Mailed: June 17, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ESRT Empire State Building, L.L.C.
(substituted for Empire State Building Co. L.L.C.)[1]
v.
Michael Liang

Opposition No. 91204122
to application Serial No. 85213453

Eric J. Shimanoff of Cowan Liebowitz & Latman PC for ESRT Empire State Building Co. L.L.C.

David Yan of Law Offices of David Yan for Michael Liang.

Before Cataldo, Taylor and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Michael Liang ("Applicant") seeks registration on the Principal Register of the mark displayed below for

> Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer;

[1] Empire State Building Company L.L.C. ("Original Opposer"), is no longer in existence and all of Original Opposer's rights and title to the pleaded registrations and common law trademarks were assigned to ESRT Empire State Building, L.L.C. ("Opposer"), as recorded in the Assignment Services Division of the United States Patent and Trademark Office (USPTO) at Reel/Frame Nos. 5139/0027 and 5136/0116. Accordingly, the Board granted Original Opposer's motion to substitute in an order issued on January 20, 2015.

> Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter

in International Class 32.[2]

The application includes the following description of the mark:

> The mark consists of a building resembling the Empire State Building surrounded by three concentric circles. The middle circle is wide and contains the wording "NYC BEER" in the interior. The circles are surrounded by a wreath with a wheat pattern. At the bottom is a banner with the term "LAGER" inside.

Pleadings

ESRT Empire State Building, L.L.C. ("Opposer") opposes registration of Applicant's mark on the grounds of dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c), false suggestion of a connection under Trademark Act

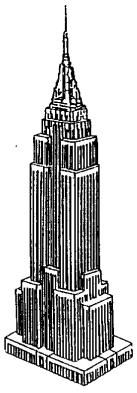
[2] Application Serial No 85213453 was filed on January 8, 2011, based upon Applicant's allegation of a bona fide intent to use the mark in commerce. "NYC BEER" and "LAGER" are disclaimed apart from the mark as shown. Color is not claimed as a feature of the mark.

Section 2(a), 15 U.S.C. § 1052(a) and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).[3]

Opposer claims ownership of two registrations issued on the Principal Register for the mark EMPIRE STATE BUILDING (standard characters, "BUILDING" disclaimed):

> Registration No. 2411972 for "entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing" in International Class 41;[4] and
>
> Registration No. 2413667 for "real estate services, namely the management and leasing of real estate" in International Class 36.[5]

Opposer also claims ownership of two registrations, issued on the Principal Register with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for the mark shown below:



[3] Opposer also asserted a claim that Applicant lacked a bona fide intent to use his mark in commerce, but did not pursue this ground at trial. Accordingly, it is deemed waived.

[4] Issued December 12, 2000. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

[5] Issued December 19, 2000. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

The registrations include the following description of the mark:

> The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top. The lining shown in the drawing is a feature of the mark and is not intended to indicate color.
>
> Registration No. 2429297 for "real estate services, namely the management and leasing of real estate" in International Class 36;[6] and
>
> Registration No. 2430828 for "entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing" in International Class 41.[7]

With regard to its claim of dilution, Opposer asserts that its marks are distinctive and famous; that its marks were distinctive and famous prior to Applicant's constructive first use date of January 8, 2001; and that registration of Applicant's mark will injure Opposer as a result of dilution by blurring of the distinctive qualities of Applicant's marks.[8]

Applicant, in his answer, denied the salient allegations in the notice of opposition except to the extent discussed below.

Evidentiary Matters

At the outset, we note that each party has filed objections against certain testimony and evidence introduced by its adversary. Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations,

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[6] Issued February 20, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

[7] Issued on February 27, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

[8] 24 TTABVUE 20.

and this precludes the need to strike any of the testimony and evidence. Given the circumstances herein, we choose not to make specific rulings on each and every objection. As necessary and appropriate, we will point out in this decision any limitations applied to the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. While we have considered all the evidence and arguments of the parties, we do not rely on evidence not discussed herein.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. The parties introduced the testimony and evidence identified below. In this decision, we will endeavor to discuss confidential testimony and evidence in general terms and only as necessary to support our determination.

A. Opposer's Evidence.

Testimony deposition of Applicant Michael Liang, taken March 13, 2015, and Exhibits 1 through 5.

Testimony deposition of Stacey-Ann Hosang, Opposer's Public Relations Manager, taken March 25, 2015 and Exhibits 6 through 62.

Testimony deposition of Crystal Persaud, Opposer's Legal Counsel, taken March 26, 2015 and Exhibits 63 through 83.

Testimony deposition transcript of Celeste Beatty, Owner of Harlem Brewing Company, taken March 27, 2015 and Exhibits 84 through 85.

Opposer's First Notice of Reliance upon Opposer's Registrations, dated March 30, 2015, consisting of current printouts from the electronic database records of the USPTO's Trademark Status and Document Retrieval ("TSDR") records, showing the current status and title (owner) of Opposer's pleaded registrations attached as Exhibit A.

Opposer's Second Notice of Reliance upon Official Records, dated March 30, 2015 consisting of Applicant's application and Petition to Revive Abandoned Application from the TSDR records for the involved application attached as Exhibit A.

Opposer's Third Notice of Reliance upon Internet Materials, dated March 30, 2015, and the following Exhibits:

(a) Exhibit A – printouts of various website pages available online with articles dated prior to January 8, 2011, concerning Opposer's EMPIRE STATE BUILDING Marks and/or the Empire State Building.

(b) Exhibit B – printouts of various website pages available online with articles dated after January 8, 2011, concerning Opposer's EMPIRE STATE BUILDING Marks and/or the Empire State Building.

(c) Exhibit C – printouts of various website pages available online with artwork available to purchase by the public depicting the visual equivalent of the Empire State Building.

(d) Exhibit D – printouts of various website pages available online with tourist and general information concerning Opposer's marks and/or the Empire State Building.

(e) Exhibit E – printouts of various website pages available online showing merchandise bearing Opposer's EMPIRE STATE BUILDING marks and images depicting the visual equivalent of the Empire State Building in connection with a variety of goods.

Opposer's Fourth Notice of Reliance upon Printed Materials, dated March 30, 2015, and the following Exhibits:

(a) Exhibit A – printed articles dated prior to January 8, 2011, concerning
Opposer's EMPIRE STATE BUILDING marks and/or the Empire State Building.

(b) Exhibit B – excerpts from books about and/or showing images depicting the visual equivalent of the Empire State Building.

Opposer's Fifth Notice of Reliance upon Applicant's Discovery Responses, dated March 30, 2015, and the following Exhibits:

(a) Exhibit A – Applicant's Response to Opposer's First Set of Requests for Admission Nos. 4, 5, 7 and 8.

(b) Exhibit B – Opposer's First Set of Interrogatories and Request for Production of Documents and Things, Interrogatory Nos. 1, 2, 4-6, 8-11, 13, 15 and 16 and Document Request Nos. 1-14, 17, 18, 20-23.

(c) Exhibit C – Applicant's Response to Opposer's First Set of Interrogatories and Request for Production of Documents and Things, Interrogatory No. 13 and Document Request Nos. 4, 14, 21, and 22.

(d) Exhibit D – Applicant's Amended Response to Opposer's First Set of Interrogatories and Request for Production of Documents and Things, Interrogatory Nos. 1, 2, 4-6, 8-11, 13, 15 and 16 (a typographical

error lists Response 16 as Response 10), and Document Request Nos. 1-14, 17, 18 and 20-23.

(e) Exhibit E – Applicant's e-mail response to Interrogatory No. 16 and attached document to Opposer's e-mail request to supplement Applicant's Amended Response to Opposer's Interrogatories.

Opposer's Rebuttal Notice of Reliance upon Official Records, dated July 8, 2015, consisting of a printout of information from the electronic database records of the USPTO, namely, the TSDR record, showing that the current status of the registration for the mark NY and Design, Reg. No. 1247058, is expired.

Opposer's Second Rebuttal Notice or Reliance upon Applicant's Discovery Responses, dated July 13, 2015, consisting of Applicant's Responses to Opposer's Request to Admit No. 3.

B. Applicant's Evidence.

Testimony deposition transcript of Applicant's friend, Xuefeng Yang, taken May 22, 2015, and Exhibits 1 through 6.

Testimony deposition transcript of Applicant Michael Liang, taken May 22, 2015 and Exhibits 7 through 8.

Applicant's First Notice of Reliance upon Official Records, dated May 27, 2015, and Exhibits A through C.

Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To establish standing in an opposition, an opposer must show both a real interest in the proceedings as well as a reasonable belief of damage. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson,* 50 USPQ2d at 1025.

In light of Applicant's admission in its answer[9] of Opposer's ownership of its pleaded registrations, and further in view of Opposer's pleading of a reasonable claim of likelihood of confusion, the Board, in a January 20, 2015 order otherwise denying Opposer's summary judgment motion, found no genuine issue regarding Opposer's standing.[10] Further, because Opposer established its standing with respect to its pleaded ground of likelihood of confusion, it has the right to assert any other ground as well, that also has a reasonable basis in fact. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 188.

Dilution by Blurring

Findings of Fact

The testimony and evidence establish the following:

> Opposer owns and operates the Empire State Building, a distinctively-styled art deco skyscraper featuring multiple setbacks, that was completed in 1931 and located in the heart of the City of New York;[11]
>
> For 40 years, the Empire State Building was the tallest building in the world, and presently is the fifth tallest building in the United States;[12]
>
> The Empire State Building has been featured in hundreds of motion pictures and television shows, including *King Kong*, *An Affair to Remember* and *Sleepless in Seattle*.[13]

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[9] 7 TTABVUE 3.

The citations to "TTABVUE" throughout the decision are to the Board's public online database that contains the proceeding file, available on the USPTO website, www.USPTO.gov. The first number represents the prosecution history number listed in the electronic case file and the second represents the page number(s).

[10] 41 TTABVUE 3.

[11] 66 TTABVUE 18-19 (confidential); 87 TTABVUE 15-26 (confidential).

[12] *Id.*

[13] 87 TTABVUE 15-26 (confidential).

The Empire State Building features a famous observation deck on its 103rd floor that is visited by millions of guests each year, including numerous celebrities, athletes and political figures.[14]

Numerous third parties seek licenses from Opposer to use its pleaded marks to advertise, promote and sell their goods and services, including a wide range of merchandise, television programs and motion pictures, all acknowledging Opposer's rights in its pleaded marks and providing source attribution for such use.[15]

For over 40 years, Opposer has provided lighting displays on the Empire State Building, alone and pursuant to licensing agreements with such partners as Reebok, Warner Brothers, ASPCA, NFL, Cartier, Mercedes-Benz, and Boy Scouts of America, and frequently feature celebrity lighting ceremonies attracting significant media attention.[16]

For over 30 years, a major New York radio station has broadcast from the top of the Empire State Building, and since September 11, 2001, nearly all of New York's commercial broadcast television and radio stations have transmitted from antennae located on the top of the building.[17]

Since 1931, Opposer and its predecessors in interest have used EMPIRE STATE BUILDING and the design thereof as marks in connection with a wide variety of goods and services.[18]

Since 1990, visitors to the Empire State Building exit through a licensed gift shop featuring such goods as apparel, glassware, candy, beverage holders, water bottles, toys, books, holiday ornaments branded with or sold under the EMPIRE STATE BUILDING mark and design mark displayed above.[19]

The Empire State Building gift shop sells non-alcoholic beverages as well as wine and champagne.[20]

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[14] *Id.*

[15] 66 TTABVUE 24-33 (confidential); 87 TTABVUE 15-26 (confidential).

[16] *Id.*

[17] *Id.*

[18] *Id.*

[19] *Id.*

[20] *Id.*

Opposer's pleaded marks appear on carpets, elevator interiors and exteriors, wall décor, signage, tickets, kiosks and brochures within the Empire State Building.[21]

Opposer's annual sales and advertising and promotional expenditures for Internet, magazine, newspaper, billboard and poster advertisements in connection with the Empire State Building and its pleaded marks are very significant.[22]

The Empire State Building and Opposer's goods and services under its pleaded marks have a strong social media presence, with 750,000 "likes" on Facebook, 70,000 followers on Twitter, and accounts on Pinterest, Yelp and Instagram, where a search of #empriestatebuilding displays over 650,000 photographs.[23]

Since 1931, the Empire State Building and Opposer's pleaded marks have received significant press and media coverage in such papers as *The Wall Street Journal*, *The New York Times*, *The Boston Globe* and *The Miami Herald*, and such television programs as *CNN Headline News*, *FOX News*, *Live! With Regis and Kelly* and *Good Morning America.*[24]

Articles and media references to the Empire State Building recognize the structure as an iconic, world-famous architectural and cultural landmark.[25]

Applicant acknowledges that the Empire State Building is famous.[26]

Applicant acknowledges that his "intention to put a – a – a building in there [his mark] that resembles the Empire State Building is simply because the – the building is – is such an emblem of New York City… ."[27]

Applicant's witness, Mr. Xuefeng Yang, acknowledges that the building displayed in Applicant's mark "It's the Empire State Building. It looks like Empire State Building. … Everything about it. With the … tapering roof, it looks like Empire State Building."[28]

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[21] *Id*.

[22] 87 TTABVUE 136-162.

[23] *Id*. at 167-179.

[24] *Id*. at 136-162.

[25] *Id*.

[26] *Id*. at 127.

[27] 94 TTABVUE 111.

[28] 94 TTABVUE 17-18.

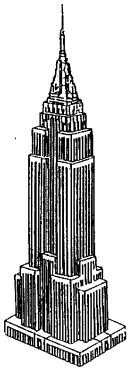
Analysis

The Trademark Act provides a cause of action for the dilution of famous marks. *See* Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c). Section 43(c) provides as follows:

> Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Opposer contends that Applicant's mark, displayed below, will dilute the distinctiveness of Opposer's marks.

For purposes of our analysis, we will concentrate our determination based upon Opposer's pleaded registrations for its design mark, displayed below.



The Trademark Act defines dilution by blurring as follows:

> "[D]ilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B). "Dilution diminishes the 'selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public.'" *Toro Co. v. ToroHead Inc.,* 61 USPQ2d 1164, 1182 (TTAB 2001) (internal citation omitted).

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has set forth the following four elements a plaintiff must prove in order to prevail on a claim of dilution by blurring in a Board proceeding:

> (1) that plaintiff owns a famous mark that is distinctive;
>
> (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
>
> (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
>
> (4) the defendant's use of its mark is likely to cause dilution by blurring.

Coach Services Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1723-4 (Fed. Cir. 2012) ("*Coach Services")*. In this case, the involved application is based on intent-to-use. As a result, Opposer's burden is to show that its mark became famous prior to the filing date or constructive use date of Applicant's application.[29] *Cf. Toro Co. v. ToroHead Inc.,* 61 USPQ2d at 1174 ("We hold that in the case of an intent-to-use application, an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding."). *See also Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.,* 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1294-5 (TTAB 2016); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2024 (TTAB 2014).

Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner. *See e.g.*, *National Pork Board v. Supreme Lobster and Seafood Co.,* 96 USPQ2d 1479 (TTAB 2010). In addition, we must determine not only whether there is an 'association' arising from the similarity of the marks, but

[29] With regard to the second factor, Applicant has not commenced use of his mark in commerce. However, in a Board *inter partes* proceeding, a plaintiff that establishes its ownership of a distinctive and famous mark may prevail upon a showing of likelihood of dilution against a Section 1(b) application, even though the plaintiff cannot show actual dilution. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1174 ("an application based on an intent to use the mark in commerce satisfies the commerce requirement of the [Federal Trademark Dilution Act] for proceedings before the Board.").

whether such association is likely to 'impair' the distinctiveness of the famous mark. *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011) ("*Nike v. Maher*").

The Alleged Fame of Opposer's Design Mark Prior to January 8, 2011

Applying the first and third *Coach* elements to this proceeding, Opposer must show that the mark comprising the design of the Empire State Building became famous before the January 8, 2011 filing date of the involved intent-to-use application, inasmuch as there is no evidence that Applicant is entitled to an earlier constructive use date.

It is well-established that dilution fame is different from fame for likelihood of confusion purposes, and the burden of proof is significantly more difficult. *Coach Services, Inc.,* 101 USPQ2d at 1713 ("Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.") Indeed, "[i]t is well-established that dilution fame is difficult to prove." *Id.* at 1724. Also, in contrast to likelihood of confusion fame, dilution fame is not determined in the context of a certain field of goods or services; rather, the party asserting dilution fame of its mark "must show that, when the general public encounters the mark 'in almost any context, it associates the term, at least initially, with the mark's owner." *Id.* at 1725. In other words, a famous mark is one that has become a "household name." *Id.*

The statute sets forth the following four factors for determining whether a mark is famous for dilution purposes:

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

or third parties.

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

iii. The extent of actual recognition of the mark; and

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

15 U.S.C. § 1125(c)(2)(A). *See also*, *New York Yankees Partnership v. IET Products and Services, Inc.,* 114 USPQ2d 1497, 1502 (TTAB 2015); *McDonald's Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1286 (TTAB 2014).

With respect to the first factor, Opposer has used the mark comprising the design of the Empire State Building since 1931. This mark has received considerable public exposure through Opposer's advertising and mentions in national media. Opposer has spent very significant sums on advertising since then, including the placement of the mark. Opposer's activities under its mark, including the operation of its world-famous observation deck, which has been featured in several iconic movies and received millions of visitors each year, its wide range of branded products and services under its marks, its co-sponsored celebrity lighting ceremonies, its licensing of its mark to third parties with full attribution, and more recently, its strong social media presence, have garnered strong recognition of its mark since at least the 1980s to 1990.

With respect to factor two, Opposer's revenues under its mark is also very significant. Visitors from around the world visit the Empire State Building every day, and are exposed to multiple uses of Opposer's mark on everything

from tickets to uniforms to gift items to decorations for the building itself. Opposer's observation deck receives daily visits from visitors worldwide, and is frequented by numerous celebrities from music, film, sports and governments.

As to the third factor, Opposer's mark regularly receives extensive media exposure in print, radio, television and the Internet.

Finally, with respect to the fourth factor, Opposer owns its two pleaded registrations for its design mark, issued on the Principal Register.

Upon consideration of the four factors and the record before us, we find that Opposer's design mark became famous for dilution purposes well prior to 2011.

Likelihood of Applicant's Mark to Cause Dilution by Blurring

The Trademark Act enumerates six non-exhaustive factors a court or tribunal may consider in determining whether a mark is likely to cause dilution by blurring:

> i. The degree of similarity between the mark or trade name and the famous mark.
>
> ii. The degree of inherent or acquired distinctiveness of the famous mark.
>
> iii. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
>
> iv. The degree of recognition of the famous mark.
>
> v. Whether the user of the mark or trade name intended to create an association with the famous mark.
>
> vi. Any actual association between the mark or trade name and the famous mark.

Section 43(c)(B)(i)-(vi).

In applying and weighing these factors, we find it is likely that Applicant's mark will cause dilution by blurring of Opposer's design mark. With regard to the first factor, Applicant's involved mark prominently features, as indicated in the description of the mark, "a building resembling the Empire State Building." While Applicant asserted in his testimony that the design could be of another building,[30] his assertions are belied by the description of his mark in his application. Furthermore, there is no evidence of record to suggest that the building depicted in Applicant's mark could be other than the Empire State Building displayed in Opposer's design mark. Applicant's witness, Mr. Yang, unequivocally stated that the building in Applicant's mark is the Empire State Building. While Applicant's mark includes additional wording and design elements, these do not serve to diminish the similarity of the building design therein to Opposer's design mark.

With regard to the second factor, there is nothing in the record to suggest that Opposer's design mark lacks inherent distinctiveness. Furthermore, even if we were to find that Opposer's design mark lacks inherent distinctiveness, the record is replete with evidence that the mark has acquired distinctiveness due to Opposer's long use, promotional efforts, and unsolicited media recognition.

Moreover, taking into account the third factor above, the record shows that Opposer is engaging in 'substantially exclusive' use of its mark. Although Applicant has relied upon a third-party registration consisting in part of the

[30] 94 TTABVUE 98-104.

design of the Empire State Building, such registration was cancelled in 2014 and lacks any significant probative value.[31] Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration expired. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973). There is no other evidence of record to suggest that Opposer's use of its design mark is not "substantially exclusive."

With respect to the fourth factor, we have no direct evidence, *e.g.*, a survey, showing a level of recognition of Opposer's mark. However, Opposer's evidence of strong and consistent mention in printed, radio, television and Internet media, as well as its popularity on various social media, suggest that Opposer's mark has attained a significant level of recognition. Certainly, some of this media attention involves the Empire State Building itself, contrasted with Opposer's mark and the goods or services offered thereunder. However, Opposer's evidence of its efforts in branding, co-sponsorship, and licensing use of its design mark to third parties with attribution, support its efforts to create and maintain recognition not only of the Empire State Building, but of its activities under its mark related thereto.

With regard to the fifth factor involving an intention to create an association with the Opposer's mark, the evidence is insufficient to support a finding that Applicant is intentionally attempting to associate his mark with Opposer's mark.

[31] 51 TTABVUE 5-15.

Finally, as to the sixth factor, there is no evidence of actual association between Applicant's mark and Opposer's design mark, particularly given that Applicant has not yet commenced use of his mark.

Dilution by Blurring – Conclusion

After considering all of the evidence of record in regard to the Section 43(c) false suggestion of a connection factors, we find that Applicant's mark is likely to cause dilution by blurring of Opposer's mark. We find in particular that Opposer's mark is famous for purposes of dilution, that its mark is inherently distinctive or, if not, have acquired distinctiveness through Opposer's efforts, that Opposer is engaging in substantially exclusive use of its mark, and that its efforts suggest a strong degree of recognition for its mark. While we find the evidence does not support a finding that Applicant intended to create an association with Opposer's mark, or that there has been any opportunity for actual association, these factors are insufficient to overcome a finding of dilution in this case.

Because we have found Applicant's mark dilutes by blurring Opposer's design mark, we need not analyze Opposer's claims that Applicant's mark is likely to cause confusion with the marks in Opposer's pleaded registrations, or create the false suggestion of a connection with Opposer.

Decision: The opposition is sustained and registration to Applicant is refused.