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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Crazy Horse Memorial Foundation

v.

Frank B. Spencer

Opposition No. 91204980
to application Serial No. 77557722
filed on August 28, 2008

Linda M. Byrne of Crawford Maunu for The Crazy Horse Memorial Foundation.

Jay F. Moldovanyi and John Zanghi of Fay Sharpe for Frank B. Spencer.

Before Quinn, Wellington and Mermelstein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Frank B. Spencer ("applicant") filed an application to register the mark CRAZY HORSE (in standard characters) for "online adult entertainment services, namely, providing a website featuring pictures and information in the field of exotic dancing, and featuring articles and stories dealing with adult themes; adult entertainment services, namely, exotic dancing performances" in International Class 41. Applicant

alleges first use anywhere and first use in commerce of the mark in 1978.

The Crazy Horse Memorial Foundation ("opposer") asserts that its CRAZY HORSE marks have been used since 1949, and that the mark is famous for goods and/or services in the fields of education, culture, and entertainment. As grounds for opposition, opposer further alleges that applicant's mark, when used in connection with applicant's services, so resembles opposer's previously used and registered marks shown below for its goods and/or services as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).



for

providing an educational and cultural exhibition in the nature of a carved mountain monument (in International Class 41);¹ and

CRAZY HORSE (in standard characters)

for

series of pre-recorded video tapes featuring a mountain monument, magnets and decorative

¹ Registration No. 2382778, issued September 5, 2000; renewed. The registration includes the following description of the mark: "The mark consists in part of a silhouette of an American Indian on horseback."

refrigerator magnets (in International Class 9);

sculptures of stone (in International Class 19);

giftware of plaster, ceramic, porcelain, leather, stone and wood, namely, decorative plates, decorative mugs, paper weights, decorative boxes (in International Class 21);

charitable fund raising services for the creation, construction and preservation of a carved mountain monument (in International Class 36); and

providing an educational and cultural exhibition in the nature of a carved mountain monument (in International Class 41).²

Opposer further claimed prior common law rights in its CRAZY HORSE mark for various services rendered in connection with its monument complex. Opposer also alleges a claim of dilution by tarnishment of its marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

Applicant, in his answer, essentially denied the allegations in the notice of opposition. Applicant also asserted the "Morehouse defense"³ based on his ownership of an existing incontestable registration, specifically a registration for CRAZY HORSE (in standard characters) for "entertainment services, namely, exotic dance performances."

² Registration No. 2508515, issued November 20, 2001; renewed.

³ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

The parties filed, on November 15, 2012, a proposed stipulation for adoption of "accelerated case resolution" ("ACR") procedures in this case. The Board, on November 26, 2012, approved the stipulation.⁴ As a result, the parties' agreed approach to trial of the pleaded claims and defenses was more limited, in regard to the methods for introducing testimonial evidence, than otherwise permitted by the rules; but the parties were under no restrictions as to the amount of testimonial evidence they could introduce. The record comprises the pleadings; the file of the involved application; declaration testimony, with related exhibits, taken by each party; excerpts of printed publications; official records; responses (including documents) to discovery requests; and various other documents. Both parties filed briefs on the case.⁵

Before turning to the substantive merits of this litigation, we first discuss the scope of this proceeding. Opposer, in its original pleading and accompanying cover sheet,

⁴ Information regarding ACR may be found in Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 528.05(a)(2), 702.04 and 705 (2013), and the ACR & ADR section of the Board's internet webpage at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

⁵ The Board, on October 19, 2013, granted the parties' motion to file briefs in excess of the page limit, although noting at the same time that "one premise underlying ACR is that the Board may issue ACR decisions within fifty days of briefing, faster than usual, because the ACR briefing is more limited, so the Board has less to review before issuing its decision." Opposer also filed a reply brief. Applicant then filed a paper captioned "Rebuttal Brief." There is no provision for filing such brief by a party in the position of defendant. See TBMP § 801.02(d). Accordingly, applicant's sur-reply brief is stricken and we have not considered it.

as well as in its amended pleading (accepted by the Board on Nov. 26, 2012), pleaded the two issues identified above, namely likelihood of confusion and dilution. The pleading did *not* mention any claim of disparagement under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

In its brief at final hearing, opposer attempts to interject for the first time a claim of disparagement under Section 2(a). In the section of the brief devoted to its dilution claim, opposer sets forth the following sub-heading: "Applicant's Trademark Disparages the Foundation and Native Americans." (Brief, p. 38). Applicant, in its brief, did not make any reference to a claim of disparagement under Section 2(a). Opposer, in its reply brief, is entirely silent as to any claim of disparagement under Section 2(a).

It is well settled that an opposer, in briefing the case, may not rely on an unpleaded claim, and that to be able to do so the opposer's pleading must be amended, or deemed amended, pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the claim. *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008). Opposer never formally offered an amendment to its pleadings to assert a claim of disparagement under Section 2(a). Thus, the only way for the Board to consider a disparagement claim under Section 2(a) at this stage would be if the trial record supports an effective amendment under Fed. R. Civ. P. 15(b). When an

issue not raised by the pleadings is tried by the parties' express or implied consent, the Board will treat it in all respects as if raised in the pleadings. Fed. R. Civ. P. 15(b)(2).

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. Fairness considerations are paramount in assessing whether an issue has been tried by implied consent - there must be an absence of doubt that the non-moving party is aware that the issue is being tried. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011).

In the present case, we find that there was no trial, either expressly or impliedly, of any disparagement claim under Section 2(a). Applicant was never put on notice of this unpleaded claim before or at the trial stage. In this regard, we readily acknowledge that opposer's testimony included statements that applicant's mark is disparaging to opposer. However, the testimony relating to disparagement easily could be interpreted as going to the pleaded claim of dilution by tarnishment, which involves reputational harm. Indeed, in its brief, even opposer makes the mistake of conflating Section 2(a)

disparagement with dilution by tarnishment. Accordingly, we cannot fault applicant's silence in not objecting to opposer's evidence that opposer may believe provides equal support for both such claims, but which applicant may only have considered to be a presentation of evidence of tarnishment.⁶ Under such circumstances, we also cannot say that applicant was fairly apprised that the evidence was being introduced in support of an unpleaded disparagement claim under Section 2(a), rather than in support of the pleaded claim of dilution by tarnishment.⁷ See, e.g., *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony which related to an existing claim and was not fairly apprised that the evidence was being offered in support of an unpleaded claim). To allow amendment at this late juncture would result in prejudice to applicant. Given that there was no presentation of testimonial evidence by deposition under the agreed provisions for trying this case, we find that the situation arising under Fed. R. Civ. P. 15(b) should be particularly scrutinized. The parties agreed to present their direct testimony by declaration rather than deposition, with no cross-examination. Thus, there

⁶ Further, we note that the parties' ACR stipulation (¶¶ 7-8) provides that neither party will object to the testimony, nor will challenge the propriety of the actions of the other party's attorney, or make any motion or argument related to the appropriateness of an attorney's representation.

⁷ Opposer also did not raise any claim that applicant's mark falsely suggests a connection with it under Section 2(a). See *In re Kent Pedersen*, 109 USPQ2d 1185 (TTAB 2013).

was no cross-examination of the witnesses whose testimony forms the basis of opposer's late attempt to assert a disparagement claim. Given the manner in which declaration testimony is often introduced,⁸ a Fed. R. Civ. P. 15(b) motion should be allowed in only the rarest of cases.

In view of the above, we will decide the following issues specifically identified by both of the parties: applicant's *Morehouse* defense; and opposer's claims of priority and likelihood of confusion, and dilution. So as to be clear, no further consideration will be given to any disparagement claim under Section 2(a).

THE PARTIES

Opposer

The record shows that Tasunke Witco, popularly known as "Crazy Horse," was an Oglala Lakota leader who lived in the mid-nineteenth century (1842-1877). He was considered to be a person of great moral character, spending much of his life protecting the cultural ways and dignity of his people. (Opposer's response, Interrogatory No. 11).

In 1937, Lakota tribal leaders approached Korczak Ziolkowski to carve a mountain monument in the Black Hills of South Dakota as a tribute to North American Indians, and in

⁸ Parties may reserve the right to conduct in person cross-examination of witnesses providing the declaration testimony, as may be needed, but the parties herein agreed to refrain from any cross-examination.

particular to honor Crazy Horse. Mr. Ziolkowski began to carve the monument in 1947, being assisted by his wife and children. Over 65 years later, the monument remains under construction.

Opposer is a non-profit, educational and cultural foundation, founded by the Ziolkowski family, which seeks to foster better understanding among races; opposer is supported by admissions to its mountain monument complex and through donations. Opposer's complex at the monument includes the Indian Museum of North America, the Indian University of North America, a theater, a restaurant and a gift shop.

Ruth Ziolkowski, opposer's president and chief executive officer for over 30 years (and widow of Korczak Ziolkowski), in her declaration testimony, gives the most detailed account of opposer and its various activities. She explained opposer's Mission Statement:

The mission of Crazy Horse Foundation is to protect and preserve the culture, tradition and living heritage of the North American Indians. The Foundation demonstrates its commitment to this endeavor by continuing the progress on the world's largest sculptural undertaking by carving a memorial of Lakota leader Crazy Horse; by providing educational and cultural programming; by acting as a repository for American Indian artifacts, arts and crafts through the Indian Museum of North America and the Native American Educational & Cultural Center; and by establishing and operating the Indian University of North America and, when practical, a medical training center for American Indians.

(dec., ¶ 10).

In pertinent part, Ms. Ziolkowski also testified as follows:

The Foundation has provided many services since at least as early as 1949, including cultural exhibition, educational, entertainment, online, and dancing performance services. The Foundation's range of services has consistently expanded over the years between 1949 to the present.

My husband, Korczak Ziolkowski, began the massive undertaking of creating a mountain monument in 1947 at the invitation of Dakota Indian chiefs. In order to honor Native Americans, the Indians chose to depict Crazy Horse, a proud warrior.

The Foundation began its work to honor Native Americans at least as early as 1948. This work included building and creating a mountain monument...

Over the years, the Foundation has provided many types of entertainment services, including dance performances. Dance performances have taken place at the CRAZY HORSE complex since at least as early as the CRAZY HORSE dedication ceremony, which took place on June 3, 1948.

Construction of a combination museum, studio and home began in 1948, with public tours beginning in at least as early as 1949... The Foundation began to provide restaurant services in 1984.

Over the years, the Foundation has provided entertainment and cultural services, including dancing, to commemorate special events. For example, since 1990, the second Monday in October has been celebrated by the Foundation as Native American Day in South Dakota, with this annual celebration including dance performances.

For many years before 1978, the Foundation has provided many types of entertainment services, including dance performances, museum services, educational services, as well as special events such as guest artists, films, musical, storytelling and other live performances, lectures, ceremonies and celebrations.
(dec., ¶¶ 3-8).

Opposer's myriad of activities also includes sponsorship of journalism workshops, teacher seminars, hosting of field trips and granting of scholarships.

Opposer promotes its mountain monument complex as a tourist destination, and Ms. Ziolkowski confirmed that opposer's complex receives over 1.3 million visitors each year. Opposer promotes its services in national printed publications and on television, as well as through internet websites. Ms. Ziolkowski asserts that applicant's mark "is disparaging to the good will and fine reputation of the Foundation." (dec., ¶ 25).

Rollie Noem, opposer's administrative vice president, in his declaration, offers additional details about opposer and its various activities. The most pertinent facts are as follows. Opposer operates a carved mountain monument, cultural center and museum; opposer's services include performances of Native American dancing, ceremonies and celebrations; in this connection, opposer conducts charitable fund raising activities for the creation, construction and preservation of a carved mountain monument. Opposer has hosted many events, celebrations

and community activities relating to Native Americans. Opposer provides a website featuring pictures and information in the fields of Native American dancing and history. Opposer also offers education services regarding Native American history and culture to a wide range of ages, from grade school to the university level, and has provided educational scholarships to hundreds of students. Opposer offers restaurant services at its monument complex. Opposer also provides DVDs on the history and culture of Native Americans. According to Mr. Noem, opposer "has provided some of these services since at least as early as 1949" and that the "range of services has consistently expanded over the years." (dec., ¶ 4). Mr. Noem's declaration testimony focused on opposer's entertainment services that include Native American dance performances which, according to Mr. Noem, opposer has provided under the mark since 1949. Opposer's newsletters have featured photographs and articles about dance performances hosted by opposer. During the warm weather months, opposer's complex hosts daily outdoor dance performances for visitors, many of which appear in videos posted on the internet. Opposer features its CRAZY HORSE mark in a variety of promotional materials, including brochures, calendars, catalogs, printed publications, postcards, posters, videos, menus and on the internet. Given Mr. Noem's knowledge of the travel industry, he contends that opposer's services "are the subject

of significant renown, fame and good will." (dec., ¶ 10). In this connection, Mr. Noem relies upon numerous articles appearing in a variety of printed publications which discuss opposer's services. Opposer promotes its services on national television programs, at trade shows, videos, You Tube videos, with opposer spending "many thousands of dollars over the years." (dec., ¶ 18).

The record includes other testimonial declarations. Dr. Laurie Becvar, the Senior Associate Provost Graduate Dean at the University of South Dakota, testified that "Crazy Horse" is "the name of a beloved Lakota leader who serves as a role model for many Americans, symbolizing strength, bravery and integrity." (dec., ¶ 3). According to Dr. Becvar, she "believe[s] that the public associates 'CRAZY HORSE' with that Lakota leader and/or with the monument that is being created to honor him and all Native Americans," and that applicant's mark is disparaging to opposer's reputation, contrary to opposer's mission of honoring Native Americans. (dec., ¶¶ 3-4). Dr. Becvar goes on to state that "[o]ver the years, some people of Native American descent have struggled with the challenges of alcoholism and domestic abuse," further opining that "especially in light of these challenges, Applicant's use and registration of 'Crazy Horse' for [applicant's services] is disparaging and tarnishes the good will of the Lakota leader and [opposer]." (dec., ¶ 5).

Donald Montileaux, an artist and author who is a member of the Oglala Lakota Tribe, the same heritage as the Lakota leader Crazy Horse, makes almost identical assertions regarding applicant's mark. The same goes for Lula Red Cloud, an artist and artisan who is a member of the Oglala Lakota Tribe, and who is the great, great granddaughter of Chief Red Cloud of the same tribe.

Dr. Laurel Vermillion is president of Sitting Bull College in North Dakota and is a member of opposer's board of directors. Dr. Vermillion is of Lakota descent, and further echoes the view that "the public associates 'CRAZY HORSE' with the Lakota leader and/or with the monument that is being created to honor him and all Native Americans" (dec., ¶ 4), and that applicant's mark for its services is disparaging to opposer.

Likewise, Monsignor William O'Connell, founder of Catholic Social Services in South Dakota, and a member of opposer's board of directors, makes similar allegations. Monsignor O'Connell chronicles many of opposer's good works, including hosting events to bring attention to issues such as autism and diabetes. Monsignor O'Connell states, based on his experience, that "the public associates CRAZY HORSE with the Lakota leader and/or with the monument that is being created to honor him and all Native Americans," and that "especially in light of the unique challenges of Native people," applicant's use and registration

of its mark for adult entertainment services "is disparaging and tarnishes the good will of the Lakota leader and [opposer]."

(dec., ¶¶ 6-7).

Nort Johnson, President and CEO of the Black Hills Badlands & Lakes Tourism Association in South Dakota, states that the Crazy Horse monument and museum "are a top tourist attraction, providing a wholesome, family-friendly destination." (dec., ¶ 4) Mr. Johnson states that over 1.3 million people visited the Crazy Horse complex in 2012, and that this number will increase in future years. According to Mr. Johnson, visitors come from every state, as well as from many foreign countries; opposer provides many valuable educational and cultural services; and the public associates "CRAZY HORSE" with the Lakota leader and/or with the monument that is being created to honor him and all Native Americans. Mr. Johnson believes that applicant's mark for online adult entertainment services "is disparaging to the good will and fine reputation of [opposer], contrary to [opposer's] mission of honoring Native Americans." (dec., ¶ 8).

While the details are unimportant, the record also includes evidence from applicant about a degree of controversy surrounding opposer's monument complex and opposer's activities related thereto. Some within the Lakota and Native American communities have opposed the memorial for various reasons,

ranging from the monument's construction on sacred tribal burial land to the perceived attempts by opposer to usurp the identity of Native American culture for personal gain. This information is irrelevant to the trademark issues before us.

Applicant

Applicant, either individually or through related companies that he owns or controls, has been continuously doing business under the mark CRAZY HORSE since 1978 in connection with "gentlemen's clubs" or strip clubs providing adult entertainment. Applicant also has operated since 1995 a website featuring adult entertainment services and "adult-oriented" products. In 2010, one of applicant's related entities obtained through an assignment Registration No. 3044028 (issued January 17, 2006; combined Sections 8 and 15 affidavit accepted and acknowledged) of the mark CRAZY HORSE in standard characters for "entertainment services, namely, exotic dance performances" in Class 41.⁹

Applicant also claims ownership of the following registrations: Registration No. 3055283 (issued January 31, 2006; combined Sections 8 and 15 affidavit accepted and

⁹ Opposer, in its brief, contends that the assignment is invalid and that applicant "has no valid rights in the CRAZY HORSE trademark by virtue of the '028 registration." (Brief, p. 17). It does not appear that opposer ever sought to cancel the registration on this basis, and this issue is inappropriate for consideration in the context of this opposition proceeding. In any event, the registration and any rights therein held by applicant are not material to determination of the merits of opposer's pleaded claims.

acknowledged) of the mark PURE GOLD'S CRAZY HORSE (in standard characters) for "exotic dancing services" in Class 41; and Registration No. 2069552 (issued June 10, 1996; renewed) for the mark shown below



for "adult entertainment in the nature of exotic female performers" in Class 41, and "restaurant, night club, and tavern services" in Class 42. Applicant further owns a pending application (now suspended), namely Serial No. 85217717 to register the mark CRAZY HORSE (in standard characters) for "restaurant, night club, tavern and cocktail lounge services" in Class 42. Applicant has branded these services with the idea that the mark CRAZY HORSE portrays the personification of a wild animal.

Applicant also has owned since 1995 the domain name <crazyhorse.com> which applicant uses to promote his services; applicant owns over fifteen other similarly named websites (e.g., <crazyhorseclevelandoh.com>).¹⁰ According to Mr. Spencer, the mark CRAZY HORSE is "one of the most recognizable names in the adult entertainment industry." (dec., ¶ 8). Applicant owns

¹⁰ The parties' rights in their respective domain names are beyond the jurisdiction of the Board.

and operates under the mark two gentlemen's clubs in Ohio, and franchises and licenses the mark to a saloon in Ohio, two clubs in North Carolina and one club in South Carolina. Applicant promotes his services in newspapers, magazines and trade journals, as well as through signage on buses, posters and handouts. Applicant has been attempting to expand the geographical reach of his services, including searching for a suitable location in Las Vegas.

With this background we turn to the claims and defenses at issue. We consider first the *Morehouse* defense because, if the defense is found to be well-taken, it would essentially bar opposer's claims.

MOREHOUSE DEFENSE

Crazy Horse Consulting Inc. ("CHC") owns Registration No. 3044028 of the mark CRAZY HORSE (in standard characters) for "entertainment services, namely, exotic dance performances" in International Class 41.¹¹ Applicant argues that opposer cannot be damaged by allowing the present application to register because the applied-for mark is identical to the registered

¹¹ The registration issued on January 17, 2006; combined Sections 8 and 15 affidavit accepted and acknowledged. We assume, for consideration of this defense, that the registration is valid and subsisting, contrary to the gist of some of opposer's contentions. See, n.9, *supra*.

mark, and the registration covers identical or substantially the same services to those recited in the application.¹²

We initially note that Office records show the current owner of the registration as "Crazy Horse Consulting Inc." Applicant states that CHC is "my wholly owned licensing entity." (Spencer dec., ¶ 13). Opposer did not object to the defense on this basis, and we find that the discrepancy in ownership of the registration and application, as reflected by Office records, is explained by applicant's declaration testimony.

In any event, we find that the defense is lacking on its merits.

The *Morehouse* defense is an equitable affirmative defense which, in appropriate circumstances, may be asserted by a defendant/applicant in an *inter partes* proceeding. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 160 USPQ at 717. It is based on the principle that "[a]n opposer cannot be 'damaged' within the meaning of Lanham Act §13 by registration of a mark for particular goods or services if applicant owns an existing registration for the same or substantially identical mark for the same or substantially identical goods." J.T. McCarthy,

¹² Opposer, in its reply brief (p. 4, n.1), stated: "If the Board disagrees with the [opposer's] analysis and finds the *Morehouse* defense applies to some of the services in the opposed application, the [opposer] requests that the Board allow the opposed application only with respect to the services listed in the '028 registration: 'entertainment services, namely, exotic dance performances.'" *But see Trademark Manual of Examining Procedure* ("TMEP") § 703 (2013) ("USPTO Does Not Issue Duplicate Registrations).

McCarthy on Trademarks and Unfair Competition, § 20:38 (4th ed. 2011). See *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); *Green Spot (Thailand) Ltd. v. Vitasoy International Holding Ltd.*, 86 USPQ2d 1283 (TTAB 2008); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203 (TTAB 2006), *aff'd*, (Appeal Nos. 06-1366, 1367, Fed. Cir., Dec. 6, 2006). The *Morehouse* defense has been found to be available against not only likelihood of confusion claims, but also against dilution claims. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1651-53 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

Applicant's applied-for mark and registered mark are identical; both marks consist of CRAZY HORSE in standard character form.

The focus of the dispute regarding the applicability of the defense centers on the recitation of services as set forth in the pending application and applicant's prior registration. The *Morehouse* defense requires that the goods and/or services in the prior registration and the services in the involved application be the same or substantially the same. If the goods and/or services are different, "it cannot be said ... that there would be no *added* damage to opposer from [applicant's] proposed registration." *Jacks-Evans Mfg. Co. v. Jaybee Mfg. Corp.*, 481 F.2d 1342, 179 USPQ 81, 83 (CCPA 1973) (emphasis in original).

The recitation in the prior registration reads "entertainment services, namely, exotic dance performances" in International Class 41; the recitation in the application reads "online adult entertainment services, namely, providing a website featuring pictures and information in the field of exotic dancing, and featuring articles and stories dealing with adult themes; adult entertainment services, namely, exotic dancing performances" in International Class 41.

The application now includes additional services, that is, "online adult entertainment services, namely, providing a website featuring pictures and information in the field of exotic dancing, and featuring articles and stories dealing with adult themes." Although the additional on-line adult entertainment services may be related, commercially or otherwise, to the exotic dance performance services, these services are not the same or substantially the same as those in the prior registration. *See Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972). More specifically, although the online services and the exotic dancing services may fall under the broad umbrella of adult entertainment services, the present application includes services different from and additional to the ones listed in the registration. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d at 1652-53. It cannot be said that opposer

would not suffer added damage from applicant's proposed registration if there is in fact likelihood of confusion or dilution by tarnishment. See *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 1500 (TTAB 1986) (Morehouse defense not applicable even though goods in the application and prior registration were, in part, identical, or otherwise closely related, because the application included goods different from the goods listed in the prior registration); *Liberty & Co., LTD. v. Liberty Trouser Co., Inc.*, 216 USPQ 65, 68 (TTAB 1982) (the prior registration defense is not applicable where the goods and/or services in the prior registration are narrower in scope than the goods and/or services in the challenged application).

Accordingly, applicant's *Morehouse* defense fails, and will not shield applicant from opposer's claims, if proven. We next turn our attention to the merits of the notice of opposition.

STANDING

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made of record its pleaded registrations of its CRAZY HORSE marks; in addition, opposer demonstrated its use of the marks. Thus, opposer has shown that it is not a mere intermeddler. Opposer's use and/or registration of its mark establish that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000);

Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

PRIORITY

In view of opposer's ownership of valid and subsisting registrations of its CRAZY HORSE marks, opposer's priority is not in issue with respect to the registered marks for the goods and/or services identified in those registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, based on its registrations, there is no issue regarding opposer's priority of the marks shown below on the identified goods and services:



for "providing an educational and cultural exhibition in the nature of a carved mountain monument"; and

CRAZY HORSE (in standard characters)

for "series of pre-recorded video tapes featuring a mountain monument, magnets and decorative refrigerator magnets"; "sculptures of stone"; "giftware of plaster, ceramic, porcelain, leather, stone and wood, namely, decorative plates, decorative mugs, paper weights, decorative boxes"; "charitable fund raising services for the creation, construction and preservation of a

carved mountain monument"; and "providing an educational and cultural exhibition in the nature of a carved mountain monument."

Further, opposer has relied upon certain common law rights in its CRAZY HORSE marks for goods and services in addition to those identified in the pleaded registrations. With respect thereto, opposer must show that it has priority by a preponderance of the evidence. *Hydro-Dynamics Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Common law rights exist by virtue of use of the mark in connection with specific goods and services and exist independent of registration rights.

Opposer's record establishes its prior common law use of its marks on a variety of goods and services, *all offered in connection with and related to its monument complex dedicated to honoring Native Americans*. These services include, in pertinent part, cultural, exhibition, educational and entertainment services (e.g., live, in-person performances, tours, lectures), museum services, and Native American dance performance services, as well as use in connection with printed publications (e.g., newsletters).

With respect to online services, opposer's website launched in 2000 (<crazyhorse.org>), while applicant's website launched in 1995 (<crazyhorse.com>). Thus, as is apparent from the manner in which opposer litigated this case, opposer focuses its

priority with respect to certain services, but not including its online services. So as to be clear, applicant was the first party to use its mark in connection with online website services; however, we must still determine whether a likelihood of confusion exists based on opposer's prior rights in any of its goods or services (other than opposer's online services) vis-à-vis the services recited in the application, including applicant's online website services.

LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In any likelihood of confusion analysis, however, two key considerations are 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, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us, are discussed below.

Fame

We begin with the *du Pont* factor of fame, on which opposer has placed significant weight. Fame of the prior mark plays a

dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Because of the extreme deference accorded to 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 fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Ruth Ziolkowski testified as follows:

Based on my daily interactions with people around the world, it is my opinion that the Foundation's CRAZY HORSE services have a significant degree of renown, fame and good will. This is based upon the fact that the Foundation's CRAZY HORSE services have received significant attention in a variety of nationwide media, including personal visits, newspapers and magazines, online media, and television programs.
(dec., ¶ 26).

Monique Ziolkowski, an employee of opposer (and daughter of Ruth Ziolkowski), testified as follows:

I have personally interacted with many people around the world in connection with the CRAZY HORSE mission, including President

Bill Clinton, Pope John Paul II, and many visitors from across the U.S. and around the world. In my experience, the Foundation's CRAZY HORSE services have a significant degree of renown, fame and good will. (dec., ¶ 10).

Opposer's proof of fame includes use of the mark since 1949, and the fact that over 1.3 million people visit its monument complex annually. Opposer, in response to Interrogatory No. 8, identifies its marketing expenditures for 2012 and, in response to Interrogatory No. 9, opposer sets forth its revenue for 2012. These are the only figures relating to opposer's sales and advertising.¹³ The numbers for 2012 are designated as "confidential"; if we were able to set forth the numbers in this decision, it would be obvious that they fall far short of the numbers upon which fame has been found in prior cases. See, e.g., *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1306 and cases cited therein. In this connection, we fail to understand opposer's contention that the sales and advertising figures *for only one year* are comparable to the figures in other cases involving a famous mark, which generally reveal sales and advertising over several years.

Opposer also states that its services are publicized at many travel and tourism trade shows across the United States, as

¹³ In its reply brief (p. 7), opposer erroneously asserts that it has furnished sales and advertising data for the years 2008-2012. This is incorrect as only numbers relating to its business in 2012 are of record. Thus, we share applicant's bewilderment on opposer's reliance on Exhibit Nos. 77-78, which relate to applicant's revenue data.

well as through national media, including television programs, magazines (e.g., People) and newspapers (e.g., The New York Times). Opposer's monument complex has garnered travel awards. According to opposer, it enjoys a "strong relationship" with a "wide variety of Native Americans, as exemplified by countless articles, spiritual ceremonies, resolutions of different tribes, letters from scholarship recipients, etc." (Brief, p. 34).

Although opposer's mark has been in use for over 60 years, and opposer receives more than 1.3 million visitors each year, we are unable to effectively gauge the degree of exposure of the mark and any consequential recognition among relevant purchasers. The only direct declaration testimony on this point comes from opposer's own witnesses, all of whom have a connection with opposer and its activities. These witnesses merely offered conclusory opinions about fame among consumers, without any probative and corroborating evidence from consumers themselves. That is to say, the declaration testimony of these witnesses is merely opinion and the witnesses have not been established as competent to testify as to what others think about the fame of opposer's mark CRAZY HORSE.

We have little doubt about the historical renown of the Lakota leader known by the name "Crazy Horse." For example, "Crazy Horse" has been the subject of a stamp issued by the U.S. Postal Service; and opposer is located in the town of Crazy

Horse, South Dakota. But, it is an entirely different question when considering whether fame attaches to opposer's CRAZY HORSE marks as used in connection with opposer's goods and/or services. In this regard, opposer has failed to show that its mark is famous for its goods and/or services, separate and apart from any level of fame associated with the historical figure Crazy Horse.

In sum, opposer's proofs fall far short of establishing that its marks are famous for its goods and/or services, whether considered among the Native American community or among consumers in the public-at-large.¹⁴

We find this *du Pont* factor is neutral.

The Marks

We must compare each of opposer's two CRAZY HORSE marks to applicant's mark CRAZY HORSE (in standard characters) as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

"The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter

¹⁴ Contrary to opposer's assertion, the record does not establish an admission by applicant, in an unrelated civil action brought by a third party against applicant, that opposer's marks are famous.

the marks would be likely to assume a connection between the parties." *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Opposer's registered mark CRAZY HORSE, in standard characters, and its common law CRAZY HORSE mark are identical in all respects to applicant's mark CRAZY HORSE in standard characters.

Opposer's registered logo mark, CRAZY HORSE and design, is highly similar to applicant's mark. It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."). Where both words and a design comprise the mark (as in opposer's logo mark), then the words are normally accorded greater weight

because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In opposer's logo mark, the literal portion of the mark, namely CRAZY HORSE, is the dominant portion, and is accorded greater weight over the design features when comparing this mark to applicant's mark CRAZY HORSE.

Although the dominant portion of opposer's logo mark is identical to the entirety of applicant's mark, we must, of course, go further and compare the marks in their entireties. When we make this comparison, we find that the marks are similar in sound, appearance, meaning and overall commercial impression. Indeed, the silhouette of a Native American riding a horse may evoke the Lakota leader, and serves to reinforce the name "CRAZY HORSE" in the logo mark.

In attempting to distinguish the parties' marks, applicant points to the manners in which the marks are actually used in

commerce. With respect to the applied-for mark and the marks in opposer's registrations, we are concerned only with their depictions in the application and registrations.¹⁵ But in any event, and contrary to applicant's contention, whether a comparison is made with opposer's registered marks or with opposer's common law mark, the marks are identical or virtually identical.

This *du Pont* factor weighs heavily in opposer's favor.

The Goods and/or Services

The crux of this litigation centers on the similarity or dissimilarity between the parties' goods and/or services. It is well settled that the goods and services of opposer and the services of 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 and/or services of opposer and applicant are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the

¹⁵ The mark in opposer's Registration No. 2508515 and the mark in the subject application are both "standard character" word marks. Such marks must be compared without regard to any stylization (that is, size, typeface, capitalization, or color) in which they may be displayed in actual use. *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d at 1258-59. These two marks (both consisting only of the words CRAZY HORSE) must thus be considered identical in every respect, regardless of the specific way in which each may actually be used.

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 *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

It should be noted that if a registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. See, e.g., *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). In contrast, common law rights in a mark must be closely scrutinized to determine what the record reveals about the actual nature of the goods or services, the particular channels of trade, and the classes of purchasers to whom sales of the goods or services are offered.

We will focus our attention, as the parties have done, on the respective services. Opposer may rely on any of its services that were rendered prior to applicant's first use; as

noted earlier, this use does not include opposer's later use of its mark in connection with online services. Opposer characterizes its services as "wide-ranging and varied," and that "in a broad sense" they "can even be considered related" to applicant's online adult entertainment services and exotic dancing performances. According to opposer, the parties' services "fall within the same service category: entertainment services," and some of the services "are identical, such as ... dance performance services." (Brief, pp. 22-23). Opposer goes on to contend that its "broadly-worded services (cultural exhibition services) encompass applicant's more narrow description of services (exotic dance services)" (Brief, p. 23), and that "[a]lthough the type of exotic dancing provided by each party is somewhat different, the likelihood of confusion analysis requires only that the services be related." (Brief, p. 24). Opposer relies on dictionary definitions showing that the word "adult" means "one who has attained maturity or legal age," and the word "exotic" means "from another part of the world" or "intriguingly unusual or different." Thus, opposer concludes, "both parties' services are provided to adults," and "both parties' dance performances are exotic." (Brief, p. 24). Opposer details its various services, concluding that "in view of the wide range [thereof]," and the "fact that [opposer] has provided dance and online services for years, the Board should

weigh the parties' services as being identical and/or related." (Brief, p. 26). As is apparent from the above, opposer focuses on its dancing performances in comparing its services to applicant's services.

We are not persuaded by opposer's arguments. Each and every service rendered by opposer is significantly different from the type of "adult entertainment services" offered by applicant. Opposer essentially asks the Board to view the terms "adult" and "exotic" out of context as they are used in applicant's recitation of services. Contrary to opposer's position, the limitation in applicant's recitation of services, namely "adult entertainment services," describes services that are sexual in nature and are intended for adults only, namely ecdysiast displays for others. This limitation is significant when comparing the parties' respective services, and in determining whether consumers are likely to be confused as to the source of the services.

Applicant's evidence establishes that services specifically referred to as "adult entertainment services" are highly regulated at the state and local levels, and that there is a significant public interest in preventing children from exposure to such services. In this connection, applicant introduced numerous state and municipal regulations that specifically define the nature of "adult entertainment." (Diane Jacquinet (a

paralegal at applicant's law firm) dec., ex. A). To summarize, the regulations define such entertainment as sexual in nature and limited to adults only; these services are often rendered in the types of gentlemen's clubs or strip clubs operated by applicant. In opposer's home state where its monument complex is located, South Dakota Code §11.12.01(6) defines "adult service" as "dancing, serving food or beverages, modeling, posing, wrestling, singing, reading, talking, listening, or other performances or activities conducted for any consideration in an adult oriented business by a person who is nude or seminude during all or part of the time that the person is providing the service." In connection with this point, we also take judicial notice of the following dictionary definitions: "adult: intended for adults; not suitable for children: *adult entertainment*"; and "exotic: of, pertaining to, or involving stripteasing: *the exotic clubs where strippers are featured*; an exotic dancer; stripper." (dictionary.com based on Random House Dictionary (2014)). Given the specific nature of "adult entertainment services," as that terminology is commonly used and understood, it is reasonable to find that the consuming public will associate the term "adult entertainment" with sexually oriented services exclusive to adults.¹⁶ These services

¹⁶ In interpreting the identification of goods or services in an application or registration, we consider the ordinary meaning of the

are clearly distinguishable from any of the services rendered by opposer, whether we consider the services listed in opposer's registrations or the services for which it has prior common law use. By way of example, many of the photos relied upon by opposer to support its dancing services show juveniles engaging in cultural or traditional Native American dance routines; applicant's photos dealing with his adult entertainment services reveal something quite different.

Given the disparate nature of the parties' services, not surprisingly they are offered in different trade channels. Opposer offers its services principally through its own monument complex, whereas applicant offers its services through gentlemen's clubs and strip clubs. Further, as regulated by certain laws, applicant's services are rendered exclusively to adults, which is not the situation with opposer's services that are offered to the general public of all ages. As pointed out by opposer, however, there is an overlap in customers insofar as adults are concerned.

Based on the evidence, it is clear that "adult entertainment" is commonly used and recognized terminology, and that the terminology's presence in applicant's recitation of

terms used, while recognizing terminology used in the relevant trade or industry. *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1477 (TTAB 2007). See generally TMEP § 1402.01. In the present case, both meanings are the same, in regard to applicant's identification.

services represents a significant limitation on the type of services rendered by applicant. The record is absolutely devoid of probative evidence that the consuming public would ever perceive any of opposer's services (or goods), either as listed in its registrations or as specifically established by its common law rights, as originating from the same source as "online adult entertainment services, namely, providing a website featuring pictures and information in the field of exotic dancing, and featuring articles and stories dealing with adult themes; adult entertainment services, namely, exotic dancing performances," even when rendered under the same or similar marks. If the goods and/or services are not related or marketed in a way that they would be encountered by the same consumers in situations that would give rise to a mistaken belief that they originate from the same source, then confusion may not be likely, even if the marks are identical or similar. See *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722-23; *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355-56 (Fed. Cir. 2004); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213 (TTAB 2011); *Local Trademarks Inc. v. The Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990). See also *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed.

Cir. 2006) (limiting language in the identification found to sufficiently distinguish the goods).

We find that the dissimilarity between the parties' goods and/or services and the trade channels therefor are *du Pont* factors that weigh heavily in applicant's favor.

Third-Party Use and Registration

The sixth *du Pont* factor focuses on the number and nature of similar marks in use on similar goods and/or services. The Board has in the past given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the mark being opposed on grounds of likelihood of confusion to show that confusion is not, in reality, likely to occur. The justification is that the presence in marks of common elements extensively used by others unrelated as to source may cause purchasers not to rely upon these elements as source indicators, but to look to other elements as a means of distinguishing the source of the goods/services. *See, e.g., Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995). By relying on third-party uses and registrations of "CRAZY HORSE," applicant would have us conclude that the existence of such marks, coupled with specific differences between the goods and/or services, are sufficient to avoid a likelihood of confusion herein. That is to say, applicant's position essentially is that opposer's mark is

inherently weak. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.").

Opposer maintains that over the years it has objected to commercial use of "Crazy Horse" by others (without offering any specific examples into the evidentiary record), and that applicant has failed to introduce credible evidence of significant third-party use of marks similar to opposer's marks.

However, applicant did introduce numerous examples of third-party usage of CRAZY HORSE marks for a range of goods and services. (Mark Masterson (an attorney with the law firm representing applicant) dec., Ex. A, Parts I and II). Mr. Masterson conducted an internet search for businesses operating under names that include "Crazy Horse." The search revealed names for restaurants and bars, as well as for businesses as diverse as a campground, a tour guide company, an automobile parts dealer, and a jeweler. Reprints of the home pages of these web sites accompanied the declaration testimony. These uses are listed in Table 2 in applicant's Brief, p. 29.

We have considered these internet documents, but only to the extent of what they show on their face; we have not considered them, however, for the truth of any matter asserted

therein, as for example, the length of time that an entity has been in business and using "CRAZY HORSE." Thus, the websites, standing alone without any corroborating evidence relating to extent of use, number of views, etc., are extremely limited in their probative value in the likelihood of confusion analysis. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Noticeably absent from this record is the critical evidence that the alleged uses have been widespread enough, consistent enough and qualitatively significant enough, to infer that the relevant consumers have been so conditioned by a plethora of such similar marks that they have learned to distinguish between otherwise similar marks. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1693-94 (third-party use was not "so widespread as to 'condition' the consuming public"); *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1629 (TTAB 2007). Thus, the website evidence is entitled to only minimal probative value.

Applicant also relied upon a summary list of a search of the USPTO'S TESS database for live registrations and pending applications that include "Crazy Horse." (Jacquinot dec., Ex. H). The search revealed 35 records, and the exhibit includes

copies of registrations and applications retrieved from the USPTO's TSDR database. These official records cover a range of goods and services, including motorcycles, rifles, knives, whiskey, energy drinks, clothing, racing cars and watches. The third-party registrations/applications are reproduced in applicant's Brief, Table 1, pp. 26-28.

Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d at 1934. *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given any weight."); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). Likewise, the third-party applications are not probative. *Glamorene Prods. Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (applications are evidence only of the fact that the applications were filed and nothing else).

Further, with respect to both the third-party use and registration evidence, any probative value of this evidence is

severely undercut by the fact that the goods and/or services covered by the usage or registrations are different from the ones involved in this proceeding. See *In re Thor Tech. Inc.*, 90 USPQ2d at 1639.

In view of the above, we find this factor to be neutral.

Conditions of Purchase

Opposer argues that the parties' customers are impulsive and not sophisticated when purchasing the respective services. Applicant contends that purchases of its services involve "at least some level of care." (Brief, p. 23). The parties essentially make their arguments based solely on the nature of the goods and services, with no supporting evidence.

There is nothing in the record to confirm that the parties' services are purchased quickly or impulsively and without any investigation into their source. We decline to find, based solely on the nature of the services as identified in the registrations and application, that the services are subject to such purchase.

We find that this factor is neutral.

Actual Confusion

Applicant trumpets the lack of any instances of actual confusion, despite the purported 35 years of contemporaneous use of the marks. Opposer asserts, however, that there have been "several instances of misdirected telephone calls" and "actual

confusion as to the appropriate domain name for use by schoolchildren." (Brief, p. 31).

With respect to the phone calls, Monique Ziolkowski testified that she and her mother received "misdirected calls [of the nature shown below] on a regular basis for the past several years." (dec., ¶ 5). Monique Ziolkowski indicated that she "often overhear[s] her [mother's] end of the conversation and on occasion she has "personally answered some of the calls [herself]." *Id.* She states that "on a regular basis, [opposer] receives telephone calls that are obviously intended for a business providing adult entertainment services," and that "these calls are often received in the middle of the night." (dec., ¶ 6). She also goes on to testify that "the frequency of such calls has increased in recent years," while indicating that she does not know the reason for the increased number of calls. *Id.* Monique Ziolkowski described the typical call as follows:

MZ: Crazy Horse Memorial.

Caller: Is this Crazy Horse? I got this number off the internet.

MZ: Yes.

Caller: How many dances can I get for \$20? Are you open all night? How much does it cost for me to get [description of crude service]?

MZ: This is the Crazy Horse Memorial, a mountain carving in South Dakota.

Caller: Caller often hangs up at this point or says something like "You mean this isn't the strip club?!!!" and then hangs up without identifying himself.
(dec., ¶ 4).

Regarding the purported actual confusion by students, Ruth Ziolkowski testified that opposer has been aware of applicant's website, <crazyhorse.com>, for many years and that this URL is similar to opposer's domain name, <crazyhorse.org>. Ruth Ziolkowski's testimony reads as follows:

The Foundation works closely with schools and teachers to facilitate lessons and curricula relating to Native Americans and U.S. history. Unfortunately, however, teachers have told me personally many times that their ability to teach students in this area is hampered by students who mistakenly visit Mr. Spencer's website, rather than the Foundation's website. The students who have been confused in this manner range in age from elementary age to university age.
(dec., ¶ 23).

Evidence of actual confusion "is too important to be established by means of an inference, unsupported by corroborating evidence." *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340, 346 (TTAB 1983). We find that opposer's evidence falls far short of showing probative instances of actual confusion. An unknown number of misdirected phone calls (and which may be relatively few in number as compared to all the phone calls opposer receives), is not persuasive evidence of confusion, and could result from careless retrieval of phone

numbers from directories or the internet. Persuasive evidence of actual confusion must show confusion as to source or sponsorship, not mere carelessness in attempts to contact a business. Further, what teachers have told the witness constitutes hearsay; moreover, accessing the incorrect website may have nothing to do with confusion as to the source or origin of the parties' respective services.¹⁷

In sum, the evidence of actual confusion is not persuasive of opposer's case. Rather, there appears to have been 35 years of contemporaneous use of the marks with little to no actual confusion, at least based on this record. We find that this *du Pont* factor is neutral.

Conclusion

Based on the record before us, we conclude that confusion amounts to only a speculative, theoretical possibility, rather than a likelihood. On balance, the relevant factors, especially the dissimilarity between opposer's goods/services and applicant's services, favor a conclusion of no likelihood of confusion. Simply put, consumers are not likely to confuse the source or origin of opposer's goods and/or services related to its monument complex, even its historical or cultural dancing

¹⁷ To the extent opposer alleges injury from the registration of applicant's domain names, we can offer no remedy. See n.10, *supra*. We reiterate that the registration and use of domain names as such does not fall within our jurisdiction.

performances, with applicant's adult entertainment services, whether online services or exotic dancing performances, even when offered under identical marks. We find that opposer has not met its burden of establishing that confusion is likely to occur. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

The opposition grounded on likelihood of confusion is dismissed.

DILUTION

The Trademark Dilution Revision Act of 2006 ("TDRA"), which was signed into law on October 6, 2006, amended Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). It provides that:

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.

15 U.S.C. § 1125(c)(1). To prevail on a dilution claim under the TDRA, a plaintiff must show that: (1) it 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 or by tarnishment. *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1723-25.

The TDRA defines dilution by blurring as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). Dilution by tarnishment is defined as "an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C). Opposer focuses its claim on the latter, namely dilution by tarnishment. This portion of the statute is intended to protect the owner of a famous mark against reputational harm. *See, e.g., Ty Inc. v. Perryman*, 306 F.3d 509, 64 USPQ2d 1689, 1691-92 (7th Cir. 2002) (using the hypothetical example of the use of the famous mark

TIFFANY for strip clubs). See generally McCarthy on Trademarks and Unfair Competition, § 24:89.

Fame

A threshold question in any federal dilution claim is whether the mark at issue is "famous." Under the TDRA, a mark is famous if it "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C.

§ 1125(c)(2)(A). By using the "general consuming public" as the benchmark, the TDRA eliminated the possibility of "niche fame," which some courts had recognized under the previous version of the statute. See *Top Tobacco, LP v. N. Atl. Operating Co.*, 509 F.3d 380, 85 USPQ2d 1251 (7th Cir. 2007) (noting that the reference to the general public "eliminated any possibility of 'niche fame,' which some courts had recognized before the amendment"). The TDRA lists four non-exclusive factors for courts to consider when determining whether a mark is famous:

(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.

(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).

Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. McCarthy on Trademarks and Unfair Competition, § 24:104 at 24-290 ("The standard for the kind of 'fame' needed to trigger anti-dilution protection is more rigorous and demanding than the 'fame' which is sufficient for the classic likelihood of confusion test."). While fame for dilution "is an either/or proposition" – it either exists or does not – fame for likelihood of confusion is a matter of degree along a continuum. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d at 1374-75. Accordingly, a mark can acquire "sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame." *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007).

It is well-established that dilution fame is difficult to prove. See *Everest Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 73 USPQ2d 1580 (8th Cir. 2005) ("The judicial consensus is that 'famous' is a rigorous standard."); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001) ("Fame for

dilution purposes is difficult to prove."); see also McCarthy on Trademarks and Unfair Competition, § 24:104 at 24-286, 24-293 (noting that fame for dilution is "a difficult and demanding requirement" and that, although "all 'trademarks' are 'distinctive' – very few are 'famous'"). Importantly, the owner of the allegedly famous mark must show that its mark became famous "prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1174.

As noted, fame for dilution requires widespread recognition by the general public. 15 U.S.C. § 1125(c)(2)(A). An opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Id.* at 1181. In other words, a famous mark is one that has become a "household name." *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 72 USPQ2d 1078 (9th Cir. 2004) (quoting *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564 (9th Cir. 2002)).

With this framework in mind, when we consider opposer's evidence of fame, we find that opposer's proofs clearly are insufficient. As discussed above with respect to likelihood of confusion, opposer's evidence of fame is relatively sparse,

falling far short of establishing that its mark is famous for its goods and/or services for purposes of a dilution claim.

Conclusion

Based on the evidentiary record, we find that opposer has failed to provide sufficient evidence of fame for dilution purposes. Absent a showing of fame, opposer's dilution claim fails, and we need not consider the remaining statutory factors for dilution.

In reaching this result we note opposer's equitable argument against allowing applicant to obtain another registration covering adult entertainment services, and to thereby assist applicant in its attempts to franchise the mark. According to opposer, allowing applicant to secure another registration encourages him to use the federal registration as a selling point in franchising efforts, and "would be detrimental to the challenges of the Native American community and would be inconsistent with the mission of the Foundation":

In considering the tarnishing and disparaging effects of the Applicant's use of "Crazy Horse," the Foundation asks the Board to consider the daunting challenges of the Native American community. Native Americans rank at the bottom of nearly every social statistic: highest teen suicide rate of all minorities (at 18.5 per 100,000), highest rate of teen pregnancy, highest high-school drop-out rate at 54%, lowest per capita income, and unemployment rates between 50% to 90%. Federal statistics indicate that Indian women are raped at a

higher rate than any other race, and are more likely to be victims of sexual assault and domestic violence than other women. (citations omitted). (Brief, p. 38).

Even if one accepts opposer's contention that applicant's use of its mark is "tasteless and offensive" and that "it reinforces negative stereotypes," (Brief, p. 4), this does not mean that applicant's application runs afoul of the pleaded statutory grounds for relief. Although we appreciate opposer's concerns, we have decided the issues herein, as we must, based on the record and the relevant trademark law and case law.

The opposition grounded on dilution is dismissed.

DECISION

We carefully have considered all of the evidence of record pertaining to the relevant likelihood of confusion and dilution factors,¹⁸ as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion), and we conclude that opposer has not proved its pleaded claims.

The opposition is dismissed.

¹⁸ We note again that our decision is confined to the issues of likelihood of confusion and dilution. We have not considered any claim that applicant's mark may be scandalous or disparaging under Section 2(a). Our decision does not indicate the USPTO's approval of applicant's mark; the only question before us is whether opposer has proved its pleaded claims.