

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Fiji Water Company Pte. Ltd.
v.
Hitesh Patel
—

Opposition No. 91280233
—

Michael M. Vasseghi and Danielle M. Criona of The Wonderful Company LLC,
for Fiji Water Company Pte. Ltd.

Gene Bolmarcich of Law Offices of Gene Bolmarcich,
for Hitesh Patel.

—
Before Thurmon, Allard, and Brock,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Hitesh Patel (“Applicant”) seeks registration on the Principal Register of the
mark:



(FIJIAN SPICE COMPANY disclaimed) for “Spices; Turmeric for food; Edible turmeric,” in International Class 30.¹ The mark is described as “consist[ing] of the wording ‘FIJIAN SPICE COMPANY’ in orange below a geometric design with triangles, squares and bars in orange and reminiscent of a tiki design.”

Fiji Water Company Pte. Ltd. (“Opposer”) filed a Notice of Opposition alleging likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052 (d),² based on its registered marks:

- FIJI (in typeset form; acquired distinctiveness claimed in whole) for “natural, spring and artesian water for drinking,” in International Class 32;³ and



- (acquired distinctiveness claimed in whole) for “Drinking Water; Natural Artesian Water,” in International Class 32.⁴

¹ Application Serial No. 90763462 was filed on June 9, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce. Color is claimed as a feature of the mark.

² 1 TTABVUE 6-7, paras. 15-18.

Opposer also claimed dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). 1 TTABVUE 7-8. Because Opposer did not pursue this claim in its brief, it is therefore forfeited. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, Can. No. 92050879, 2013 TTAB LEXIS 347, at *6 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

Citations to the briefs refer to the Board’s online database, TTABVUE. Before the TTABVUE designation is the docket entry number, and after this designation are the page references, if applicable.

³ Registration No. 2703620, issued on April 8, 2003; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” or “typeset” drawings. *See In re Viterro Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012) (“[U]ntil 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”). A typed or typeset mark is the legal equivalent of a standard character mark. TRADEMARK MANUEL OF EXAMINING PROCEDURE (TMEP) § 807.03(i) (2024).

⁴ Registration No. 3282520, issued on August 21, 2007; renewed.

In its Answer, Applicant admitted that “to the extent these facts are correct as reflected in the records of the USPTO,” Opposer is the owner of its pleaded registrations and that its registrations are valid and subsisting.⁵ Applicant otherwise denied the salient allegations of the Notice of Opposition.⁶

Only Opposer filed evidence and a trial brief. Applicant did not take testimony or introduce any evidence during its testimony period or file a trial brief, but it is not required to do so. *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 TTAB LEXIS 383, at *5 (TTAB 2022). The onus is on Opposer, as the party in the position of plaintiff, to prove its case by a preponderance of the evidence. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 144 (2015) (“The party opposing registration bears the burden of proof, see [37 C.F.R.] § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b).”). Opposer has not carried its burden, and we dismiss the opposition.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file history of Applicant’s involved application.

Additionally, Opposer introduced the following evidence:

- Affidavit of Clarence Chia, Senior Vice President of Marketing, eCommerce and Direct to Consumer for Fiji Water Company LLC (“FIJI Water”), Opposer’s licensee, and related exhibits (“Chia Aff.”).⁷

⁵ 4 TTABVUE 2, para. 2; 1 TTABVUE 4, para. 2.

⁶ 4 TTABVUE.

⁷ 11 TTABVUE (confidential)/13 TTABVUE (public).

- Amended Notice of Reliance on TSDR printouts of Opposer’s pleaded registrations.⁸

As mentioned earlier, Applicant did not make any evidence of record. This does not result in a concession of the case, however, as Applicant, the defendant in the proceeding, is not required to take testimony or introduce evidence. *See Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, Can. No. 92056548, 2018 TTAB LEXIS 168, at *12 n.13 (TTAB 2018) (“Because Respondent, as defendant herein, is under no obligation to submit evidence or a brief, we do not construe Respondent’s failure to do so as a concession of the case.”); *see also* TRADEMARK MANUAL OF BOARD PROCEDURE (TBMP) § 801.02(b) (2024) and cases cited therein.

II. Entitlement to a Statutory Cause of Action

Entitlement is an element of the plaintiff’s case in every inter partes proceeding. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303-08 (Fed. Cir. 2020).

⁸ 14 TTABVUE.

Here, Opposer properly made of record TSDR printouts of its pleaded registrations by submitting them under a Notice of Reliance.⁹ “The pleaded registrations establish Opposer’s direct commercial interest in the proceeding that entitles it to bring a statutory cause of action, namely, to oppose registration of Applicant’s mark on the ground of priority and likelihood of confusion.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *15 (TTAB 2023) (valid and subsisting pleaded registration made of record establishes entitlement to oppose) (citing *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161 (Fed. Cir. 2002) (“In most settings, a direct commercial interest satisfies the ‘real interest’ test.”) and *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...direct commercial interest”)). Thus we find that Opposer has established its entitlement to bring a statutory action.

III. Priority and Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent or Trademark Office 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[.]” In order to prevail on its Section 2(d) claim, therefore, Opposer must establish both priority and likelihood of confusion. *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *27 (TTAB 2020). We consider each element of this claim, priority and likelihood of confusion, in turn below.

⁹ 14 TTABVUE.

A. Priority

Because Opposer's pleaded registrations are properly of record and because Applicant did not counterclaim to cancel either of them, priority is not at issue with respect to the registered marks and the goods identified in them. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402 (CCPA 1974).

B. Likelihood of Confusion

Having established priority, the remaining issue is likelihood of confusion. Our analysis is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"); *see also In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., Guild Mortg.*, 912 F.3d at 1379-81. Varying weight may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1354-55 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) ("[T]he various evidentiary factors may play more or less weighty roles in any particular determination."). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07 (Fed. 1997)).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See, e.g., In re*

Chatam Int'l Inc., 380 F.3d 1340, 1341-42 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer addresses the first, third, fourth and fifth *DuPont* factors, and also mentions the second factor briefly.¹⁰

Opposer pleaded ownership of two registrations. However, we focus our analysis on Opposer’s registered FIJI mark in standard character format for “natural, spring and artesian water for drinking” (Reg. No. 2703620). We consider this mark to be the more pertinent of Opposer’s pleaded registrations for our *DuPont* analysis because it is in standard characters and therefore must be considered “regardless of font style, size, or color[.]” *Citigroup*, 637 F.3d at 1353. If we do not find a likelihood of confusion with respect to this mark and its identified goods,¹¹ then there would be no likelihood of confusion with the stylized mark and goods of Opposer’s other registration. *See In re Max Cap. Grp. Ltd.*, Ser. No. 77186166, 2010 TTAB LEXIS 1, at *19-20 (TTAB 2010).

1. Strength or Weakness of Opposer’s Mark

We now consider the strength of Opposer’s FIJI mark in order to evaluate the scope of protection to which it is entitled. *DuPont*, 476 F.2d at 1361. In determining the strength of a mark, we consider both its inherent strength, based on the nature

¹⁰ 15 TTABVUE 4, 15-25.

¹¹ The two registrations identify essentially the same goods.

of the mark itself, and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength)). “[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003); *see also Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017) (per curiam).

Opposer argues that its mark is “highly distinctive” and “famous.”¹²

a. Conceptual Strength

Conceptual strength is a measure of a mark’s distinctiveness and may be placed “in categories of generally increasing distinctiveness . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015). Conceptual strength “focuses on the inherent potential of the term at the time of its first use.” *Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, Opp. No. 91247034, 2023 TTAB LEXIS 223, at *28 (TTAB 2023) (quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2023 Update)).

¹² 15 TTABVUE 8, 9, 16-19.

Opposer's FIJI mark is registered on the Principal Register based on a claim acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).¹³ Accordingly, the mark is not inherently distinctive. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577 (Fed. Cir. 1988); *see also Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1359 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."). Also we take judicial notice of the dictionary definition of FIJI, which is defined in the MERRIAM-WEBSTER DICTIONARY under the category "geographical name" as "islands in the southwestern Pacific east of Vanuatu constituting (with Rotuma Island) an independent dominion of the Commonwealth of Nations[.]"¹⁴ We find, therefore, that FIJI is geographically descriptive of certain islands in the South Pacific Ocean and conclude that the FIJI mark is conceptually weak. *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, Opp. No. 91223982, 2020 TTAB LEXIS 269, at *53 (TTAB 2020) ("[W]e find that Plaintiff's BROOKLYN BREWERY and BROOKLYN marks are inherently weak.").

¹³ 14 TTABVUE 5-9.

¹⁴ MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/Fiji>, accessed on October 8, 2024. *Shenzhen IVPS Tech.*, 2022 TTAB LEXIS 383, at *41 (the Board may take judicial notice of dictionary definitions).

b. Market Strength or Fame of Opposer's Mark

Opposer argues that its pleaded mark is famous.¹⁵ Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. *Joseph Phelps Vineyards*, 857 F.3d at 1324-25. “While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1375 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003)). Famous marks “enjoy wide latitude of legal protection.” *Id.* at 1374. Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.*

Market strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 1319-22 (Fed. Cir. 2018); *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (“[O]ur cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”).

¹⁵ 15 TTABVue 8, 9, 16-19.

Raw numbers alone, however, may be misleading. Thus, some context in which to place raw statistics may be necessary, for example, suitable context includes information about market share or sales or advertising figures for comparable types of goods. *Bose*, 293 F.3d at 1375. Other ways Opposer can place its raw financial data in context include evidence of the general reputation of the identified goods sold under the pleaded mark, or other contextual evidence of the type of advertisements and promotions Opposer uses to gain sales to show that the consuming public has been regularly exposed to Opposer's marks on a nationwide scale. *See, e.g., Omaha Steaks*, 908 F.3d at 1320 ("Market share is but one way of contextualizing ad expenditures or sales figures.").

Opposer argues that "FIJI is a famous brand, and thus enjoys a long latitude of protection."¹⁶ In support of its claim that its FIJI mark is famous, Opposer made of record evidence that it has sold its FIJI water in the United States for over 18 years and that, during this time, it "has sold over 206 million cases of FIJI brand water,"¹⁷ which equates to 3.5 billion individual bottles of water.¹⁸

Opposer, through its licensee FIJI Water, has extensively advertised and marketed its water offered under the pleaded mark.¹⁹ Although the exact amounts are filed under seal, Mr. Chia testified as to the total expenditures in the US since

¹⁶ 15 TTABVUE 8 (quotation omitted).

¹⁷ 13 TTABVUE 10 (Chia Aff., para. 26 and Exhibit D).

¹⁸ 15 TTABVUE 15; 11 TTABVUE 10 (Chia Aff., para. 26 and Exhibit D). Because Opposer specifies the number of individual bottles in its brief, we disclose it here too, even though this number is redacted in Mr. Chia's public affidavit. 13 TTABVUE 10 (Chia Aff., para. 26).

¹⁹ 13 TTABVUE 2, 3 (Chia Aff., paras. 3-4, 10).

2005, an amount that we find to be substantial, and he provided a breakdown of the annual advertising expenditures in the United States since 2018.²⁰ Although financial data about competitors is difficult to obtain, Mr. Chia testified, without explanation, as to advertising amounts by one competitor, EVIAN water, and Opposer's advertising expenditures are substantially higher.²¹

In 2015 FIJI Water launched its multi-million dollar "Untouched" television marketing campaign, which still runs today.²² Mr. Chia testified to the dollar amount of this campaign, which again is confidential, and which again we find to be substantial.²³ The campaign consists of "numerous, 15-second spots," all of which tell the story of the brand, the most recent version of which was released in 2020.²⁴ These spots have run on many television networks, including ABC, ABC Family, AMC, Bravo, CBS, Comedy Central, E!, ESPN, Food Network, and NBC to name a few and they have run during programs such as *The Bachelorette*, *Jimmy Kimmel Live*, *The Late Late Show*, *The Daily Show*, and *American Idol*.²⁵ Opposer does not provide any other details about the Untouched campaign, such as how frequently each ad ran during a particular program, or how many viewers are likely to have seen each of them, given that some programs, such as *The Late Late Show*, while offered

²⁰ 11 TTABVUE 11, 99-100 (Chia Aff., para. 34 and Exhibit F).

²¹ *Id.* at 12 (Chia Aff., para. 37).

²² 13 TTABVUE 11-12 (Chia Aff., para. 35).

²³ 11 TTABVUE 11-12 (Chia Aff., para. 35).

²⁴ 13 TTABVUE 11-12 (Chia Aff., para. 35).

²⁵ *Id.* at 12 (Chia Aff., para. 36).

nationwide, are aired late at night and not during prime viewing hours. While we acknowledge the high cost of this campaign, and its widespread distribution via network television, the record does not contain any other contextual information about it, so we are not able to assess, for example, how many consumers were exposed to these advertising spots since the campaign's launch. *See e.g., Omaha Steaks*, 908 F.3d at 1320 (“For example, ‘a 30-second spot commercial shown during a Super Bowl football game may cost a vast sum, but the expenditure may have little if any impact on how the public reacts to the commercial message.’” (quoting *Bose*, 293 F.3d at 1375)). Nonetheless, we acknowledge the campaign's long and widespread use.

Additionally, Mr. Chia testified that the pleaded mark is advertised online, in print and on billboards, some samples of which are of record, including evidence of advertising on New York City's Times Square billboard in 2019.²⁶ Turning to social media advertising, the FIJI mark is advertised on Facebook, Instagram, and X (formerly Twitter), and the brand's Facebook page has recorded almost seven hundred thousand “likes.”²⁷ Brand influencers, who have between 36,000 and 2,500,000 followers, are also used to promote the FIJI mark on social media, and several examples of influencer posts are attached to Mr. Chia's affidavit.²⁸ However, there are no other details about any of this advertising activity. For example, Opposer does not indicate how many consumers have been exposed to its print, billboard and

²⁶ *Id.* at 3, 15-35 (Chia Aff., para. 12 and Exhibit A).

²⁷ *Id.* at 3, 41-45 (Chia Aff., para. 13 and Exhibit C).

²⁸ *Id.* at 3, 37-39 (Chia Aff., para. 13 and Exhibit B).

online advertising, nor does Opposer specify the number of posts featuring FIJI water made by each influencer, so we cannot gauge the amount of exposure that the brand received through these efforts.

The record shows that FIJI water has been the official water at many high profile events. For example, “FIJI brand water was the official water of the Film Independent Spirit Awards from 2013-2023, the Screen Actor Guild Awards from 2010-2022, the Critic’s Choice Awards from 2015-2023, the 70th Annual Tony Awards and Creative Art Awards in 2016, the Recording Academy GRAMMY Awards in 2017 & 2022–2023, the Emmy Awards Red Carpet and Governors Ball from 2014-2023, and the Annual Golden Globe Awards from 2015-2019.”²⁹ While we acknowledge that these are star-studded events with national media exposure, there is no evidence, for example, of the scope of publicity that the pleaded mark received by virtue of its being the official water for these events, so we cannot determine with certainty the scope of public exposure to the brand. Nonetheless, we infer due to the high-profile nature of the events, and without evidence to the contrary, that such exposure would have been significant.

To establish and maintain in the mind of consumers that FIJI brand water is a status product, Mr. Chia testified that Opposer focuses on strategic placement of FIJI water in select television shows and motion pictures.³⁰ To that end, FIJI brand water has been the subject of product placement in many television shows, including CSI

²⁹ *Id.* at 7 (Chia Aff., para. 17).

³⁰ *Id.* at 8 (Chia Aff., para. 20).

New York, Will & Grace, The Apprentice, Two and a Half Men, Keeping up with the Kardashians, House of Cards, Dancing with the Stars, The Office, 90210, Veep, Gilmore Girls, Curb Your Enthusiasm, and Friends: The Reunion.³¹ As for motion pictures, FIJI water was placed in, for example, Ocean's 8, What Men Want, and Selena Gomez: My Mind and Me.³² While we acknowledge that these shows are generally popular and widely available on network television and/or on popular streaming services, such as Netflix, Opposer provided no other information about the product placement. For example, the record does not disclose the number of episodes of Will & Grace that the FIJI water appeared in or how many consumers viewed that episode or even how many average viewers watch the program; consequently, we are hard-pressed in turn to assess with any amount of certainty the consumer exposure to the mark through these product placements.

For unsolicited media coverage, Opposer points to print media, the bulk of which generally consist of photographs of celebrities merely holding a FIJI water bottle and/or articles mentioning celebrities storing FIJI water in their refrigerator; while these photos and related articles do not describe the general reputation of the mark and the identified goods, they do serve to reinforce FIJI water as a status product.³³ There are, however, three articles that generally address the reputation of the goods: (1) an InTouch "Hot Stuff!" article, dated July 2, 2018, featuring FIJI water and the

³¹ *Id.* at 8-9 (Chia Aff., para. 21).

³² *Id.* at 9 (Chia Aff., para. 22).

³³ *Id.* at 10, 49-97 (Chia Aff., para. 29 and Exhibit E).

bottle's new flip-top sports cap;³⁴ (2) a Yahoo! Lifestyle article, dated October 16, 2019, summarizing the results of a taste-test of ten bottled-water brands, where FIJI ranked second;³⁵ and (3) a mention in New York Magazine, dated June 30, 2020, describing the appealing taste of FIJI water.³⁶

The record also contains evidence that FIJI water is part of pop culture. For example, in September 2018, hip-hop artist and fashion designer, Kanye West, was the musical guest on "Saturday Night Live."³⁷ Rapper Lil Pump performed with him while wearing a FIJI water bottle costume.³⁸ A photograph of Mr. West's daughter wearing the FIJI water bottle costume later appeared in People magazine.³⁹

Additionally, Mr. Chia testified that FIJI Water "has sponsored or been affiliated with numerous events throughout the United States[,]” and he lists many events, without description, that appear to involve the film industry, the music and arts industry, and the fashion industry.⁴⁰ While FIJI Water was involved with some events for only one or two years, other events enjoyed a longer term involvement, some of which we list here: The Gotham Independent Film Awards, New York, from 2012–2023; Film Independent Spirit Awards from 2012–2023; Screen Actor Guild Awards from 2012–2022; Critic's Choice Movie Awards, Los Angeles, from 2015–

³⁴ *Id.* at 60.

³⁵ *Id.* at 87-88.

³⁶ *Id.* at 90.

³⁷ *Id.* at 9-10 (Chia Aff., para. 24).

³⁸ *Id.*

³⁹ *Id.* at 65.

⁴⁰ *Id.* at 4-7 (Chia Aff., para. 16).

2023; Emmy Awards Red Carpet and Governors Ball, Los Angeles, from 2015–2022; and Recording Academy Annual Grammy Awards in 2016 & 2022-2023.⁴¹ Again, we acknowledge the high-profile nature of these events, but again Mr. Chia’s testimony lacks any detail as to the visibility of the FIJI mark at these events and he fails to testify as to the number of people who were likely exposed to the mark by, for example, advertising or promotional efforts at the event itself or via subsequent media coverage of the events, and/or if water bottles bearing the mark were distributed to attendees. To the extent that Mr. Chia testified that FIJI Water “sponsored” the event, we can infer that the mark was advertised and promoted in some meaningful way due to the nature of the event itself; however, it is unclear what meaningful exposure attendees may have had to the pleaded mark to the extent that FIJI Water was merely “affiliated with” the event. As Mr. Chia does not distinguish between events FIJI Water “sponsored” as opposed to those it was “affiliated with,” this portion of his testimony is not as probative as it could be on the issue of fame of the pleaded mark.

As for awards, Opposer’s FIJI water has won several, some of which are set out in Mr. Chia’s testimony.⁴² Additionally, Mr. Chia testified that in 2023, FIJI water was “ranked America’s favorite bottled water among adults, per a study conducted by third-party Morning Consult.”⁴³

⁴¹ *Id.*

⁴² *Id.* at 10 (Chia Aff., paras. 27-28).

⁴³ *Id.* (Chia Aff., para. 27).

c. Summary

Although there are some shortcomings in the evidence of the commercial strength or fame of the FIJI mark, as addressed above, we accept Mr. Chia's un rebutted affidavit and related exhibits as evidence that Opposer's mark has been in long use and heavily promoted and, we find the evidence sufficient to show that the FIJI mark falls on the very strong side of the spectrum from very strong to very weak. *See e.g., Joseph Phelps Vineyards*, 857 F.3d at 1325.

Despite any inherent or conceptual weakness of the term FIJI because it may be considered geographically descriptive and therefore registered under the provisions of Section 2(f), the evidence shows the FIJI mark to be very commercially strong for bottled water. On balance, the evidence regarding the commercial strength of the FIJI term with the identified goods overcomes the mark's intrinsic shortcoming. As a result, we find that Opposer's mark is entitled to a broad scope of protection.

This weighs heavily in favor of likelihood of confusion.

2. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor, which assesses the similarity or dissimilarity of the marks. *DuPont*, 476 F.2d at 1361. We analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Viterra*, 671 F.3d at 1362 (quoting *DuPont*, 476 F.2d at 1361). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *4 (TTAB 2014)).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)). When assessing the similarity of the marks, we keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (quoting *Coors Brewing*, 343 F.3d at 1344).

As a reminder, Opposer’s mark is FIJI in standard characters and Applicant’s



mark is the composite mark (FIJIAN SPICE COMPANY disclaimed).

Considering Opposer’s mark, it consists solely of the geographically descriptive word FIJI. The sole point of overlap in the marks is the geographically descriptive term FIJI(IAN).

Turning to Applicant’s mark, all three literal elements have been disclaimed. Because the disclaimer was entered via examiner’s amendment without issuance of an Office Action,⁴⁴ the record does not include an explanation for the disclaimer; however, the disclaimer of the term FIJIAN suggests that the term is geographically descriptive of the goods and that the goods will emanate from Fiji. Adjectival forms

⁴⁴ March 1, 2022 Examiner’s Amendment.

of geographic terms, here, FIJIAN, are considered primarily geographically descriptive. *See e.g., In re Jack's Hi-Grade Foods, Inc.*, Ser. No. 333701, 1985 TTAB LEXIS 60, at *3 (TTAB 1985) (holding NEAPOLITAN primarily geographically deceptively misdescriptive of sausage emanating from the United States, where the term is defined as “of or pertaining to Naples in Italy”); *see also* TMEP § 1210.02(a) and cases cited therein.

Opposer argues that FIJIAN is the dominant portion of Applicant's mark because it is the first literal element of the mark and that it is more source-identifying than the other literal elements SPICE COMPANY, which are disclaimed because they are either descriptive or generic when considered in light of Applicant's identified goods, i.e., spices.⁴⁵ We agree with Opposer on the general principal that when a mark comprises both a word and a design, the literal elements are normally accorded greater weight because they would be used by purchasers to request the goods or services. *See Viterra*, 671 F.3d at 1362 (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.’” (*quoting CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82 (Fed. Cir 1983))). However, that is not always the case. *See e.g., In re Covalinski*, Ser. No. 85685983, 2014 TTAB LEXIS 353, at *8-10 (TTAB 2014) (design predominant in word and design mark) (citing *Parfums de Coeur Ltd v. Lazarus*, Opp. No. 91161331, 2007 TTAB LEXIS 36, at *10-17 (TTAB 2007) and *Ferro Corp. v. Ronco Labs, Inc.*, 356 F.2d 122, 124 (CCPA 1966)).

⁴⁵ 15 TTABVUE 19-21.

Here, we find that the dominant element of Applicant’s mark is the FIJIAN term, since it appears first, but, mindful that descriptive and disclaimed terms generally have less significance in likelihood of confusion determinations, we also find that Applicant’s distinctive design has equal importance to the wording due to its sheer comparative size and its location at the top of the mark. *See e.g., Cunningham*, 222 F.3d at 947 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’” (*quoting In re Nat’l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985))); *Dixie Rests.*, 105 F.3d at 1407 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, Ser. No. 75645560, 2001 TTAB LEXIS 685, at *12 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

The point of similarity between the literal elements of Opposer’s FIJI mark and



Applicant’s mark is the descriptive term FIJI and its variation, i.e., FIJIAN. The marks sound similar to the extent that they both include the “Fiji” portion when pronounced. Visually, Applicant’s mark is different due to the inclusion of a visually large, distinctive design element and the literal elements SPICE COMPANY.

Turning to connotation, Opposer argues that both FIJI and FIJIAN are geographic locations – the South Pacific island – and that the difference between the two terms

“is very slight.”⁴⁶ Regarding commercial impression, Opposer argues that because both parties’ goods are consumable products, “[t]he similarity of the products, coupled with the similarity of the marks suggests that the [parties’ marks] convey a similar commercial impression.”⁴⁷

The record shows that FIJI is an island in the South Pacific Ocean, and we take judicial notice that FIJIAN is defined as “Of or relating to Fiji or its people, language, or culture.”⁴⁸ Thus, we agree with Opposer to some extent that the terms have some similarity in meaning due to the fact that they both relate to the remote island of FIJI. However, considering the marks in their entirety, we find that the remoteness (relative to US consumers) of the Fiji island causes the FIJI and FIJIAN terms to engender different commercial impressions when considered in light of the identified goods. FIJI for water engenders the commercial impression of clear, blue water and, due to its geographical remoteness, it also engenders the commercial impression that the water is untainted and unpolluted. However, in connection with Applicant’s mark, the remoteness of the Fiji islands engenders a different commercial impression, i.e., that of an exotic spice. The tiki design of Applicant’s mark reinforces the exotic nature of the identified goods.

The parties’ marks only point of similarity is the geographically significant term FIJI and its variation FIJIAN. As discussed above, terms that are understood to be

⁴⁶ 15 TTABVUE 23.

⁴⁷ *Id.*

⁴⁸ THE AMERICAN HERITAGE DICTIONARY, <https://ahdictionary.com/word/search.html?q=fijian>, accessed on September 23, 2024.

geographically descriptive are less likely to cause confusion. While both parties' goods may originate from Fiji, for purposes of our likelihood of confusion analysis, it is necessary that Opposer demonstrate that there is confusion as to the source of the goods, and not merely confusion because the parties' goods may both originate from the same country. *See, e.g., L'Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at *19-20 (TTAB 2012) ("The issue here, of course, is not whether purchasers would confuse the parties' goods, but rather whether there is a likelihood of confusion as to the source of the goods.").

For the foregoing reasons, we find that the marks are more dissimilar than similar.

3. The Similarity or Dissimilarity and Nature of the Parties' Goods

We now consider the second *DuPont* factor, which consider "[t]he similarity or dissimilarity and nature of the goods." *In re Detroit Ath. Co.*, 903 F.3d 1297, 1306-09 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361). In making our determination, we must look to the goods as identified in Opposer's pleaded registration and the involved application. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014); *see also Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.").

The goods of the opposer and applicant need not be identical or competitive, or even be offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs.*, 668 F.3d at 1369. Evidence of relatedness may include news articles and/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 offered by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both Applicant's goods and the goods identified in Opposer's pleaded FIJI registration. *In re Embiid*, Ser. No. 88202890, 2021 TTAB LEXIS 168, at *30 (TTAB 2021).

In its brief, Opposer makes only the following passing references to the issue of relatedness of the parties' goods:

Second, FIJI is used on bottled water and the FIJIAN Mark is used on spices. While the goods are **not related, they are both consumable goods**, making it more likely for consumers to think that "the bottled water people" are now also selling spices.

....

Both FIJI® water and the applied for FIJIAN product are consumables and which typically move through trade

channels like grocery stores, convenience stores, and online.⁴⁹

Thus, Opposer expressly concedes in its brief that the parties' goods are "not related."

In the likelihood of confusion analysis as the issue is presented in this case, the parties' goods are considered "related" if consumers are likely to mistakenly believe that the parties' goods emanate from the same source. *Coach Servs.*, 668 F.3d at 1369 ("[L]ikelihood of confusion can be found 'if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.'" (quoting *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *28-29 (TTAB 2007))). As the Federal Circuit observed, "related" means "related in the minds of potential consumers." *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1244 (Fed. Cir. 2004) ("[G]oods that are neither used together nor related to one another in kind may still 'be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.'" (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000))).

With this understanding of "relatedness," Opposer's argument that the parties' goods are related by virtue of their both being "consumables" is not persuasive, as it shows a misunderstanding of the requirement of "relatedness." Even were we to consider Opposer's argument, it would fail because a finding of relatedness requires

⁴⁹ 15 TTABVUE 8-9, 23 (emphasis added).

more than Opposer's unsupported assertion that the goods are "consumable." *Cai*, 901 F.3d at 1371 (Attorney argument is no substitute for evidence.). Further, Opposer does not cite any caselaw to support its argument that the mere fact that the parties' goods are consumable renders them related for purposes of our likelihood of confusion analysis, nor are we aware of any. We are simply not persuaded without evidence that consumers will believe that bottled water and spices emanate from the same source merely because both are "consumable."

Given Opposer's concession that the goods are unrelated and the lack of evidence supporting a relationship between "consumable goods", the second *DuPont* factor weighs heavily against a finding of likelihood of confusion.

4. The Similarity or Dissimilarity of Established, Likely to Continue Channels of Trade

Next we consider established, likely-to-continue channels of trade under the third *DuPont* factor. Because there are no limitations as to channels of trade in either Opposer's registration or the involved application, we must presume that the goods identified in Opposer's registration and Applicant's application travel through all normal and usual trade channels for such goods. *Coach Servs.*, 668 F.3d at 1370 (absent limitation "goods are presumed to travel in all normal channels ... for the relevant goods").

Opposer argues that:

The presumed and actual channels of trade are also identical. Since there are no channel of trade restrictions in the opposed application, the Board must assume that the recited goods will be available through all the normal channels of trade to all the usual purchasers for such goods. Both FIJI® water and the applied for FIJIAN product are

consumables and which typically move through trade channels like grocery stores, convenience stores, and online. Since both products flow through identical channels of trade, this factor favors a finding of likelihood of confusion.⁵⁰

Through the testimony of Mr. Chai, Opposer established that FIJI water is “sold in grocery, gourmet food, health food, and other specialty stores, delicatessens, restaurants, hotels, museums, movie theatres, nightclubs, and health clubs throughout the world.”⁵¹ In addition, FIJI water is sold via FIJI Water’s website at <https://store.fijiwater.com>.⁵²

Although Opposer argues in its brief that Applicant’s spices “typically move through trade channels like grocery stores, convenience stores, and online,”⁵³ Opposer did not introduce any evidence to support this, such as third-party website printouts showing the identified goods available at grocery stores, convenience stores or online, nor do we see any supporting evidence in the record. Thus, Opposer’s argument is not supported by evidence. *Cai*, 901 F.3d at 1371. Thus, we are cannot find that the parties’ channels of trade overlap.

The fact pattern presented here is analogous to that presented in *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at *27-33 (TTAB 2014). In it, opposer’s pleaded registrations identified a wide range of goods and services, including “retail store services in the field of furniture, housewares and

⁵⁰ 15 TTABVUE 23-24.

⁵¹ 13 TTABVUE 4 (Chia Aff., para. 14).

⁵² *Id.* at 4 (Chia Aff., para. 14).

⁵³ 15 TTABVUE 23.

home furnishings; and restaurant and catering services,” various foods and flowers. *Id.* at *3-4. Applicant sought to register its involved mark for, *inter alia*, various nutritional, herbal, vitamin and mineral supplements. *Id.* at *1. Opposer presented evidence that it sold its identified goods and services through its retail stores, its website and through catalogs. *Id.* at *27. The record also showed that applicant did not sell its identified nutritional supplements through retail stores but rather through independent sales consultants. *Id.* at *28. Neither opposer’s pleaded registration nor applicant’s involved application contained any restrictions as to its channels of trade. *Id.* at *1-4. The Board in *Inter Ikea* wrote:

Opposer argues that because the description of goods for applicant’s nutritional, herbal, vitamin and mineral supplements is not restricted to any channels of trade or classes of consumers, the supplements are presumed to move through all the ordinary and usual channels of trade and to all the usual customers for nutritional, herbal, vitamin and mineral supplements. Accordingly, opposer concludes that, “the trade channels of and customers for Applicant’s goods offered under the AKEA Mark are presumed to overlap with Opposer’s trade channels and customers for its goods under the IKEA Mark. Applicant could, like Opposer, offer its products in retail stores, through catalogs, and over the Internet.”

There are two problems with opposer’s argument. First, there is no evidence in the record, except applicant’s description of how it sells its nutritional, herbal, vitamin and mineral supplements, as to the ordinary and usual channels of trade for nutritional, herbal, vitamin and mineral supplements. Accordingly, opposer is asking us to assume, rather than require opposer to prove, that nutritional, herbal, vitamin and mineral supplements move in the same channels of trade and are sold to the same classes of consumers as furniture, housewares and home furnishings. That is not something we can or will do, because it would not be faithful to the underlying legal principle. When an application or registration fails to

specify or limit the channels of trade of classes of customers, we must assume that the goods or services in question travel in all the normal channels of trade and to all prospective purchasers **for the relevant goods or services**. Thus, when the dispute involves the comparison of **different** goods or services, this principle does not help the party asserting a likelihood of confusion unless there is further evidence that would permit a comparison of the normal trade channels for the parties' respective goods or services. That evidence is lacking here.

Second, and more important, that applicant could conceivably sell its nutritional, herbal, vitamin and mineral supplements through a retail store, catalogs and over the internet does not prove that opposer's goods and services and applicant's goods and services move through the same channels of trade and are sold to the same classes of consumers. For example, there is no evidence that any company rendering retail store services in the field of furniture, housewares and home furnishings, as well as restaurant and catering services, also sells nutritional, herbal, vitamin and mineral supplements. Under opposer's theory, 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.

Inter IKEA Sys., 2014 TTAB LEXIS 166, at *28-32 (emphasis in italics in original, bold here) (citations omitted).

As in *Inter IKEA*, the record in the present matter contains evidence of only one party's channels of trade, i.e., that of Opposer's. There is no evidence of Applicant's channels of trade. Thus, for the reasons discussed in *Inter Ikea*, even though the parties' identifications are unrestricted, and we must assume that the parties' respective goods travel in all the normal channels of trade and to all prospective purchasers for the relevant goods or services, due to the lack of evidence, we are unable to compare the normal trade channels for the respective goods.

Because Opposer has not shown that the parties' channels of trade overlap, the third *DuPont* factor is neutral.

5. Sales Conditions and Purchaser Sophistication

The fourth *DuPont* factor is the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. ‘careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. Purchaser sophistication or degree of care when encountering marks may tend to minimize likelihood of confusion. *In re N.A.D., Inc.*, 754 F.2d 996, 1000 (Fed. Cir. 1985) (finding no likelihood of confusion where goods were elaborate machines purchased “only [by] very sophisticated purchasers ... who would buy with great care”). Precedent requires that we base our decision on the least sophisticated potential purchaser. *Stone Lion*, 746 F.3d at 1325.

Opposer argues that the parties' goods are “relatively inexpensive, ‘low involvement’ products, and consumers are likely to exercise a lower degree of ordinary care in purchasing these goods[,]” and then argues, without evidence, that both parties' identified goods are “marketed to [] highly similar if not identical health conscious consumers who are interested in healthy beverages.”⁵⁴

Opposer's registration for its FIJI mark identifies “natural, spring and artesian water for drinking.” Applicant identifies “spices; turmeric for food; edible turmeric.” Because there are no restrictions or limitations in the identifications, these identifications include all goods of the type identified, without limitation as to their nature or price. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d

⁵⁴ 15 TTABVUE 24.

1367, 1373-74 (Fed. Cir. 2013). Thus, the goods are presumed to include water and spices that are relatively inexpensive. *Sock It to Me, Inc. v. Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *24-25 (TTAB 2020) (Because the identifications did not include any limitation as to price, “the goods are presumed to include socks that are relatively inexpensive.”). “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot*, 214 F.3d at 1329.

The relative low price of Opposer’s goods is bolstered by evidence of record. Mr. Chia testified that the retail cost of Opposer’s water varies depending if one buys a 24-pack or an individual bottle. For example, a 24-pack of FIJI brand water, in the 500 mL size, sells for approximately \$40.00 a case on the FIJI Water website.⁵⁵ Individual bottles of water are also available and are usually sold in the refrigerated section of stores, in restaurants and bars.⁵⁶ The retail price for a single 500 mL bottle can vary depending on location, but ranges from about \$1 to \$4.⁵⁷

Although the record contains pricing information as to Opposer’s identified goods, there is no evidence in the record about purchasing conditions, pricing, and types of purchasers who would purchase Applicant’s identified goods. We find, therefore, the fourth factor is neutral in our analysis. *See, e.g., Double Coin Holdings Ltd. v. Tru*

⁵⁵ 13 TTABVUE 3 (Chia Aff., para. 7).

⁵⁶ *Id.*

⁵⁷ *Id.*

Dev., Can. No. 92063808, 2019 TTAB LEXIS 347, at *25-26 (TTAB 2019) (finding the fourth *Dupont* factor neutral where there was a lack of evidence in the record showing “consumers will exercise a higher than ordinary degree of purchasing care”).

6. Balancing the Factors

We have carefully considered all of the evidence made of record, as well as all arguments related thereto.

We have found the pleaded FIJI mark to be commercially strong and entitled to a broad scope of protection, despite its conceptual weakness and its registration under the provisions of Section 2(f). This weighs heavily in favor of likelihood of confusion.


Comparing the marks, we find that the marks are more dissimilar than similar and, comparing the goods, Opposer concedes that the parties’ goods are not related.⁵⁸ There is no evidence that the channels of trade overlap, nor is there evidence of purchasing care and consumer sophistication. The first and second factors, therefore, weigh against confusion, the second heavily so, while the third and fourth factors are neutral. Due to dissimilarity of the marks and Opposer’s concession that the parties’ goods are not related, we conclude that Applicant’s mark is not likely to cause confusion with Opposer’s mark. In reaching our conclusion, we find that the first and second factors are dispositive and outweigh the other factors, including the fifth factor relating to the fame of Opposer’s mark. *See, e.g., Chatam Int’l*, 380 F.3d at 1341-42; *Federated Foods*, 544 F.2d at 1103. *See also, Inter IKEA*, 2014 TTAB LEXIS 166, at *8-37 (finding the IKEA mark famous for “retail store services in the field of furniture,

⁵⁸ 15 TTABVUE 8-9.

housewares and home furnishings,” and confusion unlikely due, in part, to lack of evidence that Applicant’s identified goods (fruit juices) were related to Opposer’s retail store services).

IV. Decision



The opposition to registration of the  mark of application Serial No. 90763462 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) is dismissed.