

This Opinion is Not a
Precedent of the TTAB

Mailed: February 18, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Givn Goods, Inc.

v.

IBMG, LLC

Opposition Nos. 91281529 & 91281530

David Postolski of Gearhart Law LLC,
for Givn Goods, Inc.

Sam E. Iverson of Pillsbury Winthrop Shaw Pittman LLP,
for IBMG, LLC.

Before Zervas, Lynch, and Lebow
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

In two applications, IBMG, LLC (“Applicant”) seeks registration on the Principal Register of the mark GIVN in standard characters for:

Cosmetics, toilet preparations and perfumery products, namely, lipsticks, lip gloss, lip liners, lip balms, lip palettes; eye shadows, eye lining pencils, liquid eye liners,

eye makeup, mascara, eyebrow pencils, artificial eyelashes, eye palettes; blushers, multi-use cosmetic sticks, foundation makeup, pressed powder, loose powder, makeup remover, concealers, powders and gels for use on face, cleansers, namely, facial cleansers and skin cleansers; multi-use colored creams, namely face creams and skin creams; exfoliators, namely, skin and facial exfoliators; moisturizers for the face and body, masks for the face and body, non-medicated skin toners, eye creams, skin cleansing wipes; non-medicated skin care creams, lotions, oils, sprays, and gels for the face and body; anti-cellulite and body firming creams, lotions, serums and sprays for the face and body; nail polish, nail enamel; nail polish remover; fragrances for personal use; sun care lotions, bronzers, tanning lotions, sunscreens, self tanners, after sun soothers and rehydrators, namely, sun creams, lotions and gels in International Class 3;¹ and

Online retail store services in the fields of cosmetics, beauty, skin care, toiletry, fragrance, and clothing products of others; online retail store services in the fields of cosmetics, beauty, skin care, toiletry, fragrance, and clothing products; providing purchasing information about fragrances and cosmetic products and accessories; buying club services, namely, a cosmetics and beauty and skin care products club featuring arranging periodic shipment to club members; promoting the goods and services of others by providing a web site featuring product information and reviews, information about consumer purchasing behavior and trends, product how-to articles and videos, discounts and coupons for the goods of others, and links to the retail web sites of others, all in the fields of cosmetics, beauty, skin care, toiletry, fragrance, and clothing products; compiling, analyzing, processing and providing customer preference and product usage data to providers of cosmetics, beauty, skin care, toiletry, fragrance, and

¹ The goods are set forth in Application Serial No. 97117960, which was filed on November 10, 2021 based on alleged bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). Application Serial No. 97117960 is the subject of Opposition No. 91281529.

clothing products for business purposes in International Class 35.²

By its Notices of Opposition, Givn Goods, Inc. (“Opposer”) opposes registration based on an alleged likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer relies on its previously registered mark GIVN in standard characters for:

Bottled drinking water; Distilled drinking water; Drinking water; Drinking water with vitamins; Drinking waters; Purified bottled drinking water in International Class 32.³

² The services are set forth in Application Serial No. 97117966, which was filed on November 10, 2021 based on alleged bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). Application Serial No. 97117966 is the subject of Opposition No. 91281530.

³ Registration No. 4594320 issued on August 26, 2014 and has been renewed. Opposer also pleaded ownership of Registration No. 5220840 for the same mark GIVN for services in International Class 36 and submitted that registration into evidence. 17 TTABVUE 18-24. However, in Opposer’s briefing, it does not rely on that registration for its Section 2(d) claims, so we deem any likelihood of confusion claim based on Registration No. 5220840 impliedly waived.

Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, *4 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Unless otherwise indicated, the TTABVUE citations are to Opposition No. 91281529, the parent case of these consolidated proceedings.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation, this order 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 order employs citations to the LEXIS legal database and cites only precedential decisions, unless otherwise specified. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). Proceeding and serial numbers also are included for decisions of the Board. Those Board decisions that issued on or after January 1, 2008 may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available through USPTO.gov in the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

Applicant denies the salient allegations in the Notices of Opposition.

The Board granted Applicant's consented motion to consolidate the oppositions.⁴

II. Evidentiary Record and Applicant's Objections

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the opposed applications. In addition, Opposer submitted two Notices of Reliance, which contain USPTO records and discovery materials, during Opposer's trial period,⁵ and a rebuttal Notice of Reliance containing Internet materials during its rebuttal period.⁶ Applicant submitted a Notice of Reliance that contains USPTO records, discovery materials and Internet materials,⁷ and a declaration from Cori Whiting, a Trademark Specialist with Applicant's counsel's firm, who introduced a trademark research report from CompuMark for GIVN in connection with certain services.⁸

Applicant raises numerous evidentiary objections.⁹ First, Applicant objects to the evidence attached to Opposer's Exhibits 44 and 47 of Opposer's Second Notice of Reliance (19 TTABVUE 5-18, 47-50) as inadmissible because they are Opposer's own responses to Applicant's interrogatories. Second, Applicant objects to the evidence in Opposer's Exhibits 46, 49 and 51 (19 TTABVUE 28-46, 56-60, and 66-69) as

⁴ 9 TTABVUE.

⁵ 17 & 19 TTABVUE.

⁶ 22 TTABVUE.

⁷ 20 TTABVUE.

⁸ 21 TTABVUE.

⁹ 24 TTABVUE 11-12.

inadmissible because they are Opposer's own responses to document requests. Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5), permits the introduction of discovery responses only by the party that propounded the discovery, subject to a limited exception not applicable here. We therefore sustain these objections.

Third, Applicant objects to the evidence in Opposer's Exhibits 52, 54 and 57 of Opposer's Second Notice of Reliance (19 TTABVUE 70-87, 100-21, and 128-49), as inadmissible documents produced by Opposer in discovery, which are not eligible for introduction through a notice of reliance. A party may not submit its own documents produced in discovery under notice of reliance alone, unless the documents are otherwise admissible under notice of reliance. Trademark Rules 2.122(k)(3)(ii) & 2.122(e), 37 C.F.R. §§ 2.122(k)(3)(ii) & (e). The exhibits at issue, which include email exchanges, spreadsheets, and non-Internet promotional materials, are not the types of documents eligible for admission under a notice of reliance, as provided in Rules 2.122(e) & (g). *See* 37 C.F.R. § 2.122(g) (cross-referencing other rules identifying "the types of evidence admissible by notice of reliance"); *id.* at (e) (official records; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet materials with a URL and date). We therefore sustain these objections.

Fourth, Applicant objects to the evidence submitted with Exhibits 58-63 of Opposer's Rebuttal Notice of Reliance (22 TTABVUE 7-47), consisting of various screenshots of third-party websites, press releases and articles. Opposer's opening

Brief cites to these rebuttal exhibits to support its assertion that the parties' goods and services are similar, that the trade channels overlap and that its mark is commercially strong. However, Applicant contends the exhibits are improper rebuttal evidence, and should have been submitted during Applicant's main testimony period, citing TBMP § 707.02(c) ("An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal").

Opposer responds:

Applicant attempts to render this evidence inadmissible simply by virtue that it could have been submitted in the Opposer's initial trial period, but was submitted in the Opposer's rebuttal period. Applicant cites to no authority except for TBMP § 707.02(c). "The fact that evidence might have been offered in chief does not preclude its admission as rebuttal." *Data Packaging Corporation v. Morning Star, Inc.*, 1981 WL 40443, at *5 (TTAB 1981). In any case, the evidence of trade channels was clearly submitted during the rebuttal period to rebut the evidence that Applicant submitted and refers to in this section of their brief. 24 TTABVUE 20 (citing to Opposer's discovery responses as to trade channels).¹⁰

Trademark Rule 2.121(b) and (c) provide that the Board will set "a testimony period for the plaintiff to present evidence in rebuttal," and "[a] testimony period which is solely for rebuttal will be set for fifteen days." 37 C.F.R. §§ 2.121(b) & (c). By definition, rebuttal evidence is meant to counter an opponent's evidence. *Life Zone Inc. v. Middleman Group Inc.*, Opp. No. 91160999, 2008 TTAB LEXIS 37, at *14-15 (TTAB 2008) ("It is axiomatic that rebuttal testimony may be used only to rebut

¹⁰ 25 TTABVUE 12 (Opposer's Reply Brief).

evidence offered by the defendant.”). Opposer’s quote from *Data Packaging* is out of context, and it cannot be relied on for the proposition that evidence to support the case in chief can be withheld until rebuttal. Indeed, the Board in *Data Packaging* went to great lengths to explain that the testimony at issue was proper rebuttal, detailing how it responded to the opponent’s evidence and argument. 1981 TTAB LEXIS 90, at *12-14 (no proceeding number) (TTAB 1981). “Evidence which should constitute part of an opposer’s case in chief, but which is made of record during the rebuttal period, is not considered when the applicant objects.” *Automedx, Inc. v. Artivent Corp.*, Opp. No. 91182429, 2010 TTAB LEXIS 343, at *3 (TTAB 2010).

The evidence at issue here regarding the similarity of the goods, services and trade channels, and commercial strength of Opposer’s mark is geared to establishing the likelihood of confusion claim, rather than responding to Applicant’s evidence. *See e.g., Texas Gas Transmission Corp. v. Chemplex Co.*, 1972 TTAB LEXIS 111, at *16 (no proceeding number) (TTAB 1972) (“The question of the possible similarity of channels of trade in a proceeding of this character is generally a part of a plaintiff’s case-in-chief going to the heart of the question of likelihood of confusion raised in an opposition. It would appear that this testimony was taken by opposer, as an after-thought, to shore up deficiencies in its case-in-chief. As such, it is improper rebuttal.”). Thus, the evidence in Exhibits 58-63 of Opposer’s Rebuttal Notice of Reliance should have been submitted with Opposer’s case-in-chief, and are improper rebuttal. We sustain Applicant’s objections.

In summary, as a result of the sustained objections, Opposer's Exhibits 44, 46, 47, 49, 51, 52, 54, and 57-63 (19 TTABVUE 5-18, 28-50, 56-60, 66-87, 100-21, 128-49; 22 TTABVUE 7-47) are excluded from the record.

Finally, we note that Applicant's Brief relies on a list of third-party application serial numbers, for which the applications are not in the record, to "diminish[] the probative value of the Class 3 applications" by the same third-party owner that Opposer submitted for the record.¹¹ However, a mere list of application serial numbers and classes does not serve to introduce the listed applications. *See Edom Labs. Inc. v. Lichter*, Opp. No. 91193427, 2012 TTAB LEXIS 81, at *11-12 (TTAB 2012). And "it is well settled that the Board does not take judicial notice of USPTO records." *UMG Recordings, Inc. v. O'Rourke*, Opp. No. 91178937, 2009 TTAB LEXIS 533, at *12 (TTAB 2009); *see also Edom Labs.*, 2012 TTAB LEXIS, at *12 ("The Board does not take judicial notice of registrations or applications residing in the Office"). Thus, Applicant's assertions about the applications are unsupported.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *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, 125-26 n.4 (2014)). A plaintiff may oppose the registration of a mark when such proceedings are within the zone of interests protected by the statute and the plaintiff has a reasonable belief in damage that is proximately caused by

¹¹ 24 TTABVUE 18 n.2.

registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020).

Opposer's pleaded registration for the identical mark, for which current status and title is established,¹² supports Opposer's plausible likelihood of confusion claims against the involved applications, thereby showing its real interest in this proceeding that falls within the zone of interests protected by the statute, and a reasonable basis for its belief of damage. Opposer has demonstrated its entitlement to oppose. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000).

IV. Priority and Likelihood of Confusion

A. Priority

To prevail on its likelihood of confusion claims, Opposer first must establish priority. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, Opp. No. 91193335, 2013 TTAB LEXIS 6, at *28 (TTAB 2013) (citing *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470 (Fed. Cir. 1987)). Opposer properly introduced its pleaded registration for drinking water goods set out above,¹³ and Applicant has not counterclaimed to cancel it. Therefore, priority is not an issue as to the mark and goods covered by that registration. *See Top Tobacco LP v. N. Atl. Op. Co.*, Opp. No. 91157248 (parent), 2011 TTAB LEXIS 367, *15 (TTAB 2011) (citing *King Candy, Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974)); *see also Massey Junior*

¹² 17 TTABVUE 9-17 (TSDR records).

¹³ *See id.*

Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1403 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation”).

B. Likelihood of Confusion

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). The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods and/or services. *See 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.”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortgage Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th

1355, 1365 (Fed. Cir. 2023) (“It is well established that, in opposition proceedings, the burden of proof rests on the opposer.”)

We have considered the case law cited by the parties, but discuss only some of it below. Because the likelihood of confusion analysis depends on the evidentiary record, prior decisions often are “of little value,” as “[e]ach case must rest upon its own distinctive fact situation.” *Star Watch Case Co. v. Gebruder Junghans, A.G.*, 267 F.2d 950, 952 (CCPA 1959).

1. Strength of Opposer’s Mark

We first turn to the strength of Opposer’s mark, as this informs the appropriate scope of protection of the mark in the likelihood of confusion analysis. Opposer characterizes its mark as an inherently distinctive, conceptually strong mark that is unique on the Trademark Register, as well as a commercially strong mark with “nationwide success.”¹⁴ Applicant, on the other hand, asserts that Opposer’s GIVN mark is conceptually and commercially weak.

“Two of the *DuPont* factors (the fifth and sixth) consider strength.” *Spireon*, 71 F.4th at 1362. In determining the strength of Opposer’s GIVN mark, we address both conceptual strength, based on the nature of the mark itself, and commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010); *see also Spireon*, 71 F.4th at 1362. 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

¹⁴ 83 TTABVUE 11 (PepsiCo’s Brief).

(sales, advertising, length of use),” while “the sixth *DuPont* factor allows [Applicant] to contract that scope of protection by adducing evidence of ‘[t]he number and nature of similar marks in use on similar goods.’” *Made in Nature v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, **23-24 (TTAB 2022) (quoting *DuPont*, 476 F.2d at 1361).

Opposer’s pleaded registration, which does not include a claim of acquired distinctiveness, affords its registered mark a presumption of inherent distinctiveness. *See* Trademark Act Section 7(b), 15 U.S.C. § 1057(b). Conceptual strength is a measure of a mark’s distinctiveness, which falls “in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Spireon*, 71 F.4th at 1362 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

The parties take different positions on where Opposer’s GIVN mark falls on the spectrum of distinctiveness. Opposer seems to categorize its mark as arbitrary, opining that “[t]he term ‘GIVN,’ presuming a consumer understands it to mean the same as ‘given,’ means nothing about the quality of bottled water.”¹⁵ Applicant argues that the mark is highly suggestive because it “convey[s] Opposer’s mission to help consumers ‘give’ to others in purchasing Opposer’s GIVN water, suggesting Opposer’s buy-one, give-one business model.”¹⁶ Applicant cites Opposer’s discovery responses,¹⁷

¹⁵ 23 TTABVUE 14 (Opposer’s Brief).

¹⁶ 24 TTABVUE 21 (Applicant’s Brief).

¹⁷ 20 TTABVUE 30, 37.

marketing materials,¹⁸ and ownership of Registration No. 5220840 for fundraising from “a portion of the proceeds from the sale of water funds access to clean water for persons in need,”¹⁹ as support for the proposition that the term is highly suggestive and therefore conceptually weak. In its discovery responses, Opposer describes its goods as “the nation’s leading socially conscious premium spring water that provides one day of clean water to people in need for every bottle sold.”²⁰

We find that GIVN likely would be perceived by consumers as a misspelling and phonetic equivalent of “given.” However, nothing about GIVN or “given” describes or suggests anything about Opposer’s identified drinking water. The fact that Opposer has chosen to market the water by promising a donation for each bottle of drinking water purchased does not mean that GIVN or “given” conveys anything about the identified goods.

Applicant also contends that a term that “identif[ies] the function or purpose of a product may also be descriptive or highly suggestive.”²¹ In response, Opposer cites *In re. Rec. Equip. Inc.*, Serial No. 87186780, 2020 TTAB LEXIS 482, at *19 (TTAB 2019) for its helpful discussion of why the mark CO-OP, which described the applicant’s business model, was not merely descriptive of the identified bicycles and accessories. The Board held in that case that even though the applicant promoted itself as a co-

¹⁸ 20 TTABVUE 56-64.

¹⁹ 17 TTABVUE 18-24.

²⁰ 20 TTABVUE 37 (answer to Interrogatory No. 2).

²¹ 24 TTABVUE 22 (Applicant’s Brief).

op, neither the applicant nor others in the trade used the term in connection with bikes and accessories. *Id.* The Board ultimately held:

The evidence shows that some consumers may be aware that Applicant is a co-op, but the record does not support a finding that the mark CO-OP immediately conveys to average consumers information about a quality, feature, or characteristic of bicycles and the other goods identified in the application.

Id. We apply the same logic here. While GIVN may bring to mind Applicant's charitable undertakings, it does not immediately convey to consumers any information about a quality, feature or characteristic of drinking water.

Turning to commercial strength, “[a] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992)). Such strength rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1324-25 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)). As the Federal Circuit has explained, “[w]hile dilution fame is an either/or proposition--fame either does or does not exist--likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *Palm Bay Imps.*, 396 F.3d 1369 (internal quotation omitted)).

Opposer claims commercial strength, but most of its supporting evidence has been excluded based on Applicant's objections we sustained above.²² The only surviving evidence Opposer refers to, Exhibit 55-56, is described as "third-party articles discussing Opposer and associating it with nationwide famous brands."²³ Applicant counters that these so-called third-party articles are Opposer's own press releases from 2019 and 2020, and they are not probative of any commercial strength. *See Made in Nature v. Pharmavite*, 2022 TTAB LEXIS 228, at *39 (deeming press releases unpersuasive evidence of strength because they are not "unsolicited media attention").

Although not cited by Opposer, we note that Applicant introduced Opposer's discovery responses that contain some information relevant to commercial strength. For example, interrogatory answers include Opposer's statement that it has "over 3,000 stores carrying our product, distribution agreements with US Foods, Sysco and more."²⁴ Additional distributor names are listed in another interrogatory answer.²⁵ Other answers include a future projection of revenue from the sale of its drinking water of "approximately \$100,000 per month in product on the average in 2023,"²⁶ and projected future planned advertising expenditures for Opposer's drinking water

²² 19 TTABVUE 10, 12 (Exhibit 44); 19 TTABUE 128-149 (Exhibit 57); 22 TTABVUE 38-44 (Exhibits 61-62).

²³ 23 TTABVUE 15 (Opposer's Brief).

²⁴ 20 TTABVUE 38 (Answer to Interrogatory No. 3).

²⁵ 20 TTABVUE 39 (Answer to Interrogatory No. 6).

²⁶ 20 TTABVUE 40 (Answer to Interrogatory No. 10).

of “approximately \$20,000 per year.”²⁷ Another interrogatory answer submitted by Applicant includes Opposer’s representation that it “has been recognized as a ‘Best for the World Honoree - Community’ for 2016-2018 and 2021, and 2021 and 2022 Mindful Award for Water Product of the Year as a maker of goods, water, and apparel, and due to its commitment to environment.”²⁸

Even though this evidence suggests some moderate commercial success, it does not move the needle much on commercial strength. The sales and advertising figures were cast as projections of future revenue and spending, rather than reports of past activity that would better reflect actual consumer recognition of the mark. Also, the location and distribution information does not place these figures in sufficient context to assess Opposer’s market share or compare it to competitors in the industry. *See e.g., Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1375 (Fed. Cir. 2002) (“Large market shares of product sales or large percentages of advertising expenditures in a product line would buttress claims to fame.”). Similarly, the record regarding Opposer’s award lacks sufficient detail to be probative of consumer recognition of the GIVN mark.

Overall, the minimal evidence, especially in view of the limitations above, does not demonstrate sufficient consumer recognition of the mark to establish elevated commercial strength. *See Lacoste Alligator S.A. v. Maxoly Inc.*, Opp. No. 91177866, 2009 TTAB LEXIS 511, *7 (TTAB 2009) (“Because of the extreme deference that we

²⁷ 20 TTABVUE 40-41 (Answer to Interrogatory No. 11).

²⁸ 20 TTABVUE 40-41 (Answer to Interrogatory No. 13).

accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it.”). We do not find elevated commercial strength.


Applicant next argues, pointing to third-party registrations and uses,²⁹ that GIVN/GIVEN is “commercially weak as a source identifier, as demonstrated by widespread use of the same or similar terms by many different parties for an array of goods and services.”³⁰ However, Applicant’s premise is flawed, as uses and registrations for goods and services unrelated to Opposer’s drinking water do not render its mark weak. *See Omaha Steaks*, 908 F.3d at 1325 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *In re i.am.symbolic, llc*, 866 F.3d 1315, 1328 (Fed. Cir. 2017) (disregarding third-party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, . . . support a finding that registrants’ marks are weak with respect to the goods identified in their registrations”). None of the uses and registrations are for drinking water or any other goods or services that appear related to Opposer’ goods on their face. For example, Applicant relies on evidence such as the use and registration of

²⁹ 20 TTABVUE 147-392. Applicant included some foreign use appearing in a foreign language (20 TTABVUE 147-56, 174-80), and we have no basis to find them relevant to the U.S. consumer, so we have not considered them.

³⁰ 24 TTABVUE 23 -26 (Applicant’s Brief) (listing illustrative use and registration evidence from the record).

THE GIVEN INSTITUTE for “leadership development training for Catholic women; providing instruction in the field of Catholicism;”³¹ GIVEON for various clothing



items,³² and the use and registration of  for “spirits and liqueurs, specifically excluding wines.”³³ Overall, Applicant’s evidence fails to show weakness of GIVN in the context of Opposer’s drinking water goods.

Therefore, we consider GIVN for the identified goods as an arbitrary and conceptually strong mark with an ordinary degree of commercial strength, and that strength has not been contracted through third-party use of the same or similar marks on similar goods.

2. Similarity of the Marks

Turning to the first *DuPont* factor, we must compare Opposer’s GIVN mark to Applicant’s GIVN mark “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 393 F.3d at 1371 (quoting *DuPont*, 476 F.2d at 1361). The standard-character marks are identical. The overall appearance and sound of the marks, and their connotations and commercial impressions, are identical.

³¹ 20 TTABVUE 230-35 (Registration No. 5933456; giveninstitute.com).

³² 20 TTABVUE 300-02 (Registration No. 7007864).

³³ 20 TTABVUE 258-64 (Registration No. 3843109; givenspirits.com).

C. Relatedness of the Goods and Services

Turning next to the *DuPont* factor addressing the similarity or dissimilarity of the goods, our assessment focuses on Applicant’s identifications, which include “lip balms,” “non-medicated skin care ... sprays ... for the face and body” and “online retail store services in the field of cosmetics,” which are the goods and services that Opposer contends are related to drinking water, as discussed below. Also, we consider the identified goods in Opposer’s pleaded registration: “Bottled drinking water; Distilled drinking water; Drinking water; Drinking water with vitamins; Drinking waters; Purified bottled drinking water.” See *Octocom Sys. v. Houston Comp. Servs.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (identifications control). “[L]ikelihood of confusion can be found ‘if the respective goods [or services] 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.’” *Coach Servs.*, 668 F.3d at 1369 (internal citations omitted). Where marks are identical, such as in this case, the necessary degree of similarity of the goods or services declines. *In re Embiid*, Serial No. 88202890, 2021 TTAB LEXIS 168 at *62 (TTAB 2021).

Likelihood of confusion is established as to a class of goods or services in an application if it exists as to any good or service in that class. *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 TTAB LEXIS 139 at *19 n.41 (TTAB 2024). Thus, considering the record as a whole, we will address the goods Applicant’s Class 3 application and the services Applicant’s Class 35 application.

Opposer's entire argument and cited evidence for the relatedness of the goods and services at issue, from its opening Brief, is as follows:

As to the similarity of the goods, the Opposer's drinking water and the Applicant's class 3 cosmetics and class 35 retail services for selling cosmetics have been sold by the same source in the marketplace and have been registered by the same registrant for the same marks as well.

Evian, a sub-brand of Danone, an international corporation, sells both bottled water and cosmetics in the form of facial spray (explicitly identified in the '960 application), and maintains both goods under the same registration. *See* 17 TTABVUE 246, Exhibit 28 (Reg. No. 2822102); *See* 17 TTABVUE 285-89, Exhibits 39-40.

Aquafina sells both water and cosmetics in the form of lip balm, lip gloss, and lip exfoliants (also explicitly identified in the '960 application), under the same trademark, and maintains both goods under registrations for the same mark. *See* 17 TTABVUE 251-264, Exhibits 29-31 (Reg. Nos. 3214155, 3170128, and 1917411); *See* 17 TTABVUE 290-296, Exhibits 41-43.

Pepsi sells soft drinks and has applied for several marks to sell cosmetics under their brand. *See* 17 TTABVUE 265-284, Exhibits 32-38 (Reg. Nos. 957017 and 4684879 & Ser. Nos. 98188707, 98189654, 98189629, 98189648, and 98189640).

Applicant points out that in response to requests for admission, Opposer admitted it does not offer under its mark, or have current business plans to offer under its mark, the type of goods Applicant has identified in these registrations as being related to drinking water.³⁴

First, as to Applicant's Class 35 services, there is no third-party evidence of the same mark used on drinking water and in connection with the services in the

³⁴ 20 TTABVUE 24-30.

challenged application, and no registration covering both such goods and services. Nor do we find Applicant's Class 35 services related on their face to Opposer's identified drinking water goods. Therefore, Opposer has failed to establish that Applicant's Class 35 services and Opposer's goods are related.

Turning next to Applicant's Class 3 goods, Opposer's reliance on some of its evidence is misplaced. Registration No. 2822102 for EVIAN-and-design,³⁵ which covered cosmetics and still mineral waters, was cancelled for failure to maintain the registration, which lapsed on September 16, 2024. *See Nike Inc. v. WNBA Enterprises LLC*, Opp. No. 91160755, 2007 TTAB LEXIS 39, at *9 n.6 (TTAB 2007) (notice taken of current status of registration properly made of record, when status of registration changed between time made of record and time case decided). This cancelled registration therefore lacks probative value other than to show it once issued. *Made in Nature v. Pharmavite*, 2022 TTAB LEXIS 228, at *31. In addition, Opposer's evidence regarding the PEPSI mark consists of soft drink registrations, and pending intent-to-use applications that include cosmetic items.³⁶ However, the third-party registrations are for soft drinks, not for drinking water, and the applications, even though they identify cosmetics, are evidence only of the fact that the applications have been filed, *In re Toshiba Med. Sys. Corp.*, Serial No. 79046106, 2009 TTAB LEXIS 447, at *12 n.8 (TTAB 2009), and have no other probative value, *Interpayment Servs. Ltd. v. Docters & Thiede*, Opposition No. 119852, 2003 TTAB LEXIS 104, at

³⁵ 17 TTABVUE 246-50.

³⁶ 17 TTABVUE 265-84.

*14 n.6 (TTAB 2003); *Nike Inc. v. WNBA Enterprises*, 2007 TTAB LEXIS 39, at *12 n.8 (“[P]ending applications are evidence only that the applications were filed on a certain date. They are not evidence of use of the marks.”).

On the other hand, the record also includes some proper evidence of purported relatedness. For example, the *evian.com* website promotes the EVIAN mark on bottled drinking water, and the *evianspray.com* website promotes EVIAN on “facial mist.”³⁷ Notably, for purposes of the Class 35 analysis, the websites do not appear to be retail sites where the EVIAN goods are offered for sale, but rather the site for water includes a “WHERE TO BUY” link,³⁸ and the site for facial spray includes a link to “Find a Store.”³⁹ In addition, screenshots from Amazon show the mark AQUAFINA on lip balm, and the Aquafina website shows the mark on bottled drinking water.⁴⁰ The record also includes a use-based, live registration for AQUAFINA that identifies lip balm and lip gloss,⁴¹ and another for the same mark that identifies non-carbonated water and table water.⁴² Thus, we have two third-party use examples where the same mark appears on drinking water and one of the cosmetics in Applicant’s Class 3 application (facial mist), and one of these uses is corroborated with registration evidence.

³⁷ 17 TTABVUE 285-89.

³⁸ 17 TTABVUE 285.

³⁹ 17 TTABVUE 289.

⁴⁰ 17 TTABVUE 290-96.

⁴¹ 17 TTABVUE 251-55.

⁴² 17 TTABVUE 262-63.

Generally, third-party use evidence can support the relatedness of goods and services by showing that consumers are accustomed to encountering them offered under the same mark. *See Detroit Ath. Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018). And use-based, third-party registrations showing that the same entity has registered a single mark identifying the same goods and services at issue are relevant to show that the respective goods and services are of a type that may emanate from a single source under one mark. *L'Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, *21-22 (TTAB 2012); *In re Albert Trostel & Sons Co.*, Serial No. 74186695, 1993 TTAB LEXIS 36, *7-8 (TTAB 1993).

However, with only two third-party use examples and a single live, registered mark (AQUAFINA) for both types of goods, this record falls short of showing that consumers are “accustomed” to encountering drinking water and cosmetics under the same mark, or that entities tend to register the same mark for both goods. This is particularly true here, where the goods and services appear to be so different on their face. Consequently, in the context of this inter partes proceeding, we find Opposer’s evidence too sparse to meet its burden of proof that Applicant’s Class 3 goods are related to Opposer’s Class 33 goods.

3. Trade Channels, Classes of Consumers, and Degree of Care in Purchasing

The third *DuPont* factor considers the established, likely-to-continue channels of trade and classes of consumers. *See Detroit Ath.*, 903 F.3d at 1308 (citing *DuPont*, 476 F.2d at 1361). The fourth *DuPont* factor, the degree of consumer care when making a purchasing decision, may increase or reduce the likelihood of confusion. *See, e.g., In*

re N.A.D., Inc., 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks); *Palm Bay*, 396 F.3d at 1376 (impulse purchases of inexpensive items may have the opposite effect). For these factors, we again look to the language of the identifications and the evidence of record to assess the trade channels, classes of consumers, and degree of care in purchasing. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323-24 (Fed. Cir. 2014).

The only trade channel evidence Opposer cites in its Brief has been excluded as improper rebuttal.⁴³ However, the record contains some evidence about Opposer's trade channels, thanks to Applicant's introduction of some of Opposer's discovery responses. One interrogatory answer identifies retail stores that have carried Opposer's goods: "Publix Markets, WholeFoods, Jewel-Osco Stores, Super Duper Burgers, Bareburgers, Pret a Manger, Jamba Juice, Philz Coffee, Instacart, Biggby Coffee, Gourmet Foods International, and Caribou Coffee."⁴⁴ In another interrogatory answer, "Opposer states that Opposer's goods are advertised, promoted, and marketed in the United States primarily the foodservice industry, quick-service restaurants, coffee chains, specialty QSR, and online sales via Amazon and Shopify."⁴⁵

⁴³ 23 TTABVUE 12-13 (Opposer's Brief, citing 22 TTABVUE 7-37 & 45-47).

⁴⁴ 20 TTABVUE 39 (Answer to Interrogatory No. 7).

⁴⁵ 20 TTABVUE 40 (Answer to Interrogatory No. 8).

First, as to the Class 35 application, on their face, Applicant's recited services do not themselves show or suggest any overlapping trade channels with drinking water, or shared consumers. The minimal trade channel evidence in the record relating to Applicant's Class 35 services, which involve the fields of cosmetics, beauty, skin care, toiletry, fragrance, and clothing products of others, includes articles about Applicant's activity (under other marks) providing cosmetic product samples with "health, beauty and lifestyle magazines."⁴⁶ The record does not demonstrate overlap with Opposer's trade channels.

As to Applicant's Class 3 goods, the minimal relatedness evidence discussed above involving lip balms and facial sprays does not show those products being sold in the same trade channel as drinking water. As previously noted, the Evian websites are not online retail sites, and the respective goods are on different sites, evian.com and evianspray.com. The AQUAFINA lip balm is offered through Amazon.com, but the record only shows AQUAFINA water promoted, not offered for sale, on the Aquafina website, which includes a "Product Locator" link.⁴⁷ While we have evidence that Opposer's drinking water, and cosmetics such as Applicant's, are both offered on Amazon.com, the mere coexistence of both products among the vast array of goods offered by Amazon does not persuade us that the goods are in the same trade channel. There is no evidence to suggest that customers would search Amazon and encounter both types of goods on the same webpages, or even under the same Amazon

⁴⁶ 20 TTABVUE 134, 146.

⁴⁷ 17 TTABVUE 290-95.

department. In the record, the AQUAFINA lip balm appears under “Beauty & Personal Care”⁴⁸ while Opposer’s water appears under “Grocery & Gourmet Food.”⁴⁹ And as discussed above, while there is evidence of Evian promoting water and facial mist, they do not do so together on the same website.⁵⁰ Thus, the record overall includes no evidence of the Class 3 goods and Opposer’s goods being sold through the same trade channels.

Opposer correctly notes that identified goods and services in the applications and registration are presumed to move in all normal trade channels and to all normal potential purchasers of such goods and services. However, to the extent the record in this case shows what those trade channels are, we cannot find that they overlap, so this presumption does not tip the third *DuPont* factor in Opposer’s favor.

Turning to the fourth *DuPont* factor, the identified goods and services in this case are not restricted by price, trade channel or type of purchaser. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1359 (Fed. Cir. 2000) (must focus on identifications). Applicant asserted in an interrogatory answer submitted by Opposer that consumers of the Class 3 goods in the application “tend to be highly sophisticated and exercise a high degree of care in making purchasing decisions for such goods.”⁵¹ However, the record does not include evidence that supports this proposition. Some

⁴⁸ 17 TTABVUE 290.

⁴⁹ 20 TTABVUE 48.

⁵⁰ 17 TTABVUE 6-7 (Opposer identifies the URLs as evian.com and evianspray.com), 285-89 (screenshots).

⁵¹ 17 TTABVUE 41 (Answer to Interrogatory No. 25).

actual pricing information for cosmetics suggests that these goods can be relatively inexpensive.⁵² For Opposer's identified goods, Applicant introduced an Amazon.com page showing Opposer's water offered at \$29.99 for a 24-pack and other water offered at just under \$2 per bottle.⁵³ The nature of these ordinary consumer goods and their relatively modest prices suggest that consumers typically would not exercise elevated care in purchasing them. *Stone Lion*, 746 F.3d at 1325 (recognizing precedent requiring consideration of the "least sophisticated consumer in the class"). Based on the cost, these goods would tend to be more "impulse" purchases.⁵⁴

4. Thirteenth Factor – Bad Faith

Opposer argues under the thirteenth "catchall" *DuPont* factor that Applicant adopted its mark in bad faith because Applicant lacks a bona fide intent to use the mark.⁵⁵ Applicant responds that Opposer's argument is legally flawed because bad faith for likelihood of confusion purposes refers to an intent to confuse consumers, and lack of bona fide intent to use a mark, even if proven, is irrelevant. Applicant correctly points out that Opposer cites to a case in which intent was discussed in the context of a proposed amendment to add a lack of bona fide intent claim as an additional ground to oppose, not equating lack of intent with bad faith in the likelihood of confusion context. *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, Opp. No. 86336, 1993 TTAB LEXIS 6, at * (TTAB 1993).

⁵² 17 TTABVUE 184, 193-98, 290.

⁵³ 20 TTABVUE 48.

⁵⁴ 23 TTABVUE 13.

⁵⁵ 23 TTABVUE 15-17 (Opposer's Brief).

We are not persuaded by Opposer’s argument under this factor. Lack of bona fide intent to use is a different claim than likelihood of confusion, and Opposer did not bring such a claim. *See Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352 (Fed. Cir. 2022) (addressing lack of bona fide intent and likelihood of confusion as separate claims). Nor has Opposer established how the alleged lack of bona fide intent to use the mark equates to bad faith for likelihood of confusion purposes. “A party’s bad faith in adopting a mark is relevant to the thirteenth *DuPont* factor.” *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (citing *DuPont*, 476 F.2d 1361). “[An inference of bad faith] requires an intent to confuse.” *Id.* at 1036 (citation omitted). The case law and discussion provided by Opposer relate to a different claim not at issue in this case, where Opposer has not asserted a lack of bona fide intent to use ground as a basis for opposition.

We find no bad faith on Applicant’s part, and the thirteenth *DuPont* factor is neutral.

D. Balancing the *DuPont* Factors

We have accorded Opposer’s GIVN mark its appropriate scope of protection in light of the considerations discussed above. The identity of the marks weighs heavily in favor of likely confusion, but Opposer failed to demonstrate relatedness of the goods and services at issue, or that they are sold in overlapping trade channels to the same consumers. With no evidence of relatedness as to Applicant’s Class 35 services, and very scant evidence as to Applicant’s Class 3 goods, and the record reflecting that they generally are not promoted and sold together in the same

channels, Opposer has not met its burden of proof that consumers, even buying on impulse, would expect goods and services such as Applicant's to emanate from the same source as drinking water, even when offered under identical marks. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"); *DuPont*, 476 F.2d at 1362 (noting that particular factors "may from case to case play a dominant role"). There is no proof of bad faith by Applicant to sway the determination. Accordingly, Opposer has not proven its claims under Section 2(d).

Decision: The consolidated oppositions are dismissed, and the applications will proceed in due course.