

ESTTA Tracking number: **ESTTA926755**

Filing date: **10/05/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91230559
Party	Defendant Tung B Vo
Correspondence Address	HANS J CROSBY 1125 WEST STREET , SUITE 200 ANNAPOLIS, MD 21401 UNITED STATES hcrosby@classiccounsel.com 240-744-4614
Submission	Brief on Merits for Defendant
Filer's Name	Hans J Crosby
Filer's email	hcrosby@ClassicCounsel.com
Signature	/Hans J Crosby/
Date	10/05/2018
Attachments	Applicant Accelerated Case Resolution Trial Brief-Final.pdf(671596 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN EXPRESS MARKETING	)	
& DEVELOPMENT CORP.	)	Opposition No. 91230559 (parent)
	)	Serial No. 86894103
Opposer,	)	
	)	Mark: AMERIXPRESS
v.	)	
	)	
TUNG B. VO	)	
	)	Opposition No. 91232714
Applicant.	)	
	)	Serial No. 86881103
	)	Mark: AMERIXPRESS LLC

**APPLICANT'S ACCELERATED CASE RESOLUTION TRIAL BRIEF**

**TABLE OF CONTENTS**

TABLE OF AUTHORITIES ..... 3

I. DESCRIPTION OF THE RECORD ..... 5

II. STATEMENT OF THE ISSUES ..... 6

III. STATEMENT OF FACTS ..... 7

    A. Applicant and the “Amerixpress” mark ..... 7

    B. Opposer and the “American Express” mark ..... 7

IV. ARGUMENT ..... 9

    A. The “Amerixpress” Mark is Unlikely to Cause Confusion ..... 9

        1. Opposer has the Burden of Proof ..... 9

        2. The “American Express” mark is not famous ..... 9

        3. The appearance, sound and meaning are dissimilar ..... 15

        4. The relevant goods and services are not related ..... 19

        5. Dissimilar trade channels and consumers ..... 25

        6. The conditions under which sales are made ..... 27

        7. The “Amerixpress” mark is the result of imagination ..... 29

    B. The “Amerixpress” mark is Unlikely to Dilute “American Express” ..... 31

        1. Opposer has the burden of proof ..... 31

        2. The “American Express” mark is not famous ..... 31

        3. Applicant’s use of its marks is not likely to cause dilution ..... 32

V. CONCLUSION ..... 37

## TABLE OF AUTHORITIES

	Page(s)
<b>CASES</b>	
<i>7-Eleven Inc. v. Wechsler</i> , 83 U.S.P.Q.2d 1715, 1729 (T.T.A.B. 2007) .....	35
<i>Bose Corp. v. QSC Audio Products, Inc.</i> , 293 F.3d 136, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) .....	9, 10
<i>Champagne Louis Roederer, SA. v. Delicato Vineyards</i> , 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) .....	17
<i>Dexas Int'l, Ltd v. Ideavillage Prods. Corp.</i> , Opposition No 91225850 (T.T.A.B. July 24, 2018) .....	17, 18
<i>Falk Corp. v. Toro Mfg. Corp.</i> , 493 F.2d 1372, 181 U.S.P.Q. 462 (C.C.P.A. 1974) .....	17
<i>Federated Foods Inv. v. Fort Howard Paper Co.</i> , 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976) .....	12, 13, 20
<i>Hoover v. Royal Appliance Mfg. Co.</i> , 238 F.3d 1357 (Fed. Cir. 2001) .....	9
<i>In re Coors Brewing Co.</i> , 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) .....	20, 21, 22, 23
<i>In re E.I. du Pont de Nemours &amp; Co.</i> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) .....	9, 10, 14, 19
<i>In re N.A.D., Inc.</i> , 754 F.2d 996, 224 U.S.P.Q. 969 (Fed. Cir. 1985) .....	27
<i>In re Opus One Inc.</i> , 60 U.S.P.Q.2d 1812, 1813 (TTAB 2001) .....	20
<i>In re Shell Oil Co.</i> , 992 F.2d 1204, 26 U.S.P.Q.2d 1687 (Fed. Cir. 1993) .....	16, 17
<i>Inter Ikea Systems B.V. v. Akea, LLC</i> , 110 U.S.P.Q.2d 1734 (T.T.A.B. 2014) .....	9, 10, 11, 28, 29
<i>Irwin Auger Bit Co. v. Irwin Corp.</i> , 134 U.S.P.Q. 37, 39 (T.T.A.B. 1962) .....	12, 13, 20, 22, 24

<i>Keebler Co. v. Murray Bakery Prods.</i> , 866 F.2d 1386, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) .....	17
<i>Kellogg Co. v. Pack'em Enters., Inc.</i> , 14 U.S.P.Q.2d 1545 (T.T.A.B. 1990), <i>aff'd</i> , 951 F.2d 330, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) .....	17
<i>Lever Bros. Co. v. Barcolene Co.</i> , 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) .....	17
<i>Lloyd's Food Prods., Inc. v. Eli's, Inc.</i> , 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993) .....	20
<i>Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.</i> , 875 F.2d 1026, 10 U.S.P.Q.2d 1961 (2d Cir. 1989) .....	35
<i>Mini Melts, Inc. v. Reckitt Benckiser LLC</i> , 118 U.S.P.Q.2d 1464 (T.T.A.B. 2016) .....	18
<i>Sears Mortgage Corp. v. Northeast Sav. F.A.</i> , 24 U.S.P.Q.2d 1227 (T.T.A.B. 1992) .....	17
<i>The Conde Nast Publications Inc. v Vogue Travel</i> , 205 U.S.P.Q. 579 (T.T.A.B. 1979) .....	23, 24
<i>Toro Co. v. ToroHead, Inc.</i> , 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001) .....	31, 32
<i>Weider Pubs., LLC v. D&amp;D Beauty Care Co., LLC</i> , 109 U.S.P.Q. 1347 (C.C.P.A. 1972) .....	21, 22, 23, 24

**TREATISES**

<i>McCarthy, McCarthy on Trademarks and Unfair Competition</i> .....	32
--	----

## **I. DESCRIPTION OF THE RECORD**

In accordance with Rule 2.128(b) of the Trademark Rules of Practice, T.B.M.P. § 801.03, and the Stipulation for Accelerated Case Resolution dated July 11, 2018, the record for this consolidated opposition proceeding consists of the following:

1. The pleadings for each of the oppositions that comprise this consolidated opposition.
2. The file histories for Application Serial No. 86894103 and Application Serial No. 86881103.
3. The record on Summary Judgment, consisting of:
  - (a) Opposer's Summary Judgment Brief (TTABVUE Docket No. 8);
  - (b) Declaration of Alison B. Silver in support of Opposer's Summary Judgment motion and accompanying Exhibits 1-30 (TTABVUE Docket No. 8 and [Confidential] Docket No. 10);
  - (c) Declaration of Timothy J. Kelly in support of Opposer's Summary Judgment motion and accompanying Exhibits 1-28 (TTABVUE Docket No. 9 and [Confidential] Docket No. 10);
  - (d) Applicant's Summary Judgment Brief (TTABVUE Docket No. 11);
  - (e) Declaration of Hans J. Crosby in support of Applicant's Summary Judgment motion and accompanying Exhibit 1 (TTABVUE Docket No. 11);
  - (f) Opposer's Reply Brief in support of its Summary Judgment motion (TTABVUE Docket No. 12);

(g) Declaration of Aya Cieslak-Tochigi in support of Opposer's Summary Judgment motion and accompanying Exhibits 1-3 (TTABVUE Docket No. 12).

4. Applicant's Testimony filed July 27, 2018 and accompanying Exhibit 1 and Exhibits A, B and C (TTABVUE Docket No. 25).<sup>1</sup>

## **II. STATEMENT OF THE ISSUES**

The issues presented in this consolidated opposition proceeding are: (1) whether Applicant's "Amerixpress" mark (Application Serial No. 86894103) and "Amerixpress LLC" mark (Application Serial No. 86881103) should be registered and are unlikely to cause confusion, to cause mistake, or to deceive under the Lanham Act § 2(d), 15 U.S.C. § 1052(d) in view of Opposer's mark, and (2) whether Applicant's "Amerixpress" mark (Application Serial No. 86894103) and "Amerixpress LLC" mark (Application Serial No. 86881103) should be registered and are unlikely to cause dilution under the Lanham Act § 43(c), 15 U.S.C. § 1025(c).

Applicant submits that in view of, *inter alia*, the lack of fame, the differences in appearance, sound and impression among the marks and the lack of relationship among the relevant goods/services, Applicant's "Amerixpress" mark is unlikely to cause confusion, mistake, deception or dilution. Thus, Opposer will not be damaged by the registration of Applicant's marks and this consolidated opposition must be dismissed.

---

<sup>1</sup> Applicant notes that Opposer sought no discovery from Applicant during Opposer's Trial Period.

### **III. STATEMENT OF FACTS**

#### **A. Applicant and the “Amerixpress” mark**

Applicant filed Application Serial No. 86894103 for the “Amerixpress” mark in connection with “import agency services” in International Class 035.

The trademark application for the “Amerixpress” mark was examined by the U.S. Patent and Trademark Office (“USPTO”), where the USPTO’s Examining Attorney issued no refusal based on likelihood of confusion or other similar grounds, and therefore, approved the trademark application for publication.

Applicant filed Application Serial No. 86881103 for the “Amerixpress LLC” mark in connection with “Calcium supplements; Dietary supplements; Herbal supplements; Homeopathic supplements; Mineral supplements; Mineral nutritional supplements; Natural herbal supplements; Nutritional supplements; Probiotic supplements; Protein supplements; Soy protein dietary supplements; Vitamin supplements; Vitamin and mineral supplements” in International Class 005 as well as “Export agency services for the goods of others” in International Class 035.

The trademark application for the “Amerixpress LLC” mark was examined by the USPTO, where the USPTO’s Examining Attorney issued no refusal based on likelihood of confusion or other similar grounds, and therefore, ultimately approved the trademark application for publication.

#### **B. Opposer and the “American Express” mark**

Opposer American Express has made of record multiple federal trademark registrations. *See Opposer’s Trial Brief, pg. 6.* These federal trademark registrations are hereinafter referred to as the “American Express” mark.



Opposer American Express has not alleged that it provides “import agency services” of any kind, namely American Express-branded import agency services. *See e.g., Opposer’s Trial Brief, pgs. 1-35.*

Opposer American Express has not alleged that it provides “export agency services” of any kind, namely American Express-branded export agency services. *See id.*

Opposer American Express has not alleged that it provides nutritional or dietary “supplements,” namely American Express-branded supplements, for example, calcium supplements; dietary supplements; herbal supplements; homeopathic supplements; mineral supplements; mineral nutritional supplements; natural herbal supplements; nutritional supplements; probiotic supplements; protein supplements; soy protein dietary supplements; vitamin supplements; vitamin [and/or] mineral supplements. *See id.*

Opposer American Express has not cited any trademark registrations with goods and/or services listed in International Class 005. *See id.*

Applicant submits that given, *inter alia*, the lack of fame, the differences in appearance, sound and impression among the marks and the lack of relationship among the relevant goods/services, Applicant’s “Amerixpress” mark is unlikely to cause confusion, mistake, deception or dilution. Accordingly, Opposer will not be damaged by registration of Applicant’s marks and this consolidated opposition should be dismissed.

#### **IV. ARGUMENT**

##### **A. The “Amerixpress” Mark is Unlikely to Cause Confusion**

###### **1. Opposer has the Burden of Proof**

In an opposition proceeding, the opposer bears the burden of proof to establish that the applicant does not have the right to register its mark. *See Hoover v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1360 (Fed. Cir. 2001). Specifically, Opposer must prove that Applicant’s “Amerixpress” mark would create a likelihood of confusion under 15 U.S.C. § 1052(d) by applying the *du Pont* Factors, which compare among other things the sound, appearance, meaning and commercial impression of the marks as well as the relatedness of the goods, channels of trade, and any other established fact probative of the effect of use. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). In light of the evidence of record, Applicant submits that Opposer has failed to meet its burden of proof that Applicant’s “Amerixpress” mark would create a likelihood of confusion with Opposer’s mark.

###### **2. The “American Express” mark is not famous**

Fame must be assessed in view of comparable types of products or services. *See Inter Ikea Systems B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734 (T.T.A.B. 2014) (holding IKEA famous for retail store services for furniture but not for nutritional supplements or retail store services for nutritional supplements). Fame may be measured indirectly by sales volume, advertising expenditures, indicia of commercial awareness, critical assessments, notice by independent sources of the products identified by a mark as well as the general reputation of the goods and services. *See Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 136, 63 U.S.P.Q.2d 1303, 1305-06 (Fed. Cir. 2002); *Inter Ikea*

*Systems*, 110 U.S.P.Q.2d at 1743. However, in that raw numbers alone may be misleading, some context in which to place raw numbers is necessary. As such, fame must be assessed in view of the substantiality of data (e.g., sales or advertising figures) for *comparable types of products or services*. See *Bose Corp.*, 63 U.S.P.Q.2d at 1309; *Inter Ikea Systems*, 110 U.S.P.Q.2d at 1743. For example, in the absence of convincing evidence or testimony, the Board in *Inter Ikea Systems*, 110 U.S.P.Q.2d at 1743, found opposer's IKEA mark famous only for retail store services in the field of furniture, housewares and home furnishings, and not for nutritional supplements as described in applicant's trademark application. Although opposer claimed that it sold herbal drinks and herbs within its retail stores, the Board concluded that the testimony and evidence was not specific enough to support finding fame for such individual products, much less nutritional supplements in general. See *Inter Ikea Systems*, 110 U.S.P.Q.2d at 1743. Any analysis is necessarily drawn from the evidence of record, not extrinsic matter. *In re E.I. du Pont*, 476 F.2d at 1361.

Opposer alleges that the "American Express" mark is distinctive and strong. See *Opposer's Trial Brief*, pgs. 13-14. However, Opposer provides no direct evidence in support of such claimed distinctiveness and strength. See *id.* It is well recognized that all analysis must be drawn from the evidence of record. *In re E.I. du Pont*, 476 F.2d at 1361. Opposer does claim that the "American Express" mark is registered and, in certain instances, incontestable, as support of its claim of strength and distinctiveness. See *Opposer's Trial Brief*, pg. 14. However, in that fame must be assessed in view of comparable types of products or services, it is significant that none of the "American Express" trademark registrations list a comparable product or service. That is, none of

the “American Express” trademark registrations list supplements (i.e., nutritional supplements), import agency services or export agency services (or any comparable product or service) as specifically listed for the “Amerixpress” mark. Where there is such an absence of specific evidence, there can be no finding of fame for individual products or services, namely for supplements (i.e., nutritional supplements) or import/export agency services. See *Inter Ikea Systems*, 110 U.S.P.Q.2d at 1743.

Referencing a commercial context, Opposer has introduced raw numbers in support of its claim that the “American Express” mark is famous. Such raw numbers include data with respect to annual number of issued American Express-branded charge card products (i.e, credit cards), market penetration, countries of operation, merchant acceptance, annual revenues, advertising expenditures, market capitalization as well as numbers with respect to internet website visitors. See *Opposer’s Trial Brief*, pgs. 14-16. Notably, all of this data pertains to American Express-branded financial products and services, in particular the American Express-branded charge card product and service. It is recognized that Opposer American Express is well known in the financial services industry, in particular for the American Express-branded charge card product and service. However, considering the context of the submitted data, Applicant submits that Opposer fails to provide any data or other evidence with respect to *comparable types of products or services*. See *id.* That is, Opposer fails to introduce any data or other evidence with respect to the goods and services relevant to Applicant’s trademark applications, namely supplements, import agency services and/or export agency services. See *id.*

Although Opposer alleges generally that American Express-branded charge card products are accepted at many retail establishments, Opposer provides no data or other

evidence with respect to actual purchases of supplements (e.g., nutritional supplements) or import/export agency services by consumers at such merchants, much less the actual purchase of supplements or import/export agency services via an American Express-branded charge card product versus an alternative charge card product (e.g., Visa® or MasterCard®) or cash. *See Opposer's Trial Brief, pg. 16.* Opposer also provides no data or other evidence supporting the notion that when a purchase is made at a merchant, consumers may somehow associate the purchase of that product – from among the thousands of products available for purchase – with a particular charge card product, much less associate the purchased product with an American Express-branded charge card. Put another way, Opposer provides no data or other evidence that consumers view the American Express-branded charge card and service as anything more than a payment method for the purchase of any one of the thousands of third-party-branded products and services found in thousands of different retail locations. *See e.g., See Federated Foods Inv. v. Fort Howard Paper Co., 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976)* (numerous products under one roof unlikely to cause consumer confusion); *Irwin Auger Bit Co. v. Irwin Corp., 134 U.S.P.Q. 37, 39 (T.T.A.B. 1962)* (consumers do not believe that the large number of goods found in a store originate with a single source). Opposer also provides no data or other evidence that American Express itself provides supplements, import agency services and/or export agency services directly to consumers.<sup>2</sup>

---

<sup>2</sup> American Express faces similar evidentiary problems with respect to use of the American Express-branded charge card to purchase shipping services and purchases of third-party products through the American Express-branded Membership Rewards Program. Simply put, Opposer provides no data or other evidence supporting the notion that when any such purchase is made, which is necessarily the purchase of a third-party

Opposer cites publications from media outlets setting forth various rankings for American Express. *See Opposer's Trial Brief, pg. 15.* In particular, Opposer cites a brand ranking as allegedly ranking the American Express brand higher than brands such as Budweiser®, Ford® and Starbucks®. *See id.* Applicant submits that such ranking provides no information with respect to any product or service, much less any comparable product or service. While Opposer alleges that such ranking establishes fame beyond the financial services industry, Applicant submits that no evidence regarding any relevant product or service is presented. Applicant assumes that Opposer does not intend to argue that this ranking indicates the American Express brand is famous for products and/or retail services such as beer (Budweiser®), automotive vehicles (Ford®) or coffee (Starbucks®), the only products/services suggested by this ranking, but even in this context no actual data is presented to suggest fame for such products/services. Even more glaring, this ranking contains no evidence (e.g., consumer recognition) regarding the goods and services relevant to Applicant's trademark applications, namely supplements, import agency services and/or export agency services. In fact, with respect to consumer recognition of any product or service, Opposer has presented only one survey regarding the American Express brand. *See TTABVUE Docket No. 8-10,*

---

branded product from among thousands of third-party branded products, consumers somehow associate the purchase of that product with a particular charge card product or service, specifically the American Express-branded charge card or the American Express-branded Membership Rewards Program. That is, Opposer provides no data or other evidence that consumers view the American Express-branded charge card/service and American Express-branded Membership Rewards Program as anything more than a payment method for the purchase of any one of thousands of third-party-branded products/services found in thousands of different retail locations. *See e.g., See Federated Foods*, 192 U.S.P.Q. at 29 (numerous products under one roof unlikely to cause consumer confusion); *Irwin Auger Bit*, 134 U.S.P.Q. at 39 (consumers do not believe that the large number of goods found in a store originate with a single source).

Opposer's Memo of Law, at p. 6, ll. 9-15; Silver Decl., ¶ 18. In this consumer survey, however, two (2) of three (3) categories of respondent owned at least one credit card, indicating the survey relates to consumer recognition of financial services and products. *See id.* As noted above, American Express is well known for financial products and services, in particular the American Express-branded charge card product. While one category covers respondents age 18-65 with income above \$25,000 per year, it is unclear to what extent this category overlaps with the other two categories of respondents and thus, more important, to what extent the respondents recognized the survey as a strictly financial survey. *See id.* Simply put, the evidence does nothing to establish that consumers recognize the "American Express" mark for anything other than financial products and services, namely the American Express-branded charge card product.

Furthermore, Opposer has cited the proceedings of other courts and panels as evidence of fame. *See Opposer's Trial Brief, pg. 15.* However, the Board will recognize that any likelihood of confusion analysis "is necessarily drawn from the *probative facts in evidence*," *In re E.I. du Pont*, 476 F.2d at 1361 (emphasis added), and furthermore, "[i]n one case [evidence] will indicate that confusion is unlikely; in the next it will not . . . ." *Id.* at 1362. As such, the finding of any other proceeding, as well as any evidence therein, is irrelevant. Nevertheless, Applicant points out that like all other evidence submitted by Opposer, such other proceedings provide no evidence of fame with respect to any comparable product or service, namely supplements (i.e., nutritional supplements) and/or import/export agency services as specifically listed in Applicant's "Amerixpress" trademark applications.

Given the lack of evidence with respect to any relevant goods and services, Applicant submits that a finding of fame is not possible on the evidentiary record.

### **3. The appearance, sound and meaning are dissimilar**

Applicant's "Amerixpress" mark and Opposer's "American Express" mark, considered in their entireties, are dissimilar in appearance and pronunciation, and create dissimilar commercial impressions, as to warrant a finding of no likelihood of confusion.

Viewed and compared in their entireties, the subject marks are as follows:

American Express

Amerixpress

Notably, Applicant's mark does not include the term "American" or "Express", the two terms that make up the entirety of Opposer's mark. Given the prominence of these two terms in Opposer's mark, the terms "American" and "Express" render the mark different in appearance and overall pronunciation compared to Applicant's "Amerixpress", which lacks both terms "American" and "Express". Conversely, Opposer's mark does not include the phrase "Amerixpress", not only the dominant but the only term that makes up the entirety of Applicant's mark. Given the prominence of this term in Applicant's mark, the term "Amerixpress" renders the mark different in appearance and overall pronunciation compared to Opposer's "American Express", which lacks the entire term "Amerixpress". Indeed, consumers encountering Applicant's mark are presented with the new and previously unknown – in appearance and sound – term "Amerixpress", whereas consumers encountering "American Express" are presented with not only two commonly known words but a combination of words already known. Thus, the marks are dissimilar visually, aurally and in meaning.



It is submitted that Opposer's comparison of its mark and Applicant's mark improperly dissects Applicant's mark. Opposer states that both "Amerixpress" and "Amerixpress LLC" each begin with "Ameri-" short for American and end with "xpress" which is pronounced "Express". See Opposer's Trial Brief, pg. 19. However, such a dissection of Applicant's mark into parts fails to consider Applicant's mark in its entirety, as would be encountered by the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993). Notably, comparing all subject marks in their entirety reveals the actual differences in appearance and sound. First, differences in appearance indicate that consumer confusion is unlikely. "Amerixpress" is comprised of one (1) word and "Amerixpress LLC" is comprised of one (1) word (and one (1) business entity designation), whereas "American Express" is comprised of two (2) words. "American Express" is comprised of fifteen (15) letters and one (1) space whereas "Amerixpress" is comprised of only eleven (11) letters, i.e., 26.6% fewer letters than the "American Express" mark. Second, differences in sound also indicate that consumer confusion is unlikely. "Amerixpress" is pronounced as one (1) word whereas "American Express" is not only pronounced, but according to Opposer, well-recognized as two (2) words. See Opposer's Trial Brief, pg. 16. Also, "A-mer-i-x-press" is pronounced as five (5) syllables – the designation L-L-C adding three (3) additional syllables – whereas "A-mer-i-can Ex-press" must be pronounced as a four (4) syllable term followed by a space (a pause) followed by a two (2) syllable term. Given that the "Amerixpress" mark is new and previously unknown – in appearance and sound,<sup>3</sup> whereas "American Express" is

---

<sup>3</sup> A long line of cases has discussed the relationship between appearance and sound in

made up of two extremely common words, where the combination of these two words is well known, such differences in appearance and sound are more than enough to render any potential consumer confusion unlikely.<sup>4</sup>

While Opposer attempts to rely on the recent non-precedential opinion of *Dexas Int'l, Ltd v. Ideavillage Prods. Corp.*, Opposition No 91225850 (T.T.A.B. July 24, 2018), Applicant submits that such reliance is misplaced. *See* Opposer's Trial Brief, pg. 19. In *Dexas Int'l, Ltd*, the Board concluded that there was a likelihood of confusion between Applicant's SNACKEEZ DUO mark and Opposer's common law SNACK-DUO mark. Referring to "minor middle elements" between SNACK and DUO, Opposer attempts to equate the deletion of the hyphen (-) from SNACK-DUO and the addition of EEZ to

---

refusing to find likelihood of confusion. *See Champagne Louis Roederer, SA. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (Board dismissal affirmed based on dissimilarity of CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em Enters., Inc.*, 14 U.S.P.Q.2d 1545 (T.T.A.B. 1990), *aff'd*, 951 F.2d 330, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (dismissal affirmed based on dissimilarity of FROOTEE ICE and Design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (Board dismissal affirmed based on dissimilarity of PECAN SANDIES and PECAN SHORTEES); *Sears Mortgage Corp. v. Northeast Sav. F.A.*, 24 U.S.P.Q.2d 1227 (T.T.A.B. 1992) (dissimilarity between APPROVAL PLUS and APPROVALFIRST dispositive); *Falk Corp. v. Toro Mfg. Corp.*, 493 F.2d 1372, 181 U.S.P.Q. 462 (C.C.P.A. 1974) (differences between TORO and TORUS supported a finding of no likelihood of confusion); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) ("While appellant points out some similarities between the word ALL as it is used by both parties, inspection of the two marks also shows some obvious differences. Considering appellee's mark in its entirety, we are convinced that there is no likelihood of confusion").

<sup>4</sup> In its Trial Brief, Opposer comments that the Trademark Examining Attorney for Applicant's marks identified "American Express" as the pseudo-mark for each. *See* Opposer's Trial Brief, pgs. 18-19. However, the Board will readily recognize this comment of Opposer's as irrelevant, since the focus in any likelihood of confusion analysis is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks, and not an Examining Attorney trained in trademark examination procedure. *See In re Shell Oil Co.*, 992 F.2d at 1207, 26 U.S.P.Q.2d at 1689. Still, we remind Opposer that at no time did the Examining Attorney find a conflict between the marks, the Examining Attorney instead concluding that there is no likelihood of confusion between Applicant's and Opposer's marks.

SNACK with the significant differences between the “Amerixpress” and “American Express” marks. However, in that it will be readily recognized that the hyphen (-) in SNACK-DUO does not distinguish SNACK-DUO from SNACK DUO, the situation in *Dexas Int'l* amounts to little more than the addition of EEZ to the first term of the two term mark SNACK DUO, to create the similar SNACKEEZ DUO. *See Dexas Int'l*, Opposition No 91225850 (citing *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2d 1464 (T.T.A.B. 2016) (finding MINI-MELTS and MINI MELTS similar)). Applicant submits that the situation of *Dexas Int'l* is not analogous. *Dexas Int'l* might have been relevant had the “American Express” mark been modified to “Americaneez Express”. However, “Amerixpress” is not the result of merely adding a term (or some other combination of letters) to the first (or second) term of “American Express”. Rather, “Amerixpress” is the result of the numerous differences discussed above, which has resulted in the new and previously unknown “Amerixpress” mark, which is different in appearance, sound and impression.<sup>5</sup>

Applicant further submits that the marks are dissimilar in connotation and commercial impression. The “Amerixpress” mark is the result of Applicant’s imagination, wherein the marks were conceived to provide consumers – especially Vietnamese consumers - with the connotation and commercial impression of an

---

<sup>5</sup> In its Trial Brief, Opposer makes several mentions to the website address: <https://www.americanexpress.com>. *See* Opposer’s Trial Brief, pgs. 19-20. However, Applicant reminds Opposer that the trademark at issue is “American Express”, and not <https://www.americanexpress.com>. Opposer has made no claim of trademark rights, and provided no evidence of rights, in either <https://www.americanexpress.com> or the phrase “americanexpress”. Opposer has neither made of record trademark registrations or provided any common law evidence to establish such trademark rights. Accordingly, Applicant submits that this likelihood of confusion analysis must limit its comparison to Applicant’s “Amerixpress” mark and Opposer’s “American Express” mark.

import/export company that provides trusted goods from America. *See* TTABVUE Docket No. 25, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at Response No. 9. “Ameri” was selected as a reference to America, because while consumers often don’t trust the goods from certain countries (e.g., India, China), consumers do trust the quality of goods made and purchased in America. *See id.* “Xpress” was selected as an indicator of an import/export company. *See id.* In contrast, as acknowledged by Opposer, the “American Express” mark has no specific meaning, *see* TTABVUE Docket No. 8, Opposer’s Memo of Law, at p. 22, ll. 1-4, except that the “American Express” mark imbues consumers with commercial connotations and impressions of a particular brand of financial goods and/or services, namely the American Express-branded charge card product and service. *See id.* Clearly, the connotations and commercial impressions provided by the marks are quite different. In that Opposer alleges that its mark is well-known to consumers for the American Express-branded charge card products and services, Applicant submits that such differences in commercial connotation and impression are more than enough to render any potential consumer confusion unlikely.

Therefore, given the dissimilarity of appearance, sound, connotation and commercial impression, Applicant submits that confusion is unlikely.

#### **4. The relevant goods and services are not related**

The dissimilarity of the goods or services favors a finding that likelihood of confusion is unlikely. Any analysis is necessarily drawn from the evidence of record. *In re E.I. du Pont*, 476 F.2d at 1361.

As the Board is aware, there is no “under the same roof” rule that all products with similar marks sold in one store will cause confusion. *See Federated Foods*, 192 U.S.P.Q. at 29. The Board has also recognized that there is no *per se* rule that confusion is likely where similar marks concern department store services and a product that may be sold in the store, the Board stating that:

[i]t is common knowledge that there are sold in many hardware, grocer, variety and drug stores an almost unlimited variety of goods . . . . The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source.

Similarly, there is no *per se* rule that confusion is likely simply because the marks involved concern department store services and an item that could be sold in a department store.

*Irwin Auger Bit*, 134 U.S.P.Q. at 39. Similarly, the Board has recognized that there is no *per se* rule that confusion exists among similar marks used for food/beverage products and restaurant services. *See Lloyd’s Food Prods., Inc. v. Eli’s, Inc.*, 987 F.2d 766, 768, 25 U.S.P.Q.2d 2027, 2030 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 U.S.P.Q.2d 1812, 1813 (T.T.A.B. 2001). Rather, for confusion to exist in any of the above scenarios, the evidence of record must show “something more” than similar or even identical marks are used for the products and/or services at issue. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003). In *Coors Brewing*, this “something more” was lacking and thus there was no confusion between COORS for restaurant services and COORS for beer. *See id.* In *Coors Brewing*, “something more” was lacking where the evidence demonstrated that only a small number of restaurants sold or brewed their own private beer, and therefore, the degree of overlap between the sources of restaurant services and the sources of beer was *de minimis*. *See id.*

Here, the required “something more” is lacking and the degree of overlap between the source of Applicant’s goods/services and the source of Opposer’s goods/services is *de minimis*. The relevant goods and services listed in Applicant’s trademark applications are supplements (i.e., nutritional supplements), import agency services and export agency services. Opposer does not claim to provide such supplements, import agency services or export agency services directly to consumers. Rather, Opposer claims only that (1) the American Express-branded charge card can be used to purchase such supplements, (2) the American Express-branded charge card can be used to ship such supplements, (3) such supplements can be purchased through Opposer’s Membership Reward program, and (4) Applicant’s import/export services may involve foreign currency transactions sourced from American Express services. Applicant submits that such allegations do not amount to the “something more” required to establish a relationship between Applicant’s and Opposer’s goods and/or services. Notably, Opposer provides absolutely no data regarding the percentage of purchases made using the American Express-branded charge card that represent the purchase and/or shipment of supplement products and, in the complete absence of such data, cannot demonstrate any relationship between the goods/services of Applicant and Opposer. *See In re Coors Brewing*, 343 F.3d at 1345, 68 U.S.P.Q.2d at 1063 (no relationship found between goods/services even where applicant’s and opposer’s marks were identical); *cf. Weider Pubs., LLC v. D&D Beauty Care Co., LLC*, 109 U.S.P.Q. 1347, 1356 (C.C.P.A. 1972) (relationship only where 35 percent of opposer’s editorial content and 30 percent of advertising content was directed to applicant’s goods/services). While Opposer alleges that supplements may be purchased at tens of thousands retail locations, consumers will readily recognize that such

supplements are one of “an almost unlimited variety of goods” that may be sold at such locations. *Irwin Auger Bit Co.*, 134 U.S.P.Q. at 39. Opposer also provides absolutely no data regarding the percentage of purchases made via the American Express-branded charge card that represent the shipment of supplement products and, in the complete absence of such data, cannot demonstrate any relationship between the goods/services of Applicant and Opposer. *See In re Coors Brewing*, 343 F.3d at 1345, 68 USPQ2d at 1063; *cf. Weider Pubs.*, 109 U.S.P.Q. at 1356. Similarly, Opposer provides absolutely no data regarding the percentage of purchases made of supplements via Opposer’s Membership Reward program and, in the complete absence of such data, cannot demonstrate any perceived relationship between the goods/services of Applicant and Opposer. Even Opposer admits that vitamins, minerals and supplements are simply one “*among the many thousands* of products available . . .” through the Membership Rewards Program, *see* TTABVUE Docket No. 8, Silver Decl., ¶ 26 (emphasis added), with no special relationship established between American Express and any of these many thousands of products.<sup>6</sup> Finally, Opposer also fails to provide any data regarding the percentage of American Express foreign exchange services that involve import/export services and, in the complete absence of such data, cannot demonstrate any relationship between the goods/services of Applicant and Opposer. *See In re Coors Brewing*, 343 F.3d at 1345, 68 U.S.P.Q.2d at 1063; *cf. Weider Pubs.*, 109 U.S.P.Q. at 1356. In sum, although Opposer attempts to associate its “American Express” mark with Applicant’s goods and services,

---

<sup>6</sup> Moreover, a review of website screenshots from the American Express-branded Membership Rewards Program reveals that the available products are all clearly branded as third-party products, not as American Express-branded products, with no relationship established between any one of the available products and American Express. *See* TTABVUE Docket No. 8, Silver Decl., ¶ 26, Exh. 29.

the evidence of record not only fails to provide that “something more” required to establish such an association or relationship, but also fails to demonstrate any consumer association between American Express and Applicant’s goods and services.

Applicant notes that Opposer attempts to rely on the decision of *Weider Pubs.*, 109 U.S.P.Q. at 1356 (C.C.P.A. 1972) for the argument that a sufficient relationship exists between Applicant’s goods/services and the financially-based products and services offered by American Express. However, Applicant submits that the decision of *Weider Pubs.* is consistent with the case law cited above, where it well established that “something more” is required to establish a relationship between different goods/services, even where the same mark is used. *See In re Coors Brewing*, 343 F.3d at 1345, 68 U.S.P.Q.2d at 1063. In *Weider Pubs.*, which concerned identical marks - SHAPE for beauty salon, nail care and health care spas and SHAPE for print and online magazines - this “something more” was established only after demonstrating that approximately 35 percent of opposer’s editorial content dealt with beauty and fashion and 30 percent of its advertising content was directed to the same.<sup>7</sup> *See Weider Pubs.*, 109 U.S.P.Q. at 1356. As discussed above, Opposer fails to provide any data regarding the percentage or portion of American Express services that are associated with Applicants goods/services, much less data demonstrating that Applicants goods/services are significant feature or portion of the American Express services. In the complete absence of such data, Opposer cannot demonstrate any relationship between the goods/services of Applicant and Opposer. *See In re Coors Brewing*, 343 F.3d at 1345, 68 U.S.P.Q.2d at 1063 (no relationship found

---

<sup>7</sup> The court in *Weider Pubs.* followed the Boards decision in *The Conde Nast Publications Inc. v Vogue Travel*, 205 U.S.P.Q. 579 (T.T.A.B. 1979), where VOGUE for magazines and VOGUE for travel agency services were considered related, based only the fact that the topic of travel was a significant feature in the magazine. *See id.*



between goods/services even where applicant's and opposer's marks were identical); *cf. Weider Pubs.*, 109 U.S.P.Q. at 1356 (relationship found only where 35 percent of opposer's editorial content and 30 percent of advertising content was directed to applicant's goods/services). As also discussed above, while Opposer alleges that Applicant's goods/services may be found at thousands of retail locations, consumers will readily recognize that such goods/services are only one of "an almost unlimited variety of goods" that are provided at such locations, such that no relationship would be established between the goods/services of Opposer and the goods/services provided at such locations. *Irwin Auger Bit Co.*, 134 U.S.P.Q. at 39; *see also The Conde Nast Publications Inc. v Vogue Travel*, 205 U.S.P.Q. 579 (T.T.A.B. 1979) (magazine and travel agency service related only where the topic of travel was a *significant feature* in the magazine).

Furthermore, Applicant notes that Opposer has failed to submit other evidence commonly used to establish that certain goods and/or services may be considered related by consumers and thus emanate from a single source. Opposer has failed to provide any U.S. Trademark Registration with a goods/services identification that includes both Opposer's and Applicant's goods and/or services. Such an absence confirms that a single source rarely if ever provides both Applicant's and Opposer's goods and/or services, and therefore, consumers are unlikely to believe that such dissimilar goods and/or services originate from a single source. Moreover, whereas Opposer is involved in financial goods and services, supplements are chemically manufactured products and import/export agency services concern cross-border logistics for physical goods. Opposer has submitted no evidence that consumers are likely to believe that a company that specializes in financial services will also have chemical manufacturing expertise as

well as cross-border logistical expertise for such manufactured physical products. Instead, Applicant submits that consumers would believe that such companies and goods/services are unrelated.

Therefore, given dissimilar and unrelated goods and services as discussed above, Applicant submits that confusion is unlikely.

### **5. Dissimilar trade channels and consumers**

Considering the evidence of record, it is clear that the evidence does not definitely establish that similar trade channels and consumers exist for the relevant goods/services.

With respect to supplements, import agency services and export agency services and the “Ameriexpress” mark, Applicant has explained that the relevant channels of trade and buyers involve “buying of vitamins/minerals/dietary and nutritional supplements from United States based wholesalers and exporting said products to distributors in Vietnam for further distribution to Vietnam businesses and consumers” while furthermore “products would be imported into the United States from Vietnam, as the business concept [is] as an import/export business”, TTABVUE Docket No. 25, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at Response No. 2, whereas when discussing trade channels and consumers, Opposer offers no conflicting facts on these issues. *See* Opposer’s Trial Brief, pgs. 23-24. Rather, Opposer merely offers the legal conclusion that Applicant’s and Opposer’s trade channels and consumers must overlap. However, Applicant reminds Opposer that all issues are determined on the evidence of record, not mere legal conclusions.

With respect to supplements and the “AmeriXpress” mark, Opposer appears to allege that the American Express-branded charge card can be used to purchase supplements at retail locations and via the American Express Membership Rewards Program. *See id.* However, Opposer has provided no facts as to how consumers encounter any American Express-branded product or service at such retail locations. *See id.* It is presumed that most consumers are unaware of any American Express-branded product or service at any retail location, as most consumers are not holders of an American Express-branded charge card - i.e., American Express users remain a small subset of all consumers. It is also presumed that many if not most retail locations provide no American Express-branded product or service, as many if not most retail locations don’t offer the American Express-branded charge card as a payment option. Notably, such data was not offered by Opposer during discovery other otherwise introduced into evidence. As for the American Express Membership Rewards Program, while Opposer has provided some information regarding the products available through the Rewards Program, such products have been demonstrated to be only third-party-branded products (e.g., third-party-branded supplements), and that such products are available through the Rewards Program only to the extent American Express makes them available. In other words, supplements are available via the Rewards Program only if American Express intentionally included the supplements in the Rewards Program – a trade channel entirely controlled by American Express.

With respect to import agency services and export agency services and the “AmeriXpress” mark, Opposer appears to allege that American Express-branded charge card can be used to purchase shipping services. *See id.* However, Applicant points out

that shipping services are quite different from the import/export services provided by import/export companies. Whereas shipping companies such as Federal Express assist in the movement of goods (freight) from point A to point B, an import/export company is able to facilitate the actual *trade* of goods across borders – for example by obtaining necessary import/export permits and advising on other cross-border issues. In contrast, a shipping company such as Federal Express is unable to ship a parcel unless all import/export permits and other requirements have already been satisfied (e.g., by an import/export company). Even the USPTO distinguishes between import/export agency services and shipping services, classifying import/export services in International Class 035 (advertising, business management, administration, office functions) while classifying shipping services in International Class 039 (transport, packaging and storage of goods, travel arrangement). In sum, the evidence of record does not definitely establish that import/export agency services and the American Express-branded charge card are found in similar channels of trade and/or with similar consumers.

#### **6. The conditions under which sales are made**

The conditions of sale favor a finding that likelihood of confusion is unlikely. Circumstances suggesting care in consumption behavior tend to minimize the likelihood of confusion. *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (concluding that, because only knowledgeable purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks). Here, consumers would tend to take care before their purchase decision. The products and services offered are not “impulse purchases” that would be purchased without significant research beforehand.

With respect to “supplements” (i.e., nutritional or dietary supplements), Applicant notes that the TTAB has previously held that consumers will exercise at least a moderate degree of consumer care when purchasing dietary supplements, irrespective of whether the product is expensive or inexpensive. *See Inter Ikea Systems*, 110 U.S.P.Q.2d at 1745. Moreover, Applicant has noted the large expense – purchases in the tens of thousands of dollars per supplement – required for the wholesale purchase of supplements. *See* TTABVUE Docket No. 25, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at Response No. 3. The expense and complexity of issues necessarily increases where supplements are purchased for export to other countries – Applicant’s “export agency services”. *Id.* Again considering the expense and complexity of issues in dealing with cross-border requirements, consumers engaging either “export agency services” or “import agency services” are necessarily careful. Simply put, all of Applicant’s products and services require careful consideration from consumers. None of Applicant’s products or services are the subject of impulse purchases.

Opposer has presented no evidence with respect to consumer behavior in obtaining or using its financial goods and services, the American Express-branded charge card and service, namely whether such goods and services are impulse purchases or the subject of careful sophisticated purchasing. However, the obtaining of an American Express-branded charge card requires initially completing and filing an application with American Express. Such credit-based applications necessarily include a credit check and/or the disclosure of the consumer’s social security number. As such, obtaining an American Express-branded charge card also requires careful consideration on the part of

consumers. Once a holder of an American Express-branded charge card, the consumer must then, when making a purchase, determine whether a merchant accepts the card - American Express-branded charge cards are not accepted everywhere. The consumer must then use the card at the merchant and at a subsequent date settle the bill for the card. As such, use of the American Express-branded charge card and service also requires at least a moderate degree of consumer care.

Therefore, in view of the discussion above, Applicant submits that consumers will exercise at least a moderate degree of care when purchasing any of the goods/services of Applicant and Opposer. *See Inter Ikea Systems*, 110 U.S.P.Q.2d at 1745.

#### **7. The “Amerixpress” mark is the result of imagination**

Not only is the “Amerixpress” mark the result of Applicant’s imagination but Applicant took steps to avoid consumer confusion with other marks. As discussed above, Applicant created the “Amerixpress” mark so as to provide consumers – especially Vietnamese consumers - with the connotation and commercial impression of an import/export company that provides trusted goods from America. *See* TTABVUE Docket No. 25, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at Response No. 9. To this end, “Ameri” was selected as a reference to America, because while consumers often don’t trust the goods from certain countries (e.g., India, China), consumers do trust the quality of goods made and purchased in America, whereas “Xpress” was selected as an indicator of an import/export company. *See id.* Moreover, when creating the marks, Applicant conducted a Google search and found only Amerixpress Inc., an Illinois trucking company, but no use of “Amerixpress” by Opposer much less use of the marks by anyone

in connection with the relevant goods or services. *See id.* Furthermore, on January 29, 2016, Applicant conducted through legal counsel an online search of the USPTO’s database (TESS), concluding that there was no conflict with any existing trademark. *See id.* As such, Applicant not only never intended to create an association between its marks and the “American Express” mark, but actively took steps to ensure that no association would exist between any marks.<sup>8</sup> Opposer attempts to suggest unclean hands because Applicant didn’t remember at one time having an American Express credit card – a card obtained only because it was required by the merchant Costco and held only for a short period of time (believed to be less than a year) for business purposes. However, imperfect memory does not amount to unclean hands. Not only does Applicant challenge any individual to perfectly remember the specific brand of credit card (e.g., whether Visa, MasterCard, American Express or Discovery) they carry at any one point in time, but it is emphasized that Applicant never denied knowing of American Express and even recognized that American Express is well known for financial products and services. *See id.*, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. C, Deposition of Tung B. Vo, at pg. 70. Rather, as discussed above, when creating the “Amerixpress” mark via imagination, Applicant took steps to ensure consumer confusion with any other mark was unlikely, including conducting its own trademark search as well as engaging legal counsel to provide trademark search and analysis services. *See id.*, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at

---

<sup>8</sup> In declining to issue any refusal during prosecution of Applicant’s trademark applications before the USPTO, the Examining Attorney agreed that no confusion or consumer association was likely.

Response No. 9; Exh. C, Deposition of Tung B. Vo, at pgs. 69-70. As such, Applicant submits that any inference regarding intention must favor Applicant.

**B. The “Amerixpress” mark is Unlikely to Dilute “American Express”**

**1. Opposer has the burden of proof**

In a successful dilution claim, the moving party must establish the following: (1) it owns a distinctive, famous mark, (2), the nonmoving party is using a mark that is likely to dilute the famous mark, and (3) the nonmoving party began using its mark after the mark became famous, and (4) the non-moving party’s use of its mark is likely to cause dilution. Dilution is an extraordinary remedy and, as such, all doubts must be resolved against the party claiming dilution. *See Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001). As discussed below, the evidence of record compels the conclusion that dilution is unlikely.

**2. The “American Express” mark is not famous**

Fame in the context of dilution is an extremely high standard, requiring that what was once a common word is now a word the public associates with the famous mark, where the party claiming fame must prove that the mark has become the principal meaning of the word. *See Toro*, 61 U.S.P.Q.2d at 1180. For dilution, it is a higher standard of fame than that required for likelihood of confusion. *See id.* As discussed above, the AMERICAN EXPRESS mark cannot be considered “famous” on the evidence of record. As discussed in detail above, considering the evidence of record, Opposer fails to provide any data or other evidence with respect the issue of fame and comparable types of products or services. That is, Opposer fails to introduce any data or other



evidence with respect to the goods and services relevant to Applicant's trademark applications, namely supplements, import agency services and/or export agency services. Furthermore, Opposer has failed to submit evidence showing that the public associates the "American Express" mark as the principal meaning for this combination of words. In that both words "American" and "Express" are extremely common words, used in an almost unlimited number of ways by the public, it is submitted that the "American Express" mark cannot be considered the principal meaning of "American" and "Express" to the exclusion of all other meanings. Accordingly, Applicant submits that a finding of fame is not possible on the evidentiary record in the context of dilution.

### **3. Applicant's use of its marks is not likely to cause dilution**

Pursuant to 15 U.S.C. § 1125(c)(2)(B), six factors may be considered in determining the likelihood of dilution, namely (1) the similarity of the marks, (2) the distinctiveness of the famous mark, (3) the extent to which the owner of the famous mark is engaged in substantially exclusive use of the mark, (4) the degree of recognition of the famous mark, (5) whether there was any intention on the part of the Application to create an association with the famous mark, and (6) any actual association.

"Without virtual identity, the injury of blurring is unlikely to occur." McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24:119. A party asserting dilution must prove more than confusing similarity; it must show that the marks are "identical or substantially similar". See *Toro*, 61 U.S.P.Q.2d at 1183 ("While the marks TORO and ToroMR and design are similar, we do not find that they are substantially similar for dilution purposes."); see also McCarthy, § 24: 117 ("Blurring is one mark seen by customers as now identifying two sources. Two different marks identifying two different

sources is not blurring and will not be likely to cause dilution. For example, if the marks are different in sight and sound and only similar in meaning, the ‘one mark, two sources’ phenomenon of ‘blurring’ is not likely to occur”).

As established above, the “Amerixpress” and “American Express” marks are dissimilar in appearance and sound, and create dissimilar commercial impressions. Notably, Applicant’s mark does not include the term “American” or “Express”, the two terms that make up the entirety of Opposer’s mark. Given the prominence of these two terms in Opposer’s mark, the terms “American” and “Express” render the mark different in appearance and overall pronunciation compared to Applicant’s “Amerixpress”, which lacks both the terms “American” and “Express”. Conversely, Opposer’s mark does not include the phrase “Amerixpress”, not only the dominant but the only term that makes up the entirety of Applicant’s mark. Given the prominence of this term in Applicant’s mark, the term “Amerixpress” renders the mark different in appearance and overall pronunciation compared to Opposer’s “American Express”, which lacks the entire term “Amerixpress”. Indeed, consumers encountering Applicant’s mark are presented with the new and previously unknown – in appearance and sound – term “Amerixpress”, whereas consumers encountering “American Express” are presented not only with two commonly known words but a combination of words that is already well known. Thus, the marks are dissimilar visually, aurally and in meaning.

Applicant also notes that comparing the marks in their entirety reveals actual differences in appearance and sound. Differences in appearance indicate that dilution is unlikely. “Amerixpress” is comprised of one (1) word and “Amerixpress LLC” is comprised of one (1) word (and one (1) business entity designation), whereas “American

Express” is comprised of two (2) words. “American Express” is comprised of fifteen (15) letters and one (1) space while “Amerixpress” is comprised of only eleven (11) letters, i.e., 26.6% fewer letters than the “American Express” mark. Differences in sound further indicate that consumer confusion is unlikely. “Amerixpress” is pronounced as one (1) word whereas “American Express” is not only pronounced, but according to Opposer, well-recognized as two (2) words. *See* Opposer’s Trial Brief, pg. 16. Also, “A-mer-i-x-press” is pronounced as five (5) syllables – the designation L-L-C adding three (3) additional syllables – whereas “A-mer-i-can Ex-press” must be pronounced as a four (4) syllable term followed by a space (a pause) followed by a two (2) syllable term. Given that the “Amerixpress” mark is new and previously unknown – in appearance and sound, whereas “American Express” is made up of two extremely common words, where the combination of these two words is also well known, such differences in appearance and sound are more than enough to render any potential consumer confusion unlikely.

Applicant further submits that the marks are dissimilar in connotation and commercial impression. The “Amerixpress” mark is the result of Applicant’s imagination, wherein the marks were conceived to provide consumers – especially Vietnamese consumers - with the connotation and commercial impression of an import/export company that provides trusted goods from America. *See* TTABVUE Docket No. 25, Exh. 1 of Applicant’s Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant’s Response to Interrogatories, at Response No. 9. “Ameri” was selected as a reference to America, because while consumers often don’t trust the goods from certain countries (e.g., India, China), consumers do trust the quality of goods made and purchased in America. *See id.* “Xpress” was selected as an indicator of an import/export

company. *See id.* In contrast, as acknowledged by Opposer, the “American Express” mark has no specific meaning, *see* TTABVUE Docket No. 8, Opposer’s Memo of Law, at p. 22, ll. 1-4, except that the “American Express” mark imbues consumers with connotations and commercial impressions of a particular brand of financial goods and/or services, namely the American Express-branded charge card product and service. *See id.* Clearly, the connotations and commercial impressions provided by the marks are quite different. In that Opposer alleges that its mark is well-known to consumers for American Express-branded charge card products and services, Applicant submits that such differences in connotation and commercial impression are more than enough to render any potential consumer confusion unlikely.

Therefore, for the reasons discussed above, the heightened “identical or substantially identical” standard of dilution cannot be met, and there can be no dilution. *See e.g., 7-Eleven Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1729 (T.T.A.B. 2007) (“In discussing likelihood of confusion, we found that GULPY and BIG GULP are not similar. Given that finding of fact, in the context of dilution, we must also find that the marks are not substantially similar”). Applicant notes that marks have been found to lack the requisite similarity for a dilution claim under a state statute having essentially the same purpose as 15 U.S.C. § 1125(c)(2)(B), where only a single different letter leads to a difference in how the marks are pronounced. *See Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026, 1029-30, 10 U.S.P.Q.2d 1961 (2d Cir. 1989) (LEXIS and LEXUS differ by only one letter and thus not similar for purposes of a dilution claim).

Furthermore, Applicant never intended to create an association between its “Amerixpress” mark and any other mark. Not only is the “Amerixpress” mark the result

of Applicant's imagination but Applicant took steps to avoid consumer confusion with any other mark. As discussed above, Applicant created the "Amerixpress" mark so as to provide consumers – especially Vietnamese consumers - with the connotation and commercial impression of an import/export company that provides trusted goods from America. *See* TTABVue Docket No. 25, Exh. 1 of Applicant's Trial Evidence by Declaration, ¶ 1; Exh. A, Applicant's Response to Interrogatories, at Response No. 9. To this end, "Ameri" was selected as a reference to America, because while consumers often don't trust the goods from certain countries (e.g., India, China), consumers do trust the quality of goods made and purchased in America, whereas "Xpress" was selected as an indicator of an import/export company. *See id.* Moreover, when creating the marks, Applicant conducted a Google search and found only Amerixpress Inc., an Illinois trucking company, but no use of "Amerixpress" by Opposer much less use of the mark by Opposer in connection with the relevant goods or services. *See id.* Furthermore, on January 29, 2016, Applicant conducted through legal counsel an online search of the USPTO's database (TESS), concluding that there was no conflict with any existing trademark. *See id.* As such, Applicant not only never intended to create an association between its mark and the "American Express" mark, but actively took steps to ensure that no association would exist between marks.<sup>9</sup> As such, Applicant submits that the evidence of record supports the lack of any intention to associate.

In view of the discussion above, Applicant submits that the evidence of record compels the conclusion that dilution is unlikely.

---

<sup>9</sup> In declining to issue any refusal during prosecution of Applicant's trademark applications before the USPTO, the Examining Attorney agreed that no consumer association between marks was likely.

## V. CONCLUSION

Consideration of the *du Pont* factors compels the conclusion that Applicant's "Amerixpress" mark is so dissimilar to Opposer's "American Express" mark as to be unlikely to cause confusion. Given, *inter alia*, the lack of fame, the differences in appearance, sound and impression and the lack of relationship among relevant goods/services, the "Amerixpress" mark is unlikely to cause confusion, mistake or deception. Furthermore, the "Amerixpress" mark is so dissimilar to the "American Express" mark that dilution is extremely unlikely. Accordingly, Applicant respectfully submits that this consolidated opposition proceeding should be dismissed and the trademark applications for the "Amerixpress" mark be allowed to proceed towards allowance and registration.

Respectfully submitted,



Dated: October 5, 2018

---

HANS J. CROSBY, ESQ.  
CLASSIC COUNSEL, P.C.  
1125 West Street, Suite 200  
Annapolis, MD 21401  
Tel. 240.744.4614  
Email: hcrosby@ClassicCounsel.com

Attorney for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of APPLICANT'S ACCELERATED CASE RESOLUTION TRIAL BRIEF, has been served on Opposer's designated representative/attorney, on October 5, 2018, via the email(s) of record.



---

Hans J. Crosby, Esq.