been established when four elements are proved:

1. Applicant's mark is the same or a close approximation of Opposer's name or identity;
2. The mark would be recognized as such, in that it points uniquely and unmistakably to Opposer;
3. Opposer is not connected with the goods sold by Applicant; and
4. Opposer is of sufficient fame or reputation that, when Applicant's mark is used in connection with its goods, a connection with Opposer would be presumed.

Mystery Ranch, Ltd. v. Terminal Moraine Inc., Opp. No. 91250565, 2022 WL 17369425, at *10 (TTAB 2022).⁴⁸ Failure to prove any one of these elements is fatal to the claim. *Id.* at *14.⁴⁹

Opposer argues in its main brief that it “meets the first element given that the PANERALUX Marks are a close approximation of the PANERA mark as they are identical with the exception of the descriptive -LUX suffix.” 42 TTABVue 54.⁵⁰ With respect to the second element, Opposer argues that “the PANERALUX Marks would be viewed as pointing uniquely and unmistakably [sic] to Opposer” because “the PANERA brand is famous with almost thirty years of use, numerous awards and recognitions, unsolicited media coverage from numerous well-known national publications, many longstanding registrations consisting [of] or containing PANERA” and “Opposer’s broad geographic reach, and, most significant, survey evidence indicating 91.3% public recognition.” *Id.* With respect to the fourth element, Opposer argues that “there is ample evidence that the PANERA Marks are famous, including Opposer’s survey” and that “[i]n light of the extremely high recognition of the PANERA Marks, a connection between the parties will be presumed when

⁴⁸ As discussed above, Applicant’s applications contain numerous goods in Classes 9 and 11. A “false suggestion of a connection may be found as to an entire class on the basis of any one item listed in the identification of goods in that class.” *In re Int’l Watchman, Inc.*, Ser. No. 87302907, 2021 WL 5755146, at *10 (TTAB 2021) (citing *Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1380 (Fed. Cir. 2021)).

⁴⁹ For purposes of the third element, there is no dispute that Opposer is not connected to Applicant’s goods.

⁵⁰ Opposer does not address its Section 2(a) claim in its reply brief.

PANERALUX is used with Applicant's goods, particularly Applicant's cooking and kitchen-specific products." *Id.* at 56.⁵¹

Applicant first argues that "Opposer makes no attempt whatsoever to explain any connection to Opposer's **name or identity**," which is "Pumpernickel Associates, LLC, which has absolutely no connection to Applicant's Marks." 45 TTABVUE 44 (emphasis in bold here in italics in Applicant's brief). According to Applicant, "[w]hile 'Panera' and 'Panera Bread' are marks that Opposer uses, Opposer makes no effort to argue that 'Panera' is Opposer's **identity**." *Id.* at 44-45 (emphasis in bold here in italics in Applicant's brief).

Applicant further argues that its mark is not the same as or a close approximation of the PANERA mark, that Opposer fails to carry its burden of proving that PANERALUX points uniquely and unmistakably to Opposer, and that "[t]here is absolutely no evidence, and the survey completely and utterly fails to provide any substantiation, that Applicant's use of Applicant's Marks on Applicant's goods has any relation to Opposer in the mind of consumers." *Id.* at 45-46.

As noted above, Opposer's false suggestion of a connection claim must be dismissed if Opposer cannot establish all four of the required elements. We need not address the first and second elements of Opposer's claim because we find below that Opposer has failed to establish the fourth element, namely, that Opposer is of

⁵¹ Much of Opposer's argument conflates its Section 2(a) claim with its Section 2(d) claim. "While there may be some analogy between these statutory provisions, our primary reviewing Court has held that, '[c]learly the same standard cannot be adopted for §2(a) as for §2(d).'" *Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, Opp. No.91224343, 2019 WL 3834985, at *9 (TTAB 2019) (quoting *Univ. of Notre Dame*, 703 F.2d at 1376).

sufficient fame or reputation that when “Applicant’s mark is used in connection with its [Class 9 and Class 11 goods], a connection with Opposer would be presumed.” *Mystery Ranch*, 2022 WL 17369425, at *10, 16 (unnecessary to address all elements of a Section 2(a) false suggestion of a connection claim where one element was not established). *See also Leathernecks Motorcycle Club*, 2024 WL 2863442, at *8 (“The test is whether the USMC’s fame and reputation is of such a nature that a connection with the USMC would be presumed in the context of indicating membership in a motorcycle club bearing the name ‘Leathernecks.’”).

“[T]he Board has made it clear that in assessing the ‘fame or reputation’ factor, it is relevant whether the goods or services provided under the [involved] mark are similar to goods or services associated with the party complaining of a false association.” *Piano Factory*, 11 F.4th at 1380 (citing, inter alia, *Hornby v. TJX Cos.*, Canc. No. 92044369, 2008 WL 1808555, at *14-15 (TTAB 2008); *In re White*, Ser. No. 78146926, 2006 WL 2049628, at *8-9 (TTAB 2006)).⁵² “To be sure, a false association claim does not require proof that a prior user’s reputation is closely related to an applicant’s goods.” *Id.* (quotation and quotation marks omitted). “Nonetheless, as the Board has made clear, similarity between the goods or services offered under the [involved] mark and the goods or services offered by the party challenging . . . registration can be highly relevant to a false association claim.” *Id.*

A related principle is that a party’s name may be famous among the particular consumers of those goods and services even if it is not famous among members of the

⁵² In *Piano Factory*, the Federal Circuit used the term “false association” to refer to a Section 2(a) false suggestion of a connection claim. *Piano Factory*, 11 F.4th at 1369.

general public. And a party's name may be associated with particular goods such that a false association may be established with goods or services of that type even if it would not have been established with respect to entirely different goods or services.

Id. (citation omitted).

In affirming the Board's decision in *Piano Factory* that the cancellation petitioner, the producer of SCHIEDMAYER-labelled pianos, had proved its Section 2(a) claim against the respondent, the owner of a registration of SCHIEDMAYER for celestas, which are "keyboard instruments that resemble small pianos and are played like pianos," *id.* at 1367, the Federal Circuit noted that the Board had found that "celestas are close cousins of pianos" and that "[i]n light of the similarity between pianos and celestas, the Board found that persons seeing the Schiedmayer name on pianos would likely conclude that the pianos were made by or associated with the Schiedmayer companies in general and [petitioner] Schiedmayer Celesta in particular." *Id.* at 1379. The Federal Circuit held that given the close similarity of pianos and celestas as types of keyboards, it was "reasonable for the Board to consider the issue of the appellee's fame and reputation from the perspective of purchasers of keyboard musical instruments, who would be more likely than the general public to associate Schiedmayer-labelled pianos with the appellee." *Id.* at 1380.

Here, in assessing "whether the goods . . . provided under the [PANERALUX] mark are similar to [the] goods or services associated with [Opposer,] the party complaining of a false association," *id.*, we find that the involved goods and services are entirely dissimilar for the reasons discussed above in our analysis of the second *DuPont* factor on Opposer's Section 2(d) claim. While Opposer proved that its

PANERA mark is very strong in connection with restaurant services, we find that Opposer is not of sufficient fame that consumers of any of the entirely dissimilar Class 9 and Class 11 goods identified in the two applications would presume a connection with Opposer when they view the PANERALUX mark used for those goods. *Cf. Leathernecks Motorcycle Club*, 2024 WL 2863442, at *8-9 (finding that the collective membership mark LEATHERNECKS used to indicate membership in a motorcycle club falsely suggested a connection with the United States Marine Corp because the nearly 250 year old-Corps was of sufficient fame or reputation that “the relevant public would mistakenly believe Applicant has a connection with the USMC should the [LEATHERNECKS] mark be used to indicate membership in a motorcycle club, especially one whose entire present membership are active duty or honorably discharged U.S. Marines or U.S. Navy Corpsman who have served with the Fleet Marine Force”); *Int’l Watchman*, 2021 WL 5755146, at *12 (finding that the mark NATO for “tents” and other goods falsely suggested a connection with the North Atlantic Treaty Organization where “the applicant’s tents identified in Class 22 are the type of items consumers would associate with the military” and “NATO is a military alliance with active duty soldiers” such that “consumers would associate such goods with NATO.”).

Because Opposer failed to prove the required fourth element of its Section 2(a) false suggestion of a connection claim, Opposer cannot succeed on that claim, which is dismissed with prejudice with respect to both applications.

Decision: The opposition is dismissed with respect to all of Opposer's claims for relief against both of the opposed applications.