

This Opinion is Not a  
Precedent of the TTAB

Hearing: December 12, 2018

Mailed: December 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*American Express Marketing & Development Corp.*

*v.*

*Tung B. Vo*

—  
Opposition No. 91230559

Opposition No. 91232714  
—

Timothy J. Kelly and Jessica Hiney of McCarter & English, L.L.P.,  
for American Express Marketing & Development Corp.

Hans J. Crosby of Classic Counsel PC,  
for Tung B. Vo.

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Before Cataldo, Taylor and Bergsman,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Tung B. Vo (“Applicant”) has filed applications on the Principal Register for the mark AMERIXPRESS (standard characters) for “import agency services,” in Class

35,<sup>1</sup> and AMERIXPRESS LLC (standard characters) for the goods and services listed below:

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 Class 5; and

Export agency services for the goods of others, in Class 35.<sup>2</sup>

Applicant disclaimed the exclusive right to use the term “LLC.”

American Express Marketing & Development Corp. (“Opposer”) filed Notices of Opposition against the registration of Applicant’s marks under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c), on the grounds that Applicant’s marks are likely to cause confusion with and are likely to dilute Opposer’s registered AMERICAN EXPRESS marks. Opposer pleaded ownership of nine registrations including

- Registration No. 1024840 for the mark AMERICAN EXPRESS (typed drawing) for, inter alia,

General merchandise mail order services, in Class 42;

Financial and financially related services, namely, credit card services, traveler’s check services, money order services, international banking services, investment banking services, military banking services, financial

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<sup>1</sup> Application Serial No. 86894103, filed February 2, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s claim of a bona fide intent to use the mark in commerce.

<sup>2</sup> Application Serial No. 86881103, filed January 20, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s claim of a bona fide intent to use the mark in commerce.

services for travelers, foreign remittance services, electronic funds transfer services, mutual fund investment services and insurance underwriting services, in Class 36;

Computerized credit authorization, convention and meeting arrangement services and real estate management services, in Class 35;<sup>3</sup> and

- Registration No. 4225805 for the mark AMERICAN EXPRESS (standard characters) for, inter alia,

Providing online forums and electronic bulletin boards for transmission of messages among computer users concerning small business advice; providing equipment and facilities for videoconferencing, teleconferencing, and telepresence conferencing, in Class 38;

Assistance with electronic transfers of money; banking services; foreign currency exchange services; payment processing services, namely, charge card, credit card, prepaid card, gift card, stored value card and payment card transaction processing services; electronic charge card, credit card, prepaid card, gift card, stored value card and payment card transactions; issuing charge cards, credit cards, prepaid cards, prepaid gift cards, stored value cards and payment cards; providing online information for merchants regarding guidelines and fees pertaining to credit card acceptance, in Class 36; and

Business development services, namely, providing start-up support for businesses of others; business management consultation; assisting businesses in obtaining government contracts; corporate meeting management services; providing facilities for business meetings, in Class 35.<sup>4</sup>

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<sup>3</sup> Registered November 11, 1975; third renewal.

Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

<sup>4</sup> Registered October 16, 2012, Sections 8 and 15 declarations accepted and acknowledged.

Applicant, in its Answers, denied the salient allegations in the Notices of Opposition.

The Board consolidated proceedings in an order dated March 8, 2017.<sup>5</sup>

On November 28, 2017, Opposer filed a motion for summary judgment.<sup>6</sup> The Board found in a decision issued on May 21, 2018 that there were no genuine disputes of material fact regarding Opposer's standing and priority because Opposer introduced copies of its pleaded registrations printed from the USPTO electronic database, as well as paper copies printed by the USPTO showing the current status and title of the pleaded registrations.<sup>7</sup> However, the Board found that there were genuine disputes of material fact with respect to the similarity of the marks and the relatedness of the goods and services, as well as to whether Applicant's marks will dilute the distinctiveness of Opposer's marks and, therefore, denied Opposer's motion for summary judgment on the likelihood of confusion and dilution claims.<sup>8</sup>

Subsequently, the parties stipulated to use the Accelerated Case Resolution (ACR) process to litigate these proceedings. The parties agreed that the summary judgment record, as supplemented during trial, is the trial record.<sup>9</sup>

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<sup>5</sup> 7 TTABVUE.

<sup>6</sup> 8 TTABVUE.

<sup>7</sup> 14 TTABVUE 3-4.

<sup>8</sup> 14 TTABVUE 4-6.

<sup>9</sup> 23 TTABVUE 2.

## I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application files. The parties introduced the testimony and evidence listed below:

### A. Opposer's testimony and evidence.

1. Declaration of Allison B. Silver, Vice President of Global Advertising and Brand Marketing for American Express Travel Related Services Company, Inc., Opposer's corporate parent;<sup>10</sup>
2. Declaration of Timothy J. Kelly, Opposer's counsel;<sup>11</sup>
3. Excerpts from Applicant's discovery deposition;<sup>12</sup> and
4. Declaration of Aya Cieslak-Tochigi, one of Opposer's attorneys.<sup>13</sup>

### B. Defendant's testimony and evidence.

1. Declaration of Hans J. Crosby, Applicant's counsel;<sup>14</sup> and
2. Applicant's testimony declaration, including Applicant's second amended responses to Opposer's first set of interrogatories and request for production of documents, and Applicant's discovery deposition transcript.<sup>15</sup>

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<sup>10</sup> 8 TTABVUE. Portions of the Silver declaration designated confidential are posted at 10 TTABVUE.

<sup>11</sup> 9 TTABVUE. Portions of the Kelly declaration designated confidential are posted at 10 TTABVUE.

<sup>12</sup> 9 TTABVUE 10-100.

<sup>13</sup> 12 TTABVUE 13-108.

<sup>14</sup> 11 TTABVUE 26-49.

<sup>15</sup> 25 TTABVUE. Responses to document production requests are admissible solely for the purpose of showing that a party has stated that there are no responsive documents. *See City*

## II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is

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*Nat’l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012).

record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l*, 64 USPQ2d at 1380).

A. The strength and fame of Opposer’s AMERICAN EXPRESS mark.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. The inherent strength of the AMERICAN EXPRESS mark.

AMERICAN EXPRESS and variations registered by Opposer are inherently distinctive. As noted above, Opposer has made of record its pleaded AMERICAN

EXPRESS registrations which are not subject to any counterclaims for cancellation. The registrations are registered on the Principal Register without any disclaimers or claims of acquired distinctiveness. The registrations are “prima facie evidence of the validity of the registered mark[s] and of the registration of the mark[s], of the owner’s ownership of the mark[s], and of the owner’s exclusive right to use the registered mark[s] in commerce on or in connection with the goods or services specified in the certificate[s].” Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

In assessing the inherent strength of Opposer’s marks, we note that there is no testimony or evidence regarding the number and nature of similar marks in use on similar goods or services or third-party registrations consisting in whole, or in part, of AMERICAN EXPRESS or variations thereof. Evidence that a mark, or an element of a mark, has been adopted by many different registrants may indicate that the common element has some non-source identifying significance that undermines its conceptual or inherent strength as an indicator of a single source. *Jack Wolfskin Austrang Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’”) (quoting *Juice Generation*, 115 USPQ2d at 1674).



2. The commercial strength of Plaintiff's marks.

Opposer alleges and argues that AMERICAN EXPRESS is a famous mark.<sup>16</sup> Applicant, on the other hand, testified that he considers AMERICAN EXPRESS to be well-known, not famous.<sup>17</sup> According to the ENCYCLOPAEDIA BRITANNICA, Opposer "is a leading issuer of personal, small business, and corporate credit cards," and that "[t]he classic American Express green charge card was introduced in 1958."<sup>18</sup> Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

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<sup>16</sup> Notices of Opposition ¶¶4, 6 and 9 (1 TTABVUE 11, 16, and 18); Opposer's Brief, pp. 2, 4-7 and 13-17 (26 TTABVUE 9, 11-4 and 20-24).

<sup>17</sup> Applicant's Discovery Dep., p. 12 (25 TTABVUE 51); *see also* Applicant's Brief, p. 11 (27 TTABVUE 12) ("It is recognized that Opposer American Express is well known in the financial services industry, in particular the American Express-branded charge card product and services.").

<sup>18</sup> American Express Company, ENCYCLOPAEDIA BRITANNICA (2018). The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) ("dictionaries and encyclopedias may be consulted"); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works).

When a trademark attains recognition in an encyclopedia, we may take it to be reasonably well-known. *Cf. B.V.D. Licensing Corp. v. Body Action Design Inc.*, 6 USPQ2d at 1721 ("When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous.").

“[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))).

Fame may be measured indirectly by the volume of sales and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice, by independent sources, of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06, 1309.); *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014). Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Bose* at 1309. In other words, there may be the need for testimony or evidence that contextualizes the numbers so that the Board may arrive at a proper understanding of whether consumers recognize the mark. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, \_\_\_ F.3d \_\_\_, \_\_\_ USPQ2d \_\_\_, \_\_\_ (Fed. Cir. 2018) (citing *Bose* at 1309).<sup>19</sup>

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<sup>19</sup> We disagree with Applicant’s contention that “some context in which to place raw numbers is necessary.” Applicant’s Brief, p. 10 (27 TTABVUE 11). Testimony or evidence to place raw numbers in context is necessary where the raw numbers may be misleading. If the raw numbers are not misleading, then testimony or evidence placing them in context is not

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer has introduced the testimony and evidence set forth below to show that AMERICAN EXPRESS is a famous mark:

- Credit cards in force from 2010 through 2016.<sup>20</sup>

<b>Year</b>	<b>In the United States</b>	<b>Outside the United States</b>
2010	48.9 million	42.1 million
2011	50.6 million	46.8 million
2012	52.0 million	50.4 million
2013	53.1 million	54.1 million
2014	54.9 million	57.3 million
2015	57.6 million	60.2 million
2016	47.5 million	62.4 million

- Amount billed by Opposer’s credit cardholders from 2010 through 2016.<sup>21</sup>

<b>Year</b>	<b>In the United States</b>	<b>Outside the United States</b>
2010	\$479.3 billion	\$234.0 billion
2011	\$542.8 billion	\$297.4 billion
2012	\$590.7 billion	\$297.7 billion
2013	\$637.0 billion	\$315.4 billion

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necessary. Obviously, the better practice is for the propounding party to introduce testimony and evidence into context so as to remove any doubt (e.g., the significance of the number of hits that a website may retrieve or the number of followers one has on social media).

<sup>20</sup> Opposer’s 2012 Annual Report, Silver Decl. ¶7 and Exhibit 5 (8 TTABVUE 144); Opposer’s 2014 Annual Report, Silver Decl. ¶7 and Exhibit 7 (8 TTABVUE 382); Opposer’s 2015 Annual Report, Silver Decl. ¶7 and Exhibit 8 (8 TTABVUE 557); Opposer’s 2016 Annual Report, Silver Decl. ¶7 and Exhibit 9 (8 TTABVUE 737).

<sup>21</sup> *Id.* at 8 TTABVUE 144, 382, 557 and 737.

<b>Year</b>	<b>In the United States</b>	<b>Outside the United States</b>
2014	\$688.1 billion	\$334.7 billion
2015	\$721.0 billion	\$318.7 billion
2016	\$700.4 billion	\$337.1 billion

- Opposer’s U.S. credit card services revenues and net income from 2010 through 2016.<sup>22</sup>

<b>Year</b>	<b>Revenue</b>	<b>Net Income</b>
2010	\$9.9 billion	\$2.2 billion
2011	\$10.8 billion	\$2.7 billion
2012	\$11.5 billion	\$2.6 billion
2013	\$12.1 billion	\$3.1 billion
2014	\$12.6 billion	\$3.2 billion
2015	\$13.1 billion	\$3.4 billion
2016	\$12.4 billion	\$2.5 billion

- “[Opposer] has invested on the average of \$2 *billion* per year since 2013 in advertising and promotion in the United States alone.”<sup>23</sup> Opposer has advertised on television, through online advertising, direct mail, and banner advertising. The advertising and promotional materials feature the AMERICAN EXPRESS trademark.<sup>24</sup>

<sup>22</sup> *Id.* at 8 TTABVUE 165, 387, 562 and 742. Ms. Silver testified that Opposer’s corporate records “shows hundreds of thousands of merchants – frequently with multiple United States locations – who accept AMERICAN EXPRESS®-branded cards” covering virtually every aspect of the U.S. economy. Silver Decl. ¶20 and Exhibit 18 (8 TTABVUE 36 and 10 TTABVUE 12-154). Although Exhibit 18 (designated confidential) shows thousands of merchants, some with multiple locations, across the spectrum of the economy, accept the AMERICAN EXPRESS credit card, we cannot verify that Exhibit 18 shows that hundreds of thousands of merchants accept Opposer’s card.

<sup>23</sup> Silver Decl. ¶16 and Exhibit 14 (8 TTABVUE 35 and 10 TTABVUE 3). It is not clear why Opposer designated Silver Exhibit 14 confidential because it is a bar chart summary of Opposer’s advertising expenditures to which Ms. Silver publicly testified. Thus, the bar chart summary does not have any trade secret or commercially sensitive information. Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g), “[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”

<sup>24</sup> Silver Decl. ¶16 (8 TTABVUE 35).

- The results of an internal survey conducted by Opposer for use in connection with its business found that when respondents were presented with an aided awareness question,<sup>25</sup> 98% (2016) and 99% (2017) of the respondents between the ages of 18-65 with an income greater than \$25,000 and 99% (2016 and 2017) of the respondents between the ages of 18-65 with a household income greater than \$75,000 and owning a credit card other than AMERICAN EXPRESS, recognized the AMERICAN EXPRESS trademark.<sup>26</sup>
- Since 2013, Opposer's corporate records show that Opposer's website americanexpress.com has generated almost 1.7 billion page views from more than 400 million unique visitors (an average of 340 million page views from an average of 20 million unique visitors).<sup>27</sup>
- In its 2017 list of "The World's Biggest Public Companies," Forbes (forbes.com) ranked Opposer as the 97<sup>th</sup> largest public company with a market value of \$70 billion on \$34 billion in sales and \$54 billion in profits.<sup>28</sup>

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<sup>25</sup> "How much do you know about American Express?"

<sup>26</sup> Silver Decl. ¶18 and Exhibit 16 (8 TTABVUE 36 and 10 TTABVUE 5-7). It is not clear why Opposer designated Silver Exhibit 16 confidential because it is a summary of the survey results to which Ms. Silver publicly testified. Thus, the survey summary does not have any trade secret or commercially sensitive information.

We find the internal survey probative because Opposer was testing the effectiveness of its advertising, marketing, and branding to determine its effectiveness.

<sup>27</sup> Silver Decl. ¶19 and Exhibit 17 (8 TTABVUE 36 and 10 TTABVUE 9-10). It is not clear why Opposer designated Silver Exhibit 17 confidential because it is a summary of Opposer's website traffic to which Ms. Silver publicly testified. Thus, the website traffic summary does not have any trade secret or commercially sensitive information.

<sup>28</sup> Silver Decl. ¶6 and Exhibit 1 (8 TTABVUE 31 and 41).

Forbes ranked AMERICAN EXPRESS as the World's 23<sup>rd</sup> most valuable brand.<sup>29</sup>

For purposes of context, rankings for the following companies in Forbes list of "The World's Biggest Public Companies" are listed below:<sup>30</sup>

<b>Company</b>	<b>Ranking</b>
JP Morgan Chase	4 <sup>th</sup>
Wells Fargo	5 <sup>th</sup>
Bank of America	7 <sup>th</sup>
Citigroup	12 <sup>th</sup>
US Bancorp	96 <sup>th</sup>
Capital One Financial	128 <sup>th</sup>
PNC Financial Services	147 <sup>th</sup>
Bank of New York Mellon	163 <sup>rd</sup>
Visa	174 <sup>th</sup>
BB&T	247 <sup>th</sup>
State Street	274 <sup>th</sup>
Sun Trust Banks	322 <sup>nd</sup>
MasterCard	379 <sup>th</sup>
PayPal	380 <sup>th</sup>
Fifth Third Bancorp	453 <sup>rd</sup>

- In 2017, CBS News (cbsnews.com) ranked AMERICAN EXPRESS as the 27<sup>th</sup> most valuable brand in the world with a net worth of \$17.8 billion;<sup>31</sup>
- In its 2012 Annual Report, Opposer reported that it had won its sixth straight J.D. Power and Associates award for highest customer satisfaction among U.S. credit card companies;<sup>32</sup> and

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<sup>29</sup> *Id.* at 8 TTABVUE 73; Silver Exhibit 4 (8 TTABVUE 113).

<sup>30</sup> Silver Decl. Exhibit 1 (8 TTABVUE 41-75).

<sup>31</sup> Silver Decl. ¶6 and Exhibit 2 (8 TTABVUE 31 and 77).

<sup>32</sup> Silver Exhibit 5 (8 TTABVUE 126).

- Interbrand Global Brand Consultancy, publisher of the annual “Best Global Brands” has listed AMERICAN EXPRESS as the 27<sup>th</sup> best brand in 2017, the 25<sup>th</sup> best brand in 2016 and 2015, as the 23<sup>rd</sup> best brand in 2014 and 2013, and the 24<sup>th</sup> best brand in 2012.<sup>33</sup>

The above-noted evidence establishes that AMERICAN EXPRESS is a famous mark in connection with credit card services. Opposer’s number of credit cards in force, the amount billed using the credit cards, and the revenues and net income generated by the AMERICAN EXPRESS credit card services in the United States are substantial by any measure. Likewise, Opposer’s advertising expenditures in the United States averaging \$2 billion dollars per year since 2013 are substantial by any measure. For purposes of context, we note that even though we do not have the comparable figures for Opposer’s competitors or market share information, FORBES ranked AMERICAN EXPRESS as the 97<sup>th</sup> largest public company, it ranked CAPITAL ONE as the 128<sup>th</sup> largest public company, VISA as the 174<sup>th</sup> largest public company, and MASTERCARD as the 379<sup>th</sup> largest public company. As a result, Opposer’s internal survey found that AMERICAN EXPRESS has a 99% aided awareness among the relevant public. Opposer’s internal survey results are corroborated by the high rankings AMERICAN EXPRESS has received as a global brand.<sup>34</sup>

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<sup>33</sup> Silver Decl. ¶6 and Exhibit 4 (8 TTABVUE 31 and 113-120).

<sup>34</sup> It would have been better for Opposer to have introduced testimony and evidence as to the renown of the AMERICAN EXPRESS mark in the United States because foreign use of a mark does not ordinarily influence purchaser perceptions in this country, and the evidence does not demonstrate that it does in this case. *Cf. Double J of Broward Inc. v. Skalony*

As noted above, AMERICAN EXPRESS is famous for Opposer's credit card services. We agree with Applicant that AMERICAN EXPRESS is not famous for import or export services or vitamin, mineral, or nutritional supplements.<sup>35</sup> However, the fact that AMERICAN EXPRESS is famous for credit card services and not for the goods and services for which Applicant seeks registration does not undercut the scope of protection that we accord a famous mark. *See Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897.

We think that the Board's rule—that the fame of the FRITO-LAY marks extends no further than the products with which the marks are currently used—undercuts the legal standard of protection for famous marks. Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. ...

This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is

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*Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) (information concerning applicant's foreign activities is not relevant to the issues in an opposition proceeding); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (since foreign trademark use creates no rights in the United States, any information or evidence pertaining to foreign use is thus immaterial to a party's right to register its mark in the United States); *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd*, *Miller Brewing Co. v. Oland's Breweries*, 548F.2d 349, 192 USPQ 266 (CCPA 1976). Nevertheless the totality of the evidence introduced by Opposer regarding the commercial strength and renown of the AMERICAN EXPRESS mark in terms of its global reach is probative but by no means dispositive of whether AMERICAN EXPRESS is famous in the United States.

<sup>35</sup> Applicant's Brief, pp. 10-11 (27 TTABVUE 11-12).



especially seductive. ... Accordingly, we hold that the fame of the mark must always be accorded full weight when determining the likelihood of confusion. When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a “long shadow which competitors must avoid.”

*Id.* (internal citations omitted).

In view of the foregoing, Opposer’s AMERICAN EXPRESS mark is entitled to a very broad scope of protection.

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“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 the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721; see also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The

proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, because the relevant goods and services include, inter alia, credit card services, nutritional supplements, and general merchandise mail order services, the average customer is an ordinary consumer, and there is no evidence in the record to suggest otherwise.

Applicant is seeking to register the marks AMERIXPRESS and AMERIXPRESS LLC and Opposer's mark is AMERICAN EXPRESS. Because the term "LLC" indicates a type of business entity, it has no source indicating significance and Applicant has disclaimed the exclusive right to use it.<sup>36</sup> *In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522, 1526 (TTAB 2006); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998) (the designation "Inc." has no trademark or service mark significance because it merely "indicates the type of entity that performs the services."); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (the designation "Inc." has no source indication or distinguishing capacity). Accordingly, we focus our attention on AMERIXPRESS. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests

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<sup>36</sup> May 9, 2016 Office Action in Application Serial No. 86881103 (Opposition No. 91232714).

on a consideration of the marks in their entireties. *Viterra*, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

AMERIXPRESS is similar to AMERICAN EXPRESS because both marks start with the term “AMERI” and end with “XPRESS.” Applicant’s compression of the terms “AMERI” and “XPRESS” into a single term AMERIXPRESS does not distinguish the marks because consumers, if they even notice of the compression of the terms, will view and verbalize it as AMERI XPRESS based on normal English pronunciation. *See, e.g., In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1312-13 (TTAB 2014) (MOMSBANGTEENS will be viewed and verbalized as MOMS BANG TEENS); *In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB 2011) (finding “Person2Person Payment” generic despite deletion of spaces); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that DESIGNED TO SELL does not create a distinct commercial impression from DESIGNED2SELL).

Also, Applicant’s use of “AMERI,” rather than “AMERICAN,” will not distinguish the marks because consumers will interpret “Ameri” as a shortened version of “America” or “American.”<sup>37</sup> Slight differences in marks do not normally create dissimilar marks. *See Mag Instr. Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1714-15 (TTAB 2010) (difference of a single letter does not suffice to distinguish MAG STAR from MAXSTAR); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Moreover, although there are certain differences between the [marks’ CAYNA and

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<sup>37</sup> Applicant’s Discovery Dep., pp. 24 and 37 (25 TTABVUE 63 and 76); Applicant’s response to Opposer’s interrogatory No. 9(c) (25 TTABVUE 23).

CANA] appearance, namely, the inclusion of the letter ‘Y’ and the design feature in applicant’s mark, there are also obvious similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions.”).

Likewise, Applicant’s use of XPRESS is a shortened form of the term EXPRESS. While there is not necessarily one correct pronunciation of a mark, based on normal English pronunciation, consumers are likely to pronounce XPRESS as “Express.” The word “Express” is defined, inter alia, as “to send by express: to express a package or merchandise” or “a system of method of sending freight, parcels, money, etc., that is faster and safer, but more expensive than ordinary freight service: we agree to send the package by express.”<sup>38</sup> Thus, both marks have similar meanings and engender similar commercial impressions (i.e., United States made or sent).<sup>39</sup>

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<sup>38</sup> Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2018). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). We note with some puzzlement that neither party introduced into the record definitions of the terms comprising the marks at issue.

Opposer started as an express mail business in 1850. Silver Decl. ¶¶6 and 9 (8 TTABVUE 31 and 32).

<sup>39</sup> Applicant’s Discovery Dep., p. 24 (25 TTABVUE 63) (“I figure AMERI, that half of the name would be, you know American, you know, American-made products, and XPRESS being something similar to an export. So they know, if they’re reading, they’re looking at the name, they’ll say, okay, this guy is, you know, an export company.”); *Id.* at p. 37 (25 TTABVUE 76) (“So AMERI as in American, and XPRESS as in export, and I wanted to use it so that

There is no doubt that if AMERICAN EXPRESS and AMERIXPRESS were placed side-by-side the differences between them including those enumerated by Applicant in its brief would be discernible.<sup>40</sup> However, in the normal environment of the marketplace where purchases are actually made, purchasers and prospective purchasers would not usually have the opportunity for a careful examination of these marks in minute detail. An individual relies on the recollection of the various marks that he has previously seen in the marketplace and, more frequently than not, his recollection is not obscured with minute details or specific characteristics of the marks, but is determined by an overall or general impression of the many and various marks that encompass him/her in his/her daily living experiences. Viewing the respective marks from this standpoint, it is apparent that there exist marked resemblances in the overall appearance, sound and commercial impression which they convey to customers. As we noted above, they both begin with AMERI and end with XPRESS.

Considering the fame of Opposer's mark, the resemblance between AMERICAN EXPRESS and AMERIXPRESS is sufficient to cause purchasers and prospective purchasers to find that the marks are more similar than dissimilar. Accordingly, when the marks are viewed as a whole, Applicant's mark AMERIXPRESS is similar

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Vietnamese people can, you know, look at it as a name that it can trust, that it's products made from the U.S."); Applicant's response to Opposer's interrogatory No. 9(c) (25 TTABVue 23) (Applicant selected "AMERI" as a reference to "America" and "XPRESS" as an indicator or an import/export company or a company that ships goods.").

<sup>40</sup> Applicant's Brief, pp. 16-17 (27 TTABVue 17-18).

to Opposer's mark AMERICAN EXPRESS in appearance, sound, meaning and commercial impression.

C. The similarity or dissimilarity and nature of the goods and services.

We readily acknowledge that Applicant's "import agency services," "export agency services for the goods of others," and vitamin, mineral and nutritional supplements differ from Opposer's credit card services and the various products and activities listed in Opposer's registrations. The test here is not, however, whether the goods and services are likely to be confused. Rather, the test is whether purchasers are likely to be confused as to source, connection or sponsorship between the providers of the products and services. As often stated, it is not necessary that the goods be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *See Hilson Research Inc. v. Soc'y for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1213, 1215 (TTAB 1990). When viewed in this light, we find that there is a likelihood that consumers will be confused into mistakenly believing that Applicant's products and services are somehow sponsored by or associated with Opposer.

“The crux of the issue before us is whether the respective goods [and services] sold ... under the marks are sufficiently related in the minds of the common purchasers to result in a likelihood of confusion.” *Berghoff Rest. Co. v. Washington Forge, Inc.*, 225 USPQ 603, 608 (TTAB 1985). In this case,

11. [Opposer’s] business provides a range of payment and expense management solutions to companies and organizations of all sizes. These solutions include cards, cross border payment services, and commercial financing, all under the AMERICAN EXPRESS® umbrella. ...

12. [Opposer’s] business offers a range of payment and expense management solutions to companies and organizations throughout the world, which solutions include local currency corporate cards in more than 85 countries and territories, as well as U.S. Dollar and euro corporate cards in more than 100 countries and territories.

...

24. In addition to the foregoing, [Opposer] has long had associations with companies focused on shipping. For example, [Federal Express, UPS, and the U.S. Postal Service]. ...

27. [Opposer] also provides foreign currency exchange and payment services under the AMERICAN EXPRESS® trademark. ... consumers, including small businesses, can utilize the many benefits provided with this services to, among other things, send and receive foreign payments to/from foreign markets.<sup>41</sup>

Consumers familiar with Opposer’s famous AMERICAN EXPRESS credit card services, as well as its cross border payment services, local currency corporate cards, foreign remittance services, electronic funds transfer services and foreign currency exchange and payments services, upon encountering Applicant’s AMERIXPRESS

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<sup>41</sup> Silver Decl. ¶¶11, 12, 24, and 27 (8 TTABVUE 33, 34, 38, and 39).

import and export services will mistakenly believe that the services emanate from the same source or are otherwise somehow affiliated because of the similarities of the marks.

Likewise, consumers familiar with Opposer's famous AMERICAN EXPRESS credit card services and its "general merchandise mail order services" upon encountering Applicant's AMERIXPRESS vitamin, mineral and nutritional supplements are likely to mistakenly believe that Applicant's goods emanate from or are associated with Opposer's services. *See In re Hyper Shoppes [Ohio], Inc.*, 857 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (applicant's "general merchandise store services" includes registrant's furniture); *In re House Beer, LLC*, 114 USPQ2d 1073, 1078 (TTAB 2015) ("[I]t has often been recognized that likelihood of confusion may arise where confusingly similar marks are used on goods, on the one hand, and in connection with sales of such goods, on the other."); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1639-40 (TTAB 2007) ("It is settled that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other.").

Moreover, the fame of Opposer's mark plays a role in our analysis regarding the similarity or dissimilarity of the goods and services, "because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products." *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897. A famous mark "casts a long shadow which competitors must avoid." *Id.* (quoting *Kenner Parker*, 22 USPQ2d



at 1457); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) (“there is ... no excuse for even approaching the well-known mark of a competitor.”)); *see also Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 151 USPQ 350, 352 (CCPA 1966) (holding that HUNT’S for canned food products is confusingly similar to HUNT for cleaning products); *Am. Sugar Refining Co. v. Andreassen*, 296 F.2d 783, 132 USPQ 10, 11 (CCPA 1961) (concluding that DOMINO for sugar is confusingly similar to DOMINO for pet food); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1843 (TTAB 1989) (holding likelihood of confusion between CLASSIC TIFFANY for automobiles and opposer's mark TIFFANY for jewelry, silver, and similar items); *R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 USPQ 856, 860 (TTAB 1978) (holding SIR WINSTON and design for tea is likely to cause confusion with WINSTON for cigarettes).

If we understand Applicant’s argument correctly, Applicant contends that Opposer failed to prove that its goods and services are related to the goods and services for which registration is sought because Opposer failed to introduce evidence that “something more” than similar marks are used for the goods and services at issue.<sup>42</sup> The Federal Circuit explained that where the goods or services are well-known or generally recognized as having a common source, a plaintiff’s burden to establish relatedness is easier to satisfy. However, where the relatedness of the goods

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<sup>42</sup> Applicant’s Brief, pp. 20-24 (27 TTABVUE 21-25).

or services is obscure or less evident, the plaintiff will need to show “something more” that the mere fact that the goods or services are used together. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014). Assuming arguendo that the relatedness of the goods and services at issue is obscure or less evident, and therefore, Opposer is required to introduce testimony and evidence to show “something more.” Opposer satisfies the “something more” requirement by having established that its AMERICAN EXPRESS mark is famous. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *see also James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555 (7th Cir. 1976); *Beef/Eater Rests., Inc. v. James Burrough Ltd.*, 398 F.2d 637, 158 USPQ 562 (5th Cir. 1968), where the owner of BEEFEATER for gin, a well-known and famous, was successful in halting the use of BEEFEATER and SIGN OF THE BEEFEATER to identify restaurant services.

The goods and services for which Applicant seeks registration are related to the goods and services for which Opposer has registered its AMERICAN EXPRESS mark.

- D. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Applicant’s descriptions of goods and services have no restrictions or limitations and, accordingly, we must presume that those goods and services will move in all normal channels of trade and be sold to all classes of consumers. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Likewise, Opposer’s description of services has no restrictions or limitations and we

presume that they move in all normal channels of trade and will be sold to all classes of consumers. *Id.* Accordingly, and contrary to Applicant's arguments, we may not limit or restrict Applicant's import or export services to vitamin, mineral, and nutritional supplements to wholesalers in Vietnam for further distribution to Vietnamese businesses and consumers.<sup>43</sup>

A consumer utilizing Applicant's import and export agency services may also utilize Opposer's credit card services, cross border payment services, local currency corporate cards, foreign remittance services, electronic funds transfer services, and foreign currency exchange and payments services. Likewise, Applicant's vitamin, mineral and nutritional supplements may be sold through Opposer's general merchandise mail order services. Accordingly, Applicant's goods and services may be offered through some of the same channels and to some of the same consumers as Opposer's services.

E. The conditions under which sales are made.

Applicant argues that the goods and services for which registration are sought are not impulse purchases and that, therefore, consumers will exercise a high degree of purchaser care.<sup>44</sup> The testimony and evidence regarding the conditions under which

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<sup>43</sup> Applicant's Brief, p. 25 (27 TTABVUE 26).

<sup>44</sup> Applicant's Brief, p. 27 (27 TTABVUE 28). We cannot consider Applicant's argument regarding the expense and complexity of the purchasing process where the products are purchased for export because Applicant's vitamin, mineral, and nutritional supplements are not limited or restricted to sale for export and, therefore, includes sales of such products to the ultimate consumer. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

consumers purchase or select credit card services, import services, export services, and vitamin, mineral and nutritional supplements are sparse. Even assuming that relevant consumers will exercise a high degree of purchaser care, the potential for confusion is accentuated by the significance of Opposer's famous AMERICAN EXPRESS mark, as well as the similarity of the marks because many potential consumers may not notice the differences in the marks. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("Human memories even of discriminating purchasers...are not infallible.") (quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)). Furthermore, careful purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods and services, but will see the marks as variations of each other, pointing to a single source. *See, e.g., Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) ("What is important is not whether people will necessarily confuse the marks, but whether the marks will be likely to confuse people into believing that the goods they are purchasing emanate from the same source.") (citations omitted). Accordingly, we find this *du Pont* factor to be neutral.

F. Analyzing the factors.

Opposer's AMERICAN EXPRESS mark is famous and, therefore, it is entitled to a broad scope of protection or exclusivity of use. Keeping that fact in mind, because the marks are similar, the goods and services are related and are offered in some of the same channels of trade and to some of the same consumers, we find that

Applicant's marks AMERIXPRESS for "import agency services" and AMERIXPRESS LLC for "export agency services for the goods of others" and vitamin, mineral, and nutritional supplements are likely to cause confusion with Opposer's registered AMERICAN EXPRESS marks for, inter alia, "general merchandise mail order services," credit card services, cross border payment services, local currency corporate cards, and foreign currency exchange and payments services.

### III. Dilution

To prevail on a dilution claim, Opposer must show that: (1) it owns a famous mark that is distinctive; (2) Applicant is using, or intends to use, a mark in commerce that allegedly dilutes Opposer's famous mark; (3) Applicant's use of its mark began, or the filing date of its intent to use application, is after Opposer's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment. Section 43(c)(1) of the Lanham Act, 15 U.S.C. § 1125(c)(1); *see also Coach Servs.*, 101 USPQ2d at 1723-24.

#### A. Whether Opposer's AMERICAN EXPRESS mark was famous when Applicant filed its applications?

As noted above, Opposer must prove that it owns a famous mark that was famous for purposes of dilution before defendant began using its mark or filed its intent to use application. Applicant filed its application Serial No. 86881103 for the mark AMERIXPRESS LLC on January 20, 2016, and its application Serial No. 86894103 for the mark AMERIXPRESS on February 2, 2016. Applicant has not used the

marks.<sup>45</sup> Accordingly, Opposer must prove that its AMERICAN EXPRESS mark was famous before 2016.

A threshold question in a federal dilution claim is whether the mark at issue is “famous.” For dilution, 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); *see also Coach Servs.*, 101 USPQ2d at 1724. To establish the requisite level of fame, the “mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark.” *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). 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.* In other words, a famous mark is one that has become a “household name.” *Id.* With this framework in mind, we turn to Opposer’s evidence of fame prior to 2016.

Opposer “began in 1850 as an express mail business.”<sup>46</sup> Over the next 166 years, Opposer grew into one of the top 100 biggest public companies in the world.<sup>47</sup> Interbrand Global Brand Consultancy, publisher of the annual “Best Global Brands” ranked AMERICAN EXPRESS as the 25<sup>th</sup> best brand in 2015, as the 23<sup>rd</sup> best brand

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<sup>45</sup> Applicant’s response to Opposer’s interrogatory No. 2(a) (25 TTABVUE 11); Applicant’s Discovery Dep., p. 18 (25 TTABVUE 57).

<sup>46</sup> Silver Decl. ¶¶6 and 9 95 TTABVUE 31 and 32).

<sup>47</sup> Silver Decl. ¶6 and Exhibit 1 (8 TTABVUE 31 and 41).

in 2014 and 2013, and the 24<sup>th</sup> best brand in 2012.<sup>48</sup> In its 2012 Annual Report, Opposer reported that it had won its sixth straight J.D. Power and Associates award for highest customer satisfaction among U.S. credit card companies.<sup>49</sup>

Since 2013, Opposer has spent an average of \$2 billion per year on advertising and promoting the AMERICAN EXPRESS services in the United States.<sup>50</sup> Opposer has advertised on television, through online advertising, direct mail, and banner advertising. As a result, between 2010 and 2015, Opposer has had an average of 61.2 million credit card holders in the United States,<sup>51</sup> who have annually charged an average of \$609.8 billion.<sup>52</sup> By any standard, Opposer has a substantial number of customers generating a substantial amount of business.

This level of activity lead to the finding in Opposer's internal survey that when respondents were presented with an aided awareness question in 2016,<sup>53</sup> 98% of the respondents between the ages of 18-65 with an income greater than \$25,000 and 99% of the respondents between the ages of 18-65 with a household income greater than \$75,000 and owning a credit card other than AMERICAN EXPRESS, recognized the

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<sup>48</sup> Silver Decl. ¶16 and Exhibit 4 (8 TTABVUE 31 and 113-120).

<sup>49</sup> Silver Exhibit 5 (8 TTABVUE 126).

<sup>50</sup> Silver Decl. ¶16 and Exhibit 14 (8 TTABVUE 35 and 10 TTABVUE 3).

<sup>51</sup> Opposer's 2012 Annual Report, Silver Decl. ¶7 and Exhibit 5 (8 TTABVUE 144); Opposer's 2014 Annual Report, Silver Decl. ¶7 and Exhibit 7 (8 TTABVUE 382); Opposer's 2015 Annual Report, Silver Decl. ¶7 and Exhibit 8 (8 TTABVUE 557); Opposer's 2016 Annual Report, Silver Decl. ¶7 and Exhibit 9 (8 TTABVUE 737).

<sup>52</sup> *Id.* at 8 TTABVUE 144, 382, 557 and 737.

<sup>53</sup> "How much do you know about American Express?"

AMERICAN EXPRESS trademark.<sup>54</sup> Because the survey indicates only that the survey was conducted in 2016 and 2017, we must construe the earliest date of the survey as the end of 2016 and, therefore, subsequent to the filing date of Applicant's applications. *See EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period); *see also Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use). However, the high degree of consumer recognition captured by the survey reflects the renown of the AMERICAN EXPRESS mark prior to when the survey was taken. A 98% and 99% recognition rate is earned over time and did not suddenly develop subsequent to the filing dates of Applicant's applications. Therefore, Opposer's internal survey is somewhat probative. *Cf. Hornby v. TJX Cos. Inc.*, 87 USPQ2d 1411, 1416 (TTAB 2008).

With respect to the Section 2(a) claim, respondent is correct that we must determine the extent of petitioner's fame or reputation as of the time respondent's registration issued. However, we may still consider activities that occurred subsequent to that registration date in order to make a determination as to petitioner's fame or reputation as of the issuance of the registration. In other words, evidence of petitioner's fame or reputation *after* the date of issuance of respondent's registration may tell us something about the fame or reputation as of that date. Of course, the more time that has passed since the registration date, the less probative the activities are with respect to the plaintiff's fame or reputation at the time the registration issued. Activities occurring many years after the registration date

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<sup>54</sup> Silver Decl. ¶18 and Exhibit 16 (8 TTABVUE 36 and 10 TTABVUE 5-7).



would obviously be too distant in time to inform a determination about fame or reputation as of the registration date. However, in the present case respondent's registration issued in 2000, so petitioner's activities in the few years that passed between that date and the date of trial may still have probative value.

*Id.*

Based on the foregoing evidence, we find that Opposer's AMERICAN EXPRESS mark is famous for purposes of dilution and was so prior to the filing date of Applicant's applications.

B. Applicant's use of its mark in commerce

The second dilution element Opposer must establish is that Applicant is using its allegedly diluting mark in commerce. Under the 1999 amendments to the Federal Trademark Dilution Act, we held that an application based on intent to use a mark in commerce under Trademark Act Section 1(b) satisfied the commerce requirement. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1505 (TTAB 2015) (citing *Toro Co.*, 61 USPQ2d at 1174). The Trademark Dilution Revision Act of 2006 (TDRA) does not change this result. *See N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014) (holding that an opposer asserting a dilution claim in a Board proceeding against an application based on an allegation of actual use in commerce pursuant to Section 1(a) may prove applicant's use in commerce by direct evidence or rely on the application filing date as the date of constructive use)).

We therefore find that Opposer has satisfied the second dilution element as to both applications.

C. Whether Applicant's marks are likely to cause dilution

The final element of our dilution analysis assesses whether Applicant's marks are likely to dilute Opposer's marks. Dilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner. *See N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011) and *Toro Co.*, 61 USPQ2d at 1183)).

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

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

Section 43(c)(B)(i)-(vi) of the Trademark Act, 15 U.S.C. § 1125(c)(B)(i)-(vi).

In weighing evidence produced at trial, some of these statutory dilution factors may be given more weight than others, depending on the evidence of record. *Omega*

*SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1667 (TTAB 2010), *aff'd* 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)).

We will address these factors as they apply to Applicant's mark AMERIXPRESS. We need not analyze AMERIXPRESS LLC because, as noted above, LLC is merely an entity designation and does not carry any trademark significance.

1. The degree of similarity between AMERIXPRESS and AMERICAN EXPRESS.

The Board noted in *National Pork Board v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010), that,

after finding in the affirmative on the question of pre-existing fame, an important question in a dilution case is whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.

While we are not conducting a Section 2(d) likelihood of confusion analysis under this factor for dilution by blurring, we still consider the degree of similarity or dissimilarity of the marks in their entirety as to appearance, connotation, and commercial impression. *N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *Research in Motion Ltd. v. Defining Presence Marketing Grp. Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012)). We consider the marks in terms of whether they are sufficiently similar in their overall commercial impressions that the required association exists. *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1030 (TTAB 2011).<sup>55</sup>

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<sup>55</sup> Accordingly, Applicant's reliance on the principal that the marks must be "very or substantially similar" to support a finding of dilution set out in *Toro*, 61 USPQ2d at 1183, is misplaced.

The overall similarity between AMERIXPRESS and AMERICAN EXPRESS is readily apparent. Each begins with “Ameri” and ends in “xpress.” They sound alike and have similar meanings and convey similar commercial impressions. When considered in their entirety, the marks are sufficiently similar that AMERIXPRESS will “trigger consumers to conjure up” AMERICAN EXPRESS. That is, consumers encountering Applicant’s AMERIXPRESS will immediately be reminded of Opposer’s famous AMERICAN EXPRESS.

2. The degree of inherent or acquired distinctiveness of AMERICAN EXPRESS.

Opposer’s AMERICAN EXPRESS mark is inherently distinctive. Even if the mark is not viewed as inherently distinctive, it is famous, which necessarily subsumes a finding that the marks has acquired distinctiveness. *See N.Y. Yankees P’ship*, 114 USPQ2d at 1507.

3. The extent to which Opposer is engaging in substantially exclusive use of the mark.

There is no evidence in the record of any third-party use of any marks similar to Opposer’s AMERICAN EXPRESS mark. Therefore, we find that Opposer is engaging in substantially exclusive use of its mark. This factor favors a likelihood of dilution.

4. The degree of recognition of AMERICAN EXPRESS.

As noted above, between 2010 and 2016, Opposer has averaged 61.2 million credit card holders in the United States.<sup>56</sup> This level of activity lead to the finding in

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<sup>56</sup> Opposer’s 2012 Annual Report, Silver Decl. ¶7 and Exhibit 5 (8 TTABVUE 144); Opposer’s 2014 Annual Report, Silver Decl. ¶7 and Exhibit 7 (8 TTABVUE 382); Opposer’s 2015 Annual Report, Silver Decl. ¶7 and Exhibit 8 (8 TTABVUE 557); Opposer’s 2016 Annual Report, Silver Decl. ¶7 and Exhibit 9 (8 TTABVUE 737).

Opposer's 2016 internal survey that when respondents were presented with an aided awareness question,<sup>57</sup> 98% of the respondents between the ages of 18-65 with an income greater than \$25,000 and 99% of the respondents between the ages of 18-65 with a household income greater than \$75,000 and owning a credit card other than AMERICAN EXPRESS, recognized the AMERICAN EXPRESS trademark.<sup>58</sup> Interbrand Global Brand Consultancy, publisher of the annual "Best Global Brands" has listed AMERICAN EXPRESS as the 25<sup>th</sup> best brand in 2015, as the 23<sup>rd</sup> best brand in 2014 and 2013, and the 24<sup>th</sup> best brand in 2012.<sup>59</sup> In its 2012 Annual Report, Opposer reported that it had won its sixth straight J.D. Power and Associates award for highest customer satisfaction among U.S. credit card companies.<sup>60</sup>

We find that AMERICAN EXPRESS has a high degree of recognition.

5. Whether Applicant intended to create an association with AMERICAN EXPRESS.

There is no direct evidence that Applicant intended to create an association with AMERICAN EXPRESS.

6. Any actual association between AMERIXPRESS and AMERICAN EXPRESS.

There is no evidence of any actual association between Opposer's marks and Applicant's mark because Applicant has not used its mark.

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<sup>57</sup> "How much do you know about American Express?"

<sup>58</sup> Silver Decl. ¶18 and Exhibit 16 (8 TTABVUE 36 and 10 TTABVUE 5-7).

<sup>59</sup> Silver Decl. ¶6 and Exhibit 4 (8 TTABVUE 31 and 113-120).

<sup>60</sup> Silver Exhibit 5 (8 TTABVUE 126).

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D. Conclusion as to dilution by AMERIXPRESS

With the exception of intent and evidence of actual association, the dilution factors favor finding that there is a likelihood of dilution. Therefore, we find that Applicant's registration of AMERIXPRESS and AMERIXPRESS LLC would impair the distinctiveness of Opposer's AMERICAN EXPRESS mark and is likely to dilute the distinctive quality of AMERICAN EXPRESS.

**Decision:** The oppositions are sustained on both the grounds of likelihood of confusion and dilution.