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

Proceeding no.	91239609
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/459,649
Mark: AIRBLUE

JETBLUE AIRWAYS CORPORATION,

Opposer,

v.

AIRBLUE LIMITED,

Applicant.

Opposition No. 91239609

APPLICANT AIRBLUE LIMITED'S TRIAL BRIEF

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Applicant Airblue Limited (“airblue” or “Applicant”) hereby submits its trial brief in opposition to Opposer JetBlue Airways Corporation’s (“JetBlue” or “Opposer”) Opposition against Application Serial No. 87/459,649 for the AIRBLUE Mark.

I. INTRODUCTION & SUMMARY OF THE ARGUMENT.

The Board should deny JetBlue’s Opposition based on its claims of likelihood of confusion and dilution by blurring of its JETBLUE marks.¹ Applicant is a commercial airline based in Pakistan. Starting in 2003, airblue has used the AIRBLUE Mark in association with each of the goods and services listed in the Challenged Application in association with domestic flights within Pakistan and international flights between Pakistan and various countries in the Middle East and Europe. Applicant now intends to expand its international routes to include flights between Pakistan and the United States.

Many U.S. customers are already familiar with airblue and the AIRBLUE Mark—they are currently able to purchase tickets for airblue flights, enroll in airblue’s frequent flyer program, or interact with airblue’s online and physical advertising. As such, there is no legal or factual basis for Opposer’s claims. They should be rejected and the AIRBLUE Mark should issue in due course.

II. DESCRIPTION OF THE RECORD.

JetBlue submitted several Notices of Reliance and the Testimonial Declarations of Elizabeth Windram during its opening and rebuttal trial periods, as set forth below:

- “Opposer’s First Notice of Reliance on Printed Publications” and Exhibits 1-31 thereto, submitted at 48 TTABVUE.
- “Opposer’s Second Notice of Reliance on Applicant Airblue Limited’s Discovery Responses” and Exhibits 32-76 thereto, submitted at 49 TTABVUE; Exhibits 75-77 thereto, submitted as 50 TTABVUE; and the remainder of Exhibit 77 thereto, submitted as 51 TTABVUE.
- “Opposer’s Third Notice of Reliance on it Trademark Registrations” and Exhibits 78-120 thereto, submitted as 52 TTABVUE.
- “Opposer’s Fourth Notice of Reliance on Internet Materials” and Exhibits 121–122 thereto, submitted as 53 TTABVUE.

¹ Though the operative Notice of Opposition

- “Opposer’s Fifth Notice of Reliance on Discovery Deposition” and Exhibit 123 thereto, submitted as 55 TTABVUE.
- “Opposer’s Sixth Notice of Reliance on Internet Materials” and Exhibits 124–137 thereto, submitted as 56 TTABVUE.
- “Opposer’s Rebuttal Notice of Reliance” and Exhibits 138-180 thereto, submitted as 94 TTABVUE; and certain confidential versions of certain Exhibits thereto, submitted as 95 TTABVUE.
- “The Trial Declaration of Elizabeth Windram” and Exhibits A-BB thereto submitted as 57 TTABVUE; Exhibits CC-JJ thereto submitted as 58 TTABVUE; certain confidential versions of the Exhibits submitted as 59 TTABVUE, and a DVD of Exhibit Q thereto submitted as 60 TTABVUE
- “Rebuttal Declaration of Elizabeth Windram” and Exhibits A-B thereto, submitted as 96 TTABVUE; and confidential versions of the Exhibits thereto, submitted as 97 TTABVUE.

Applicant likewise submitted Notices of Reliance and the Testimonial Declaration of Tariq Chaudhary during its trial period, as set forth below:

- “Applicant’s Notice of Reliance” and Exhibits 1-10 thereto, submitted as 65 TTABVUE; Exhibits 11-20 thereto, submitted as 66 TTABVUE; Exhibit 17 thereto, submitted as 82 TTABVUE; Exhibits 21-30 thereto, submitted as 67 TTABVUE; Exhibits 31-40 thereto, submitted as 68 TTABVUE; Exhibits 41-50 thereto, submitted as 69 TTABVUE; Exhibits 51-60 thereto, submitted as 70 TTABVUE; Exhibits 61-70 thereto, submitted as 71 TTABVUE; Exhibits 71-78 thereto, submitted as 72 TTABVUE; a confidential version of the Notice of Reliance, submitted as 74 TTABVUE; confidential versions of Exhibits 26-44 thereto, submitted as 75 TTABVUE; confidential versions of Exhibits 45-77 thereto, submitted as 76 TTABVUE; and a confidential version of Exhibit 78 thereto, submitted as 77 TTABVUE.
- “Applicant’s Amended Notice of Reliance” and Exhibits 10, 12, 13, 62, 63, 64, and 65 thereto, submitted as 88 TTABVUE. Applicant’s Amended Notice of Reliance (88 TTABVUE) contains amendments to paragraphs 10, 12, 13, 62, 63, 64, and 65 of Applicant’s Notice of Reliance (65 TTABVUE). The Exhibits submitted with Applicant’s Amended Notice of Reliance are the same as those submitted with Applicant’s Notice of Reliance.
- “Testimonial Declaration of Tariq Chaudhary” and Exhibits 1-27 thereto, submitted as 73 TTABVUE.

Opposer submitted a Statement of Objections containing objections to certain evidence submitted by Applicant at 101 TTABVUE 57-62. Applicant submits (1) Applicant’s Responses to Opposer’s Statement of Objections as well as (2) a Statement of Objections to Opposer’s Evidence, both of which are appendices to this trial brief.

III. STATEMENT OF THE ISSUES.

1. Is Applicant's AIRBLUE Mark likely to cause confusion with Opposer's JETBLUE Mark?
2. Is Opposer's JETBLUE Mark sufficiently famous to support a claim for dilution? If so, is Applicant's AIRBLUE Mark likely to cause dilution of Opposer's JETBLUE Mark?
3. Did Applicant have a *bona fide* intent to use the AIRBLUE Mark in U.S. commerce at the time it filed the Challenged Application?

IV. STATEMENT OF FACTS.

A. Applicant is an Established Airline Operating With Extensive Commercial Aviation Operations in the Middle East.

Applicant is an international airline founded in 2003. 73 TTABVUE 2. It is currently the second largest airline in Pakistan and it flies to several domestic destinations within Pakistan, as well as international destinations throughout the Middle East, including the United Arab Emirates and Saudi Arabia. 73 TTABVUE 5, 46. In addition to air transportation services, airblue has offered a "frequent flyer" program since 2004, and previously offered an airblue credit card for over 10 years that provided benefits to customers, such as extra points towards the customer's frequent flyer account. 73 TTABVUE 5-6. Applicant uses the trademark AIRBLUE in association with its goods and services offered across the globe. 73 TTABVUE 3.

Applicant maintains an English-language website, www.airblue.com, through which it advertises its goods and services. 72 TTABVUE 118-20; 73 TTABVUE 7, 58-64. The Applicant's AIRBLUE mark is prominently displayed throughout the website, including on the home page and multiple, internal pages within the airblue.com domain. Customers anywhere in the world—including the United States—can reserve tickets on Airblue flights through Applicant's website and have been able to do so since 2004. 73 TTABVUE 7; 31 TTABVUE. Applicant also offers a mobile application that customers use to purchase tickets on airblue flights and perform other tasks such as managing their reservations, selecting seats on flights, and accessing boarding passes. 73 TTABVUE 8. U.S. customers can download the application via the Apple App Store and the Google Play Store. *Id.*; 73 TTABVUE 100-05. Several third-party booking

websites also advertise and allow customers to reserve tickets on airblue flights; some of the third parties include popular United States-based travel websites, such as expedia.com and kayak.com. 73 TTABVUE 8, 107-29.

Applicant advertises its air transportation, frequent flyer program, and credit card services through airblue-branded social media accounts, including on Facebook, Twitter, Instagram, and LinkedIn, all of which prominently display the AIRBLUE mark.² 72 TTABVUE 69-117; 73 TTABVUE 7, 66-98; 31 TTABVUE. Applicant also advertises its services through posters and other physical and digital signage, newspapers and other printed publications, and by sponsoring events in countries where it currently offers its services. 73 TTABVUE 8-9, 131-39. Applicant has an e-mail subscription, through which it markets its services as well as provides company and industry updates; U.S. customers can currently sign up for the e-mail subscription on airblue’s website. 73 TTABVUE 9, 141.

Applicant works with hundreds of travel agent partners throughout the world to market its goods and services, including travel agents in Los Angeles, California; Houston, Texas; Chicago Illinois; Arlington, Virginia; and New York, New York. 73 TTABVUE 9-10. Applicant is currently seeking additional travel agent partners in the U.S. and has a portal on its website through which U.S. travel agents can apply to partner with airblue. 73 TTABVUE 10, 168-70.

Over the past two decades, airblue has achieved considerable success. It has grown to be the second largest airline in Pakistan and has been named the “Best Pakistani Airline.” 73 TTABVUE 5. Applicant’s annual revenues exceed a billion Rupees, and it invests millions in marketing and sales, as shown below:

² Applicant uses its website and social media accounts to market to customers around the globe. It does not maintain separate websites or social media accounts for each country. 73 TTABVUE 7.

³ The average exchange rate in 2016 was 104.71 Rupees to 1 US dollar. Exchange Rates, US Dollar to Pakistani Rupee Spot Exchange for 2016, <https://www.exchangerates.org.uk/USD-PKR-spot-exchange-rates-history-2016.html> (last accessed Feb. 10, 2023).

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73 TTABVUE 6, Ex. 6 (confidential version 78 TTABVUE Ex. 6). The investment in marketing and sales is comprised of advertising on airblue’s website, on its social media platforms, in print and on billboards, sponsorship of local and regional events, and other marketing channels. 73 TTABVUE 7-10.

U.S. customers have already been exposed to the AIRBLUE Mark. From 2014 to 2019, over 12,000 U.S. citizens purchased tickets for international airblue flights.⁶ 73 TTABVUE 15-16, 385. Airblue currently has over 230,000 customer who have signed up for the frequent flyer program, including at least 714 customers who provided U.S. addresses when signing up for their program. 73 TTABVUE 16-17, 390-92. U.S. customers can enroll in airblue’s frequent flyer program through the airblue website, through travel agents, or in person. 73 TTABVUE 16-17, 387. Applicant has been also been mentioned in prominent U.S. publications, including *The New York Times*. 71 TTABVUE 50-57. Applicant is not aware of a single customer who confused Applicant’s goods and services with JetBlue’s or otherwise associated the AIRBLUE Mark with the JETBLUE Mark. 73 TTABVUE 18-19.

B. Applicant Intends to Offer International Flights To and From the United States.

Applicant filed an intent-to-use application for the word mark AIRBLUE on May 22, 2017 (the “Challenged Application”) for the following goods and services: Class 36 for “issuance of credit cards; credit card services, namely, providing cash and other rebates for credit card use as part of a customer loyalty program” and Class 39 for “air transportation of passengers, property, and cargo; air transportation

⁴ The average exchange rate in 2017 was 105.29 Rupees to 1 US dollar. Exchange Rates, US Dollar to Pakistani Rupee Spot Exchange for 2017, <https://www.exchangerates.org.uk/USD-PKR-spot-exchange-rates-history-2017.html> (last accessed Feb. 10, 2023).

⁵ The average exchange rate in 2018 was 121.57 Rupees to 1 US dollar. Exchange Rates, US Dollar to Pakistani Rupee Spot Exchange for 2018, <https://www.exchangerates.org.uk/USD-PKR-spot-exchange-rates-history-2018.html> (last accessed Feb. 10, 2023).

⁶ Applicant only records the citizenship of its passengers on international flights, so this number does not include U.S. citizens who flew domestically within Pakistan. 73 TTABVUE 15-16. Applicant’s CEO expects that many more U.S. customers have flown on airblue flights, such as U.S. citizens with a green card, or those with dual citizenship. *Id.*

services featuring a frequent flyer bonus program; making reservations and bookings for air transportation; providing automated check-in and ticketing services for air travel.” These are the same goods and services airblue currently offers in the Middle East.

Applicant will offer international flights between the United States and airblue’s current destinations in the Middle East. 73 TTABVUE 10. As a foreign airline, Applicant is only permitted to offer international flights—it cannot and will not offer domestic flights within the United States. *See* 49 U.S.C. §§ 40102(21), 40102(23); 73 TTABVUE 309.

Before it can offer international flights to and from the U.S., airblue requires approval from the Pakistani Civil Aviation Authority (“PCAA”) and U.S. regulatory bodies. 73 TTABVUE 3-4. The U.S. and Pakistan have an “Air Service Agreement” to facilitate cooperation and international travel between the two countries. 73 TTABVUE 13; 70 TTABVUE 96-104 (PCAA website); 71 TTABVUE 3-12 (U.S. Dept. of State website). A copy of the original agreement from 1997, obtained from the U.S. Department of State, is submitted at 71 TTABVUE 14-37.⁷ In 1999, the U.S. and Pakistan “transform[ed] the Agreement into an ‘Open Skies’ Agreement.” 71 TTABVUE 39-46; 73 TTABVUE 13-14. To do so, the governments amended the agreement to provide that Pakistani airlines can fly routes “from points behind Pakistan via Pakistan and intermediate points to a point or points in the United States and beyond” and may “operate flights in either or both directions” between the U.S. and Pakistan. 71 TTABVUE 41-42.

In December 2020, the PCAA authorized airblue to offer international flights from Pakistan to any country with whom Pakistan has an Air Service Agreement, including the United States. 73 TTABVUE 13. Accordingly, airblue now only requires approval from U.S. regulatory bodies. *Id.*

Applicant’s CEO, Mr. Chaudhary, has experience navigating U.S. regulatory requirements. 73 TTABVUE 14. Indeed, he is in the process of launching a domestic U.S. airline—separate and distinct from airblue and that does not use the AIRBLUE Mark—which is currently engaged in the certification

⁷ Mr. Chaudhary testified that the Agreement and amendments thereto are kept by the U.S. Department of State on its official website and he accessed and reviewed the documents from that website. 73 TTABVUE 13-14.

process and has received approval from the U.S. Department of Transportation to begin offering domestic flights in the U.S. *Id.* Because Pakistan and the U.S. have an Open Skies agreement and airblue is an established foreign airline, the U.S. regulatory process for airblue is less onerous than for launching a new domestic airline. *Id.*; *see also* 65 TTABVUE 105-106 (under Open Skies agreements “the bar to enter those markets is much lower than if you were to start service within those jurisdictions”). The U.S. Department of Transportation (“DOT”) publishes a “Foreign Air Carrier Information Packet,” which outlines the steps a foreign air carrier must follow to receive “DOT authority to enable a foreign air carrier to conduct commercial operations to and from the United States.” 73 TTABVUE 316-82. This official DOT record indicates that foreign air carriers can expect to obtain approval “within 30-60 days after filing” their application. 73 TTABVUE 322; *see also* 65 TTABVUE 105 (“[I]f you are already flying and want to go to a different jurisdiction, typically that process takes, sometimes weeks and in other cases, just a few months.”). Given its prior experience, airblue does not anticipate any issues obtaining U.S. regulatory approval and expects it to be timely granted. 73 TTABVUE 10-11, 14.

The DOT prohibits foreign airlines from advertising in the U.S. until they have the DOT’s initial economic approval. 62 Fed. Reg. 51175 (Sept. 30, 1997); 73 TTABVUE 322 (“[A] foreign air carrier may not sell, offer to sell, or otherwise hold out foreign air transportation services to the public unless and until it has received requisite economic authority from the department.”). Accordingly, airblue cannot start advertising its international flights to and from the U.S. to consumers. Indeed, it is *expressly prohibited* from doing so. However, Applicant has an established English-language website, social media accounts accessible in the U.S., third-party booking websites, a network of travel agents through which it intends to immediately begin advertising to the U.S. market once it received authorization from the DOT. 73 TTABVUE 7-10.

C. The JETBLUE Mark.

As JetBlue admits, the JETBLUE Mark is comprised of the words “Jet” and “Blue.” 28 TTABVUE 3. Both terms describe JetBlue’s air transportation services. The word “jet” is defined as “an airplane powered by one or more jet engines” when used as noun, or “to travel by jet” when used as a verb—both

definitions directly describe JetBlue’s air transportation services. *Jet*, Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/jet> (last accessed Feb. 13, 2023).⁸ The word “blue” is defined as “of the color whose hue is that of the clear sky.” *Blue*, Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/blue> (last accessed Feb. 13, 2023) (“of the color whose hue is that of the clear sky”).

JetBlue’s former CEO and others involved in the selection of the JETBLUE Mark are quoted in a 2009 article. 70 TTABVUE 3-12. They explain that they thought “*blue* has a good visual aspect to it . . . It’s the sky.” 70 TTABVUE 7. After toying with other blue-formative marks, JetBlue’s former CEO explains they selected JETBLUE because “*Jet* made it sound real, like it wasn’t a puddle jumper”—clearly referring to the jet airliners JetBlue uses to provide its services—“and the *blue* had that association with the wild blue yonder”—clearly, again, referring to the sky. 70 TTABVUE 8. As is clear from these quotes, the intended meaning of the JETBLUE Mark is its descriptive meaning.

D. JetBlue and its Purported Evidence of “Fame.”

As Opposer notes in its trial brief, JetBlue is a U.S. airline, offering domestic flights within the United States. 57 TTABVUE 5 – 6.⁹ JetBlue’s market is primarily limited to the East Coast of the United States. 56 TTABVUE 350 (“JetBlue is not as relevant on a national scale outside of [the] Northeast [and] Florida. . .”). Indeed, JetBlue admits it is “highly dependent on the New York metropolitan market” where “approximately one-half” of their daily flights originate or terminate. 56 TABVUE 145.

JetBlue offers international flights to Mexico, and select countries within the Americas. 57 TTABVUE 68, Ex. F. JetBlue has not presented *any* evidence regarding what proportion of its business is associated with international flights versus domestic flights. JetBlue does not offer international flights to

⁸ Applicant requests that the Board exercise its discretion and take judicial notice of the dictionary definitions presented herein. *See Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 U.S.P.Q. 594 (T.T.A.B. 1982), *aff’d*, 703 F.2d 1372 (Fed. Cir. 1983).

⁹ *See also* 56 TTABVUE 137 (“A vast majority of [JetBlue’s] operations are centered in and around the heavily populated northeast corridor of the U.S., which includes the New York and Boston metropolitan areas.”)

Europe, Asia, or the Middle East. *Id.* However, JetBlue notes that customers flying between the U.S. and the Middle East, including Pakistan, may be exposed to the JETBLUE Mark through its partnership with Emirates and Qatar airlines. 57 TTABVUE 8-9.

JetBlue has not presented any evidence of actual confusion among its domestic or international customers. JetBlue has not presented any survey evidence relating to (1) consumer recognition of the JETBLUE Mark; or (2) the likelihood of confusion between the AIRBLUE and JETBLUE Marks.

E. JetBlue’s Purported “Family” of BLUE Marks.

In addition to the JETBLUE Mark, JetBlue claims to have rights in a “family of BLUE marks.” 100 TTABVUE 12-13, 43-45. JetBlue cites 13 blue-formative marks that constitute the alleged family, namely: SHOPBLUE, TRUEBLUE, BLUEPASS, BLUEBUD, BLUE BASIC, BLUE, BLUE PLUS, BLUE EXTRA, BLUE CITY, OUT OF THE BLUE, BETABLUE, BLUETALES, and BLUE INC. 100 TTABVUE 13. JetBlue has not established that it owns rights in each of these Blue marks, much less that it has exclusive rights in each mark.

First, JetBlue has only submitted trademark registrations for SHOPBLUE, TRUBLUE, and BLUEPASS. *See* 52 TTABVUE 2-7 50-81. For the remaining marks, JetBlue has not submitted evidence of any U.S. trademark registrations and cannot rely on any ownership or validity presumptions associated with registration. JetBlue now admits that the BLUEPASS registration “has lapsed,” leaving only SHOPBLUE and TRUEBLUE. 100 TTABVUE 13 n.3. As JetBlue acknowledges, the SHOPBLUE mark is used by a third party for an online retail store. 100 TTABVUE 40-41. JetBlue’s SHOPBLUE registration covers “online retail store services” which is precisely what the third party offers. 56 TTABVUE 61; 65 TTABVUE 126-27 (screenshot of the third-party’s SHOPBLUE online store). JetBlue has also acknowledged that the TRUEBLUE mark is in use by at least one other third party. Indeed, a 2009 article entitled “JetBlue Airlines: It’s All in a Name” reports that when JetBlue was first searching for a name, it considered TRUEBLUE but decided against it because Thrifty Rent-A-Car owned the mark True Blue. 70 TTABVUE 7-8.

Second, JetBlue admitted, in verified interrogatory responses, that it is “not currently using the

BLUEPASS trademark,” is “not currently using the BLUETALES trademark,” and it is “not currently using the BETABBLUE trademark.” 65 TTABVUE 86, 89. Moreover, JetBlue does not claim to be using the BLUE INC. mark, it merely claims to have used it in the past. 100 TTABVUE 13.

Third, for the remaining seven marks, JetBlue has failed to show the extent of its purported use of the marks. For the BLUEBUD mark, JetBlue merely cites to one press release from 2019 to show its use of the mark. 100 TTABVUE 13, 20 (citing 57 TTABVUE 44-66). For the BLUE BASIC, BLUE, BLUE PLUS, and BLUE EXTRA marks, JetBlue similarly cites to only one print out from its website showing these are different “fares” for JetBlue flights. 100 TTABVUE 13 n. 5-8. For the BLUE CITY mark, JetBlue relies only on a single sentence in a declaration to suggest they have used the mark since 2007, with no further evidence of its use. *Id.* n. 9. Finally, for the OUT OF THE BLUE mark, JetBlue relies on a single print out from its blog. *Id.* n. 10. For each of these marks, JetBlue has not presented any evidence to show how much of its advertising costs are associated with each mark, the geographic scope of its use or advertising of the marks, how many U.S. customers have been exposed to the marks, or any other evidence to show consumers associate the marks exclusively with JetBlue.

F. For Many Years, Third Party “BLUE” Marks Have Saturated the Commercial Aviation Industry in the U.S.

Given the descriptive nature of the term “blue,” it is unsurprising that blue-formative marks are used extensively in the airline industry, both within the U.S. and globally. An article entitled “Why so Blue? The Dominance of the Color in the Industry” reports that 21% of airlines use the color blue as their dominant color, making it the second most commonly used color in the industry. 69 TTABVUE 85. The reported reason for this is that in addition to the association the color has with the sky, “blue” is viewed as trustworthy, calming and easy to remember. 69 TTABVUE 88; *see also* 69 TTABVUE 94 (also reporting that “U.S. airlines” predominantly use “blue and red in logos to represent America”). The article concludes that the authors “believe aviation will always feature blue in some major regard, as there are just too many logical associations with the color, and yet so few reasons against its use.” 69 TTABVUE 90.

Official records from the International Civil Aviation Organization (“ICAO”) list no fewer than

eight registered “Low-Cost-Carriers” that currently use blue-formative marks, including JetBlue, airblue, Atlas Blue, Pacific Blue, Blue Air, Blue Panorama, Blue1, and Azul Airlines. 73 TTABVUE 18, 396-402. As JetBlue acknowledges in its trial brief, blue-formative marks can coexist in the industry. 100 TTABVUE 24-25. Indeed, on several occasions, JetBlue has limited its own use of blue-formative marks to accommodate the co-existence of third-party marks.

First, KLM Air France owns a U.S. trademark registration for the mark FLYING BLUE relating to a customer loyalty program in Class 036 and Class 039, among others. 66 TTABVUE 33-36, 96-102. The Flying Blue loyalty program is marketed to U.S. customers through the website www.flyingblue.us/en and has been featured in prominent U.S. publications such as *Forbes*; it advertises that the program is offered to U.S. customers via partnerships with major U.S. and international airlines, including Delta Air Lines. 66 TTABVUE 38-42; 67 TTABVUE 86-90; 73 TTABVUE 18-19. KLM Air France also markets a “Flying Blue Credit Card.” 67 TTABVUE 92-97. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] 59 TTABVUE 1362-66. [REDACTED]

[REDACTED]. *Id.* .

Second, Blue Air is a Romanian airline that advertises its air transportation services to U.S. customers through its website, www.flyblueair.com/en, as well as through third-party booking website eSky.com, Expedia.com, Kayak.com, and Wego.com. 68 TTABVUE 16-59; 88 TTABVUE 3, 20-22, 26-32; 100 TTABVUE 42; 73 TTABVUE 404-08. [REDACTED]

[REDACTED]. *Id.*

Ex. 25.

Third, Airbus S.A.S. owns a U.S. trademark registration for NAVBLUE for various goods and services in Class 039 such as flight and airport information services. 66 TTABVUE 46-47. [REDACTED]

[REDACTED]

[REDACTED] 100 TTABVUE 24.

Fourth, Blafugl “provides air charter and freight services” under the marks BLUEBIRD CARGO and BLUEBIRD NORDIC. 97 TTABVUE 8. Blafugl owns a U.S. trademark registration for BLUEBIRD NORDIC and has filed a U.S. trademark application for BLUEBIRD CARGO, both covering goods and services in Class 035 among others. 66 TTABVUE 54-55, 81-82. After the Parties submitted their Summary Judgment briefs in this Opposition, [REDACTED]

[REDACTED] 97 TTABVUE 9-11.

Fifth, Air Methods Corporation applied to register the mark ONLY BLUE for air transportation services in Class 039. 97 TTABVUE 13-14. [REDACTED]

[REDACTED] *Id.* [REDACTED]

[REDACTED] *Id.*

Sixth, AZUL Airlines offers international flights between the U.S. and South America.¹⁰ 67 TTABVUE 12-15. AZUL Airlines network directly overlaps with JetBlue’s international flights to and from South America, it even flies to JetBlue’s primary markets in Florida and New York. 67 TTABVUE 20-34. AZUL Airlines markets its services to U.S. consumers via its own website, social media (including post directed to consumers in New York), and several of the same third party booking websites that JetBlue uses and has been featured in U.S. publications such as *USA Today*. 67 TTABVUE 12-80; 73 TTABVUE 404-08. [REDACTED]

In addition to the several co-existence agreements, JetBlue admits that there is no likelihood of

¹⁰ Marks comprised of foreign words are translated into English to determine similarity with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, 1696 (Fed. Cir. 2005). “Azul” is Spanish for “blue.” *Azul*, SPANISHDICTIONARY, <https://www.spanishdict.com/translate/azul> (last visited Feb. 16, 2023).

confusion or dilution between the JETBLUE Mark and the following third-party blue-formative marks in the air transportation industry (100 TTABVUE 25):

Mark	Reg. No.	Representative Goods and Services
BIG BLUE TRAVEL (66 TTABVUE 127-29)	4,798,272	039: Travel agency services, namely, making reservations and booking for transportation for sports fans and corporate groups.
THE BLUE TRAIN (66 TTABVUE 73-74)	1,904,666	039: Transportation of passengers and goods, including cars and vehicles, by rail, <i>air</i> , road and sea.
BLUE HAWAIIAN (66 TTABVUE 91-92)	5,218,396	039: Transportation of passengers and/or goods by air, namely aircraft charter services.
BLUE NOTE (66 TTABVUE 133-39)	4,994,149	039: Arranging of travel tours and cruises. Providing information, news, and commentary in the field of travel.
BLUE SKIES (66 TTABVUE 44)	5,276,842	035: Aircraft business management services, namely, managing and arranging aircraft operations and aircraft crew scheduling for others.
BLUEGRACE (66 TTABVUE 56-57)	3,997,591	039: Freight transportation by road, rail, <i>air</i> and ocean. Transportation and delivery services by <i>air</i> , road, rail and sea.

The record is replete with several additional blue-formative trademarks registrations and applications owned by third parties, which JetBlue has not attempted to distinguish or otherwise addressed in its trial brief, as set forth below.

Mark	Reg./App. No.	Representative Goods and Services
BLUE SKY TRAVELER (66 TTABVUE 48-49)	5,640,838	041: On-line journals, namely, blogs featuring travel gear, travel guides, travel destinations, travel recommendations, inspiration, health and wellness, relationships, food and wine, restaurant recommendations, hotel recommendations, and entertainment.
BLUE ANGELS (66 TTABVUE 50-51)	4,564,359	028: Toy airplanes; scale model airplanes 041: Entertainment in the nature of stunt aircraft flying; Entertainment in the nature of VIP rides; Entertainment in the nature of air shows; Flight simulator amusement rides.
BLUE CLOUD TRAVEL (66 TTABVUE 52-53)	88/576,308	039: Travel booking agencies.
BLUE WATER SHIPPING (66 TTABVUE 58-59)	3,004,150	035: Arranging for pickup, delivery, storage and transportation of freight via air carriers. IC 039: Express delivery of goods by air and truck.
STA TRAVEL BLUE TICKET	4,910,652	039: Travel arrangement; Transport of passengers by air; Booking agency services for travel,

(66 TTABVUE 60-61)		namely, travel booking agencies; Online travel ticket reservation services
STA BLUE TICKET (66 TTABVUE 85-86)	5,225,362	039: Travel and passenger transportation services; Transport of passengers by air; Chartering of aircraft; Booking agency services for travel, travel ticket reservation services; provision of computerised travel information.
BLU WAGON (66 TTABVUE 62-63)	87/947,723	039: Transportation and delivery services by air, road, rail and sea.
BEYOND BLUE (66 TTABVUE 64-65)	1,479,897	039: Reservation services for all types of travel; Arranging and booking of travel by air and sea for package holidays; Arranging and booking of travel, excursions and cruises; arranging and booking of individual or group travel.
ST. BLUE (66 TTABVUE 71-72)	4,086,849	039: Air freight shipping services: Air transportation of passengers and freight.
BLUE WATER (66 TTABVUE 77-78)	3,004,151	039: Chartering, namely, planes and break bulk vessels; Express delivery of goods by air and truck.
BLUE WATER (66 TTABVUE 93-94)	5,639,914	039: Shipping services, namely, parcel shipping services, air freight shipping services and shipping of goods; Air freight shipping services.
SHIP IT BLUE (66 TTABVUE 83-84)	3,958,972	039: Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck.
BLUE ZONES (66 TTABVUE 89-90)	87/378,032	039: Transport services for sightseeing travel tours; Reservation services for transportation.
BLUE SKY SELF STORAGE (66 TTABVUE 103-04)	90/691,543	039: Supply chain logistics and reverse logistics services, namely, storage, transportation, and delivery of goods for others by air, rail, ship or truck.
BLUE MOON (66 TTABVUE 105-07)	88/227,361	039: Travel services, namely, arranging high altitude flights.
BLUE ZONES LIVING (66 TTABVUE 108-10)	88/078,247	039: Provision of travel information; Arranging of transportation for travel tours; Providing a web site featuring travel information and commentary.
BLUE ORIGIN (66 TTABVUE 111-13)	88/151,867	039: Travel services, namely, arranging high altitude flights.
BLUE SHIFT HELICOPTERS (66 TTABVUE 114-16)	87/458,180	039: Helicopter transport encompassing Federal Aviation Regulation Part 135.
USPS BLUEEARTH (66 TTABVUE 124-26)	4,823,042	039: Pickup, transportation and delivery of packages and documents by various modes of transportation.
BLUE SKIES BY NETJETS (66 TTABVUE 130-32)	5,167,020	035: Aircraft business management services, namely, managing and arranging aircraft operations and aircraft crew scheduling for others.
GREAT BLUE HERON (66 TTABVUE 140-41)	97/006,673	039: Travel agency services, namely, making reservations and bookings for transportation;

		Travel booking agencies; Coordinating travel arrangements for individuals and for groups; Providing information about travel, via the Internet.
BLUE PLANET TOURISM (66 TTABVUE 142-44)	90/116,412	039: Travel booking agencies; Airline ticket reservation services; Booking of tickets for air travel; Providing automated check-in and ticketing services for air travelers; Providing information, news and commentary in the field of travel.
BLUE CARD (66 TTABVUE 145-46)	90/606,588	039: Air and ground transportation services for passengers and others; Bookings for private air transportation services featuring a payment or exchange program for air travelers and others.
BLUSHIFT (66 TTABVUE 147-48)	90/906,671	039: Launching of spacecraft for others.
BLUE SUNSET TRAVEL (66 TTABVUE 149-50)	90/900,040	039: Travel arrangement; Travel booking agencies.
BLUE SABER TRANSPORTATION (66 TTABVUE 151-52)	90/576,565	039: Shipping and delivery services, namely, pickup, transportation, and delivery of packages and letters by various modes of transportation

In addition to the numerous U.S. trademark registrations and applications, there are several third parties using blue-formative marks in the airline industry.

JetBlue acknowledges the existence of Virgin Blue, which has re-branded to Virgin Australia. 100 TTABVUE 40. Before it rebranded, Virgin Blue marketed and offered international flights between Australia and the United States. 66 TTABVUE 3-4. JetBlue’s witnesses testified that JetBlue was aware of Virgin Blue’s international flights to the U.S. (78 TTABVUE, Ex. 5 210:15-25) and that “JetBlue would not have considered such use of the Virgin Blue mark likely to cause confusion with, or dilute, JetBlue’s marks in the United States, *even if Virgin Blue had not rebranded.*” 97 TTABVUE 3. (emphasis supplied). These types of international flights are exactly what airblue intends to offer. 36 TTABVUE 7.

Applicant has also submitted evidence relating to several foreign airlines, which JetBlue claims are irrelevant. 100 TTABVUE 39-40. These foreign air carriers are relevant because they show (1) that there is widespread use of blue-formative marks in the global airline industry, (2) that JetBlue is able to co-exist with these foreign air carriers in South America and Europe, and (3) to show the ubiquitous nature of the channels of trade used by JetBlue, the foreign air carriers, and airblue, namely company websites, social media, and third-party booking websites like eSky.com, Expedia.com, Kayak.com, and Wego.com. For

example:

- Blue Islands is a European airline that markets air transportation services via its own website, social media, and third-party booking websites such as Expedia.com. 68 TTABVUE 60-91; 73 TTABVUE 404-08.
- Bluebird Airways is a European airline that markets air transportation services via its own website, social media, and third-party booking websites including Kayak.com and Wego.com. 68 TTABVUE 93-104; 69 TTABVUE 2-14.
- Blue Wing Airlines is a South American airline that markets air transportation services on its own website and social media. 69 TTABVUE 16-37.

In addition to the numerous entities offering air transportation, frequently flyer programs, and credit cards under blue-formative marks identified above, two of JetBlue's direct competitors, American Airlines and Delta Air Lines, each use blue-formative marks for credit card services—the “Aviator Blue MasterCard” and the “Blue Delta SkyMiles Card,” respectively. 88 TTABVUE 35-38; 66 TTABVUE 26-27; 73 TTABVUE 18; and 65 TTABVUE 78 (identifying “JetBlue's main competitors” including American Airlines and Delta Air Lines). JetBlue has not objected to the name of either competitor's credit card. 78 TTABVUE, Ex. 5 (219:8-220:8; 222:7-21).

The airline industry is clearly saturated with several coexisting blue-formative marks.

V. LAW AND ARGUMENT.

JetBlue opposes the AIRBLUE Mark on three grounds: (1) a likelihood of confusion between the JETBLUE Mark and the AIRBLUE Mark¹¹; (2) a likelihood of dilution of the JETBLUE Mark; and (3) that airblue allegedly lacked a *bona fide* intent to use the AIRBLUE Mark. 100 TTABVUE 30. The Board should reject all of them, and each is addressed in turn.

A. Applicant's AIRBLUE Mark is Not Likely to Cause Confusion with the JETBLUE Mark.

¹¹ In its Notice of Opposition, Opposer alleges that the AIRBLUE Mark is likely to be confused with “Opposer's BLUE Marks.” 1 TTABVUE ¶ 41. In its trial brief, Opposer only argues that the AIRBLUE Mark “is confusingly similar to JetBlue's JETBLUE Mark.” 100 TTABVUE 30. Accordingly, JetBlue has waived any argument relating to a likelihood of confusion with its purported family of BLUE Marks. T.B.M.P. § 801.01 (“If a party fails to reference a pleaded claim . . . in its trial brief, the Board will deem the claim . . . to have been waived.”), citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 U.S.P.Q.2d 1424, 1426 n.3 (T.T.A.B. 2013).

In assessing the likelihood of confusion, the thirteen *du Pont* factors “must be considered when they are of record.” *In re Guild Mortg. Co.*, 912 D.3d 1376, 129 U.S.P.Q. 2d 1160, 1162 (Fed. Cir. 2019). The *du Pont* factors include: (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity of and nature of the goods and services; (3) the similarity or dissimilarity of established channels of trade; (4) the conditions under which and buyers to whom sales are made, i.e., impulse vs. careful sophisticated purchasing; (5) the strength of the senior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interference between the applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether *de minimus* or substantial; and (13) any other established facts probative of the effect of use. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (“*du Pont*”). The Board often starts by considering the strength of Opposer’s mark to evaluate the scope of protection to which the mark is entitled.

To prevail on its claim, Opposer must prove by a preponderance of the evidence that Applicant’s mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant’s goods, even in the absence of contrary evidence or argument. *B&B Hardware, Inc. v. Hargis Indus. Inc.*, 113 U.S.P.Q. 2d 2045, 2046, 2056 (2015); *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 U.S.P.Q. 2d 1031, 1040 (T.T.A.B 2010). Applicant submits that a majority of the factors weigh in favor of Applicant, and JetBlue has failed to meet its burden. Judgment should be entered in Applicant’s favor.

1. The JETBLUE Mark is both Conceptually and Commercially Weak.

The strength of a mark is determined by examining both the conceptual or inherent strength of the mark, as well as the commercial strength or recognition of the mark. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q. 2d 1458, 1476 (T.T.A.B 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 U.S.P.Q. 2d 1681, 1686 (Fed. Cir. 2010).

“Extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established.” *Pure & Simple Concepts, Inc. v. I H W Mgmt.*, 857 F. App’x 652, 656 (Fed. Cir. 2021) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)). Third-party registrations containing a segment of a mark that both contesting parties use show “that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.* at 656 (quoting *Juice Generation*, 794 F.3d at 1339).

JetBlue concludes that its JETBLUE Mark is inherently strong and commercially famous. For the reasons set forth below, JetBlue has failed to show its JETBLUE Mark is inherently distinctive and has failed to meet its burden to clearly show its JETBLUE Mark is famous.

a. The JETBLUE Mark is Conceptually Weak.

The conceptual strength of a mark is determine by placing it on the continuum from generic, descriptive, suggestive, and arbitrary or fanciful. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 972 (Fed. Cir. 2018). Terms that are suggestive, arbitrary, or fanciful are “inherently distinctive” whereas terms that are descriptive or generic are not. *Id.* at 973. A descriptive term “immediately conveys information concerning a feature, quality, or characteristic of the goods or services,” the category is not “a monolithic set of terms [rather] some terms are only slightly descriptive and others terms are highly descriptive.” *Real Foods Pty Ltd.*, 906 F.3d at 972. A suggestive term “requires imagination, thought, and perception to reach a conclusion about the nature of the goods.” *In re N.C. Lottery*, 866 F.3d 1363, 1366 (Fed. Cir. 2017). Finally, fanciful or arbitrary terms do not describe or suggest any characteristic of the goods and services, rather they are “coined” word or phases “that have been added to rather than withdrawn from the human vocabulary by their owners, and have, from the very beginning, been associated in the public mind with a particular product.” *Real Foods Pty Ltd.*, 906 F.3d at 973.

JetBlue argues that “JETBLUE does not describe any characteristic or qualities of JetBlue’s products or services” and is a “fanciful term.” 100 TTABVUE 35. This is demonstrably false. The JETBLUE Mark is comprised of the terms “Jet” and “Blue.” 100 TTBAVUE 11. JetBlue has admitted that

“Jet” has “meaning with respect to air travel.” 100 TTABVUE 43. JetBlue has also admitted that the term “Blue” has an informational, descriptive meaning in the industry; it refers to “the wild blue yonder . . . It’s the sky”.¹² 70 TTABVUE 7-8. As noted above, the dictionary definitions of both terms directly describe JetBlue’s air transportation services: “Jet” is defined as “an airplane powered by one or more jet engines” or “to travel by jet” and “Blue” is defined as “the color whose hue is that of the clear sky.” *See supra* Section IV.C. Consumers who encounter the JETBLUE Mark are likely to understand it is associated with air transportation based on the common meaning of these terms.

A mark can also be considered as descriptive if third-party registrations “show that a mark or a portion of a mark is descriptive or suggestive of services because a term has a recognized meaning.” *In re Forte Solutions Group, LLC*, 2012 TTAB LEXIS 301, *12 (T.T.A.B. 2012). “Blue” makes up part of two dozen registrations related to aviation travel, aviation entertainment, or travel services in general. *See Supra* Section IV. This demonstrates that “blue” in association with airplane services and travel is descriptive. *Therabody, Inc. v. Shanghai Three Gun (Grp.) Co.*, 2022 TTAB LEXIS 420, *30–31 (T.T.A.B. 2022) (finding the prolific use of “gun” by third-parties in relation to a massage apparatus, as evidence that “gun” is “weak and diluted”); *In re Forte Solutions Group, LLC*, 2012 TTAB LEXIS 301, *12 (T.T.A.B. 2012).

JetBlue claims the incontestable status of its marks as proof that the JETBLUE Mark is inherently distinctive. 100 TTABVUE 35. This, too, is incorrect. “[I]ncontestable status means [the mark] is conclusively considered to be valid, but it does not dictate that the mark is ‘strong’ for purposes of determining a likelihood of confusion.” *Safer, Inc. v. OMS Investments, Inc.*, 94 U.S.P.Q.2d 1031, 1036 (T.T.A.B. 2010), *see also Sock it To Me, Inc. v. Hordijczuk*, Opp. No. 91236423, 2020 BL 304244 at *4 (T.T.A.B. 2020) (“the incontestable status of Opposer’s registration is of no consequence to the strength of Opposer’s mark”). *In re Majestic Distilling Co.*, 315 F.3d 1311, 1319 (Fed. Cir. 2003) (incontestable status of a mark does not “directly bear on likelihood of confusion” under the *DuPont* factors).

¹² In addition, “third party registrations and uses are competent to show that [blue] has an accepted meaning in a given field.” *ProMark*, 114 U.S.P.Q.2d at 1244.

When two descriptive terms, such as “jet” and “blue”, are combined into one composite term, “the determination of whether the composite also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression.” *In re Datapipe, Inc.*, 111 U.S.P.Q. 2d 1330, 1332 (T.T.A.B. 2014). The deletion of a space between two words does not change merely descriptive terms into a non-descriptive term. *See In re Planalytics, Inc.*, 70 U.S.P.Q. 2d 1453, 1455 (T.T.A.B. 2004) (finding that “GASBUYER”, a combination of the descriptive terms “GAS” and “BUYER”, is merely descriptive); *see also In re 3Com Corp.*, 56 U.S.P.Q. 2d 1060 (T.T.A.B. 2000) (finding that “ATMLINK”, a combination of “ATM” and “LINK”, is generic); *see also Micro Motion Inc. v. Danfoss A/S*, 49 U.S.P.Q. 2d 1628 (T.T.A.B. 1998) (finding that “MASSFLO”, a misspelled version of “mass flow”, is generic). Thus, the JETBLUE mark is descriptive because it describes core “function, feature, [and] purpose . . . of the relevant good[],” and airline common carrier company. *In re Jewelry Supply, Inc.*, 2011 TTAB LEXIS 148, *6–7 (T.T.A.B. 2011) (finding the phrase “Jewelry Supply” descriptive for an online jewelry retailer).

As discussed *supra*, JetBlue has admitted that both “jet” and “blue” are merely descriptive terms that have informational meaning within the airline industry. The combination of these two terms does not create a non-descriptive term. JetBlue has failed to show that its JETBLUE mark is anything more than a descriptive term used to describe its goods and services, let alone commercially strong.

b. Opposer Failed to Establish its JETBLUE Mark is Commercially Strong, Let Alone Famous.

The “fame of the prior mark” is to be considered in determining a likelihood of confusion. *du Pont*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567. “Because of the extreme deference accorded to a famous mark . . . and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it.” *L’Oreal S.A. v. Marcon*, 102 U.S.P.Q. 2d 1434, 1437 (T.T.A.B. 2012). The strongest evidence of commercial strength is “direct evidence” in the form of consumer surveys. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1374, 63 U.S.P.Q. 2d 1303 (Fed. Cir. 2002). Commercial strength can also be “measured indirectly by the volume of sales and advertising expenditures of the goods

sold under the mark, for example, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services.” *Weider Publ’ns, LLC v. D & D Beauty Care Co., LLC*, 109 U.S.P.Q. 2d 1347, 1354 (T.T.A.B. 2014).

JetBlue does not present any consumer surveys or other direct evidence of commercial strength. Instead, JetBlue attempts to show commercial strength through indirect evidence; for the reasons set forth below, it fails to clearly show the JETBLUE Mark is commercially strong.¹³

i. JetBlue’s Advertising and Revenue Figures are Misleading and Lack Context.

JetBlue claims that it expended upwards of [REDACTED] 100 TTABVUE 17. These figures are grossly misleading and insufficient to prove fame for several reasons.

First, JetBlue fails to mention that these figures relate to JetBlue’s *global* business. 78 TTABVUE, Ex. 5 (174:9-13, 176:1-3); *see also id.* (177:3-5) (“But the revenue is generated across our network which spans beyond the U.S.”). JetBlue’s former “director of brand and advertising” could only “guesstimate” how much of the advertising and revenues is attributed to the U.S. market. *Id.* (174:18–175:11). When asked what she was relying on to arrive at that “guesstimate,” she responded “hearsay.” *Id.* (174:18–175:11); *see also id.* (176:9-13). In short, JetBlue has no evidence showing how much it expended on marketing *in the U.S.*, nor how much revenue it derived from conduct *in the U.S.* “Because Opposer failed to break down sales and expenditures for the United States alone, the probative value of this evidence to prove commercial strength or fame is diminished.” *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 U.S.P.Q. 2d 10596 (T.T.A.B. 2020).¹⁴

¹³ To the extent JetBlue argues its use of the JETBLUE Mark since 2000 is evidence of its strength or recognition, “the probative value of this factor is greatly diminished inasmuch as this use was not substantially exclusive given the third party uses” of “blue” in the industry. *Stuart Spencer Designs*, 94 U.S.P.Q. 2d 1549, 1572 (T.T.A.B. 2009); *see supra* Section IV.F.

¹⁴ JetBlue testified that the majority of its advertising occurs on the East Coast. 78 TTABVUE, Ex. 5 (157:1-159:24); 56 TTABVUE 350 (“JetBlue is not as relevant on a national scale outside of [the]

Second, JetBlue relies exclusively on its 2013, 2016, and 2019 10-K forms for its financial information. *See* 100 TTABVUE 17 (citing 57 TTABVUE 14, 212-15). As noted in Applicant’s Objections to JetBlue’s Evidence, incorporate herein by reference, the 10-K forms cannot be used to prove the truth of the matter asserted. *See* Applicant’s Statement of Objections Section I.B, submitted herewith; *see also Overstock.com, Inc. v. J. Becker Mgmt.*, 2015 TTAB LEXIS 211, *9 (T.T.A.B. 2015) (10-K forms are hearsay). Even if the 10-K forms could be used in this way, the forms provide no information relating to what is included in JetBlue’s advertising costs or how those costs are distributed. Instead, each 10-K form has the same two-sentence recitation of the advertising costs; for example, the 2019 10-K form reads in full: “Advertising costs, which are included in sales and marketing, are expenses incurred. [REDACTED] [REDACTED] 56 TTABVUE 180. [REDACTED] [REDACTED] 78 TTABVUE, Ex. 5 (155:3-20, 167:13-168:9; 267:17-268:11); 95 TTABVUE 356. In short, JetBlue’s only evidence of its advertising costs is not supported by the record.

Third, JetBlue fails to provide any context for its advertising and revenue figures “in terms of comparing the sales figures over the same period with those of others . . . or showing Opposer’s market share compared with that of other [U.S. airlines], or even comparing Opposer’s annual advertising with those of other [U.S. airlines].” *Morgan Creek Prods., Inc. v. Foira Int’l Inc.*, 91 U.S.P.Q. 2d 1134, 1140 (T.T.A.B. 2009). JetBlue merely asserts that is it the fifth or sixth largest carrier, but does not identify how many carriers there are in the market, or how any of its figures relate to the other carriers. 100 TTABVUE 33. Evidence in the record suggests JetBlue has a small market share. A 2020 article, submitted by JetBlue, reports that the company “has only about 5% market share” compared to the 81% of the market that is dominated by “Delta, American, United, and Southwest.”¹⁵ 56 TTABVUE 350. JetBlue’s 10-K forms

Northeast [and] Florida. . . .”). JetBlue has presented no evidence that consumers nationwide have encountered the JETBLUE Mark, let alone that they “recognize the mark as a source indicator.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 U.S.P.Q.2D (BNA) 1043, 1056 (T.T.A.B. 2017).

¹⁵ The same article reports that JetBlue is comparatively “small and faces severe competition from the bigger carriers.” 56 TTABVUE 350.

also provide that “most of [JetBlue’s] competitors are larger and have greater financial resources and name recognition than we do.” 56 TTABVUE 16. “Raw numbers of product sales and advertising expense may have sufficed in the past” but “raw numbers alone in today’s world may be misleading” and “some context in which to place raw statistics” is needed. *Bose Corp.*, 293 F.3d at 1375. JetBlue has failed to provide context for its financial figures.

In addition to all of the above, JetBlue claims that *all* of its advertising expense and revenue figures “necessarily pertains to the JETBLUE Mark.” 100 TTABVUE 17. Tellingly, JetBlue does not cite to anything to support this proposition, nor is there any evidence in the record to substantiate it. JetBlue has failed to present any evidence to “establish[] the percentage of revenue or advertising figures which pertain specifically to the [JETBLUE] mark” let alone the services at issue in this Opposition. *Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 U.S.P.Q.2d 1182, 1194 (T.T.A.B. 2014); *see also Masimo Corp. v. Rooti Labs Ltd.*, Opp. No. 91224804, 2017 BL 325495, at *10 (T.T.A.B. 2017) (\$630 million in revenue and 40% market share “may show Opposer’s general popularity” but “does not demonstrate the commercial strength of its ROOT mark in particular”).

ii. JetBlue’s Other Indicia of Commercial Strength are Insufficient.

JetBlue claims that its website and mobile application are viewed by millions of consumers a year, that it has millions of followers on social media, and that third party publications have resulted in millions of impressions. 100 TTABVUE 16-17. Once again, JetBlue fails to present the full picture and engages in wild speculations about the nature of this “evidence.”

First, JetBlue testified that these metrics relate to its global business and could not provide statistics specific to the U.S. market. 78 TTABVUE, Ex. 5 (41:6-8; 44:13-17; 45:18-23; 126:22-129:2; 145:3-8). Second, JetBlue acknowledges that a single consumer could result in multiple “visits” or “impressions” and could not say how many individual consumers visited the website or mobile application or saw the third party publications. *Id.* (120:17-121:7). Third, JetBlue testified that some unknown number of visitors and followers are “bots” or fake accounts. *Id.* (57:22-62:20, 122:1-123:1). Finally, JetBlue testified that it tracks every mention of JetBlue in third party media; there is no evidence that the JETBLUE Mark is used

in a way that impacts consumer perception in any of the media mentions. *Id.* (136:20-25).

JetBlue also identifies eight marketing campaigns that it claims are “iconic” and have led to millions of impressions. 100 TTABVUE 18. The only evidence JetBlue submitted is mock ups of these campaigns and videos discussing or showing the commercials. *Id.* As set forth in Applicant’s Objections to JetBlue’s Evidence, the content of the videos is hearsay and cannot be used to prove the truth of the matter asserted. *See* Applicant’s Statement of Objections Section II.C, submitted herewith. There is no evidence in the record relating to what criteria makes these campaigns “iconic” or how many people were actually exposed to these marketing materials.

The same is true for the awards JetBlue has received—JetBlue testified that it did not know how many consumers were aware of the awards or whether there was any marketing related to the awards. 78 TTABVUE Ex. 5 (178:12-186:4).

Without context showing how many U.S. consumers are exposed to these marketing efforts, this evidence is insufficient to show commercial strength or fame of the JETBLUE Mark. JetBlue’s conclusory assertions and reliance on inadmissible hearsay falls far short of its burden to establish the strength and fame of the JETBLUE Mark.

iii. Numerous Third Parties use Blue-Formative Marks in the Industry and “Blue” is Closely Associated with Air Transportation Services.

Third-party use and registration of similar marks “bears on the strength or weakness of Opposer’s mark.” *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015). In a crowded field of similar marks, a “mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q. 2d 1689, 1693 (Fed. Cir. 2005) (citing *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626-27 (8th Cir. 1987)).

JetBlue claims that “Blue” “is the core of the JETBLUE brand” and is the “dominant part” of each of its BLUE Marks. 100 TTABVUE 12. As noted above, dozens of third-parties have registered, have applied to register, and/or use blue-formative marks in air transportation and closely related goods and

services. *See supra* Section IV.F. JetBlue merely claims that Applicant has not shown the extent of use of the third-party marks in the U.S. 100 TTABVue 42. Even if this were true, the sheer volume of “evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 U.S.P.Q.2d at 1136 (citing *Juice Generation*, 115 U.S.P.Q.2d at 1674 (finding the existence of twenty-six third party marks powerful on its face)). This is particularly true here. The Board “must account for the field and industry at issue, in this case aviation and airlines” and “three examples of relatedness are more than sufficient in the oligopolistic airline industry.” *In re TriStar History and Preservation Inc.*, 2015 BL 304357, at *3 (T.T.A.B. 2015). The existence of similar Blue-formative marks weakens the JETBLUE mark.

2. The Marks are Substantially *Dissimilar*.

The first *du Pont* factor requires examination of the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re E.I du Pont*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The test is not whether the marks can be distinguished when subject to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. *See Zheng Cai v. Diamond Hong, Inc.*, 127 U.S.P.Q.2d 1797, 1801 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 U.S.P.Q.2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1551 (T.T.A.B. 2012); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L’Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1438 (T.T.A.B. 2012).

When two marks share a syllable, the Board considers whether that syllable is “more responsible than other elements” for creating the consumer impression related to each mark. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 U.S.P.Q.2d 1232, 1243 (T.T.A.B. 2015). In addition, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that descriptive and conceptually weak designations are entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 U.S.P.Q.2d 1671,

1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 1026 (T.T.A.B. 2009).

While marks are considered in their entireties, “it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this feature in determining the commercial impression created by the mark.” *L’Oreal S.A.*, 102 U.S.P.Q.2d at 1438 (citing *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985)). The parties share one syllable—the term “blue”—which as noted above refers to the sky. *See supra* Section IV.C. JetBlue does not deny that dozens of third parties use and hold registrations for mark containing the common syllable “blue” to market goods and services in the airline industry. *See supra* Section IV.C; 100 TTABVUE 36-39. Rather, JetBlue tries to distinguish the third party marks or submits that such use of the term “blue” is not likely to be confused with the JETBLUE Mark. 100 TTABVUE 36-39. Regardless of JetBlue’s position on these third parties, “[s]uch third party registrations and uses are competent to show that the common term has an accepted meaning in a given field and ... the remaining portions of the marks may be sufficient to distinguish the marks as a whole from one another.” *ProMark*, 114 U.S.P.Q.2d at 1244. Given the descriptive nature of the term “blue,” the term “contributes less distinctiveness to the overall commercial impression of the parties’ respective marks than would an arbitrary or fanciful term” and consumers are likely to focus on other elements of the marks. *ProMark*, 114 U.S.P.Q.2d at 1244.

Descriptiveness aside, at a minimum the extensive use of “blue” in the industry shows that “consumers have been educated to distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin*, 116 U.S.P.Q. 2d at 1136. This is true even though “blue” comprises only a portion of the JETBLUE Mark. For example, in *Primrose Retirement*, the Board found—in view of evidence of third-party “ROSE-formative” marks—the Opposer’s PRIMROSE mark could only “bar the registration of marks as to which the resemblance to Opposer’s mark is striking.” *Primrose Retirement*, 122 U.S.P.Q. 2d at 1036-37 (citing *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 U.S.P.Q. 2d 1271, 1278 (T.T.A.B. 2009)). When examining the similarity of the marks the Board found that although the

marks generally “look and sound alike to the extent the ROSE is present in both” and the meaning of both marks relates to a “flowering plant,” the marks were “specifically different” and this factor weighed against a likelihood of confusion. *Id.* at 1037-38.

Here, consumers are likely to focus on the first syllable of the Parties’ marks, namely “air” and “Jet” given the descriptive meaning and wide spread use of “blue.” *ProMark*, 114 U.S.P.Q.2d at 1244; *Primrose Retirement*, 122 U.S.P.Q. 2d at 1037 (“The initial element PRIM-” is “prominent” given third party use of ROSE); *see also L’Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d at 1439 (“purchasers in general are more inclined to focus on the first word or portion in a trademark”); *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q. 2d 1895, 1897 (T.T.A.B. 1988) (“it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered”).

“Jet” and “air” are different in appearance and sound. The “air” in the AIRBLUE Mark is generally pronounced like “err” and is softer than the hard “j” and “t” sounds in “Jet.” Further, “Jet” refers to the aircraft JetBlue uses to render its services (*see supra* Section IV.C), whereas “air” refers to the sky. 73 TTABVUE 2. The appearance, sound and connotation of the JETBLUE and AIRBLUE marks are not similar—at a minimum they are “specifically different.” *Primrose Retirement*, 122 U.S.P.Q. 2d at 1037-38. These distinctions also illustrate the differences in intended commercial impressions of each Parties’ marks.

3. Channels of Trade.

JetBlue argues that the parties’ services travel in the same channels of trade because airblue intends to market services through “the same social media channels (ex. Facebook, Twitter, and Instagram), and the same online travel agency websites—such as Expedia.com, eSky.com, Wego.com, Kayak.com and OneTravel.com—that JetBlue already uses to promote its services.” These same channels are used by nearly all of the third-party entities offering similar services under blue-formative marks. *See Supra* Section IV.F. “Advertising on the Internet is ubiquitous and ‘proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 754 (Fed. Cir. 2014) (quoting *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453, 470-71 n.14

(E.D. Pa. 2012)).

4. JetBlue's Customers are Sophisticated and Exercise Care when Purchasing JetBlue's Goods and Services.

JetBlue has previously argued that at least some of its customers are “sophisticated purchasers that are unlikely to be confused.” 33 TTABVUE 132. When customers of goods or services are similar, sophistication among those customers is “important and often dispositive because ‘sophisticated consumers may be expected to exercise greater care.’” *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489 (1st Cir. 1981)). “There is always less likelihood of confusion,” where a service is expensive and purchased by a sophisticated customer. *Id.* at 16 (quoting *Astra Pharmaceutical Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206 (1st Cir. 1983)). Substantial choices in services when selecting a company to provide said services serves as “substantial evidence” that a consumer exercises a high degree of care and “militates against finding a likelihood of confusion.” *PC Club v. Primex Techs., Inc.*, 32 F. App’x 576, 579 (Fed. Cir. 2002)

Here, JetBlue’s customers, by its own admission, are “sophisticated purchasers that are unlikely to be confused.” 33 TTABVUE 132. Customers looking to purchase an airline ticket also have substantial choices to make when doing so, such as departure/arrival locations, departure/arrival times, class of ticket, optional in-flight services, and baggage checking services to name a few. Consumers face even more choices when selecting credit cards and rewards programs, such as interest rates, cash back/rewards, ancillary benefits, backing financial institutions, card payment networks, annual fees, and other miscellaneous charges and fees. The substantial care required and exercised by customers when selecting an airline ticket or credit card weighs heavily against likelihood of confusion. The litany of decisions to be made before purchasing air transportation services or enrolling for a credit card reduce the likelihood of confusion. *See PC Club*, 32 F. App’x at 579 (Fed. Cir. 2002) (finding the existence of choices in a product, such as the amount of memory a customer wants in a laptop, weighs against likelihood of confusion).

In addition, airline tickets, particularly on international flights, are not so inexpensive that they are

subject to impulse buying. *See Recot Inc. v. M.C. Becton*, 54 U.S.P.Q. 2d 1894, 1899 (Fed. Cir. 2000). Accordingly, the Board should assume consumers exercise a high degree of care. *See also In re Republic Jet Center LLC*, 2019 BL 202990, at *6 (T.T.A.B. 2019) (“[B]ecause [the] services involve general aviation and aviation support services, we assume that consumers will exercise a high degree of care when making their purchasing decisions”).

5. There are Numerous Similar Marks used by Third Parties.

The sixth *du Pont* factor “requires [the Board] to consider evidence pertaining the number and nature of similar marks in use on similar services.” *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 U.S.P.Q. 2d 1030, 1033 (T.T.A.B. 2016).

JetBlue is well aware of the widespread use of the term blue in the industry. Indeed, a 2009 article entitled “JetBlue Airlines: It’s All in a Name” reports that when JetBlue was first searching for a name, it “liked Blue right away, but everybody agreed the word alone would be impossible to trademark.” 70 TTABVUE 6. After bringing in consultants, JetBlue landed on the name True Blue, but two weeks before the airline was to publicly announce the name, it learned that Thrifty Rent-A-Car owned the mark True Blue. 70 TTABVUE 7-8.

[REDACTED]

[REDACTED]

[REDACTED]

A segment of a mark “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.’” *Jack Wolfskin*, 797 F.3d at 1374 (quoting *Juice Generation*, 794 F.3d at 1339). Extensive use of a segment of a mark used on similar goods and services is evidence that consumers “have been educated to distinguish between different marks,” and are not as likely to be confused by similar marks. *Id.*

[REDACTED]

[REDACTED] *See supra* Section

IV.F. [REDACTED]

[REDACTED]

Consumers are likely to understand that Applicant's Mark is unrelated to and separate from the JETBLUE Mark.

6. There is No Evidence of Actual Confusion Despite Substantial Concurrent Use.

JetBlue has not presented a shred of evidence that there has been any consumer confusion between JetBlue and airblue. In fact, [REDACTED]

[REDACTED] 78 TTABVUE, Ex. 5 (194:10-19). Airblue is likewise unaware of any instances of actual confusion. (Chaudhary 30(b)(6) at 160:8-20). JetBlue has not presented any surveys, consumer testimonials, or expert testimony that could be a proxy for actual confusion.

JetBlue (founded in 2000) and airblue (founded in 2003) have coexisted in the airline industry for nearly 20 years. 100 TTABVUE 11. Opposer states, "passengers flying to or from the Middle East (including enroute to Pakistan) also take JETBLUE-branded flights or use JETBLUE-branded airline services, including through JetBlue's partnership with Emirates, the largest airline in the Middle East." 100 TTABVUE 15. In addition, hundreds of U.S. customers have enrolled in airblue's frequently flyer program and more than 12,000 U.S. citizens have flown on airblue flights. *See supra* Section IV.A. Despite JetBlue serving customers from airblue's primary market, and airblue serving customers from the U.S., JetBlue is unable to point to any evidence of actual confusion throughout 20 years of simultaneous operations and overlapping customers. The complete lack of evidence of actual confusion, as well as substantial concurrent use of the JETBLUE and AIRBLUE marks without actual confusion, weighs heavily against a finding of likelihood of confusion. *See United Foods Inc. v. United Air Lines, Inc.*, 41 U.S.P.Q. 2d 1653, 1663 (T.T.A.B. 1995) (finding no confusion in view of nine years of contemporaneous use and only three, un-

proven instances of actual confusion).

7. JetBlue Has Not Established a Family of Marks.

As noted *supra*, JetBlue claims it “owns a family of BLUE Marks,” and that “[t]he ‘blue’ formative of the family comprises the dominant part of each mark. 100 TTABVUE 44. JetBlue bears the “very high hurdle [of] showing that it has established a ‘family of [“blue”] marks.’” *Slim N’ Trim, Inc. v. Walgreen Co.*, 2004 TTAB LEXIS 143, *7–9 (T.T.A.B. Mar. 16, 2004) (citing 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 23:61 at page 23–139 (4th ed. 2002)). A family of marks forms when “the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner.” *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1461 (Fed. Cir. 1991). Thus, the Board has routinely held that merely pointing to multiple registrations containing the family term or use of the family term is insufficient to demonstrate a family of marks. *See e.g., Manhattan Int’l Trade Inc. v. Industrie IP Pty Ltd.*, 2018 TTAB LEXIS 164, *16 (T.T.A.B. May 11, 2018); *In re United States Steel Corp.*, 2016 TTAB LEXIS 128, *10–11 (T.T.A.B. Apr. 8, 2016)); *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461 (T.T.A.B. 1978); *Consol. Foods Corp. v. Sherwood Med. Indus. Inc.*, 177 U.S.P.Q. 279, 282 (T.T.A.B. 1973). “In fact, where a party argu[es] that it owns a family of marks fails to introduce testimony or other evidence on the specific question of whether consumers recognize the family, the party is typically unable to prove ownership of a family of marks.” *Manhattan Int’l Trade*, 2018 TTAB LEXIS 164, *16–17 (collecting cases rejecting a family of marks where the plaintiff failed to provide testimony or other evidence of consumer recognition); *see also Champion Int’l Corp. v. Plexowood, Inc.*, 191 U.S.P.Q. 160, 162 (T.T.A.B. 1976) (“There is nothing in evidence to show the nature and extent of use of opposer’s other ‘FLEX’ prefixed marks . . . much less that the various marks . . . have become familiar or known to the relevant segment of the purchasing public. . . . This purchaser recognition factor, the salient consideration necessary to achieve a ‘family of marks’, is noticeably lacking in this case.”).

Here, there is nothing to suggest that consumers associate the use of the word “blue” in the airline industry with JetBlue. In fact, as noted *supra*, there is substantial evidence showing that “blue” is a common

segment of several third-party marks used throughout the airline and credit card industry. JetBlue has provided no direct evidence of consumers associating the word “blue” with JetBlue, let alone that it has a family of marks formed by the word “blue.” This factor weighs against a finding of likelihood of confusion.

Failure to introduce evidence of consumer recognition of “blue” is not the sole basis the Board has to reject a claim of a family of marks. The Board should reject this claim because the term “blue” is merely descriptive of the good or service associated with the marks in the family. *See, e.g., Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 TTAB LEXIS 383, *41–45 (T.T.A.B. 2022) (concluding that ‘SMOK,’ read as ‘smoke,’ for vaping products is descriptive and without establishing distinctiveness, cannot be the basis of a family of marks); *Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 U.S.P.Q. 2d 1782, 1801–02 (T.T.A.B. 2002) (in connection with family of marks claim, making the observation that “[t]he term ‘Authority,’ is highly suggestive when used as part of a series of marks for retail store services, in that the term readily suggests that [opposer] can provide customers ‘authoritative’ assistance.”); *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461 (T.T.A.B. 1978) (in connection with family of marks claim utilizing the term AQUA, the Board observed that “the term ‘AQUA’ possesses an obvious meaning or connotation of ‘water’ which would be known to the average purchaser of plumbing equipment, whether a plumber or a homeowner, and, as such, it is highly suggestive if not descriptive of plumbing supplies”); *Logetronics, Inc. v. Logicon-Intercomp Inc.*, 199 U.S.P.Q. 814, 818 (T.T.A.B. 1978) (in connection with family of marks claim utilizing the prefix LOG or LOGE, the Board observed that “the alleged root of the family, ‘LogE’, has an admittedly highly suggestive connotation (the log of exposure)”).

Here, “blue” is descriptive, or at minimum suggestive, of airline related goods and services as established in *supra* Section IV.C. Moreover, JetBlue has failed to demonstrate that its descriptive mark, blue, has acquired distinctiveness. *See supra* Section IV.C. JetBlue has not demonstrated it owns a family of blue-formative marks.

8. The Extent of Potential Confusion, if any, is De Minimis.

As stated numerous times *supra*, there is no evidence on the record of any actual confusion. JetBlue has also failed to submit any consumer surveys, consumer testimonials, or expert testimony to support the

assertion of potential confusion.

Consumer surveys “disclosing likelihood of confusion ranging from 11 percent to 25 percent have been found significant,” however “a 7.6 percent level of confusion is not very significant.” *Helene Curtis Indus. v. Suave Shoe Corp.*, 13 U.S.P.Q. 2d 1618, 1626 (T.T.A.B. 1989). There are no consumer surveys in the record that indicate any actual or potential confusion, thus this factor weighs against finding a likelihood of confusion.

9. Applicant has not Engaged in Bad Faith.

Despite not pleading bad faith in its Notice of Opposition, JetBlue argues that Applicant’s AIRBLUE Mark should be refused because Applicant allegedly filed the application in bad faith. 100 TTABVUE 45. This argument falls flat. Bad faith adoption of a mark centers around the “intention to trade off of,” another’s mark. *L’Oreal S.A. v. Marcon*, 102 U.S.P.Q. 2d 1434, 1442 (T.T.A.B. 2012). Airblue began in Pakistan, and the founder of the company was unaware of JetBlue’s existence until several years after selecting the airblue name. 55 TTABVUE 94.

Having no knowledge of JetBlue when selecting the AIRBLUE marks necessarily precludes the possibility of bad faith adoption, as it is impossible for airblue to have intended to trade off the JETBLUE marks without knowledge of them. JetBlue has presented no evidence of bad faith intent, and this factor weighs against a finding of likelihood of confusion.

B. Applicant’s AIRBLUE Mark is Not Likely to Dilute the JETBLUE Mark.

Dilution by blurring is an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). “Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party’s use of a mark on its goods are immediately reminded of the famous mark and associate the junior party’s use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark’s owner.” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 1888 (T.T.A.B. 2011). In determining whether a mark is likely to cause dilution by blurring, the Board may consider all relevant factors, including: (1) the degree of similarity between the marks; (2) the degree of inherent or acquired

distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the mark intended to create association with the famous mark; and (6) any actual association between the marks. 15 U.S.C. § 1125(c)(2)(B)(i)-(vi); *Chanel*, 110 U.S.P.Q. 2d at 2025.

1. The JETBLUE Mark is not Sufficiently Famous for Dilution.

JetBlue has the high evidentiary burden to demonstrate that its mark is famous. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1372–73 (Fed. Cir. 2012) (“Whether a mark is famous under the TDRA is a factual question reviewed for substantial evidence.”); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q. 2d 1164, 1180 (T.T.A.B. 2001) (“Fame for dilution purposes is difficult to prove.”); *Everest Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 763 (8th Cir. 2005) (“The judicial consensus is that ‘famous’ is a rigorous standard.”). Even if JetBlue established fame for confusion, it does not follow that it established fame for dilution. *Coach Servs.*, 668 F.3d at 1373 (citing 4 J. Thomas McCarthy, *McCarthy On Trademark and Unfair Competition* § 24:104 at 24-290 (4th ed. 2011)); *see also Vill. Recorder v. Bigfoot Internet Ventures Pte. Ltd.*, 2020 TTAB LEXIS 209, *32 (T.T.A.B. May 1, 2020) (denying a dilution claim when the trademark owner failed to establish fame). Because JetBlue was unable to prove fame for confusion, it cannot possibly establish fame for dilution. “it follows that [JetBlue]’s evidence is insufficient to prove fame for purposes of dilution”. *Coach Servs.*, 668 F.3d at 1373.

“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.*, 668 F.3d at 1373 (quoting *Toro*, 61 U.S.P.Q.2d at 1180.) JetBlue must show that when the general public views the JETBLUE mark “‘in almost any context, it associates the term, at least initially, with the mark’s owner.” *Id.* at 1373 (quoting *Toro*, 61 U.S.P.Q.2d at 1181). This level of fame has also been characterized as the mark becoming a “household term[] which almost everyone is familiar.” *Toro*, 61 U.S.P.Q.2d 1164, 1181 (T.T.A.B. 2001); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir. 2004) (quoting *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir. 2002)). Additionally, the mark must be famous “prior to the filing date of the trademark application or

registration against which it intends to file an opposition or cancellation proceeding.” *Coach Servs.*, 668 F.3d at 1373 (citing *Toro*, 61 U.S.P.Q.2d at 1174).

The Trademark Dilution Revision Act (TDRA) provides that 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). The TDRA’s fame benchmark—“general consuming public”—no longer permits “niche fame” in establishing that a mark is famous. *See Top Tobacco, LP v. N. Atl. Operating Co.*, 509 F.3d 380, 384 (7th Cir. 2007) (noting that the reference to the general public “eliminated any possibility of ‘niche fame,’ which some courts had recognized before the amendment”). The TDRA provides four factors for courts to consider when determining whether a mark is famous:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A).

Ultimately, if the JetBlue’s mark is not “famous” then it cannot establish a claim for dilution. *See Coach Servs.*, 668 F.3d at 1372 (“Because we find that CSI failed to prove fame for dilution, we need not address the other statutory factors courts can consider to determine whether a mark is likely to cause dilution by blurring.”); *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 871 (9th Cir. 2020) (“Because there was legally insufficient evidence to find that the claimed EAMES trade dresses were famous under 15 U.S.C. § 1125(c)(2)(A), the judgment against OSP for their dilution must be reversed.”).

As a preliminary matter, the Federal Circuit requires a trademark opposer to demonstrate that its mark was famous *before* the registration date of the trademark application. *Coach Servs.*, 668 F.3d at 1373 (citing *Toro*, 61 U.S.P.Q. 2d at 1174); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118

U.S.P.Q. 2d 1289, 1298 (T.T.A.B. 2016) (collecting cases concluding that fame must be established prior to the trademark application); *see also* 15 U.S.C. § 1125(c)(1). Thus, it follows that any evidence of fame JetBlue provided that post-dates airblue’s May 22, 2017 application date is irrelevant for this analysis and should be disregarded.

JetBlue glosses over the fact that airblue and JetBlue operate in *different markets*. Airblue intends to run international flights between the United States and the Middle East, while JetBlue has failed to demonstrate that a consumer can go to JetBlue and purchase a ticket to Pakistan. This is not an inconsequential detail. The rigorous fame analysis for dilution looks at the geographic reach of the mark to determine if there is fame. 15 U.S.C. § 1125(c)(2)(A)(i)-(ii). JetBlue’s reach to this consumer base—individuals wishing to travel between the United States and Pakistan—has not been established and cuts against JetBlue’s argument that its mark is famous for dilution instead of famous in a niche market of flights within western countries, primarily of which is the United States.

As JetBlue has failed to establish fame for confusion it therefore failed to establish fame for dilution. Moreover, JetBlue has not demonstrated that its fame for dilution purposes has the necessary geographic reach. By failing to demonstrate fame, JetBlue is missing the basic requirement for a claim of dilution, and its claim should fail for this reason alone.

2. The Marks are Substantially Dissimilar.

For the purposes of dilution, the T.T.A.B. does not conduct “a Section 2(d) likelihood of confusion,” but instead “consider the degree of similarity or dissimilarity of the marks in their entirety as to appearance, connotation, and commercial impression.” *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 U.S.P.Q. 2d 1187, 1198 (T.T.A.B. 2012). As noted above, the AIRBLUE Mark and JETBLUE Mark are not similar. *See supra* Section V.A.2. This factor weighs in favor of Applicant.

3. The JETBLUE Mark is Neither Inherently Distinctive nor has Acquired Distinctiveness.

If the mark is famous, then courts are “require[d] . . . to analyze how distinctive or ‘unique’ the mark is to the public.” *Sony Grp. Corp. v. Campbell*, 2022 TTAB LEXIS 391, *70–71 (T.T.A.B. Oct. 28,

2022). This “inquiry is made even when it is undisputed that [JetBlue]’s mark is registered on the Principal Register. *Id.* (quoting *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, 69 U.S.P.Q. 2d 1718, 1735 (T.T.A.B. 2003) (internal quotations omitted). “The more descriptive the mark, the less likely it is to be blurred by uses of identical or similar marks.” *Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q. 2d 2013, 2025 (2014) (internal citation omitted); *see also 7-Eleven, Inc. v. Wechsler*, 83 U.S.P.Q. 2d 1715, 1729 (T.T.A.B. 2007) (finding that this dilution factor only *slightly* favored the opposer because the mark was suggestive). Here, the JETBLUE mark is descriptive, which weighs against JetBlue.

A mark is descriptive “if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods.” *In re Jewelry Supply, Inc.*, 2011 TTAB LEXIS 148, *6–7 (citing *In re Gyulay*, 820 F.2d 1216, 3 U.S.P.Q. 2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 U.S.P.Q. 88 (T.T.A.B. 1984); *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (T.T.A.B. 1979). The mark JETBLUE is a quintessential example of a descriptive mark, as evidenced by dictionary definitions, third party registrations, and remarks from JetBlue’s former CEO. 70 TTABVUE 3-12.

JetBlue intended consumers to not simply see the word “jetblue” as a new a fanciful term, but instead to read the words “jet” and “blue” separately. This is evidenced in multiple ways. First, the tradename that JetBlue uses capitalizes the letters “J” and “B” which would imply that these are separate terms. Registration No. 3163120. While the “j” is in lowercase in this registration, the capitalization of the letter “B” is would direct any reader to interpret “jet” and “blue” separately. And as icing on the cake, JetBlue chose to display the word “jet” in silver color and “Blue” in blue. As established herein and *supra* Section V.A.1., the JETBLUE mark is merely descriptive and thus this factor weighs against JetBlue.

4. JetBlue is Not Engaged in Substantially Exclusive Use of the Mark.

As discussed in *supra*, Section IV.F., JetBlue is not the sole company running airline related services to use the word “blue” in association with its services. Additionally, JetBlue admits that not all uses of the word “blue” can cause confusion. 100 TTABVUE 25. Given the widespread usage of the word “blue” in the travel industry, including the airline industry, this factor weighs against JetBlue. *See, e.g.*,

Therabody, Inc. v. Shanghai Three Gun (Grp.) Co., 2022 TTAB LEXIS 420, *30–31 (T.T.A.B. Nov. 17, 2022) (concluding that the trademark opposer’s use of the term “gun” in association with a massage apparatus as weak and diluted because of the widespread use of the word “gun” with massage apparatuses).

5. Degree of Recognition.

“The degree of recognition of the famous mark requires [the Board] to determine the level of fame acquired by the famous mark. In other words, once the mark is determined to be famous as a prerequisite for dilution protection, we must apply a sliding scale to determine the extent of that protection (*i.e.*, the more famous the mark, the more likely there will be an association between the famous mark and the defendant's mark).” *7-Eleven*, 83 U.S.P.Q. 2d at 1729–1730. However, finding a mark famous for dilution purposes does not automatically mean that the mark has met “an extraordinary degree of recognition relative to other famous marks.” *Id.*

JetBlue has not pointed to any survey evidence or expert testimony to demonstrate that there is a high degree of recognition of the JETBLUE mark. Instead, it claims that because its mark is “inherently distinctive—which it is not— and it spent millions on advertising, it is therefore has a high degree of recognition. 100 TTABVUE 49. This is insufficient evidence to establish a high degree of recognition, and therefore this factor does not weigh in favor of JetBlue. *See, e.g., Chanel, Inc. v. Camacho & Camacho, LLP*, 2018 TTAB LEXIS 13, *48 (T.T.A.B. Jan. 12, 2018) (“In the absence of survey or other recognition evidence here, we cannot find that the CC Monogram Mark has acquired an extraordinary degree of recognition relative to other famous marks”) (internal quotations omitted).

6. Applicant Did Not Intend to Create an Association with the JETBLUE Mark.

JetBlue has not presented any evidence that Applicant intended to create an association with the JETBLUE Mark. Applicant selected the AIRBLUE Mark in 2003, years before it learned of JetBlue or the JETBLUE Mark, and is expanding to the U.S. “as an extension of its current product line marketed under the [AIRBLUE] trademark.” *Rolex Watch U.S.A. v. AFP Imaging Corp.*, 101 U.S.P.Q.2d 1188, 1195 (T.T.A.B. 2011). Accordingly, this factor favors Applicant. *Id.*; *see also Kate Spade LLC v. Woly, Inc.*, 2022 TTAB LEXIS 189, *58 (T.T.A.B. April 25, 2022) (“Opposer did not introduce any evidence or

argument that Applicant intended to create an association with Opposer's KATE SPADE mark. This factor weighs against finding dilution"); *7-Eleven*, 83 U.S.P.Q. 2d at 1730 (same).

7. There is no Evidence of Any Actual Associations Between the Parties' Marks.

This factor requires that JetBlue "not only prove an association between its own and applicant's mark, but that such an association will impair the distinctiveness of [the JETBLUE] mark." *Rolex Watch U.S.A.*, 101 U.S.P.Q. 2d at 1196. *Kate Spade*, 2022 TTAB LEXIS 189, *58-59 ("Applicant's application was filed based on its intent to use the WOLV and design mark. There is no evidence that Applicant has made any use of its WOLV and design mark in commerce. Accordingly, there is no evidence of any actual association between Applicant's WOLV and design mark and Opposer's KATE SPADE mark.").

It should be noted that JetBlue's brief is silent on this issue. 100 TTABVUE 45–50. It did not over any evidence of association, though airblue has been using the junior mark since 2003 with its services available on English websites. 72 TTABVUE 118-20; 73 TTABVUE 7, 58-64. By failing to present any kind of evidence, this factor should be weighed against JetBlue.

Even if JetBlue had shown any actual association between the Parties' Marks, it has presented no evidence to "establish that such association would impair the distinctiveness" of the JETBLUE Mark and no evidence "of the degree to which [JetBlue's] marketing power would potentially be diminished by applicant's intended use of the mark." *Rolex Watch U.S.A.*, 101 U.S.P.Q.2d at 1196 (citing McCarthy on Trademarks and Unfair Competition § 24:120 ("the fact that people 'associate' the accused mark with the famous mark does not in itself prove the likelihood of dilution by blurring")). Accordingly, this factor favors Applicant.

Even if the JETBLUE Mark were sufficiently famous and its use exclusive, "the degree of dissimilarity between the marks, . . . lack of evidence that applicant intended to create an association with opposer's mark . . . and [lack of evidence] of the degree to which [its] marketing power" would be diminished require that the Opposition be cancelled on grounds of dilution. *Rolex Watch U.S.A.*, 101 U.S.P.Q. 2d at 1196-97 (finding no dilution despite the ROLEX mark being famous, arbitrary, and used exclusively by Opposer).

C. Applicant Has a Bona Fide Intent to use the AIRBLUE Mark in Commerce.

Whether an applicant has a bona fide intention to use a mark in commerce is an objective determination based on the totality of circumstances. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 U.S.P.Q.2d 1892, 1898 (Fed. Cir. 2015). Opposer has the burden to prove by “a preponderance of the evidence that Applicant lacked a bone fide intention to use the mark” in connection with the identified goods and services. *The Wet Seal, Inc. v. FD Mgmt, Inc.*, 82 U.S.P.Q.2d 1629, 1643 (T.T.A.B. 2007); *Research in Motion Ltd.*, 92 U.S.P.Q. 2d at 1930 (T.T.A.B. 2009). If Opposer does so, the burden then shifts to Applicant to rebut Opposer’s arguments and the evidentiary bar for showing a bona fide intent to use “is not high.” *M.Z. Berger*, 114 U.S.P.Q.2d at 1897-98.

“[P]rior experience and success in the relevant industry . . . are consistent with and corroborative of applicant’s claimed bona fide intention to use the mark.” *Lane Ltd. v. Jackson Int’l. Trading Co.*, 33 U.S.P.Q.2d 1351, 1356 (T.T.A.B. 1993); *see also The Wet Seal, Inc.*, 82 U.S.P.Q.2d at 1643 (“that applicant had the capacity to market [the identified goods], having produced them in the past . . . would tend to affirmatively rebut any claim by opposer regarding applicant’s intent”); *Monster Energy Co. v. Tom & Martha LLC*, 2021 U.S.P.Q.2d 1197 (T.T.A.B. 2021) (“Evidence that a party has the capacity to market or manufacture a product can rebut a lack of bona fide intent to use claim.”). When the filing of the Challenged Application is “consistent with [Applicant’s] overall business model” or “consistent with an extension of [Applicant’s] current product line,” that too suggests Applicant had the bona fide intent to use the mark. *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.*, 101 U.S.P.Q. 2d 1188, 1197 (T.T.A.B. 2011).

1. JetBlue Has Failed to Meet its Burden of Proof to Show that Applicant Lacked a Bona Fide Intent to Use the AIRBLUE Mark in Commerce.

JetBlue’s argument is that Applicant has no evidence relating to its intent to use the AIRBLUE Mark in the U.S., relies only on “statements of subjective intent,” and that Applicant hasn’t taken steps towards offering its services.¹⁶ 100 TTABVue 50-52. This is not true. First, as discussed further below,

¹⁶ While Applicant has taken steps towards offering its services in the U.S., even if it hadn’t “merely because applicant may not have taken steps to actually launch or introduce a particular [service] does not mean that applicant otherwise had no intention to develop or market the [service].” *The Wet Seal, Inc.*,

Applicant has submitted into evidence testimony and exhibits evidencing Applicant's intent to use the AIRBLUE Mark in the U.S., such as documents showing: Applicant is seeking additional travel agent partners in the U.S., Applicant is hiring additional employees and has entered into lease agreements for additional aircraft to meet U.S. expansion demands, and third-party articles referencing Applicant's intent to expand its network.¹⁷ *See infra* Section V.C.2.

Second, Applicant's testimony does not amount to mere "statements of subjective intent." The cases JetBlue cites involve testimony relating to the applicants' "subjective state of mind" such as where the applicant testifies: "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future." *Research in Motion*, 92 U.S.P.Q.2d at 1931; *The Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q.2d 1723, 1728-29 (T.T.A.B. 2010). Here, Applicant's CEO has testified that Applicant has taken concrete steps towards offering its services in the U.S., including opening bank accounts in both the U.S. and at technical stop locations, seeking new partners to provide a co-branded credit card, obtaining approval from the PCAA to offer international flights to the U.S., and that Applicant has the experience and capacity to offer its services. *See infra* Section V.C.2. This testimony is more than sufficient. *The Wet Seal, Inc.*, 88 U.S.P.Q.2d at 1643 (testimony that is "unclear" as to intent but shows Applicant "had the capacity" to offer its services is sufficient).

In short, JetBlue's "evidence falls far short of demonstrating by a preponderance of the evidence that [airblue] lacked a bona fide intention to use the mark." *The Wet Seal, Inc.*, 88 U.S.P.Q.2d at 1643. The inquiry should end here. The opposition should be dismissed on the ground of lack of bona fide intent. *Id.*

2. Applicant Has the Experience and Capacity to Offer its Services in the U.S. and has Taken Steps Towards Doing So.

88 U.S.P.Q.2d at 1643; *see also Monster Energy Co.*, 2021 U.S.P.Q.2d at 15 ("Although the record does not show that Applicant took concrete steps to launch all the goods and services in its application, it does not necessarily indicate . . . that Applicant lacked a bona fide intent to use its mark in commerce.").

¹⁷ Mr. Chaudhary testified that most of airblue's operational decisions are made by him unilaterally or by telephonic conversations among executives. 95 TTABVUE 246 (13:13-18); 73 TTABVUE 3. He also testified that it is not airblue's practice to develop written marketing plans (95 TTABVUE 268 (39:8-18)), rather Applicant relies on historical data and experience, including for its plans for the U.S. market. *Id.* (35:1-38:14, 78:13-80:7).

Applicant has twenty years of experience in the airline industry. 73 TTABVUE 2. Applicant has achieved considerable success, with billions in annual revenue and being named the “Best Pakistani Airline.” 73 TTABVUE 5-6, Ex. 6 (confidential version 78 TTABVUE Ex. 6). It currently offers international flights to the United Arab Emirates and Saudi Arabia and has previously offered international flights to Oman, Turkey, and the United Kingdom. 73 TTABVUE 2-3. Applicant’s plan to offer the same services to the U.S. is a natural expansion of its business, suggesting that Applicant had the requisite bona fide intent. *Rolex Watch U.S.A., Inc.*, 101 U.S.P.Q.2d at 1197 (finding bona fide intent where “the filing of the application . . . is consistent with an extension of [Applicant’s] current product line”).

JetBlue is well aware of airblue’s success abroad, but claims it is “not probative of intent in the U.S.” 100 TTABVUE 51-52. To the contrary, the Board has found such foreign conduct probative when it shows the Applicant has the experience needed to offer its services in the U.S. For example, in *Lane*, the Board found that “applicant’s attempts to obtain a European licensee” showed a bone fide intent to use the mark in view of “applicant’s prior success” and “the fact that these prospective licensees were not domiciled in the United States does not detract from applicant’s claim of bona fide intention.” 33 U.S.P.Q.2d at 1354, 1356. In fact, in the only case JetBlue relies on, *Honda Motor Co.*, suggest foreign conduct *is* probative. There, the Board found applicant lacked a bone fide intent because he did not “demonstrate that he manufactures vehicles *in Germany or elsewhere*” and therefor failed to show “the existence of an ability” to do so in the United States. 90 U.S.P.Q.2d at 1664. Here, Applicant’s foreign conduct shows “prior experience and success in the relevant industry . . . [that is] consistent with and corroborative of applicant’s claimed bona fide intention to use the mark.” *Lane Ltd.*, 33 U.S.P.Q.2d at 1356 (T.T.A.B. 1993).

In addition to having relevant experience, Applicant has taken steps towards offering its goods and services in the United States, as shown by testimony from Applicant’s CEO and documents submitted into evidence, for example:

- Applicant terminated its relationship with Faysal Bank in 2019, who marketed the airblue credit card for 10 years, and is actively seeking new partners to offer credit card services. 73 TTABVUE 6. The new partner or partners will offer credit card services under the AIRBLUE Mark for Applicant’s entire market, including the United States. *Id.*; 95 TTABVUE 250-56 (18:5-20:15, 23:11-24:17).

- Applicant is seeking additional travel agent partners in the U.S., as advertised on the airblue website. 73 TTABVUE 10, 168 (advertising that “Airblue is now accepting applications from travel agents worldwide” including “US, Europe, and Canada”). Applicant intends to use its existing and new travel agent partners to market its international flights to and from the U.S. when permitted to begin advertising. 73 TTABVUE 10.
- Applicant has a fleet of Airbus A320 and A321 planes that it intends to use to offer flights to the U.S. 73 TTABVUE 10-11. Airbus publishes technical information showing the range of its planes, Applicant relied on this information to determine that its aircraft can fly from Pakistan to the U.S. with technical stops. 73 TTABVUE 12. .
- Applicant received two additional A321neo aircraft through a lease with GE Capital Aviation Services Limited (“GECAS”). 73 TTABVUE 10-11, Ex. 15 (confidential version 79 TTABVUE Ex. 15). And is negotiating the lease of two additional aircraft to be delivered in 2023. 73 TTABVUE 11-12. These leases have and will increase airblue’s capacity and allow it to offer flights to and from the U.S. *Id.*; *see also* 71 TTABVUE 68-71 (reporting that airblue’s new A321 aircraft “will certainly help grow the airline’s network in the future, especially its plan to venture into the U.S. airline market”). The newly leased aircraft, or any of Applicant’s fleet, can be used to fly to the U.S. 73 TTABVUE 11-12.
- Applicant purchased and leased spare engines compatible with its fleet of aircraft to ensure its fleet is reliable and ready for expansion to the U.S. and to increase the range of the aircraft. 73 TTABVUE 12.
- Applicant opened a two bank account in the U.S. that airblue will use for its U.S. operation. 73 TTABVUE 15. Applicant’s financial reports show that airblue has millions of Pakistani Rupees in its U.S. accounts. *Id.*; 73 TTABVUE Ex. 6 (confidential version 78 TTABVUE Ex. 6).
- Applicant has also opened bank accounts in Europe that it will use for its business there, including for technical stops between airblue’s current network and the United States. 95 TTABVUE Ex. 17 (75:11-17).
- Applicant announced that it plans to offer flights between its current network in the Middle East and Europe and Turkey.¹⁸ 37 TTABVUE 5. These destinations may serve as technical stops for flights to and from the United States. 37 TTABVUE 12.
- Applicant is actively hiring additional pilots and flight crew to meet the demands of expansion to the U.S. 73 TTABVUE 12. Applicant’s website shows it is currently seeking to hire eight additional pilots and fifteen flight service members. 73 TTABVUE 12, 232-33.

¹⁸ JetBlue claims there is no evidence of this announcement (100 TTABVEU 26), however in addition to testimony from Applicant’s CEO, Applicant has submitted publications that report: “Airblue will use its A321neo . . . to start new services to Turkey and Europe.” 70 TTABVUE 51; *see also* 70 TTABVUE 56 (“The A321neo will enable the airline to further expand its network.”); 70 TTABVUE 80-81 (reporting on airblue’s new A321neo aircraft and noting airblue’s intent to expand to other parts of the world).

JetBlue makes much of the fact that Applicant does not have regulatory approval to offer flights to and from the U.S. In an analogous case, the Opposer made the same argument—namely that the applicant had no intention to offer alcoholic beverages because it did not have regulatory approval to do so. *Uncle Nearest, Inc. v. Dias*, Opposition No. 91271407, at 23-24 (T.T.A.B. Dec. 8, 2022). The Board was not persuaded and found that “[t]here is no requirement that . . . an applicant must obtain all requirement permits before filing an intent-to-use basis application. . . . The fact that Applicant may not have been aware of the full scope of requirements for bringing an alcoholic beverage to market does not show that she did not have a bone fide intent at the time she filed her application.” *Id.*

In this case, Applicant is aware of the regulatory requirements for offering its services to the U.S. and has received approval from the PCAA to do so. 73 TTABVUE 13. Applicant’s CEO has experience navigating U.S. regulatory requirements for a start-up U.S. airline, which are more stringent than for established foreign air carriers. 73 TTABVUE 14; *see also* 95 TTABVUE 258-59 (29:19-30:20). Mr. Chaudhary testified, in his experience, that it will take “no more than six months” to get approval from U.S. regulatory bodies. 73 TTABVUE 14-15; 65 TTABVUE 105. DOT records suggest it may be even quicker: “within 30 to 60 days.” 73 TTABVUE 322. Mr. Chaudhary also testified that COVID has delayed airblue from seeking approval from U.S. regulatory bodies. *See e.g.*, 95 TTABVUE 250-51 (18:25-19:15) (“with 2020 and ’21 practically lost to COVID, we have now recently started approaching the bank” regarding credit card services); 256 (24:9-17) (“And a lot of it has to do with the fact that our business, airlines especially, as you know well, have been very severely impacted with COVID); 259 (30:1-20) (“there wasn’t much happening for about two years. I mean, literally, as we all know.”).¹⁹

As soon as Applicant obtains economic approval to offer flights to and from the U.S., it can start advertising its goods and services in the U.S. market. 62 Fed. Reg. 51175 (Sept. 30, 1997). Applicant has everything it needs to do so. For example, Applicant has established English-language social media

¹⁹ Mr. Chaudhary also testified that Applicant has started the regulatory approval process to fly to Manchester, which may serve as a technical stop for flights to the U.S. 95 TTABVUE 278-79 (54:6-55:14). And has plans to make technical stops in Istanbul as well. *Id.* (55:15-20).

accounts, a website, a mobile application, an e-mail subscription service, and U.S. travel agents through which it plans to market its goods in the U.S. *See supra* Section IV.A; *see also* 95 TTABVue 282-83 (58:9-59:8). This again shows Applicant's capacity to market its services and distinguishes the cases JetBlue relies upon. *Cf Research in Motion Limited v. NBOR Corporation*, 92 U.S.P.Q.2d 1926, 1930-31 (T.T.A.B. 2009) (no bona fide intent in part because applicant had "no channels of trade formulated" for future use); *Honda Motor Co.*, 90 U.S.P.Q.2d 1660, 1663 (T.T.A.B. 2009) (no bona fide intent in part because applicant had no "channels of trade that will be used in the United States").

Applicant's experience and capacity to market its good and services "affirmatively rebut[s] any claim by Opposer regarding applicant's intent." *The Wet Seal, Inc. v. FD Management, Inc.*, 82 U.S.P.Q.2d 1629, 1643 (T.T.A.B. 2007). The Opposition should be dismissed as to bona fide intent.

VI. CONCLUSION.

For at least the reasons stated above, the Board should rule in favor of Applicant on all claims and the Opposition should be denied.

Respectfully Submitted,
DORSEY & WHITNEY LLP

Dated: March 6, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of March, 2023, I caused to be served a true and correct copy of the foregoing by email on Opposer JetBlue Airways Corporation's attorneys of record at the following addresses:

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3	In re Republic Jet Ctr. LLC, 2019 TTAB LEXIS 132, Serial No. 87414987P
4	In re TriStar History & Pres., Inc., 2015 TTAB LEXIS 340, Serial Nos. 86078454 and 86111943
5	In re United States Steel Corp., 2016 TTAB LEXIS 128, Serial No. 86174180
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8	Masimo Corp. v. Rooti Labs Ltd., 2017 TTAB LEXIS 304, Opposition No. 91224804
9	Overstock.com, Inc. v. J. Becker Mgmt., 2015 TTAB LEXIS 211, Opposition No. 91203624
10	Shenzhen IVPS Tech. Co. v. Fancy Pants Products, LLC, 2022 TTAB LEXIS 383, Opposition No. 91263919
11	Slim N' Trim, Inc. v. Walgreen Co., 2004 TTAB LEXIS 143, Cancellation No. 92032743 to Registration No. 2479423
12	Sock It To Me, Inc. v. Hordijczuk, 2020 TTAB LEXIS 282, Opposition No. 91236423
13	Sony Grp. Corp. v. Campbell, 2022 TTAB LEXIS 391, Opposition No. 91245851
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15	Village Recorder v. Bigfoot Internet Ventures Pte. Ltd., 2020 TTAB LEXIS 209, Cancellation No. 92064373

In re Forte Solutions Group, LLC , 2012 TTAB LEXIS 301

Trademark Trial and Appeal Board

August 8, 2012, Decided

Serial No. 76699385

Reporter

2012 TTAB LEXIS 301 *

In re Forte Solutions Group, LLC

Disposition: [*1]

Decision: The refusal to register is affirmed.

Core Terms

registrant's, planning, consulting, marks, third-party, consumers, consulting services, planning services, similarity, channels, likelihood of confusion, advertises, register, impression, purchasers

Counsel

Kay Lyn Schwartz of Gardere Wynne Sewell LLP for Forte Solutions Group, LLC.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

Panel: Before Grendel, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion By:

Bergsman, Marc A.

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Bergsman, Administrative Trademark Judge:

Forte Solutions Group, LLC ("applicant") filed a use-based application to register the mark PLAN4, in standard character form, for services ultimately identified as "business planning services," in Class 35.

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark is likely to cause confusion with the previously registered mark PLAN4DEMAND, in typed drawing form, for "business consulting services," in Class 35. ¹

[*2]

Our determination of likelihood of confusion 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). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See 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").

A. The similarity or dissimilarity and nature of the services described in the application and registration, the likely-to-continue channels of trade and classes of consumers.

Because the scope of the registration applicant seeks is defined by its application (and not by its actual use) it is the recitation of services in its **[*3]** application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

By the same token, in considering the scope of the cited registration, we look to the recitation of services in the registration itself, and not to extrinsic evidence about the registrant's actual services, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 46 C.C.P.A. 711, 1958 Dec. Comm'r Pat. 432, 119 USPQ 139 (CCPA 1958).

Applicant is seeking to register its mark for "business planning services" and the cited registration is for "business consulting services."

"Consulting" is defined as "employed or involved in giving **[*4]** professional advice to the public or to those practicing a profession." ²

"Planning" is defined as "the act or process of making a plan or plans." ³

By definition, business consulting is broad enough to encompass business planning because a company rendering business consulting services could be consulting about business planning. This finding of fact is corroborated by the third-party websites excerpts attached to the August 29, 2011 Office action. The third-party websites **[*5]** include the following:

¹ Registration No. 2558639, issued April 9, 2002; renewed. Registrant deleted "information technology consulting services," in Class 42, when it filed its combined declaration of use and renewal application.

² The Random House Dictionary of the English Language (Unabridged), p. 437 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Norte Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ *Id.* at 1481.

1. Maruya Associates (maruyaassociates.com) In touting its business consultation services, Maruya Associates explains that it provides "Customized Business Plans."

Our business plan consultants work side-by with you and your team to prepare a full-length plan that begins with your aimed audience in psyche. We facilitate wide-ranging business planning process over several weeks that result in a well-organized, written and fully customized plan ready for presentation to investors, lenders and other strategic third parties.

2. Z Intro (zintro.com) is a website directory for "4 'Business Planning, Coaching & Consultation."

3. Cole Gavlas, PC (colegavlas.com) advertises tax and business advisory services. Cole Gavlas identifies "business planning" as part of its "business consultation."

4. Bon-Wine Consulting (bon-wine.com) is a company specializing the China wine market. It advertises that its business consultation includes planning.

5. Creative Business Adventures (creativebusinessadventures.com) advertises that its business planning services includes "consult and help establish short term priorities" and "business consulting in person or by telephone. [*6]

6. Williams Teusink Larsen (williamsteusink.com) is a law firm that advertises "business planning and operations" services, including "business consultation."

7. Reginald Singh, CPA, MBA advertises in the BusinessHelp.com website that he provides "business consulting" and "strategic business planning."

8. Hicks, Hicks, & Braun (hhbtaxes.com) advertise that they provide small business consultation and strategic business planning.

In addition, the examining attorney submitted numerous third-party registrations for marks that include both business planning and business consulting services (e.g., Registration No. 3934653 for the mark DEEP INTELLIGENCE, Registration No. 3773798 for the mark DELIVERABLES BASED PLANNING, and Registration No. 3875709 for the mark PLAYSTUDIO). Third-party registrations which individually cover a number of different services that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). [*7]

In view of the foregoing, we find that applicant's "business planning services" are closely related to registrant's "business consulting services." Furthermore, the evidence noted above demonstrates that business planning services and business consulting services move in the same channels of trade and are sold to the same classes of consumers.⁴

[*8]

⁴ In addition, because business consulting encompasses business planning, we must presume that the channels of trade and classes of purchasers are the same. See *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). See also *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues that the markets for applicant's services and registrant's services are distinctly different (*i.e.*, applicant's services are related to business planning and registrant's services for supply chain consulting).⁵ However, because there are no relevant limitations as to channels of trade or classes of purchasers in the recitation of services in the application or the cited registration, it is presumed that applicant's business planning services and registrant's business consulting services move in all channels of trade normal for those services, and that they are available to all classes of purchasers for those services. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Under these circumstances, we cannot resort to extrinsic evidence to restrict the channels of trade for applicant's or registrant's services. 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). Because business consulting encompasses business planning, the services [*9] move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of the mark in the cited registration.

Applicant references seven registrations owned by five entities for "Pla4" or "Planfor" marks for different services and argues that "Pla4" is a weak term that is entitled to a narrow scope of protection.⁶ Applicant references the following registrations:

1. Registration No. 3433876 for the mark PLANFORTOMORROW for financial planning services, namely, estate planning, financial planning for retirement, and investment consultation and investment management;
2. Registration No. 3429354 for the mark CAREPLAN4LIFE for consulting and legal services, namely, providing parents of children afflicted with cerebral palsy, erbs [*10] palsy and other special needs with a comprehensive program and plan to guide them in medical, educational and financial planning for their children;
3. Registration No. 2410136 for the mark PLAN4EVER.COM for providing information via the global computer network in the field of retail goods for the death care industry, namely, books, cards, flowers, urns, caskets and monuments; and for providing information via the global computer network in the field of funeral and legal services;
4. Registration No. 2862187 for the mark PLAN4HEALTH for educational services, namely, lectures on the subject of health and diet; and
5. Registration No. 2881196 for the mark PLAN4TEN, Registration No. 2800385 for the mark PLAN4MOST, and Registration No. 2821214 for the mark PLAN4ONE all for the administration of employee benefit plans.

The third-party registrations submitted by applicant are of limited probative value because they do not cover the same services in cited registration. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far [*11] removed from the goods at issue). See also *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 59 C.C.P.A. 1231, 175 USPQ 99, (CCPA 1972) ("Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word "KEY". The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here").

Also, third-party registrations do not prove that PLAN4DEMAND is a weak term. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). See also *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

⁵ Applicant's Brief, pp. 11-12.

⁶ Applicant's Brief, pp. 9-10.

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject [*12] of the third party [sic] registrations are still in use. Because of this doubt, third party [sic] registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286. See also *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given any weight").

Nevertheless, third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of services because a term has a recognized meaning. In this case, PLAN4 means "to make plans for." Accordingly, we find that registrant's mark PLAN4DEMAND is a suggestive mark that informs consumers that registrant's services are focused on planning for increased consumer demand.

C. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the [*13] *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the services are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Moreover, in comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side [*14] comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, 972 F.2d 1353 (Fed. Cir. 1992).

The marks are similar in appearance, sound, meaning and commercial impression because they share the term "Pla⁴," suggesting that the services are rendered to assist businesses in planning something: in applicant's case, planning for anything, in registrant's case, planning for increased consumer demand. In fact, registrant's mark incorporates applicant's entire PLAN4 mark which may lead consumers to mistakenly believe that PLAN4DEMAND is a version of applicant's PLAN4 business planning services that focuses on consumer demand. In this case, the presence the word "Demand" in the registrant's mark does not eliminate the likelihood of confusion. See, *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) [*15] (applicant's mark ML is similar to registrant's mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 54 C.C.P.A. 1295, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709. As indicated above, PLAN4DEMAND is likely to be perceived as a particular version of PLAN4 when used in connection with registrant's closely related business consulting services.

In view of the foregoing, we find that applicant's mark PLAN4 is similar to registrant's mark PLAN4DEMAND in terms of appearance, sound, meaning and commercial impression.

D. Degree of consumer care.

Applicant argues, without any supporting evidence, that

Applicant's and Registrant's [*16] services are directed to a specific consumer. Therefore, the ultimate consumers are relatively sophisticated due to the nature of the specialized services. Another factor to consider is the price involved with the services. Both the services of the applicant and registrant would not be considered inexpensive by the average consumer's standard. This means that great care would be taken in selecting these services. As such, the purchasers are careful." ⁷

We acknowledge that the business owners will exercise a relatively high degree of care when acquiring or using business consulting or business planning services. However, on this record, we cannot find that the degree of the care exercised by business owners outweighs the similarity of the marks and the similarity of the services.

E. Balancing the factors.

In view of the facts that the marks are similar, the services are closely related and move in the same channels of trade and are available to the same classes [*17] of consumers, we find that applicant's mark PLAN4 for "business planning services" is likely to cause confusion with the mark PLAN4DEMAND for "business consulting services."

End of Document

⁷ Applicant's Brief, p. 12.

In re Jewelry Supply, Inc. , 2011 TTAB LEXIS 148

Trademark Trial and Appeal Board

May 4, 2011, Decided

Serial No. 77475181

Reporter

2011 TTAB LEXIS 148 *

In re Jewelry Supply Inc.

Disposition: [*1]

Decision: The refusal to register under Trademark Act Section 2(e)(1) without acquired distinctiveness under Section 2(f) is affirmed.

Core Terms

JEWELRYSUPPLY, registration, jewelry, advertising, registered, website, online, marks, featuring, videos, sales, goods and services, legal equivalent, declaration, Trademark, displayed

Counsel

Lawrence G. Townsend of Owen Wickersham & Erickson PC for Jewelry Supply Inc.

Laurie Mayes, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Panel: Before Cataldo, Taylor and Wellington, Administrative Trademark Judges.

Opinion By:

Cataldo, Peter W.

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Cataldo, Administrative Trademark Judge:

Jewelry Supply Inc. filed an application to register on the Principal Register the mark JEWELRYSUPPLY.COM in standard characters for the following services:

online retail store services featuring jewelry boxes, jewelry findings, jewelry displays, jewelry repair kits, tools for making jewelry, beads, magnifiers, craft kits, crystals, and educational material, specifically books and various media, including instructional videos on the subject of jewelry (in International Class 35).

The application was filed on May 15, 2008 based on an allegation of January 1999 as a date of first use of the mark in commerce. ¹ During prosecution applicant amended [*2] its application to seek registration of its mark under Section 2(f) of the Trademark Act.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its services and that applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act. ² When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs, and applicant filed a reply brief.

Applicant having filed the application seeking registration under Section 2(f) has conceded [*3] that the mark is merely descriptive under Section 2(e)(1). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); and *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009). Thus, the sole issue on appeal is whether applicant has carried its burden of establishing, by a preponderance of the evidence, a prima facie case that its merely descriptive mark has acquired distinctiveness under Section 2(f). See *Yamaha, supra*; and *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

First, we must determine the degree of descriptiveness of the JEWELRYSUPPLY.COM mark that applicant seeks to register in relation to its recited services. In this regard, we note that a term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). [*4] Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

We turn then to the evidence made of record by the examining attorney in support of her position that JEWELRYSUPPLY.COM merely describes the recited services. This evidence includes dictionary definitions of "JEWELRY" as "ornaments for body, items worn as ornaments, e.g. necklaces, bracelets, earrings or rings;" ³ and "SUPPLY" as "provide, to give, sell, or make available something that is wanted or needed by somebody or something." ⁴ In addition, the examining attorney made of record articles and advertisements from Internet websites in which "JEWELRY SUPPLY" is used by third parties to identify their online jewelry store services. The following examples are illustrative: [*5]

Gemshow-Online Jewelry Supply

Swarovski Crystal Beads Bali Beads Jewelry Supply Sterling Silver Beads Sterling Silver Findings Sterling Silver Alphabet Beads Bali Bead Caps 14KGF Beads ...

(gemshow-online.com)

Lotta Displays

Jewelry Supply Super Store

Beads, Findings, Jewelry Displays, Tools, Merchant Supplies, Gift Bags, Jewelry Boxes, Jewelry Pouches, Wholesale Jewelry and more!

¹ Application Serial No. 77475181.

² The examining attorney also issued and subsequently withdrew a genericness refusal. In addition, the examining attorney issued several requirements with which applicant complied.

³ *Encarta World English Dictionary* (North American Edition) 2007.

⁴ *Id.*

Our goal is to offer unique, eye-catching jewelry displays at affordable prices. We directly import many of our items, and we search the globe for unique gift packaging ideas. We have a large stock of inexpensive jewelry making supplies including beads, findings, bead cord, sterling silver, tools and more in order to make our store a one-stop jewelry supply center.

(lottadisplays.com)

American Jewelry Supply is the world's largest full line distributor of tools and equipment for assayers, smelters, refiners, jewelers, polishers, casters, and electroplaters.

(americanjewelrysupply.com)

Welcome to BestBuyBeads.com - your online bead store. We are your source for CRYSTALLIZED - Swarovski Elements, crystal beads, silver & gold beads, jewelry supplies, and jewelry making ideas.

(bestbuybeads. [*6] com)

National Jewelers Supplies

Welcome to National Jewelers Supplies where you can find over 1000 quality jewelers tools, equipment and supplies. Our mission is to ensure that every customer's online experience is convenient, easy, and informative. We are distinguished from other jeweler's supplies companies based on our knowledge of jewelry supply products, our friendly service, our competitive prices and our valuable warranties.

(nationaljewelerssupplies.com)

SilverSource - Your Sterling Wholesale Silver Jewelry Supplier

Our quality wholesale jewelry supplies are competitively priced and proven to sell. Sterling silver jewelry has an excellent price point, and more style and design variation than jewelry made of any other precious metal. SilverSource carefully selects a wide variety of silver jewelry ring and earring designs to appeal to diverse customer tastes - all while assuring maximum profitability for our wholesale silver jewelry supply customers.

(silversource.com)

In addition, the examining attorney made of record copies of third-party registrations for various goods and services including services related to those in the involved application in which [*7] the terms JEWELRY or SUPPLY is disclaimed.

Based upon the evidence of record, we find that JEWELRY SUPPLY is, at best, highly descriptive of applicant's online retail store services featuring jewelry and jewelry-related products. Furthermore, although applicant does not appear to dispute the point, we note for completeness that the ".com" element in the JEWELRYSUPPLY.COM mark is not distinctive, nor does it render the mark, when viewed in its entirety, distinctive. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649 (TTAB 2005). We find, therefore, that JEWELRYSUPPLY.COM is a highly descriptive mark as used in connection with applicant's services and, as a result, applicant needs a commensurate high degree of evidence to show that its mark has acquired distinctiveness for its services. See *Yamaha*, 6 USPQ2d at 1008 [*8] ("in general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.")

We turn next to the evidence submitted by applicant in support of its Section 2(f) claim of acquired distinctiveness. As noted above, it is applicant's burden to prove acquired distinctiveness. See *Yamaha*, 6 USPQ2d at 1006; and *In re Hollywood Brands, Inc.*, 214 F.2d 139, 41 C.C.P.A. 1001, 1954 Dec. Comm'r Pat. 289, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008. A claim that applicant has been using the subject matter for a long period of substantially exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 57 C.C.P.A. 1173, 166 USPQ 34 (CCPA 1970), [*9] and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the services would be less likely to believe that it indicates source in any one party. See *In re Bongrain International Corp.*, 894 F.2d 1316, 13

USPQ2d 1727 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. However, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

In this case, as proof of acquired distinctiveness, applicant submitted a claim of ownership of Registration No. 3260055 for the mark displayed below, with a disclaimer of "JEWELRY SUPPLY" for "costume jewelry parts and findings, finished jewelry, [*10] jewelry boxes not of metal, jewelry boxes of precious metal" in Class 14; and "jewelry display cases" in Class 20. ⁵



Applicant "concedes that its prior registration does not constitute *prima facie* evidence of its acquired distinctiveness in its JEWELRYSUPPLY.COM mark." ⁶ However, applicant asserts that its applied-for JEWELRYSUPPLY.COM mark and the mark in its prior registration are legal equivalents.

In addition, applicant submitted the declaration of its president, Kenneth W. Roberts, attesting that the mark has been in substantially exclusive and continuous use in commerce in connection with the identified services for more than five years preceding the date of the declaration. Mr. Roberts declares [*11] that (1) applicant has been using the mark "at least as early as January 1999," and since then "has invested a total of approximately \$ 3.35 million in advertising for its JEWELRYSUPPLY.COM services" which are "primarily spent on internet marketing and magazine features;" ⁷ (2) applicant further has "invested an additional \$ 1.5 million on its 270 page color catalog and related flyers;" ⁸ (3) in 2007, applicant delivered its catalog to 60,000 customers; ⁹ (4) "the www.jewelrysupply.com site, which prominently features the Mark, reaches approximately 240,000 people per month and receives a daily page view of approximately 104,000;" ¹⁰ (5) applicant's mark "has been promoted to consumers nationwide through various online sources, including, but not limited to: www.kaboodle.com, www.beadjewelryblog.com, www.thisnext.com, and www.aboutus.org;" ¹¹ (6) applicant's instructional videos featuring its mark are displayed on online video streaming services including You Tube, MySpace, and MetaCafe; ¹² (7) applicant's sales through its "online retail store average approximately \$ 7 million per year" and "total approximately \$ 45 million;" ¹³ and (8) applicant has sold 5 million products [*12] bearing the JEWELRYSUPPLY.COM mark on their packaging. ¹⁴

⁵ Issued on the Principal Register on July 10, 2007 with the following description of the mark: "The mark consists of JEWELRY SUPPLY and design of triangle including beads, spool of wire, tools and findings."

⁶ Applicant's brief, p. 12-13.

⁷ Roberts Declaration, paras. 1-3, 8.

⁸ *Id.* at para. 9.

⁹ *Id.*

¹⁰ *Id.* at para. 5.

¹¹ *Id.* at para. 6.

¹² *Id.* at para. 7.

¹³ *Id.* at para. 10.

Applicant submitted a copy of its prior registration printed from the Office's Trademark Electronic Search System (TESS); printed copies of screenshots from its internet website as well as the above-noted third-party websites featuring advertisements and instructional videos regarding applicant's services; and an example of its catalog and packaging labels for goods available under its services.

With regard to applicant's prior registration, Trademark Rule 2.41(b) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as prima facie evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the [*13] registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. See *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of the rule, is the analysis used in tacking cases, i.e., whether the marks are legal equivalents. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991). See also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*; and *In re Dial-A-Mattress Operating Corp.*, *supra*. Aside from the identity of the marks in the registration and the application, applicant is also required to establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship [*14] between the goods and services in the prior registration and the goods and services identified in the application to warrant the conclusion that the distinctiveness of the mark associated with the goods and services in the registration will "transfer" to the goods and services listed in the application. See *In re Rogers*, *supra*.



In this case, we find that .

while perhaps confusingly similar to, is clearly not the legal equivalent of the applied-for mark, JEWELRYSUPPLY.COM. The only similarity between the marks is the common term JEWELRY SUPPLY, wording to which applicant disclaimed any exclusive rights when seeking registration of that mark. Otherwise, the mark in applicant's prior registration contains a triangular design depicting jewelry beads, tools, spools of wire and findings, all of which is notably absent from the applied-for mark. Such design clearly is not the equivalent of the top level domain indicator .COM. As a result, the two marks are distinguishable from one another, create somewhat different commercial impressions, and cannot be considered "the same" for purposes of Trademark Rule 2.41(b). Because [*15] the marks are not the same, Trademark Rule 2.41(b) cannot be used to establish that JEWELRYSUPPLY.COM has acquired distinctiveness as a mark for any goods or services, let alone the services for which registration is now sought. Thus, it is unnecessary to consider the relationship between the goods for which the mark has been registered and the services identified in the application.

We do not disregard applicant's prior registration, but consider it for such probative value as it may have in the context of the rest of applicant's evidence of acquired distinctiveness. In this regard, however, we keep in mind that the registration contains a disclaimer of the wording JEWELRY SUPPLY and, perhaps more importantly, the examining attorney's evidence demonstrates that said wording is used by several others in describing retail jewelry services.

With regard to the sales and advertising figures recited in the declaration of applicant's president, we observe that applicant has provided no context for the industry by which we may determine applicant's share of the online jewelry supply market or where such sales and advertising expenditures place applicant among others in the same and related [*16] fields. In other words these figures, without context, tell us very little about whether consumers of applicant's online jewelry supply services have come to recognize JEWELRYSUPPLY.COM as a source indicator. Therefore this evidence has very limited probative value.

¹⁴ *Id.* at 11.

Similarly, while Mr. Roberts states in his declaration that applicant's website is viewed by 104,000 people per day and 240,000 people per month, such figures suggest that applicant's website is repeatedly viewed by the same individuals rather than supporting a finding that large numbers of new individuals are exposed to applicant's mark on its web site each month. In addition, there is no indication of the number of individuals viewing the promotions of applicant's services under the JEWELRYSUPPLY.COM mark on the third-party websites beadjewelryblog.com, thisnext.com, or kaboodle.com, while the number of page views listed for JEWELRYSUPPLY.COM on the aboutus.org site is a very modest 237 views. Furthermore, the viewership of streaming videos featuring applicant's mark range from 33,500 on YouTube to approximately 300 to 1,000 on other video services. Again, there is no indication as to the number of individuals who have [*17] repeatedly viewed these videos.

In short, the evidence submitted by applicant suggests that it has enjoyed some commercial success in marketing its jewelry-related services under its JEWELRYSUPPLY.COM mark. However, the evidence falls rather short of demonstrating that JEWELRYSUPPLY.COM, as used in connection with such services, has acquired distinctiveness under Section 2(f). There is neither context for the sales and advertising figures, marketing materials, and internet website impressions nor direct evidence in the form of, for instance, surveys or affidavits asserting source-indicating recognition by which we may determine that JEWELRYSUPPLY.COM has come to indicate source in applicant.

Finally, we note that applicant and the examining attorney argue at length in their briefs regarding whether applicant's evidence that displays the applied-for mark with the triangular design from its prior registration in place of the "dot" as displayed below on its specimen of record, is sufficient to support a finding of acquired

distinctiveness as to the word mark JEWELRYSUPPLY.COM.



[*18]

However, even setting aside the question of whether these marks are legal equivalents and considering all of the evidence submitted by applicant as supporting its Section 2(f) claim as to JEWELRYSUPPLY.COM, we find that with this highly descriptive mark, applicant has not met its burden of showing acquired distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, *supra*, 6 USPQ2d at 1008.

In re Republic Jet Ctr. LLC, 2019 TTAB LEXIS 132

Trademark Trial and Appeal Board

May 10, 2019, Decided

Serial No. 87414987P

Reporter

2019 TTAB LEXIS 132 *

In re Republic Jet Center LLC

Disposition: [*1]

Decision: The refusal to register Applicant's mark REPUBLIC JET CENTER is affirmed.

Core Terms

marks, Registrant's, third-party, similarity, consumers, likelihood of confusion, aircraft, JET, airport, charter, air transportation, purchasers, AIRLINES, terms, impression, registered, website, transit service, Trademark, channels, words

Counsel

David B. Sunshine of Cozen O'Connor P.C., for Republic Jet Center LLC.

Daniel Stringer, Trademark Examining Attorney, Law Office 103, Stacy Wahlberg, Managing Attorney.

Panel: Before Bergsman, Ritchie and Heasley, Administrative Trademark Judges.

Opinion By:

Bergsman, Marc A.

Opinion

This Opinion Is Not a Precedent of the TTAB

Opinion by Bergsman, Administrative Trademark Judge:

Republic Jet Center LLC (Applicant) seeks registration on the Principal Register for the mark REPUBLIC JET CENTER, in standard characters, for the services listed below:

Providing general aviation services, namely, aircraft loading and unloading; skycapping in the nature of porter services; ground transportation of aircraft passengers and goods by various means; airport wheelchair services in the nature of transportation of passengers by wheelchair; rental of cars at the fixed base operation; rental of aircraft hangar space; mislabeled baggage delivery services; delivery of catering goods and newspapers, in Class 39; and Providing aircraft ground-support services, namely, aircraft fueling services, providing toilet,

water tank and lavatory cleaning services for [*2] aircraft; providing a ground power unit to supply power to a parked aircraft while its engines are turned off in the nature of battery charging services, in Class 37. ¹

Applicant disclaimed the exclusive right to use the term "Jet Center."

The Examining Attorney refused to register Applicant's mark under [Section 2\(d\) of the Trademark Act, 15 U.S.C. § 1052\(d\)](#), on the ground that Applicant's mark so resembles the registered marks listed below, owned by the same entity, as to be likely to cause confusion or mistake, or to deceive:

1. Registration No. 3323331 for the mark REPUBLIC AIRLINES, in standard characters for "transportation services, namely, passengers and delivery of goods by air," in Class 39. Registrant disclaimed the exclusive right to use the word "Airlines." ²

2. Registration No. 4446692 for the mark REPUBLIC AIRWAYS, in standard characters, for "air transportation services, namely the transportation of cargo, freight and passengers; airline transportation services," in Class 39. Registrant disclaimed the exclusive right to use the word "Airways." ³

3. Registration No. 4687026 for the mark REPUBLIC AIRWAYS HOLDINGS [*3] and design, reproduced below, for "air transportation services, namely the transportation of cargo, freight and passengers; airline transportation services," in Class 39. Registrant disclaimed the exclusive right to use the phrase "Airways Holdings." ⁴



Registrant's description of the mark reads as follows:

The mark consists of gray stars forming a circular background behind the stylized wording "Republic Airways" in blue over "Holdings" in red.

¹

Application Serial No. 87414987, filed April 18, 2017, 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.

²

Registered October 30, 2007; renewed.

³

Registered December 10, 2013.

⁴

Registered February 17, 2015.

The color(s) gray, blue and red is/are claimed as a feature of the mark.

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 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, 191 L. Ed. 2d 222, 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 [*4] on those factors we find to be relevant."). "[E]ach case must be decided on its own facts and the differences are often subtle ones." Indus. Nucleonic's Corp. v. Hinde, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973) (internal citations removed). 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 record evidence but 'may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods'" (quoting Herbko Int'l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002))).

I. The strength of Registrant's marks, including the number of similar marks in use in connection with similar services.

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 the marketplace recognition value of the [*5] 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. North Atlantic 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 Bd. of India v. Republic of Tea Inc., 80 USPQ2d 1881, 1899 (TTAB 2006); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. 2019) ("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 Bd. of India v. Republic of Tea Inc., 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness. For purposes of analyzing likelihood of confusion, a mark's renown may "var[y] along a spectrum from very strong to very weak." Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). The proper standard is the mark's "renown within a specific product market," *id.*, and "is determined from [*6] the viewpoint of consumers of like products," *id.* at 1735, not from the viewpoint of the general public.

A. Inherent Strength

When making a determination of likelihood of confusion in an *ex parte* appeal, in order to determine the inherent or conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary-fanciful continuum of words. Word marks that are arbitrary, fanciful, or suggestive are "held to be inherently distinctive." Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 120 S. Ct. 1339, 146 L. Ed. 2d 182, 54 USPQ2d 1065, 1068 (2000); see also, Chippendales USA, 96 USPQ2d at 1684 ("In general, trademarks are assessed according to a scale formulated by Judge Friendly in Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976), which evaluates whether word marks are 'arbitrary' or 'fanciful,' 'suggestive,' 'descriptive,' or 'generic.'").

[*7] The word "Republic" in Registrant's mark is defined, inter alia, as "a state in which the supreme power rests in the body of citizens entitled to vote and is exercised by representatives chosen directly or indirectly by them," "any body of persons viewed as a commonwealth," and "a state in which the head of government is not a monarch or other hereditary head of state."⁵ When used in connection with Registrant's transportation services, the word "Republic" is arbitrary because it is a "known word used in an unexpected or uncommon way." [*Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173 \(Fed. Cir. 2004\)](#) (defining an arbitrary mark as a "known word used in an unexpected or uncommon way" and observing that such marks are typically strong); see also [*Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 \(Fed. Cir. 2005\)](#) (arbitrary terms are conceptually strong trademarks).

B. Commercial Strength

There is no evidence regarding the commercial strength of Registrant's REPUBLIC marks.

C. The number and nature of similar marks in use in connection with similar services.

To show that Registrant's REPUBLIC marks are weak marks entitled to a narrow scope of protection, Applicant submitted two-third party registrations consisting in part of the word "Republic," and one third-party website for Republic Airport, "Long **[*8]** Island's Executive Airport" (republicairport.net).⁶ The third-party registrations are listed below:

1. Registration No. 3980174 for the mark TRAVEL REPUBLIC ("Travel" disclaimed) for, inter alia, "travel agency services," in Class 39, and "arranging of holiday temporary accommodation; hotel reservation services; temporary accommodation services relating to villas, apartments; booking of temporary accommodation," in Class 43;⁷ and
2. Registration No. 5388917 for the mark ONLINE REPUBLIC ("Online" disclaimed) for, inter alia, "travel agency services for making transportation reservations," in Class 39.⁸

While the Federal Circuit has held that "extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established," see [*Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 \(Fed. Cir. 2015\)](#) (citing [*Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 \(Fed. Cir. 2015\)](#)), this record of third-party registrations is not persuasive because neither third-party registration is for Registrant's type of transportation services, nor is the third-party website. **[*9]** Assuming arguendo, that travel agency services and airport services are related to Registrant's transportation services, two

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Dictionary.com/browse/republic# based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed May 7, 2019. 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).

⁶

Applicant's August 9, 2018 Request for Reconsideration (4 TTABVUE 8-15).

⁷

Id. at 4 TTABVUE 8.

⁸

Id. at 4 TTABVUE 10.

third-party registrations and one third-party website do not rise to the same level of persuasiveness as the voluminous evidence in [Juice Generation](#) and [Jack Wolfskin](#).

Because Registrant's REPUBLIC marks are arbitrary marks that are conceptually strong, we find that Registrant's marks fall on the strong side "of the spectrum from very strong to very weak."

II. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation, and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties 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, 55 C.C.P.A. 903, 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).

In comparing the marks, we are mindful that "The proper test is not a side-by-side comparison [*10] 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." [Cai v. Diamond Hong, Inc.](#), 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting [Coach Servs. Inc. v. Triumph Learning LLC](#), 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); 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).

Applicant is seeking to register the mark REPUBLIC JET CENTER and the Registrant's marks are REPUBLIC AIRLINES, REPUBLIC AIRWAYS, and REPUBLIC AIRWAYS HOLDINGS and design. The marks are similar because they share the arbitrary word "Republic." Moreover, the word "Republic" is the dominant part of all the marks.

The exclusive right to use the terms "Jet Center," "Airlines," "Airways," and "Airways Holdings" have been disclaimed because they are descriptive. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. See [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given [*11] little weight in reaching a conclusion on the likelihood of confusion.") (quoting [In re Nat'l Data Corp.](#), 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); [In re Dixie Rests. Inc.](#), 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); [In re Code Consultants, Inc.](#), 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). 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 on a consideration of the marks in their entireties. [In re Nat'l Data Corp.](#), 224 USPQ at 751; see also [In re Vittera Inc.](#), 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

With respect to the design in Registrant's mark REPUBLIC AIRWAYS HOLDINGS and design, the words are normally accorded greater weight because they are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the services. See [Vittera](#), 101 USPQ2d at 1908, 1911 (citing [CBS Inc. v. Morrow](#), 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)); [Sweats Fashions Inc. v. Pannill Knitting Co.](#), 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987).

The significance of the word "Republic" is reinforced by its location as the first word of each mark. See [In re Detroit Athletic Co.](#), 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); [*12] [Palm Bay Imps.](#) 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first

word in the mark and the first word to appear on the label); [*Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 \(Fed. Cir. 1992\)](#) (upon encountering the marks, consumers will first notice the identical lead word).

Because the dominant part of each mark is the word "Republic" followed by a descriptive word, the marks are similar in appearance, sound, connotation and commercial impression. "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." [*In re Denisi*, 225 USPQ 624, 624 \(TTAB 1985\)](#). The peripheral differences in this case fail to distinguish the marks.

III. The similarity or dissimilarity and nature of the services.

Registrant's marks are registered for airline transportation services. Applicant is a "fixed base operator" or "FBO." ⁹ A "fixed base operator" is a "commercial business allowed to operate on airport grounds in order to provide services to the airport. In essence, they are private jet terminals located on the grounds of an airport." ¹⁰ The services provided by fixed base operators include fueling, baggage handling, aircraft rental, aircraft interior [*13] and exterior cleaning and lavatory servicing, providing ground transportation, and providing hangar space. ¹¹ However, we must consider the services as they are described in the application at issue, and not extrinsic evidence about Applicant's actual services. See [*Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 \(Fed. Cir. 2014\)](#); [*Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 \(Fed. Cir. 1990\)](#) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods are directed."); [*Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 \(CCPA 1973\)](#) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [or services]"); compare [*In re Thor Tech, Inc.*](#), 113 USPQ2d 1546, 1547 (TTAB) (using extrinsic evidence to define the description of goods); [*In re Trackmobile*](#), 15 U.S.P.Q.2d (BNA) 1152, 1154 (TTAB 1990) (if the cited registration contains terms that are not readily understood, the Board may rely [*14] on extrinsic evidence explaining the meaning of those terms).

To show that the Registrant's airline transportation services and Applicant's services are similar, the Examining Attorney submitted copies of 17 use-based, third-party registrations for activities listed in both the application and the cited registrations. ¹² Third-party registrations based on use in commerce that individually cover a number of

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An excerpt from Applicant's website (republicjetcenter.com) attached to the February 9, 2018 Office Action (TSDR 140); see also Applicant's August 9, 2018 Request for Reconsideration (4 TTAVUE 12) ("Welcome to Republic Jet Center: New York's Newest, State-of-the-Art FBO").

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval System (TSDR), by page number in the downloadable .pdf format.

¹⁰

Presidential-aviation.com attached to the August 28, 2018 Denial of Request for Reconsideration (5 TTABVUE 4).

¹¹

Id.; SKYbrary website (skybrary.aero) attached to the February 9, 2018 Office Action (TSDR 142); "Fixed-base operator," Wikipedia.org attached to the February 9, 2018 Office Action (TSDR 143-144).

¹²

different services may have [*15] probative value to the extent that they serve to suggest that the listed services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988). Representative registrations, with relevant portions of the identifications, are listed below.

MARK	REGISTRATION NUMBER	Services
JET SOURCE	2322153	Aircraft fueling and cleaning; air transportation
WEST JET	3559405	Aircraft refueling; air charter services
ENVOY	4867612	Maintenance of baggage-related facilities; refueling of aircraft; aircraft interior and exterior cleaning and sanitation; air transport
AMERICAN AIRLINES	4939082	Maintenance of baggage-related facilities; airport baggage checking; baggage handling; aircraft interior and exterior cleaning and sanitation; air transport of passengers, cargo and freight
FLEXJET	2367318	Fueling services; air transportation

Also, the Examining Attorney submitted excerpts from 11 websites from companies offering air transportation or charter services as well as FBO services, including some of the various [*16] activities listed Applicant's description of services under the same mark.¹³ Representative third-party websites are listed below:

July 20, 2017 Office Action (TSDR 23-40); February 9, 2018 Office Action (TSDR 22-74). The Examining Attorney submitted copies of 24 registrations in total. However, he submitted Registration No. 4867612 twice. Also, six registrations listed "maintenance" services. "Maintenance" is not listed in Applicant's description of services and because the Examining Attorney did not define "maintenance" services and show how "maintenance" services are related to the activities listed in Applicant's description of services, we do not know if it is broad enough to encompass any of the activities listed in Applicant's description of services. Accordingly, we do consider seven of the registrations that the Examining Attorney submitted.

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We did not consider the Naples Jet Center website (naplesjetcenter.com) that displayed links to charter services and "FBO" services. July 20, 2017 Office Action (TSDR 41-44). The excerpt that the Examining Attorney submitted did not specifically list any of the activities set forth in Applicant's description of services.

We did not consider the Vail Valley Jet Center website (vvjc.com) that has links to aircraft charter and line services [*17] because the Examining Attorney did not define line services so we do not know whether line services include the activities listed in Applicant's description of services. July 20, 2017 Office Action (TSDR 45).

We did not consider the Air Canada (aircanada.com) (July 20, 2017 Office Action (TSDR 46-49)), the Southwest Airlines websites (swacargo.com, southwest.com, and southwestairlinesinvestorrelations.com) (July 20, 2017 Office Action (TSDR 50-53)) or the United Airlines website (unitedcargo.com and united.com) (July 20, 2017 Office Action (TSDR 54-56)) because we assume that major airlines are going render the activities listed in Applicant's description of services as an integral part of their airline services. Also, the Southwest Airlines websites did not list any of the activities in Applicant's description of services. Compare the Delta Airlines websites Delta Private Jet website (deltaprivatejets.com) (February 9, 2018 Office Action (TSDR 137-138)) advertising the company's FBO services, including providing rental cars, fueling, lavatory servicing, and battery

1. Aero Charter website (aerocharter.com) advertises itself as a full service FBO Operator offering, inter alia, air transportation services, refueling services, "and all other services along with the amenities you've come to expect from top FBOs." ¹⁴

2. Napa Jet Center (napajetcenter.com) advertises itself as an FBO providing aircraft refueling, hangar and storage, detailing, lavatory, laundry and catering services, as well as aircraft charter services. ¹⁵

3. Gary Jet Center (garyjetcenter.com) advertises its air charter services and its FBO services, including fueling, aircraft parking, and providing rental cars. ¹⁶

We find the evidence sufficient to show that the services are related because the same marks are used by others to identify and distinguish air transportation or charter services and any number of the activities listed in Applicant's description of services. Each of the activities in Applicant's description of services do not have be used by the third parties. It is sufficient if only some of the activities are used. *Cf. Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant argues, in part, that the Registrant's air transportation services and its services are not related because

Applicant's services are rendered to charter aircraft companies who require aircraft servicing at Republic Airport. [*19] The owner of the Cited Registrations markets its services to the general public through code-sharing arrangements with the major airline carriers. ¹⁷

As noted above, we analyze the similarity or dissimilarity and nature of the services based on the description of services in the application and the cited registrations. We do not read limitations into the description of services. See *i.am.symbolic*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"); *In re Thor Tech*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). Therefore, we must presume that Applicant's services may be rendered anywhere and not limited to Republic Airport and that Registrant's services may be rendered without code-sharing arrangements with the major airline carriers.

charging services and the Delta website (delta.com) (February 9, 2018 Office Action (TSDR 139) advertising the company's [*18] air transportation services.

We did not consider the Florida Jet website (floridajet.com) (February 8, 2018 Office Action TSDR 107-109) or the Fargo Jet Center (fargojet.com) (February 8, 2018 Office Action (TSDR 114-118)) because neither website listed any of the activities in Applicant's description of services.

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February 9, 2018 Office Action (TSDR 75-78).

¹⁵

February 9, 2018 Office Action (TSDR 79-82).

¹⁶

February 9, 2018 Office Action (TSDR 85-87).

¹⁷

Applicant's Brief, p. 8 (8 TTABVUE 13).

IV. Established, likely-to-continue channels of trade and classes of consumers.

The third-party website evidence discussed above shows [*20] that that airplane owners and people or companies that charter planes use FBO services. In fact, the air charter services and FBO services are bundled together as an advertising tool to attract customers. For example, on the Aero Charter webpage focusing on that company's charter services, the company advertises that it "provides full FBO services, aircraft management, aircraft sales and acquisitions, maintenance, avionics and a full travel agency." ¹⁸

We find that air transportation or charter services and the activities listed in Applicant's description of services are offered in the same channels of trade to the same classes of consumers.

V. Conditions under which and buyers to whom sales are made.

Although there is no evidence regarding how consumers make their purchasing decisions with respect to the relevant services, because Applicant's services involve general aviation services and aviation ground support services, we assume that consumers will exercise a high degree of care when making their purchasing decision. Nevertheless, in cases where there are similar marks, related goods, and similar channels of trade and classes of consumers, [*21] even a careful, sophisticated consumer of these services may not note the differences in the marks. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 ("The alleged sophistication of golfers is outweighed by the Board's findings of strong similarity of marks and identity of goods."); *Weiss Assocs. Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841-42 (Fed.Cir.1990) (similarities in marks and products overshadowed sophistication of purchasers); *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 58 C.C.P.A. 751, 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, 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.

VI. Conclusion

Because the marks are similar, the services are related and are offered in the same channels of trade to the same classes of consumers, [*22] we find that Applicant's mark REPUBLIC JET CENTER for the services listed in the application are likely to cause confusion with the previously registered REPUBLIC AIRLINES and REPUBLIC AIREWAYS marks for air transportation services.

End of Document

In re TriStar History & Pres., Inc. , 2015 TTAB LEXIS 340

Trademark Trial and Appeal Board

September 3, 2015, Decided

Serial Nos. 86078454 and 86111943

Reporter

2015 TTAB LEXIS 340 *

In Re TriStar History and Preservation Inc.

Disposition: [*1]

Decision: The Section 2(d) refusals to register Applicant's marks are affirmed.

Core Terms

marks, Registrant's, Airlines, goods and services, likelihood of confusion, airplanes, typed, air transportation, consumers, globes, similarities, overlapping, channels, appearance, passengers

Counsel

Christopher M. DeBacker of the Law Office of Mark Brown LLC, for TriStar History and Preservation Inc.

Caitlin Watts-FitzGerald, Trademark Examining Attorney, Law Office 111, Robert L. Lorenzo, Managing Attorney.

Panel: Before Bucher, Lykos and Adlin, Administrative Trademark Judges.

Opinion By:

Adlin, Michael B.

Opinion

This Opinion is not a Precedent of the TTAB

Opinion by Adlin, Administrative Trademark Judge:

TriStar History and Preservation Inc. ("Applicant") seeks registration of the two marks shown below



Image

Name

1

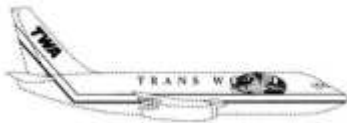
Image

Name



² for "Air transportation of passengers and freight."

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that Applicant's marks so resemble four marks registered to American Airlines Inc. ("Registrant") for various types of model airplanes that use of Applicant's marks in connection with Applicant's services is likely to cause confusion or mistake or to deceive. The cited American Airlines marks are TWA in typed form ³ and the three marks shown below [***2**] Image Name



⁴ Image Name



⁵ Image

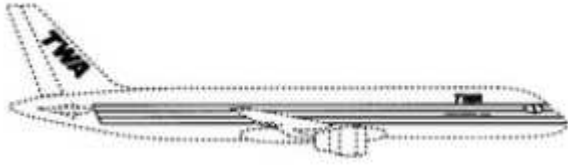
¹ Application Serial No. 86078454, filed September 30, 2013, under Section 1(b) of the Trademark Act, based on an alleged intent to use the mark in commerce. The registration includes this description of the mark: "The mark consists of two overlapping globes with meridians and parallels located in the space where the two globes overlap. The letters T, W, and A located in the center of the overlapping globes in a bold and italicized font."

² Application Serial No. 86111943, filed November 6, 2013 under Section 1(b) of the Act.

³ Registration No. 2615260, issued September 3, 2002, for "toys, namely, model airplanes made of plastic and metal." Renewed.

⁴ Registration No. 2736074, issued July 15, 2003, for "toys, namely model airplanes made of plastic, wood and metal." Renewed. The registration includes this description of the mark: "The mark consists of the words 'TRANS WORLD' as well as a fanciful depiction of the world map appear on the sides of the airplane. The letters 'TWA' appear on the rear tale wing of the airplane. The belly of the airplane is blue with a red solid stripe appearing on top of the blue. The applicant is not claiming those portions of the drawing that appear in broken/dotted lines as part of the mark." Color is not claimed as a feature of the mark.

⁵ Registration No. 2746294, issued August 5, 2003, for "Scale model airplanes." Renewed. The registration includes this description of the mark: "The mark consists of three stripes of equal weight, positioned on both sides of the aircraft. The stripes are blue at the top, white in the middle and red at the bottom. In addition, the phrase 'TWA' is lined for the color red. and outlined in the color white and is positioned in the front and on both sides of the aircraft and on the tail of both sides of the aircraft. The drawing also consists of the phrase 'AN AMERICAN AIRLINES COMPANY'. This phrase is blue except for the word 'AMERICAN' which is red. This phrase is located toward the front of the aircraft below the letters 'TWA' and above the blue, white and red stripes. The remaining body of the entire aircraft is polished silver." Color is not claimed as a feature of the mark.



Name
Applicant and the Examining Attorney filed briefs. ⁷

⁶ After the refusals became final, Applicant appealed and

[*3] [*4]

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all 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); see also [In re Majestic Distilling Company, Inc.](#), 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See [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.").

Turning first to the marks, we [*5] must compare them "in their entireties as to appearance, sound, connotation and commercial impression." [Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772](#), 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting [du Pont](#), 177 USPQ at 567). That is, we may not dissect the marks into their various components. [In re Nat'l Data Corp.](#), 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also [Franklin Mint Corp. v. Master Mfg. Co.](#), 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

Applicant's stylized TWA word mark is virtually identical to the cited mark TWA in typed format. ⁸ Indeed, there is nothing distinctive about Applicant's stylization, and in any event, because the cited mark is in typed form, it may be displayed in the same stylized format as Applicant's mark. See, e.g., [In re Vittera](#), 101 USPQ2d at 1909 (citations omitted). In other words, the marks look virtually identical, sound identical and convey identical meanings.

[*6]

While Applicant's other mark includes "two overlapping globes with meridians and parallels located in the space where the two globes overlap," it also, quite prominently, includes "[t]he letters T, W, and A located in the center of the overlapping globes *in a bold and italicized font*" (emphasis supplied). It is settled that where, as here, a mark is comprised of a literal element and a design, such as Applicant's TWA design mark, the literal element is normally accorded greater weight, because consumers are likely to remember and use the words, term or acronym to request the goods or services. See [id. at 1911](#) ("the verbal portion of a word and design mark likely will be the dominant portion"); see also, [In re Appetito Provisions Co. Inc.](#), 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that "if

⁶ Registration No. 3038805, issued January 10, 2006, for "scale model airplanes" (sic). Section 8 Affidavit accepted, Section 15 Affidavit acknowledged. The registration includes this description of the mark: "The body, wings and engine of the plane are silver. There are three (3) stripes placed horizontally along the plane. The stripes are blue, white and red in descending order. The letters 'T-W-A' are red outlined in white." Color is not claimed as a feature of the mark.

⁷ The Examining Attorney's objection to the attachments to Applicant's Appeal Brief is sustained and the materials have been given no consideration because they are untimely. Trademark Rule 2.142(d).

⁸ There is no substantive difference between "standard character" marks and marks in "typed" form. [In re Vittera 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, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks").

one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services" and "because applicant's mark shares with registrant's mark that element responsible for creating its overall commercial impression, the marks are confusingly similar"). The dominance of the initialism [*7] TWA in Applicant's globe design mark is only reinforced by its appearance, as Applicant describes it, "in a bold and italicized font." In short, Applicant's globe design mark looks similar to TWA in typed form, sounds identical and conveys a highly similar meaning.

While Applicant's marks are less similar to Registrant's TWA design marks, the fact remains that TWA is the dominant element of not only Applicant's globe design mark but also the cited marks in Registration Nos. 2746294 and 3038805, because the "three stripes" in each of these marks are not in any way distinctive and "TWA" appears twice in each of these marks. While the mark in Registration No. 2746294 also includes the phrase "AN AMERICAN AIRLINES COMPANY," this phrase merely highlights the fact that TWA is the ongoing source of the model airplanes, and that it is part of American Airlines. As for the mark in Registration No. 2736074, the words "TRANS WORLD" do not meaningfully distinguish it from Applicant's mark because this merely indicates what the TWA initialism stands for, and that TWA/Trans World Airlines is the source of the model airplanes, while the "world map" design is not distinguishing because Applicant's [*8] design mark contains "two overlapping globes," which are essentially a type of "world map." In short, while there are more differences between Applicant's marks and Registrant's design marks than Registrant's typed mark, Applicant's marks and Registrant's design marks are still more similar than different, in how they look and sound and in the meaning they convey.

Furthermore, given the close similarity between Applicant's design mark and Registrant's cited typed mark, and that Applicant's stylized mark is virtually identical to the cited typed mark, this factor not only weighs heavily in favor of a finding of likelihood of confusion, but also reduces the degree of similarity between the goods and services that is required to support a finding of likelihood of confusion, at least with respect to Registrant's typed mark. [*In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 \(Fed. Cir. 1993\)](#); [*Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 \(TTAB 2002\)](#); and [*In re Opus One Inc.*, 60 USPQ2d 1812, 1815 \(TTAB 2001\)](#).

Turning to the goods and services and channels of trade, at first glance the only relationship between Applicant's [*9] "air transportation of passengers and freight" and Registrant's model airplanes is that both relate to aviation in some manner. However, the Examining Attorney has established that the relationship is deeper than that. Specifically, she introduced evidence that United Airlines, US Airways and American Airlines ⁹ not only sell model airplanes, but do so on the same websites through which they also sell services including "air transportation of passengers." Furthermore, their model airplanes bear the same marks under which the airlines sell "air transportation of passengers." The following webpages introduced by the Examining Attorney are either part of, or accessible directly through, the airlines' websites which sell air transportation services:

⁹ We do not require evidence to recognize these as major, well-known airlines.

Image

Name

http://unitedshop.summitma.com/unitedshop/dept.asp?dept_id=11000 01/15/2014 03:35:24 PM

United Shop











Home | Login | My Account | Cart | FAQ | Contact Us | Go to united.com

Keyword Item #

Model Airplanes Travel Apparel Merchandise Sale New Arrivals

sort: Item Number

Model Airplanes


 737-800 with Windows 1/130 Scale \$24.50	 747-400 Business Class 1/200 Scale \$198.00	 747-400 Business Class 1/200 Scale \$126.00	 747-400 First Class 1/200 Scale \$348.00
 777-200 Business Class 1/144 Scale \$184.00	 777-200 Business Class 1/200 Scale \$124.00	 777-200 First Class 1/200 Scale \$326.00	 787-8 Business Class 1/144 Scale \$188.00
 787-8 Dreamliner Premier 1/200 Scale \$31.00	 787-8 First Class 1/100 Scale \$275.00		

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- Gentle Jets
- MUSEUM
- SEASONAL
- TECHNOLOGY ACCESSORIES
- TOYS & GAMES
- TRAVEL















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- 
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 \$38.00

14 products in this category, displaying products 1 to 14.

DESCRIPTION	PRICE	
 777-300 ER New Delivery 032051 Skymarks 777-300 ER with the new livery. Plastic 1:200 scale. Includes plastic base. Approximately 15 1/2" L x ...	\$58.00	<input type="button" value="add to basket"/>
 AA 757-200 1/200 Scale Plastic 031170 757-200 plastic model with classic livery. 1:200 scale. Approximately 9L x 7" W	\$32.00	<input type="button" value="add to basket"/>
 Hot Wings AA 727 032003 Hot Wings AA 727 in classic livery. Die cast metal, approx 5" long. Includes connectable runway.	\$8.99	<input type="button" value="add to basket"/>
 Hot Wings AA DC-10 032001 Hot Wings AA DC-10 in classic livery. Die cast metal, approx 9" long. Includes connectable runway.	\$8.99	<input type="button" value="add to basket"/>
 Skymarks A319 1:150 Scale NEW! 032041 Airbus A319 plastic model by Skymarks. 1:150 scale. Includes plastic base. Approximately 9 1/2" L x 9" W. 032041...	\$38.00	<input type="button" value="add to basket"/>
 TWA 707 Astrojet 700-308 Astrojet 1:100 scale. Handcrafted mahogany aircraft with hand painted graphics. Stand included. This item has a...	\$175.00	<input type="button" value="add to basket"/>
 TWA 727 w/Winglets Classic 1:100 030104 727 with Winglets in the Classic livery. 1:100 Scale Handcrafted mahogany aircraft with hand painted graphics. L...	\$225.00	<input type="button" value="add to basket"/>
 TWA 757-200 Winglets Classic 1:100 030403 757-200 with Winglets in the Classic livery. 1:100 scale. Handcrafted mahogany aircraft with hand painted graphics. L...	\$225.00	<input type="button" value="add to basket"/>
 TWA 767-300 Classic 1:100 Scale 030044 767-300 with the Classic livery. 1:100 Scale. 18" wingspan. Handcrafted mahogany aircraft with hand painted graphics. L...	\$225.00	<input type="button" value="add to basket"/>
 TWA 777-200 Classic 1:100 Scale 030046 TWA 777-200 Classic livery. 1:100 scale. Handcrafted mahogany aircraft with hand painted graphics. Stand included. L...	\$250.00	<input type="button" value="add to basket"/>
 TWA Conquest 990 030051 AA Conquest 1:100 Scale 17" long by 15" wingspan. Handcrafted mahogany aircraft with hand painted graphics. L...	\$175.00	<input type="button" value="add to basket"/>
 TWA MD80 Classic 1:100 Scale 030062 MD80 in the Classic livery. 1:100 Scale 17" long by 15" wingspan. Handcrafted mahogany aircraft with hand painted graphics. L...	\$195.00	<input type="button" value="add to basket"/>
 TWA Spirit of St. Louis 1:32 030018 Spirit of St. Louis 1:32 scale. Handcrafted mahogany aircraft with hand painted graphics. Stand included. This item has a...	\$150.00	<input type="button" value="add to basket"/>
 TWA Tri motor 1:48 Scale 030018 Ford AT-5C Tri motor. 1:48 Scale. Handcrafted mahogany aircraft with hand painted graphics. Stand included. Th...	\$165.00	<input type="button" value="add to basket"/>

Shopping Cart

- 0 Items

Customer Login

-
- [Forgot your password?](#)

Image Name

Image

Name



[*10]

In many cases, a mere three examples of a relationship between the goods and services and channels of trade might not be particularly persuasive standing alone. However, we must account for the field and industry at issue, in this case aviation and airlines. We do not require evidence to know that by its nature, aviation is exceedingly difficult and expensive. Accordingly, the airline industry's barriers to entry are substantial, and in fact insurmountable for all but a few. We do not require evidence to know that there are a small number of major airlines. Therefore, the Examining Attorney's three examples of relatedness are more than sufficient in the oligopolistic airline industry.

Furthermore, we cannot ignore that Applicant's marks display TWA in what appears to be the exact same font and style as the "TWA" appearing on the tails of the airplanes comprising the designs in cited Registration Nos. 2736074, 2746294 and 3038805. Consumers aware that major airlines sell model planes and familiar with Registrant's cited marks will be likely, upon seeing that the TWA in Applicant's marks is presented in the same manner as the TWA on the tails of Registrant's design marks, to assume [*11] a connection between the sources of Applicant's services and Registrant's goods. *See Monogram Models, Inc. v. Ford Motor Company*, 176 USPQ 498 (TTAB 1972) (finding likelihood of confusion from use of same mark for full-sized automotive vehicles and scale model assembly kits for automobiles).

"Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services." [*Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 \(Fed. Cir. 2002\)](#); [*Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 \(Fed. Cir. 2000\)](#) ("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods"). Here, the evidence establishes that the goods and services are related and move in the same channels of trade. These factors therefore also weigh in favor of a finding of likelihood of confusion.

Applicant argues that there is no likelihood of confusion between the goods and services because [*12] it is a nonprofit entity with the intent to transport passengers and freight for the purposes of education and historical preservation. Thus, [Applicant's] audience, consumers of the services with which [Applicant's] mark is used, are those individuals and businesses interested in historical preservation of aircraft and the aircraft industry in the United States. [Applicant] will be intimately involved in interaction with its customers and participants, and there

would be no source confusion involved with customers and participants who are using the [Applicant's] services.

Applicant's Appeal Brief at 3. We are not persuaded. As the Examining Attorney points out, "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application, regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." [*Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 \(Fed. Cir. 1990\)](#). In [*13] other words, we must base our decision on the "air transportation of passengers" services identified in the applications, which the evidence shows are offered on airline websites with model airplanes which bear the same mark.

Finally, Applicant argues that confusion is unlikely because the relevant consumers are sophisticated and careful. While we accept that consumers of air transportation will exercise at least some care, that is not enough to prevent confusion in this case, because the relevant consumers, *i.e.*, members of the general public, are also accustomed to airlines providing these services as well as model airplanes, and because Applicant's marks are so similar to the cited marks. In any event, even assuming that this factor weighs against a finding of likelihood of confusion, it is outweighed by the similarities between the marks, the relatedness of the goods and services and the overlapping channels of trade.

Conclusion

Applicant's marks and Registrant's typed mark are quite similar as their dominant, literal element is virtually identical, and there are more similarities than dissimilarities between Applicant's marks and Registrant's design marks. Furthermore, [*14] the goods and services identified in the applications and cited registrations are related and move in overlapping channels of trade.

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In re United States Steel Corp. , 2016 TTAB LEXIS 128

Trademark Trial and Appeal Board

February 23, 2016, Hearing ; April 8, 2016, Decided

Serial No. 86174180

Reporter

2016 TTAB LEXIS 128 *

In re United States Steel Corporation

Disposition: [*1]

Decision: The refusal to register Applicant's proposed mark COPPER-TEN under Section 2(a) is affirmed.

Core Terms

copper, deceptive, steel, consumers, registration, marks, prepainted, building materials, sheet steel, purchasers, weathered, coated, misdescription, simulate, sheets, prong, misdescribes, ingredient, Trademark, Register

Counsel

Jonathan C. Parks for United States Steel Corporation.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119, Brett Golden, Managing Attorney.

Panel: Before Quinn, Cataldo and Lynch, Administrative Trademark Judges.

Opinion By:

Quinn, Jeffrey

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Quinn, Administrative Trademark Judge:

United States Steel Corporation ("Applicant") seeks registration on the Principal Register of the proposed mark COPPER-TEN (in standard characters) for "prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper" in International Class 6.¹

¹ Application Serial No. 86174180, filed January 24, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first anywhere and first use in commerce on February 28, 2010.

The Trademark Examining Attorney refused registration [*2] under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that Applicant's proposed mark, when applied to the goods, is deceptive.

When the refusal was made final, Applicant appealed and requested reconsideration. Upon denial of the request, proceedings in the appeal resumed, and Applicant and the Examining Attorney filed briefs. An oral hearing was held before this panel.

We affirm the refusal to register.

Applicant argues that the COPPER portion of its proposed mark does not misdescribe the goods as having copper material, but rather accurately describes the visual appearance simulated by the goods, namely, that the sheet steel has been prepainted to simulate naturally weathered copper. Thus, Applicant contends, COPPER-TEN does not misdescribe the goods, and consumers would not find the mark to be deceptive. Further, Applicant relies on what it characterizes as a "family of trademarks," comprising GALV-TEN, COR-TEN AZP, DUAL-TEN and the present proposed mark. To this point, Applicant asserts that consumers will associate not only the individual marks, but the common characteristic of the family, with Applicant, and that this common characteristic [*3] eliminates the possibility that consumers are likely to believe any possible misdescription. The relevant consumers, according to Applicant, are home builders, construction experts and professional architects, all of whom are sophisticated and understand that the goods are specially coated steel and do not necessarily contain any copper metal or materials. In support of its arguments Applicant submitted printouts of web pages from third-party websites, and identical declarations of Applicant and Applicant's licensee.

The Examining Attorney maintains that the term COPPER appearing in the proposed mark indicates that the goods contain copper when, in fact, they do not; that consumers are likely to believe this misrepresentation; and that this misrepresentation is likely to materially affect consumers' decisions to purchase the goods. The Examining Attorney introduced excerpts of third-party websites.

Before turning to the merits of the refusal, we direct our attention to a procedural matter. In its reply brief Applicant asserts for the first time a claim that its proposed mark has acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). (10 TTABVue [*4] 7-8). Applicant essentially relies upon certain statements in the two declarations regarding deceptiveness, and couches them in terms of acquired distinctiveness.

First, marks that are deceptive under Section 2(a), as we have found here, are not registrable either on the Principal Register, even under Section 2(f), or the Supplemental Register. Second, a claim of acquired distinctiveness raised for the first time in a reply brief is manifestly untimely. See Trademark Rule 2.142(d) (record should be complete prior to appeal). Accordingly, we have given no consideration to Applicant's late claim of acquired distinctiveness.

I. Applicable Law -- Section 2(a) -- "Deceptive Matter"

Section 2(a) is an absolute bar to registration of an applied-for mark comprised of deceptive matter. The Examining Attorney has the initial burden of putting forth a *prima facie* case that a trademark falls within the prohibition of Section 2(a). *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (LOVEE LAMB deceptive for "automotive seat covers"); *In re E5 LLC*, 103 USPQ2d 1578, 1579 (TTAB 2012) (mark consisting of alpha symbol and the [*5] letters "CU" deceptive of dietary supplements not containing copper). A mark is deceptive if the following criteria are met:

- 1) The applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods;
- 2) Prospective purchasers are likely to believe that the misdescription actually describes the goods; and
- 3) The misdescription is likely to affect the purchasing decision of a significant portion of relevant consumers.

See *In re Budge Mfg. Co.*, 8 USPQ2d at 1260; *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391-92 (TTAB 2013); see also *In re Spirits International, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a "significant portion of the relevant consumers be deceived"). A mark is deceptive even if only a portion of the mark is deceptive. See *American Speech-Language-*

Hearing Assoc. v. National Hearing Aid Society, 224 USPQ 798, 808 (TTAB 1984). This includes marks, such as Applicant's, that comprise both deceptive matter and a non-deceptive [*6] term. *Id.* The law is clear; Section 2(a) of the Trademark Act prohibits registration of deceptive matter, not merely deceptive marks. *See In re White Jasmine LLC*, 106 USPQ2d at 1391 ("It is well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark.").

II. Analysis

A. Does the applied-for mark consist of or contain a term that misdescribes the character, quality, function, composition, or use of the goods?

Applicant seeks registration for the proposed mark COPPER-TEN for goods described as "prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper." Further, throughout prosecution, Applicant confirmed that its goods do not contain copper as an ingredient or component; rather, the goods are prepainted steel sheets meant to look like weathered copper. In accordance with Section 2(a), registration must be refused if a mark is deceptive of a feature or an ingredient the goods. *See In re E5 LLC*, 103 USPQ2d at 1579-81 (consumers would understand CU portion of the mark to indicate chemical symbol for copper, and because [*7] applicant's dietary supplements do not contain copper, mark is deceptive).

Inasmuch as Applicant's goods do not contain copper, the proposed mark COPPER-TEN misdescribes the goods.

Applicant advances several arguments in an attempt to show that purchasers would not understand the presence of the term COPPER in the proposed mark to indicate that the building material contains copper.

Contrary to Applicant's contention, the addition of --TEN in the mark has no impact on the deceptiveness of the COPPER portion of the mark and, in turn, the mark as a whole. *See, e.g., R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 51 C.C.P.A. 946, 1964 Dec. Comm'r Pat. 238, 140 USPQ 276 (CCPA 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leatherlike appearance made into shoes); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (TEXHYDE held deceptive of synthetic fabric sold in rolls to be used in the manufacture of furniture, upholstery, luggage, etc.); *Caldwell Lace Leather Co., Inc. v. Western Filament, Inc.*, 173 USPQ 695 (TTAB 1972) (NEOHIDE held deceptive and deceptively misdescriptive of shoe laces which could be made to simulate [*8] leather). Applicant pointed to no meaning of the term --TEN that would change the meaning or impression of the reference to COPPER in the mark or of the mark as a whole. *See A. F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (COPY CALF not deceptive of non-leather goods because the term as a whole indicates the goods "are imitations or copies of wallets and billfolds made of calf skin").

We further are entirely unpersuaded by Applicant's argument that because it owns a purported family of --TEN marks, the present mark cannot be deceptive. Applicant owns the following registrations issued on the Principal Register: Reg. No. 3331634 for the mark COR-TEN AZP for "prepainted coated sheet steel, namely, corrosion-resistant coated sheet steel prepainted to simulate naturally weathered steel" in International Class 6; Reg. No. 4298490 for the mark FLANGE-TEN for "steel mill products, namely, advanced high-strength automotive sheet steels exhibiting improved stretch flangability" in International Class 6; Registration No. 4376566 for the mark TRIP-TEN for "steel mill products, namely, hot rolled steel and galvanized steel sheet" in [*9] International Class 6; Registration No. 4376567 for the mark DUAL-TEN for "steel mill products, namely, hot rolled steel and galvanized steel sheets" in International Class 6; and Reg. No. 4702394 for the mark GALV-TEN for "prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered galvanized steel" in International Class 6.

We fail to see the applicability of a family of marks argument in the context of a deceptiveness case, to somehow transform an unregistrable deceptive mark into a source indicator. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."). Moreover, even if we believed that a family of marks argument had applicability in considering deceptiveness,

Applicant has failed to establish that it owns a family of --TEN marks. The Federal Circuit has defined a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed [*10] and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In the past, the Board has looked at whether the marks asserted to comprise a "family" have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and, thereafter, recognition of common ownership based upon a feature common to each mark. *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978). The mere use of the marks together in an advertisement for Applicant's Weathered Metal Series TM falls short of establishing a family in the absence of evidence to show a recognition among purchasers that the common characteristic of --TEN is indicative of a common origin of the goods. [*11] Further, ownership of a few registrations for marks that include the common element --TEN hardly suffices to establish a family of marks. In sum, the mere fact of adoption, use and/or registration of a few marks incorporating a common element does not in itself prove that a family of marks exists. *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 52 C.C.P.A. 978, 1965 Dec. Comm'r Pat. 209, 144 USPQ 419 (CCPA 1965); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527, (TTAB 2000); *Consolidated Foods Corp. v. Sherwood Medical Indus., Inc.*, 177 USPQ 279 (TTAB 1973).

We also note that any clarifying features of an applicant's advertising do not serve to overcome deceptiveness in a mark. In this connection, Applicant's advertisements, indicating that its product is a prepainted steel sheet to "give your project the distinctive aged appearance and the rich, classic character that until now, only time -- and the elements -- could provide," do not diminish the deceptiveness of the proposed mark. Rather, the mark must stand on its own. See *In re Budge Mfg. Co.*, 8 USPQ2d at 1261; *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1014-1015 (TTAB 2006) (CAFETERIA deceptive [*12] for "restaurants providing full service to sit-down patrons, excluding cafeteria-style restaurants").

Accordingly, we find the first prong of the Section 2(a) deceptiveness test to be satisfied.

B. Are purchasers likely to believe that the misdescription actually describes the goods?

As noted above, the Examining Attorney introduced evidence to show that copper is a common feature or ingredient of building materials. The following details the popularity of copper:

Copper has earned a respected place in the related fields of architecture, building construction, and interior design.

The history of copper in architecture can be linked to its durability, corrosion resistance, prestigious appearance, and ability to form complex shapes. For centuries, craftsmen and designers utilized these attributes to build aesthetically pleasing and long-lasting building systems.

For the past quarter century, copper has been designed into a much wider range of buildings, incorporating new styles, varieties of colors, and different shapes and textures. Copper clad walls are a modern design element in both indoor and outdoor environments.

Copper's most famous trait is its [*13] display from a bright metallic color to iridescent brown to near black and finally to a greenish verdigris patina ... The metal's distinctive green patina has long been coveted by architects and designers.

Benefits

Corrosion resistance

Durability/Long-life
Low thermal movement
Low maintenance
Lightweight
Ventilation
Radio frequency shielding
Lightning protection
Wide range of finishes
Design continuity
Antimicrobial
Sustainability
Recyclability
Cost effectiveness

(Wikipedia, Office action, April 30, 2014) ²

As just indicated, copper is very desirable for building materials because it is highly durable, corrosion resistant, low maintenance, lightweight, and has a distinctive green patina, which is the choice of architects and designers. An entire industry is developing to provide consumers with less expensive "faux copper." (<decorativeceilingtiles.net>, <delformstudios.com>, Office action, November 19, 2014). Indeed, Applicant's goods mimic the look of weathered copper with the use of less expensive prepainted steel sheets. The following website blog illustrates some differences between real copper and faux copper:

Metal and Copper Roofing [*14] Blog

Our previous blog posts on copper roof look-alikes (Copper Looking Metal Roofing -- Is there a Good Fake? and "Metal Roofs that Look Like Copper Roofs (But Aren't!)" have proven to be quite popular, so we decide to elaborate on the topic once again.

The question of the hour is, can you fake the look of a real copper with another material. I certainly understand why we often receive requests for a metal roof that "looks like copper" but costs considerably less. Considering that a real copper roof can cost as much as \$ 10 to \$ 15 a square foot (compared to finished steel roofs that can cost as little as \$ 1 a square foot), it makes perfect sense that a faux copper roof would have some appeal.

So, with that in mind, is there a good fake? Kind of. There are a big variety of finished (i.e. "painted") metals (mostly steel or aluminum) that have colors which attempt to replicate various stages of the ageing of copper on a roof. With names such as "weathered copper," "antique patina," "dark bronze" and the like, we often get asked for samples of these colors as the labels conjure up some of the cache of a real copper roof.

It's quite amazing how often the receiver of [*15] these samples is disappointed by what they see. Their imagination of what can be done to replicate copper is often far more creative than any finish that can be produced on a mass-production paint line.

(<metalroofnet.com>, Office action, November 19, 2014)

The final paragraph of the blog excerpt highlights our view that, because copper is a common component of building materials, purchasers are likely to believe, based on the mark and the goods at issue, that Applicant's goods [*16] contain "the real thing," namely copper when, in fact, they do not.

² The Board gives guarded consideration to evidence taken from Wikipedia, bearing in mind the limitations inherent in this reference work, so long as the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question. See *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007). In the case before us, the Wikipedia evidence was submitted with the Examining Attorney's initial Office action, and Applicant had an opportunity to rebut it.

We are not persuaded by Applicant's argument that the relevant customers of its goods include home builders, construction experts and professional architects who, Applicant claims, are sophisticated and are not likely to be deceived by Applicant's proposed mark. First, the identification of goods in the present application is not limited as to the channels of trade or the classes of purchasers to whom the goods are sold. Thus, the identification is broad enough to include do-it-yourself consumers or handymen who could purchase the goods at a building supply store such as Home Depot or Lowe's. *See Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160, 163 (TTAB 1983). Second, and in any event, there is no direct probative evidence from the relevant purchasers themselves to support the assertion that these purchasers are not likely to be deceived. The only evidence on this point are two identical declarations, both self-serving characterizations of alleged consumer perception and understanding, without providing any factual basis therefor. One is from David Durham, a Marketing Manager for Applicant, [*17] and the other is from Michael Blake, president of Sheffield Metals, a licensee of Applicant. Messrs. Durham and Blake state, in relevant part:

Applicant licenses a family of trademarks including GALVTEN for "prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered galvanized steel" (see U.S. Reg. No. 4,702,394); COR-TEN AZP for "prepainted coated sheet steel, namely, corrosion-resistant coated sheet steel prepainted to simulate naturally weathered steel (see U.S. Reg. No. 3,331,634); and the captioned COPPER-TEN mark for "prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper."

Consumers for the products described [above] are sophisticated purchasers including home builders, construction experts, and professional architects.

With regard to the family of trademarks described [above], use of the "COPPER" or "GALV" terms, for example, with the "--TEN" element common to each mark indicates to the consumer a visual appearance associated with the product identified by the mark.

Consumers understand that the use of the term "COPPER" in the captioned COPPER-TEN mark indicates [*18] that the product will provide coated sheet steel prepainted to simulate naturally weathered copper as a visual appearance of the product.

Consumers understand that the use of the term "COPPER" in the captioned COPPER-TEN mark does not indicate that the product contains copper metal or is otherwise comprised of copper materials.

The choice of visual appearance of the sheet steel product connoted by the COPPER-TEN mark is merely a personal preference and not a material factor in the consumer's decision to select the COPPER-TEN product to the extent that the consumer understands that the product does not contain copper metal or materials.

(4 TTABVue 15-18)

Again, these declarations fail to rebut the Examining Attorney's showing that purchasers are likely to believe that Applicant's goods sold under the proposed mark COPPER-TEN contain copper.

In view of the above, we find that the second prong of the Section 2(a) deceptiveness test has also been satisfied.

C. Is the misdescription likely to materially affect the purchasing decision of a significant portion of relevant consumers?

Under this prong we look to whether the misdescription is material to consumers' [*19] decision to purchase the goods. *See In re Budge Mfg. Co.*, 8 USPQ2d at 1260. The record is replete with evidence showing that genuine copper is commonly used and highly desirable for building materials. Copper sheets "are popping up everywhere" in home building and remodeling. (<homerenovations.about.com>, Office action, April 30, 2014); and "Steel is one of the most popular types of metal roofing for its high strength and relatively low price ... The major disadvantage of steel is that it can rust ... Copper roofing is beautiful, malleable and soft. It naturally resists corrosion thanks to the verdigris that forms over copper as it weathers ... Copper looks great naturally and doesn't need to be painted. Although copper roofing has a number of desirable aesthetic traits, it is much more expensive than steel roofing." (<armormetalroofing.com>, Office action, April 30, 2014).

Because copper is a commonly used component of building materials, and copper has several important and desirable advantages over other building material components, such as steel, we find that its presence as an

ingredient or feature -- or indeed its absence -- would be material to the decision [*20] of consumers to purchase Applicant's goods. See *In re White Jasmine*, 106 USPQ2d at 1392. Thus, the third and final prong of the Section 2(a) deceptiveness test also has been satisfied.

III. Conclusion

In sum, after reviewing the evidence of record, we find that all three prongs of the deceptiveness test have been satisfied: 1) Applicant's proposed mark COPPER-TEN misdescribes its goods because consumers would understand the COPPER portion, in the context of the goods, to refer to copper, and the goods do not contain copper; 2) due to the common use and popularity of copper as an ingredient or feature of building materials, consumers are likely to believe the misdescription; and 3) due to the several advantages of copper as used for building materials, the misrepresentation will materially affect the decisions of consumers whether to purchase the goods. The Examining Attorney's evidence established a *prima facie* case against registration, and Applicant did not meet its burden to come forward with countering evidence to overcome the refusal. See *In re Budge Mfg. Co.*, 8 USPQ2d at 1260-61.

In view of the above, with the three prongs of [*21] the test satisfied, we find that Applicant's proposed mark is deceptive within the meaning of Section 2(a).

End of Document

Kate Spade LLC v. Wolv, Inc., 2022 TTAB LEXIS 189

Trademark Trial and Appeal Board

April 21, 2022, Hearing; April 25, 2022, Decided

Opposition No. 91241442

Reporter

2022 TTAB LEXIS 189 *

Kate Spade LLC v. Wolv, Inc.

Disposition: [*1] Decision: We dismiss the opposition on all grounds asserted.

Core Terms

SPADE, marks, registration, dilution, watches, consumers, likelihood of confusion, famous, trademark, bona fide intent, fame, Notice, LLC, pleaded, logo, advertising, similarity, commerce, products, brand, media, registered, reproduced, filing date, blurring, factors, dissimilarity, impression, house mark, entireties

Counsel

G. Roxanne Elings of Davis Wright Tremaine LLP, for Kate Spade LLC.

Amit Agarwal Esq. for Wolv, Inc.

Panel: Before Cataldo, Bergsman, and Hudis, Administrative Trademark Judges.

Opinion By:

Bergsman, Marc A.

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Bergsman, Administrative Trademark Judge:

Wolv, Inc. ("Applicant") seeks registration on the Principal Register of the mark WOLV and design, reproduced below, for "wrist watches," in International Class 14.¹

1

Application Serial No. 87672203 was filed on November 4, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's asserted bona fide intention to use the mark in commerce.



The description of the mark reads as follows:

The mark consists of the wording "WOLV" in all capital letters beneath a spade logo. The first letter of "WOLV," "W" is stylized, resembling two letter "Vs" intersecting at the center. There is a stylized letter "W" within the body of the spade logo.

Color is not claimed as a feature of the mark.

Kate Spade LLC ("Opposer") filed a Notice of Opposition ² against the registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (likelihood of confusion), Section 43(c) of the Trademark [*2] Act, 15 U.S.C. § 1125 (likelihood of dilution), and Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (lack of a bona fide intent to use the mark in commerce). ³ Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address two evidentiary matters.

A. Whether Opposer pleaded ownership of Registration No. 4158410.

Opposer, in its Notice of Opposition, pleaded ownership of numerous SPADE Marks consisting of KATE SPADE NEW YORK and design, reproduced below, KATE SPADE, in typed drawing and standard character form, JACK SPADE in standard character form, and a spade design, reproduced below: ⁴

²

Notice of Opposition, 1 TTABVUE. Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry.

³

Opposer also pleaded a false suggestion of a connection claim under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, because Opposer did not refer to the false suggestion of a connection claim in its brief, we consider it waived. *See e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived); *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (opposer's pleaded descriptiveness claim not argued in brief deemed waived); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. [*3] Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (pleaded claims not argued in its brief deemed waived), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

⁴

Notice of Opposition PP 7 and 10 and Exhibit A (1 TTABVUE 27-28 and 34-42). Only a list of Opposer's asserted registrations was attached to the Notice of Opposition, not the registrations themselves or their equivalents that may be obtained from the USPTO's online TESS and TSDR databases.



Specifically, Opposer pleaded ownership of, inter alia, 12 KATE SPADE NEW YORK and design marks, reproduced above, for a variety of goods. However, Opposer did not identify Registration No. 4158410 in the ESTTA cover sheet for the above-noted mark for "ankle bracelets; bracelets; charms, earrings; jewelry; jewelry boxes, jewelry cases; necklaces; pendants; pins being jewelry; rings; watches," in International Class 14. ⁵ [*4]

Opposer included Registration No. 4158410 for the mark KATE SPADE NEW YORK and design for, inter alia, watches, as part of Exhibit A of the Notice of Opposition. ⁶ The Notice of Opposition corresponds to the complaint in a court proceeding. Trademark Rule 2.116(c), 37 C.F.R. § 2.116(c). In addition, the Board views the ESTTA filing form and the Notice of Opposition as comprising a single document or paper being filed with the Board. *See PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) ("Since ESTTA's inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board."). By including Registration No. 4158410 for the mark KATE SPADE NEW YORK and design for goods in International Class 14 in Exhibit A, Opposer put Applicant on notice that it was pleading ownership of that registration. Accordingly, we find that Opposer pleaded ownership of Registration No. 4158410.

B. Whether Opposer's pleaded registrations are of record.

Opposer is under the mistaken impression [*5] that its pleaded registration are automatically of record. In its brief, Opposer stated the following:

In addition to the file history of Opposer's registrations for the SPADE Marks and opposed application for the SPADE Wolv Mark, which are automatically of record pursuant to 37 C.F.R. § 2.122(b)(1). ⁷

However, Opposer's pleaded registrations are not automatically of record pursuant to 37 C.F.R. § 2.122(b)(1).

Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), reads as follows (emphasis added):

The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, **of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed** forms part of the record of the proceeding without any action by the parties and reference

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Registered June 12, 2012; Sections 8 and 15 declarations accepted and acknowledged.

ESTTA -- the Electronic System for Trademark Trials and Appeals -- is the Board's electronic filing system. ESTTA is a web-based application available on the Internet.

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¹ TTABVUE 34.

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Opposer's Brief, p. 1 (64 TTABVUE 9).

may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.

A party that wishes to rely on its ownership of a federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient [*6] to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it. This may be done in a number of different ways. For example,

. A federal registration owned by the plaintiff in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by (a) an original or a photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a copy of information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). [*7] See also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2021).

. A federal registration owned by any party to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by (a) a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current printout or copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a printout or copy of the information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). See also TBMP § 704.03(b)(1)(A).

. Finally, a federal registration owned by any party to a Board inter partes proceeding may be made of record by that [*8] party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).⁸ See also TBMP § 704.03(b)(1)(A).

Opposer did not take advantage of any of the above-noted means of making its pleaded registrations of record. Accordingly, Opposer's pleaded registrations are not of record. However, Opposer did plead common law rights in the marks KATE SPADE house mark, JACK SPADE, and a spade design reproduced below:



6. Founded in 1993 by the award winning designer Kate Spade, Opposer, including its predecessors-in-interest, launched a collection of handbags bearing the now world-renowned KATE SPADE house mark.

7. Opposer has also used and continues to use the trademark JACK SPADE and the following Spade design: (hereinafter referred to as the "SPADE Logo" and collectively with the KATE SPADE house mark and JACK [*9] SPADE trademark referred to herein as the "SPADE Marks").⁹

Thus, Opposer must rely on its common law rights in the KATE SPADE house mark, JACK SPADE, and the spade design mark in the form shown immediately above. See *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (only mark pleaded by opposer and tried was registered design mark and applicant had no notice that opposer intended to rely on use of unregistered word mark appearing on opposer's packaging).

II. The Record

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application. Only Opposer introduced testimony and evidence, and filed a brief.

Opposer introduced the testimony and evidence listed below:

- . Notice of reliance on unsolicited media coverage from publications in general circulation;¹⁰
- . Notice of reliance on Opposer's advertising in publications in general circulation;¹¹
- . Notice of reliance on excerpts from books published by Opposer;¹²
- . Notice of reliance on the discovery deposition of William Hsu, Applicant's sole owner and President;¹³
- . Testimony declaration of Kelly Sandoval, the Vice President of Global Marketing for Tapestry, Inc. Opposer is a wholly-owned subsidiary of Tapestry, Inc.¹⁴

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Notice of Opposition PP 6-7 (1 TTABVUE 28).

¹⁰

37-49 TTABVUE. Opposer referred to the exhibits as "unsolicited advertising" presumably because the exhibits display one of Opposer's products as part of an ensemble and lists the price. However, we find that the evidence is unsolicited media coverage because the exhibits are part of lifestyle articles identifying a variety of different products by different [*10] manufacturers.

¹¹

50 and 52 TTABVUE.

¹²

51 TTABVUE.

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55 TTABVUE. Opposer submitted a condensed version of the deposition with four deposition pages on each sheet. Trademark Rule 2.123(g)(1), 37 C.F.R. § 2.123(g)(1), provides, in pertinent part, "[t]he deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet)."

¹⁴

56 TTABVUE. The Board posted the portions of the Sandoval declaration Opposer designated as confidential at 59-60 TTABVUE.

- . Unsolicited media coverage relating to Opposer's goods under its marks posted on the Internet; ¹⁵
- . Notice of reliance on an unidentified publication by Digital Luxury Group entitled "World Luxury Index Handbags" that purportedly ranks the renown of luxury [*11] handbags; ¹⁶
- . Notice of reliance on Opposer's annual reports; ¹⁷
- . Notice of reliance on photographs of billboard advertisements; ¹⁸
- . Notice of reliance [*12] on a photograph of a banner displaying the mark TAPESTRY outside of the New York Stock Exchange banner; ¹⁹ and
- . Notice of reliance on excerpts from Opposer's website (katespade.com). ²⁰

III. Entitlement to a Statutory Cause of Action. ²¹

Entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671, 210 L. Ed. 2d 833 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82, 211 L. Ed. 2d 16 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co. [*13]*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff

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57 TTABVUE and 58 TTABVUE 2-121.

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58 TTABVUE 123-150. Inasmuch as the document does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the documents for whatever probative value they may have.

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58 TTABVUE 152- 1462. Inasmuch as the document does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). *See also* *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1717-19 (Fed. Cir. 2012). However, because Applicant did not object, we will consider the documents for whatever probative value they may have.

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58 TTABVUE 1464-67. Inasmuch as the exhibit does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the exhibit for whatever probative value it may have.

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58 TTABVUE 1469. Inasmuch as the exhibit does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the exhibit for whatever probative value it may have.

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58 TTABVUE 1471-1519.

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Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting "standing" under §§ 1063 and 1064 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at *4. See also *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1.

Kelly Sandoval, the Vice President of Global Marketing for Tapestry, Inc., Opposer's parent corporation, testified to the following facts:

. Opposer was founded in 1993;²²

. "By the mid-to-late 1990's, [Opposer's] SAM handbag was the "it bag." We reproduce the SAM handbag below;²³



. "Today, the KATE SPADE brand has grown into a global life and style house offering at least 20 product categories in the United States and around the world, including: (i) watches; (ii) wearable tech (fitness trackers and smart watches); (iii) jewelry; (iv) tech accessories (including phone covers, audio, earbuds and headphones, charging devices and small speakers for home); (v) footwear; (vi) sleepwear; (vii) swimwear; (viii) legwear; (ix) loungewear; (x) jackets; (xi) [*14] active wear; (xii) kids apparel and accessories; (xiii) hair accessories; (xiv) fragrances; (xv) home décor (including lighting, bedding, bath and stationery); (xvi) tabletop (including fine china, barware, place settings, casual dining and kitchen items); (xvii) menswear and accessories under the JACK SPADE trademark; (xviii) small leather goods; (xix) bridal; and (xx) and ready-to-wear apparel (including dresses, separates, jackets, outerwear, skirts and pants).";²⁴ and

. "The KATE SPADE trademarks [KATE SPADE house mark, JACK SPADE, and the spade design] have been continuously used and registered in connection with all of [Opposer's] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories, since the debut of the SAM bag in every season of [Opposer's] collections."²⁵

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Sandoval Testimony Decl. P 4 (56 TTABVUE 4).

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Id.

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Id. at P 5 (56 TTABVUE 5).

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Kelly Sandoval's testimony that Opposer has used the KATE SPADE house mark and the spade design in connection with a variety of product categories, including, watches, which marks Opposer asserts are similar to the WOLV and [*15] spade design sought for registration, proves Opposer has an interest falling within the zone of interests protected by the statute.

In addition, Opposer has a reasonable belief in damage that is proximately caused by registration of the mark because Opposer's likelihood of confusion claim is not frivolous. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (plaintiff may establish standing by proving a real commercial interest in its own marks and a reasonable belief that it would be damaged (e.g., a claim of likelihood of confusion that is not wholly without merit)); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112-18 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion); *CPC Int'l, Inc. v. Seven-Up Co.*, 218 USPQ 379, 380 (TTAB 1983) ("[O]pposer established its standing to raise the issue [of nonuse] by proving that its assertion of likelihood of confusion was not wholly without merit.").

[*16] Opposer has established its entitlement to bring this opposition proceeding.

Once a plaintiff proves an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. *See Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing shown on one ground, plaintiff has right to assert any other ground in proceeding); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground).

IV. Priority

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) permits opposition on the basis of ownership of "a mark or trade name previously used in the United States . . . and not abandoned." We now consider whether Opposer has established its priority of use, a necessary element of any claim under Section 2(d).



As discussed above, because Opposer did not introduce its pleaded registrations into the record, it must prove priority by introducing evidence. Opposer must establish proprietary rights in its pleaded common-law marks (i.e., the KATE [*17] SPADE house mark, JACK SPADE, and the spade design) that precede Applicant's actual or constructive use of its involved mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018) (we must determine "whether Petitioner established 'proprietary rights in its pleaded common-law mark that precede [Respondent's] actual or constructive use of its involved mark.'") (quoting *Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017); *Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). In other words, because unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer's burden to demonstrate that it owns a trademark that was used prior to Applicant's first use or constructive use of its mark and not abandoned. *Executive Coach Builders*, 123 USPQ2d at 1180 (citing *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008)).

Applicant's constructive use priority date is November 4, 2017, the date it filed its intent-to-use application to register the WOLV and design mark pursuant to Section 1(b) of the Trademark Act. *See Executive Coach Builders*, 123 USPQ2d at 1180 (citing *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); and *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008)). Applicant did not introduce any

testimony regarding any use prior **[*18]** to November 4, 2017. Therefore, November 4, 2017 is Applicant's priority date.

As noted above, Kelly Sandoval testified that Opposer began using its KATE SPADE mark and the spade design on handbags "[b]y-the mid-to-late 1990's." ²⁶ In addition, Sandoval testified to the following:

. The KATE SPADE trademarks have been continuously used and registered in connection with all of [Opposer's] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories."; ²⁷

. "[Opposer's] continuous use of the  logo since 1993 has the  logo synonymous with the brand."; ²⁸

. "From 2015-2019, [Opposer's] domestic net sales resulting from only KATE SPADE branded watches totaled over [a substantial amount]; ²⁹ and

. From 2009-2019, [Opposer] dedicated [a significant amount of money] to market its goods bearing the KATE SPADE trademarks, which include the **[*19]** distribution of brand imagery, both in film and in print, digital and social media, outdoor advertising, as well as the production of those assets including public relations efforts and fashion events and presentations." ³⁰

Sandoval's testimony is sufficient to prove that Opposer used the marks KATE SPADE and the spade logo prior to Applicant's November 4, 2017 constructive use date. We find that Opposer has proven priority of use in connection with a wide variety of goods, specifically handbags and watches.

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 191 L. Ed. 2d 222, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "In discharging this duty, the thirteen *DuPont* factors 'must be considered' 'when [they] are of record.'" *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and **[*20]** *DuPont*, 177 USPQ at 567). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may

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Sandoval Testimony Decl. P 4 (56 TTABVUE 4).

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Id. at P 8 (56 TTABVUE 6).

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Id. at P 9 (56 TTABVUE 7).

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Id. at P 10 (56 TTABVUE 7). Because Opposer designated its sales figures confidential, we refer to them in general terms.

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Id. at P 15 (56 TTABVUE 8). Because Opposer designated its advertising figures confidential, we refer to them in general terms.

control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

"Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.'" *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004). 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 record evidence but 'may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.'" (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002))).

For the sake of economy, we confine our analysis to the issue of likelihood of confusion between Applicant's mark and Opposer's KATE SPADE mark and the spade design. These are the marks most similar to Applicant's mark. If we cannot find a likelihood [*21] of confusion based on either or both of those marks, we would not find a likelihood of confusion with the JACK SPADE mark. See *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3 (TTAB 2020); *North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its WOLV and design mark on "wrist watches." Kelly Sandoval testified that the KATE SPADE trademarks are used on a wide variety of products.

Today, the KATE SPADE brand has grown into a global life and style house offering at least 20 product categories in the United States and around the world, including: (i) watches; (ii) wearable tech (fitness trackers and smart watches); (iii) jewelry; (iv) tech accessories (including phone covers, audio, earbuds and headphones, charging devices and small speakers for home); (v) footwear; (vi) sleepwear; (vii) swimwear; (viii) legwear; (ix) loungewear; (x) jackets; (xi) active wear; (xii) kids apparel and accessories; (xiii) hair accessories; (xiv) fragrances; (xv) home décor (including lighting, bedding, bath and stationery); (xvi) tabletop (including fine china, barware, place settings, casual dining and kitchen items); (xvii) menswear [*22] and accessories under the JACK SPADE trademark; (xviii) small leather goods; (xix) bridal; and (xx) and ready-to-wear apparel (including dresses, separates, jackets, outerwear, skirts and pants).³¹

The KATE SPADE trademarks have been continuously used and registered in connection with all of [Opposer's] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories, since the debut of the SAM bag in every season of [Opposer's] collections, including:

- a. on packaging, hangtags and store signage;
- b. throughout the <katespade.com> website;
- c. throughout [Opposer's] social media accounts, including Facebook, Instagram, YouTube, Pinterest and Twitter; and
- d. in connection with products, including within print patterns, leather embossing and cutout design details, on jewelry, shoes, hardware in handbags, and on watch faces.³²

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We find Opposer uses the KATE SPADE mark and the spade design on a wide variety of products including jewelry, [*23] shoes, handbags, and watches and, therefore, the goods are in part identical.

B. Established, likely-to-continue channels of trade and classes of consumers.

"[Opposer] sells its products online from its website and in retail stores across the country." ³³ As of 2017, Opposer had 250 retail stores across the country including New York City, Chicago, Los Angeles, San Francisco, Seattle, Washington, D.C., Atlanta, and Disney World in Orlando. ³⁴ Opposer also sells its products to specialty stores, department stores, and online retailers including Bloomingdale's, Nieman Marcus, Macy's, Belk's, Dillard, Zappos and Amazon. ³⁵

Opposer advertises extensively.

Opposer has placed advertisements in over 70 widely

circulated print and digital editions of national publications, such as *Vogue*, *InStyle*, *Marie Claire*, *Vanity Fair*, *Elle*, *Harper's Bazaar*, *Esquire*, *Glamour*, and *W*, since 2012 through the present. In addition, it has placed advertisements in regional magazines such as *New York Magazine*, *Los Angeles Magazine* [*24] and *Ala Moana* in Hawaii. Kate Spade's national marketing campaigns have featured supermodels the likes of Karlie Kloss, Fernanda Ly and Jourdan Dunn and celebrities such as Bryce Howard and fashion icon Iris Apfel. ³⁶

As noted above, Opposer has an extensive presence on social media, such as Facebook, Instagram, Pinterest, Twitter, Tumblr, YouTube, and Snapchat. ³⁷

Applicant is seeking to register its mark for "wrist watches" without any limitations or restrictions as to channels of trade, classes of consumers, or price. Thus, we presume that Applicant's goods move in all channels of trade normal for such goods and that they will be purchased by all potential customers for such goods, including the channels of trade in which Opposer offers its products and the potential customers to whom Opposer offers its products. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *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).

C. The strength of Opposer's KATE SPADE trademark and spade design.

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Sandoval Testimony Decl. P 8 and Exhibits 1 and 2 (56 TTABVUE 5 and 29-48).

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Sandoval Testimony Decl. P 11 (56 TTABVUE 6).

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Sandoval Testimony Decl. P 13 and Exhibit 1 (56 TTABVUE 6 and 29-34).

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Sandoval Testimony Decl. P 13 (56 TTABVUE 6-7).

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Sandoval Testimony Decl. P 17 (56 TTABVUE 8).

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Sandoval Testimony Decl. P 22 (56 and 59 TTABVUE 9). Because Opposer designated as confidential the extent of its social media followers and viewers, we refer to it in general terms.

To determine a mark's strength, we consider its inherent strength, based on the nature of the mark itself, [*25] and its commercial strength, based on its marketplace recognition. 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"); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atlantic 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 Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2022 update) ("The first enquiry is for conceptual strength and 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.").

Commercial strength may be measured indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services [*26] identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

1. Inherent strength

The relevant marks at issue are KATE SPADE and the spade design reproduced below:³⁸



The name Kate Spade and the spade design have no descriptive or geographic meaning when used in connection with the various consumer items on which Opposer uses the marks. Therefore, Opposer's marks are arbitrary marks and inherently strong. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as a "known word used in an unexpected or uncommon way" and observing that such marks are typically strong). See also *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of [*27] protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion).

2. Commercial strength

Opposer pleaded and argued that its KATE SPADE mark and the spade design are famous.³⁹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of

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As we noted above, the solid spade design is the only common law design mark asserted in the Notice of Opposition. Because Applicant was not otherwise placed on notice, Opposer cannot expand upon the common law spade design marks that Opposer made of record or cited in its brief and appendix. See *Riceland Foods*, 26 USPQ2d at 1884.

³⁹

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).

Fame may be measured indirectly by the volume of sales of 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 and 1309. Raw numbers alone may be misleading, however. Thus, some [*28] context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

- . extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;
- . the number of consumers that Opposer solicits through its advertising throughout the year;
- . local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and mentions in national publications;
- . unsolicited media attention; and
- . product placement in television and in movies.

Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

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, Opposer has the duty to clearly prove the fame of its mark. *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)).

In the likelihood [*29] of confusion analysis, "fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

With this framework in mind, we turn to Opposer's evidence of fame.

a. Advertising and publicity

Opposer has spent a substantial amount of money marketing products with the KATE SPADE mark and the spade design over the past ten years.⁴⁰

[Opposer] has placed advertisements in over 70 widely circulated print and digital editions of national publications, such as *Vogue*, *InStyle*, *Marie Claire*, *Vanity Fair*, *Elle*, *Harper's Bazaar*, *Esquire*, *Glamour*, and *W*, since 2012 through the present. In addition, it has placed advertisements in regional magazines such as *New York Magazine*, *Los Angeles Magazine* and *Ala Moana* in Hawaii. Kate Spade's national marketing

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campaigns have featured supermodels the likes of Karlie Kloss, Fernanda Ly and Jourdan Dunn and celebrities such as Bryce Howard and fashion icon Iris Apfel.⁴¹

Like many fashion brands, [Opposer] promotes its new fashion offerings by presenting them in a runway fashion show generally held at least twice a year. These fashion shows are attended by celebrities, such as [*30] Zosia Mamet, Olivia Culpo and Jourdan Dunn and all major fashion media outlets such as *Vogue*, *Refinery29*, *Elle*, *InStyle*, *Fashionista*, *Harper's Bazaar* and *W Magazine*, as well as new media outlets, including bloggers such as Man Repeller and Julia Engel, who have millions of followers on Instagram, Twitter and other channels.⁴²

In addition, Kate Spade often engages in outdoor advertising with the use of billboards in high-density and geographically diverse locations such as the SoHo neighborhood of New York City, the Sunset Boulevard in Los Angeles, Highland Village in Houston Texas, and Charlotte, North Carolina.⁴³

This has undoubtedly driven a significant number of visitors to its website.⁴⁴

Opposer advertises on third party websites, as well as on the major social media platforms, such as Facebook, Instagram, Pinterest, Twitter, Tumblr, and Snapchat.⁴⁵ Opposer's social media platforms have millions for followers.⁴⁶

"[Opposer] has recruited outside agencies to conduct market surveys to measure aided awareness of the KATE SPADE brand -- *i.e.*, the participant giving an affirmative answer when asked if she has heard of KATE SPADE -- and unaided awareness of the KATE SPADE brand -- *i.e.*, the participant names KATE SPADE when asked the first fashion brand that comes to mind. [Opposer] then relies on those surveys to make create [sic] marketing strategy."

⁴⁷ The participants of these market surveys recognize the KATE SPADE brand.⁴⁸

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Sandoval Testimony Decl. P 17 (56 TTABVUE 8). *See also* 50 and 52 TTABVUE.

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Sandoval Testimony Decl. P 19 (56 TTABVUE 8-9).

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Sandoval Testimony Decl. P 20 (59 TTABVUE 9).

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Sandoval Testimony Decl. P 12 (59 TTABVUE 7) (confidential). Because Opposer designated the visitors to its website as confidential, [*31] we refer to the number in general terms.

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Sandoval Testimony Decl. P 22 (56 TTABVUE 9).

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Sandoval Testimony Decl. P 22 (59 TTABVUE 10). Because Opposer designated the number of followers on its social media platforms as confidential, we refer to the number in general terms.

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Sandoval Testimony Decl. P 16 (56 TTABVUE 8).

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As a result of Opposer's advertising and marketing, "Gartner, Inc. and its predecessor L2, Inc. ("L2/Gartner")--the global standard for measuring digital competence by analyzing 1,250 data points across Site & E-Commerce, Digital Marketing, Social Media, and Mobile across different industries--has, since 2011, consistently ranked Kate Spade as one of the top fashion brands." ⁴⁹

Opposer has received numerous awards for the quality of its products and social media presentations. ⁵⁰

b. Sales under the KATE SPADE mark and the spade logo.

From 2009 through 2019, Opposer's domestic net sales of products bearing the KATE SPADE and the spade design have been in the billions ⁵¹ and its domestic net sales for KATE SPADE branded watches have been in the millions. ⁵²

At the end of 2013, Kate Spade had 118 retail stores across the U.S., which had grown to approximately 250 stores by 2017, one of which is located at the Walt Disney World Resort. Today, as Kate Spade shifts to digital platforms to deliver Kate Spade branded products, it retains over [*33] 200 retail shops and outlet stores across the United States. Kate Spade also sells wholesale to specialty stores and major department stores, which have included Bloomingdales, Neiman Marcus, Macy's, Belk's and Dillard's. Kate Spade's third-party retailers sell KATE SPADE-branded merchandise in their retail locations and through their websites. Kate Spade also sells its goods through online retailers, including Zappos and Amazon. ⁵³

c. Actual recognition of the marks

Perhaps the most significant evidence for analyzing fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used. *Cf. TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1104 (TTAB 2018) (quoting *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011)).

The millions of visitors to Opposer's website and other social media platforms evidences widespread recognition of Opposer's marks by a substantial fraction of the United States population. ⁵⁴

"[Opposer] garners [*34] significant media attention, as demonstrated in monthly reports showing mentions in magazines and on digital sites. These mentions include both editorials featuring KATE SPADE branded products, as well as celebrities wearing the KATE SPADE product." ⁵⁵ Opposer introduced numerous lifestyle news articles

Sandoval Testimony Decl. P 16 (confidential). Because Opposer designated the surveys as confidential, [*32] we refer to the results in general terms.

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Sandoval Testimony Decl. P 27 (56 TTABVUE 11).

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Sandoval Testimony Decl. P 28 (56 TTABVUE 12-14).

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Sandoval Testimony Decl. P 10 (59 TTABVUE 7). Because Opposer designated its revenues as confidential, we refer to them in general terms.

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Id.

⁵³

Sandoval Testimony Decl. P 13 (56 TTABVUE 6-7).

⁵⁴

Sandoval Testimony Decl. P 22 (59 TTABVUE 10).

identifying a KATE SPADE product as part of a fashion ensemble.⁵⁶ For example, CNN.com reported that Opposer's products were "the label to buy when one is ready to shift from no-name-brands to designer."⁵⁷

The unsolicited media coverage listed as part of the record demonstrates that the KATE SPADE name is a well-known, commercially strong trademark.⁵⁸ In addition, there is some evidence that fashion writers recognize the spade design as a commercially strong mark. For example (emphasis added),

. Design Rush website (designrush.com)

Kate Spade New York is now a global lifestyle brand that inspires colorful living through their handbags, clothing, jewelry, shoes, stationery, eyewear fragrance, home décor, bedding and gifts. Although the ownership has changed hands, the logo still reflects the originality and creativity of the founder. Their logo design marries the luxury retail space with the company's spirited approach to fashion, commitment to curiosity, and passion for sharing a colorful world.

The logo design is simple, minimal and quirky. It features a small spade -- exactly the same one as the shape found on the suit of spades in a pack of cards. The logo is representative of not just the surname of the brand's founder, but also the label's love of simple shapes and unique designs.⁵⁹

Kate Spade is a classic logo design in the E-commerce & Retail, Fashion & Beauty and Luxury Industries.⁶⁰

. Prestige website (prestigeonline.com) (July 2020)

Going back to its symbol for inspiration, Kate Spade launches its latest Signature Collection

The spade logo is iconic. It is used in various applications in all categories in every season of Kate [*36] Spade's collections. From bold to subtle and through unusual applications, the spade is always present.⁶¹

. Real Simple website (realsimple.com) (February 2019)

Everything is 30% Off at Kate Spade Right Now -- Shop the 8 Bags We're Obsessed With

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Sandoval Testimony Decl. P 29 (56 TTABVUE 14). *See also* 37-49 TTABVUE.

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37-49 TTABVUE.

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57 TTABVUE 22.

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See e.g., CNN Style website (CNN.com) (July 2018) ("Kate Spade the brand ... launched in 1993 and became synonymous with entry-level fashionistas everywhere.") (57 TTABVUE 22). *See the dilution fame analysis for a detailed discussion of the renown of Opposer's marks. [*35]*

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57 TTABVUE 19.

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57 TTABVUE 20.

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57 TTABVUE 26.

From the mind of Kate Spade's creative director Nicola Glass -- who's known for her Kate Spade creations that mold **the brand's signature spade symbol** with unique prints and colors -- comes a beautiful spring collection that we can't get enough of. ⁶²

. Transform Magazine website (transformmagazine.com) (February 2019)

Kate Spade rebrands in pink spades and green shades Fashion house and lifestyle brand Kate Spade has announced a new identity with the launch of its spring 2019 collection blending pink and the **brand's iconic spade**. ⁶³

. Harper's Bazaar Magazine (harpersbazaararabia.com) (April 2019)

What 4 Bazaar Editors Are Buying From Kate Spade This Season

"SS19 is all about pretty pops of colour and there are few better ways to achieve this than with a chic red shoulder bag. I love the contrast of pin and red in the Nicola Twistlock bag and how the **brand's iconic spade symbol** is cleverly [***37**] integrated as the primary motif." -- Connie Chamberlayne, Content Editor ⁶⁴

. SSI Life blog (ssilife.com) (July 2020)

Kate Spade New York Signature Handbag Collection Fall 2020

When Creative Director Nicola Glass first joined Kate Spade in new york [sic] in 2018, she was inspired by the shape of the heart that is found naturally within the spade symbol, the center of the brand's iconography.

Pulling inspiration from the **brand's iconic spade symbol**, we are excited to launch a new collection of handbags for Fall 2020. ⁶⁵

We find that Opposer's KATE SPADE mark and spade logo are very strong marks along the spectrum of from very weak to very strong.

Because the KATE SPADE mark and the spade design are both inherently strong and commercially strong, those marks are entitled to a broad scope of protection.

D. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's*, [***38**] LLC, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F.

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57 TTABVUE 30.

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57 TTABVUE 34.

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57 TTABVUE 36.

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57 TTABVUE 42.

App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 55 C.C.P.A. 903, 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).

In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

"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." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We keep in mind that "[s]imilarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register the mark [*39] WOLV and design reproduced below:



Opposer uses the marks KATE SPADE and the spade design reproduced below:



The marks are similar because they include either a spade design or in the case of the mark KATE SPADE, the word "Spade." However, when we consider Applicant's mark in its entirety, we find the marks are more dissimilar than similar. We find the dominant element of Applicant's mark is the word "Wolv." "In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012)); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because "[t]he word portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Id.* (quoting *Vitterra*, 101 USPQ2d at 1911).


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 on a consideration of the marks in their entireties. *Vitterra* [*40], 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Accordingly, we disagree with Opposer's contentions that (i) because the spade design is a common element, consumers will perceive it to be the dominant feature of the marks,⁶⁶ (ii) because the spade design is above the name Kate Spade in Opposer's mark and the word "Wolv" in Applicant's mark, the spade design is the dominant portion of those marks,⁶⁷ and (iii) "consumers are likely to 'read' what they see, regardless of what the word below the design [WOLV] actually says."⁶⁸ All of these contentions as to how consumers would perceive Applicant's mark comprise mere arguments of counsel without supporting proof. "Attorney argument is no substitute for evidence." *Cai v. Diamond Hong*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

We again point out that Opposer failed to introduce its pleaded registrations into the record and it pleaded ownership of the common law KATE SPADE house mark, not the KATE SPADE NEW YORK and design mark it purportedly registered. The KATE SPADE house mark does not include the spade design and, [*41] therefore, for this additional reason, Opposer's contentions are inapposite.

We also are unpersuaded by Opposer's argument that Applicant intends the spade design to be the dominant element of its mark because Applicant prepared renderings of sample watches that feature the spade logo as a stand-alone mark and ornamentation.⁶⁹ Applicant's spade design is not the subject of the application being



opposed. The mark at issue is  WOLV. We focus our analysis on the mark sought to be registered, not on how Applicant may use the spade design on proposed watches. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993) (indicating that applicant's assertions that the applied-for mark would appear with applicant's house mark were not considered in the likelihood-of-confusion determination); *Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 46 C.C.P.A. 790, 1959 Dec. Comm'r Pat. 210, 120 USPQ 480, 481 (CCPA 1959) ("In determining the applicant's right to registration, only the mark as set forth in the application may be considered"); *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 45 C.C.P.A. 842, 1958 Dec. Comm'r Pat. 222, 117 USPQ 213, 214 (CCPA 1958) ("The fact that each of the parties applies an additional name or trademark to its product is not sufficient to remove the likelihood of confusion.

The right to register a trademark must be determined on the basis of what is set forth in the application rather than the manner in which the mark may be actually used."); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[W]e do not consider how [the parties] actually use their marks in the marketplace, but rather how they appear in the registration[s]. We must compare the marks as they appear in the drawings, and not on any [packaging] that may have additional wording or information."). *Cf. In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1412 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017) ("In considering the similarity between the marks, we must compare Applicant's mark with the cited mark as shown in the registration certificate.").

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Opposer's Brief, p. 21 (64 TTABVUE 29).

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Opposer's Brief, p. 22 (64 TTABVUE 20).

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Opposer's Brief, p. 22 (64 TTABVUE 30).

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Opposer's Brief p. 21 [*42] (64 TTABVUE 29) (citing Hsu Discovery Dep., Exhibits 7, 8 and 12 (55 TTABVUE 107-154 and 192)).



Turning to Opposer's pleaded spade logo, we find Applicant's



logo that consumers will perceive the marks as emanating from the same source despite the inherent and commercial strength of Opposer's spade logo. Because the marks must be compared in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire [*43] marks, not just part of the marks. *DuPont*, 177 USPQ at 567; *Nat'l Data Corp.*, 224 USPQ at 751. *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

That holds true here, where Applicant's composite mark contains the prominent word "Wolv." We would run afoul of the principle that we compare the marks in their entireties were we to ignore the word "Wolv." Even though the design elements of both marks are spade designs, the visual distinctions between the designs along with Applicant's addition of the word "Wolv" create visually dissimilar marks that engender different commercial impressions.

Focusing on the spade designs, Opposer's asserted spade logo is solid black and resembles the spade displayed on playing cards. As noted above, consumers may associate Opposer's spade logo with the Kate Spade's surname. In contrast, Applicant's spade logo is more ornate and is composed of an outline of a spade with a highly stylized letter "W" in the middle that consumers are likely to associate with the word "Wolv."

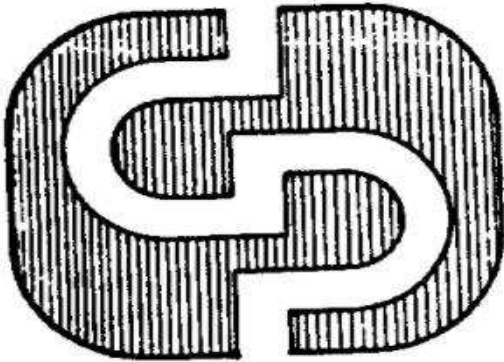
We do not suggest [*44] that purchasers will parse out these features separately, or recall them specifically. We do not place the marks side-by-side in our analysis, but consider the marketplace, the consumer's hazy recollection, and the overall impressions made by each parties' spade design, which we find readily distinguishable. Further, we compare the marks in terms of their overall appearances, pronunciation, connotation and commercial impressions, and conclude that there is no likelihood that consumers will confuse the source of each parties' goods based on the marks. *Cf. In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ reproduced below is not similar to K+EFF reproduced below);



In re TSI Brands, 67 USPQ2d 1657 (TTAB 2002) (AK AMERICAN KHAKIS and design reproduced below is not similar to the stylized letters AK and design);



Georgia-Pacific Corp. v. General Paper Corp., 196 USPQ 762, 772 (TTAB 1977) (the stylized letters GP and design reproduced below is not similar to the stylized letters GP and design reproduced below);

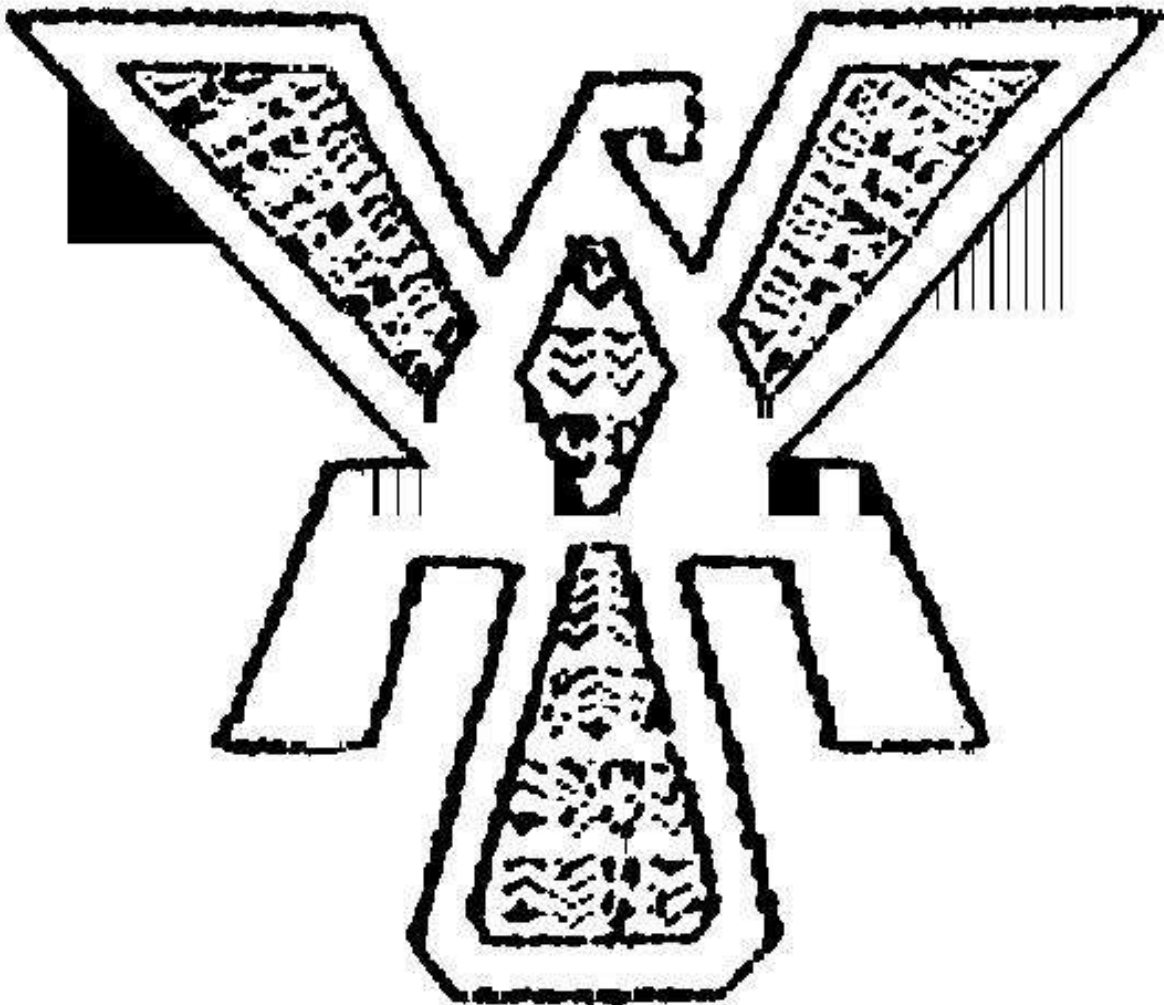




We turn now to the comparison between Applicant's **WOLV** mark and Opposer's KATE SPADE mark. As noted above, the similarity between Opposer's KATE SPADE mark and Applicant's WOLV and design mark is that the design portion of Applicant's mark [*45] is a spade. In some cases, words and pictures that designate the same thing often have similar meanings (word-design equivalency). See *Izod Ltd. v. Zip Hosiery Co.*, 405 F.2d 575, 56 C.C.P.A. 812, 160 USPQ 202, 203 (CCPA 1969) (TIGER HEAD is similar to a tiger design); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (PENGUIN is similar to a penguin design); *Squirrel Brand Co. v. Green Gables Inv. Co.*, 223 USPQ 154, 155 (TTAB 1984) (SQUIRREL BRAND is similar to a squirrel design).

However, as discussed above, when we consider Applicant's mark in its entirety, the dominant portion of the mark is the word "Wolv" and consumers may associate the stylized letter "W" within the spade design with the term "Wolv." The case before us is somewhat similar to *Eagle Clothes, Inc. v. Robert Lewis Inc.*, 165 USPQ 266, 268 (TTAB 1970), where the Board did not find the marks similar considering the differences between the highly stylized bird design sought to be registered,

Applicant's Mark



Registrant's Marks



Silver Eagle



Golden Eagle



We find that the marks are not similar.

E. Conclusion

After considering Opposer's arguments and evidence as they pertain to the relevant *DuPont* likelihood of confusion factors, although the goods are in part identical, we presume the parties will offer the goods in the same channels of trade to the same classes of consumers, and Opposer's marks [*46] are very strong, we find the marks are so dissimilar in their entireties that there is no likelihood of confusion. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (finding that despite the fact the marks were used for the same class of goods and that the goods traveled in the same trade channels and were purchased by the same or similar customers, the mark CRISTAL for champagne and the mark CRYSTAL CREEK for wine differed in appearance, sound, significance, and commercial impression); *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 UPSQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.").

We dismiss the Section 2(d) likelihood of confusion claim.

VI. Dilution

Opposer alleges dilution by both blurring and tarnishment,⁷⁰ but, in its brief, argues only that Applicant's mark is likely to blur the distinctiveness of Opposer's marks.⁷¹ To prevail, Opposer must show that: (1) it owns a famous mark which is distinctive; (2) Applicant is using a mark in commerce which allegedly dilutes Opposer's famous mark; (3) Applicant's use of its mark began after Opposer's became famous; and (4) Applicant's use of its mark is likely to cause [*47] dilution by blurring. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015) (citing *Coach Servs.*, 101 USPQ2d at 1724).

A. Whether Opposer owns distinctive, famous marks for purposes of analyzing Opposer's dilution claim.

There is no dispute that Opposer's KATE SPADE mark and the spade logo are distinctive, both inherently, and commercially as a result of widespread use and consumer recognition. Conceptually, they are coined, arbitrary symbols. Applicant does not dispute that the marks are inherently distinctive.

As for whether the marks are sufficiently "famous" to be entitled to protection against dilution, we must determine whether they are "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." *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting 15 U.S.C. § 1125(c)(2)(A)). By using the "general consuming public" as the benchmark, the TDRA eliminated the possibility of "niche fame," which some courts had recognized under the previous version of the statute. *Coach [*48] Servs.*, 101 USPQ2d at 1724. In assessing fame for dilution, we consider:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.

⁷⁰

Notice of Opposition P 28 (1 TTABVUE 31) ("Applicant's Mark is likely to blur and/or tarnish the positive associations of Opposer's SPADE Marks.").

⁷¹

Opposer's Brief, pp. 27-28 (64 TTABVUE 35-36).

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

15 U.S.C. § 1125(c)(2)(A).

Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. *Coach Servs.*, 101 USPQ2d at 1724. While fame for dilution "is an either/or proposition" -- it either exists or does not -- fame for likelihood of confusion is a matter of degree along a continuum. *Palm Bay*, 73 USPQ2d at 1694 (quoting *Coors Brewing*, 68 USPQ2d at 1063). Accordingly, a mark can acquire "sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame." *Coach Servs.*, 101 USPQ2d at 1724 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007)).

Dilution fame is difficult to prove. *Coach Servs.*, 101 USPQ2d at 1724 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB. 2001) ("Fame for dilution purposes is difficult to [*49] prove."); and *Everest Capital Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 73 USPQ2d 1580, 1585 (8th Cir. 2005) ("The judicial consensus is that 'famous' is a rigorous standard.")).

To establish the requisite level of dilution 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*, 61 USPQ2d at 1180). 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." *Coach Servs.*, 101 USPQ2d at 1724 (quoting *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 72 USPQ2d 1078, 1083 (9th Cir. 2004) (quoting *Thane Int. Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9th Cir. 2002))). Fame for purposes of dilution applies to a select class of marks that are truly renowned.

The party claiming dilution must demonstrate by the evidence that its mark is truly famous. In effect, an owner of a famous mark is attempting to demonstrate that the English language has changed. ... However, to accomplish this successfully, 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 [*50] owner's use of the mark. What was once a common noun, a surname, a simple trademark, etc., is now a term the public primarily associates with the famous mark. To achieve this level of fame and distinctiveness, the party must demonstrate that the mark has become the principal meaning of the word. For example, the mark DUPONT was recognized as a mark that could be protected under the FTDA and would not be treated as merely a surname. H.R. REP. No. 104-374, at 3 (1995) ("[T]he use of DUPONT shoes ... would be actionable under this legislation"). On the other hand, the plaintiff in the *Hasbro* case could not show that the English language had changed, and that purchasers associated the common word CLUE *in the abstract* with the producer of the board game.

Therefore, an opposer relying on the FTDA to provide the broadest protection for its mark against totally unrelated goods, as in this case, must provide evidence that when the public encounters opposer's mark in almost any context, it associates the term, at least initially, with the mark's owner.

Toro, 61 USPQ2d at 1180-81 (internal citation omitted).

We discussed the evidence of fame of Opposer's marks above in our analysis of the commercial strength of Opposer's [*51] marks.

By any and all measures, KATE SPADE is a famous trademark and is entitled to protection against dilution under 15 U.S.C. § 1125(c). However, the renown of the spade logo is not so clear cut. Unlike the WAVE and ACCOUSTIC WAVE marks in *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1306-07, we are faced with a record where virtually every reference to the spade design is joined with a reference to the KATE SPADE word mark. With the exception of a few fashion writers who made note of the spade logo (discussed above) and the products on which

Opposer has used the spade design as ornamentation, Opposer presents consumers little in the way of independent advertising or other promotional materials of the spade design alone. Because Opposer has not introduced evidence presenting consumers with an independent reference to the spade design apart from the KATE SPADE word mark, consumers do not have a basis to disassociate the spade design from the KATE SPADE word mark. *Cf. Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1308 ("[C]onsumer awareness of the product mark apart from the fame of the associated house mark, whether demonstrated directly or indirectly, is a reliable test of the independence of the product mark from its parent house [*52] mark.").

We find Opposer failed to establish that its use of the spade design is as a symbol the public primarily associates as Opposer's famous mark such that it eclipses the common use of a spade design. *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro*, 61 USPQ2d at 1180). In other words, Opposer has not proven its spade design is a "household symbol" such that when the public encounters Opposer's spade design in almost any context, the public associates the spade design, at least initially, with Opposer.⁷²

We therefore find that KATE SPADE is famous for dilution purposes but that the spade design is not famous for dilution purposes. Because the spade design is not famous for purposes of dilution, we continue our dilution analysis only with respect to the KATE SPADE word mark.

B. Whether Applicant is using its WOLV and design mark in commerce.

The second dilution element Opposer [*53] must establish is that Applicant is using its allegedly diluting mark in commerce. The Board has previously held that, under the 1999 amendments to the Federal Trademark Dilution Act, an application based on intent to use a mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), satisfies the "in commerce" requirement. *Toro Co.*, 61 USPQ2d at 1174. *See also N.Y. Yankees P'ship*, 114 USPQ2d at 1505. The Trademark Dilution Revision Act of 2006 (TDRA) does not change this result. *See N.Y. Yankees P'ship*, 114 USPQ2d at 1505-06 (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)).

Because Applicant filed an intent to use application, Opposer has satisfied the second dilution element.

C. Opposer's KATE SPADE mark was famous before Applicant's constructive filing date.

Based on Kelly Sandoval's testimony regarding Opposer's revenues and advertising expenditures and the extensive unsolicited media coverage in magazines in general circulation,⁷³ we find the KATE SPADE mark was famous before the filing [*54] date of Applicant's application, November 4, 2017.

D. Whether Applicant's use of its WOLV and design mark is likely to cause dilution by blurring.

Dilution by blurring is "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B)). It "occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1509.

⁷²

Also, with the exception of the news article at 57 TTABVUE 46-58, the news articles and blogs referring to the renown of the spade design were dated after the November 4, 2017 filing date of Applicant's application. Therefore, it is not clear whether Opposer's spade design was famous for dilution purposes prior to that date. *See* 57 TTABVUE 2-148.

⁷³

The concern is that "the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Nat'l Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). *See also, Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1816 (Fed. Cir.) ("dilution law is intended to protect a mark's owner from dilution of the mark's value and uniqueness"). Blurring may occur "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." [*55] *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)).

To determine whether Applicant's use of its mark is likely to cause dilution by blurring, we consider:

- (i) the degree of similarity between Applicant's mark and Opposer's famous mark;
- (ii) the degree of inherent or acquired distinctiveness of Opposer's mark;
- (iii) the extent to which Opposer is engaging in substantially exclusive use of its mark;
- (iv) the degree of recognition of Opposer's mark;
- (v) whether Applicant intended to create an association with Opposer's KATE SPADE mark; and
- (vi) any actual association between Applicant's mark and Opposer's mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

a. Whether the marks are similar

We "consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression." *N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012)). We must then determine whether Applicant's mark is sufficiently similar to Opposer's as to "trigger consumers to conjure up" Opposer's mark. *Nike*, 100 USPQ2d at 1030 (quoting *Nat'l Pork Bd.*, 96 USPQ2d at 1497). In other words, Applicant's mark must be close enough to Opposer's KATE SPADE mark that consumers will recall the KATE SPADE mark [*56] and be reminded of it "even if they do not believe the goods come from the famous mark's owner." *Nike*, 100 USPQ2d at 1030 (quoting *Toro*, 61 USPQ2d at 1183).

With this background, we now turn to a consideration of the degree of similarity between Applicant's WOLV and design mark and Opposer's KATE SPADE mark in the dilution context. While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists. Also, in determining the similarity or dissimilarity of the marks, "we will use the same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Nike*, 100 USPQ2d at 1030 (quoting *Coach Services*, 96 USPQ2d at 1613).

The same reasoning we used to determine the marks are not similar for purposes of likelihood of confusion applies to our analysis as to whether Applicant's mark is so similar that it trigger consumers to conjure [*57] up Opposer's mark. Specifically, the dominance of the word "Wolv" in Applicant's mark and the ornate spade design featuring a highly stylized letter "W" are so different than Opposer's KATE SPADE mark that consumers viewing Applicant's mark will not call to mind or conjure up Opposer's KATE SPADE mark.

This factor weighs heavily against finding dilution by blurring.

b. Opposer's mark is highly distinctive

Opposer's KATE SPADE mark is highly distinctive. It is a coined, arbitrary mark, highly recognized in fashion circles in the United States. Indeed, as noted above, a KATE SPADE product is one of the first designer products many consumers purchase. Applicant does not dispute that KATE SPADE is highly distinctive.

In any event, "[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding" that the mark has acquired distinctiveness. *N.Y. Yankees P'ship*, 114 USPQ2d at 1507. *See also, Chanel, Inc. v. Makarczyk*, 110 USPQ2d at 2025 ("In any event, the discussion above regarding opposer's extensive evidence of fame of the CHANEL mark used in connection with clothing, fashion accessories, beauty products and boutiques more than sufficiently establishes that [*58] opposer's CHANEL mark has acquired a high degree of distinctiveness among consumers."). This factor weighs in favor of finding dilution by blurring.

c. Opposer use of KATE SPADE is substantially exclusive

There is no evidence that Opposer's use of KATE SPADE is anything other than exclusive. Applicant does not dispute that Opposer's use of the KATE SPADE mark is substantially exclusive.

This factor weighs in favor of finding dilution by blurring.

d. Opposer's KATE SPADE mark is widely recognized in the United States

As we discussed above in the context of the fame of Opposer's KATE SPADE mark, KATE SPADE is widely recognized in the United States. This factor weighs in favor of finding dilution by blurring.

e. Applicant did not intend to create an association with Opposer's KATE SPADE mark

Opposer did not introduce any evidence or argument that Applicant intended to create an association with Opposer's KATE SPADE mark. This factor weighs against finding dilution by blurring.

f. Actual association between Applicant's WOLV and design mark and KATE SPADE mark.

Applicant's application was filed based on its intent to use the WOLV and design mark. There is no evidence that Applicant has made any [*59] use of its WOLV and design mark in commerce. Accordingly, there is no evidence of any actual association between Applicant's WOLV and design mark and Opposer's KATE SPADE mark. This factor is neutral.

g. Conclusion

Although Opposer's KATE SPADE mark is distinctive and widely recognized, and Opposer's use of its KATE SPADE mark is substantially exclusive, the similarities between Applicant's WOLV and design mark and Opposer's KATE SPADE mark are insufficient to support a finding of dilution by blurring in light of the prominence of the word portion of Applicant's mark. *See Citigroup, Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1667 (TTAB 2010), *aff'd on other grounds*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) ("[T]he weight given to each of the statutory factors is dependent upon the evidence introduced into the record. Each factor may vary in weight from case to case depending on the facts. ... Thus, there is no prohibition to giving the statutory dilution factors more or less weight depending on the facts.") (citing *Kellogg Co. v. Pack'em Enters. Inc.*, 21 USPQ2d at 1145).

We dismiss Opposer's dilution claim.

VII. Whether Applicant had a bona fide intent to use its mark when it filed the application at issue.

"A person who has a bona fide intention, [*60] under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register...." Section 1(b)(1) of the Trademark Act, 15 U.S.C. § 1051(b)(1). "A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances." *Boston Red Sox v.*

Sherman, 88 USPQ2d 1581, 1586 (TTAB 2008) (citing *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994)). "Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods [on the filing date of its application]. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to prove that the applicant lacks a bona fide intention to its use its mark in commerce." *Id.* at 1587 (citing *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993)). See also *Spirits Int'l, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1549 (TTAB 2011); *Boston Red Sox Baseball Club*, 88 USPQ2d at 1587. If an opposer establishes a prima facie case, the burden shifts to applicant to rebut that prima facie case by producing evidence which would establish that it had the [*61] requisite bona fide intent to use the mark when it filed its application. See *Commodore Electronics*, 26 USPQ2d at 1507. See also *Saul Zaentz*, 95 USPQ2d at 1727.

The evidentiary bar for showing bona fide intent to use is not high, but more is required than "a mere subjective belief." *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). The objective evidence must indicate an intention to use the mark that is "firm" and "demonstrable." *Id.* In other words, Applicant's evidence bearing on its bona fide intent must be "objective" in the sense that it is evidence in the form of real-life facts and by the actions of the Applicant, not solely by Applicant's uncorroborated testimony as to its subjective state of mind. That is to say, Congress did not intend the issue to be resolved simply by an officer of Applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future." 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:14. See also *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990) ("Nothing in the statute entitles a registrant who has formerly used a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subjective affirmative 'intent not [*62] to abandon.'").

Opposer argues that "Applicant lacked firm and demonstrable plans to use the SPADE Wolv Mark at the time it filed the application." ⁷⁴

Despite four years having passed since filing the Application, Applicant still has not decided on an expense budget, the model(s), types, or movement(s) of watch(es) he wants to manufacture, where he wants to manufacture the watches (China or Switzerland), at what price point he will sell the watches, nor has he retained anyone to design or manufacture the watch. Indeed, Mr. Hsu [Applicant's sole owner and President] testified that he has not taken any stops [sic] pending the outcome of this opposition proceeding. Despite not having the monies to finance the business, Hsu has not sought out investors or other sources of money. Despite not having any training, experience or capacity to run a watch business, Applicant has not sought out any business partners, investors or third parties (other than to render the logo itself). ⁷⁵

Mr. Hsu produced what he claims is a "business plan," which is an undated document that is more accurately described as hopeful assertions, and has no plans for implementation. The "business plan" lacks any real [*63] details that would be included in a credible business plan, such as strategies to build a company operational structure, identification as to sources of product parts, packaging and labeling for Applicant's products, manufacturing and distribution capabilities, or a budget for sales and marketing campaign -- all of which Applicant does not plan to pursue until after securing his trademark registration. ⁷⁶

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Opposer's Brief, p. 29 (64 TTABVue 37).

⁷⁵

Id.

⁷⁶

Id. at p. 30 (64 TTABVue 38).

The testimony of Applicant's Mr. Hsu tells another story. Even though Hsu has no experience making watches, he decided to start a watch company because he is a watch enthusiast.⁷⁷

Q. Why a watch company?

A. I'm a watch enthusiast. I love watches. It's my passion. It's my dream to create a watch company.⁷⁸

Hsu owns five or six watches including two Rolex watches, an Invicta, and a Seiko. He considered selling one of Rolex watches to help fund the project.⁷⁹

Hsu testified about the steps he took to bring his watch company to fruition including documents he created. Hsu testified as follows:

. Etienne Ruffeux, an independent [*64] contractor, designed a watch clasp for Applicant. He also made sketches for a watch case, dials, crown, bezel, bracelet and watch hands. He helped design the logo and made digital renderings of the sketches Hsu approved, and made electronic 3D models;⁸⁰

. Applicant uses the mark at issue as a "thumbnail for my profile picture on Facebook and Instagram";⁸¹

. Within "the last two or three years," Applicant has made a sample box, watch straps, push pins, sample business cards and authentication cards;⁸²

. Within the last "two or three years," Applicant made a "very basic breakdown of the money that I need to manufacture watches,"⁸³ including the cost for a technical study.⁸⁴

In order to begin the manufacturing process and discussions with Roventa Henex, you need to pay for a technical study, which means that they have engineers look over the designs and redesign anything they need

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Hsu Discovery Dep., p. 105 (55 TTABVUE 31).

⁷⁸

Id.

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Id. at p. 71 (55 TTABVUE 23).

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Id. at p. 32 (55 TTABVUE 13).

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Id. at p. 39 (55 TTABVUE 15).

⁸²

Id. at pp. 40-41 (55 TTABVUE 15-16).

⁸³

Id. at pp. 62-72 and Exhibit 4 (55 TTABVUE 21-23 and 92).

⁸⁴

Id. at p. 66 (55 TTABVUE 22).

to design, and that's like the preliminary work that needs to be done, prior to moving forward with manufacturing anything.⁸⁵

[*65] . Within the last "two or three years," Applicant created a "prototype specification detail" for different models of watches so potential watch manufacturers (e.g., Time Star, Roventa Henex, and Walca) can prepare a quote.⁸⁶

Q. So how did you come up with the specifications of each of these styles?

A. These are specifications that I would like to have in the watches that I manufacture.

Q. Are they based on anything else -- did you base them on other types of watches?

A. I would look at some watches and look at my wrist and decide if I wanted larger or smaller sometimes, or, like some items you just can't change. Some items are unchangeable, elements of a watch.

Q. Can you give me some examples of what some of those are?

A. Okay.

If you look at depth rating for a dive watch, to consider a dive watch, it has to be 300 meters depth rating, meaning you could go 300 meters under water without being damaged. The Longitude is not a dive watch, so it doesn't require a 300-meter reading.

For the movements that are being used, Eta 2824-2, the best setting for the best Eta movement is -- has a B error of point 3, and that's the best you can expect in an Eta model. That's something you can't change. **[*66]**⁸⁷

. Hsu Discovery Exhibit 6 comprises "[i]mages of watch renderings and some are images of actual watches or watch parts, and authentication card renderings," Hsu created within the last two or three years;⁸⁸

. Hsu Discovery Exhibit 7 comprises sample authentication cards that Hsu collected within the last two or three years for inspiration;⁸⁹

. Hsu Discovery Exhibit 8 comprises "a group of pages of renderings, designs, sketches, corrections, notes from different stages of designing," Hsu and Etienne created around two years earlier;⁹⁰

⁸⁵

Id.

⁸⁶

Id. at pp. 72-73 and 76 and Exhibit 5 (55 TTABVUE 23 and 93-96).

⁸⁷

Id. at p. 74 (55 TTABVUE 24).

⁸⁸

Id. at pp. 77-84 and Exhibit 6 (55 TTABVUE 24-26 and 97-106).

⁸⁹

Id. at pp. 84-85 and Exhibit 7 (55 TTABVUE 26 and 107-133).

⁹⁰

. Hsu Discovery Exhibits 9 and 10 collectively show "an early rendering of just sketches [Hsu] was making on Photoshop," other watch models prepared two or three years earlier.⁹¹

. Hsu Discovery Exhibit 12 is "a design of a case back, which is the cover for the back of the watch where the movement is inserted, and it's a design that I created [*67] with a little bit of Ettienne's input, and this was a process of him converting it into Adobe Illustrator format to prepare for 3D rendering," prepared two years prior;⁹²

. With respect to the many sketches and design, Hsu testified as follows:

So if you notice, throughout all of these exhibits, there are many watch sketches and designs and many different watch names. So throughout the design process, I've experimented and entertained many, many different variations of designs and movements and names and colors, styles. And so these are all -- these are specifications for just a few of the ones that -- of the designs that I was entertaining.⁹³

. Hsu Discovery Exhibit 14 is "a general business and advertising plan,"⁹⁴ that is a dynamic document that Hsu "added to two or three years ago."⁹⁵

Above, we discussed the type of evidence necessary to objectively support the bona fides of Applicant's intent to use its mark in commerce. The Board also considers when this evidence came into existence. This is important here because [*68] Mr. Hsu testified he created many of the documents within the last two or three years. Applicant filed the application November 4, 2017. Opposer deposed Mr. Hsu November 20, 2019. Because Hsu created documents within the last two or three years, he created them approximately between November 2016 through November 2017.

In addition, once Opposer filed its Notice of Opposition, Applicant's cessation of preparations to use the mark constitutes a sufficient reason to overcome any inference that Applicant did not have a bona fide intent to use the mark at the time it filed the application. *Cf. Cmty. of Roquefort v. Santo*, 443 F.2d 1196, 58 C.C.P.A. 1303, 170 USPQ 205, 208 (CCPA 1971) (applicant's "subsequent decision to hold further activities in abeyance pending the outcome of the opposition appears to be but a reasonable business precaution and does not demonstrate a lack of intention to market the product commercially upon successful termination of the proceeding."); *Visa Int'l Serv. Assoc. v. Life-Code Sys., Inc.*, 220 USPQ 740, 744 (TTAB 1983) (applicant's "decision to hold further activities in abeyance pending the outcome of the opposition does not demonstrate a lack of intention to market services commercially upon successful termination of the opposition."); *Penthouse Int'l, [*69] Ltd. v. Dyn Elecs., Inc.*, 196 USPQ 251, 257 (TTAB 1977) ("[N]onuse of a mark pending the outcome of litigation to determine the right to such use or pending the outcome of a party's protest to such use constitutes excusable nonuse sufficient to overcome

Id. at pp. 88-94 and Exhibit 8 (55 TTABVUE 27-29 and 134-154).

⁹¹

Id. at pp. 94-99 and Exhibits 9-10 (55 TTABVUE 29-30 and 155-188).

⁹²

Id. at pp. 101-102 and Exhibit 12 (55 TTABVUE 30-31 and 192).

⁹³

Id. at p. 100 (55 TTABVUE 30).

⁹⁴

Id. at pp. 112-120 and Exhibit 14 (55 TTABVUE 33-35 and 197-200).

⁹⁵

Id. at p. 117 (55 TTABVUE 34).

any inference of abandonment."). Therefore, Applicant's nonaction subsequent to the May 29, 2018 filing date of the Notice of Opposition is excused.

The particular facts of each case must be carefully considered in their totality, but generally, the strongest documentary proof will have been created prior to, or at the latest on, the filing date of the intent-to-use application. *Cf. Société des Produits Nestlé S.A. v. Cândido Viñuales Taboada*, 2020 USPQ2d 10893, at *12-13 (TTAB 2020) (citing *Swiss Grill*, 115 USPQ2d 2001, 2009-10) (TTAB 2015) (lack of bona fide intent to use found where no documentary evidence predated application filing date)). Documents created seven months after the application filing date have been found relevant to, but not dispositive of, the applicant's intent at the time of filing. *Nestlé*, 2020 USPQ2d 10893, at*13 (citing *Swatch*, 108 USPQ2d at 1474 (nonetheless, the Board ultimately found the applicant's bona fide intent lacking)). Correspondence occurring nine to eleven months after the filing date also has been found sufficiently contemporaneous to corroborate other [*70] evidence regarding the applicant's bona fide intent as of the application filing date. *Nestlé*, 2020 USPQ2d 10893, at*13 (citing *Lane*, 33 USPQ2d at 1356).

In contrast, a long gap between the filing of an application and the activities asserted to demonstrate bona fide intent tends to undercut an inference that the applicant actually had a bona fide intent to use the mark. *Nestlé*, 2020 USPQ2d 10893, at*13. For example, in *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, the Board discounted evidence of Internet searches and investigations conducted more than two years after the application filing date because they "were not even remotely contemporaneous with the filing of the application." *Id.* at 1587-88. *See also Swiss Grill*, 115 USPQ2d at 2009 (applicant's vague claims about communications, meetings, or events which took place one or two years after the filing date, and which did not relate to the mark in question, were found insufficient to show bona fide intent at the time of filing).

In sum, the Board considers the evidence as a whole, and any clear interrelationships that exist between the several pieces of evidence of record, to determine whether the evidence, in its totality, establishes a bona fide intent to use the mark for the identified goods. *Cf. West Florida [*71] Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). Considering the evidence here in its totality, we find that the documents Hsu created and Opposer introduced in his discovery deposition are sufficiently contemporaneous with the filing date of the application to be relevant in determining whether Applicant had a bona fide intent to use the WOLV and design mark at the time Applicant filed its application.

When we consider Hsu's testimony and all the documents introduced in his discovery deposition in its entirety, we find Applicant had a bona fide intent to use the mark in commerce as of the filing date of the application. We assume arguendo that Applicant's business plan standing alone lacks sufficient detail to demonstrate a bona fide intent to introduce watches into the market. The business plan, however, is not the only document going to the question of Applicant's bona fide intent. In addition, Applicant created the following documents:

- . A basic budget for starting the project. The budget includes the estimated costs for manufacturing the watches, watch parts, design costs, and a technical study. It also includes Applicant's potential sources for funding;⁹⁶
- . A "prototype specification detail" for different models of watches so potential watch manufacturers (e.g., Time Star, Roventa Henex, and Walca) can prepare a quote;⁹⁷ and
- . Numerous renderings of watches, watch parts, and other related accessories.⁹⁸

⁹⁶

Id. at pp. 62-72 and Exhibit 4 (55 TTABVUE [*72] 21-23 and 92).

⁹⁷

Id. at pp. 72-73 and 76 and Exhibit 5 (55 TTABVUE 23 and 93-96).

⁹⁸

Id. at pp. 32, 40-41, and Exhibits 6-10 and 12 (55 TTABVUE 13, 15-16, 24-31, 97-188, and 192).

Consequently, the Hsu discovery deposition testimony and accompanying exhibits, taken as a whole, indicate that Applicant had more than subjective hopeful or wishful thinking. Applicant had a rudimentary plan and a reason to believe that it could have watches manufactured to its order and specification and market them in the United States. Considering the totality of the circumstances, the low evidentiary bar, and the objective evidence as it bears on Applicant's subjective intent, this suffices to demonstrate Applicant's bona fide intent to use the mark WOLV and design in commerce.

We dismiss Opposer's claim that Applicant did not have a bona fide intent to use its WOLV and design mark when Applicant filed its application.

End of Document

Manhattan Int'l Trade Inc. v. Industrie IP Pty Ltd. , 2018 TTAB LEXIS 164

Trademark Trial and Appeal Board

May 11, 2018, Decided

Opposition No. 91216270

Reporter

2018 TTAB LEXIS 164 *

Manhattan International Trade Inc. and Pure & Simple Concepts Inc. v. Industrie IP Pty Limited

Disposition: [*1]

Decision: The opposition is dismissed.

Core Terms

marks, registrations, clothing, likelihood of confusion, pleaded, third-party, disclaimed, retail, Register, dilution, purchasers, similarity, amend, weak, goods and services, substantial number, bona fide intent, Trademarks, ownership, Internet, channels, products, segment

Counsel

Thomas D. Rosenwein of Rosenwein Law Group for Manhattan International Trade Inc. and Pure & Simple Concepts Inc.

Bryan M. Friedman and Andrew R. Nelson of Friedman Stroffe & Gerard PC for Industrie IP Pty Limited.

Panel: Before Cataldo, Adlin and Masiello, Administrative Trademark Judges.

Opinion By:

Adlin, Michael B.

Opinion

This Opinion is not a Precedent of the TTAB

Opinion by Adlin, Administrative Trademark Judge:

Industrie IP Pty Limited ("Applicant") seeks registration of the mark shown below

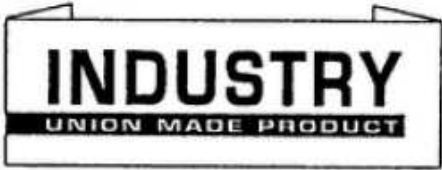


(with FINEST QUALITY GARMENT MAKERS INDUSTRIE, TURN OF THE CENTURY CLOTHING and EST 1999 disclaimed) for: "Clothing, namely, shirts, pants, jeans, coats, jackets, denim pants, denim jackets, denim jeans, swimsuits, athletic trunks, shorts, underwear, socks, t-shirts, dresses, skirts, blouses, coveralls, belts, footwear and headwear" in International Class 25; and "retail clothing store services" in International Class 35. ¹ In their notice of opposition, Manhattan International Trade Inc. ("MIT") and Pure & Simple Concepts Inc. ("PSC") (collectively "Opposers") ² allege prior use and registration of a purported [*2] "family" of marks for clothing which all share the term INDUSTRY, and that use of Applicant's mark would be likely to cause confusion with, and dilute, ³ Opposers' marks, specifically:

¹ Application Serial No. 85881059, filed March 20, 2013 as an intent-to-use application under Sections 1(b) and 44(d) of the Trademark Act, 15 U.S.C. §§ 1051(b) and 1126(d). The basis was subsequently amended to Section 44(e), 15 U.S.C. § 1126(e), based on Australian Registration No. 1546618. The application includes this description of the mark: "The mark consists of the words 'FINEST QUALITY GARMENT MAKERS INDUSTRIE TURN OF THE CENTURY CLOTHING EST 1999' stacked with a line on the outside of 'EST 1999' and the phrase 'TURN OF THE CENTURY CLOTHING'. There is a design line separated by two hammers creating an 'X' between the words 'FINEST QUALITY' and 'GARMENT MAKERS'."

² The notice of opposition in fact refers to one unnamed "Opposer," in singular form, and the ESTTA coversheet for the notice of opposition identifies a single opposer, comprising both MIT and PSC, rather than listing MIT and PSC separately as co-opposers. In any event, there is no question that Opposers filed the notice of opposition jointly, MIT assigned each of Opposers' pleaded marks and registrations to PSC while this case was pending (Reel/Frame 5802/0974), and we hereby join PSC as a plaintiff/co-opposer.

³ The ESTTA coversheet for the notice of opposition asserts that the grounds for opposition also include deceptiveness and false suggestion of a connection. However, the allegations in the notice of opposition, including those in Paragraph 7 thereof, do not state a claim under either ground. *Cf. Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008) (false suggestion) and *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1313 (TTAB 1990) (deceptiveness). Opposers did not pursue these claims, they were waived, and have not been considered.




<u>Reg. No.</u>	<u>Mark</u>	<u>Goods</u>
2118102	INDUSTRY BY WORK WEAR (typed) (WORK WEAR disclaimed)	all mens, women's, boys' and girls' wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats ⁴
2326074	 (UNION MADE PRODUCT disclaimed)	All men's, women's, boys' and girls' wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats ⁵
2403592	INDUSTRY GIRL (typed) (GIRL disclaimed)	All Women's and girls' wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats ⁶

4, 5, 6

⁴ Issued December 2, 1997; renewed.

⁵ Issued March 7, 2000; renewed.

⁶ Issued November 14, 2000; renewed.

Reg. No.	Mark	Goods
2446522	 <p>(SUPPLY CO. disclaimed)</p>	All men's, women's, boys', girls' and children's wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats ⁷
2723120		men's, women's, boys', girls' and children's wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing and lingerie, together with all accessories, namely, belts, socks, ties, caps and hats ⁸
2859863		All men's, women's, boys', girls' and children's wearing apparel namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing, underwear, lingerie, brassieres, panties, hosiery, pantyhose, camisoles, sleepwear, and footwear, together with all accessories, namely, belts, socks, ties, caps and hats ⁹

7 8, 9

In its answer, Applicant denies the salient allegations in the notice of opposition and asserts a number of "affirmative defenses" which it did not pursue or prove at trial and which are accordingly waived. *Miller v. Miller*, 105

⁷ Issued April 24, 2001; renewed.

⁸ Issued June 10, 2003; renewed.

⁹ Issued July 6, 2004; renewed.

USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. Am. Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

[*3] [*4]

I. Motion to Amend

Even though their only properly pleaded claims are likelihood of confusion and dilution, Opposers assert in their Trial Brief, for the first time, that an additional issue to be decided is whether Applicant had a bona fide intention to use its mark at the time it filed the involved application. 23 TTABVUE 8, 18-20. In its Trial Brief, Applicant "objects" to consideration of a claim of no bona fide intent to use because it was not pleaded or tried by implied consent. 24 TTABVUE 12. In response, on the same day they filed their Trial Reply Brief, Opposers for the first time filed a motion for leave to amend the notice of opposition to add a claim of no bona fide intent to use, and that motion is now contested. 28-30 TTABVUE.

The motion for leave to amend is denied. It is much too late, coming almost four months after the trial ended, and after briefing was complete. *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1486-87 (TTAB 2007) **[*5]** (denying motion for leave to amend to add claim of no bona fide intent to use filed four days after trial ended, in large part because "applicant has had no opportunity to present evidence on this issue to refute or explain the testimony on which opposer relies in support of this ground"). In any event, the basis for the proposed new claim is Opposers' own (Mr. Rozenwald's) testimony, regarding a trade show that took place at least eight months before Opposers filed their motion for leave to amend, and prior to trial. 14 TTABVUE 473-74 (Rosenwald Tr. 24-28). Opposers' delay in seeking leave to amend is neither explained nor excusable in the face of the prejudice Applicant would suffer if the amendment was allowed. *Black & Decker Corp.*, 84 USPQ2d at 1486-87. Indeed, the trial is over. Furthermore, as Applicant points out, the alleged facts on which the proposed new claim is based occurred well over one year after Applicant's filing date, and according to Opposers themselves, do not even relate to the mark in question. That Applicant used a mark which Opposers allege is not the same as the involved mark well over a year after filing the application to register the involved **[*6]** mark is irrelevant to whether Applicant had a bona fide intention to use the involved mark more than a year earlier.¹⁰

II. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Applicant's involved application. In addition, Opposers introduced:

A Notice of Reliance ("NOR") on: their pleaded registrations and the file histories therefor; two of Applicant's uninvolved and abandoned applications to register marks including forms of the term INDUSTRY; the testimonial deposition of Ted Rozenwald, President of both Opposers, and the exhibits thereto; Opposers' initial disclosures and answers to Applicant's interrogatories;¹¹ and a Baptist World Aid Australia document entitled "The Australian Fashion Report 2015 The Truth Behind the Barcode." 14 TTABVUE.¹²

A "Supplemental" NOR¹³ on: Applicant's written responses to Opposers' **[*7]** interrogatories and document requests. 21 TTABVUE.

¹⁰ Opposers point to no evidence that the issue was tried by implied consent, and the record reveals it was not.

¹¹ Interrogatory responses may be introduced only by the "inquiring party." Trademark Rule 2.120(k)(5). Therefore, Opposer's responses to Applicant's interrogatories have been given no consideration.

¹² Applicant's objection to this Report, 24 TTABVUE 11, is sustained. The document is not self-authenticating, was not authenticated and constitutes hearsay. *Cf.* Trademark Rule 2.122(e) and *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031 (TTAB 2010). Even if we had considered the report, it would not change the outcome of this case.

¹³ While it is not clear whether Opposers intended this NOR to be part of their case in chief (in which case it was late-filed after the September 9, 2015 close of Opposers' testimony period), or to be part of their rebuttal (in which case it was prematurely

Applicant introduced:

NOR No. 1 on third-party registrations. 17 TTABVUE.

NOR No. 2 on Opposers' written responses to Applicant's document requests; and e-mails between Opposers and Applicant. 18 TTABVUE. ¹⁴

NOR No. 3 on one of Applicant's uninvolved registrations. 19 TTABVUE.

NOR No. 4 on Internet printouts. 20 TTABVUE.

[*8]

III. Standing and Priority

Opposers' pleaded registrations, 14 TTABVUE 2-453, establish their standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Because Applicant has not counterclaimed to cancel any of Opposers' registrations, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); **[*9]** *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See 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."). Opposers bear the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence or argument, and treat the remaining factors as neutral.

A. The Goods and Services

The parties' goods, including shirts, pants and many other items of clothing, are in-part identical. While Applicant's retail clothing store services are not identical to Opposers' clothing products, retail clothing stores and the clothing sold therein are obviously quite closely related. It is settled that retail store **[*10]** services may be related to the goods sold therein. *See e.g. In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGGS for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (finding "that consumers would be likely to believe that jewelry on the one hand and retail stores selling jewelry on the other emanate from or are sponsored by the same source if such goods and services are sold under the same or similar marks"); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (finding "that store services and the goods which may be sold in that store are related goods and services"). This factor weighs heavily in favor of finding a likelihood of confusion.

Moreover, because the goods are in-part identical, we must presume that the channels of trade and classes of purchasers for the goods are as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this **[*11]** legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Associated*

filed), it could have been introduced during Opposers' rebuttal period. Because Applicant failed to object to this evidence, we have considered it. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991).

¹⁴ The e-mails are not self-authenticating, were not authenticated and constitute hearsay. *Cf. Trademark Rule 2.122(e)*. Therefore, we have not considered them.

Charities Inc. v. Child Health Research Institute, 101 USPQ2d 1022, 1028 (TTAB 2011). And Applicant's retail clothing stores could obviously be a potential channel of trade for Opposers' clothing.

The legal identity of the goods, close relationship of the goods and services, and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Vittera*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

B. Opposers' Alleged Family of Marks

Opposers allege that they own a "family" of marks for clothing products, each of which includes the term INDUSTRY. 23 TTABVUE 14-16.

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates [*12] not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.... Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991) (internal citations omitted). More specifically,

in order to establish ownership of a family of marks it must be shown by competent evidence "first, that prior to the entry into the field of the opponent's mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create [*13] public recognition coupled with an association of common origin predicated on the 'family' feature; and second, that the 'family' feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark)."

Marion Labs. Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215, 1218-19 (TTAB 1988) (quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)). See also *TPI Holdings Inc. v. Trailertrader.com LLC*, 126 USPQ2d 1409, 1420 (TTAB 2018).

Here, the substantive entirety of Opposers' argument that they own a family of INDUSTRY marks is as follows: "Opposers promote the family as shown by the dedicated websites (manhattaninc.com and the branded website at industryclothing.com) and marketing efforts via representatives, trade shows and the like, as fully testified to by Opposers' president. (Rozenwald Dep. pp. 16-22)." 23 TTABVUE 16. The only portions of the cited testimony which reference use of multiple INDUSTRY marks follow:

24 Q Yes. How are the marks used in

Page 15

1 connection with the apparel for which the
2 registrations are claimed?
3 A There's a main label in the garment
4 in the neckline, there is a logo on the garment
5 itself on the front of the garment, and there is a
6 hangtag on the garment; all of which have the word
7 Industry.
8 Q And do the hangtags reflect the
9 various marks, the five different marks?
10 A Yes, they do.
11 Q And is that also true for the label
12 that's on the back of the item?
13 A The label in the garment, the
14 branding on the garment, and the hangtag are all
15 consistent with the trademark.
16 Q Okay. And are the marks shown --
17 other than on the goods themselves -- are they
18 advertised or displayed in other areas? Other
19 venues?
20 A Yes, they are.
21 Q What venues or areas are they
22 displayed?
23 A Trade show use. We participate in
24 many trade shows throughout the year. Social

Page 16

1 media activity. Branding within the retail
2 environment. Signage. Point of purchase
3 material, and others.
4 Q Is there any display of the mark with
5 respect to any websites on the Internet?
6 A Yes.
7 Q How does that work?
8 A There are various websites that sell
9 the product. There is a brandcentric website that
10 is specific to the Industry mark.
11 Q Is there a website for Manhattan
12 International Trade Company?
13 A Yes, there is.
14 Q And then on site, is there displays
15 of Industry marked merchandise?
16 A Yes, there is.
17 Q And the website that you say that is
18 brandcentric for Industry, do you know what the
19 URL is for that website?
20 A Industryclothing.com.
21 Q Are there any other social media
22 sites that your company either in the Manhattan
23 Company or the Pure & Simple company use to
24 identify and market your goods? For example,

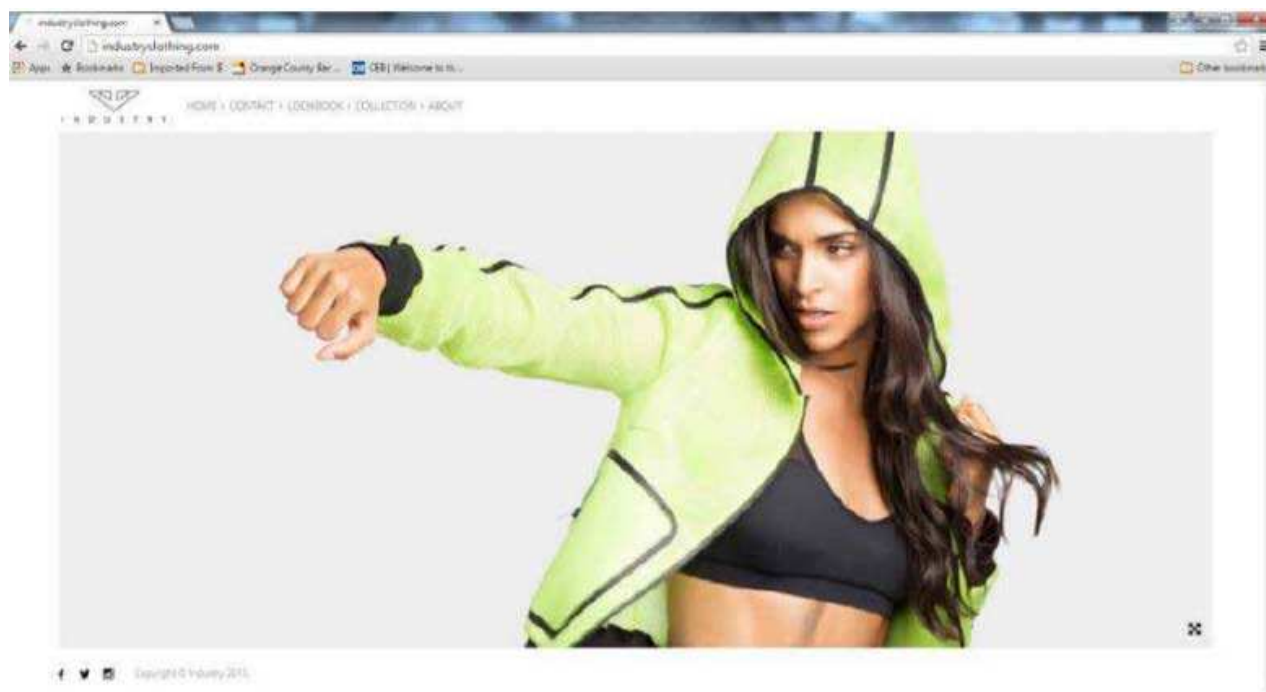
Page 17 [*14]

14 Q Now, when you say a corporate
15 showroom in New York, which corporation does that
16 involve?
17 A Manhattan International.
18 Q And where is that located in New
19 York?
20 A 214 West 39th Street, Suite 802.
21 Q How long has that corporate showroom
22 been in existence?
23 A Approximately 12 years.
24 Q And product that displays one or more

Page 19

1 of the Industry marks that you've identified are
2 displayed at that New York corporate showroom?
3 A Yes.

from clear whether "at least a substantial number of" the pleaded INDUSTRY marks "were used ... together" on any particular item of clothing, or whether only one mark was used on each item of clothing. Furthermore, there is absolutely no testimony or other evidence that any of the pleaded INDUSTRY marks used on hangtags, labels, "branding" or elsewhere were "promoted together," much less "in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature." *Marion Labs.*, 6 USPQ2d at 1218. Similarly, the testimony about "trade shows," "social media," "branding within the retail environment" and Internet use does not address whether "at least a substantial number" of the specific, pleaded INDUSTRY marks were used together, or promoted together, during trade shows, on social media or the Internet or in the retail environment. **[*15]** The only evidence of record regarding Opposers' websites ¹⁵ does not show use of multiple INDUSTRY marks:



URL: <http://industryclothing.com/>

Date and time accessed: 11/06/2015 at 1:33 PM

20 TTABVUE 5. In short, if "at least a substantial number" of the pleaded INDUSTRY marks were used together in a "corporate showroom," on clothing, in social media or elsewhere, this is not clear from the record, nor is there any evidence that a substantial number of the pleaded INDUSTRY marks were promoted together. There is no evidence of public recognition, or "an association of common origin" predicated on the shared term INDUSTRY.

[*16]

Neither Opposers' mere intention to create a family of marks, nor their ownership of multiple registrations containing the family term, are sufficient in and of themselves to establish that Opposers own a family of marks. *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978); *Consol. Foods Corp. v. Sherwood Med. Indus. Inc.*, 177 USPQ 279, 282 (TTAB 1973); *Witco Chem. Co., Inc. v. Chemische Werke Witten G.m.b.H.*, 158 USPQ 157, 160 (TTAB 1968). In fact, where a party arguing that it owns a family of marks fails to introduce testimony or other

¹⁵ Mr. Rozenwald mentioned two website URLs during his testimony, but this is not sufficient to make the websites of record. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1488 n.59 (TTAB 2017); *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1458 (TTAB 2004) ("Information on websites is transitory and subject to change at any time at the owner's discretion.").

evidence on the specific question of whether consumers recognize the family, the party is typically unable to prove ownership of a family of marks. *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 186 (Fed. Cir. 1984) ("Colony failed to establish, for example by a survey, that the term HOBO is used by the public in connection with restaurant services to identify Colony exclusively"); *White Heather Distillers Ltd. v. The American Distilling Co.*, 200 USPQ 466, 470 (TTAB 1978) ("not one shred of evidence has been submitted by opposer [*17] to show that the marks claimed to comprise the 'family' or any distinctive feature of such marks have become known to the relevant segment of the purchasing public as a result of sales and promotional activities so as to create common exposure, and hence an association of common ownership"); *Am. Standard*, 200 USPQ at 461; *Champion Int'l Corp. v. Plexowood, Inc.*, 191 USPQ 160, 162 (TTAB 1976) ("There is nothing in evidence to show the nature and extent of use of opposer's other 'FLEX' prefixed marks ... much less that the various marks ... have become familiar or known to the relevant segment of the purchasing public This purchaser recognition factor, the salient consideration necessary to achieve a 'family of marks', is noticeably lacking in this case."). See also *Gen. Cable Corp. v. Republic Wire and Cable Corp.*, 327 F.2d 1019, 51 C.C.P.A. 1035, 1964 Dec. Comm'r Pat. 356, 140 USPQ 487, 489 (CCPA 1964).

Furthermore, evidence must establish the *extent* of public exposure to the alleged family. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1194 (TTAB 2007) ("None of this material is evidence of public exposure to the marks, or in any event, of the extent [*18] of public exposure to such marks."). Evidence must also establish that Opposers' use of a substantial number of pleaded INDUSTRY marks "create the commercial impression that [INDUSTRY] is the common feature of a family of trademarks." See *Christian Broad. Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1566 (TTAB 2007). It is not enough to merely use INDUSTRY with additional terms, such as GIRL, UNION MADE PRODUCT or SUPPLY CO. Rather, Opposers must show that their INDUSTRY marks will be recognized as commonly owned because of that term. *Eveready Battery Co., Inc. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009).¹⁶

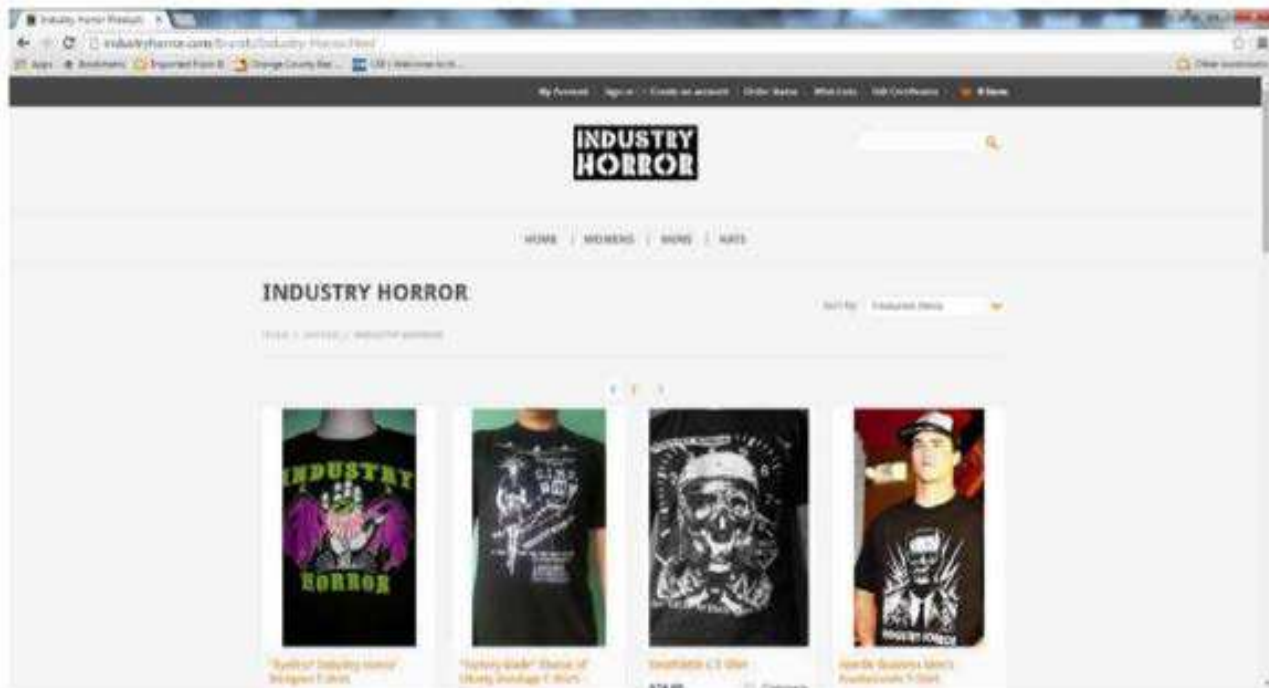
[*19]

Finally, as discussed immediately below, the alleged family term, INDUSTRY, is conceptually and commercially weak for clothing. This reduces the likelihood that even vigorous promotion would result in the requisite customer recognition. *TPI Holdings*, 126 USPQ2d at 1428 ("we find --TRADER formative marks are so commonly used by others that the shared --TRADER element in Petitioner's marks does not constitute a distinguishing feature. Petitioner cannot lay claim to a family of marks based on the common trait in its marks, despite the evidence showing Petitioner's efforts to establish such a family of marks"); *Marion Labs.*, 6 USPQ2d at 1218; *Am. Standard*, 200 USPQ at 461-62 ("it is obvious that the nature and character of the claimed 'family' feature must be considered in this evaluation for a 'family' concept is bottomed on recognition of the common feature as the distinguishing feature of each mark; and a descriptive or highly suggestive portion of a composite mark is hardly likely to be the significant and origin-indicating feature"); *Witco Chem.*, 158 USPQ at 160. See also *Servo Corp. of Am. v. Servo-Tek Prods. Co., Inc.*, 289 F.2d 955, 48 C.C.P.A. 978, 1961 Dec. Comm'r Pat. 380, 129 USPQ 352, 353 (CCPA 1961). [*20]

C. The Relative Strength of Opposers' Pledged Marks

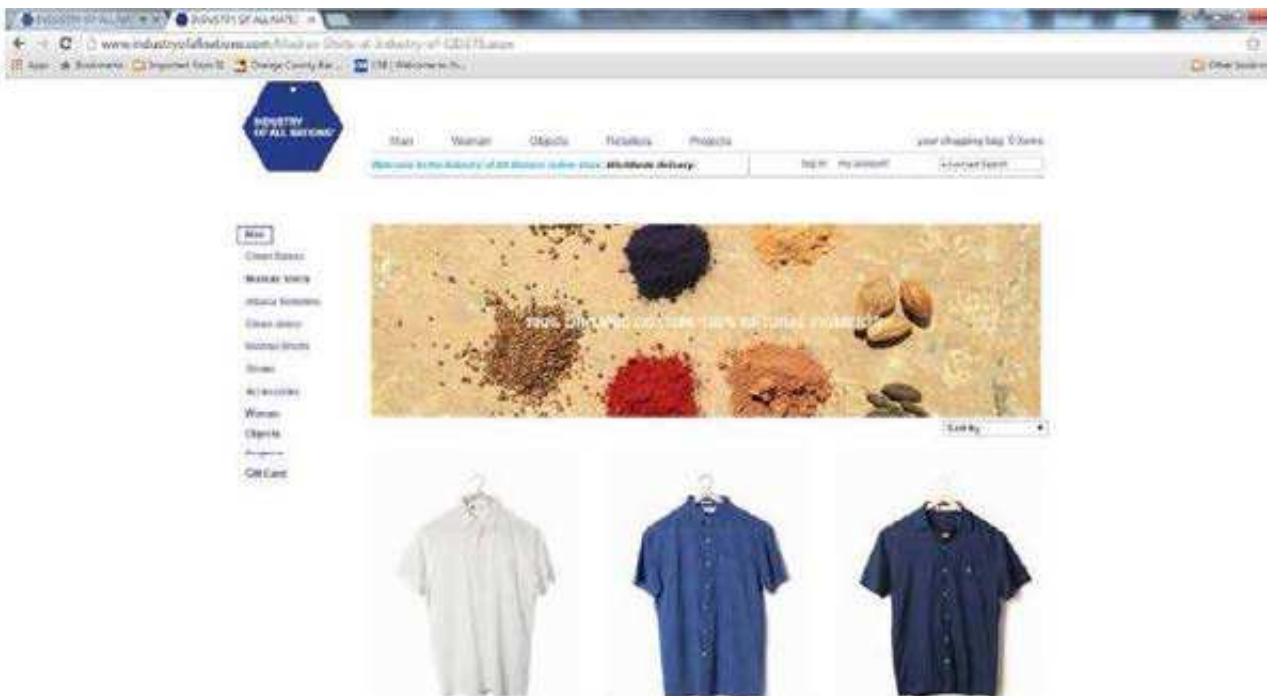
Opposers allege not just that their pleaded INDUSTRY marks are strong, but that they are famous for purposes of dilution. The evidence is to the contrary; Opposers' marks are relatively weak, conceptually and commercially. Indeed, Applicant has established that third-party marks and trade names including variations of the term INDUSTRY are commonly used for clothing products which fall within the parties' identifications of goods. For example:

¹⁶ Even in cases where the owner of multiple marks with a shared feature has significantly higher sales than Opposers in this case, the failure to provide evidence of consumer recognition of the alleged "family" of marks, or promotion of the members of the family together, generally results in a finding that ownership of a family of marks was not established. 14 TTABVue 475-76 (Rozenwald Tr. 32-33); *Polaroid Corp. v. Am. Screen Process Equip. Co.*, 166 USPQ 151 (TTAB 1970); *Moore Bus. Forms, Inc. v. Roger-snap Bus. Forms, Inc.*, 163 USPQ 303 (TTAB 1969); *Witco Chem.*, 158 USPQ at 157.



URL: <http://industryhorror.com/brands/Industry-Horror.html>

Date and time accessed: 11/06/2015 at 10:09 AM



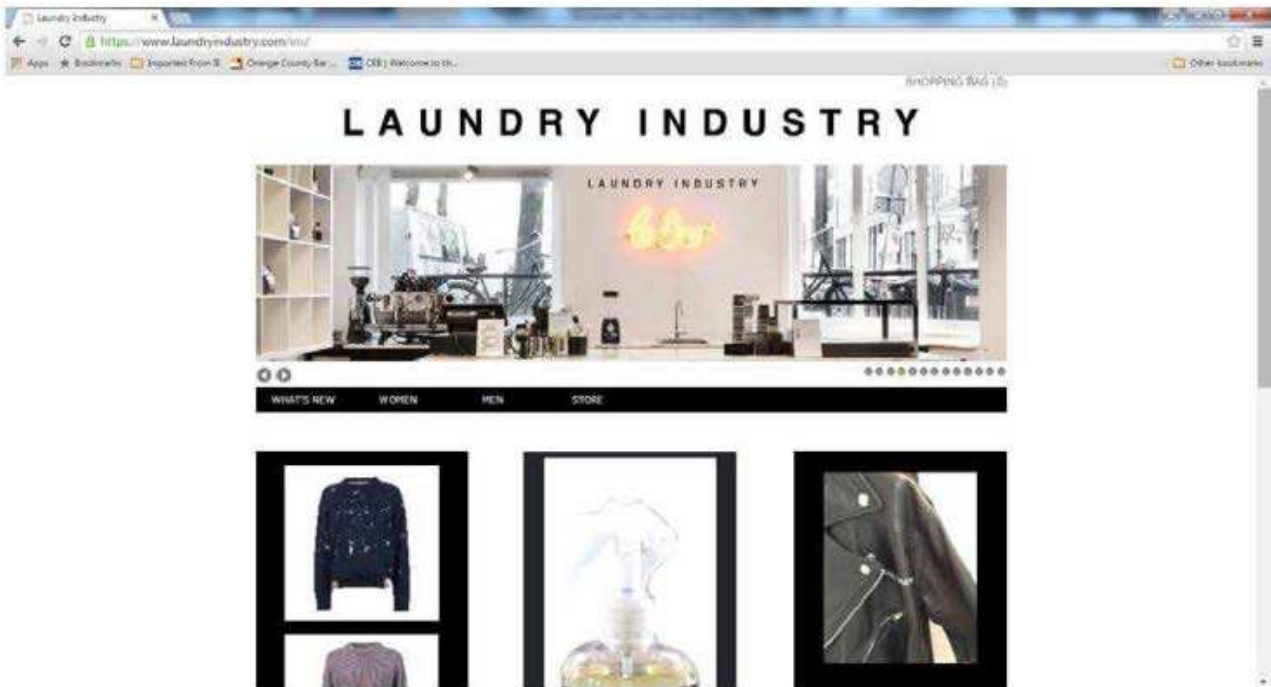
URL: <http://www.industryofallnations.com/Madras-Shirts-at-Industry-of-CID275.aspx>

Date and time accessed: 11/06/2015 at 10:25 AM



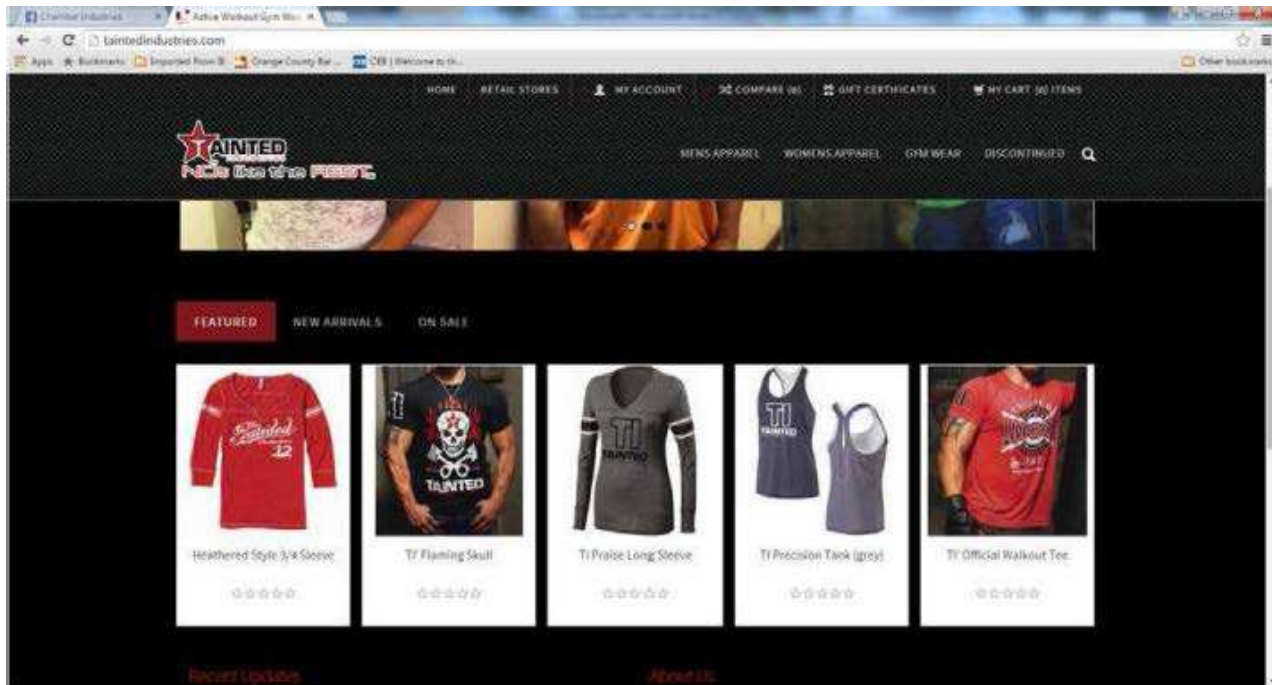
URL <http://www.alphaindustries.com/>

Date and time accessed: 11/06/2015 at 10:47 AM



URL: <https://www.laundryindustry.com/en/>

Date and time accessed: 11/06/2015 at 10:37 AM

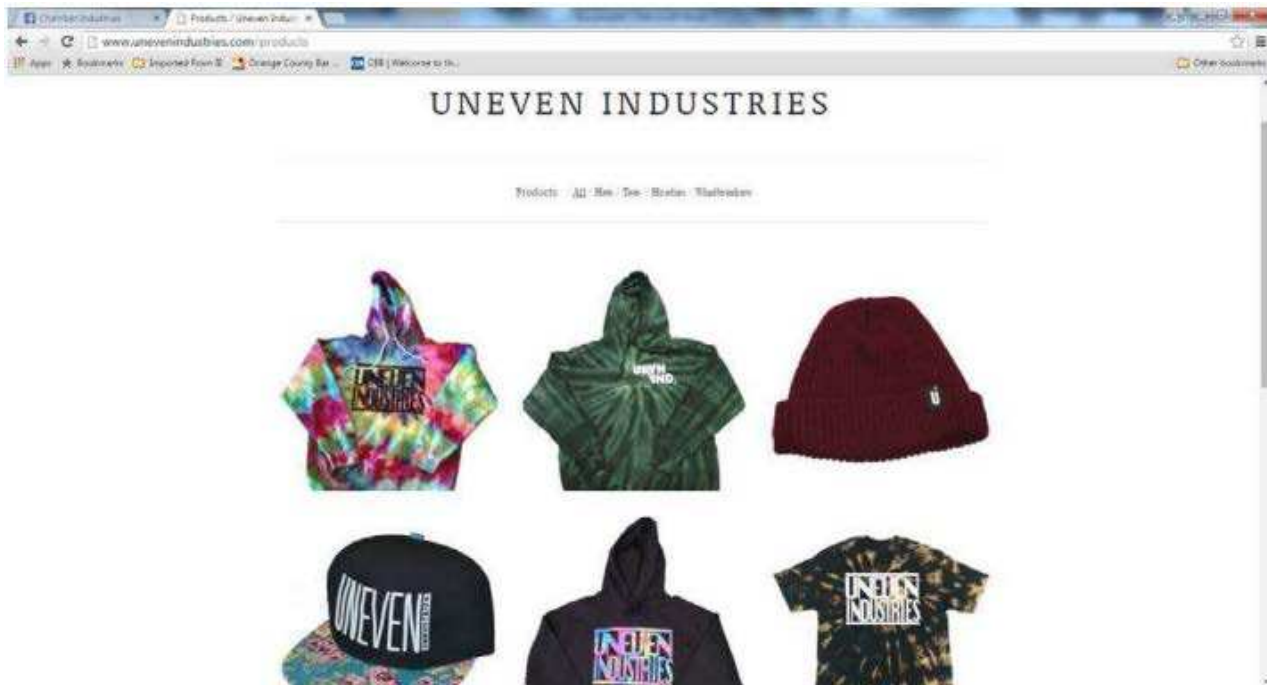


URL: <http://taintedindustries.com/>

Date and time accessed: 11/06/2015 at 10:52 AM



URL: <http://addictedindustries.com/collections/menstees>

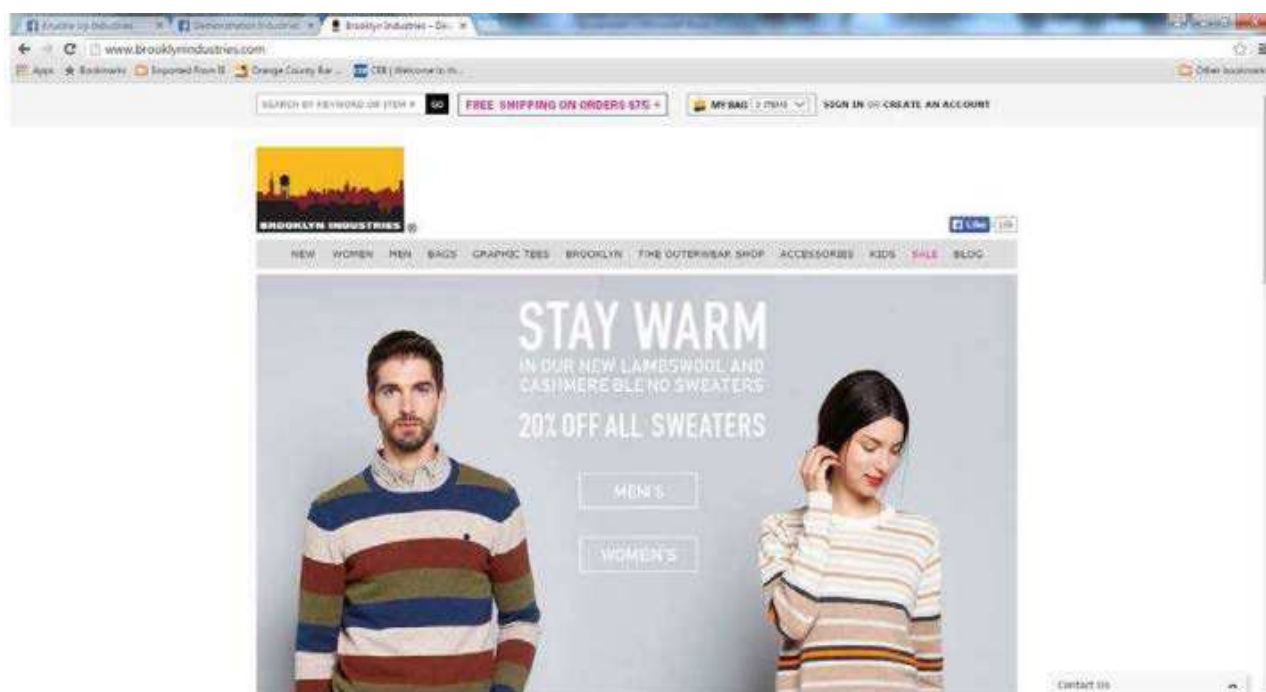


URL: <http://www.unevenindustries.com/products>



JRL: <http://b-o-xindustriesclothing.com/>

Date and time accessed: 11/06/2015 at 11:06 AM



URL: <http://www.brooklynindustries.com/>

Date and time accessed: 11/06/2015 at 11:19 AM

20 TTABVUE 7, 9-14, 16, 18.

While Applicant has not presented specific evidence concerning the extent and impact of these uses, it nevertheless presented "evidence of these marks being used in internet commerce for clothing." *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); **[*21]** see also *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (Internet printouts "on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein"). We find this evidence "powerful on its face. The fact that a considerable number of third parties use similar marks was shown," *Juice Generation, Inc. v. GS Ents., LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015), and Opposers did not contradict this showing with evidence. See also *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1155 (TTAB 2012); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996) ("Evidence of widespread thirdparty use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field."); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987).¹⁷







[*22]






Applicant also introduced a large number of third-party use-based Principal Register registrations of INDUSTRY marks for clothing products identical to or encompassed by those identified in Opposers' pleaded registrations,¹⁸ including:









¹⁷ Opposers' sales of "Industry branded" goods, while not insignificant, are at the same time not sufficient to establish fame or strength. 14 TTABVUE 475-76, 496 (Rozenwald Tr. 32-33, 114). Moreover, to the extent Opposers provided specific figures, they are not broken down by particular mark or particular goods, and we therefore have no information about the levels of sales or advertising of the goods sold under any of Opposers' particular pleaded marks.






<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>
 inner city industry	3755031	CAPTAINS OF INDUSTRY	3686552
COTTAGE INDUSTRY	4037356	INDUSTRY 654	3576883
INDUSTRY WHORE	4531643	LAUNDRY INDUSTRY	1969126
305 INDUSTRY (INDUSTRY disclaimed)	4267801	INDUSTRY XPERIENCE (INDUSTRY disclaimed)	4793878
POUND SAND INDUSTRY	4068398	STARK INDUSTRIES	4820547

¹⁸ Several of the third-party registrations appear to be for marks shown to be in use by Applicant's Internet evidence.

<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>
INDUSTRY 9	4238133	SALATHIEL'S DIRTY WHITE INDUSTRIES (INDUSTRIES disclaimed)	4809174
INDUSTRY HORROR	4341474	MISLED INDUSTRIES (INDUSTRIES disclaimed)	4805085
CHALC INDUSTRY (INDUSTRY disclaimed)	3073119	 (INDUSTRIES disclaimed)	4835814
	3826429	HOMEGROWN INDUSTRIES (INDUSTRIES disclaimed)	4761209
REPLICA INDUSTRY	3871671	 (INDUSTRIES disclaimed)	4717560
 (INDUSTRIES disclaimed)	4662246	KLOUD INDUSTRIES	4271382
ALPHA INDUSTRIES (INDUSTRIES disclaimed)	4643776	HOLLUX INDUSTRIES (INDUSTRIES disclaimed)	4261038
 (IRISH and INDUSTRIES disclaimed)	4618430	 (INDUSTRIES disclaimed)	4467101
BENT INDUSTRIES (INDUSTRIES disclaimed)	4608467	SIDEWALK INDUSTRIES (INDUSTRIES disclaimed)	4451934


<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>
CHAMBER INDUSTRIES (INDUSTRIES disclaimed)	4596499	GNAR INDUSTRIES (INDUSTRIES disclaimed)	4217451
TAINTED INDUSTRIES (INDUSTRIES disclaimed)	4532960	 (INDUSTRIES disclaimed)	4265573
ADDICTED INDUSTRIES (ADDICTED disclaimed)	4637798	KNUCKLEUP INDUSTRIES (INDUSTRIES disclaimed)	4330209
UNEVEN INDUSTRIES	4480568	 (INDUSTRIES disclaimed)	4283658
BATTLE TEK INDUSTRIES (INDUSTRIES disclaimed)	4461427	GATS & TATS INDUSTRIES (INDUSTRIES disclaimed)	4111378
BLOCK INDUSTRIES	4456487	ABSTERGO INDUSTRIES (INDUSTRIES disclaimed)	4127977
OBSCURE INDUSTRIES (INDUSTRIES disclaimed)	3624250	DOIN DIRT INDUSTRIES (INDUSTRIES disclaimed)	4376893
B-0-X INDUSTRIES CLOTHING (INDUSTRIES CLOTHING disclaimed)	4390760	 (INDUSTRIES disclaimed)	4226899
 Northbound Industries (INDUSTRIES disclaimed)	4059403	 (INDUSTRIES disclaimed)	4116041
FOOD GANG INDUSTRIES (INDUSTRIES disclaimed)	4176500	BUZZSAW INDUSTRIES (INDUSTRIES disclaimed)	4046535

<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>
	3973099	 (INDUSTRIES disclaimed)	3890138
 (INDUSTRIES disclaimed)	3825286	 Whip Industries (INDUSTRIES disclaimed)	4423440
BROOKLYN INDUSTRIES (INDUSTRIES disclaimed)	3691224	SECTION 8 INDUSTRIES (INDUSTRIES disclaimed)	3811658
SIX GEAR INDUSTRIES (INDUSTRIES disclaimed)	3764411	LEWD INDUSTRIES (INDUSTRIES disclaimed)	3962972
PETROL INDUSTRIES	4264909	CRWWND INDUSTRIES (INDUSTRIES disclaimed)	3912230
 (INDUSTRIES disclaimed)	3946802		4013010
LUCKY PUNK INDUSTRIES (INDUSTRIES disclaimed)	3810391	MOYAINDUSTRIES (INDUSTRIES disclaimed)	3935054
 (INDUSTRIES disclaimed)	3742150	 (INDUSTRIES disclaimed)	3736186
CHOCOLATE INDUSTRIES (INDUSTRIES disclaimed)	3789515	COVETED INDUSTRIES (INDUSTRIES disclaimed)	3835763

<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>
 (INDUSTRIES disclaimed)	3660819	 (INDUSTRIES disclaimed)	3721207
COUNTERFEIT INDUSTRIES (INDUSTRIES disclaimed)	3622650	FIGHT INDUSTRIES (INDUSTRIES disclaimed)	3747903
 (INDUSTRIES disclaimed)	3709966	 (INDUSTRIES disclaimed)	3716341
	3640867	AFTER CLASS INDUSTRIES (INDUSTRIES disclaimed)	3747318
WARP SPEED INDUSTRIES (INDUSTRIES disclaimed)	3640716		

See 17 TTABVue 1-284.

These third-party registrations tend to "show the sense in which [the term INDUSTRY] is used in ordinary parlance." *Juice Generation*, 115 USPQ2d at 1675 (quoting 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015)) ("[a] real evidentiary value of third party registrations per se is to show the sense in which ... a mark is used in ordinary parlance"). Third party registrations are relevant [*23] to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Id.* In short, INDUSTRY and variations thereof are minimally distinctive in this field. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1471 (TTAB 2014).

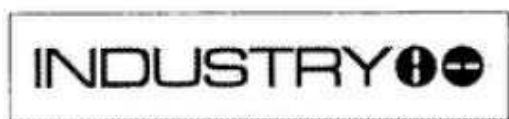
Furthermore, while we recognize that none of the 75 registrations listed above establish "the specific extent and impact" of any actual use of the registered marks, and that some of the registrations have likely been cancelled since the trial ended, the sheer volume of registrations here is large enough that this evidence, in combination with the third-party use evidence, is "powerful on its face." See *Jack Wolfskin*, 116 USPQ2d at 1136 and *Juice Generation*, 115 USPQ2d at 1674-75. It would be improper for us to "too quickly dismiss[] the significance of this evidence. *Jack Wolfskin*, 116 USPQ2d at 1136; see also *Juice Generation*, 115 USPQ2d at 1675 [*24] (improper in analogous circumstances to insist "on specifics as to the third-party use"). We should also point out that in addition to the 75 third-party Principal Register registrations listed above, Applicant introduced eight Supplemental Register registrations for INDUSTRY marks for clothing: REPLICIA INDUSTRY (Reg. No. 3871671); 

(Reg. No. 4565833) (INDUSTRIES disclaimed); IMPERFUCT INDUSTRIES (Reg. No. 4416181) (INDUSTRIES disclaimed); KALIFORNIA INDUSTRIES (Reg. No. 4196092); VELVET INDUSTRIES (Reg. No. 3735493) (INDUSTRIES disclaimed); STARK INDUSTRIES (Reg. No. 4127017) (INDUSTRIES disclaimed); FIGHT INDUSTRIES (Reg. No. 3747903) (INDUSTRIES disclaimed); and SIN CITY INDUSTRIES (Reg. No. 3779654) (INDUSTRIES disclaimed).¹⁹ By virtue of being on the Supplemental Register, these registrations constitute additional evidence that INDUSTRIES is not particularly distinctive in this field. *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1255-56 (TTAB 2012); *Perma Ceram Enters. Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992). Moreover, out of the total of 83 Principal and Supplemental Register [*25] registrations identified herein, 60 include disclaimers of INDUSTRY or INDUSTRIES, also evidencing that these terms have been considered nondistinctive. See *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014) and *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.* 89 USPQ2d 1844, 1851 (TTAB 2008)

In short, the widespread third-party use and registration of INDUSTRY/INDUSTRIES marks for clothing establishes that this element of Opposers' pleaded marks is both conceptually and commercially weak. We find that Opposers have not established ownership of a family of marks in which INDUSTRY or variations thereof are the [*26] family component.

D. Similarity of the Marks

Because Opposers have not established ownership of a family of marks, we must determine whether there is a likelihood of confusion between Applicant's mark and any one of Opposers' pleaded marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1657 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) ("opposer has not established that it had a family of marks prior to applicant's first use of its mark. Therefore, the likelihood of confusion analysis will be based solely on the use of the individual marks in opposer's registrations"). Here, if we find confusion likely between the mark in Opposers' Registration No. 2723120 (the "'120 Registration"), shown on the left, and Applicant's involved mark, shown below on the right



we need not consider the likelihood of confusion between Applicant's mark and Opposers' other pleaded marks. On the other hand, if we find no likelihood of confusion between Applicant's mark and the mark in Opposer's pleaded '120 Registration, we would not find confusion between Applicant's mark and Opposers' other [*27] pleaded marks, which are less similar to Applicant's mark in overall commercial impression. *In re Max Capital Grp.*, 93 USPQ2d at 1245. We therefore focus on the mark in the '120 Registration.

We begin by accepting Opposers' argument that the doctrine of foreign equivalents should apply to the term INDUSTRIE in Applicant's mark. That term is the French word for "industry" (and is pronounced the same). 14 TTABVUE 473 (Rozenwald Tr. 23-24); 21 TTABVUE 44 (Applicant's Response to Int. No. 29). Moreover, "French is a common foreign language spoken by an appreciable segment of the population." *In re Thomas*, 79 USPQ2d at 1024. Thus we find that this element of Applicant's mark is identical to the literal portion of Opposers' mark in meaning and sound, and almost identical in appearance.²⁰ Were this the only element of Applicant's mark, we

¹⁹ In addition, Applicant owns a Supplemental Register registration, albeit not use-based, for RAGTRADER INDUSTRIE, with INDUSTRIE disclaimed, for clothing goods identical to those identified in Opposers' pleaded registrations (Reg. No. 4486583). 19 TTABVUE 5-6.

²⁰ Even if we did not apply the doctrine of foreign equivalents, we would find INDUSTRIE and INDUSTRY quite similar.

would find it confusingly similar to Opposers' mark, notwithstanding the conceptual and commercial weakness of Opposers' mark.

[*28]

However, we must consider the marks "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). When we do so, the many differences between the marks easily outweigh their similarity.

Indeed, the term INDUSTRIE in Applicant's mark is but one of its 12 literal terms, all of which are disclaimed. It is subsidiary to at least the term GARMENT MAKERS, which precedes (appears above) it and is written in bold type, while INDUSTRIE is not. Furthermore, the design elements of the two marks are quite different, having essentially nothing in common.²¹

[*29]

While the term INDUSTRIE is more prominent than some of the literal elements of Applicant's mark, it is far from prominent enough for confusion to occur, when consumers are so used to seeing the terms INDUSTRY and INDUSTRIES used by so many third-parties which offer identical clothing products. In short, Applicant's mark will be perceived as just one more of the many INDUSTRY/INDUSTRIES marks for clothing. "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Juice Generation*, 115 USPQ2d at 1674. *See also Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 45 C.C.P.A. 856, 1958 Dec. Comm'r Pat. 236, 117 USPQ 295, 297 (CCPA 1958); *Coach/Braunsdorf*, 110 USPQ2d at 1476-78 (finding, based on this principle, "that the mark PERKSPOT is sufficiently different from the marks PERKS and PERKSCARD to avoid a likelihood of confusion" even though the marks were used for legally identical services); *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 779-80 (TTAB 1979) (allowing registration of NATURE'S PLUS for vitamins [*30] despite prior registration of PLUS for vitamins given coexistence of a number of registrations containing PLUS for similar goods). As the Federal Circuit stated in analogous circumstances:

Jack Wolfskin's evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product. Jack Wolfskin's extensive evidence of third-party uses and registrations of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints.

Jack Wolfskin, 116 USPQ2d at 1136. This factor weighs heavily against finding a likelihood of confusion.

E. Balancing the Factors

²¹ As Applicant points out, Opposers argued during prosecution of their application to register



that their mark was unlikely to be confused with the registered marks



or INDUSTRYGEAR.COM for in-part identical clothing products and retail clothing store services, respectively, because "the marks share little or no similarity insofar as the elements of appearance, sound, connotation and commercial impression are concerned." 14 TTABVue 367, 429. *See generally Juice Generation*, 115 USPQ2d at 1675 ("Although estoppel based on prosecution of an application has played a more limited role for trademarks than for patents ... we have recognized that such comments have significance as 'facts' illuminative of shade and tone in the total picture confronting the decision maker." (citations omitted)).

Although the goods and services and channels of trade are identical or quite closely related, and there is therefore a lower threshold for establishing similarity between the marks and, ultimately, likelihood of confusion, the marks in this case are too different, and the single term they have in common is too weak, for confusion to be likely.

It [*31] seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Sure-Fit Prods., 117 USPQ at 297. Opposers' Section 2(d) claim is dismissed.

V. Dilution

As indicated in connection with Opposers' likelihood of confusion claim, Opposers failed to establish that their marks are strong, which *a fortiori* means that their marks are not famous for dilution purposes. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012). This precludes a finding of dilution. 15 U.S.C. § 1125(c)(1); *Coach Servs.*, 101 USPQ2d at 1723-24 ("to prevail on a dilution claim under the TDRA, a plaintiff must show that: (1) it owns a famous mark that is distinctive ..."); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1296 (TTAB 2016). [*32] Accordingly, Opposers' Section 43(c) claim is also dismissed.

Masimo Corp. v. Rooti Labs Ltd. , 2017 TTAB LEXIS 304

Trademark Trial and Appeal Board

August 22, 2017, Decided

Opposition No. 91224804

Reporter

2017 TTAB LEXIS 304 *

Masimo Corporation v. Rooti Labs Limited

Disposition: [*1]

Decision: The opposition is sustained and registration is refused to Application Serial No. 86395592 for the mark

Image Name  .

Core Terms

monitors, ROOT, marks, likelihood of confusion, patient, consumers, purchasers, registration, similarity, products, factors, healthcare professional, medical device, sophisticated, channels, complementary, connotation, measuring, sensors, blood pressure, appearance, marketed, wearable, branded, pleaded, identification, differentiate, impression, contends, reasons

Counsel

Gregory B. Phillips, Mark D. Kachner, and Deborah S. Shepherd of Knobbe, Martens, Olson & Bear, LLP, for Masimo Corporation.

P. Jay Hines of Muncy, Geissler, Olds & Lowe P.C. for Rooti Labs Limited.

Panel: Before Adlin, Heasley and Pologeorgis, Administrative Trademark Judges.

Opinion By:

Heasley, David K.

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Heasley, Administrative Trademark Judge:

Rooti Labs Limited ("Applicant") seeks registration on the Principal Register ¹ of the stylized word and design mark



Image Name for "Computer software for using in database management of data mining for healthy care, home care, foodstuff, travel, life style or medical information" and related goods ² in International Class 9, and "wearable digital electronic devices comprised primarily of a transmitting and receiving apparatus found in wireless digital phones for medical use to measure physiological parameters such as body weight, blood pressure, blood-oxygen level, polysomnography; [*2] blood pressure monitors" and related goods ³ in International Class 10.

[*3] [*4]

Masimo Corporation ("Opposer") has opposed registration of Applicant's mark on the ground of likelihood of confusion with Opposer's previously used and registered mark **ROOT** (in standard characters) for "medical devices, namely patient monitors and patient sensors for monitoring and measuring blood properties, respiration, exhaled gases or brain function" in International Class 10. ⁴ "In view of Opposer's prior statutory and common law trademark

¹ Application Serial No. 86395592 was filed on September 16, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. [15 U.S.C. § 1051\(b\)](#). The application describes the mark as "the stylized term 'ROOTI' with a semi-circle dotting the 'I'."

² The goods identified in International Class 9 are: "Computer software for using in database management of data mining for healthy care, home care, foodstuff, travel, life style or medical information; Computer software and hardware for using cloud computing in network management for healthy care, home care, foodstuff, travel, life style or medical information; Downloadable electronic game software for use on mobile and cellular phones, handheld computers and desktop computers; Computer-gaming software; Computer operating software; Computer operating programs; Computer operating programs, recorded; Satellite-aided navigation systems; Global positioning system (GPS); Computer terminal; Computer game programs; Computer game programs downloadable via the Internet; Digital music downloadable from the Internet; Films downloaded via the Internet; Downloadable films and television programs featuring healthy care, home care, foodstuff, travel, life style or medical information provided via a video-on-demand; Downloadable films and movies featuring healthy care, home care, foodstuff, travel, life style or medical information provided via a video-on-demand service; Downloadable image file containing artwork, text, audio, video, games and Internet Web links relating to sporting and cultural activities; Downloadable electronic books in the field of healthy care, home care, foodstuff, travel, life style or medical information; Downloadable e-books in the field of healthy care, home care, foodstuff, travel, life style or medical information; Downloadable pictures in the field of healthy care, home care, foodstuff, travel, life style or medical information; Wear-mounted digital electronic devices comprised primarily of a transmitting and receiving apparatus found in digital phones for use in displaying the information of time, date, GPS, position, direction, distance, speed, step, calories, climate, temperature, wind speed, height, deviation of speed and heartbeat, not for medical use; GPS tracking device to be worn on the wrist of an athlete during endurance events; Wearable digital electronic devices comprised primarily of software and display screens for analytic reports of algorithms results and cloud computing for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computer; Wear-mounted digital electronic devices comprised of a transmitting and receiving apparatus for digital phones to display time, date, GPS, position, distance, speed, step, climate, temperature, and wind speed."

³ The goods identified in International Class 10 are: "Wearable digital electronic devices comprised primarily of a transmitting and receiving apparatus found in wireless digital phones for medical use to measure physiological parameters such as body weight, blood pressure, blood-oxygen level, polysomnography; blood pressure monitors; Thermometers for medical purposes; Clinical thermometers; Medical examination apparatus, namely, wireless monitors intended for use by healthcare professionals for unattended surveillance of physiological data with healthcare settings; Skin examination apparatus, namely, ambulatory devices that measure skin surface moisture, skin color, sebum, skin surface pH and temperature; Heartbeat measuring apparatus; Electrocardiographic (ECG) recorders; Pulse and heartbeat measuring devices; Medical devices, namely, wireless data collection monitors that continuously gather physiological data from the subjects being monitored and then transmit encrypted data via a bi-directional relay to the central server; Medical instruments, namely, ambulatory patient monitors that provide remote vital signs monitoring for subjects in healthcare, occupation and home settings; Medical apparatus, namely, physiological monitoring telemetry device intended for monitoring subjects in the home, work place and alternate care settings; Blood pressure measuring apparatus; Wear-mounted digital electronic devices comprised of a transmitting and receiving apparatus for digital phones to display caloric utilization, heartbeat and respiration in athletes."

rights," it pleads in its Notice of Opposition, "Applicant is not entitled to registration of the Application pursuant to Section 2(d) of the Lanham Act, [15 U.S.C. § 1052\(d\)](#)." ⁵ In its Answer, Applicant admits that Opposer owns its pleaded Registration, but denies all salient allegations of likelihood of confusion. ⁶ Its purported "affirmative defenses" merely amplify its denials. ⁷

[*5]

For the reasons that follow, we sustain the opposition.

I. Standing and Priority

Because Opposer's registration is properly of record, Opposer has established its standing. See [Empresa Cubana Del Tabaco v. Gen. Cigar Co.](#), 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1401, 191 L. Ed. 2d 360 (2015); [Ritchie v. Simpson](#), 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); [15 U.S.C. § 1063](#); see [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); [Lipton Ind., Inc. v. Ralston Purina Co.](#), 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). And priority is not at issue as to the mark and goods identified therein. [King Candy Co., Inc. v. Eunice King's Kitchen, Inc.](#), 496 F.2d 1400, 182 USPQ 108, 110-11 (CCPA 1974). Applicant states that it "does not contest the priority of the Opposer by virtue of its pleaded registration." ⁸

[*6]

II. The Evidentiary Record

The record includes the pleadings, Applicant's application file under Trademark Rule 2.122(b), and the following:

A. Opposer's evidence

. The testimonial deposition of Kristen Budreau, Opposer's Director of Marketing Communications, with exhibits; ⁹

. Opposer's Notice of Reliance on its registered mark, Applicant's answers to Opposer's first and second sets of interrogatories and requests for admission, with exhibits, as well as printouts from Applicant's website, www.rootilabs.com; ¹⁰

B. Applicant's evidence

⁴ Registration No. 4491598, issued on the Principal Register on March 4, 2014.

⁵ Notice of Opposition P 6, 1 TTABVUE 8. Opposer also predicated its opposition on Section 43(a) of the Lanham Act, [15 U.S.C. § 1125\(a\)](#). Notice of Opposition P 7, 1 TTABVUE 8. This is not a cognizable ground for opposition. See [Person's Co., Ltd v. Christman](#), 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990); [Fiat Group Automobiles S.p.A. v. ISM, Inc.](#), 94 USPQ2d 1111, 1116n. 8 (TTAB 2010). Furthermore, it was not pursued in Opposer's briefing, and is therefore waived. See [Luxco, Inc. v. Consejo Regulador del Tequila, A.C.](#), 121 USPQ2d 1477, 1479 (TTAB 2017).

⁶ Answer, 4 TTABVUE.

⁷ Answer, 4 TTABVUE 3-4.

⁸ Applicant's brief p. 7, 15 TTABVUE 9.

⁹ 13 TTABVUE.

¹⁰ 9 TTABVUE.

. Applicant's Notice of Reliance on printouts from Opposer's website www.masimo.com, from Applicant's website www.rootilabs.com, from Applicant's Facebook page www.facebook.com/rootilabs, from www.kickstarter.com, from www.techcrunch.com and from www.Amazon.com

III. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis [*7] of all of the probative facts in evidence that are relevant to the factors set forth in [*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 \(CCPA 1973\)](#) ("*DuPont*") cited in [*B&B Hardware, Inc. v. Hargis Ind., Inc.*, U.S. , 135 S.Ct. 1293, 191 L. Ed. 2d 222, 113 USPQ2d 2045, 2049 \(2015\)](#); see also [*In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 \(Fed. Cir. 2003\)](#).

In applying the *DuPont* factors, we bear in mind the fundamental principles underlying the Lanham Act in general and Section 2(d) in particular, which are "to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers." [*Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 658, 83 L. Ed. 2d 582, 224 USPQ 327, 331 \(1985\)](#) quoted in [*Matal v. Tam*, U.S. , 137 S. Ct. 1744, 198 L. Ed. 2d 366, 122 USPQ2d 1757, 1762 \(2017\)](#); see also [*DuPont*, 177 USPQ at 566](#).

We have considered each relevant *DuPont* factor for which there is evidence or argument, and have treated any other factors as neutral. See [*M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 \(Fed. Cir. 2006\)](#); [*8] [*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."). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. [*Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 \(Fed. Cir. 2011\)](#); [*In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 \(Fed. Cir. 1993\)](#) (factors "may play more or less weighty roles in any particular determination").

Two key considerations are the similarities between the marks and the similarities between the goods. See [*In re I.AM.Symbolic, LLC*, 866 F.3d 1315, 2017 WL 3393456, *3 \(Fed. Cir. 2017\)](#); [*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 \(CCPA 1976\)](#); [*Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1429 \(TTAB 2013\)](#).

A. Similarity of the marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Opposer's marks [*9] as compared in their entireties, taking into account their appearance, sound, connotation and commercial impression. [*DuPont*, 177 USPQ at 567](#); [*Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 \(Fed. Cir. 2014\)](#); [*Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 \(Fed. Cir. 2005\)](#).

Applicant contends that there are significant differences in the appearance, sound and meaning of the respective marks. In appearance, it contends, the stylized lettering of its mark "creates an entirely unique and memorable appearance" ¹¹:

Image Name 

In terms of sound, while conceding that there is no correct pronunciation of a mark, Applicant argues that consumers might pronounce its mark "ROO-TIE" or "ROO-TEA", and either pronunciation differentiates its mark from the hard 't' ending and single syllable [*10] of Opposer's mark. ¹² In terms of meaning, it urges that the

¹¹ Applicant's brief p. 9, 15 TTABVue 11.

additional "I" in its mark transforms the meaning of the word--e.g., JED v. JEDI, TAX v. TAXI.¹³ Applicant concludes that the differences in sight, sound and meaning weigh strongly against a likelihood of confusion.

However, "two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation." [*In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 \(TTAB 2016\)](#) (emphasis in original; quoting *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff'd mem.*, 979 F.2d 216 (Fed. Cir. 1992)). Here we agree with Opposer that there is similarity in virtually all respects.

In appearance, Applicant's stylized lettering does not differentiate it because Opposer's standard character mark "could be displayed [*11] in any size, color, or font, including a size, color, and font identical to those in Applicant's mark." [*In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1742-43 \(TTAB 2016\)](#) (citing [*In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 \(Fed. Cir. 2012\)](#); [*Citigroup Inc. v. Capital City Bank Group*, 98 USPQ2d at 1258](#)?59). The small semi-circle design dotting the "I" in Applicant's mark makes little or no difference. See [*In re Davia*, 110 USPQ2d 1810, 1814 \(TTAB 2014\)](#) ("As for the raised dots and periods in the mark, they are unpronounceable and contribute very little to the overall commercial impression of the mark."). The literal portion--the part used by purchasers to request the goods--is normally accorded greater weight in determining whether marks are confusingly similar. [*In re Vittera*, 101 USPQ2d at 1908, 1911.](#)

Applicant's mark incorporates Opposer's entire **ROOT** mark, which increases the likelihood of confusion. See, e.g., [*Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 \(CCPA 1977\)](#) (CALIFORNIA CONCEPT with surfer logo for men's hair and cosmetic [*12] products confusingly similar to CONCEPT for cold permanent wave lotion and neutralizer); [*Coca-Cola Bottling Co. of Memphis, Tenn., Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 \(CCPA 1975\)](#) (BENGAL LANCER for club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin). As the first four letters in Applicant's five-letter mark, **ROOT** is its most prominent, dominant component. See [*Palm Bay Imps.*, 73 USPQ2d at 1692](#) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); [*Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 \(TTAB 1988\)](#) ("[I]t is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). Applicant does not suggest that **ROOT** is pronounced differently in either mark.

The only difference in sound is the letter "I" at the end of Applicant's mark. While there is no one correct pronunciation of a mark, see [*In re Vittera Inc.*, 101 USPQ2d at 1912](#), Applicant's letter "I", whether pronounced as [*13] a long "E" or a long "I", is a minor subordinate suffix, which fails to differentiate the marks meaningfully. [*In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 \(Fed. Cir. 2010\)](#) ("[T]he presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical."). In fact, "[t]he general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto. Thus, 'if the dominant portion of both marks is the same, the confusion may be likely notwithstanding peripheral differences.'" [*In re Jump Designs*, 80 USPQ2d 1370, 1375 \(TTAB 2006\)](#) (quoting TMEP § 1207.01(b)(iii)).

It is true, as Applicant suggests, that the addition of an "I" can sometimes transform the meaning of a word, but that transformation generally takes place when the addition forms a new, familiar word, as in JEDI and TAXI. [*Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 59 C.C.P.A. 1162, 174 USPQ 392 \(CCPA 1972\)](#) (ALL CLEAR! for household cleaner not confusingly similar to ALL for household cleansing products). But here there [*14] is no such transformation. Purchasers normally retain a general rather than a specific impression of trademarks, *Mini Melts*,

¹² Applicant's brief p. 10, 15 TTABVUE 12.

¹³ Applicant's brief p. 10, 15 TTABVUE 12.

Inc. v. Reckitt Benckiser LLC, 118 USPQ2d 1464, 1470 (TTAB 2016), so they would most likely focus on the marks' common root element, **ROOT**, disregarding the one-letter suffix. ¹⁴

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In terms of connotation, "root" is "something resembling or suggesting the root of a plant in position or function," "the fundamental or essential part," or "the source or origin of a thing," ¹⁵ and both parties use **ROOT** in this sense. Opposer's Director of Marketing Communications, Kristen Budreau, testified that it uses **ROOT** for a medical monitor to which various medical sensors attach: "an in-room hub." ¹⁶ Its annual report referred to "The root of our inspiration - the healing connection between patients and their caring caregivers...." ¹⁷ Applicant, in its discovery responses, admits that goods bearing its mark are used for health monitoring, ¹⁸ and states that "Applicant conceived the name and mark to represent its focus on human health. Applicant chose the 'ROOT' component as a 'foundation' for this purpose and the 'I' to represent 'human,' thus conveying the notion of caring for the health of ourselves, families and friends. Applicant also owns pending application Serial No. 86419252 for the mark Image



Name which design implies the roots of a tree in support of the central concept and the goal of developing products that [*16] improve health and life. ..." ¹⁹ Hence, the dominant term **ROOT** in Applicant's mark is intended to convey the same or similar connotation as Opposer's **ROOT** mark.

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In sight, sound, and meaning, the dominant portion of Applicant's mark is the same as Opposer's mark. While "the similarity or dissimilarity of the marks is determined based on the marks in their entireties ... there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties." [*Bond v. Taylor*, 119 USPQ2d 1049, 1055 \(TTAB 2016\)](#) (citing [*In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 \(Fed. Cir. 1985\)](#)). Despite Applicant's addition of a peripheral suffix, and despite its stylization and design, the marks, taken in their entireties, are highly similar in overall commercial impression.

For these reasons, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. Similarity of the Goods

¹⁴ We do not accept Opposer's suggestion that the "I" at the end of Applicant's mark would be associated with "Internet." As Applicant points out, "while the use of the letter 'I' at the beginning of a word has become common shorthand for Internet, the letter is **not** used for this purpose when placed at the end of the word. There is no basis in the record for the Opposer to contend otherwise." Nor do we credit Opposer's suggestion that the "I" represents the word "index." As Applicant observes, the examples on which Opposer relies were acronyms, such as PVI for Pleth Variability Index or ORI for Oxygen Reserve Index. "As 'root' does not represent an acronym," Applicant notes, "there is no basis for consumers to ascribe the 'index' meaning in this case." We agree. The letter "I" fails to distinguish the parties' marks, not because it is descriptive, but because it is subordinate to the dominant component **ROOT**.

¹⁵ Dictionary.com, Random House Dictionary (2017). The Board may take judicial notice of dictionary definitions, [*Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 \(TTAB 1982\)](#), *aff'd*, [*703 F.2d 1372*, 217 USPQ 505 \(Fed. Cir. 1983\)](#), including online dictionaries that exist in printed format or have regular fixed editions. [*In re Cordua Rests. LP*, 110 USPQ2d at 1229n.4, *aff'd* 823 F.3d 594, 118 USPQ2d 1632 \(Fed. Cir. 2016\)](#); [*In re Hodgdon Powder Co.*, 119 USPQ2d 1254, 1256n.5 \(TTAB 2016\)](#).

¹⁶ Budreau dep. 19:7-24, 13 TTABVUE 22.

¹⁷ Budreau dep. 26:9-11, 13 TTABVUE 29.

¹⁸ Applicant's Responses to Opposer's Request for Admission Nos. 1-3, Opposer's Notice of Reliance, 9 TTABVUE 37-38.

¹⁹ Applicant's Answer to Interrogatory No. 3, Opposer's Notice of Reliance, 9 TTABVUE 16.

Under the second *DuPont* factor, we consider the similarity or dissimilarity of Applicant's and Opposer's goods. [DuPont, 177 USPQ at 567](#). We base our evaluation on the goods as they are identified in the application and registration. [Stone Lion, 110 USPQ2d at 1161](#); [*18] [Octocom Systems, Inc. v. Houston Comp. Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 \(Fed. Cir. 1990\)](#).²⁰

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Opposer's identification of goods reads "medical devices, namely patient monitors and patient sensors for monitoring and measuring blood properties, respiration, exhaled gases or brain function." Opposer contends that the following International Class 10 goods in the subject application are identical to the goods identified in its cited registration:

- . Pulse and heartbeat measuring devices;
- . Heartbeat measuring apparatus;
- . Electrocardiographic (ECG) recorders; and
- . Blood pressure measuring apparatus.²¹

In response to this list, Applicant "does not dispute this point as the identification is currently drafted."²² More generally, Applicant admits that certain of the goods identified in the involved application are used for health monitoring,²³ such as monitoring for heart arrhythmia and blood pressure.²⁴

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Applicant argues, however, that these four identified goods refer to its "wearable consumer product," unlike the pleaded registration, which "is restricted to 'patient monitors and patient sensors' and therefore restricted to medical professional and **not** consumer use."²⁵ But the application identifies *inter alia* devices "for medical use" including "medical examination apparatus, namely wireless monitors intended for use by healthcare professionals...." And Applicant does not limit its Class 10 goods to "consumer use." The Board does not read limitations into an unrestricted application. See [SquirtCo v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 \(Fed. Cir. 1983\)](#) cited in [In re I.AM.Symbolic, LLC, 866 F.3d 1315, 2017 WL 3393456 at *3](#); [In re Mr. Recipe, 118 USPQ2d at 1091](#).

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²⁰ Opposer also claims common law rights in the **ROOT** mark. Notice of Opposition P 5, 1 TTABVUE 7, Opposer's brief p. 25, 14 TTABVUE 32. But its pleadings, briefing and record evidence do not clarify how these claimed common law rights differ from its rights under its cited registration--either as to goods covered or duration of use. Opposer alludes generally to a variety of health measurement devices it has offered under other marks, such as RADICAL-7, RADIUS-7, RAD-8, MIGHTYSAT, and PRONTO-7, Opposer's brief pp. 8-11, 14 TTABVUE 15-18. And it claims a "zone of natural expansion" for its **ROOT** mark into the product lines it offers under these other marks. Opposer's brief p. 29, 14 TTABVUE 36. As our ensuing analysis demonstrates, this evidence may be relevant to show how various sensors can be connected to the **ROOT** monitor and used in a complementary manner, but it does not demonstrate common law rights in the **ROOT** mark that differ in any meaningful way from the rights asserted under Opposer's registration. And since the goods identified in Opposer's registration are similar or related to Applicant's identified goods, as we ultimately find, we do not need to reach or rely upon Opposer's asserted "zone of natural expansion" argument. See generally [Orange Bang, Inc. v Ole Mexican Foods, Inc., 116 USPQ2d 1102 \(TTAB 2015\)](#) (no need to apply natural zone of expansion analysis).

²¹ Opposer's brief p. 26, 14 TTABVUE 33.

²² Applicant's brief p. 11, 15 TTABVUE 13.

²³ Applicant's Responses to Opposer's Request for Admission Nos. 1-3, Opposer's Notice of Reliance, 9 TTABVUE 37-38.

²⁴ Applicant's Answer to Interrogatory No. 14, 9 TTABVUE 20.

²⁵ *Id.* (emphasis in original).

Since Applicant has conceded that its measuring devices are identical to those in the cited registration, the similarity of marks needed to support a determination that confusion is likely declines as to those goods. See [*Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 \(Fed. Cir. 2012\)](#). Furthermore, a likelihood of confusion may be found with respect to a particular class based on any item within the identification of goods or services for that class. [*Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 \(CCPA 1981\)](#); [*Bd. of Regents v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1190 \(TTAB 2014\)](#).

Although Applicant's Class 9 goods are not identical to Opposer's goods, they are still sufficiently related to engender a likelihood of confusion. "It is not necessary that these goods be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be encountered by the same persons in situations that would give rise, [*22] because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods." [*In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 \(TTAB 2009\)](#).

Here, Opposer's **ROOT** monitor "provides a hub for monitoring and transmitting medical data from a patient to doctors, nurses and other medical personnel...." ²⁶ It monitors multiple data sources, measuring blood pressure, blood oxygen level, respiration, pulse rate, exhaled gases and brain functions, and other parameters. ²⁷ It then displays this data:



Image Name

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Opposer's website (introduced in Applicant's Notice of Reliance) describes the **ROOT** monitor:

²⁶ Budreau dep. 19:8-20:7, 13 TTABVUE 22-23.

²⁷ *Id.*

²⁸ (showing RADICAL 7 handheld monitor docked at **ROOT** monitor), Opposer's brief p. 12, 13, 14 TTABVUE 19, 20; Budreau dep. 27:10-12, Ex. 5, 13 TTABVUE 30, 140.

Root®

Patient Monitoring and Connectivity Platform



Root offers broad application across the continuum of care

Root is a patient monitoring and connectivity platform that offers our breakthrough rainbow® and Masimo SET® measurements with other breakthrough parameters in an integrated, clinician-centric platform. With docking capabilities for the Radical-7® handheld monitor or Radius-7™ patient-worn monitor, an instantly interpretable display, and multiple networking/connectivity options, Root integrates multiple streams of data and simplifies patient care workflows, empowering caregivers to help make quick patient assessments throughout the continuum of care.

Image Name

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Opposer's **ROOT** monitor connects with many third-party medical devices, from which it collects, monitors, displays and transmits data, creating a comprehensive electronic medical record.³⁰

Applicant's identified goods in Class 9 are, in pertinent part:

Computer software for using in database management of data mining for healthy care, home care, foodstuff, travel, life style or medical information; Computer [*24] software and hardware for using cloud computing in network management for healthy care, home care, foodstuff, travel, life style or medical information;

...

Wearable digital electronic devices comprised primarily of software and display screens for analytic reports of algorithms results and cloud computing for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computer....

Applicant maintains that these goods are health monitoring devices for general use by consumers, unlike Opposer's goods, which are expensive sensors used by health care professionals to monitor patients.³¹ But once again, the identification in the application is not so limited. *In re Mr. Recipe*, 118 USPQ2d at 1091. We must consider the application and registration to include all goods of the type identified. See, e.g., *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013).

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²⁹ www.masimo.com, Applicant's First Notice of Reliance exhibit 1, 10 TTABVUE 7.

³⁰ Opposer's brief pp. 13, 20, 14 TTABVUE 20, 27; Budreau dep. 28:8-20, 13 TTABVUE 31; www.masimo.com, Applicant's First Notice of Reliance exhibit 1, 10 TTABVUE 8.

³¹ Applicant's brief pp. 12-14, 15 TTABVUE 14-16.

Moreover, as Applicant's discovery responses reveal, its goods complement Opposer's **ROOT** monitors:

. Interrogatory No. 17

Describe how the goods or services in use, or intended to be in use, with Applicant's Mark interface with professionals in the healthcare or medical industries.

Response to Interrogatory No. 17

Applicant's devices can be recommended by doctors or other health professionals. All of the vital data of the patients or other users are uploaded to a cloud-based data center via smart phone or Wi Fi. Doctors and their patients can login to Applicant's platform to access reports and historical data trends.³²

. Interrogatory No. 37

In response to Opposer's interrogatory No. 12, Applicant states that its "initial focus is on health wearables." Describe in detail what are "health wearables."

Response to Interrogatory No. 37

Health wearables are smart devices worn on the body that measure core health data such as blood pressure, vision quality, and body temperature.³³

. Request for Admission No. 1

Admit that Applicant's Mark is used in connection with an interactive healthcare [*26] platform.

Response to Request No. 1 Admitted.³⁴

. Request for Admission No. 2:

Admit that goods bearing Applicant's Mark are used for health monitoring.

Response to Request No. 2 Admitted.³⁵

. Request for Admission No. 3

Admit that goods bearing Applicant's Mark are used for continuous health monitoring.

Response to Request No. 3. Admitted.³⁶

. Request for Admission No. 8

Admit that goods bearing Applicant's Mark allow persons to monitor health information.

Response to Request No. 8 Admitted.³⁷

. Request for Admission No. 9

Opposition No. 91224804

³² Opposer's Notice of Reliance, 9 TTABVUE 20-21.

³³ Opposer's Notice of Reliance, 9 TTABVUE 33.

³⁴ Opposer's Notice of Reliance, 9 TTABVUE 37.

³⁵ Opposer's Notice of Reliance, 9 TTABVUE 38.

³⁶ Opposer's Notice of Reliance, 9 TTABVUE 38.

³⁷ Opposer's Notice of Reliance, 9 TTABVUE 39.

Admit that goods bearing Applicant's Mark allow Health Professionals to monitor health information.

Response to Request No. 9 Admitted. ³⁸

. Request for Admission No. 11

Admit that goods bearing Applicant's Mark provide a platform for Health Professionals to monitor patients' biometric data.

Response to Request No. 11 Admitted. ³⁹

. Request for Admission No. 23

Admit that goods bearing Applicant's Mark transmit health data electronically. **[*27]**

Response to Request No. 23 Admitted. ⁴⁰

. Request for Admission No. 32

Admit that goods bearing Applicant's Mark are intended for use by Health Professionals for surveillance of physiological data.

Response to Request No. 32 Admitted. ⁴¹

. Request for Admission No. 33

Admit that Healthcare Professionals may use Applicant's goods to monitor patient biometric data.

Response to Request No. 33

Admitted. ⁴²

[*28]

Applicant's discovery responses do not differentiate between its Class 9 and Class 10 goods, and its identifications of goods in both classes, quoted above, are broadly worded enough to encompass health care monitoring devices. Indeed, Applicant's own promotional materials confirm that health care professionals as well as patients use

Applicant's Image Name  branded goods:

³⁸ Opposer's Notice of Reliance, 9 TTABVUE 39.

³⁹ Opposer's Notice of Reliance, 9 TTABVUE 39.

⁴⁰ Opposer's Notice of Reliance, 9 TTABVUE 41.

⁴¹ Opposer's Notice of Reliance, 9 TTABVUE 43.

⁴² Opposer's Notice of Reliance, 9 TTABVUE 43.


Image

Name

1. Rooti's core competence is ECG sensing technology with other vital signals such as body temperature, motion and respiration to do some analysis and evaluate potential diseases such as Heart Arrhythmia, Sleep Apnea...etc. The Rooti devices are recommended by doctors and major user scenario is out of the hospital to do telemetry service.
2. Rooti's medical wearable products, all embedded wireless communication technology WIFI or Bluetooth inside of the devices. All the vital data of the patients will upload to data center of Rooti cloud via smart phone or WIFI environment. The doctors or patients can login Rooti service platform to access the reports or history trend.
3. Rooti is to provide the web-base platform for doctor or nurses to get the info of patients. In the meantime the patients can use the App of smart phone to track their own vital history.
4. Rooti's mark will be used in Hardware device, Smart App and Web-site service platform.
5. Rooti is service and solution provided company. The whole eco system will integrate the medical grade wearable device, smart phone application and web service for hospital, health care center or telemetry service.
6. Rooti Devices – the patients wear it to do vital sign recording
 Rooti smart phone application App – the patients use that for reviewing of vital history trend
 Rooti service platform – the doctors or nurses to use that to access the report and monitor

43

As the foregoing evidence demonstrates, Applicant's goods are similar and highly related to Opposer's **ROOT**-branded goods. Health care professionals recommend Applicant's wearable devices to patients, and the devices monitor and transmit the patients' health data electronically to a platform where the data may be reviewed [*29] by the patients and/or the health care professionals. Applicant's wearable devices thus resemble third-party medical devices that connect to Opposer's **ROOT** monitors. "If goods are complementary in nature, or used together, this relatedness can support a finding of likelihood of confusion." *In re Cook Medical Technologies, LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012) (citing *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed.

Cir. 1984)). In short, the parties' **ROOT** and Image Name  branded goods would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. See *Thor Tech Inc.*, 90 USPQ2d at 1635.

For these reasons, the second *DuPont* factor also weighs in favor of finding a likelihood of confusion.

C. Similarity of Channels of Trade

The third *DuPont* factor concerns the similarity or dissimilarity of the parties' established, likely-to-continue trade channels. *DuPont*, 177 USPQ at 567. [*30]

Applicant stresses that Opposer's products are marketed to medical professionals. For example, Opposer's promotional materials regarding its **ROOT** monitor, as used in connection with its SEDLINE brand sensor monitoring electroencephalogram (EEG) brain function signals, cautions that "Federal (USA) law restricts this device to sale by or on the order of a physician." ⁴⁴ In addition, Applicant contends, "Registrant's goods are very expensive and marketed to sophisticated medic[al] professionals. In stark contrast, Applicant's goods are relatively inexpensive and marketed to general consumers." ⁴⁵

⁴³ Opposer's Notice of Reliance, Requests for Admission Exhibit 1, 9 TTABVUE 54 (highlighting added); see also Applicant's Responses to Requests for Admission 36-39, confirming quotes from the exhibit, 9 TTABVUE 44-45.

⁴⁴ Budreau dep. ex. 10, 13 TTABVUE 261-261.

⁴⁵ Applicant's brief p. 6, 15 TTABVUE 8.

As Opposer points out, however, "Applicant concedes that many of the goods identified in this application are 'essentially identical' to the goods in Opposer's pleaded registration." ⁴⁶ "It is well established that absent restrictions in the application and registration, [identical] goods and services are presumed [*31] to travel in the same channels of trade to the same class of purchasers." [In re Vittera, 101 USPQ2d at 1908](#). Here, Applicant has conceded that four of its identified goods, used the monitor heart rate and blood pressure, are essentially identical to Opposer's. ⁴⁷ "Because the goods are in-part identical, the identical goods are presumed to travel in the same channels of trade to the same classes of purchasers." [Bond v. Taylor, 119 USPQ2d at 1053](#).

The parties' remaining identified goods contain no limitations, see [SquirtCo, 216 USPQ at 940](#), so we must presume that they would be sold in all usual channels of trade to all normal potential purchasers. See [In re Vittera, 671 F.3d at 1362](#), quoted in [In re I.A.M.Symbolic, LLC, 866 F.3d 1315, 2017 WL 3393456 at *8](#). As discussed above, it is apparent from the [*32] record evidence that the parties' goods are complementary. As Applicant stated in its answer to Interrogatory no. 17:

Applicant's devices can be recommended by doctors or other health professionals. All of the vital data of the patients or other users are uploaded to a cloud-based data center via smart phone or Wi Fi. Doctors and their patients can login to Applicant's platform to access reports and historical data trends. ⁴⁸

The goods are so complementary that health care providers could recommend Applicant's goods, and patients or other adult users could purchase them in the expectation that they would be compatible with Opposer's monitors. See [In re Davia, 110 USPQ2d at 1816](#) (complementary goods likely to travel in same channels of trade to same class of customers). This confluence of trade channels and purchasers weighs in favor of finding a likelihood of confusion under the third *DuPont* factor.

D. Purchaser Sophistication [*33] and Degree of Care

The fourth *DuPont* factor concerns the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing. [DuPont, 177 USPQ at 567](#).

Applicant, true to its prior position, maintains that Opposer's "patient monitors and patient sensors" would be sold to medical professionals, not to general consumers. ... Importantly, Opposer's registered goods are very expensive and typically sell for upward of \$ 2,000. ... In stark contrast, the evidence of record shows that Applicant's goods, namely its wearable devices, are sold to general consumers in the \$ 30-\$ 100 range." ⁴⁹

Applicant's argument calls to mind [Edwards Lifesciences Corp. v. Vigilanz Corp., 94 USPQ2d 1399 \(TTAB 2010\)](#). In that case, opposer's heart monitors cost \$ 14,000 apiece, and the applicant's computer monitoring system for possible adverse drug events cost \$ 47,000 per license, and both were [*34] purchased by experienced hospital personnel after significant study and negotiations. So this *DuPont* factor weighed against a likelihood of confusion. [Id. at 1413](#).

In this case, however, there is no record evidence of the cost of Opposer's **ROOT** monitoring goods. The \$ 30 to \$ 100 range to which Applicant alludes in its brief refers to the price of its CliMate Environment Tracker, ⁵⁰ not its monitors for pulse rate, blood pressure, and the like. So the asserted price differential is unproven. Moreover, as Opposer points out, its **ROOT** monitor is compatible with third-party measurement devices, so "relevant consumers are accustomed to seeing Opposer's marks used with other authorized medical device company's products." ⁵¹

⁴⁶ Opposer's reply brief p. 2, 16 TTABVUE 6.

⁴⁷ Applicant's brief p. 11, 15 TTABVUE 13.

⁴⁸ Opposer's Notice of Reliance, 9 TTABVUE 20-21.

⁴⁹ Applicant's brief pp. 14-15, 15 TTABVUE 15-16.

⁵⁰ 12 TTABVUE 10-12; see Applicant's Answer to Interrogatory no. 34, 9 TTABVUE 31.

Applicant's wearable devices are not only compatible with but complementary to Opposer's **ROOT** monitors. In these circumstances, even sophisticated hospital purchasers exercising care in their purchases may be confused by highly similar marks. See, e.g., *In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1273-74 (TTAB 2009) (even sophisticated hospital purchasers could be confused by marks TITAN and VANTAGE TITAN [*35] on ultrasound and MRI diagnostic apparatus, respectively); *In re Cook Medical Tech.*, 105 USPQ2d at 1383 (where applicant's medical guiding sheaths were compatible with opposer's catheters, "[w]e find that the similarities between the marks and the goods sold thereunder outweigh any sophisticated purchasing decision, especially in the absence of evidence relating to the degree of care in making the decision.").

Indeed, given the similarity between Opposer's and Applicant's marks, "careful purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source." *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014). [*36] And if health care professionals are susceptible to confusion, their patients, who could purchase Applicant's ostensibly low-cost devices directly,⁵² would be even more susceptible to confusion. See *Stone Lion*, 110 USPQ2d at 1163 (consider least sophisticated potential purchasers.).

For these reasons, the fourth *DuPont* factor is neutral.

E. Actual Confusion

The seventh and eighth *DuPont* factors address whether there has been an opportunity for confusion to occur, and if so, whether there is evidence of actual confusion. *DuPont*, 177 USPQ at 567.

Applicant argues that "Opposer has presented no evidence of actual confusion."⁵³ Proof of actual confusion is not necessary to show a likelihood of confusion. E.g., *In re I.AM.Symbolic, LLC*, 866 F.3d 1315, 2017 WL 3393456 at *3 (Fed. Cir. 2017); *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 [*37] (Fed. Cir. 2002); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). Moreover, "the absence of evidence of actual confusion, under the seventh *du Pont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *du Pont* factor, that there has been a significant opportunity for actual confusion to have occurred." *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1273 (TTAB 2007) (citing *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992)).

In this case, as Opposer observes, there has been no significant opportunity for actual confusion to occur. The subject application was filed based on Applicant's claimed intent to use the mark in commerce, and that remains its filing basis. 15 U.S.C. § 1051(b).⁵⁴ The record does not reflect the extent or duration [*38] of use of Applicant's mark sufficiently to enable us to gauge the opportunity for actual confusion to have occurred in the marketplace. See *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039-40 (TTAB 2016).

Accordingly, the seventh and eighth *DuPont* factors are neutral.

F. Strength of Opposer's Mark

As our primary reviewing court, the Court of Appeals for the Federal Circuit, has stated, marks exist along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323,

⁵¹ Opposer's brief p. 32, 14 TTABVUE 39; see Budreau dep. 28:8-20, 13 TTABVUE 31; www.masimo.com, Applicant's First Notice of Reliance exhibit 1, 10 TTABVUE 8.

⁵² See Opposer's First Notice of Reliance, Applicant's Answer to Interrogatory no. 10, 9 TTABVUE 18.

⁵³ Applicant's brief p. 15, 15 TTABVUE 17.

⁵⁴ Opposer's reply brief pp. 5-6, 16 TTABVUE 9-10.

[122 USPQ2d 1733, 1734 \(Fed. Cir. 2017\)](#) (citing [Palm Bay Imps., 73 USPQ2d at 1694](#)). The strength of a mark rests on the extent to which a significant portion of the relevant consuming public recognizes the mark as a source indicator. *Id.* In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark [*39] itself and its commercial strength, based on the marketplace recognition value 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."); [Top Tobacco, L.P. v. North Atlantic Operating Co., Inc., 101 USPQ2d 1163, 1171-72 \(TTAB 2011\)](#).

Opposer claims that its **ROOT** mark is conceptually strong because it is arbitrary for monitors.⁵⁵ See [Nautilus Grp., Inc. v. ICON Health & Fitness Inc., 372 F.3d 1330, 71 USPQ2d 1173, 1180 \(Fed. Cir. 2004\)](#) (An arbitrary mark is "a known word used in an unexpected or uncommon way."). Applicant counters that the term is suggestive: "Like the root of a plant or a tree serving to attach the plant to the ground, the **ROOT** monitor serves as a 'hub' and docking station for the Opposer's other products as well as complementary third party products. ... That is the evidence of record shows that the products are 'rooted' or attached to Opposer's **ROOT** monitors. It is therefore not arbitrary but highly suggestive in relation to the goods."⁵⁶ [*40]

As we have found, Opposer's **ROOT** mark connotes the roots of a tree--a connotation that suggests, metaphorically, the function of its **ROOT** monitors, to which various health monitoring devices may be attached. This connotation is suggestive, in the sense of requiring imagination, thought or perception to reach a conclusion as to the nature of the goods. [DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd., 695 F.3d 1247, 103 USPQ2d 1753, 1755 \(Fed. Cir. 2012\)](#); [In re Fat Boys Water Sports LLC, 118 USPQ2d 1511, 1515 \(TTAB 2016\)](#). While Opposer's mark is suggestive, it is still inherently distinctive. See generally [Two Pesos Inc. v. Taco Cabana Inc., 505 U.S. 763, 112 S. Ct. 2753, 120 L. Ed. 2d 615, 23 USPQ2d 1081, 1083 \(1992\)](#) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive). And "if the mark is inherently distinctive, it is presumed that consumers will view it [*41] as a source identifier." [In re Chippendales USA, Inc., 96 USPQ2d at 1685](#). Furthermore, even if the suggestiveness of Opposer's mark marginally erodes its conceptual strength, it does not reduce the relative likelihood of confusion between the parties' marks, because both parties use the term **ROOT** in the same or similar suggestive sense.⁵⁷

The commercial strength of Opposer's mark may be measured indirectly by the volume of sales and advertising expenditures in connection with the products sold under the mark, and other factors such as length of use of the mark, widespread critical assessments; notice by independent sources of the products identified by the mark; and the general reputation of the products. [In re Mr. Recipe, 118 USPQ2d at 1086](#) (citing [Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305-06, 1309 \(Fed. Cir. 2002\)](#)). As the party asserting that its mark is famous, [*42] Opposer has the burden of proving 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 claims that its mark achieved fame in the medical device industry when the **ROOT** monitor was awarded the 2015 GOLD Medical Design Excellence Award, "the highest level of recognition presented in the Medical Design Excellence Award competition, and is the highest achievement awarded in the medical device industry."⁵⁸ Opposer further contends that it is "a recognized leader in the U.S. pulse oximeter market, which includes Opposer's **ROOT** monitors. Opposer's annual revenue for 2015 was approximately \$ 650 million. Accordingly, Opposer's monitors are well-known in the medical industry."⁵⁹

⁵⁵ Opposer's brief p. 21, 14 TTABVUE 28.

⁵⁶ Applicant's brief p. 8, 15 TTABVUE 10.

⁵⁷ See text above accompanying footnotes 19-23.

⁵⁸ Opposer's brief p. 21, 14 TTABVUE 28, citing Budreau Dep. 20:21-22:3, Ex. 2, 13 TTABVUE 23-25, 102-130.

⁵⁹ Opposer's brief p. 21, 14 TTABVUE 28, citing Budreau Dep.13:9-13, 13 TTABVUE 16.

[*43]

Applicant responds that Opposer has failed to carry its burden of proving commercial strength; it has failed to present sales or advertising figures for its **ROOT** monitor products; it only presented irrelevant evidence as to the company as a whole; and the only consumer recognition it points to is "a fairly obscure industry product design award"; Opposer presented no evidence of recognition among general consumers.⁶⁰

We consider a mark's commercial strength with the class of consumers and potential consumers of a product. [*Palm Bay Imps.*, 73 USPQ2d at 1694-95](#). In this case, that would be health care professionals and patients and other members of the public who use the monitoring devices. Opposer's medical design excellence award would tend to catch the attention of health care professionals, and Opposer has used the award to promote its **ROOT** monitor among them.⁶¹ Opposer's remaining evidence, though, fails to focus on its **ROOT** [*44] mark. Its Director of Marketing Communications testified that Masimo is a widely known, high profile company in the patient monitoring field; that its customers know it as a company that produces a premium product; that it has a very good reputation; that it is growing yearly in sales and revenue, with \$ 630 million in revenue in 2015 and a 40 percent share of the U.S. pulse oximetry market; and that it is expanding, not just in hospital space but in consumer space.⁶² That evidence may show Opposer's general popularity, but Opposer has offered a variety of health measurement devices under other marks, such as RADICAL-7, RADIUS-7, RAD-8, MIGHTYSAT, and PRONTO-7.⁶³ Its evidence does not demonstrate the commercial strength of its **ROOT** mark in particular. Thus, Opposer has not proven that its **ROOT** mark is commercially strong.

[*45]

The fifth *DuPont* factor is neutral.

IV. Conclusion

We have considered of all of the evidence of record and all of the parties' arguments, including evidence and arguments not specifically discussed in this opinion, as it pertains to the relevant *DuPont* likelihood of confusion factors. The marks are similar, the goods are in-part identical and in-part complementary and related and move in the same channels of trade. These factors outweigh any purchaser sophistication and care. The evidence as a whole leads us to conclude that there is a likelihood of confusion under Section 2(d).

End of Document

⁶⁰ Applicant's brief p. 8, 15 TTABVUE 10.

⁶¹ Budreau Dep. 20:21-22:3, Ex. 2, 13 TTABVUE 23-25, 102-130.

⁶² Budreau Dep.13:9-13, 13 TTABVUE 16.

⁶³ Opposer's brief pp. 8-11, 14 TTABVUE 15-18.

Overstock.com, Inc. v. J. Becker Mgmt. , 2015 TTAB LEXIS 211

Trademark Trial and Appeal Board

June 25, 2015, Decided

Opposition No. 91203624

Reporter

2015 TTAB LEXIS 211 *

Overstock.com, Inc. v. J. Becker Management

Subsequent History:

Related proceeding at [*Allure Furniture & Mattress, Inc. v. J. Becker Mgmt., 2015 TTAB LEXIS 347 \(Trademark Trial & App. Bd., Sept. 1, 2015\)*](#)

Disposition: [*1]

Decision: The opposition is dismissed. Pending disposition of Opposition No. 91203625, the application will be remanded to the Examining Attorney for further consideration of the issue identified herein, under Rule 2.131.

Core Terms

OVERSTOCK, marks, notice, on-line, retail store, website, registration, consumers, retail, likelihood of confusion, Printouts, annual report, fame, advertising, mattresses, furniture, products, wording, internet, recitation, weak, featuring, pleaded, sleep, declaration, third-party, business record, motion to amend, Trademark Rule, similarity

Counsel

Alan J. Howarth of Clayton, Howarth & Cannon PC. for Overstock.com, Inc.

Allison M. Corder of Valauskas Corder LLC for J. Becker Management.

Panel: Before Kuhlke, Wellington, and Gorowitz, Administrative Trademark Judges.

Opinion By:

Wellington, Thomas W.

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Wellington, Administrative Trademark Judge:

Overstock.com, Inc. ("Opposer") opposes the application filed by J. Becker Management, Inc. to register the mark:



Image Name

for "retail store and on-line retail store services featuring furniture and sleep products" in International Class 35.¹ The exclusive right to the wording MATTRESS OVERSTOCK has been disclaimed in the application.

[*2]

Opposer claims a likelihood of confusion with its registered mark **OVERSTOCK.COM** (Registration No. 2939764 or, hereinafter "Reg. '764") for "online wholesale and retail store services featuring general consumer merchandise, namely, clothing, shoes, bath and body products, jewelry, electronics, cookware, housewares, appliances, furniture, linens, pillows, decorative accessories, office furniture and accessories, toys, games, sporting goods, tools, outdoor lawn and garden equipment, pet supplies and paper products" in International Class 35.² In particular, Opposer pleads that it has "built up goodwill" in its mark; that Applicant's mark is "a colorable imitation" of Opposer's mark; that Applicant's services are "the same, similar and/or related to" the services in connection with which Opposer uses its mark; and that "registration and/or use" of Applicant's mark is likely to cause confusion, mistake and/or deceive as to origin.

[*3]

Applicant filed an answer denying the salient allegations of Opposer's likelihood of confusion claim.

I. Applicant's Affirmative Defense -- Motion to Amend Its Recitation of Services

In its answer, Applicant raised an affirmative defense by asserting that it seeks to amend its recitation of services to exclude "online" retail store services, that this amendment "will avoid a likelihood of confusion," and that it is "at least entitled to registration" of its mark in connection with the services, as amended.³ Applicant elaborated that it "is not using ... [and] has no intent-to-use" its mark in connection with the excluded services.⁴ Applicant filed a motion to amend its application in this regard on the same day as its answer.⁵ The Board subsequently acknowledged the motion and deferred consideration until final decision.⁶

In its trial brief, however, Applicant inexplicably stated that it "agrees with Opposer's **[*4]** request to the Board to deny Applicant's proposed amendment to [Applicant's] services." Brief, p. 18 (at fn. 6), referencing page 17 of Opposer's Brief. Applicant goes on to admit that "the services of the parties" overlap. *Id.*

¹ Application Serial No. 77587536 was filed on October 7, 2008 and amended to seek registration on the Principal Register on March 17, 2010. The application is based on a statement of first use in commerce and anywhere on May 11, 2005, under Section 1(a) of the Trademark Act.

² Registration No. 2939764 issued on April 12, 2005 under Section 2(f) ("acquired distinctiveness") of the Trademark Act, and has been renewed. Opposer attached printouts for the registration from the USPTO electronic database TESS with the Notice of Opposition.

³ 6 TTABVue.

⁴ *Id.*

⁵ *Id.*

⁶ 11 TTABVue.

Based on Applicant's statements in its brief, we consider its motion to amend the recitation of services as having been withdrawn. Accordingly, Applicant's proposed amendment is given no further consideration, except as explained at the end of this decision. See, *infra*, "Remand Application to Examining Attorney."

To be clear, the recitation of services in the involved application remains unchanged for purposes of our likelihood of confusion analysis, namely, "retail store and on-line retail store services featuring furniture and sleep products."

II. Evidentiary Objections

Applicant raises several objections to various evidentiary submissions made by Opposer. We address the objections by the types of materials being introduced or the basis for the objection.

Procedural Objections to Notice of Reliance Materials

Procedural objections to the introduction of evidence must be raised promptly. If a procedural objection involves a defect [*5] that may be cured promptly, but is not timely raised, the objection may be deemed to be waived. See TBMP 707.02(b) and cases cited therein.

Applicant objects, for the first time in its trial brief, to various internet materials submitted by Opposer under notice of reliance on the basis that the URL (website address) is either missing or incomplete. Because this is the type of defect that Opposer could have promptly cured had Applicant's objection been timely raised, it is deemed waived. See *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) ("[a]ny shortcomings in respondent's original submission ... under notice of reliance, such as its failure to identify the URL and when the document was actually accessed (either printed out or downloaded), are procedural deficiencies that were not timely raised by petitioner and thus have been waived").

Timeliness of Opposer's Second Notice of Reliance

Applicant's objection to Opposer's second notice of reliance as untimely is overruled. Opposer's trial period, as rescheduled, ended on June 29, 2014 which was a Sunday, and the second notice of reliance was filed on the [*6] following date, and thus is considered timely, pursuant to Trademark Rule 2.196 ("When the day ... for taking any action ... falls on a Saturday, Sunday or Federal holiday ..., the action may be taken ... on the next succeeding day ..."); see also, TBMP 112 (Times for Taking Action).

Byrne Declaration

Opposer submitted, under its first notice of reliance, the file for its registration No. 2939764 which includes a "Declaration of Distinctiveness" executed by Patrick Byrne in 2004. Applicant objects to Opposer's reliance on this declaration because it is not testimony and is not contemporary.

Opposer may introduce the file history of a registration file, including all materials submitted in the prosecution, as an official record under a notice of reliance. Trademark Rule 2.122(e); see also, TBMP 704.03(b)(1). However, without testimony, the registration file materials may have limited probative value. Absent an agreement in writing by the parties allowing testimony to be submitted in the form of an affidavit, testimony must be taken by deposition upon oral examination in accordance with [37 C.F.R. § 2.123](#), or by deposition upon written questions in accordance with [*7] [37 C.F.R. § 2.124](#). See also TBMP § 703.

In sum, although the Byrne declaration may be introduced as part of a registration's file history, it cannot substitute for testimony and statements made in the declaration are not considered for the truth of the matter asserted.

General Hearsay Objections/ Opposer's 10-K Reports

Opposer submitted various internet materials under three notices of reliance. Without accompanying relevant testimony, the internet evidence is similar to printed publications and is only admissible for what it shows on its face. See, e.g., *7-Eleven Inc v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007) (materials made of record by notice

of reliance under [37 C.F.R. § 2.122\(e\)](#) not admissible for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters); *Midwest Plastic Fabricators Inc v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report in evidence only for what it showed on its face), *aff'd*, [906 F.2d 1568, 15 USPQ2d 1359 \(Fed. Cir. 1990\)](#).

With respect to Opposer's 2012 10-K annual report filed with the U.S. [*8] Securities and Exchange Commission (SEC), we note that annual reports are not considered printed publications for purposes of submitting under a notice of reliance pursuant to Trademark Rule 2.122(e); however, they can still be made of record by notice of reliance in the same manner as other internet-available materials. See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) ("This approach facilitates the introduction of matter for the limited purpose of demonstrating what the documents show on their face.") Again, although the annual report is in evidence for what it shows on its face, factual assertions set forth therein are mere hearsay unless supported by testimony. Opposer argues that the annual report is "admissible as exception to the general rule against hearsay as a record of regularly conducted activity under Federal Rule of Evidence 803(6)." Reply Brief, p. 8. However, since there is no testimony identifying and authenticating the annual report as a business record, and it was introduced as a publicly available document obtained from the internet, the hearsay rule applies.

Applicant also objected for the first time in its brief to Opposer's [*9] reliance on the annual report for purposes of establishing the fame of its mark on the basis that Opposer did not state the document as being relevant to fame in the notice of reliance. Because this is a curable defect the objection is untimely. *Fujifilm SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234, 1237 (TTAB 2014). Moreover, when evidence has been made of record it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. See [Dynamark Corp. v. Weed Eaters, Inc.](#), 207 USPQ 1026, 1028 n.2 (TTAB 1980). Nevertheless, Opposer cannot rely on any statements made in the annual report for purposes of establishing the truth of the matter asserted, the annual report has no real probative value with respect to the factor of fame.

In sum, all of the documents obtained from the internet and submitted under notices of reliance are admissible solely for purposes of what they show on their face. These internet printouts, including Opposer's 10-K annual report, cannot be used to establish the truth of any matters asserted in the documents.

Opposer's Advertisements

Under its second notice of reliance, Opposer attached [*10] copies of what is described as "direct mail advertising mailed by [Opposer] to customers and potential customers on or about [from 2008 to 2014]." ⁷ Inasmuch as these are not printed publications or otherwise publicly available materials obtained from the internet, they are not admissible under a notice of reliance. *Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (advertising invoices and other advertising documents not admissible under notice of reliance alone); see also, [Wagner Electric Corp. v. Raygo Wagner, Inc.](#), 192 USPQ 33, 36 n.10 (TTAB 1976). Opposer's assertion that they constitute business records of "regularly conducted activity" and as such are admissible under [FRE 803\(6\)](#) is not well-taken. They do not appear to be business records and have not been authenticated as business records. Moreover, a company's business records do not constitute official records and are not self-authenticating. Thus, they cannot be submitted under notice of reliance. See *Research In Motion Ltd. V. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009).

[*11]

Accordingly, these materials (specifically "Exhibit A" attached to Opposer's second notice of reliance) are not of record and are given no further consideration.

III. Record

⁷ 23 TTABVUE.

The record in this case consists of the pleadings and, by rule, the file of the involved application. Trademark Rule 2.122(b)(1).

Opposer has made its pleaded registration (Reg. '764) for the mark OVERSTOCK.COM of record by attaching a copy thereof showing title and status from the PTO electronic database to the Notice of Opposition. Trademark Rule 2.122(d)(1).

Opposer also submitted the following materials under three notices of reliance:⁸

. A copy of the file history of Opposer's pleaded Reg. '764;⁹

. Printouts from the PTO TSDR electronic database for Registrations Nos. 3676884 (OVERSTOCK.COM CARS), 3676885 (OVERSTOCK CARS), 3693462 (OVERSTOCK.COM IT'S ALL ABOUT THE PRICES), 3728854 (LIVE BETTER WITH OVERSTOCK.COM), 3693463 (OVERSTOCK.COM IT'S ALL ABOUT THE PRICE), 3693464 (OVERSTOCK.COM PRICES), 3693465 (OVERSTOCK.COM PRICE), 3952223 (OVERSTOCKTOBER), 3069011 (OVERSTOCK.COM YOUR ONLINE OUTLET), and 4218453 (OVERSTOCK.COM AUCTIONS), 4303487 (OVERSTOCK.COM REDLINE DEALS);¹⁰

. Printouts [*12] from Opposer's website (www.overstock.com), including press releases, advertised products, a 2012 10-K annual report, and information concerning an outlet store;¹¹

. Printouts from Yahoo! Finance website;¹²

. Printouts obtained from the Internet Archive Wayback Machine (www.archive.org/web) purportedly showing Opposer's website home page at points from 1999-2013;¹³

. Advertisements from printed publications, e.g., Better Homes and Gardens, Family Circle, Good Housekeeping, etc.;¹⁴

. Printouts from the website www.forbes.com;¹⁵

. "Reprint" from publication Consumer Reports titled "Best Online Retailers";¹⁶

. Partial file histories for Opposition Nos. 91175307, 91205850, 91212400, 91212402, 91213616, and 91213617, and Cancellation Nos. 92054852, 92055634, 92056429, and 92057569; and

⁸ The advertisements submitted as "Exhibit A" under Opposer's first notice of reliance are not listed in view of Applicant's sustained objection.

⁹ 16 TTABVUE.

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.*

¹³ 23 TTABVUE.>

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

. Printouts from websites www.Overstock.com, www.phenomsonline.com, and www.usedcars.Overstock.com.

For its part, Applicant submitted the following materials under a notice of reliance during its trial period: ¹⁷

. Printouts from its website www.mattressoverstockusa.com;

. Printouts from the PTO TSDR electronic database for Registrations Nos. 3356793 (DIRTOVERSTOCK), 3871710 (HUNTFISHOVERSTOCK), 3518586 (OVERSTOCKDRUGSTORE.COM), 3843994 (OVERSTOCKDEALS.COM), 3694437 (OVERSTOCKDEALS.COM), 3249262 (OVERSTOCKJEWELER.COM), 3783032 (ACOVERSTOCK); 3945614 (WOW WEEKENDS OVERSTOCK WAREHOUSE); 3522517 (SNOWOVERSTOCK) 3220880 (STREETOVERSTOCK); 3226032 (ATVOVERSTOCK); and 3447230 (ASIA OVERSTOCK);

. Printouts from the websites www.dirtoverstock.com, www.hfverstock.com, www.OverstockDrugStore.com, www.islandoverstock.com, www.tcoverstock.com, www.recreationoverstock.com, www.OverstockLiquidationCo.com, www.OverstockAccessories.com, www.OverstockFurnitureDeals.com, www.cincinnatiOverstockWarehouse.com, www.louisvilleOverstockWarehouse.com, www.lexingtonOverstockWarehouse.com, www.automation-Overstock.com, www.nationalOverstockWarehouse.com, www.bgoOverstockWarehouse.com, www.hostpitalOverstock.com, www.furnitureMadeAffordable.com (for "Overstock Furniture Sales" website), www.hockeyoverstock.com, www.golfOverstock.com, www.beautyOverstock.net, www.OverstockDeals.com, www.OverstockJeweler.com, www.amazon.com, and Opposer's website www.Overstock.com;

. Opposer's responses to Applicant's first set of admissions Nos. 1-10; and

. Opposer's response to Applicant's interrogatory No. 9.

IV. Opposer's Standing and Priority

Because Opposer's pleaded registration for the mark OVERSTOCK.COM is of record, this is sufficient to establish Opposer's standing and removes priority as an issue with respect to this mark and services vis-a-vis Applicant's [*15] mark and services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

V. Likelihood of Confusion

We now turn our attention to likelihood of confusion. Our determination under Trademark Act Section 2(d) is based on an analysis of all 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); see also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. Similarity of the Services and Channels of Trade

Applicant's services include "retail store and on-line retail services featuring furniture and sleep products" and Opposer's services include "on-line wholesale and retail store services featuring general consumer merchandise, namely, ... furniture, linens, pillows, ... office furniture," and thus they are partially overlapping. Specifically, both parties' services include the on-line retail sale of furniture and, because [*16] "sleep products" is a broad term, the parties' services would include the online retail sale of linens and pillows. In other words, the services are, at least, partially identical. With respect to Applicant's retail "brick and mortar" store services, the record shows that these services, too, are closely related to Opposer's on-line retail store services inasmuch as they feature the same goods.

¹⁷ 19-20, 22 TTABVUE.

In line with our findings, and as previously noted, Applicant admits that "it is clear the services of the parties overlap." Brief, p. 18. Applicant further admits that "[w]ithout limitations to the channels of trade in Applicant's application or in Opposer's registration -- and both directed to retail and on-line services -- Applicant agrees with the presumption that the channels of trade overlap." *Id.* at 19-20.

In view of the above, there is no dispute that the parties' retail services are, in part, identical and otherwise closely related. Moreover, we must presume these services, at least where they overlap, will move in the same channels of trade and will be made available to the same potential classes of ordinary consumers. See [*Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 \(Fed. Cir. 2011\)](#). [*17] See also, *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); see also [*In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 \(Fed. Cir. 2012\)](#) (finding Board entitled to rely on this presumption).

Accordingly, the second and third [*du Pont*](#) factors strongly support a finding of likely confusion.

B. Similarity of the Marks

We now consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. [*Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 \(Fed. Cir. 2005\)](#).

In comparing the marks, the single and obvious point of similarity is that the word "overstock" is in both Opposer's OVERSTOCK.COM mark as well as Applicant's mark:



Image Name

There are several points of dissimilarity. First, while the term OVERSTOCK is primary in Opposer's mark, it is the second word in Applicant's mark making it, visually and aurally, less prominent in Applicant's mark. There are also elements within each mark not found in [*18] the other. In particular, Opposer has the addition of the top level domain (TLD) ".com." in its mark. Applicant's mark, on the other hand, begins with the word MATTRESS and contains a "four squares" design on the right. Generally, the addition of these elements has little significance for purposes of distinguishing trademarks. That is, ".com," being a TLD indicator for commercial websites, has been held to have no source-identifying function. See [*In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682 \(Fed. Cir. 2009\)](#) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding," and applicant "presented no evidence that ".com" evoked anything but a commercial internet domain"); see also, TMEP § 1215.01 *et seq.* ("Marks Composed, in Whole or in Part, of Domain Names"). Likewise, the word "mattress," in the context of Applicant's services, is merely descriptive or generic for Applicant's retail store services that feature "sleep products," which would include mattresses. Finally, although the design element in Applicant's mark is not descriptive, it is not highly distinctive and, in general, with marks that combine a [*19] design with wording, it is usually the words that are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. [*CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 \(Fed. Cir. 1983\)](#) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.")

As to the meanings or connotations of the marks, there is no arbitrary or inherently distinctive wording in either mark. Again, ".com" informs consumers that Opposer's mark is also a domain name and the word "mattress" merely

describes goods that Applicant is selling. We further take notice that the shared term "overstock" is defined as follows:¹⁸

Overstock:

(verb) 1. To stock (a store, etc.) with more of (something) than can be readily used.

(noun) 1. Too large a stock.

[*20]

In the prosecution of both the underlying application for Opposer's pleaded registration '764 as well as the involved application in this proceeding, the respective Examining Attorneys argued that "overstock" is merely descriptive of retail store services. Indeed, Opposer's entire mark, OVERSTOCK.COM, was initially refused registration on the basis that it is merely descriptive of the services¹⁹ and Opposer was only able to register the mark under Section 2(f) of the Trademark Act with a showing that it had acquired distinctiveness. Applicant, on the other hand, submitted a disclaimer of the exclusive right to use the descriptive wording "mattress overstock," as required by the Examining Attorney. The literal terms in both marks are descriptive of the services. For the sake of clarity, we note that the acquired distinctiveness presumption is to Opposer's mark, OVERSTOCK.COM, *as a whole*, and not to any of the individual elements, *e.g.*, the word OVERSTOCK. The wording in the mark helps create a descriptive overall commercial impression, namely, that of a website involving the sale of goods that have been "overstocked" or are considered "overstock." As to Applicant's mark, [*21] on the other hand, while the mark connotes the sale of overstocked mattresses, consumers are likely to also notice the design element or place more emphasis on this element, given that it is the only non-descriptive portion of the mark.

After making the above comparison of the two marks, it becomes readily apparent that a determination of whether the two marks are confusingly similar rests almost entirely on the degree of significance the term "overstock" plays in the minds of the relevant consuming public. Indeed, as the parties' arguments reflect, this proceeding revolves around Applicant's assertion that the shared term is weak and consumers will "look to other portions of the mark[s] for small differences as a means of distinguishing the source of the [services] in the marketplace," and Opposer's assertion that its mark is "famous" and "should be afforded a broad scope of legal protection." *Applic. Brief at p. 24 and Opp. Brief at p. 25.* We discuss address [*22] these two factors in the following sections.

C. Weakness of the term OVERSTOCK in the Context of Retail Services; the Number and Nature of Similar Marks in Use for Similar Services

In light of its defined meaning, there is an inherent weakness in the term "overstock" in connection with retail services. Consumers are likely to perceive the term as describing the types of goods being sold, *i.e.*, overstocked items that may be on discount. The evidence of third-party use and registration of this term in marks corroborates that consumers will immediately understand the term in this manner. For example, there is a "Hospital Overstock" website (www.hospitaloverstock.com) touting the sale of "NAME BRAND MEDICAL SUPPLIES CLOSEOUT PRICES" and offering to buy:²⁰

Got Medical Overstock?

Sell It to Us. Are you looking to get rid of your excess medical Supplies? We want to buy them! Please fill out our Seller's Form to Provide us with details of the products you would like to sell us.

¹⁸ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁹ 16 TTABVUE (file history of Reg. '764).

²⁰ 22 TTABVUE 9.

[*23]

Another website, "Island Overstock" (www.islandoverstock.com), advertises its consignment services:

...we invite you to become a seller at one of our events. You can sell your overstock pieces -- and increase you visibility and revenue.

This usage corroborates the weakness of "overstock" and shows that consumers will readily understand its meaning. The term is frequently and easily used by retail businesses in describing or advertising their normal course of activities.

Applicant argues that OVERSTOCK is also commercially weak or diluted as a result of extensive third-party use of the term in connection with retail store services. In support, Applicant submitted copies of seven third-party registrations for marks that include the term OVERSTOCK in connection with retail store services, as well as the printouts from over twenty third-party websites for which the URL and the website name include the term "overstock."

Additionally, and aside from the previously mentioned "Hospital Overstock" and "Island Overstock" websites, the record includes materials from various other entities, such as:

- . BEAUTY OVERSTOCK "boasts an incredible selection of beauty products for customers [*24] nationwide ... offer discontinued items to customers at fraction of the original cost"; ²¹
- . GOLF OVERSTOCK "Golf Equipment: Golf Clubs, Golf Bags, Gold Shoes, Golf Balls, Golf Apparel & Accessories"; ²²
- . HOCKEY OVERSTOCK.COM "Hockey Equipment at the best prices"; ²³
- . RECREATION OVERSTOCK "close out deals on boat covers, motorcycle bags and covers"; ²⁴
- . OVERSTOCK FURNITURE "Overstocked * Underpriced ... Click here for CRAZY LOW PRICES on our overstocks!" ²⁵ and "At Overstock Furniture we buy overstocks, one-of-a-kinds, factory sell outs, design prototypes, and more to pass the savings on to you."; ²⁶
- . OVERSTOCK LIQUIDATION "Atlanta's leading overstock retailer ... We're always tagging overstock & slow moving mattresses and furniture, so you can enjoy extra deep discounts!"; ²⁷ and
- . AUTOMATION OVERSTOCK "surplus automation equipment, overstock automation devices, manufacturer overruns..." ²⁸

[*25]

Opposer has contested the probative value of these materials because Applicant did not submit additional evidence showing that the public is actually aware of these third-party marks or the extent of usage. While this is true and we cannot gauge the popularity of or exposure to these websites (e.g., the number of people who have viewed them,

²¹ 20 TTABVUE 3.

²² *Id.* at 4-5.

²³ *Id.* at 6-7.

²⁴ *Id.* at 14.

²⁵ *Id.* at 18.

²⁶ *Id.* at 19.

²⁷ *Id.* at 22.

²⁸ *Id.* at 25.

sales, etc.), the sheer number of these websites and manner of use makes evident that OVERSTOCK is a term that may be used descriptively, if not generically, for goods being sold at a discount by retail outlets. On their face, the materials show that consumers will readily understand the descriptive significance of the word OVERSTOCK, when used in connection with retail stores, and the consumers are thus not likely to place any importance on the fact that two or more entities share this term.

Opposer also argues, in its brief under "number and nature of similar marks in use in connection with similar services," that its OVERSTOCK.COM mark is "one of a family of marks used by [Opposer] in connection with online store services. [*26]" Brief, p. 26. Generally, whether a family of marks exists is unrelated to the factor involving dilution of the term by third-party use; rather, the claim is generally asserted by a plaintiff arguing that there is a likelihood of confusion between the common characteristic to its family and defendant's mark. [*Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 597 \(TTAB 1980\)](#) ("the rationale for the 'family of marks' theory is that a party has in effect established a 'secondary meaning' in a term which serves as the characteristic feature of a number of marks used and promoted together by him in his field of endeavor, so that the subsequent use by another party of a mark containing this term for like or related goods would be likely to create an association of the later mark with the prior user and/or his 'family of marks'.") To the extent that Opposer is seeking to rely on a family of marks in this manner, it did not plead a family of marks and a likelihood of confusion claim based on an OVERSTOCK family of marks has not been tried.²⁹ *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (plaintiff's [*27] "family of marks" claim, raised for the first time in its brief not considered because it was neither pleaded nor tried by the parties). We would also be remiss if we did not point out that a family of marks generally will not be found to exist where the asserted family element is a descriptive or common term that does not serve as a distinguishing feature of the marks under consideration. See [*Servo Corp. of America v. Servo-Tek Products Co.*, 289 F.2d 955, 48 C.C.P.A. 978, 1961 Dec. Comm'r Pat. 380, 129 USPQ 352 \(CCPA 1961\)](#); and [*American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457 \(TTAB 1978\)](#). Although Opposer clearly has rights in the mark OVERSTOCK.COM, it has been demonstrated that the term OVERSTOCK, by itself, is descriptive in the context of retail store services.

[*28]

In sum, OVERSTOCK is the type of term that can be and is used by third parties to describe their retail store services and we conclude it is conceptually very weak. As a result, and in conjunction with our similarity of the marks analysis, the fact that the two marks share this term has little significance.

D. Strength or Fame of Opposer's Mark

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. [*Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 \(Fed. Cir. 1992\)](#). In the likelihood of confusion context, fame "varies along a spectrum from very strong to very weak." [*Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 \(Fed. Cir. 2012\)](#) (quoting [*Palm Bay*, 396 F.3d 1369, 73 USPQ2d 1689](#)). In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. [*Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 \(TTAB 2007\)](#). [*29] In reviewing the evidence of fame, we are mindful that fame is not a "yes or no" decision but usually involves placing a mark's strength in the spectrum of very weak to famous. [*Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 \(TTAB 2005\)](#) (stating that "[f]ame is relative . . . not absolute"), *aff'd*, [*479 F.3d 825, 81 USPQ2d 1919 \(Fed. Cir. 2007\)*](#).

²⁹ Even had Opposer pleaded a family of OVERSTOCK marks, the evidence of record is insufficient to support a finding that "the pattern of usage of the common element is sufficient to be indicative of the origin of the family." [*Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 \(TTAB 2009\)](#) citing to [*Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 \(TTAB 2007\)](#) and [*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 \(Fed. Cir. 1991\)](#).

At the outset, we note the evidence submitted by Opposer cannot be relied upon in the manner Opposer intends. As explained in "Evidentiary Objections," *infra*, nearly all of the materials submitted by Opposer cannot be used to prove statements made in the materials. Opposer's reliance on these materials to support its assertions involving fame is unfounded. As a result, we can make no findings of fact regarding factors involving fame, such as: the number of years Opposer has used its mark, the extent of Opposer's advertising activities or sales figures based on annual reports, the number of consumers, etc. While we can rely on certain materials to show that Opposer's services were advertised or received exposure in publications, such as Forbes Magazine, the statements **[*30]** made in these publications, e.g., Opposer is "the best performing online retailer" or that it "has gained plenty of notoriety," are not established facts. Similarly, printouts from the "Archive Wayback Machine" (www.archive.org), on their face, do not prove the manner of use or appearance of Opposer's website since 1999 and subsequent years.

Given the limitations to Opposer's evidentiary submissions, we cannot find on this record that Opposer's OVERSTOCK.COM has achieved a level of recognition to justify a heightened scope of protection. Accordingly, the fifth *du Pont* factor remains neutral in our likelihood of confusion analysis.

VI. Conclusion On this record, we find no likelihood of confusion between Opposer's mark, OVERSTOCK.COM,



and Applicant's mark, Image Name

In spite of our findings that the marks are used in connection, at least in part, with identical on-line retail store services and will be offered to the same consumers in the same trade channels, we find the marks themselves are sufficiently different such that consumers will distinguish the sources of the retail store services. The fact that both marks contain the term **[*31]** OVERSTOCK is not so significant to make the marks confusingly similar.

Remand Application to Examining Attorney

Trademark Rule 2.131, [37 CFR § 2.131](#), provides:

If, during an inter partes proceeding involving an application under Section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in the light of the reference by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

Although we have considered Applicant's affirmative defense, and corresponding motion to amend its recitation **[*32]** of services, as effectively withdrawn, an issue of Applicant's use of its mark on all services, as recited in the application, has been raised.

As previously noted, Applicant made the following statements in its Answer ("first affirmative defense") prior to effectively withdrawing its request to amend the recitation: ³⁰

Applicant is not using the MATTRESS OVERSTOCK (design) mark and has no intent-to-use the MATTRESS OVERSTOCK (design) mark in connection with the excluded services.

Applicant also made the following statement in its motion to amend the recitation of services: ³¹

³⁰ 6 TTABVUE 7.

³¹ 7 TTABVUE 3.

Upon dismissal of the Opposition, Applicant will cease use of the MATTRESS OVERSTOCK (design) mark in connection with the services that are removed from the services identification.

We further [*33] note that Applicant submitted at least one printout (Exhibit 1 under its notice of reliance), showing use of its mark in connection with on-line retail store services featuring "mattresses ... pillows ... sleep accessories").

The aforementioned statements by Applicant, as well as the exhibit, are all of record in this proceeding. Taken together, they raise the issue of whether or not Applicant is currently using the mark in connection with "on-line retail services" and whether it has any intent to use the mark in connection with on-line retail services. In particular, we cannot ignore Applicant's express statement that it does not use its mark and has no intention of using its mark in connection with online retail store services featuring furniture and sleep products. Under [15 U.S.C. § 1127](#), a mark is considered abandoned when "its use has been discontinued with intent not to resume such use."

The issue of whether or not Applicant may no longer be using, or has abandoned, its mark in connection with on-line retail services is a matter that was not tried in this proceeding. Moreover, this is an issue that may render the mark of the involved application unregistrable [*34] with respect to those services. In other words, because the application is based on use, under Section 1(a) ("use in commerce"), it should be amended to delete any services for which Applicant does not currently use the mark and has no intent to do so.

In view thereof and in our discretion, we find it is necessary to remand the application to the assigned Trademark Examining Attorney for further examination. Rule 2.131; *see also* TBMP § 805. In particular, we recommend the assigned Examining Attorney inquire whether the application requires further amendment; a query should be made whether Applicant is no longer using its mark in connection with on-line services and confirmation that the application's declaration of use of the mark in commerce remains valid.

However, because the involved application is also the subject of Opposition No. 91203625, we defer remanding jurisdiction of the application until a decision has issued by the Board in that case.

End of Document

Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC, 2022 TTAB LEXIS 383

Trademark Trial and Appeal Board

October 31, 2022, Decided

Opposition No. 91263919

Reporter

2022 TTAB LEXIS 383 *

Shenzhen IVPS Technology Co. Ltd. v. Fancy Pants Products, LLC

Disposition: [*1] Decision: The opposition is dismissed.

Core Terms

SMOK, marks, registration, smoke, cigarettes, electronic, website, pleaded, notice, Register, vaping, webpages, ECIG, MODS, likelihood of confusion, phonetic, MINI, PIPE, third-party, channels, copies, filing date, prior use, offering, goods and services, Trademark, cannabis, products, ALO, witness testimony

Counsel

John Alunit of Alunit IP for Shenzhen IVPS Technology Co. Ltd.

Rick Ruz of Ruz & Ruz PL for Fancy Pants Products, LLC.

Panel: Before Goodman, Pologeorgis and English, Administrative Trademark Judges.

Opinion By:

Goodman, Cheryl S.

Opinion

This Opinion is a Precedent of the TTAB

Opinion by Goodman, Administrative Trademark Judge:



Fancy Pants Products, LLC ("Applicant") filed an application to register the mark ("smokes" disclaimed) on the Principal Register for "Cigarettes containing tobacco substitutes not for medical purposes

containing only cannabis with a delta-9 THC concentration of not more than 0.3% on a dry weight basis" in International Class 34.¹

Shenzhen IVPS Technology Co. Ltd ("Opposer") opposes registration of Applicant's mark on the ground of likelihood of confusion under Section 2(d), 15 U.S.C. § 1052(d). Opposer pleads ownership of eleven registered SMOK and SMOKformative marks for, among other things, electronic cigarettes, parts and components, [*3] and related services. Opposer's pleaded registrations include the Principal Register registration for the following mark:

SMOK (in standard characters, Section 2(f) claimed)² for the following goods and services:

Chargers for electronic cigarettes; Batteries for electronic cigarettes; Battery chargers for electronic cigarettes; Battery covers in the nature of battery cases for electronic cigarettes in International Class 9;

Electronic cigarettes; Oral vaporizers for smokers; Smokers' oral vaporizer refill cartridges sold empty; Electronic cigarette atomizers sold empty; Electronic cigarette refill cartridges sold empty; Component parts of electronic cigarettes in the nature of tanks for electronic cigarettes, coils for electronic cigarettes, drip tips for electronic cigarettes, tank tubes for electronic cigarettes, and silicone rings for electronic cigarettes in International Class 34; and

On-line retail store services featuring electronic cigarettes, oral vaporizers for smokers in International Class 35.³

Opposer also pleaded a family of marks alleging that "Opposer is also the owner of a family of marks around the wording SMOK in connection with various smoking articles in class 034" and that Opposer's prior use of its family of SMOK marks precedes Applicant's filing and use in commerce dates.⁴

1

Application Serial No. 87856115 has an amended filing date of December 20, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use and a date of first use in commerce of December 20, 2018. Applicant amended its filing date from the actual filing date to the effective date of the 2018 amendments to the Agricultural Marketing Act of 1946 ("Farm Bill") as provided in the Trademark Office's "Examination Guide 1-19 Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 [*2] Farm Bill" (May 2, 2019), <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%201-19.pdf>.

Applicant provided the following description of the mark: "The mark consists of an [sic] circle with two red lines, one inside the other separated by white space, that form the outer border of the circle. Each of the two red lines is broken in numerous places. The word 'Smokes' is in red and begins and ends with a capital letter 'S'. Immediately above the word, a solid red line connects with the first capital 'S' and continues over the remaining letters ending just past the last capital 'S'. Immediately under the word, a solid red line beginning to the left of the first capital 'S' underlines the entire word and connects with the bottom of the last capital 'S.'" The colors red and white are claimed as a feature of the mark but the color black represents background and is not claimed as a feature of the mark.

2

Registration No. 6072213 issued on the Principal Register on June 9, 2020 based on an application filed on July 31, 2018, listing a date of first use of May 12, 2011 and a date of first use in commerce of June [*4] 26, 2013.

3

The remaining ten pleaded registrations Opposer identified by mark and serial number in the notice of opposition are as follows: Registration No. 4745397 SMOK HOOKAH, Registration No. 4745398 SMOK ECIG, Registration No. 4745399 SMOK CIGAR, Registration No. 4745396 SMOK MINI, Registration No. 4745395 SMOK PIPE, Registration No. 4676828 SMOK TECHNOLOGY, Registration No. 4545449 SMOK, Registration No. 4676830 SMOK DUAL COILS, Registration No. 4676829 SMOK MODS, and Registration No. 4710763 SMOK FASHION. Notice of Opposition PP 3-4, 1 TTABVUE 7.

4

Applicant filed an answer denying the salient allegations in the notice of opposition and asserting amplifications of its denials of the likelihood of confusion claim.⁵

Only Opposer filed a brief in this case.⁶ Opposer submitted testimony and other evidence during its testimony period.

Applicant did not take testimony or introduce any evidence during its testimony period nor file a brief, but it is not required to do so. *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1531 n.13 (TTAB 2018) ("Because Respondent, as defendant herein, is under no obligation to submit evidence or a brief, we do not construe Respondent's failure to do so as a concession of the case.") (citing TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 801.02(b) (June 2017)). As plaintiff, Opposer bears the burden of proving its entitlement to a statutory cause of action and its Section 2(d) claim by a preponderance of [*6] the evidence. See *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 191 L. Ed. 2d 222, 113 USPQ2d 2045, 2049 (2015) ("The party opposing registration bears the burden of proof, see § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b)").

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. In addition, Opposer introduced notices of reliance upon Applicant's responses to requests for admissions,⁷ Applicant's initial disclosures, third-party website evidence, and pages from Opposer's and Applicant's websites.⁸ Opposer also submitted the declaration testimony of Freda Huang, Head of Global Sales for Opposer, and accompanying exhibits.⁹

Notice of Opposition PP 4, 8, 1 TTABVUE 7-8. Opposer argued in its brief that it owns a family of SMOK marks. Opposer's brief, 13 TTABVUE 13.

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4 TTABVUE. These amplifications are not true affirmative defenses. See, e.g., *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *4 n.5 (TTAB 2021). Applicant also alleged "failure to state a claim" in its answer which is not a true affirmative defense because it relates to an assertion of the insufficiency [*5] of the pleading of Opposer's claim rather than a statement of a defense to a properly pleaded claim. This "defense" has been waived because it was not pursued. *U.S. Olympic Comm. v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164, at *4 (TTAB 2021).

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References to the brief and to the record refer to the Board's TTABVUE docket system. Opposer's brief is at 13 TTABVUE. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refers to the page number(s) of that particular docket entry.

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Opposer has introduced into the record Applicant's responses to requests for admissions which, for the most part, are denials or effective denials. While any admissions are properly of record, the denials are not. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i); see also, e.g., *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1395 n.9 (TTAB 2016) ("admissions are properly of record, the denials are not"); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (a denial to a request for admission is inadmissible because it establishes neither the truth nor the falsity of the assertion, "but rather [*7] leaves the matter for proof at trial."). Therefore, Opposer's references to any of Applicant's denials have no probative value and we do not consider them.

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Opposer's Notices of reliance, 5-7 TTABVUE.

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Huang Declaration and exhibits, 8 TTABVUE.

Opposer also submitted, as exhibits to the notice of opposition, TESS (Trademark Electronic Search System) screenshot captures of all of its pleaded registrations, accompanied by photocopies of the original certificates of registration, for purposes of making the registrations of record. See Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).¹⁰

A. Are the pleaded registrations properly of record?

Trademark Rule 2.122(d)(1) provides the manner in which a plaintiff may properly make its pleaded registration(s) of record when submitting its pleading.¹¹ In 2007, to conform to existing practice in connection with the submission of pleaded registrations to be received in evidence and made part of the record, the Board amended Trademark Rule 2.122(d)(1) to provide for, in addition to the submission of a copy of a pleaded registration prepared by the Office showing current status and current title, the submission of a copy ("current printout of information") from the Office's [*8] electronic database records to establish current status and title of the registration.¹² MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42249, 42262 (August 1, 2007). See also *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) ("the inclusion in the amended rule of an option to prove a pleaded registration by relying on USPTO records ... can therefore only be taken as an indication that the Office meant to liberalize the means for proving a pleaded registration").¹³

In 2016, the Board again amended Trademark Rule 2.122(d)(1) to change "current printout of information" to "current copy of information" "to broaden the manner in which a registration may be attached to include, for example, printouts or downloads." MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).¹⁴ As presently amended, Trademark Rule 2.122(d)(1) provides:

A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in [*10] evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of

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Notice of Opposition, 1 TTABVue.

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Trademark Rule 2.122(d)(2) addresses proof of a pleaded registration during trial, by notice of reliance.

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The amended rule was effective August 31, 2007, and also removed the requirement that a plaintiff provide two copies of the registration prepared and issued by the Office. See also *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1602 n.3 (TTAB 2014) (noting that two copies of registration certificates are no longer required).

¹³

Although the policy set forth by amended Trademark Rule 2.122(d)(1) liberalized the nature of the documentation that must be submitted with the electronic filing of a notice of opposition or petition to cancel, the plaintiff still must electronically attach to the submission current status and current title copies of registrations or current copies of electronic database records showing status and title. *Melwani v. Allegiance* [*9] Corp., 97 USPQ2d 1537, 1540 (TTAB 2010) ("The amendment does not contemplate a plaintiff's mere inputting of a registration number when prompted by ESTTA, the Board's on-line filing system, to list any registration upon which the plaintiff relies. ... [to result in introduction of the registration of record]."). "The fact that completion of the ESTTA filing form [to list any registration on which plaintiff relies] results in the creation of electronic records in the Board's TTABVue system ... contain[ing] links to information on a pleaded registration, is for administrative ease and it is insufficient to make the pleaded registrations of record." *Id.* See also *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84 n.3 (TTAB 1987) ("The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office.").

¹⁴

The amended rule was effective January 14, 2017.

the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

Under the rule, in the context of being received into evidence "an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration," the term "current" has been interpreted as requiring the issuing date of the title and status copies of the pleaded registrations to "be substantially contemporaneous with the date of the filing in this Office of the notice of opposition." *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Prods. of Haw., Inc.*, 204 USPQ 144, 146 (TTAB 1979) (citing *Marriott Corp. v. Pappy's Enter., Inc.*, 192 USPQ 735, 736 (TTAB 1976)). The term "current" in this context also has been interpreted as "reasonably contemporaneous," "sufficiently recently," [*11] and "shortly prior." *Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) ("status and title" copies of registrations were not of record because they "cannot be considered to have been issued either subsequent to or at a time reasonably contemporaneous with the filing of the notice of opposition"); *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1461 n.4 (TTAB 1992) ("a status and title copy prepared and issued by the Office shortly prior to the filing of the opposition of record" is in evidence); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (in connection with the notice of reliance "the question of whether a photocopy of a pleaded registration has been prepared and issued by the Patent and Trademark Office or has been prepared by the Office sufficiently recently to show current status and title goes to the issue of the competency of the copies of the registration, per se").

We attribute the same meaning of "current" to the portion of Trademark Rule 2.122(d)(1) providing for submission of a "current copy of information from the electronic records database of the Office." Thus, the rule contemplates submission of a copy from the Office's electronic database records to be reasonably or substantially contemporaneous with the initiation of the proceeding, [*12] upon the filing of either the notice of opposition or petition to cancel. While a screenshot capture is an allowable form of a "copy" contemplated by the rule, the screenshot capture still must provide all necessary information to establish that it is "current."

In this case, the TESS screenshot captures of the pleaded registrations submitted by Opposer with the notice of opposition do not reflect the retrieval date of the database record or the date the screenshots were captured. As a result, with one exception, the copies do not conform to the requirement for "current" copies under the Trademark Rule.¹⁵ Similarly, Opposer's submission of copies of the original registration certificates of the pleaded registrations

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While a TSDR (Trademark Status and Document Retrieval) database inquiry for a registration record provides a retrieval date within the body of the result ("This page was generated by TSDR on 2022-06-29 16:15:10 EDT") and is reflected when the copy is generated from the download [*13] and print options offered (see example image in the Appendix attached to this decision), a TESS database search result provides the user with a date the database was last updated, (e.g., "TESS was last updated on Wed Jun 29 03:32:23 EDT 2022") and has no download or print options (see example image in the Appendix attached to this decision). Opposer's electronic copies are TESS screenshot captures that omitted the portion of the database result that identifies the database as TESS and the date the TESS database last updated. This information is reflected preceding the registration information when accessed in TESS. Two of Opposer's TESS submissions are reproduced in the Appendix attached to this decision.

Opposer's screenshots also do not contain a URL and a date accessed (if, for example, printed through the browser feature) which would be sufficient to establish the TESS database record copy is substantially or reasonably contemporaneous with the filing of the notice of opposition. *But see STX Financing, LLC v. Terrazas*, 2020 USPQ2d 10989, at *1 (TTAB 2020) (when submitted under notice of reliance, under Trademark Rule 2.122(e)(1), 37 C.F.R. § 2.122(e)(1), TESS printouts of third-party applications and registrations are official records, and there is no requirement [*14] that the submission meet the requirement of Internet materials), *appeal dismissed sub nom. STX Financing, LLC v. Vidal*, No. 22-1192, 2022 U.S. App. LEXIS 10209, 2022 WL 1124962 (Fed. Cir. Apr. 15, 2022).

attached as exhibits to the notice of opposition do not reflect current status and current title of the registrations and do not make the registrations of record, again with one exception.¹⁶

To summarize, undated copies of the electronic database records of the Office are not sufficient to make a registration of record because the Board cannot ascertain whether they are "substantially" or "reasonably" contemporaneous with the filing of the notice of opposition or petition to cancel. For the same reason, plain copies of registrations generally are not sufficient to make a registration of record. But if the pleaded registration issued "substantially" or "reasonably" contemporaneous with the filing of the notice of opposition or petition to cancel, the undated copy of the electronic database record of the Office or plain copy of the registration will be sufficient to establish current status and title and will be considered competent evidence. **[*15]** See *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (as an exception, allowing plain copies of registrations to constitute competent evidence, when the registration's issue date is "reasonably contemporaneous" with the filing date of the notice of opposition or petition for cancellation). This is the case for one of Opposer's registrations.

In particular, Principal Register Registration No. 6072213 for the mark SMOK (in standard characters, Section 2(f)), issued on the Principal Register on June 9, 2020, which is substantially or reasonably contemporaneous with the July 29, 2020 filing date of the notice of opposition.¹⁷ Therefore, we consider both the undated TESS screenshot copy and the plain copy of this registration to be competent evidence sufficient to make the registration of record.¹⁸ See *United Global Media Grp.*, 112 USPQ2d at 1043 (finding that a copy of the original certificate of registration that issued on March 29, 2011 was sufficiently contemporaneous to the July 20, 2011 filing date of the notice of opposition to make it of record even though no status and title copy accompanied the registration attached to the notice of opposition).

As for the ten remaining registrations, the TESS screenshot captures of the pleaded registrations SMOK, SMOK HOOKAH, SMOK ECIG, SMOK CIGAR, SMOK MINI, SMOK PIPE, SMOK TECHNOLOGY, SMOK DUAL COILS, SMOK MODS and SMOK FASHION, all issuing either in 2014 or 2015, are not substantially or reasonably contemporaneous with the July 29, 2020 filing date of the notice of opposition, and therefore, are not competent evidence of current status and current title. There are no stipulations in the record as to these registrations and no admissions in the answer to establish current status and current title of these pleaded registrations. See *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990). Nor were current status and title copies of these registrations introduced by notice of reliance, or by a witness who testified as to the current status and current title of these pleaded registrations. See Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2); *Hard Rock Cafe Int'l (USA) Inc. [*17]* v. *Elsea*, 56 USPQ2d at 1511 (witness did not testify as to current status of registrations and did not make the registrations of record). Therefore, the ten remaining pleaded registrations are not properly introduced into the record.

B. Were any of the pleaded registrations not introduced into the record tried by implied consent?

¹⁶

A further defect in the TESS screenshot captures and copies of the certificates of registration for ten of the pleaded registrations: SMOK HOOKAH, SMOK ECIG, SMOK CIGAR, SMOK MINI, SMOK PIPE, SMOK TECHNOLOGY, SMOK, SMOK DUAL COILS, SMOK MODS and SMOK FASHION is that they do not reflect Opposer as the owner.

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Opposer is listed as the owner of this registration in both the copy of the certificate **[*16]** of registration and the TESS screenshot capture.

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The plain copy of the certificate of registration and the TESS screenshot capture for the SMOK Principal Register registration submitted by Opposer are reproduced in the Appendix attached to this decision.

For the ten pleaded registrations that are not introduced into the record as exhibits to the notice of opposition (SMOK,¹⁹ SMOK HOOKAH, SMOK ECIG, SMOK CIGAR, SMOK MINI, SMOK PIPE, SMOK TECHNOLOGY, SMOK DUAL COILS, SMOK MODS, and SMOK FASHION), Opposer did not specifically allege prior common law use of these marks. Therefore, we consider whether prior use based on common law rights of any of these marks was tried by implied consent. Fed. R. Civ. P. 15(b). *Cf. Teledyne Techs., Inc. v. W. Skyways, Inc.*, 78 USPQ2d 1203, 1206 (TTAB 2006) (where petitioner failed to properly make its pleaded registration of record and prior use had been pleaded, "petitioner must rely on its common law rights as shown by the record" "for purposes of the likelihood of confusion analysis"), *aff'd*, 208 F. App'x 886 (Fed. Cir. Dec. 6, 2006).

Implied consent has been found when a party does not object to the submission of evidence and/or argues the evidence in its brief on the case. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1924-26 (TTAB 2011) (petitioner's unpleaded common law marks tried by implied consent where petitioner mentioned marks in discovery responses, emphasized its intention to rely on unpleaded marks through testimony to which respondent did not object at the time, and was afforded an opportunity to cross-examine the witness; respondent's later objection in its brief untimely), *aff'd*, 188 F. Supp. 3d 22 (D.D.C. 2016), *aff'd*, 743 F. App'x 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (unpleaded registrations tried by implied consent where "applicant has raised no objection to opposer's submission of and reliance upon these unpleaded registrations").

Opposer's witness testified about use of the marks SMOK, SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and an additional mark, SMOK TECH, prior to Applicant's effective filing date.²⁰ Applicant did not raise any objection to this testimony as it did not file a brief on the case and it did not seek to cross-examine Opposer's witness [*19] declarant as permitted by Trademark Rule 2.123(c), 37 C.F.R. § 2.123(c). Accordingly, we find that Opposer's prior use based on common law of the marks SMOK, SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE and SMOK TECH has been tried by implied consent.²¹

II. Entitlement to Statutory Cause of Action²²

Entitlement to a statutory cause of action is an issue in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82, 211 L. Ed. 2d 16 (2021). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671, 210 L. Ed. 2d 833 (2021). Demonstrating [*20] a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at 7-8.

¹⁹

Opposer alleged ownership in the notice of opposition of two SMOK registrations: Registration No. 4545449 and Registration No. 6072213. As alleged by Opposer, these registrations' identifications cover [*18] different goods. Notice of Opposition, PP 1, 3, 1 TTABVUE 6-7.

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Huang Declaration P 4, 8 TTABVUE 2.

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Thus, prior use based on common law of the pleaded marks SMOK HOOKAH, SMOK CIGAR, SMOK DUAL COILS, and SMOK TECHNOLOGY was not tried by implied consent.

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We now refer to what previously had been called standing as "entitlement to a statutory cause of action." But our prior decisions and those of the Federal Circuit interpreting "standing" under Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, remain equally applicable. *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

As indicated, Opposer's SMOK Principal Register registration is of record. This registration is valid and subsisting and establishes Opposer's direct commercial interest in the proceeding and its belief in damage. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations "suffice to establish ...direct commercial interest"; a belief in likely damage can be shown by establishing a direct commercial interest).

Therefore, Opposer has shown its statutory entitlement to a cause of action and hence, to oppose registration. *Australian Therapeutic Supplies Pty. Ltd.*, 2020 USPQ2d 10837, at *3; *Cunningham*, 55 USPQ2d at 1844; *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition); *Barbara's Bakery v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (opposer's entitlement to opposition established by pleaded registration being of record and non-frivolous likelihood of confusion claim).

III. Priority

A. Opposer's pleaded Section 2(f) Principal Register SMOK registration that is of record

Because Opposer's [*21] pleaded valid and subsisting Section 2(f) SMOK Principal Register registration is of record, and Applicant has not counterclaimed to cancel it, priority is not at issue as to this mark and the goods and services covered by the registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Signal Co., Inc. v. Sigmor Corp.* 190 USPQ 81, 83 (TTAB 1975).

B. Family of Marks

As indicated, Opposer alleged in the notice of opposition a family of marks based on the "house mark 'SMOK'" and argued in its brief that it owns a family of SMOK marks.²³

"A family of marks is a group of marks having a common characteristic ... [that] only arises if the purchasing public recognizes that the common characteristic is indicative of a common origin of the goods." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001) (quoting and citing *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991)). "Recognition of the family of marks is achieved when the pattern of usage of the common element is sufficient to be [*22] indicative of the origin of the family." *J&J Snack Foods Corp.*, 18 USPQ2d at 1891.

Ownership of multiple registrations containing the alleged family feature or term is not sufficient, in and of itself, to establish that a party owns a family of marks. *See New Era Cap Co.*, 2020 USPQ2d 10596, at *7 (citing cases); *In re Globe-Union Inc.*, 189 USPQ 158, 160 (TTAB 1975) ("[O]wnership of a number of registrations for marks containing a common component is insufficient, per se, to establish a 'family of marks' identified and recognized in the trade and by purchasers of such goods by said common feature."). "[A]n opposer relying on a family of marks is relying on common law rights in the alleged family." *New Era Cap Co.*, 2020 USPQ2d 10596, at *7. Thus, the fact that the Office has registered Opposer's Principal Register SMOK mark under Section 2(f) and this registration is entitled to Section 7(b), 15 U.S.C. § 1057, presumptions of validity, ownership, and exclusive right to use the registered mark in connection with the identified goods and services, does not constitute evidence that the public recognizes SMOK as a family feature or that SMOK, as a family feature, has acquired distinctiveness. As stated by *Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 USPQ2d 1782, 1786 n.2 (TTAB 2002):

While an issued registration carries certain evidentiary presumptions, there is no [*23] legal basis for opposer's suggestion that the Office has engaged in any valuation of the extent of opposer's rights in its

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Notice of Opposition P 4, 1 TTABVUE 7; Opposer's brief, 13 TTABVUE 13. Although Opposer alleges ownership of a family of marks in reference to its registrations, "a family of marks is created not by registration but by use." *Gates Rubber Co. v. W. Coupling Corp.*, 179 USPQ 186, 187 (TTAB 1973).

registered marks or for the proposition that, in issuing registrations, the Office somehow has determined that opposer's marks constitute a family. We have accorded the registrations properly made of record the evidentiary weight to which they are entitled under the statute and have evaluated opposer's claim of the existence of a family of marks based on the evidence of record.

appeal dismissed, 46 Fed. Appx. 962 (Fed. Cir. Sept. 9, 2002); *See also TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1422 n.81 (TTAB 2018), (considering distinctiveness of the term "trader" for purposes of family of marks analysis where petitioner owned four Trader-formative registrations under Section 2(f); dictionary evidence for "trader" and Trader-formative third-party registrations was in the record as well as a limited amount of third-party use evidence) *civil action dismissed*, No. 1:18-cv-00125-PLM-RSK (W.D. Mich. June 3, 2019).

Therefore, while we acknowledge the Section 7(b) presumptions that attach to Opposer's Section 2(f) SMOK Principal Register registration, this statutory presumption does not factor into the family of marks analysis which considers the priority and the distinctiveness [*24] of the family feature under common law. *See Marion Labs. Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1219 (TTAB 1988) (considering whether opposer's evidence of use and promotion of its alleged family of marks was prior to applicant's use and whether the evidence demonstrated "that the family feature is distinctive," and not "descriptive or highly laudatory or commonly used in the trade it cannot serve as the basis for a family of marks, at least in the absence of a showing of distinctiveness").

To establish ownership of a family of marks, it must be shown by competent evidence "prior use of marks sharing a recognizable common characteristic," *Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337-38 (TTAB 2006), and "that prior to the entry into the field of the opponent's mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature." *Marion Labs. Inc.*, 6 USPQ2d at 1218 (quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)).

Thus, the preliminary issue of common law priority of the alleged family of marks must be determined before we consider the family of marks [*25] issue in connection with likelihood of confusion. *New Era Cap Co.*, 2020 USPQ2d 10596, at *6. Opposer bears the burden of proving the existence of a family of SMOK marks prior to any date Applicant can rely upon for purposes of priority. *TPI Holdings Inc. v. Trailertrader.com, LLC*, 126 USPQ2d at 1419. We must "look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use." *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). We "look ... primarily to the nature and character of opposer's advertising and promotional material" in determining whether a family of marks exists. *Witco Chem. Co. v. Chemische Werke Witten GmbH*, 158 USPQ 157, 160 (TTAB 1968).

1. Has Opposer established common law prior use of a family of SMOK marks?

In the present case, for purposes of priority, Applicant is entitled to rely on the effective filing date of its application as its constructive use date because Applicant's goods would have been unlawful and the mark not registrable prior to the effective date of the 2018 amendments to the Farm Bill. *See* "Examination Guide 1-19 Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill." *Cf. Minn. Mining and Mfg. Co. v. Nat'l Cash [*26] Register Co.*, 154 USPQ 240, 241 (TTAB 1967) ("Registrant filed its application for registration on the Principal Register on September 15, 1960, claiming a use in commerce on or about June 23, 1960. Registrant could not have qualified for registration on the Supplemental Register since it did not have the lawful use in commerce for the year preceding the filing of the application required by the statute (Section 23 of the Act of 1946). Since the amendment changing to the Supplemental Register was filed on February 10, 1964, that date must be considered the effective filing date."). In addition, Applicant took no testimony on its behalf to establish an earlier use date than the effective filing date. *See Miss Universe, Inc. v. Drost*, 189 USPQ 212, 213 (TTAB 1975) (applicant took no testimony on its behalf and is limited to the application filing date as the earliest date of use upon which he can rely). Thus, at the very least, Opposer's priority for its alleged family of SMOK marks must predate Applicant's effective filing date of December 20, 2018.

We consider whether Opposer's witness testimony and evidence has established prior use of an alleged family of marks, with SMOK as the family feature, before Applicant's priority date of December 20, 2018. As [*27] indicated, Opposer's witness only testified about the use of SMOK (as a house mark) and the marks SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and SMOK TECH.²⁴ We note that most of the marks identified by Opposer's witness utilize SMOK with a descriptive term (e.g., pipe, mods, ecig, and mini).

As to the goods and services used in connection with these marks, Opposer's witness testified very generally about electronic cigarette goods, parts and accessories that it has sold since 2013, and its provision of retail store services offering electronic cigarettes and oral vaporizers for smokers since 2016.²⁵ Broad general statements by a witness that lack sufficient detail are usually not adequate, especially in the absence of corroborating documentary evidence. *See Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *20 (TTAB 2021) (conclusory testimony consisting of the "bald assertion that he used the marks for the service" that lacked "specifics" was "significantly undermined by lack of detail" and lack of corroborating evidence); *H. Betti Indus., Inc. v. Brunswick Corp.*, 211 USPQ 1188, 1197 (TTAB 1981) (vague, indefinite and inconsistent testimony accompanied by inadequate documentary evidence [*28] found insufficient to support priority claim). The Huang testimony does not associate the offering of electronic cigarette goods, parts, and accessories and the rendering of the retail store services offering electronic cigarettes goods and oral vaporizers with any particular SMOK mark, or group of SMOK marks, and there is no documentary evidence provided in connection with the witness testimony showing use and promotion of these particular SMOK marks together in connection with these goods and services.

The documentary evidence submitted in connection with this testimony is webpages from four third-party websites identified as exhibit 1. The witness testimony simply identifies these third-party websites as online locations where Opposer's goods are sold, referencing the attached exhibit.²⁶ Opposer's witness did not specifically testify about the content of the webpages nor the dates of the webpages. Thus, Opposer's witness relies on these exhibits for what they show on their face, and not to establish prior use of SMOK-formative marks in the past.

In any event, aside from the fact that this evidence appears to be for dates after Applicant's constructive use date,²⁷ none of the website webpages show on their face goods displaying the marks SMOK FASHION, SMOK MODS,

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Huang Declaration P 4, 8 TTABVUE 2.

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Huang Declaration PP 5-6, 8 TTABVUE 3.

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Huang declaration P 9, 8 TTABVUE 3. Opposer's witness listed in her testimony the website [*29] addresses for third-party websites identified in exhibit 1 but not the dates the webpages were accessed. *Id.* The website pages themselves include the URL but no date. Although Opposer's witness testimony failed to identify the date these website documents were actually accessed or printed, for purposes of admissibility, this procedural shortcoming has been waived. *Cf. City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) ("[a]ny shortcomings in respondent's original submission ... under notice of reliance, such as its failure to identify the URL and when the document was actually accessed (either printed out or downloaded), are procedural deficiencies that were not timely raised by petitioner and thus have been waived"); *Mag Instrument, Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1708 (TTAB 2010) (authentication objection to Internet exhibits that could have been raised during oral deposition was waived), *aff'd mem.*, No. 2011-1052, 2011 U.S. App. LEXIS 22673, 2011 WL 5400095 (Fed. Cir. Nov. 9, 2011).

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We note that the webpage printouts of at least three of the websites reference the year 2021 on their face. A Giant Vapes webpage (giantvapes.com) states "20% sitewide ... valid thru 6.21.21," and both the Element Vape (elementvape.com) and the ProVape (provape.com) webpages bear 2021 copyright notices. 8 TTABVUE [*31] 6-9; 10-18; 23-25. *But see Embarcadero Tech., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 n.75 (TTAB 2013) (A copyright date "does not establish that the marks identified in the documents were actually in use...").

SMOK ECIG, SMOK MINI, SMOK PIPE and SMOK TECH, separately or together.²⁸ The Giant **[*30]** Vapes website shows the offering of goods under a SMOK NORD mark, displayed with goods from other manufacturers, and a separate webpage on this website lists SMOK as one of a number of "featured brands."²⁹ The Vapor4Life website shows the offering of goods under a SMOK NOVO mark, displayed with goods by other manufacturers, and a separate webpage lists SMOK as one of other featured brands.³⁰ The ProVape website offers three SMOK products, (SMOK MORPH, SMOK G-PRIV, SMOK ARC FOX), not grouped together, and displayed with products from other manufacturers on a webpage. The Element Vape website devotes an entire brand category to Opposer's goods, displaying numerous product listings identified under SMOK-formative marks, including SMOK NORD, SMOK NOVO and SMOK RIGEL; however, none of these webpages show any of the SMOK-formative marks identified by Opposer's witness.³¹

In view of the vagueness and non-specific witness testimony, and the lack of any corroborating documentary evidence, we find there is insufficient evidence to support common law prior use, with presumptive use dates of December 31, 2013 (goods) and December 31, 2016 (services), of any particular SMOK marks as a family with the goods and services identified by Opposer's witness.³² *See Mars Generation*, 2021 USPQ2d 1057, at *20 (probative value of testimony is significantly undermined by witness' utter lack of detail).

Opposer's witness also testified about advertising on social media and expenditures of over \$ 1 million dollars in connection with "vaping products since 2015 under the house mark 'SMOK,'" which includes the marks SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE and SMOK TECH.³³ However, the witness did not elaborate on the type **[*33]** of "vaping products" advertised under any of these marks, nor support this testimony with documentary evidence. We find this testimony is too vague to be probative as it lacks specificity as to the nature of the vaping goods used with any of these marks and lacks any corroborating documentary evidence showing use and promotion of SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE and SMOK TECH together as a family with "vaping products," with a presumptive use date of December 31, 2015.

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The SMOK formative marks are identified in the product descriptions; as pictured, the marks displayed on many of the products themselves or the packaging are not discernible.

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Huang declaration, exhibit 1, 8 TTABVUE 7, 9, (giantvapes.com).

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Huang declaration, exhibit 1, 8 TTABVUE 19, 20, (vapor4life.com).

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Huang declaration, exhibit 1, 8 TTABVUE 10-18, (elementvape.com). The pages are displayed under the website category "Home > Brands > SMOKTech." *Id.* at 10.

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When only a year is given as the date of first **[*32]** use, the date presumed is the last day of the year. Therefore, because the witness did not identify a specific month or day in 2013 or 2016, we presume a date no earlier than the last day of the year of 2013 and 2016. *See Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1856 (TTAB 2008) ("In view of the uncertainty of respondent's testimony and lack of documentation, we conclude that respondent's date of first use can be no earlier than March 31, 1995, the last day of the specified time period identified in Mr. Utgaard's testimony") (citing *Osage Oil & Trans., Inc. v. Standard Oil Co.*, 226 U.S.P.Q. (BNA) 905, 911 n.22 (TTAB 1985)); *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), *aff'd*, 706 F.2d 1213 (Fed. Cir. 1983).

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Huang Declaration PP 7, 4, 8 TTABVUE 2, 3.

Opposer also submitted under notice of reliance website printouts from the smoketech.com website and additional webpages from the Element Vape third-party website that were accessed and printed on June 26, 2021.³⁴ Opposer's witness testified that the smoketech.com website is owned by Opposer.³⁵ These webpage printouts can be considered for what they show on their face.³⁶ See *Spiritline Cruises LLC v. Tour Mgmt. Servs. Inc.*, 800 Fed. Appx. 110, 2020 USPQ2d 48324, at *2 (TTAB 2020) ("we consider Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony only for what they show on their face rather than for the truth of the matters asserted therein."). **[*34]**

Aside from the June 2021 access date of these webpages, which is later than Applicant's priority date, none of these webpages show any of the SMOK-formative marks identified by Opposer's witness (SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and SMOK TECH). Opposer's smoketech.com website lists the product name and description of the goods without any SMOK-formative component identified (e.g. Nord Kit, Morph Kit, Acro Kit). Where the marks are discernible as photographs of the actual products on these webpages, only SMOK is displayed alone on the goods, or the product mark is displayed alone on the goods without the SMOK family feature (e.g., ARCFOX).³⁷ As to the Element Vape website, for which very similar webpages were submitted by Opposer's witness as part of exhibit 1, the product listings identify the name of the goods as SMOK combined with other terms, but none are SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and **[*35]** SMOK TECH .³⁸ Where the marks are discernible on the goods themselves on these webpages, only SMOK is displayed on the photographed goods; or the discernible product marks displayed on the photographed goods do not show the SMOK family feature as part of the mark (e.g., RPM, MORPH, MORPH2).³⁹ Therefore, these webpages do not show use and promotion of the SMOK family feature with the marks SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and SMOK TECH on goods prior to Applicant's priority date.

In sum, Opposer's testimony and other evidence of record does not establish that the asserted marks SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, and SMOK TECH were used and promoted together in such a manner so as to create consumer recognition of SMOK as a family feature prior to Applicant's priority date.

In any event, the application of the family of marks doctrine requires a showing that the SMOK family feature **[*36]** is "not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark." *Marion Labs. Inc.*, 6 USPQ2d at 1218-19 (quoting *Land-O-Nod Co.*, 220 USPQ at 65-66). That is, "if the asserted family feature is descriptive or highly laudatory or commonly used in the trade it cannot serve as the basis for a family of marks, at least in the absence of a showing of distinctiveness" of the family

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Opposer's notice of reliance, 7 TTABVUE 5-38.

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Huang declaration P 9, 8 TTABVUE 3.

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Opposer's notice of reliance indicates the relevance of these webpages is "related channels of trade." Opposer's notice of reliance, 7 TTABVUE 2.

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Opposer's notice of reliance, 7 TTABVUE 10, 11, 13, 14-26.

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Opposer's notice of reliance, 7 TTABVUE 28-38.

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Opposer's notice of reliance, 7 TTABVUE 29-37. Only one of the photographed products appears to show a SMOK formative mark, i.e., SMOK OFRF. *Id.* at 37.

feature. *Id.* at 1219. See also *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1049 (Fed. Cir. 2018) ("[A]pplication of the family of marks doctrine 'requires a showing that the family feature or 'surname' is distinctive enough to trigger recognition 'in and of itself.'... [i]t may be more accurate to say that a descriptive term can serve as a family surname only where there is a strong showing of secondary meaning in the term.") (quoting *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1187 (7th Cir. 1992) (quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:19, at 103 (3d ed. 1992))); *Norwich Pharmacal Co. v. Salsbury Labs.*, 168 USPQ 250, 255 (TTAB 1970) ("Even a descriptive term may become the basis for a 'family' of marks, if a secondary meaning therein could be established.") (citation omitted).

2. Is Opposer's SMOK family feature distinctive?

We consider [*37] whether the SMOK family feature in Opposer's alleged family of marks is distinctive, highly suggestive, or descriptive. See *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d at 1422, 1427 (considering the term TRADER in connection with family of marks claim and finding that the "term 'trader' is inherently weak, and perhaps descriptive, in the context of bringing sellers and buyers together given its defined meaning as 'a person who trades; a merchant or businessman ... the weakness is accentuated when it is preceded by terms that are descriptive or generic for the particular type or field of goods being offered for sale'"); *Sports Auth. Mich., Inc.*, 63 USPQ2d at 1801-02 (making the observation that the marks in the "Authority" family "are highly suggestive" and "[t]he term 'Authority,' too, is highly suggestive when used as part of a series of marks for retail store services, in that the term readily suggests that [opposer] can provide customers 'authoritative' assistance."); *Marion Labs. Inc.*, 6 USPQ2d at 1219-20 (considering whether the family feature TOXI is highly suggestive or descriptive and finding that "'TOXI' is no more than suggestive of the goods").

The alleged family feature SMOK is not a term listed in the dictionary and does not [*38] have an established dictionary pronunciation. See *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (citing *In re Belgrade Shoe Co.*, 411 F.2d 1352, 56 C.C.P.A. 1298, 162 USPQ 227 (CCPA 1969)) ("[t]here is no correct pronunciation of a trademark that is not a recognized word"). Opposer, in its brief, submits that "it is possible to pronounce 'SMOK' and 'SMOKE' in the same way" and that "smokes," the plural of "smoke," is "similar in sound" to SMOK.⁴⁰

The word "smoke" is pronounced with a long "o" sound. ⁴¹ Opposer's witness testified that the SMOK family feature is pronounced by its customers either as "[smok]" or "[smohk]." ⁴² Therefore, SMOK can be pronounced with either a long "o" or a short "o," (/a/) but in the context of these goods and services (electronic cigarettes, parts, and accessories, and retail store services for related goods), as Opposer acknowledges, SMOK most likely is pronounced with a long "o" sound, as "smoke." ⁴³ *In re State Chem. Mfg.*

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Opposer's brief, 13 TTABVUE 12, 13.

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MERRIAM-WEBSTER DICTIONARY, <https://www.merriamwebster.com/dictionary/smoke> (accessed October 31, 2022). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or regular fixed editions. *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) (the Board may take judicial notice of online dictionary definitions also available in printed form).

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Huang declaration P 3, 8 TTABVUE 2.

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Opposer's allegations in the notice of [*40] opposition and the arguments in its brief indicate its agreement that SMOK and "smoke" are phonetic equivalents. See Notice of Opposition P 10, 1 TTABVUE 8 ("Indeed, the wording 'SMOKES' [in Applicant's mark] sounds like the plural form of Opposer's 'SMOK' [mark]."); Opposer's brief, 13 TTABVUE 12 ("Applicant's SMOKES mark

Co., 225 USPQ 687, 689 (TTAB 1985) (although "fom" could be pronounced as "mom" with a short "o," in the context of the goods, "fom" is the phonetic equivalent of "foam" which is descriptive of "industrial cleaner for carpets, rugs and upholstery"). **[*39]** See also *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 328, 59 S. Ct. 191, 83 L. Ed. 195, 1939 Dec. Comm'r Pat. 838 (1938) (NU in NU-ENAMEL found equivalent of "new"); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) ("[t]here is no legally significant difference here between 'quik' and 'quick'"); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984) (BIKINEEZ is the phonetic equivalent of "bikinis"). The purchasing public is aware of the fact that electronic cigarettes and related parts and accessories are directed to tobacco smokers as evidenced by the website evidence referenced by Opposer's witness.⁴⁴ Thus, pronouncing SMOK as "smoke" would not be strained, and both Opposer and Opposer's witness acknowledge that SMOK is pronounced by many of its customers as "smoke."

Opposer does not dispute, and we find on this record, that consumers are likely to view and verbalize the term SMOK as the phonetic equivalent and a misspelling **[*41]** of "smoke."⁴⁵ See *Fleetwood Co. v. Sylvia Mende*, 298 F.2d 797, 49 C.C.P.A. 907, 1962 Dec. Comm'r Pat. 116, 132 USPQ 458, 460 (CCPA 1962) (TINTZ, is a misspelling of "tints" for hair coloring formula); *Am. Aloe Corp. v. Aloe Creme Labs., Inc.*, 420 F.2d 1248, 164 USPQ 266, 268-269 (7th Cir. 1970) (ALO is the phonetic equivalent of the generic name "aloe" for goods containing aloe as an ingredient; defendant has not achieved sufficient secondary meaning in a family of ALO marks to preclude others from using the term); *In re State Chem. Mfg. Co.*, 225 USPQ at 689 (FOM is the phonetic equivalent of "foam" which is descriptive of "industrial cleaner for carpets, rugs and upholstery"); *Cambridge Filter Corp. v. Servodyne Corp.*, 189 USPQ 99, 103 (TTAB 1975) (in connection with a family of marks claim for the suffixes FLO and CAP, the Board observed that "flo" is the phonetic equivalent of "flow" and possesses a highly suggestive if not a descriptive significance as applied to air filters and that "cap" is at least suggestive of the capacity of air filters); *In re Yardney Elec. Corp.*, 145 USPQ 404, 405 (TTAB 1965) ("[t]he purchasing public is aware of the fact that nickel is used in storage batteries. The immediate impression of 'NICEL' as used on a battery is 'nickel'" and "we conclude that 'NICEL' is merely a misspelling and phonetic equivalent of 'nickel' and means the same thing").

"Smoke" is defined as the "act of smoking tobacco" and is an informal term for a cigarette or a cigar. See OXFORD LIVING DICTIONARY;⁴⁶ *Marion Labs. Inc.*, 6 USPQ2d at 1219-20 (in considering whether the asserted family feature TOXI is highly suggestive or descriptive, the Board took judicial notice of the dictionary definition of "toxi"). Three of the third-party websites where Opposer's goods are sold show on their face that the goods offered are nicotine products directed to smokers of tobacco and those of legal smoking age. The use of the terms "smoke" or "smoker" and "smoking" on these webpages indicate that "smoke" (in noun and verb forms) has descriptive significance in connection with electronic cigarette goods.⁴⁷ See *Specialty Brands, Inc. v. Coffee Bean Distrib.*,

appears to be the plural form of Opposer's main trademark, SMOK, because it adds only the letters 'ES' at the end. ...it is possible to pronounce 'SMOK' and 'SMOKE' in the same way."). See *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *8 (TTAB 2019) (Board considered statements in application file declaration taken together with Petitioner's statements in brief, "as admissions that the term 'grabba' is currently viewed by the relevant public as, at a minimum, immediately conveying information about an ingredient or characteristic of tobacco, or tobacco products, including cigar wraps") *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019).

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Huang declaration, P 9, exhibit 1, 8 TTABVUE 5-26.

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Opposer's brief, **[*42]** 13 TTABVUE 12, 13.

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Application Serial No. 87856115, March 11, 2019 Office Action at TSDR 4. (oxforddictionary.com).

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The Element Vape website includes a statement **[*43]** that "Products sold on this site are for adult smokers." Huang Declaration exhibit 1, 8 TTABVUE 18. The ProVape website includes a statement that "You must be of legal smoking age in your territory to

Inc., 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (evidence of third-party use shows that the word "spice" has descriptive significance when used in conjunction with spiced teas; "[t]hird-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade.").

Thus, the term "smoke," or its phonetic equivalent SMOK (Opposer's alleged family feature), is descriptive in relation to Opposer's electronic cigarettes, parts, and accessories and retail store services featuring those goods. *See TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d at 1422, 1427 (in connection with family of marks claim, finding that the "term 'trader' is inherently weak, and perhaps descriptive, in the context of bringing sellers and buyers together given its defined meaning as 'a person who trades; a merchant or businessman'"); *Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 USPQ2d at 1801-02 (in connection with family of marks claim, making the observation that "[t]he term 'Authority,' too, is highly suggestive when used as part of a series of marks for retail store services, in that the [*44] term readily suggests that [opposer] can provide customers 'authoritative' assistance."); *Am. Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978) (in connection with family of marks claim utilizing the term AQUA, the Board observed that "the term 'AQUA' possesses an obvious meaning or connotation of 'water' which would be known to the average purchaser of plumbing equipment, whether a plumber or a homeowner, and, as such, it is highly suggestive if not descriptive of plumbing supplies"); *Logetronics, Inc. v. Logicon-Intercomp Inc.*, 199 USPQ 814, 818 (TTAB 1978) (in connection with family of marks claim utilizing the prefix LOG or LOGE, the Board observed that "the alleged root of the family, 'LogE', has an admittedly highly suggestive connotation (the log of exposure)"); *Ladish Co. v. Dover Corp.*, 192 USPQ 462, 464 (TTAB 1976) (in connection with family of marks claim "characterized by the term TRI," the Board observed that "the term 'TRI' also has a descriptive or, at the least, highly suggestive meaning when used in connection with opposer's goods"); *Cambridge Filter Corp. v. Servodyne Corp.*, 189 USPQ at 103 (in connection with a family of marks claim for the family features FLO and CAP, the Board observed that "flow" or its equivalent "flo" possesses a highly suggestive if [*45] not a descriptive significance as applied to air filters and that "cap" is at least suggestive of the capacity of air filters). Opposer acknowledges the descriptiveness of the term SMOK: "Applicant may argue that the common wording [SMOK and SMOKES] is entitled to a narrow scope of protection given its descriptive nature." ⁴⁸ *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *8 (statements in brief considered "admissions that the term 'grabba' is currently viewed by the relevant public as, at a minimum, immediately conveying information about an ingredient or characteristic of tobacco, or tobacco products, including cigar wraps"); TBMP § 704.06(b).

SMOK, the family feature of Opposer's alleged family of marks, is descriptive, and therefore, Opposer must make a "strong showing" of acquired distinctiveness for SMOK to serve as the family feature. *See Royal Crown Co. v. Coca-Cola Co.*, 127 USPQ2d at 1049 (a descriptive term can serve as a family feature "only where there is a strong showing of secondary meaning in the term."). *See also Am. Aloe Corp. v. Aloe Creme Labs., Inc.*, 164 USPQ at 268-269 (ALO is the phonetic equivalent of the generic name "aloe" for goods containing aloe as an ingredient; defendant has not [*46] achieved sufficient secondary meaning in a family of ALO marks to preclude others from using the term).

In determining whether the alleged SMOK family feature has acquired distinctiveness we consider the evidence as a whole. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.3d 504, 234 F.2d 504, 43 C.C.P.A. 970, 1956 Dec. Comm'r Pat. 350, 110 USPQ 293, 295 (CCPA 1956) ("Viewing the evidence as a whole, it is by no means certain the words 'continuous vision' are descriptive of the function of trifocal lenses as distinguished from being merely suggestive thereof"); *cf. City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at *18 (TTAB 2020) (considering evidence as a whole in connection with acquired distinctiveness of a geographically descriptive term).

The considerations to be assessed in determining whether SMOK as a family feature has acquired secondary meaning "can be described by the following six factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount

purchase products." *Id.* at 25. The Vapor4Life website states "best ecigs for Smokers" ... No Matter how much you smoke, we'll guide you to the perfect product that fits your needs. ... Which best describes your smoking habits?" *Id.* at 21.

and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. ... All six factors are to be weighed together in determining [*47] the existence of secondary meaning." *In re Snowizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018) (quoting *Converse, Inc. v. Int'l Trade Comm'n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)).⁴⁹

"On this list, no single factor is determinative." *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *11 (TTAB 2019) (citing *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009)). See also *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) ("On this list, [copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source)] no single factor is determinative. A showing of secondary meaning need not consider each of these elements. Rather, the determination examines all of the circumstances involving the use of the mark.").

Opposer's witness only addressed the *Converse* factors of length of use and amount and manner of advertising, testifying to relatively modest advertising expenditures of \$ 1 million over a six-year period "under the mark 'SMOK,' including SMOK TECH, SMOK FASHION, SMOK MODS, SMOK ECIG, SMOK MINI and SMOK PIPE" as used on "vaping products."⁵⁰ Considering this testimony and evidence, we find that the alleged SMOK [*48] family feature has not acquired distinctiveness as part of an alleged family of marks. See *Royal Crown Co. v. Coca-Cola Co.*, 127 USPQ2d at 1049 (a descriptive term can serve as a family feature "only where there is a strong showing of secondary meaning in the term.").

Based on the foregoing, Opposer has not provided evidence that its claimed SMOK family feature has been used and promoted together in a manner sufficient to create public recognition prior to Applicant's effective filing date nor has it established the acquired distinctiveness of the asserted SMOK family feature, an admittedly descriptive term, prior to Applicant's effective filing date. We find that Opposer has not established a family of SMOK marks and "cannot prevail on a likelihood of confusion claim that is predicated on ownership of the family of marks." *TPI Holdings Inc., v. TrailerTrader.com, LLC*, 126 USPQ2d at 1429.

C. Common law priority of SMOK and SMOK-formative marks

When an Opposer has not established priority of use of a family of marks, it may rely on the pleaded common law marks separately. See *Truescents LLC*, 81 USPQ2d at 1338 (because plaintiff did not establish ownership of a family of marks, priority and likelihood of [*49] confusion is based on each of the separate pleaded marks). Therefore, we consider, based on the record as a whole, whether Opposer has established separately, prior use at common law for any of the following marks: SMOK,⁵¹ SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, SMOK FASHION and SMOK TECH, prior to Applicant's effective filing date. *W. Fla. Seafood, Inc.*, 31 USPQ2d at 1663 ("[O]ne should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.").

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Although Opposer does not discuss *Converse*, we consider the arguments and the record evidence using the *Converse* framework.

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Huang Declaration P 4, 8 TTABVUE 2.

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As noted in n.19 *supra*, Opposer specifically alleged likelihood of confusion with the goods listed in the SMOK Registration No. 4545449, which is not of record, and directed its argument to these goods. Notice of Opposition, P 11, 1 TTABVUE 8; Opposer's brief, 13 TTABVUE 14. These goods are not identical to the goods listed in the SMOK Principal Register Registration No. 6072213 which is of record.

In order for Opposer to prevail on its claim of likelihood of confusion based on common law rights in any of its SMOK marks (SMOK, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, SMOK FASHION and SMOK TECH), each of "the mark(s) must be distinctive, inherently or otherwise, and plaintiff must show priority of use." *Wet Seal Inc. [*50] v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981)).⁵²

As already discussed, we find Opposer's witness testimony is too vague and nonspecific to associate use of any of the SMOK or SMOK-formative marks identified by Opposer's witness with any particular goods or services or with any date of use, and there is no corroborating documentary evidence offered by the witness such as copies of invoices or receipts as to any of the SMOK or SMOK-formative marks identified. See *Elder Mfg. Co. v. Int'l Shoe Co.*, 194 F.2d 114, 39 C.C.P.A. 817, 1952 Dec. Comm'r Pat. 133, 92 USPQ 330, 333 (CCPA 1952) (oral testimony relating to prior use of a mark is strengthened by corroborative documentary evidence); *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 32 C.C.P.A. 1206, 1945 Dec. Comm'r Pat. 490, 66 USPQ 232, 236 (CCPA 1945) (testimony to establish prior use of a mark "should not be characterized by contradictions, inconsistencies, and [*51] indefiniteness but should carry with it conviction of its accuracy and applicability.").

Thus, the Huang testimony and evidence are simply insufficient to establish common law priority of use separately in connection with various goods of any of the marks (SMOK, SMOK MODS, SMOK ECIG, SMOK MINI, SMOK PIPE, SMOK FASHION, and SMOK TECH) prior to Applicant's constructive use date. Therefore, likelihood of confusion will be considered solely in connection with the pleaded Section 2(f) Principal Register SMOK mark that is of record.

IV. Likelihood of Confusion

We now turn our attention to the likelihood of confusion analysis and consider Opposer's SMOK Principal Register



mark vis-à-vis Applicant's mark.

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the 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) (setting forth factors to be considered, referred to as "DuPont factors").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental [*52] inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). We discuss the *DuPont* factors for which there is relevant argument and evidence. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (the Board considers each *DuPont* factor for which there is evidence and argument).


A. Similarity of the Marks

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As to any marks that are not inherently distinctive, Opposer must establish that the designations acquired distinctiveness prior to Applicant's constructive use date. *Perma Ceram Enters. Inc. v. Preco. Indus. Ltd.*, 23 USPQ2d 1134, 1136 (TTAB 1992) ("where the mark relied upon by a plaintiff in support of its priority of use and likelihood of confusion claim is merely descriptive ... then the plaintiff must establish priority of acquired distinctiveness").

We turn to the first *DuPont* factor, "similarity or dissimilarity of the marks." *In re E.I. du Pont*, 177 USPQ at 567. For this factor, we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E.I. du Pont*, 177 USPQ at 567). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E.I. du Pont*, 177 USPQ at 567). "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. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. [*53] v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).



Applicant's mark is  ("smokes" disclaimed) and Opposer's mark is SMOK (Section 2(f)).⁵³ Opposer's SMOK mark is in standard characters and is not limited to any particular font style, size, or color. Trademark Rule 2.52(a); 37 CFR § 2.52(a) ("no claim is made to any particular font style, size, or color"). Although disclaimed in Applicant's mark, we consider the term SMOKE the dominant element in Applicant's word and design mark, which Applicant also has admitted.⁵⁴

However, "[t]here is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Even if an element of a mark is dominant, [*54] this does not mean that other elements may simply be ignored in the likelihood of confusion analysis. See *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007). Moreover, when the word portion of marks are highly suggestive or descriptive, the presence of a design may be a more significant factor. See *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984).

Accordingly, if the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, other matter in the marks may be sufficient to avoid confusion. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is not likely to cause confusion, because the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar).

The disclaimer of SMOKE in Applicant's mark constitutes a concession that "smokes" is not inherently distinctive. See *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *18 (TTAB 2022) ("Applicant's disclaimer of 'suites' is a concession that 'Suites' is not inherently distinctive"); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n.4 (TTAB 1988) ("By its disclaimer of the word LITE, applicant has conceded that the term [*55] is merely descriptive as used in connection with applicant's goods") (citing *State Oil Refining Corp. v. Quaker Oil Corp.*, 161 USPQ 547 (TTAB 1969), *aff'd*, 453 F.2d 1296, 59 C.C.P.A. 764, 172 USPQ 361 (CCPA 1972)). TRADEMARK MANUAL OF

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As stated at nn.19 and 51 *supra*, Opposer also specifically pleaded in its notice of opposition and argued in its brief likelihood of confusion with its Registration No. 4545449 for the mark SMOK which covered different goods than those listed in Registration No. 6072213. However, as discussed above, Registration No. 4545449 is not of record, and Opposer did not establish common law prior use of this mark in connection with the goods identified in that registration.

⁵⁴

EXAMINING PROCEDURE (TMEP) § 1213.01(d) (July 2022). ("If the applicant elects to enter the disclaimer in the record and not appeal the requirement, then the disclaimer constitutes a concession that the matter is not inherently distinctive or registrable."). Based on the record here, we agree.

Opposer's SMOK mark was registered on the Principal Register under Section 2(f) based upon acquired distinctiveness, which serves as a concession that the mark in its entirety is not inherently distinctive. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact.") (emphasis in original). See also *Royal Crown Co. v. Coca-Cola Co.*, 127 USPQ2d at 1044-45 ("At the outset, because TCCC seeks registration of its ZERO-containing marks under Section 2(f) of the Lanham Act, TCCC has conceded that ZERO is not *inherently* distinctive in association with the genus of goods at issue?soft drinks, energy drinks, and sports drinks. And, TCCC thus concedes [*56] that ZERO is, to some extent, descriptive.") (emphasis in original); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive"); *In re Uncle Sam Chem. Co.*, 229 USPQ 233, 235 (TTAB 1986) (SPRAYZON, the phonetic equivalent of "sprays on," being merely descriptive of the goods, was registrable under Section 2(f) based on a proper showing of acquired distinctiveness).

As to the conceptual strength of Opposer's SMOK mark, we find Opposer's SMOK mark is inherently weak. As already discussed, the record clearly establishes that SMOK is the phonetic equivalent of "smoke" and that the word "smoke" in connection with the identified goods and services is merely descriptive. Opposer does not dispute the descriptive nature of SMOK ("smoke").⁵⁵ See *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 969 F.3d 210, 2020 USPQ2d 10914, at *17 (TTAB 2020) (although plaintiff did not address conceptual strength of its BROOKLYN marks, the Board found the BROOKLYN marks conceptually and inherently weak based not only on plaintiff's registrations issuing under Section 2(f), based on acquired distinctiveness, but also based on evidence in the record including the dictionary definition of Brooklyn and internet excerpts showing Brooklyn [*57] was a well-known geographic place), *aff'd in part, rev'd in part*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021). Opposer acknowledges the inherent weakness of the terms SMOKES and SMOK: "Applicant may argue that the common wording [SMOK and SMOKES] is entitled to a narrow scope of protection given its descriptive nature."⁵⁶ See *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *8 (statements in brief considered "admissions that the term 'grabba' is currently viewed by the relevant public as, at a minimum, immediately conveying information about an ingredient or characteristic of tobacco, or tobacco products, including cigar wraps").

The parties' marks are similar in appearance in that the literal portion of Applicant's mark contains the same first four letters of Opposer's mark SMOK. Although Applicant's mark includes the additional letters "es" to form the plural of "smoke," as Opposer points out, this is a minor point of difference.⁵⁷ See *Wilson v. Delaunay*, 245 F.2d 877, 44 C.C.P.A. 1019, 1957 Dec. Comm'r Pat. 399, 114 USPQ 339, 341 (CCPA 1957) (there is no material difference, in a trademark sense, between the singular and plural forms of a word).

As discussed previously, Opposer's mark SMOK, in the [*58] context of the identified goods and services, is the phonetic equivalent of the word "smoke." See *In re Quik-Print Copy Shops*, 205 USPQ at 507 n.9 (QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'"); *In re State Chem. Mfg. Co.*, 225 USPQ at 689 (FOM is the phonetic equivalent of "foam"). Therefore, we find Opposer's SMOK mark and the literal portion of Applicant's mark, SMOKES, are similar in pronunciation.

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Opposer's brief, 13 TTABVUE 13. See n.43, *supra*.

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Opposer's brief, 13 TTABVUE 13.

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Opposer's brief, 13 TTABVUE 12.

Furthermore, since we find that Opposer's SMOK mark is the phonetic equivalent of "smoke," Opposer's SMOK mark and the literal portion of Applicant's composite mark, SMOKES, convey similar or identical meanings. "Smoke" is an informal term for a cigarette or a cigar and is descriptive of Applicant's goods; and as previously discussed, "smoke" also has descriptive significance in connection with electronic cigarette goods which Opposer's registration covers. See OXFORD LIVING DICTIONARY.⁵⁸ See also *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 35 C.C.P.A. 802, 1948 Dec. Comm'r Pat. 158, 76 USPQ 97, 99 (CCPA 1947) (KWIXTART is the phonetic spelling of "quick start" which "was intended to describe merely that appellant's battery would start a motor or engine quickly."); *In re Hubbard Milling Co.*, 6 UPSQ2d 1239, 1240 (TTAB 1988) [*59] (MINERAL-LYX is the phonetic equivalent of "mineral licks" which is descriptive of mineral licks for animals). Opposer's SMOK mark and the literal portion of Applicant's composite mark, SMOKES, have similar commercial impressions because they may evoke smokable goods or goods used for smoking. The average purchasers of Applicant's and Opposer's goods are smokers who would recognize the descriptive significance of SMOK and SMOKES.

As stated, we must consider Applicant's mark in its entirety, including the design elements. The design features, with the colors red and white claimed as feature of the mark, include two white concentric circles with broken red lines with a square-shaped black border as the background carrier. The letters "s" at the beginning and the end of the term SMOKES are elongated by a long line either at the top or the bottom of the mark, spanning the entire word and reaching the border of the inner circle, and although Applicant's description of the mark in the application does not specifically state, we find that the elongated letter "s" design easily could be perceived [*60] by purchasers as evoking a lit cigarette with the letter "s" acting as a plume of smoke. See *T & T Mfg. Co. v. A. T. Cross Co.*, 178 USPQ 497, 498 (TTAB 1973) ("it is this drawing rather than applicant's own description of the mark that will govern the scope of protection afforded the registration thereof, when and if granted"); Trademark Rule 2.52, 37 C.F.R. § 2.52 ("A drawing depicts the mark sought to be registered."). Cf. *In re Covalinski*, 113 USPQ2d 1166, 1168-69



(TTAB 2014) (finding that the overall commercial impression of Applicant's mark is dominated by its design features, particularly the large elongated double-letter RR configuration; sufficient to make the mark dissimilar from mark with same literal component RACEGIRL); *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB



1986) (The initial letter "c" in each word, "construct" and "closet," for the mark was elongated both above and below the remaining letters and encompassed all the other letters of each word was sufficiently distinctive to allow registration with a disclaimer). Opposer's mark SMOK, the phonetic equivalent of the descriptive term "smoke," and the disclaimed term SMOKES in Applicant's mark are conceptually weak terms as used in connection with Applicant's goods and Opposer's goods and retail store services. Considering the marks [*61] in their entireties, we find that the addition of the broken concentric circle design and incorporation of the two elongated letters "s" to the disclaimed term SMOKES in Applicant's mark is sufficient to render Applicant's mark as a whole distinguishable from Opposer's mark to avoid confusion. See *In re Hamilton Bank*, 222 USPQ at 179.

Accordingly, the first *DuPont* factor supports a finding that confusion is not likely.

B. Similarity or Dissimilarity of the Goods and Services

We next consider the *DuPont* factor regarding the similarity or dissimilarity of the parties' respective goods or services. When analyzing the second factor, we look to the identifications of goods and/or services in the application and Opposer's Principal Register SMOK registration.⁵⁹ *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018).

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Application Serial No. 87856115, March 11, 2019 Office Action at TSDR 4. (oxforddictionary.com).

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"Even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods." **[*62]** *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). Thus, the goods or services need only be "related in some manner or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant's goods are "Cigarettes containing tobacco substitutes not for medical purposes containing only cannabis with a delta-9 THC concentration of not more than 0.3% on a dry weight basis." ⁶⁰

We consider most pertinent to Applicant's goods Opposer's Class 34 goods covered by its SMOK Principal Register registration: "Electronic cigarettes; Oral vaporizers for smokers; Smokers' oral vaporizer refill cartridges sold empty; Electronic cigarette atomizers sold empty; Electronic cigarette refill cartridges sold empty; Component parts of electronic cigarettes in the nature of tanks for electronic cigarettes, coils for electronic cigarettes, drip tips for electronic cigarettes, tank tubes for electronic cigarettes, and silicone rings for electronic cigarettes." We direct our focus particularly on "electronic cigarettes."

We take judicial notice of dictionary definitions of electronic cigarette ⁶¹ or ecigarette (another term for electronic cigarette) ⁶² which include "a hand-held object that some people use to simulate the effect of smoking" ⁶³ and "a battery-operated device that is typically designed to resemble a traditional cigarette and is used **[*64]** to inhale a usually nicotine-containing vapor." ⁶⁴ We take judicial notice of the dictionary definition of the term "vape" which indicates that one may vape (inhale vapor) through an electronic device such as an electronic cigarette. ⁶⁵

As indicated at nn.51 & 53 *supra*, Opposer's relatedness arguments are directed to the goods covered by the Registration, No. 4545449 for the mark SMOK, which as discussed above, is not of record and for which common law prior use has not been established.

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Applicant's goods under the mark are registrable as they are no longer covered by the Controlled Substances Act (CSA). See "Examination Guide 1-19 Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill" (addressing the enactment of the 2018 Farm Bill and the examination of hemp goods that contain no more than 0.3% THC on a dry-weight basis that no longer fall under the definition of controlled substances under the CSA). The Examination Guide does note that "not all goods for CBD or hemp-derived products are lawful following the 2018 Farm Bill," "[t]he 2018 Farm Bill explicitly preserved FDA's authority to regulate products containing cannabis **[*63]** or cannabis-derived compounds under the FDCA," and that "registration of marks for foods, beverages, dietary supplements, or pet treats containing CBD will still be refused as unlawful under the FDCA [Food Drug and Cosmetic Act]." Exam Guide at p. 2.

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We acknowledge that many dictionary definitions for electronic cigarette and e-cigarette are not as broad as the above listed definitions and identify electronic cigarettes or e-cigarettes as a device that simulates cigarette smoking and contains liquid nicotine without the tar from tobacco that is vaporized by the device.

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OXFORD ENGLISH DICTIONARY, lexico.com <https://www.lexico.com/en/definition/e-cigarette> (accessed October 31, 2022).

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COLLINS DICTIONARY COBUILD ADVANCED ENGLISH DICTIONARY, Collins Dictionary.com, www.collinsdictionary.com/us/dictionary/english/e-cigarette (accessed October 31, 2022).

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MERRIAM-WEBSTER DICTIONARY, merriam-webster.com, www.merriam-webster.com/dictionary/electronic%20cigarette (accessed October 31, 2022).

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Third-party website pages from the Vapor4Life website, provided by Opposer's witness as exhibit 1, state on their face "Best Online Vape and eJuice Shop." ... "We are your one-stop shop for the best e-cigs, e-liquids, disposable vapes, mods, pods, nic salts and hardware. Whether looking to make the switch from smoking to vaping, you have come to the right place." ⁶⁶ As to cannabis goods, the Kushism third-party website, submitted under notice of reliance, states on its face that it offers a "sizeable selection of vapes from licensed cannabis brands." ⁶⁷ These websites show on their face that consumers have been exposed to vaping goods that can be used in connection with either nicotine or cannabis.

Opposer provided two third-party news articles under notice of reliance titled "The 14 Best Weed Vaporizers to Buy in 2021" and "How to Vape Weed and Get the Most Out of It." ⁶⁸ Although these articles are hearsay, they do show on their face that [*66] the public has been exposed to articles relating to vaping "weed." *See Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) (articles, whether from the Internet or printed publications, not accompanied by testimony, may not be considered for the truth of the matters asserted therein); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) (factual assertions on webpages not considered because they were not supported by any statement from a competent witness).

As identified in Opposer's registration, electronic cigarettes are not limited in their uses and could be sold empty and used in connection with tobacco substitutes such as cannabis and hemp products. Therefore, we find that Opposer's electronic cigarettes are related to Applicant's "cigarettes containing tobacco substitutes" in that they both could be used for the same purpose, vaping or smoking (inhaling) a particular smokable substance. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1812, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes).

We find the second *DuPont* factor supports a finding of likelihood of confusion.

C. Channels of Trade

The third *DuPont* factor considers "the similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. There are no trade channel limitations in either Applicant's or Opposer's identifications of goods, and "the goods are presumed to travel in all normal channels and to all prospective purchasers for the relevant goods." *Coach Servs.* [*68], 101 USPQ2d at 1722.

Vape is defined as "to inhale vapor through the mouth from a usually battery-operated electronic device (such as an electronic cigarette) that heats up and vaporizes a liquid or solid." [*65] MERRIAM WEBSTER DICTIONARY (merriam-webster.com) <https://www.merriamwebster.com/dictionary/vape> (accessed October 31, 2022).

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Huang declaration, exhibit 1, 8 TTABVUE 26.

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Opposer's notice of reliance, 7 TTABVUE 58-64, (kushism.com).

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Opposer also argues expansion of trade, while acknowledging that this doctrine is typically applied in the priority of use context. Opposer's brief, 13 TTABVUE 17. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015). *But see Time Warner Entm't Co. v. Jones*, 65 USPQ2d at 1662 (considering expansion of trade in relatedness analysis). Expansion of trade requires a specific analysis. *See Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1598 and n.28 (TTAB 2011) (expansion of trade requires a specific analysis) *judgment set aside, opinion not vacated*, 110 USPQ2d 1679 (TTAB 2014). There is nothing in the record to support an expansion of trade argument, and Opposer's witness' testimony that it has future plans for expansion into the cannabis market does not suffice. Therefore, Opposer's contentions [*67] in the brief are purely speculative, based solely on attorney argument, and do not substitute for evidence. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citation omitted).

Opposer's witness testified that its goods are sold online, through smoking shops, vaping shops, and convenience stores.⁶⁹ Opposer's witness also indicated that its customer is over 21 years old and seeking an "alternative to cigarette smoking."⁷⁰ The four third-party websites, attached as exhibit 1 to Opposer's witness testimony, show on their face the offering of electronic nicotine smoking devices for tobacco products.⁷¹ All of these websites display a nicotine addiction warning at the top of the landing page.⁷²

Opposer also submitted under notice of reliance copies of webpages from Opposer's and Applicant's websites and copies of webpages of five third-party websites selling cannabis-related vaping and pre-roll cannabis products.⁷³

Opposer argues that **[*70]** the class of consumers for Applicant's and Opposer's goods is the same because both goods are targeted to consumers seeking alternatives to traditional cigarettes and are sold through the same venues.⁷⁴ However, it has not been established from this record that consumers that seek alternatives to traditional tobacco cigarettes also seek or use cannabis goods. In addition, the website evidence as a whole does not show on its face the offering of both these types of goods on the same websites.⁷⁵

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Huang Declaration P 7, 8 TTABVUE 3.

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Huang Declaration P 10, 8 TTABVUE 3.

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Huang Declaration exhibit 1, 8 TTABVUE 5-26. As previously noted, similar webpages from the Element Vape website were submitted under notice of reliance.

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We take judicial notice that "electronic cigarettes," components, and parts used with them are regulated tobacco products under the Food Drug and Cosmetic Act. *See* 44 U.S.C. § 1507 ("The contents of the Federal Register shall be judicially noticed...."); *Intercontinental Exch. Holdings, Inc. v. New York Mercantile Exch., Inc.*, 2021 USPQ2d 988, at *12 n.12 (TTAB 2021) (Board took judicial notice of EU regulations and definitions regarding the GDPR). *See* in particular the "Deeming **[*69]** Rule" published in the Federal Register which states that "[p]roducts that meet the statutory definition of 'tobacco products' include currently marketed products such as dissolvables not already regulated by FDA, gels, waterpipe tobacco, ENDS (including e-cigarettes, e-hookah, e-cigars, vape pens, advanced refillable personal vaporizers, and electronic pipes), cigars, and pipe tobacco." DEEMING TOBACCO PRODUCTS TO BE SUBJECT TO THE FEDERAL FOOD, DRUG, AND COSMETIC ACT, AS AMENDED BY THE FAMILY SMOKING PREVENTION AND TOBACCO CONTROL ACT; RESTRICTIONS ON THE SALE AND DISTRIBUTION OF TOBACCO PRODUCTS AND REQUIRED WARNING STATEMENTS FOR TOBACCO PRODUCTS ("Deeming Rule"), 81 Federal Register Vol. 81 28974, 28975-76 (May 10, 2016).

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Opposer's notice of reliance, 7 TTABVUE 28-38. As indicated previously in the priority discussion, Opposer's witness testified that Opposer's marketing is through social media. Huang Declaration P 8, 8 TTABVUE 3.

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Opposer's brief, 13 TTABVUE 16.

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Although one website webpage shows under "new arrivals," on what appears to be a continuation of the same webpage, vape goods and some CBD goods, all offered by different manufacturers, we find this evidence alone is insufficient to establish overlapping trade channels. Opposer's notice of reliance. 7 TTABVUE 7. *See, e.g., Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983) (finding no likelihood of confusion where both products were chemical compositions and sold under identical marks but the evidence was insufficient to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers). **[*71]**

In particular, as to the third-party websites offering electronic cigarettes, components and parts, four are offering only tobacco products. Of the five third-party websites offering only cannabis-based products, at least three of the websites appear to be on their face local dispensaries, which are regulated licensed entities,⁷⁶ also showing on their face that they offer online ordering but require local pickup. Opposer itself identifies at least two of these websites as dispensaries and acknowledges that these cannabis goods only may be offered where cannabis is sold legally.

Opposer has not shown that smoking shops, vaping shops, and convenience stores constitute an ordinary trade channel for Applicant's identified goods. [*72] Opposer relies on the websites offering cannabis, where it apparently is legally sold in certain states in the United States, that offer pre-rolled cigarettes and vaporizers or vaping devices as evidence of trade channel overlap. However, the fact that vaping type goods may be sold on the cannabis-only websites does not establish an overlap in trade channels with electronic cigarette tobacco products on different websites that offer only tobacco products, nor does it establish trade channel overlap in smoking shops, vaping stores or convenience stores. We find, on this record, it has not been established that cannabis products and tobacco products are sold in the same trade channels to the same consumers.

In light of the above, the mere fact that Applicant and Opposer have their own Internet websites advertising or offering their goods is not a sufficient basis to find overlapping trade channels. *Parfums de Couer*, 83 USPQ2d at 1021 ("the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade"). See also *Inter IKEA Sys.*, 110 USPQ2d at 1743 (rejecting opposer's theory that "any goods or services sold through [*73] retail stores, catalogs or over the Internet move through the same channels of trade and, therefore, for all intents and purposes, all goods and services potentially move through the same channels of trade").

Therefore, we find the trade channels are distinct for Applicant's and Opposer's goods and do not overlap. The third *DuPont* factor favors a finding of no likelihood of confusion.

V. Conclusion

We have considered all of the evidence pertaining to the relevant *DuPont* factors, as well as the arguments with respect thereto. Although we find the goods related, due to the weakness of the common element of the two marks and the sufficiently distinctive design elements in Applicant's mark, we find the marks are dissimilar, and overall, the channels of trade do not overlap. Therefore, we find no likelihood of confusion.

Decision: The opposition is dismissed.

APPENDIX

TESS (Trademark Electronic Search System) image that precedes TESS search result displaying database updated status date (blue arrow added to highlight the database date):

⁷⁶

We note, for example, the definition of "dispensary" in the MD. CODE HEALTH GEN. ART. § 13-3301(e) as "an entity licensed under this subtitle that acquires, possesses, processes, transfers, transports, sells, distributes, dispenses, or administers cannabis, products containing cannabis, related supplies, related products containing cannabis including food, tinctures, aerosols, oils, or ointments, or educational materials for use by a qualifying patient or caregiver."

Trademarks > Trademark Electronic Search System (TESS)

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Andrei Iancu
Director of the United States
Patent and Trademark Office



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SMOK

Word Mark SMOK

Goods and Services IC: 09- 35 021 03 028 035 043 0 11 5: Chargers for electronic cigarettes; Batteries for electronic cigarettes; Battery chargers for electronic cigarettes; Battery units in the nature of battery units for electronic cigarettes. FIRST USE: 2011/04; FIRST USE IN COMMERCE: 2010/03

IC: 04- 35 002 009 008 017 0 6 5: Electronic cigarettes; Oral apparatus for smokers; Smoked and vaporizer with cartridges sold empty; Electronic cigarette atomizers sold empty; Electronic cigarette with cartridges sold empty; Component parts of electronic cigarettes in the nature of tanks for electronic cigarettes; coils for electronic cigarettes; drip tips for electronic cigarettes; anti leaks for electronic cigarettes; and silicone tips for electronic cigarettes. FIRST USE: 2011/04; FIRST USE IN COMMERCE: 2010/03

IC: 04- 35 100 101 102 0 4 5: On-line retail sales services featuring electronic cigarettes, oral apparatus for smokers. FIRST USE: 2010/03; FIRST USE IN COMMERCE: 2010/03

Standard Characters

Character

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 6554549

Filing Date July 31, 2018

Current Status 11

Original Filing Basis 11

Publisher for Opposition March 26, 2020

Registration Number 6554549

Registration Date June 9, 2020

Owner (REGISTRANT) Shenzhen IVPS Technology Co., Ltd. LIMITED LIABILITY COMPANY CHINA 36 Jiefang Jieqian Tech Bldg. Shenzhen CHINA 518000

Attorney of Record JAY MATH

Price 445449.000000


Registrations

Type of Mark TRADEMARK SERVICE MARK

Register PRINCIPAL (1P)

Live/Dead Indicator LIVE

TESS screenshot capture submitted with Notice of Opposition for pleaded Registration No. 4545449 SMOK omitting the TESS database status date:

TSDB	Assign Name	TM Status
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Word Mark	SMOK	
Goods and Services	IC 034, US 002 008 009 011, G & S: Tobacco; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; Cigarette tubes; Tobacco pipes, not of precious metal; Cigar cases; Cigarette cases; Cigarette holders; Ashtrays for smokers; Cigarette filters. FIRST USE: 2011/01/02. FIRST USE IN COMMERCE: 2013/06/26	
Mark Drawing Code	(S) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM	
Serial Number	8006402	
Filing Date	October 17, 2013	
Current Basis	1A	
Original Filing Basis	1A	
Date Amended to Current Register	March 6, 2014	
Registration Number	4545449	
Registration Date	June 3, 2014	
Owner	(REGISTRANT) Shenzhen SMOK Technology Co., Ltd. LIMITED LIABILITY COMPANY CHINA, Room 1203 Shifeng Bldg, No.1 Beishi Rd, Gongming Town, Guangming New District Shenzhen CHINA (LAST LISTED OWNER) SHENZHEN IVPS TECHNOLOGY CO., LTD. LIMITED COMPANY CHINA, 3F, TEAN JI JING NENG YUAN TECH BUILDING NO. 2, LANGSHAN RD, NIAN SHAN DISTRICT SHENZHEN CHINA 518000	
Assignment Recorded	ASSIGNMENT RECORDED	
Attorney of Record	Nicky Aileen Baynongle	
Description of Mark	Color is not claimed as a feature of the mark. The mark consists of "SMOK" in stylized form.	
Type of Mark	TRADEMARK	
Register	SUPPLEMENTAL	
Live/Dead Indicator	LIVE	

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Slim N' Trim, Inc. v. Walgreen Co. , 2004 TTAB LEXIS 143

Trademark Trial and Appeal Board

March 16, 2004, Decided

Cancellation No. 92032743 to Registration No. 2,479,423 registered August 21, 2001.

Reporter

2004 TTAB LEXIS 143 *

Slim N' Trim, Inc. v. Walgreen Co.

Disposition: [*1]

Decision: The petition to cancel is denied.

Core Terms

milk, marks, dietary supplement, fat, trademarks, non-fat, products, Cancellation, Dairy, licensees, appears, registration, utilize, likelihood of confusion, fat free, connotation, consumer, license, Foods

Counsel

Rose A. Hickman of Christie, Parker & Hale, LLP for Slim N' Trim, Inc.

Robert R. Delaney, Jr. for Walgreen Co.

Panel: Before Hanak, Chapman and Rogers, Administrative Trademark Judges

Opinion By:

HANAK

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Hanak, Administrative Trademark Judge:

On October 9, 2001 Slim N' Trim, Inc. (petitioner) filed a Petition for Cancellation seeking to cancel Registration No. 2,479,423 which issued to Walgreen Co. (respondent) on August 21, 2001. This registration is for the mark SLIM FOR LE\$\$ depicted in typed drawing form for "dietary supplements." In its Petition for Cancellation, petitioner alleged that long before respondent first claimed that it used its mark SLIM FOR LE\$\$ (i.e. April 10, 2000), petitioner had both used and registered various SLIM marks including SLIM, SLIM FREEZ, SLIM CHEEZ, SLIMLINE, SLIM N' TRIM and SLIM N' LIGHT for various food products such as non-fat milk, low fat milk, low fat cottage cheese, low fat yogurt and ice milk. Continuing, petitioner alleged that registrant's use of SLIM FOR LE\$\$

for dietary supplements "will deceive the purchasing [*2] public and potential purchasers into believing that the [respondent's] products are sponsored, approved or sold by petitioner." (Petition for Cancellation paragraph 12).

Respondent filed an answer which, with one exception, denied the pertinent allegations of the petition for cancellation. The one exception is that respondent admitted the allegation set forth in paragraph 13 of the Petition for Cancellation, namely, that respondent had made no use of the mark SLIM FOR LE\$\$ prior to the year 2000. In addition, respondent set forth the affirmative defense that because petitioner did not oppose respondent's application to register SLIM FOR LE\$\$, that therefore petitioner should be estopped from filing this cancellation proceeding.

Petitioner filed an opening and a reply brief, and respondent filed a brief. Neither party requested an oral hearing. The record in this case is summarized at page 6 of petitioner's brief, and it includes certified status and title copies of petitioner's various registrations for its SLIM marks as well as the stipulated testimony of George Mills, a long-time employee of petitioner. Applicant made of record no evidence. Of course, the application file which [*3] resulted in the registration of SLIM FOR LE\$\$ is part of the record.

At the outset, we will deal with two preliminary matters. First, with regard to respondent's affirmative defense that petitioner is estopped from bringing this cancellation proceeding, we find this defense to be totally without merit. Because respondent made of record no evidence, it has not demonstrated that it has in any way been damaged by the fact that petitioner chose not to file an opposition proceeding, but rather chose to file this cancellation proceeding. Moreover, we note that the registration for SLIM FOR LE\$\$ issued on August 21, 2001 and that the Petition for Cancellation was filed on October 9, 2001 less than two months after the registration issued. A predecessor court to our primary reviewing Court has held that a period of six months between when a registration issues and when a cancellation proceeding is filed "has never been enough" to sustain a defense of estoppel, laches or acquiescence. Ralston Purina Co. v. Midwest Cordage Co., 373 F.2d 1015, 54 C.C.P.A. 1213, 153 USPQ 73, 76 (CCPA 1967).

Second, we note that in the Petition for Cancellation petitioner never formally pled the "family of marks" [*4] doctrine. However, reading the Petition for Cancellation in its entirety, it is clear that the marks which petitioner claimed superior rights in all consist of or begin with the word SLIM. Moreover, at page 11 of its opening brief, petitioner claims a "family of marks" containing the surname SLIM. In its brief, respondent never objected to petitioner's arguing that it possessed a "family of marks." Accordingly, we will address petitioner's "family of marks" argument on its merits.

To be quite blunt, petitioner has utterly failed to prove that it possesses a SLIM "family of marks." To elaborate, George Mills, previously identified as an employee of petitioner, testified that in 1953 he was hired by Bellbrook Dairy, a small processor and distributor of dairy products in the San Francisco, California area. Mr. Mills further testified that commencing in 1949, Bellbrook Dairy first utilized the mark SLIM for skim milk. In the early 1950's, Bellbrook Dairy commenced use of the mark SLIM CHEEZ for cottage cheese and the mark SLIM FREEZ for ice milk. According to Mr. Mills, in 1955 Bellbrook Dairy was sold. The "processing and distributing part of Bellbrook Dairy was sold to Challenge Cream [*5] & Butter." However, according to Mr. Mills, Bellbrook Dairy's SLIM trademarks were not sold to Challenge Cream & Butter Company, but were instead sold to Edlo Enterprises, Inc. Mr. Mills became a vice president of Edlo Enterprises in 1955. In 1984 the assets of Edlo Enterprises (i.e. the SLIM trademarks) were acquired by petitioner Slim N'Trim, Inc. Mr. Mills testified that in 1984 he was made a vice president of petitioner and that he has worked for petitioner in some capacity ever since.

Mr. Mills has never contended that either Edlo Enterprises or petitioner ever manufactured any products. Rather, Edlo Enterprises and later petitioner licensed the use of the SLIM trademarks to others, primarily local dairy companies.

In the intervening years, petitioner adopted other SLIM trademarks such as SLIM N'LITE, SLIM N'TRIM and SLIMLINE which it licensed to various dairy companies. The record reflects that these dairy companies did not have to take from petitioner a license to use all of the various SLIM trademarks. Rather, an individual dairy company could license simply one of the various SLIM marks.

The record further reflects that petitioner's licensees did not present petitioner's [*6] SLIM trademarks in any uniform fashion. For example, one of petitioner's licensees was Crystal Cream and Butter Co. of Sacramento, California. Crystal Cream and Butter Co. did utilize petitioner's SLIM trademark. However, Crystal Cream and Butter's packaging reveals that Crystal utilized petitioner's mark SLIM in a subordinate fashion. Exhibit 26 to the Mills deposition is an empty, one quart container for CRYSTAL fat free milk. The mark CRYSTAL appears in the most prominent fashion. In a somewhat less prominent fashion appears the generic term "fat free milk." In a decidedly less prominent fashion appears petitioner's mark SLIM. Crystal's trade dress for its fat free milk consists primarily of the background color pink with the lettering being in white. Other exhibits to the Mills deposition show that other licensees of petitioner utilized distinctively different trade dresses whenever they featured one or more of petitioner's SLIM trademarks.

Thus, a consumer seeing petitioner's mark SLIM as used by one of petitioner's licensees would not necessarily associate petitioner's mark SLIM as it was used with a distinctively different trade dress by another of petitioner's licensees. [*7] Moreover, consumers would certainly not view petitioner's various SLIM trademarks as emanating from the same "family" given the fact that (1) petitioner's licensees utilize their own distinctive trade dresses, and (2) there is no proof that petitioner's licensees took licenses to utilize all of petitioner's SLIM trademarks.

In addition, petitioner has not contended that it, as essentially a trademark licensor, has expended any sums in advertising or promoting any of its SLIM trademarks, much less that it has expended any sums in advertising and promoting its various SLIM trademarks together as a family. Moreover, petitioner's licensees have expended very minimal amounts in promoting petitioner's trademarks. For example, in the most recent year for which data is available (2001), all of petitioner's licensees expended less than \$ 430,000 in promoting one or more of petitioner's SLIM trademarks.

A party plaintiff faces a very high hurdle in showing that it has established a "family of marks." 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 23:61 at page 23-139 (4th ed. 2002). For example, a predecessor court to our primary reviewing Court held that Polaroid [*8] Corporation failed to establish a family of POLA marks despite the fact that Polaroid's sales of its various POLA products exceeded more than \$ 100 million in 1961. Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 52 C.C.P.A. 978, 1965 Dec. Comm'r Pat. 209, 144 USPQ 419 (CCPA 1965).

Given the fact that petitioner has totally failed to establish that it has a SLIM "family of marks," we will confine our likelihood of confusion analysis to a comparison of respondent's mark SLIM FOR LE\$\$ for dietary supplements with petitioner's marks SLIM, SLIM N'TRIM, and SLIM N'LIGHT all previously used and registered for non-fat milk or low fat milk. We will confine our analysis to the foregoing three marks owned by petitioner because, according to petitioner, only these three marks have been used in conjunction with non-fat or low fat milk and because petitioner contends that non-fat or low fat milk are the closest of its licensees' products to respondent's dietary supplements. In this regard, petitioner notes that respondent's specimen of use for SLIM FOR LE\$\$ shows that respondent's dietary supplement is a "ready to drink meal" that comes in eleven fluid ounce containers. Thus, as petitioner contends, respondent's liquid [*9] dietary supplement is closer to non-fat milk and low fat milk than it is to petitioner's other products such as low fat yogurt and low fat cottage cheese. (Petitioner's brief page 14).

Before beginning our likelihood of confusion analysis between respondent's mark SLIM FOR LE\$\$ and petitioner's marks SLIM, SLIM N'TRIM and SLIM N'LIGHT, we should note that priority rests with petitioner inasmuch as the record reflects that petitioner has made use of SLIM, SLIM N'TRIM and SLIM N' LIGHT long before respondent first used SLIM FOR LE\$\$ in 2000, and respondent does not contend to the contrary.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, petitioner has totally failed to establish that any company manufactures and/or markets, on the one hand, dietary supplements, and, [*10] on the other hand, non-fat milk, low fat milk or any other type of

milk. Petitioner has certainly not established that any company manufactures and/or markets under the same mark both dietary supplements and non-fat milk, low fat milk or milk of any type. Petitioner has argued, although not proven, that dietary supplements and milk (non-fat, low fat or otherwise) can be sold in the same channels of trade such as grocery stores and large drug stores. Despite petitioner's failure of proof, we do not dispute petitioner's contention. However, the fact that the same products can be sold in super markets, large drug stores or other major stores does not prove that these products are related. Such stores carry a wide variety of products including a wide array of edible items as well as non-edible items. This does not mean that dietary supplements and non-fat milk, low fat milk and milk of any type are related.

Petitioner has also argued, again without evidentiary proof, that a consumer could purchase both dietary supplements and non-fat milk, low fat milk and milk. However, this does not establish that dietary supplements are in any way related to milk of any type. This same consumer [*11] could go to a grocery store and purchase green beans, fresh fish, motor oil and dietary supplements. This simply does not establish that any of these products are related.

Finally, in an effort to establish a relationship between dietary supplements (respondent's goods) and the goods of petitioner (non-fat milk and low fat milk) which petitioner contends are most closely related to respondent's goods, petitioner notes that respondent's specimen of use indicates that one of the ingredients (amongst many other ingredients) in respondent's product is fat free milk. The fact that one of the ingredients in respondent's product is fat free milk does not mean that respondent's dietary supplements are products which are related to non-fat milk, low fat milk or milk of any type, the very products of petitioner which petitioner contends are most closely related to respondent's product. Respondent's own specimen of use (a SLIM FOR LE\$\$ label affixed to an eleven fluid ounce container) shows that respondent's SLIM FOR LE\$\$ dietary supplement contains numerous other ingredients, and includes 24 vitamins and minerals.

In short, we find that petitioner has established that respondent's dietary [*12] supplements and petitioner's non-fat milk and low fat milk are at most only minimally related.

Turning to a consideration of the marks, we note that the only term common to respondent's mark and petitioner's three marks in question (or any of petitioner's marks) is the word "slim." As applied to dietary supplements, on the one hand, and non-fat milk or low fat milk, on the other hand, the word "slim" is extremely highly suggestive. We take judicial notice of the fact that the word "slim" is defined as follows: "small in girth in proportion to height or length; slender." Moreover, variations of the word "slim," namely "slimmed" and "slimming," are defined as "to make or become slim." Webster's New World Dictionary (1975). Thus, as applied to dietary supplements and non-fat and low fat milk the word "slim" is indeed extremely highly suggestive.

Given the fact that the only component common to respondent's mark and petitioner's marks is the very highly suggestive term "slim," we find that there exists no likelihood of confusion in light of the fact that taken in their entireties, respondent's mark SLIM FOR LE\$\$ and petitioner's marks SLIM, SLIM N'TRIM and SLIM N'LIGHT are decidedly [*13] different in terms of visual appearance, pronunciation and, most importantly, connotation.

The differences in visual appearance and pronunciation are obvious, and need hardly be explained. Likewise, the difference in connotation is likewise highly obvious. However, with regard to the issue of connotation, we note that petitioner itself has acknowledged that the FOR LE\$\$ portion of respondent's mark has a decidedly different connotation than that of any of petitioner's marks when petitioner states that the FOR LE\$\$ portion of respondent's mark implies that respondent's "product costs less than petitioner's product." (Petitioner's brief page 15) By its own admission, petitioner has conceded that consumers would differentiate petitioner's marks from respondent's mark SLIM FOR LE\$\$.

Finally, as further evidence of the weakness of the word "slim" as applied to dietary supplements or non-fat and low fat milk, we note that on respondent's specimen of use for its SLIM FOR LE\$\$ dietary supplement, there appears the following language: "Compare to SLIM FAST(R)*." The asterisk then refers to the following statement appearing on the SLIM FOR LE\$\$ label: "This product is not manufactured or [*14] distributed by Slim Fast Foods Company. SLIM FAST(R) is a registered trademark of Slim Fast Foods Company." Thus, at least one other company (Slim

Fast Foods Company) is using a mark containing the word "slim" for a product (SLIM FAST) which appears to be more similar to respondent's product than are petitioner's non-fat and low fat milk products.

In sum, given the fact that petitioner has failed to prove that any of its products and respondent's dietary supplements are more than minimally related, and the additional fact that respondent's mark SLIM FOR LE\$\$, with the final two SS depicted as dollar signs, is distinctly different in terms of visual appearance, pronunciation and connotation from any of petitioner's marks, we find that there exists no likelihood of confusion.

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Sock It To Me, Inc. v. Hordijczuk, 2020 TTAB LEXIS 282

Trademark Trial and Appeal Board

July 20, 2020, Decided

Opposition No. 91236423

Reporter

2020 TTAB LEXIS 282 *

Sock It To Me, Inc. v. Lisa C. Hordijczuk DBA Sock Dirty To Me

Disposition: [*1] Decision: The opposition is dismissed

Core Terms

socks, registration, DIRTY, Trademark, fame, stockings, advertising, channels, sexual, dissimilarity, incontestable, registered

Counsel

Steven E. Klein, Sheila Fox Morrison, Davis Wright Tremaine LLP, for Sock It To Me, Inc.

Richard G. Sanders, Aaron & Sanders, PLLC, for Lisa C. Hordijczuk.

Panel: Before Mermelstein, Lykos, and English, Administrative Trademark Judges.

Opinion By:

Mermelstein, David M.

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Mermelstein, Administrative Trademark Judge:

Lisa C. Hordijczuk applied to register the standard-character mark **SOCK DIRTY TO ME** on the Principal Register for "socks." ¹ Registration is opposed by Sock It To Me, Inc., which alleges that Applicant's mark is likely to cause confusion, or mistake, or to deceive, in view of Opposer's prior use and registration of the standard character mark **SOCK IT TO ME** for "socks and stockings." ² [Trademark Act Section 2\(d\), 15 U.S.C. § 1052\(d\)](#). ³

¹

Application Serial No. 87294375, filed January 9, 2017, based on use in commerce.

²

We dismiss the opposition.

I. The Record

The record comprises the pleadings and pursuant to Trademark [Rule 2.122\(b\)](#), the file of the opposed application. In addition, the parties submitted the following evidence:

A. Opposer's Evidence

- . Opposer's pleaded registration, attached as an exhibit to the notice of opposition. 1 TTABVUE 10. See Trademark [Rule 2.122\(d\)\(1\)](#).
- . Corrected ⁴ Testimonial declaration of Michelle Walker, Opposer's CEO. 36 TTABVUE (confidential); 37 TTABVUE (redacted).
- . Opposer's first notice of reliance on dictionary definitions. 19 TTABVUE.
- . Opposer's second notice of reliance on Applicant's responses to requests for admission and interrogatories. 20 TTABVUE.
- . Reply declaration of Michelle Walker. 25 TTABVUE.
- . Opposer's third (reply) notice of reliance. 26 TTABVUE.
 - . Applicant's interrogatories and Opposer's responses; and
 - . Dockets and filings from other TTAB proceedings.

B. Applicant's Evidence

- . Testimonial declaration of Lisa C. Hordijczuk. 21-22 TTABVUE; 23 TTABVUE (confidential).
- . Applicant's notice of reliance. 24 TTABVUE.

Registration No. 4173688, issued July 17, 2012. Affidavits under §§ 8 & 15 accepted and acknowledged. Opposer disclaimed the exclusive right to use **SOCK** apart from the mark as shown.

3

Opposer also asserted the grounds of lack of ownership and nonuse, 1 TTABVUE 6, 7, but admits that Applicant's proofs at trial are sufficient for Applicant to prevail **[*2]** on these claims. *Opp. Br.* 39 TTABVUE 18 n.1. In light of Opposer's concession, these grounds for opposition are dismissed with prejudice.

4

After trial and briefing, Opposer moved for leave to file a substitute testimonial declaration of Ms. Walker and substitute opening and reply briefs. 36-39 TTABVUE. Opposer states that the substitute filings were made to correct an inaccuracy in Ms. Walker's testimony, namely, that the testimony included "amounts for sales and marketing outside the United States," and that those amounts were referenced in Opposer's originally filed briefs. Applicant did not oppose the motion, which we grant as conceded. Trademark [Rule 2.127\(a\)](#). Further references to confidential information in Ms. Walker's testimony or Opposer's briefs are to the substitute versions attached to Opposer's motions.

- . Opposer's responses to interrogatories; [*3]
- . Dictionary definitions; and
- . Webpages.

II. Evidentiary Objections

Each party filed objections to evidence submitted by the other. Opposer objects "on grounds of relevance and over breadth" to Ms. Hordijczuk's testimony, 21 TTABVUE 2-6, PP 3-17 and exhibits 1-6, "to the extent Applicant purports to introduce the testimony and evidence set forth therein for any purpose other than to show Applicant's first use of the applied for . . . mark and ownership of the opposed Application." *Opp. Br.* Appx. A, 29 TTABVUE 28. The [*4] objection is overruled. Opposer is correct that this proceeding must be conducted on the basis of the application and registration at issue, and that Applicant's mark, goods, channels of trade, classes of purchasers, and the conditions of purchase may not be limited by extrinsic evidence. *See Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990). But while Applicant's testimony and evidence about her own business under the mark cannot limit our consideration of the applicable goods, channels of trade, classes of purchasers, and conditions of sale, it is relevant to the extent that it is one example of practice in the trade. We will consider it to that extent.

Opposer also conditionally objects to Applicant's submission of certain of Opposer's discovery responses on the ground that they are incomplete without consideration of some of Opposer's other responses. *Opp. Br.* Appx. A, 29 TTABVUE 29. Opposer submitted these other responses with its third (reply) notice of reliance, to which Applicant has not objected. Because Opposer's other interrogatory responses will be considered, *see* Trademark [Rule 2.120\(k\)\(5\)](#), Opposer's objection is moot.

Finally, Applicant objects on the grounds of hearsay and lack of authentication [*5] to an exhibit to Opposer's first notice of reliance, *see Opp. Not. of Reliance*, 19 TTABVUE 55. The exhibit is an Instagram page featuring a picture of socks with **SOCK IT TO ME** labels. Next to the photograph is a comment in which the poster uses the hashtag "#sockdirtytome." Opposer contends that the post is an instance of actual confusion.

We see no problem with the authentication of the Instagram page; the page bears the URL and date, and Applicant does not provide any evidence or argument suggesting that it is not what it purports to be. The evidence is thus authenticated as internet material which may be admitted "in the same manner as a printed publication." Trademark [Rule 2.122\(e\)\(2\)](#). But Opposer relies on the Instagram page as evidence of actual confusion.⁵ *Opp. Br.*, 29 TTABVUE 25. It is far from clear that the poster was actually confused as to the source of the pictured goods, but even if he or she was, the Instagram post is "only hearsay and entitled to little weight. It is offered to prove the state of mind of a third party (concerning confusion between the two marks) or his statements. Actual confusion is entitled to great weight but only if properly proven. Such is not the case here." [*6] [Ga.-Pac. Corp. v. Great Plains Bag Co.](#), 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980) (citation omitted).⁶ Applicant's objection is sustained to the extent

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The notice of reliance indicates that the "documents are relevant to the issue of likelihood of confusion, including the similarity of the parties' respective marks in terms of appearance, sound, meaning and commercial impression." 19 TTABVUE 4. Proof of actual confusion was not one of the reasons stated for the relevance of the document in the notice of reliance, but Applicant did not raise that issue, forfeiting any objection on that ground.

6

We are aware of opinions finding similar evidence to be either not hearsay because it is not offered for the truth of the matter asserted, *see* [FED. R. EVID. 801\(c\)\(2\)](#), or to be admissible as an exception to the hearsay rule because it is evidence of the declarant's state of mind, *see* [FED. R. EVID. 803\(3\)](#). *See* J. Thomas McCarthy, [*7] MCCARTHY ON TRADEMARKS AND

that we give this single, ambiguous incident "little weight" in determining likelihood of confusion. See *id.*; cf. *Syndicat Des Proprietaires Viticulteurs de Chateauneuf-Du-Pape v. Pasquier des Vignes*, 107 USPQ2d 1930, 1942 (TTAB 2013) ("[T]his single instance of actual confusion is insufficient to show that confusion is likely. We consider this *du Pont* factor to be neutral.").

III. Standing

To establish its standing, Opposer must show a real interest in the outcome of the proceeding and a reasonable basis for its belief of damage resulting from the registration sought by Applicant. See [Trademark Act Section 13, 15 U.S.C. § 1063](#); [Empresa Cubana Del Tabaco v. Gen. Cigar Co.](#), 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); [Ritchie v. Simpson](#), 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Opposer's submission of its pleaded registration adequately establishes its interest in this proceeding and a reasonable basis for its belief that damage would result from registration of Applicant's mark. *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1820 (TTAB 2015).

IV. Likelihood of Confusion

A. Priority

Because Opposer established ownership and validity of its pleaded registration, priority is not at issue with respect to the registered mark and the goods identified in the registration.⁷ [King Candy Co. v. Eunice King's Kitchen, \[*8\] Inc.](#), 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. Applicable Law

Our determination under [Trademark Act § 2\(d\)](#) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See [In re E.I. du Pont de Nemours & Co.](#), 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); [In re Majestic Distilling Co.](#), 315 F.3d 1311, 65 USPQ2d 1201, 1203-04 (Fed. Cir. 2003). We must [*9] consider each *DuPont* factor for which there is evidence and argument. See, e.g., [In re Guild Mortg. Co.](#), 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. [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."). These and other factors are discussed below.

Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

C. Analysis

UNFAIR COMPETITION § 32:15 (5th ed. June 2020 update) (majority of courts admit evidence of thirdparty confusion notwithstanding hearsay rule). Nonetheless, the CCPA's decision in [Georgia-Pacific](#) remains controlling on this issue. See [S. Corp. v. United States](#), 690 F.2d 1368, 1369 (Fed. Cir. 1982) (decisions of the Court of Customs and Patent Appeals adopted as controlling precedent in the Federal Circuit).

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Opposer notes that its registration issued prior to Applicant's filing date and that "Applicant makes no claim of actual use . . . that predates either the filing or registration dates established by Opposer's [r]egistration." *Opp. Br.*, 29 TTABVUE 16. These arguments miss the point: Because Opposer introduced its registration in evidence, priority of either filing or use is irrelevant. Absent a counterclaim to cancel it, once an opposer introduces its registration, priority ceases to be an issue, even if the applicant was in fact the first to use its mark or file its application. [Massey Junior Coll., Inc. v. Fashion Inst. of Tech.](#), 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation"). In other words, the introduction of opposer's pleaded registration did not prove priority; it eliminated the *need* to prove priority. See [King Candy](#), 182 USPQ at 110.

1. Similarity of Goods; Channels of Trade; Purchasers; Conditions of Sale

We evaluate the relatedness of Applicant's and Opposer's goods and services based on the identification of goods or services set out in the involved application, compared with the identification of goods or services in Opposer's registration. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc.*, 16 USPQ2d at 1787; *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Applicant's goods are identified as "socks," while Opposer's goods are identified [*10] as "socks and stockings." The goods are thus identical at least in part and otherwise closely related.⁸ To the extent the goods are identical, we must consider them to move in the same channels of trade to the same purchasers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018), cert. denied, 139 S. Ct. 1550, 203 L. Ed. 2d 713 (2019) ("the TTAB properly followed our case law and presumed that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods" (cleaned up)); see *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even in the absence of evidence regarding channels of trade and classes of consumers, the Board may rely on this legal presumption in determining likelihood of confusion).

Similarly, because the parties' goods include "socks" without restriction, we must consider them to include socks of all types, including those sold at relatively low prices and purchased without the kind of careful inspection and deliberation that might tend to mitigate any confusion which might otherwise be likely. See *Am. Lava Corp. v. Multronics, Inc.*, 461 F.2d 836, 59 C.C.P.A. 1127, 174 USPQ 107, 108 (CCPA 1972); see also *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care."). Opposer introduced evidence that socks can be relatively inexpensive items, selling for as little as \$ 1.50 per pair. *Walker Dec.*, 18 TTABVue 5, 31-52.

Further, we must assume both of the parties' socks and stockings to be sold to all usual purchasers of such goods. *In re Elbaum*, 211 USPQ at 640. Because socks and stockings are basic items of clothing, the class of potential purchasers is particularly large, including virtually all adults. While some purchasers may exercise particular care and sophistication in purchases of socks or stockings, [*12] many others undoubtedly do not, especially when purchasing goods at the lower end of the price range. When the class of purchasers is mixed, we focus on the least-sophisticated customers among them. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). While "[p]urchaser sophistication may tend to minimize likelihood of confusion . . . , impulse purchases of inexpensive items may tend to have the opposite effect." *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). Because socks and stockings can be purchased at low prices by a large class of ordinary consumers, we find that they would be purchased with no more than an ordinary degree of care.

These factors favor a finding of likely confusion.

2. Strength of Prior Mark

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We take judicial notice of the definition of "stocking" as including "a usually knit closefitting covering for the foot and leg" (sense 1a) and "sock" (sense 1b). MERRIAM-WEBSTER DICTIONARY, *stocking* (<https://www.merriam-webster.com/dictionary/stockings> (visited Jul. 17, 2020)). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). The term "stocking" [*11] thus refers to both socks and foot-and-leg coverings related to socks.

Opposer contends that its mark is conceptually and commercially strong. Before considering Opposer's evidence, we address misconceptions by both parties.

Applicant makes several statements implying that the relevant time frame for considering the strength of Opposer's mark is prior to Applicant's first use, *e.g.*, 32 TTABVue 8, or its application date, *id.* at 14-15. That is incorrect. "For purposes of likelihood of confusion, the Board generally accepts and considers [*13] evidence related to likelihood of confusion for the period to and including the time of trial, and this includes evidence of the fame of a plaintiff's mark." ⁹ *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011), *judgment set aside on other grounds*, [Opp. No. 91118482, 2014 TTAB LEXIS 5, 591 TTABVue \(TTAB Jan. 22, 2014\)](#); see also [In re Chippendales USA Inc., 622 F.3d 1346, 96 USPQ2d 1681, 1686 \(Fed. Cir. 2010\)](#) ("the proper time for measuring inherent distinctiveness is at the time of registration"); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.18 (TTAB 2014). We have thus considered all record evidence of the strength or renown of Opposer's mark, including any evidence postdating Applicant's first use or application date.

For its part, Opposer notes throughout its brief that its registration is "incontestable," implying that its mark is strong or that its registration otherwise should carry greater weight in this proceeding. Nonetheless, the incontestable status of Opposer's registration is of no consequence [*14] to the strength of Opposer's mark or the issue of likelihood of confusion in general. Consistent with the majority of circuits to have considered the question, our precedent makes clear that the benefits of incontestability do not include any presumption that the mark in an incontestable registration is necessarily strong by virtue of that status. *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1036 (TTAB 2010) ("[T]hat opposer's federally-registered trademark has achieved incontestable status . . . does not dictate that the mark is 'strong' for purposes of determining likelihood of confusion."); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 11:84, 32:155 (5th ed. Mar. 2020 update).

The strength of a mark can be evaluated along two axes: inherent strength and commercial strength. See *Chippendales USA*, 96 USPQ2d at 1686. A mark's inherent strength is a measure of its distinctiveness, *i.e.*, whether it is fanciful, arbitrary, suggestive, descriptive, or generic. ¹⁰ *Id.* at 1684 (citing [Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759 \(2d Cir. 1976\)](#)). By contrast, a mark's commercial strength measures the degree to which the mark has achieved recognition among the relevant public. "[A] mark with extensive public recognition and renown deserves and receives [*15] more legal protection than an obscure or weak mark." *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Evidence of commercial strength or fame includes long use, strong sales and advertising, unsolicited media recognition, and surveys showing strong association of the mark with the source of the goods or services. See [du Pont, 177 USPQ at 567](#) (fifth factor). On the other hand, evidence that the public is confronted with the significant use by others of similar marks for similar goods tends to indicate a lack of commercial strength. See *id.* (sixth factor). The commercial strength or fame of a mark is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). Rather, likelihood of confusion fame "varies along a spectrum from very strong to very weak." See *Palm Bay*, 73 USPQ2d at 1694 (quoting [In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059 \(Fed. Cir. 2003\)](#)).

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This differs from a claim of dilution, in which the plaintiff must establish as an element of its case that its mark acquired fame prior to the defendant's first use or application date. [Trademark Act § 43\(c\)\(1\), 15 U.S.C. § 1125\(c\)\(1\)](#). Dilution was not pleaded or tried as a ground for opposition in this case.

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Because Opposer's mark is registered on the Principal Register and Applicant has not challenged its validity, it is presumed to be at least "suggestive." See [Trademark Act § 7\(b\)](#) (certificate of registration is *prima facie* evidence of the validity of the registration).

"Arbitrary word marks are words in common linguistic use but which, when [*16] used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services." McCarthy § 11:11. For example, **CAMEL** is an arbitrary mark for cigarettes. [*United States Patent & Trademark Office v. Booking.com B.V.*, 591 U.S. , 140 S. Ct. 2298, 207 L. Ed. 2d 738, 2020 USPQ2d 10729, *3 \(2020\)](#) (quoting [*Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-11, 120 S. Ct. 1339, 146 L. Ed. 2d 182 \(2000\)](#)). By contrast, a suggestive mark "suggests, but does not directly and immediately describe, some aspect of the goods or services." McCarthy § 11:62. An example of a suggestive mark is **TIDE** for detergent. Booking.com, 2020 USPQ2d at *3.

Opposer argues that its mark is inherently strong and entitled to a broad scope of protection because it is arbitrary. Applicant disagrees, contending that Opposer's mark is suggestive:

SOCK IT TO ME is a double entendre, playing on the double meaning of "sock": an article of clothing worn on the feet and to deliver a blow. In terms of conceptual strength, this double entendre is a double-edged sword. On the one hand, it enables **SOCK IT TO ME** to be treated as an inherently distinctive mark, despite the presence of the generic term for the recited goods in a prominent location. It is undoubtedly a known phrase used in an unexpected or uncommon way. On the other hand, the generic [*17] term does not entirely go away; it persists.

App. Br. 32 TTABVUE 12-13 (cleaned up).

There can be no doubt that the word *sock* is generic for Opposer's identified "socks." While Opposer's mark, **SOCK IT TO ME**, is plainly not generic or descriptive as a whole, the generic import of its first word ¹¹ lends the mark a suggestive quality because it names the identified goods. Notwithstanding the generic meaning of "sock," Opposer argues that

"sock" is also defined as "[t]o hit or strike forcefully; punch" and "[t]o deliver a blow" and has a recognized idiomatic meaning when included as part of the phrase "sock it to (someone)" that carries the meaning "[t]o deliver a forceful comment, reprimand or physical blow to someone else" or "to deliver new or information to someone that will have a very large impact or effect." Thus, viewed as a whole and in the context of its recognizable idiomatic meaning, **SOCK IT TO ME** is [*sic*] fanciful and arbitrary designation for socks.

Opp. Br., 29 TTABVUE 20 (citations omitted).

We recognize, of course, that the term **SOCK** appears in Opposer's mark as part of an idiomatic phrase which does not, in the abstract, refer to coverings for feet. But trademarks are not considered in the abstract; they are considered as they are used on or in connection with the goods or services to which they apply. Thus, when Opposer's mark is applied to socks the otherwise arbitrary phrase **SOCK IT TO ME** takes on an additional meaning -- the suggestion that Opposer's goods are socks. While Opposer's mark as a whole is clearly not descriptive or generic, consumers would clearly understand its first term to describe -- indeed name -- the goods to which it is applied. We conclude that Opposer's mark is suggestive of socks.

With regard to the commercial strength of Opposer's mark, the record shows that Opposer has used its mark "for nearly 15 years," and has sold "more than 12 million pairs of" **SOCK IT TO ME**-branded socks in the United States. *Opp. Br.*, 29 TTABVUE 20; *Walker Dec.*, 18 TTABVUE 3. Opposer provided sales and advertising figures.

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Opposer's disclaimer of **SOCK** in its registration is a concession that the term was at least descriptive of its goods at the time of registration. [*Quaker State Oil Refining Corp. \[*18\] v. Quaker Oil Corp.*, 453 F.2d 1296, 59 C.C.P.A. 764, 172 USPQ 361, 363 \(CCPA 1972\)](#).

(Opposer's sales and advertising figures for this period were submitted under seal, *Opp. Br.*, 38 TTABVUE 25 (confidential); **[*19]** *Walker Dec.*, 36 TTABVUE 7-9 (confidential), so we discuss them in general terms.) Opposer also notes its presence on its website and social media, its attendance at trade shows, and media attention in "numerous well-known publications and review websites." *Walker Dec.*, 18 TTABVUE 4-5.

Applicant criticizes Opposer's evidence of commercial strength. As Applicant notes, *App. Br.*, 31 TTABVUE 14, Opposer provided no evidence by which to place its advertising and sales figures in context. See *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("[R]aw numbers alone in today's world may be misleading.... Consequently, some context in which to place raw statistics is reasonable."). Similarly, as Applicant points out, Opposer touts its website and social media accounts, but does not mention its number of visitors or followers. *App. Br.*, 31 TTABVUE 16. Likewise, Opposer relies on its attendance at trade shows, but does not indicate the attendance at such shows or how frequently Opposer participates. *Id.* Finally, Applicant argues that Opposer's "representative sample" of "well-known publications and review websites" *Walker Dec.* P 13, Exh. C, 18 TTABVUE 5, which have featured Opposer's products is "underwhelming." **[*20]** *App. Br.*, 31 TTABVUE 16.

Applicant argues that "[s]ince Opposer fails to contextualize its bare evidence of fame, its mark is weak." *App. Br.*, 31 TTABVUE 14. We disagree. Even a complete absence of evidence of commercial strength is not itself evidence of weakness. *Cf. Majestic*, 65 USPQ2d at 1205 ("Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous." (citation omitted)). Thus even if Opposer submitted *no* evidence of commercial strength, we would find the fifth *du Pont* factor ("[t]he fame of the prior mark") neutral, rather than weighing in Applicant's favor.¹²

That said, Applicant raises some valid points about Opposer's evidence of commercial strength or fame. For instance, Opposer's sales and advertising expenditures would have clearly been bolstered had Opposer shown, **[*21]** for instance, that such figures represented a large share of the market for socks. See *Bose*, 63 USPQ2d at 1309. But Opposer's failure to do so affects the weight to be given Opposer's evidence, not its admissibility. We thus consider Opposer's sales and advertising expenditures, and recognize that they are not insubstantial. Likewise, Opposer's other evidence of commercial strength, while perhaps not perfect, has been considered, taking its probative value into account.

We conclude that, considered as a whole, Opposer's mark is somewhat suggestive of the identified goods, weighing against a finding of likelihood of confusion. On the other hand, it is clear that Opposer has enjoyed a measure of commercial success under its mark, weighing in Opposer's favor.

3. Similarity of the Marks

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation, and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are **[*22]** 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., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation and internal quotation marks omitted). While it is appropriate to accord greater weight to the more distinctive elements in the marks, we must consider the marks in

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A defendant wishing to show that the plaintiff's mark is commercially weak may do so by, for instance, offering evidence that there are numerous similar marks in use on similar goods. See *du Pont*, 177 USPQ at 567 (sixth factor). Applicant did not do so in this case.

their entirety. [*In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 \(Fed. Cir. 1985\)](#) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.").

Applicant's mark is **SOCK DIRTY TO ME** while Opposer's mark is **SOCK IT TO ME**. Both marks are depicted in standard characters, so they may be used in the same or similar stylization. See *In re Vittera*, 101 USPQ2d at 1909; *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1847; [*Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 \(Fed. Cir. 1983\)](#) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display."). Obviously, the marks are similar in that they both begin with the word **SOCK** and end in the words **TO ME**, and [*23] they differ in that the Applicant's mark includes the second word **DIRTY**, while Opposer's mark includes the second word **IT**.

Opposer's first -- and presumably strongest -- argument is that its "**SOCK IT TO ME** mark is nearly identical to and fully incorporated into Applicant's **SOCK DIRTY TO ME** mark" because the word **DIRTY** in Applicant's mark includes the letters **I** and **T** in that order (*i.e.*, **SOCK DIRTY TO ME**). *Opp. Br.*, 29 TTABVUE 21-22. This is an extreme example of impermissible dissection. Under Opposer's theory, customers would have to disregard the letters **D**, **R**, and **Y** in the word **DIRTY** to perceive the word **IT** hidden within. But there is no evidence, and we think it highly implausible, that purchasers seeing Applicant's **SOCK DIRTY TO ME** mark would see the word **IT** embedded in the word **DIRTY**. Not only is this highly unlikely, it violates the fundamental requirement that we consider the marks in their entirety. [*Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 \(CCPA 1981\)](#) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); [*Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1289 \(Fed. Cir. 2016\)](#). While it is entirely [*24] appropriate for rational reasons to afford more or less weight to certain parts of a mark, [*Nat'l Data Corp.*, 224 USPQ at 751](#), we may not ignore every other letter in a word to reveal another word that looks different, sounds different, and has a different meaning. There is no indication that purchasers of socks are particularly adept at steganography.

Opposer cites [*Hercules Inc. v. Nat'l Starch & Chem. Corp.*, 223 USPQ 1244 \(TTAB 1984\)](#), in support of its theory, but that case is inapposite. In *Hercules*, the Board found that despite the inclusion of the additional letters **SO** in the opposer's mark, when considered in their entirety, the marks at issue -- **NATROL** and **NATROSOL** -- shared similarities in appearance and pronunciation, without ignoring any part of them. By contrast, the words **DIRTY** and **IT** do not look similar, sound similar, or share similar meanings,¹³ and Opposer advances no rational reason to give the letters **D**, **R**, and **Y** in **DIRTY** less weight, let alone ignore them entirely.

The parties devote much of the rest of their argument to disputing the respective connotations of the marks and whether they are similar. Applicant urges that "**SOCK DIRTY TO ME** [is] a play on 'talk dirty to me,' mean[ing] to speak to salaciously or in a sexual manner." *App. Br.*, 31 TTABVUE 18. Applicant cites several definitions appearing in Idioms by The Free Dictionary, including The American Heritage Dictionary of Idioms and the Farlex Dictionary of Idioms. *App. Not. of Reliance*, 24 TTABVUE 33. Applicant contends that Opposer's mark, **SOCK IT TO ME**, "means 'hit me with your best shot (I can take it).'" *App. Br.*, 31 TTABVUE 17.

For its part, Opposer maintains that **SOCK IT TO ME** "is an invitation or encouragement by the speaker to a third party to deliver news or a comment that will have a forceful or significant impact on the speaker (and may also have sexual overtones)." *Opp. Br.*, 29 TTABVUE 23. But Applicant argues that any sexual connotation is not the

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Opposer also cites our non-precedential decision in [*In re ERS, Ser. No. 86822574*, 2017 TTAB LEXIS 441, 2017 WL 6398867, at *2 \(TTAB Nov. 27, 2017\)](#). *App. Br.* 39 TTABVUE 27. As Opposer notes, in *ERS* we found "**ZOCKS** and **ZOX** to be similar in sight and sound despite [the] fact that Applicant's mark shares the letters 'ocks' with [*25] the goods for which it is used (*i.e.*, socks)." *Id.* By contrast, in this case, **DIRTY** and **IT** are completely dissimilar, and their presence in the respective marks clearly *distinguishes* them in appearance, sound, and meaning.

primary [*26] import of Opposer's mark. *App. Br.*, 31 TTABVUE 19-20. We agree. While it is possible that the phrase **SOCK IT TO ME** could, in some circumstances, "have sexual overtones," that does not appear to be the primary meaning of the phrase, and nothing in the record indicates such a meaning would be suggested by Opposer's use of the phrase to identify socks and stockings. Opposer argues that "[t]here is nothing that precludes a sexually explicit statement from taking the form of a forceful comment or an invitation to deliver a physical blow . . ." *Reply Br.*, 34 TTABVUE 8. That appears to be correct, but the record falls short of showing that Opposer's mark does convey a sexually explicit statement in this case. In any event, even if Opposer is correct, the fact that the marks share somewhat salacious "overtones" is not enough in this case to overcome the differences in the primary meaning of the marks. And while the marks share the identical first word -- **SOCK** -- there is no doubt that that term is generic for socks. Potential purchasers seeing the marks applied to socks are thus likely to understand **SOCK** to refer, at least in part, to the parties' goods, rather than their source.

When each [*27] mark is considered as a whole, we conclude that each projects a different meaning, commercial impression, sound, and appearance. Accordingly, we find them more dissimilar than similar.

V. Balancing the Factors

We have carefully considered all of the evidence and argument of record. While most of the relevant *du Pont* factors favor a finding of likelihood of confusion, we find that they are outweighed in this case by the dissimilarity of the marks. There is "no reason why, in a particular case, a single *DuPont* factor may not be dispositive." [*Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 \(Fed. Cir. 1991\)](#). That is especially true of the similarity (or dissimilarity) of the marks, which is a "predominant inquiry" under the *du Pont* framework. *Hewlett-Packard*, 62 USPQ2d at 1003 (citing [*DuPont*, 476 F.2d at 1361](#))). [*Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 \(Fed. Cir. 2010\)](#) ("[E]ven if all other relevant *DuPont* factors were considered in [Opposer's] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely."). Consequently, we find that Opposer has not borne its burden to demonstrate likelihood of confusion by a preponderance of the evidence.

Although Opposer notes that doubt is to be resolved in [*28] favor of the senior party, *Opp. Br.*, 29 TTABVUE 26 (citing *Hewlett-Packard*, 62 USPQ2d at 1003; [*In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1691 \(Fed. Cir. 1993\)](#)), the rule does not apply because we are not in doubt.

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Sony Grp. Corp. v. Campbell, 2022 TTAB LEXIS 391

Trademark Trial and Appeal Board

October 28, 2022, Decided

Opposition No. 91245851

Reporter

2022 TTAB LEXIS 391 *

Sony Group Corporation v. Neil A. Campbell

Disposition: [*1] Decision: The opposition is sustained.

Core Terms

SoniStream, marks, dilution, famous, consumers, brands, pronunciation, pronounce, Stream, Registration, blurring, entertainment, appearance, music, sonic, similarity, Trademark, video, Register, products, television, followers, display, media, impression, argues, goods and services, Trademark Act, billion, ranked

Counsel

Mark Sommers, Naresh Kilaru, and Rosie Norwood-Kelly of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. for Sony Group Corporation.

Neil A. Campbell, pro se.

Panel: Before Zervas, Lykos, and Larkin, Administrative Trademark Judges.

Opinion By:

Larkin, Christopher C.

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Larkin, Administrative Trademark Judge:

Neil A. Campbell ("Applicant"), appearing pro se, seeks registration on the Principal Register of the standard-character mark SoniStream ¹ for goods identified as "Downloadable computer software for Internet and broadcast radio scheduling and audio payout" in International Class 9. ²

¹ As discussed below, this is how Applicant's standard-character mark is shown in the drawing in his application and discussed in his brief, and we will display the mark in this manner in our opinion. We note, however, that the appearance of the mark in this manner in the drawing "does not change the nature of the mark from standard character to special form." *New Era Cap Co. v.*

Sony Group Corporation ("Opposer")³ opposes registration of Applicant's mark on two grounds: (1) likelihood of confusion with Opposer's previously used and registered SONY and SONY-formative marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) likelihood of dilution by blurring of Opposer's SONY and SONY-formative marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).⁴ The case is fully briefed.⁵ We sustain the opposition on the basis of Opposer's dilution claim and do not reach its likelihood of confusion claim.

I. Opposer's Motion to Strike Applicant's Brief

In its reply brief, Opposer objects to Applicant's brief, and moves to strike [*4] it, on the grounds that it (1) was untimely filed, and (2) does not comply with the requirements of Trademark Rule 2.126, 37 C.F.R. § 2.126, because it is single-spaced, and does not include an index of cases or page numbers. 94 TTABVUE 24-26.

With respect to untimeliness, Applicant's brief was due on April 19, 2022, 80 TTABVUE 18, and it was filed the next day, April 20, 2022. 91 TTABVUE 1. Given the de minimis delay in filing, and the fact that Opposer did not demonstrate any prejudice to itself in timely filing its reply brief addressing all of Applicant's arguments, we decline to strike Applicant's brief because it was filed a day late. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") (June 2022) § 539 and cases cited therein.

Applicant's failure to comply with Trademark Rule 2.126(a)(1) is more troubling. "Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure and the Federal Rules of Evidence, is required of all parties, whether or not they are represented by counsel," *Hole in 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *1 (TTAB 2020), and, as Opposer notes, Applicant was repeatedly advised during this proceeding that his submissions must comply with the applicable rules. 8 TTABVUE 8 [*5] ("Submissions in Board proceedings . . . must be in compliance with Trademark Rules 2.126(a) and (b)."); 12 TTABVUE 2 ("Trial Briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b)."); 19 TTABVUE 2 ("submissions must be compliant with Trademark Rules 2.119 and 2.126."); 21 TTABVUE 1-2 ("Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b)."); 29 TTABVUE 4 ("submissions must be compliant with Trademark Rules 2.119 and 2.126."); 35 TTABVUE 6 (same); 73 TTABVUE 9 ("Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b).").

Pro Era, LLC, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020) (citing *In re Calphalon Corp.*, 122 USPQ2d 1153, 1154 n.1 (TTAB 2017)). As discussed below, a standard-character mark is not limited to any particular font style, size, or color. [*2]

² Application Serial No. 87882260 was filed on April 18, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce.

³ Opposer's corporate name was Sony Corporation when this proceeding was commenced, 1 TTABVUE 18, but Opposer changed its name to Sony Group Corporation during trial, 72 TTABVUE 2, and the Board granted Opposer's motion to substitute its updated name, and updated the case caption to identify Sony Group Corporation as the opposer. 73 TTABVUE 2.

⁴ In its Notice of Opposition, Opposer pleaded ownership of numerous SONY and SONYformative marks. Not. of Opp. PP 10-11; Ex. A (1 TTABVUE 21-29, 33-153). We focus below on Opposer's [*3] SONY word mark, registered in standard characters and in a stylized font, for a variety of goods and services.

Applicant's Answer to Notice of Opposition, 4 TTABVUE 1-10, denied the salient allegations of Opposer's Notice of Opposition, *id.* at 1-4, and interposed various self-styled "Affirmative Defenses, Avoidances, and Arguments." *Id.* at 5-7. Opposer moved to strike all 12 of the paragraphs in this portion of Applicant's Answer. 5 TTABVUE 2-6. The Board struck paragraphs 1, 7, and 9-12, but allowed paragraphs 2-6 and 8 to stand, not as affirmative defenses per se, but rather as amplifications of Applicant's denials of Opposer's allegations. 8 TTABVUE 4-5.

⁵ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's public online docketing system. *See New Era*, 2020 USPQ2d 10596, at *2 n.1. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer's main brief appears at 91 TTABVUE and its reply brief appears at 94 TTABVUE. Applicant's brief appears at 93 TTABVUE.

Despite these admonitions, Applicant's "brief is single-spaced and, thus, the brief is not in technical compliance with Trademark Rule 2.126(a)(1)." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.4 (TTAB 2012). Applicant's single-spaced brief is 26 pages in length and contains several pages with large blank portions, so it appears that "the brief, if double-spaced, would be within the [55]-page limitation as set forth in Trademark Rule 2.128(b)," and that Applicant's non-compliance was not "meant to be a subterfuge to circumvent the rule regarding the length of the brief." *Id.*; see also *Hole in 1 Drinks*, 2020 USPQ2d 10020, at *1-2 (declining to strike the defendant's brief on the ground that it was single-spaced). Accordingly, notwithstanding Applicant's [*6] seemingly cavalier attitude toward the rules, we will exercise our discretion to "consider [his] arguments in his brief, for whatever persuasive value they may have despite his failure to properly format the brief." *Id.*, at *2.

II. The Record

The record is immense, amounting to more than 6,000 pages of testimony and documents. It consists of the pleadings, the file history of the opposed application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following materials submitted by the parties:

A. Opposer's Evidence

- . Testimony Declaration of Takako Suzuki, Opposer's General Manager, Trademark Department, Intellectual Property Division, and Exhibits 1-50 thereto, 55 TTABVUE 2-1992; 56 TTABVUE 2-283; 57 TTABVUE 3-430; 58 TTABVUE 2-210;
- . Testimony Declaration of Mingshu W. Zhang, offered as an expert witness, and Exhibit A thereto, 39 TTABVUE 2-13;
- . Testimony Declaration of Jasmine A. Prezeau, offered as an expert witness, and Exhibits A-Z thereto, 40 TTABVUE 2-85;
- . Testimony Declaration of Dr. Melissa Pittaoulis, offered as an expert witness, and Exhibits A-H thereto, 41 TTABVUE 2-214; and
- . Notices of Reliance Nos. 1-18 (15 filed during Opposer's trial period and three filed during its rebuttal period), covering [*7] various materials including Opposer's multiple registrations,⁶ printed publications, Internet materials, Applicant's responses to Opposer's requests for admission, and excerpts from Applicant's discovery deposition. 36 TTABVUE 2-151 (No. 1); 37 TTABVUE 2-88 (No. 2); 38 TTABVUE 2-55 (No. 3); 42 TTABVUE 2-309 (No. 4); 43 TTABVUE 2-218 (No. 5); 44 TTABVUE 2-355 (No. 7); 45 TTABVUE 2-82 (No. 8); 46 TTABVUE 2-101 (No. 6); 47 TTABVUE 2-16 (No. 9); 48 TTABVUE 2-220 (No. 10); 49 TTABVUE 2-89 (No. 11); 50 TTABVUE 2-468 (No. 12); 51 TTABVUE 2-87 (No. 12); 52 TTABVUE 2-13 (No. 13); 53 TTABVUE 2-37 (No. 14); 54 TTABVUE 2-20 (No. 15); 87 TTABVUE 2-114 (No. 16); 88 TTABVUE 2-206 (No. 17); and 89 TTABVUE 2-106 (No. 18).

B. Applicant's Evidence

- . Testimony Declaration of Neil [*8] A. Campbell, 68 TTABVUE 2;

⁶ Pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), Opposer previously made its pleaded registrations of record by attaching USPTO electronic records showing their current title and status to its Notice of Opposition. 1 TTABVUE 33-153. Making registrations or other evidence of record once is enough. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *12-13 (TTAB 2022) (the Board views with disfavor the filing of duplicative evidence by different methods of introduction . . .).

. Testimony Declaration of Jonathan E. Hochman, offered as an expert witness, and Exhibits A-C thereto, 76 TTABVUE 43-128;⁷

. Testimony Declaration of Dr. Jacqueline A. Chorn, offered as an expert witness, and Appendix A thereto, 76 TTABVUE 11-42;⁸ and

. Notices of Reliance Nos. 1-7 and 9,⁹ covering Internet materials and Applicant's entire discovery deposition.¹⁰ 60 TTABVUE 2-15 (No. 1); 61 TTABVUE 2-37 (No. 2); 62 TTABVUE 2-69 (No. 3); 81 TTABVUE 1-4; 82 TTABVUE 1-4, 83 TTABVUE 2-5, 85 TTABVUE 2-5, and 86 TTABVUE 2-6 (No. 4);¹¹ 64 TTABVUE 2-41 (No. 5); 84 TTABVUE 2-16 (No. 6);¹² 69 TTABVUE 2-141 (No. 7);¹³ and 70 TTABVUE 2-20 (No. 9).

⁷ Prior to trial, Opposer moved to strike the original Hochman expert report, 67 TTABVUE 2-87, on the ground that it had not been executed during Applicant's trial period. 80 TTABVUE 10. The Board granted that motion, *id.* at 12, but construed Applicant's response as a request to reopen its trial period to allow the submission of an updated but identical Hochman report. The Board granted that construed request, and accepted the updated Hochman report. *Id.* at 15.

⁸ As with the original Hochman expert report, the Board struck **[*9]** the original Chorn declarations, 66 TTABVUE 2-32, because they had not been executed during Applicant's trial period, 80 TTABVUE 12, but accepted updated and identical Chorn declarations. *Id.* at 15. Dr. Chorn's declarations critique Opposer's likelihood of confusion survey, and are cited by Applicant only in support of his defense to Opposer's likelihood of confusion claim, 93 TTABVUE 18-19, which we do not reach.

⁹ The Board has not received a Notice of Reliance No. 8.

¹⁰ Opposer submitted under its Notice of Reliance No. 14 numbered pages 5, 10, 20, 23-26, 35-36, 42-43, 58-60, 66-69, 71-72, 77, 92-93, and 95-98 from the transcript of Applicant's 113-page discovery deposition, with heavy redaction. 53 TTABVUE 10-36. Applicant submitted his entire unredacted transcript and Exhibit 5 thereto under his Notice of Reliance No. 7. 69 TTABVUE 8-116. Trademark Rule 2.120(k)(4), 37 C.F.R. § 2.120(k)(4), provides that when one party has introduced "only part of a discovery deposition . . . an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party." Such a "notice of reliance filed by an adverse **[*10]** party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts." *Id.* Applicant's Notice of Reliance No. 7 covering the entire transcript of his discovery deposition stated that he "will likely rely on this full transcript to show the Board my complete answers to Opposer's questions in that deposition of which Opposer disclosed only in a highly redacted form to the Board from pages 5-7 and 97." 69 TTABVUE 2. As discussed below, Opposer moved to strike an email submitted with Applicant's Notice of Reliance No. 7 that was not identified as an exhibit at Applicant's discovery deposition, but did not object to the submission of the entire deposition transcript itself. 74 TTABVUE 4-5. Opposer also referred to the entire deposition in its description of the record in its main brief, 91 TTABVUE 16, noting only that the Board had struck the objected-to email. *Id.* at n.2. Accordingly, Opposer has waived any objection to Applicant's submission of the entire transcript of his discovery deposition on the ground that **[*11]** it exceeded the permissible scope of Applicant's use of the deposition under Trademark Rule 2.120(k)(4). We find that the entire transcript of Applicant's discovery deposition has been stipulated into the record by Opposer, and we have considered it in full as substantive evidence for whatever probative value it may have.

¹¹ Prior to trial, Opposer moved to strike Applicant's Notice of Reliance No. 4, which contained links to YouTube videos, 63 TTABVUE 2-4, on the ground that providing links to Internet materials is insufficient to make those materials of record. 80 TTABVUE 4. The Board granted that motion, *id.* at 6, but allowed Applicant 20 days from the date of the order to properly submit the referenced YouTube videos under notice of reliance. *Id.* at 6. Applicant subsequently submitted the videos, 81 TTABVUE 1-4; 82 TTABVUE 1-4, 83 TTABVUE 2-5, 85 TTABVUE 2-5; 86 TTABVUE 2-6, and we have considered them for whatever probative value they may have.

¹² Prior to trial, Opposer moved to strike Applicant's Notice of Reliance No. 6, 65 TTABVUE 2-7, on the ground that providing links to Internet materials is insufficient to make those materials of record. 80 TTABVUE 7. The Board granted that motion, *id.* at 8, but **[*12]** allowed Applicant 20 days from the date of the order to resubmit Notice of Reliance No. 6. *Id.* at 8-9. Applicant subsequently did so. 84 TTABVUE 2-16.

III. The Parties and Their Marks and Businesses

A. Opposer

Opposer was founded in Japan in 1946. Suzuki Decl. P 3 (55 TTABVUE 2). ¹⁴ In 1958, its company name changed from Tokyo Tsushin Kogyo K.K. to Sony Corporation, ¹⁵ and in the more than 60 years since, "Sony" has been the company's public-facing name. Suzuki Decl. P 5 (55 TTABVUE 3). In 1970, Opposer became the first Japanese company to have its shares listed on the New York Stock Exchange. Suzuki Decl. P 6 (55 TTABVUE 3). Opposer has used the SONY mark continuously in the United States since at least as early as 1960. Suzuki Decl. P 6 (55 TTABVUE 3). ¹⁶

Opposer is one of the world's largest diversified businesses with a long history in the consumer and professional electronics field, including audio, video, computer game, and mobile phone products, electronic components, and medical-related equipment and professional solutions. Suzuki Decl. P 3 (55 TTABVUE 2). Opposer is also a widely known and leading entertainment company in the motion picture, television, music, gaming and online entertainment spaces. Suzuki Decl. P 3 (55 TTABVUE 2).

Opposer's principal business operations include Sony Group Corporation, Sony Pictures Entertainment, Sony Interactive Entertainment (formerly Sony Computer Entertainment), Sony Music Entertainment, Sony Mobile Communications, and Sony Financial Holdings. Suzuki Decl. P 7 (55 TTABVUE 3). Opposer's approximate United States revenues from SONY-branded products and services across all of its business segments were \$ 12 billion in fiscal year 2013, \$ 14 billion in fiscal [*15] year 2014, \$ 16 billion in fiscal year 2015, \$ 16 billion in fiscal year 2016, \$ 17 billion in fiscal year 2017, \$ 19 billion in fiscal year 2018, and \$ 18 billion in fiscal year 2019. Suzuki Decl. P 7; Ex. 2 (55 TTABVUE 3-4, 53-1631). ¹⁷

Opposer has used its SONY mark in connection with a number of pioneering products, including the Betamax home video cassette recorder, which was the subject of a 1984 United States Supreme Court decision regarding copyright fair use, *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574, 220 USPQ 665 (1984); the Walkman, the world's first stereo cassette player, launched in 1979; the world's first compact disc player, launched in 1982; the world's first portable compact disc player, launched in 1984; the

¹³ Prior to trial, Opposer moved to strike an email attached to Applicant's Notice of Reliance No. 7, 69 TTABVUE 142-43, that was not an exhibit to Applicant's discovery deposition, on the ground that emails cannot be properly submitted under notice of reliance. 74 TTABVUE 4-5. The Board granted that motion. 80 TTABVUE 10.

¹⁴ "Rule 602 of the Federal Rules of Evidence provides that a 'witness may testify to a matter only if evidence is introduced sufficient to support [*13] a finding that the witness has personal knowledge of the matter,' and that '[e]vidence to prove personal knowledge may consist of the witness's own testimony.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *11 (TTAB 2021) (quoting Fed. R. Evid. 602). Mr. Suzuki testified that he is the General Manager, Trademark Department, Intellectual Property Division for Opposer, and has been employed by Opposer for more than 30 years, Suzuki Decl. P 1 (55 TTABVUE 2), that "[t]he facts in this declaration are based on my personal knowledge and/or my review of records and archival materials that Sony maintains in the ordinary course of business," Suzuki Decl. P 1 (55 TTABVUE 2), and that "[m]y time at Sony has exposed me to the history of the SONY brand and its continued promotion and recognition among consumers and industry professionals in the United States across numerous sectors, including consumer electronics, broadcast, and entertainment." Suzuki Decl. P 2 (55 TTABVUE 2). We find that this foundational testimony is sufficient to establish that Mr. Suzuki has personal knowledge of the history of Opposer's use of its marks and the other matters in his declaration. *Sabhnani*, 2021 USPQ2d 1241, at *12.

¹⁵ As noted above, Opposer changed its corporate name to "Sony [*14] Group Corporation" after Mr. Suzuki executed his declaration in February 2021.

¹⁶ Mr. Suzuki attached to his declaration a page from Opposer's website at sony.net discussing Opposer's history. Suzuki Decl. P 6; Ex. 1 (55 TTABVUE 3, 33-52).

¹⁷ Exhibit 2 to Mr. Suzuki's declaration contains a series of Opposer's Annual Reports filed with the United States Securities and Exchange Commission for the relevant periods.

Handycam camcorder, launched in 1989; and the Playstation video game console, launched in 1995. Suzuki Decl. PP 8-9 (55 TTABVUE 4, 1676-1762; 56 TTABVUE 56-67).

Opposer's SONY mark has also long been a prominent brand in connection with entertainment. Suzuki Decl. P 10 (55 TTABVUE 4). It has been [*16] used by Opposer's affiliates Sony Pictures Entertainment in connection with movies and television programs, Sony Pictures Television in connection with television programming, Sony Music Entertainment in connection with the Sony music label, and Sony Interactive Entertainment in connection with the PlayStation hardware, software, content, and network services. Suzuki Decl. P 16 (55 TTABVUE 7-8).

The public has been exposed to Opposer's SONY mark through television and film production and distribution since 1989, Suzuki Decl. P 10 (55 TTABVUE 4), and the production or distribution of numerous hit feature motion pictures in the United States, including A FEW GOOD MEN (1992), JERRY MAGUIRE (1996), GODZILLA (1998), GLADIATOR (2000), THE DA VINCI CODE (2006), THE SOCIAL NETWORK (2010), THE SMURFS (2011), ONCE UPON A TIME IN HOLLYWOOD (2019), two Jumanji films, JUMANJI (1995) and JUMANJI: WELCOME TO THE JUNGLE (2017), four James Bond films, 007 CASINO ROYALE (2006), 007 QUANTUM OF SOLACE (2008), 007 SKYFALL (2012), and SPECTRE (2015), and seven Spider-man films, SPIDER-MAN (2002), SPIDER-MAN 2 (2004), SPIDER-MAN 3 (2007), THE AMAZING SPIDER-MAN (2012), THE AMAZING SPIDERMAN 2 (2014), SPIDER-MAN: [*17] HOMECOMING (2017), and SPIDER-MAN: FAR FROM HOME (2019). These films have collectively grossed many billions of dollars in the United States. Suzuki Decl. P 11 (55 TTABVUE 5-6).

Opposer's SONY mark has also been used in connection with the production, distribution, and sale of musical recordings by artists such as Mariah Carey, Pearl Jam, Bruce Springsteen, Celine Dion, Pink Floyd, Luther Vandross, Gloria Estefan, Michael Jackson, Sade, Beyonce, Adele, David Bowie, and Elvis Presley. Suzuki Decl. PP 12-14; Exs. 6-9 (55 TTABVUE 6-7; 56 TTABVUE 58-146).

The SONY mark has been extensively advertised and promoted in connection with various goods and services in the United States for over half a century, including through retail stores, national television commercials, advertisements in magazines, newspapers, billboards (including one in New York City's Times Square spanning decades), the Sony.com website, digital media, social media, and global sporting events. Opposer has spent tens of millions of dollars annually advertising and promoting the SONY mark in the United States for decades. Suzuki Decl. P 40; Ex. 30 (55 TTABVUE 15; 56 TTABVUE 246-57). Mr. Suzuki's declaration displays or attaches [*18] a number of historical advertisements displaying the SONY mark, several of which we reproduce below:



Suzuki Decl. P 40 (55 TTABVUE 17).



Suzuki Decl. P 40 (55 TTABVUE 18).

Opposer's SONY mark also appears prominently on Opposer's social media pages, including on Facebook (over 8.5 million followers), Twitter (4.7 million followers), YouTube (over 390,000 subscribers), Instagram (8.7 million followers), and LinkedIn (over 770,000 followers). The social media pages for Sony Pictures display the SONY mark at the top of the pages, including on Facebook (over 29 million followers), Twitter (2.7 million followers), YouTube (4.52 million subscribers), Instagram (2 million followers), and LinkedIn (over 970,000 followers). The social media pages for Sony Music Entertainment display the SONY mark at the top of the pages, including on Facebook (1.8 million followers), Twitter (over 709,000 followers), YouTube (over 39,000 subscribers), Instagram (707,000 followers), and LinkedIn (over 639,000 followers). Suzuki Decl. P 41; Ex. 31 (55 TTABVUE 18; 56 TTABVUE 258-63).

Opposer has also promoted the SONY mark through multimedia [*19] marketing campaigns involving well-known athletes, entertainers, and other celebrities, Suzuki Decl. P 43; Ex. 33 (55 TTABVUE 19-20; 56 TTABVUE 269-79),

as well as through product placement in numerous motion pictures and television programs. Suzuki Decl. P 46; Ex. 36 (55 TTABVUE 22-25; 58 TTABVUE 2-96).

Opposer has also extensively licensed the SONY mark for a variety of consumer products and in 2018 the SONY mark was ranked as the 85th most licensed brand in the world, generating \$ 350 million worldwide from the retail sale of SONY-licensed consumer products. Suzuki Decl. P 47; Ex. 37 (55 TTABVUE 25; 58 TTABVUE 97-104). Millions of consumers in the United States have been exposed to Opposer's SONY mark through athletic sponsorships, including the FIFA World Cup competitions in 2010 and 2014, in which the mark appeared on field signage that was visible to millions of viewers of the World Cup games and game highlights in the United States. Suzuki Decl. PP 40, 49-52; Exs. 37-40 (55 TTABVUE 25-27; 58 TTABVUE 103-29).

Opposer and its SONY mark have received extensive unsolicited media coverage, and the SONY mark has been consistently been ranked and recognized as among the world's leading **[*20]** brands. Opposer has been the subject of at least 15 books. Suzuki Decl. P 55; Ex. 43 (55 TTABVUE 28; 58 TTABVUE 137-43). Nearly 30 years ago, the SONY mark was recognized in a 1994 article in THE PHILADELPHIA INQUIRER about the resignation of Opposer's founder and chairman Akio Morita as "one of the world's most famous brands," and 10 years later the mark was called "an iconic blue-chip brand across the world, a name that has come to stand for perpetual innovation in the hyper-competitive consumer electronics business" in a 2004 article in MEDIA. Suzuki Decl. P 58; Ex. 44 (55 TTABVUE 28; 58 TTABVUE 144-49).

In 1988, the LOS ANGELES TIMES reported that the SONY mark was the third most powerful brand name in the world after Coca-Cola and IBM, and ahead of Porsche, McDonald's, Disney, Honda, Toyota, Seiko, BMW, Volkswagen, Mercedes, Pepsi Cola, Kleenex, Nestle, Rolex, Jaguar, Xerox, Lipton, Hilton, Polaroid, Canon, Levi's, Yamaha and Nissan, in a survey conducted by Landor Imagepower. BUSINESS WIRE reported in 2006 that in a 2005 survey of more than 17,500 consumers, the SONY mark was ranked as the most popular consumer electronic brand in the world, ahead of Apple, Canon, Casio, Dell, **[*21]** Hitachi, Hewlett-Packard, Microsoft, Nokia, Panasonic, Philips, Pioneer, Sanyo, Sharp, and Toshiba. Suzuki Decl. P 59; Ex. 45 (55 TTABVUE 28; 58 TTABVUE 150-53).

The SONY mark has been ranked consistently in the annual Interbrand list of Best Global Brands as one of the world's leading brands. The mark was ranked 58th in 2016, 61st in 2017, 59th in 2018, 56th in 2019, and 51st in 2020. Suzuki Decl. P 60; Ex. 46 (55 TTABVUE 28-29; 58 TTABVUE 154-59). FORBES magazine has similarly consistently ranked the SONY mark as among the world's most valuable brands. The mark was ranked 38th in 2013, 80th in 2014, 79th in 2015, 76th in 2016, 73rd in 2017, 63rd in 2018, 60th in 2019, and 47th in 2020. Suzuki Decl. P 61; Ex. 47 (55 TTABVUE 29; 58 TTABVUE 160-81). The SONY mark has also received recognition as the "house mark" for iconic consumer products such as the Sony Walkman and the Sony Playstation in media coverage of those products. Suzuki Decl. PP 63-65; Ex. 49 (55 TTABVUE 30; 58 TTABVUE 188-207).

Opposer owns more than 20 registrations of its SONY mark, alone or with other elements, for various goods and services. 36 TTABVUE 15-151. These include registrations of the SONY word mark in standard **[*22]** characters for television cameras, *id.* at 15 (Registration No. 770275); data recorders, *id.* at 19 (Registration No. 785967); computers, word processors, floppy discs and typewriters for use with data recording apparatus, *id.* at 22 (Registration No. 1207979); video tape recorders, video disc players, video cameras, and recorded video tapes in addition to unrecorded video tapes, *id.* at 26 (Registration No. 1258436); radios, televisions, tape recorders, and numerous other electronics goods, *id.* at 30 (Registration No. 1622127); cellular telephones and related goods, and smart watches, *id.* at 38 (Registration No. 3243454); numerous entertainment services, including providing downloadable streaming, and wireless entertainment content in the nature of audiovisual works, motion pictures, trailers, television programming, music, and games by means of an interactive global computer and communications networks; providing online entertainment, namely, production of sound and audiovisual recordings in the field of music and musical based entertainment and production of sound and music video recordings, *id.* at 43 (Registration No. 4938522); various broadcasting, podcasting, and webcasting services, *id.* at 48 (Registration No. 4313348); and electrical sound recording apparatus, including electric record players, electrically driven record changers, and automatic phonograph record changers. *id.* at 108 (Registration No. 801885).

B. Applicant

Applicant has been involved with MusicONE, [*23] a music scheduler for radio stations, for 25 years. Campbell Tr. 12:4-13 (69 TTABVUE 15). Music scheduling involves the scheduling of the sequence of songs to be played in each hour throughout the broadcast day of a radio station. Campbell Tr. 12:14-17 (69 TTABVUE 15). Applicant testified that he has "no experience in trademarks really." Campbell Tr. 26:22-23 (69 TTABVUE 29). He testified that he came up with the SoniStream mark in 2010, Campbell Tr. 26:6-11 (69 TTABVUE 29), and that "I didn't do any research about it. I just was . . . sitting in a room and thought of it and was searching the internet for domain names that were not taken." Campbell Tr. 56:8-11 (69 TTABVUE 59). He testified that the mark "really came from 'SonicStream' and I took out the c because SonicStream is -- is abrupt, it stops, and it's also descriptive. So SoniStream flows." Campbell Tr. 28:5-8 (69 TTABVUE 31).

Applicant testified that there were three purposes of the software that he intends to sell under the SoniStream mark, the "music and program scheduler, the traffic scheduler and billing system, which is the second piece, and the playout system, I wanted to build a product that would do three things and [*24] I wanted to come up with a name that would describe that." Campbell Tr. 28:15-20 (69 TTABVUE 31). The "name would not be 'playout,' would not be 'scheduler.' It would have to be something more vague but suggestive of what it's about. It's about sound. That's the 'Soni' part, and 'Stream,' that's about broadcasting." Campbell Tr. 28:20-24 (69 TTABVUE 31). He testified that the "Soni" part of the mark "suggests sound, sonic," Campbell Tr. 29:2-4 (69 TTABVUE 32), and that while he did no research to confirm that "Soni" would be perceived as "sonic," "it seemed patently obvious" to him. Campbell Tr. 30:9-14 (69 TTABVUE 33).

Applicant testified that the SoniStream mark fit the product that he intended to develop because

it suggests sound and it suggests broadcasting, but it suggests it in a way that could include both internet and terrestrial broadcasting. That's the stream part. And part of the product is also content distribution, which I had mentioned also in -- in the description of use to you. And in that sense I'm using "stream" in a more abstract sense of not, you know, point-to-point -- well, it is point-to-point, but not -- you know, none of this is on demand streaming. But there, [*25] I'm using stream in the sense of simply communication or transferring information. So it suggests both the -- the final program stream, be it through the air or through the internet, and also the -- excuse me, the content distribution between content providers and the broadcaster.

Campbell Tr. 31:16-32:6 (69 TTABVUE 34-35).

Applicant testified that he did not choose the mark "SonicStream"

[b]ecause it's clunky. It's not sexy. It . . . doesn't flow verbally, "Sonic -- SonicStream." It's broken up and it's also descriptive. . . . I didn't know back then, but intuitively I knew it then. Let me say that. I didn't know at all about descriptive versus suggestive at all until recently. But intuitively, I -- I knew -- it just didn't seem like -- it didn't have a trademark kind of quality to it because it was just two words that exist already. So I . . . knew that intuitively. "SonicStream" didn't seem like anything. So when I took the c out, then it seemed like -- seemed more unique. So that's all. That's why it sounds better and it - - and it seemed more like a unique mark.

Campbell Tr. 111:13-112:2 (69 TTABVUE 114-15). He testified that he instead "simply removed the c from word sonic to produce [*26] this - this mark." Campbell Tr. 34:18-19 (69 TTABVUE 37).

He testified that SoniStream was "sexy" because

"SonicStream" sounds very -- sounds -- sounds like some -- sounds like something that's used -- you know, it sounds like something that is used to - to remove the siding in -- some industrial product to remove the siding of buildings for -- for demolition or something. It just -- it just sounds very hard. So SoniStream, sexy only in the sense that it's smoother. SoniStream just flows better.

Campbell Tr. 112:7-14 (69 TTABVUE 115).

Applicant first applied to register the trademark SoniStream in 2010 through MusicONE. Campbell Tr. 29:10-13; 97:5-12 (69 TTABVUE 32, 100). He testified that the mark was refused registration on the basis of the mark "SonicStream." Campbell Tr. 29:12-23 (69 TTABVUE 32). He applied again in 2018. Campbell Tr. 29:24-25 (69 TTABVUE 32).

The drawing of Applicant's mark in his current application displays the mark as "SoniStream." Applicant testified that he "entered it that way" on the drawing page, Campbell Tr. 38:15-19 (69 TTABVUE 41), but that "I don't want this font and I don't want it to look like this. I applied this way, as I explained, to give me freedom [*27] to choose different styling. But I did not -- I don't want it to look the way that is shown in this exhibit [2] here" because "it's rather dated looking." Campbell Tr. 33:17-21, 23 (69 TTABVUE 36). He testified that he was "going to file a motion to amend" the drawing because he did not "like the way it looks," and that he was "going to make the second 'S' a small s, lower case," Campbell Tr. 25:17-26:5 (69 TTABVUE 28-29), but he never amended the drawing.

IV. Opposer's Entitlement to a Statutory Cause of Action

"Entitlement to a statutory cause of action, formerly referred to as 'standing' by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case." *Illyrian Import, Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at *17 (TTAB 2022) (citations omitted); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 574 U.S. 1153, 135 S. Ct. 1401, 191 L. Ed. 2d 360 (2015). To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, an opposer must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int'l, Inc. v. Static Control* [*28] *Components, Inc.*, 572 U.S. 118, 129, 132, 134 S. Ct. 1377, 188 L. Ed. 2d 392 (2014)).

On the issue of entitlement to a statutory cause of action, Opposer argues as follows, using the outmoded "standing" nomenclature:

Sony's registered and common law rights in the SONY mark for overlapping and related/complementary goods establishes the required commercial interest. And because Sony has properly made its pleaded registrations for the SONY mark of record . . . Sony has proven its standing to oppose Applicant's application. . . . Sony has presented evidence sufficient to prevail on its likelihood-of-confusion claim. Sony has thus proven a real commercial interest in the outcome of this proceeding and a reasonable basis for its belief that it will be damaged by the registration of Applicant's "SoniStream" mark.

91 TTABVUE 40 (citations omitted). Applicant does not address the issue of Opposer's entitlement to oppose.

As noted above, Opposer made of record USPTO electronic records regarding multiple registrations of its SONY mark for a variety of goods and services showing their current status and title. Opposer's "direct commercial interest and reasonable belief in damage proximately caused by the registration of [SoniStream] are established by Opposer's registrations [*29] for [SONY]." *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *7 (TTAB 2021) (citing *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (standing may be established where the plaintiff asserts a likelihood of confusion claim "which is not wholly without merit")). Because Opposer has asserted such a claim, it "has proven its statutory entitlement to oppose, which extends to [both] its grounds for opposition." *Id.* *See also N.Y. Yankees P'ship v. IET Prods. and Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (once the opposer established its standing based on its registrations, it had the right to assert its dilution by blurring claim in addition to its likelihood of confusion claim).

V. Opposer's Dilution by Blurring Claim

Opposer asserts a claim of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), which provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or [*30] likely confusion, of competition, or of actual economic injury.

Thus, in order to prevail, Opposer must demonstrate that "(1) it owns a famous mark that is distinctive; (2) Applicant is using a mark in commerce that allegedly dilutes Opposer's famous mark; (3) Applicant's use of [his] mark began after Opposer's became famous; and (4) Applicant's use of [his] mark is likely to cause dilution by blurring" *Spotify AB v. U.S. Software Inc.*, 2022 USPQ2d 37, at *20-21 (TTAB 2022) (citing *N.Y. Yankees P'ship*, 114 USPQ2d at 1502; *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir 2012)).

A. Does Opposer Own a Famous Mark That is Distinctive? ¹⁸

"There is no dispute that Opposer's [SONY] mark is distinctive, both inherently, and by acquisition as a result of widespread use and consumer recognition. Conceptually, it is a coined, fanciful term. It is registered on the Principal Register without a claim of acquired distinctiveness, and is therefore presumed distinctive." *Id.*, at *21 (citing *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *10 (TTAB 2020)). Here, as in *Spotify*, Applicant "does not dispute that the mark is inherently distinctive." *Id.* To the contrary, he asserts that "SONY is a 4 letter distinctive fanciful mark that [*31] can be instantly recognized and recalled by the general public," 93 TTABVUE 20, and that SONY "is a very well known distinctive brand that connotes the brand SONY." *Id.* at *21.

"As for whether the mark is sufficiently 'famous' to be entitled to protection against dilution, we must determine whether 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.'" *Id.*, at *21 (quoting *N.Y. Yankees P'ship*, 114 USPQ2d at 1502) (quoting 15 U.S.C. § 1125(c)(2)(A)). "In doing so, we consider

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register."

Id., at *22-23 (quoting 15 U.S.C. § 1125(c)(2)(A)). Opposer has the burden of establishing that its SONY mark has become famous. *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2017 (TTAB 2014).

In his Response to Opposer's Request for Admission No. 13, Applicant admitted that "the SONY mark is famous among the general U.S. [*32] public." 52 TTABVUE 8. Rule 36(b) of the Federal Rules of Civil Procedure provides that "[a] matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended." Fed. R. Civ. P. 36(b). Applicant never moved to withdraw or amend this admission, and the fact that "the SONY mark is famous among the general U.S. public" is thereby conclusively established.

But we need not rely only on Applicant's admission because the "record evidence bearing on fame [more than amply] supports Applicant's admission that [SONY] is famous and is sufficient to overcome [any] limitations in that admission" *N.Y. Yankees P'ship*, 114 USPQ2d at 1503. Indeed, Opposer's evidence bearing on the fame of its

¹⁸ As discussed above, we focus here on Opposer's SONY word mark alone.

SONY mark discussed in detail above and summarized below checks all of the boxes for fame under Section 43(c)(2)(A) of the Trademark Act.

1. Advertising and Publicity of the SONY Mark

"Opposer's mark [SONY] has enjoyed extensive publicity since it was introduced to the United States" more than 60 years ago. *Spotify*, 2022 USPQ2d 37, at *22. Suzuki Decl. P 6 (55 TTABVUE 3). Opposer has advertised and promoted its goods and services to the general public in the United States in multiple business sectors. Suzuki Decl. PP 3, 7, 10 (55 TTABVUE 2-4). Opposer has extensively [*33] advertised and promoted the SONY mark in the United States for over half a century in all varieties of media, and has spent tens of millions of dollars annually for decades. Suzuki Decl. P 40; Ex. 30 (55 TTABVUE 15-17; 56 TTABVUE 246-57). Opposer has also promoted the SONY mark through multimedia marketing campaigns involving well-known athletes, entertainers, and other celebrities, Suzuki Decl. P 43; Ex. 33 (55 TTABVUE 19-20; 56 TTABVUE 269-79), and product placement in numerous motion pictures and television programs. Suzuki Decl. P 46; Ex. 36 (55 TTABVUE 22-25; 58 TTABVUE 2-96). Opposer and its affiliates operating under the SONY mark also have a robust presence on social media. Suzuki Decl. P 41; Ex. 31 (55 TTABVUE 18; 56 TTABVUE 258-63). In short, "[t]he advertising and publicity-related evidence of record is overwhelming." *Spotify*, 2022 USPQ2d 37, at *22.

2. Sales of Goods and Services Under the SONY Mark

Opposer has sold consumer goods under the SONY mark in the United States since at least as early as 1960, Suzuki Decl. P 6 (55 TTABVUE 3), and has offered entertainment-related goods and services since 1989. Suzuki Decl. P 10 (55 TTABVUE 4). Applicant himself first learned of Sony a "[l]ong time ago [*34] when I was -- you know, probably in the 1970s," Campbell Tr. 67: 1-2 (69 TTABVUE 70), and he testified that "stores have been selling Sony products my whole lifetime." Campbell Tr. 77:10-11 (69 TTABVUE 80).

The SONY mark has been the house mark for iconic products such as the Sony Betamax, the Sony Walkman, and the Sony Playstation sold in the United States for decades. Suzuki Decl. PP 8-9, 63-65; Ex. 49 (55 TTABVUE 4, 30, 1676-1762; 56 TTABVUE 56-67; 58 TTABVUE 188-207). The SONY mark has also been associated with numerous successful and well-known motion pictures that have collectively grossed many billions of dollars in the United States, Suzuki Decl. P 11 (55 TTABVUE 5-6), as well as with the production, distribution, and sale of musical recordings by a number of prominent artists. Suzuki Decl. PP 12-14; Exs. 6-9 (55 TTABVUE 6-7; 56 TTABVUE 58-146). In the period between 2013 and 2019 alone, Opposer estimates that it sold more than \$ 100 billion in goods and services under and in connection with the SONY mark in the United States. Suzuki Decl. P 7; Ex. 2 (55 TTABVUE 3-4, 53-1631).

There is no doubt that many millions of members of the general public in the United States have purchased [*35] goods and services sold under and in connection with the SONY mark on one or more occasions. Applicant is one of them, having purchased a SONY tape recorder, which he used to record his own music. Campbell Tr. 20:9-15 (69 TTABVUE 23).¹⁹

3. Actual Recognition of the SONY Mark

"Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used." *Spotify*, 2022 USPQ2d 37, at *24 (quoting *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1104 (TTAB 2018) (quoting *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011)). Based on the record here, "[i]t would be difficult to overstate the extent of public recognition of the [SONY] mark." *Id.*

As discussed above, Opposer and its SONY mark have received extensive unsolicited media coverage for many years, and the SONY mark has been consistently ranked and recognized as among the world's leading brands.

¹⁹ Applicant also "worked with Sony consumer products," Campbell Tr. 20:2-6 (69 TTABVUE 23), and in the 1990s used a Sony stereo microphone. Campbell Tr. 68:14-69:1 (69 TTABVUE 71-72).

Beginning in 1988, the SONY mark has been recognized as being in the upper echelon of famous [*36] brands in major newspapers such as LOS ANGELES TIMES and THE PHILADELPHIA INQUIRER, and in other leading publications. Suzuki Decl. PP 58-59, 61; Exs. 44, 47 (55 TTABVUE 28-29; 58 TTABVUE 144-53, 160-81).

The SONY mark has also been ranked consistently in the annual Interbrand list of Best Global Brands as among the top 100 of the world's leading brands. Suzuki Decl. P 60; Ex. 46 (55 TTABVUE 224-25; 58 TTABVUE 154-59). The Board has held on more than one occasion that a mark's appearance on Interbrand's list and in similar listings of top global brands is potent evidence of fame. *Spotify*, 2022 USPQ2d 37, at *25 (ranking of SPOTIFY mark as No. 92 on the Interbrand list, and other evidence of recognition, supported a finding that the mark "is among the most widely recognized brands in the United States."); *Chanel*, 110 USPQ2d at 2021 (appearance of CHANEL mark on the Interbrand list each year between 2001 and 2009 supported a finding of dilution fame).

The evidence under this factor "leaves no doubt that [SONY] is among the most widely recognized brands in the United States." *Spotify*, 2022 USPQ2d 37, at *25.

4. Registration on the Principal Register

As discussed above, Opposer owns multiple valid and subsisting registrations of the SONY word mark on the Principal [*37] Register for a variety of goods and services, 36 TTABVUE 15-51, 108-11, the oldest of which issued in 1964, and none of which is based on acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). "[T]his factor also favors a finding of dilution fame." *TiVo Brands*, 129 USPQ2d at 1112.

5. Conclusion Regarding Fame

All of the relevant fame factors strongly support a finding that "[b]y any and all measures, [SONY] is exceedingly famous, and entitled to protection against dilution under 15 U.S.C. § 1125(c)." *Spotify*, 2022 USPQ2d 37, at *25.²⁰

B. Is Applicant [*38] Using a Mark in Commerce That Allegedly Dilutes Opposer's Famous SONY Mark?

The involved application was filed on April 18, 2018 under Trademark Act Section 1(b) on the basis of Applicant's alleged intention to use the mark in commerce. Applicant testified in his discovery deposition in February 2020 that software bearing the SoniStream mark did not yet exist, Campbell Tr. 43:16-22 (69 TTABVUE 46), that he and his business partner "really kept - - kept the name secret . . . as best we could," Campbell Tr. 16-19 (69 TTABVUE 47), and that the SoniStream product was "not ready yet and it's not being promoted." Campbell Tr. 66:2-3 (69 TTABVUE 69). There is no evidence in the record that the SoniStream mark has ever been used.

The fact that Applicant has not used his mark in commerce is of no moment under this factor. "[A]n application based on intent to use a mark in commerce under Trademark Act Section 1(b) satisfie[s] the commerce requirement." *N.Y. Yankees P'ship*, 114 USPQ2d at 1505-06 (citing *Toro*, 61 USPQ2d at 1174 and *Chanel*, 110 USPQ2d at 2023). Opposer has therefore satisfied the second dilution element. *Id.* at 1506.

C. Was Opposer's SONY Mark Famous Before Applicant's First Use of SoniStream?

Because Applicant's application was filed under Trademark Act Section 1(b) based on his intention [*39] to use the SoniStream mark in commerce, and because Applicant has not sought to prove his actual use of his mark, the mark's date of constructive first use is deemed to be the April 18, 2018 filing date. *Id.* at 1506. On the basis of the record evidence discussed above, there is no question that the required fame attached to Opposer's SONY mark long before April 18, 2018.

²⁰ Applicant argues that his goods are "targeted toward radio broadcasters," 93 TTABVUE 23, and Dr. Chorn, Applicant's survey expert, noted in connection with her critique of Opposer's likelihood of confusion survey that data from the U.S. Bureau of Labor Statistics reported that "there were only 82,460 people employed in radio broadcasting throughout the United States and in the District of Columbia." Chorn Supp. Decl. P 3 (76 TTABVUE 40). Even assuming that the consumers of Applicant's goods are correctly defined as "radio broadcasters," and that their number is tiny relative to the entire U.S. population, they are still members of the general public for purposes of the fame of Opposer's SONY mark.

D. Is Applicant's SoniStream Mark Likely to Cause Dilution By Blurring of Opposer's Famous SONY Mark?

"Dilution by blurring is 'an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.'" *Spotify*, 2022 USPQ2d 37, at *27-28 (quoting *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B))). "It 'occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner.'" *Id.*, at *28 (quoting *N.Y. Yankees P'ship*, 114 USPQ2d at 1509). The concern addressed by Section 43(c) is "that 'the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Id.* (quoting *Nat'l Pork Board [*40] v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted)). Opposer must prove the likelihood of dilution by blurring by a preponderance of the evidence. *Rsch. in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012).

In the portion of his brief addressed to Opposer's dilution claim, Applicant cites Mr. Hochman's expert testimony that for Applicant's "critical path enterprise software," the "'buyer will conduct extensive research and have many conversations with the seller (as well as shopping competitive products before deciding whether to purchase,'" 93 TTABVUE 25 (quoting Hochman Decl. P 4 (76 TTABVUE 47)), and argues that "it's simply not possible that anyone could confuse us with Sony or that our use of the name SoniStream in direct sales of a product our customers know we produce could impair the distinctiveness of the global brand SONY." *Id.* This argument is misplaced, however, because "[b]lurring may occur 'regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.'" *Spotify*, 2022 USPQ2d 37, at *28 (quoting *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c))).

The Trademark Act sets forth the following factors to consider in determining whether [*41] Applicant's SoniStream mark is likely to dilute Opposer's famous SONY mark by blurring:

- (i) The degree of similarity between the mark . . . 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 its mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark . . . intended to create an association with the famous mark.
- (vi) Any actual association between the mark . . . and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

1. The Degree of Similarity Between the Marks

Under this factor, "[w]e 'consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression,'" *Spotify*, 2022 USPQ2d 37, at *29 (quoting *N.Y. Yankees P'ship*, 114 USPQ2d at 1506) (citing *Rsch. in Motion*, 102 USPQ2d at 1198)), to "determine whether Applicant's mark is sufficiently similar to Opposer's as to 'trigger consumers to conjure up' Opposer's mark." *Id.* (quoting *Nike*, 100 USPQ2d at 1030 (quoting *Nat'l Pork Bd.*, 96 USPQ2d at 1497)). "'While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather [*42] in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists.'" *TiVo Brands*, 129 USPQ2d at 1115 (quoting *Nike*, 100 USPQ2d at 1030).

"In the dilution context, 'the similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.'" *Id.* (quoting *Nike*, 100 USPQ2d at 1029). "Under the 2006 [Trademark Dilution Revision Act ("TDRA")] amending Section 43(c) of the Trademark Act, the previously enunciated standard requiring 'substantial similarity' between the famous mark and the mark at issue is no longer the standard for dilution by blurring; rather, the amended statutory language refers only to 'degree of similarity.'" *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011). Under the TDRA, "Congress did not require an association arising from the 'substantial' similarity, 'identity' or 'near identity' of the two marks.'" *Nike*, 100 USPQ2d at 1029 (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 97 USPQ2d 1947, 1958 (9th Cir. 2011) and citing *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769 (2d Cir. 2009) and *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 94 USPQ2d 1188, 1201 n.18 (2d Cir. 2010)).

The parties vigorously disagree about the similarity of the SONY and SoniStream marks, primarily in the context of Opposer's likelihood of confusion [*43] claim. 91 TTABVUE 46-50; 93 TTABVUE 3, 5-10, 20-22, 24; 94 TTABVUE 13-17. ²¹ In the portion of its brief devoted to its dilution claim, Opposer argues simply that "the SONY and 'SoniStream' marks are substantially similar for dilution purposes, as the descriptive word 'Stream' is simply not sufficient to distinguish the parties' marks especially given Sony's music streaming services." 91 TTABVUE 56. Applicant does not directly address the similarity of the marks factor in his discussion of Opposer's dilution claim, 93 TTABVUE 25, but concludes in his discussion of Opposer's likelihood of confusion claim that Opposer's "arguments that the marks 'SoniStream' [and] 'SONY' have the same appearance depend upon their unproven pronunciation and product relatedness claims above," that Opposer's "argument that the SoniStream and SONY marks have the same commercial impression also depends upon their unproven pronunciation claim above," and that "that the available evidence shows the mark 'SoniStream' differs significantly with 'SONY' in its appearance, sound, connotation and commercial impression, so it is not similar to SONY." *Id.* at 24.

"While we must consider Applicant's mark[] [SoniStream] as the public views [it], that is, in [its] entirety, one feature of a mark may make a greater impression on the public's awareness than another portion, and thus for rational reasons, we may consider that dominant portion to be more significant than another." *TiVo Brands*, 129 USPQ2d at 1116. "It is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Id.* (citing *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Applicant's mark consists of what he called "the 'Soni' part, and 'Stream'" Campbell Tr. 28:23 (69 TTABVUE 31). He testified that he "wanted a name that would be suggestive enough of what the product did, but not so specific that we couldn't expand on the product." Campbell Tr. 27:20-22 (69 TTABVUE [*45] 30). He selected the "Soni" part of the mark "[b]ecause it suggests sound, sonic." Campbell Tr. 29:2-4 (69 TTABVUE 32). He testified that "Soni" "really came from 'SonicStream'," which was "abrupt" and "also descriptive," Campbell Tr. 28:5-7 (69 TTABVUE 33), something which he claimed he knew "intuitively" when he selected his mark. Campbell Tr. 111:11-17 (69 TTABVUE 114).

With respect to "stream," Applicant testified that he wanted to "describ[e] something that would schedule music, schedule commercials, and play the audio," Campbell Tr. 95:9-11 (69 TTABVUE 98), and that he thought that "'stream' would accomplish all of that and - - well, it sounds streaming." Campbell Tr. 95:11-13 (69 TTABVUE 98). "Stream" was "the closest thing [he] could find that was related to sound and radio." Campbell Tr. 28:1-3 (69 TTABVUE 31).

Applicant testified that he "didn't know at all about descriptive versus suggestive at all until recently," Campbell Tr. 111:17-19 (69 TTABVUE 114), but his self-styled intuitive conclusion that "Soni" is suggestive of the goods identified in his application, while "Stream" is descriptive of them, supports a finding that "[a]s the first portion of

²¹ We reiterate that in addressing the parties' arguments, [*44] we are not analyzing whether Applicant's mark is sufficiently similar to Opposer's mark to cause consumers of the goods identified in the involved application to believe mistakenly that those goods originate with, or are sponsored or authorized by, Opposer, but rather whether the marks are sufficiently similar that a consumer exposed to Applicant's mark will conjure up Opposer's famous mark. *Spotify*, 2022 USPQ2d 37, at *29.

Applicant's mark[], [*46] the term [Soni] is more likely to be recognized and impressed upon a consumer than the [descriptive] suffix[] [Stream]." *TiVo Brands*, 129 USPQ2d at 1115 (finding that the words TAPE and BAR in the applicant's marks TIVOTAPE and TIVOBAR "describe[d] the shape of the lighting products identified by the respective marks," *id.*, and that "consumers are less likely to focus on the descriptive portions of Applicant's marks and instead would regard the first distinctive term TIVO as dominating the commercial impression conveyed by Applicant's marks.") (citations omitted). For the reasons discussed immediately above, we find that "Soni" is the dominant portion of Applicant's mark and have given greater weight to "Soni" than to "Stream" in comparing Applicant's SoniStream mark in its entirety to Opposer's SONY mark.

We begin with the degree of similarity of the marks in appearance. Opposer argues that "[w]hen comparing the SONY mark with Applicant's 'SoniStream' mark, the marks are strikingly similar in both appearance and sound" because Opposer's mark SONY and the Soni-element of Applicant's mark differ only by the presence of an "I" rather than a "Y" in Applicant's mark. 91 TTABVUE 48.

Applicant responds that

[*47] "SoniStream" and "Sony" in fact share only the combining form "SON-" which is used at the start of the names at least 28 other products and/or brands--usually for products related to sound. . . . These brands include consumer brands such as Sonus, Sonist and Sonicare which is used by over 30 million consumers in the US alone The prefix "SON-" therefore couldn't be argued to be associated with any particular brand. In addition, SoniStream is [a] 10 letter suggestive mark and SONY is a 4 letter distinctive fanciful mark that can be instantly recognized and recalled by the general public.

93 TTABVUE 20. He cites Mr. Hochman's testimony that "[t]he prefixes Soni-, Sonaand Sono- are widely used in online marketing by numerous brands with products related to sound," including the ones shown below



that "[m]any of these brands are orders of magnitude more prominent than [Applicant's company] Music1," and that "[t]hese prefixes are used to form suggestive brand names because these prefixes help to define what the product is or does (i.e. something related to sound)." Hochman Decl. PP 7-8; Ex. C (76 TTABVUE 48, 12-84).

Applicant further argues that

Sony wants to be considered very famous [*48] by the Board to urge the Board to tolerate even a small amount of similarity between "SoniStream" and "Sony" [and] Sony is in effect arguing that a person seeing the "SoniStream" mark will forget the spelling of their four-letter famous mark seen on consumer pr[o]ducts over the last forty years.

Id. at 21.

Opposer has registered its SONY word mark in a "typed drawing," ²² in standard characters, and in the stylized form shown below:

²² "Prior to November 2, 2003, 'standard character' drawings were known as 'typed drawings' A typed drawing is the legal equivalent of a standard character mark." *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *2 n.2 (TTAB 2019) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1258 n.2 (Fed. Cir. 2010)).

SONY

36 TTABVUE 15-51, 108-11.

Applicant seeks registration of SoniStream in standard characters and a standard-character mark "may be presented in any font style, size or color," *Sabhani*, 2021 USPQ2d 1241, at *34 (quoting *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018)), ²³ including any such display "that minimizes the differences or emphasizes the similarities between the marks." *Id.* (quoting *Anheuser-Busch, Inc. v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015)).

Despite Applicant's standard character claim, the drawing of his mark displays it as follows:

SoniStream

As noted above, the appearance of the mark in this manner in the drawing "does not change the nature of the mark from standard character to special form," *New Era*, 2020 USPQ2d 10596, at *2 n.1, but it does illustrate that Applicant's mark may be displayed in a manner that separates the dominant word "Soni" from the word "Stream" through the use of the uppercase letters "S" with the remaining letters in lowercase. We must also assume that Applicant may display the word "Soni," or both portions of his mark, in the same font in which Opposer's stylized SONY word mark appears above. ²⁴ Each of these displays "minimizes the differences [and] emphasizes the similarities between the marks" in appearance. *Sabhani*, 2021 USPQ2d 1241, at *34. While there are some visual differences between the marks, "we find that the appearance of the marks overall is sufficiently similar that Applicant's [*50] mark will 'trigger consumers to conjure up' Opposer's famous mark. That is, consumers encountering Applicant's mark will immediately be reminded of Opposer's famous [SONY] mark and associate the two." *N.Y. Yankees P'ship*, 114 USPQ2d at 1507. ²⁵

The similarity or dissimilarity of the sound of "Sony" and the dominant word "Soni" in Applicant's mark gets most of the parties' attention. They dispute whether "Soni" is likely to be pronounced "sew-knee," like Opposer's mark, with a long "e" sound (ē) as in the name "Tony" and the word "pony," making Applicant's mark as a whole sound

²³ Consistent with these principles, Applicant testified that he thought that by applying for registration in standard characters, he "would [*49] be free to stylize - - like different colors, like give italics to 'Stream' or something by - - doing this," Campbell Tr. 26:24-27:2 (69 TTABVUE 29-30), and that he "applied this way . . . to give [him] freedom to choose different styling." Campbell Tr. 33:18-20 (69 TTABVUE 36).

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As discussed above, Applicant claimed that the display of his mark as "SoniStream" in the drawing was in error and that he intended to amend the drawing to display the mark as SONISTREAM and to use it that way when the product is introduced. Campbell Tr. 26:13-27:5; 33:16-34:1; 37:18-38:19 (69 TTABVUE 29-30, 36-37, 40-41). Applicant's intentions in this regard are irrelevant to our analysis of the degree of similarity of the marks. We must assume that his standard-character mark could be displayed in the manners discussed above regardless of how it might appear in any amended drawing or how he might intend to use it.

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Applicant's argument that the fame of the SONY mark will make it more, not less, likely that consumers will be able to distinguish the Soni- prefix in Applicant's mark is contrary to Federal Circuit precedent. *Cf. Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992) (stating that "this court has consistently afforded strong marks a wider [*51] latitude of legal protection than weak marks," and noting that its earlier decision in *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988), which stated that the "better known [a mark] is, the more readily the public becomes aware of even a small difference," "was confined to the facts of that case" to "the extent that it treats fame as a liability . . .").

like "Sonystream," or "saw-n?," "exactly as it is pronounced in the word sonic." Campbell Tr. 34:17-18 (69 TTABVUE 37).

Opposer characterizes "Soni" as the phonetic equivalent of "Sony," 91 TTABVUE 48, and argues that

[t]he identical pronunciation of SONY and the "Soni" portion of Applicant's mark is further borne out by the expert testimony from Prezeau and Zhang. As they both testified, a significant portion of the U.S. public is likely to pronounce the "SoniStream" mark as "SONYstream." Specifically, [*52] Prezeau testified regarding U.S. speakers of Spanish, French, Italian, and Portuguese, while Zhang testified regarding U.S. speakers of Chinese, Korean, and South Asian languages. . . . Together, such groups amount to over 50 million people in the United States, or approximately 15% of the U.S. population. . . .

Id. at 49 (citations omitted). Opposer does not directly address how the other 85% of the U.S. public that does not belong to one of these linguistic cohorts will pronounce Applicant's mark beyond arguing that "Soni" is equivalent to "SONY" because "I" and "Y" are functionally the same. *Id.* at 48-49.

Applicant testified that he "simply removed the c from the word sonic to produce this - - this mark," Campbell Tr. 34:18-19 (69 TTABVUE 37), such that "SoniStream" will be pronounced in the same manner as "Sonicstream" but without the "c," and that he "will show that Sony's evidence (the pronunciation survey by Mingshu Ziang [sic], and the pronunciation predictions of Jasmine Prezeau) could at most imply that 2.5% of the U.S. population would be likely to pronounce 'SoniStream' similarly to or nearly the same as 'SONY-stream'." 93 TTABVUE 3. He takes a deep dive into the testimony of Opposer's [*53] linguists and the U.S. Census Bureau data regarding the percentages of the U.S. population that speak languages other than English at home. *Id.* at 5-9.

Applicant also argues that as to members of the United States public who speak only English, "Sony has provided no survey evidence or even examples of the pronunciation of SoniStream by consumers," *id.* at 9, while he has provided

15 YouTube videos in which you can hear the pronunciation by Americans of other marks beginning [sic] with the SONI- prefix In all of these the "o" and "i" in the SONI- prefix are both pronounced short as they are in "sonic"--not l[ong] "o" and a long "e" as in SONY. The most significant of these similar marks which all share the SONI- prefix SoniStream uses are: Sonicare and Sonifresh--products which are used by 30 million consumers in the US. . . . Since I have produced evidence showing consumers consistently *do not* pronounce the SONI- prefix like SONY, and Sony has presented no survey or even example evidence that consumers in the US *do* pronounce the SONI- prefix like SONY (e.g., showing americans [sic] pronouncing Sonicare "Sony Care"), the available evidence does not support Sony's phonetically-based pronunciation [*54] predictions for SoniStream so they should be rejected as well

Id. ²⁶

Drawing an analogy to likelihood of confusion case law, Applicant relies on *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649 (Fed. Cir. 2014), for the propositions that "[t]here is no correct pronunciation of a trademark that is not a recognized word" and that "[w]here a trademark is not a recognized word and the weight of the evidence suggests that potential consumers would pronounce the mark in a particular way, it is error for the Board to ignore this evidence entirely and supply its own pronunciation." 93 TTABVUE 9 (quoting *StonCor*, 111 USPQ2d at 1651). He concludes that "the evidence Sony has provided could at most imply that 2.4% of the US public would be expected to pronounce 'SoniStream' similarly or nearly the same as 'SonyStream'," *id.* at 21, but that "other words or marks that contain the prefix 'Soni' followed by two consonants or one ending consonant is [sic] consistently pronounced as in 'sonic', 'supersonic', 'ultrasonic', 'sonics', 'sonically', 'Sonist', 'Sonicare', 'SoniGuard', 'Sonifex' and others." *Id.*

²⁶ As noted above, we have reviewed the videos, and we discuss their probative value below.

In its reply brief, Opposer argues [*55] that more than 50,000,000 people in the United States who speak the Romance or Asian languages discussed by Opposer's experts are "likely to pronounce 'SoniStream' as 'SONY-stream,'" 94 TTABVUE 13, and that

the various YouTube videos submitted by Campbell have [no] relevance to the likely pronunciation of "SoniStream", as such videos involve the pronunciation of different marks which are governed by different phonological and orthographic rules (i.e., SONICARE, SONIFRESH, SONISOFT, SONISHARE, SONIBLE, SONIFEX, and SONISPHERE). For instance, with respect to SONICARE, the pronunciation of this mark is likely driven by the presence of the word "sonic," especially since the underlying product (an electric toothbrush) contains "sonic" technology. Various other videos concern replacement heads for SONICARE toothbrushes, which may also contribute to the pronunciation of those marks (i.e., SONIFRESH, SONISOFT, and SONISHARE). That said, the two videos concerning SONISOFT actually pronounce the mark as "SONY-soft" and accordingly do not support [Applicant's] argument. The video concerning SONIST also pronounces this mark as "SO-nist".

Id. at 14-15.

We agree with Applicant that there is no "correct" pronunciation [*56] of a mark, such as SoniStream, that is not a recognized word in United States English, and we thus must consider "all the reasonable possibilities" for the pronunciation of SoniStream. *Cf. Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.19 (TTAB 2014) (finding that the marks IKEA and AKEA had "similarities in the way they sound (ī key ă vs. ă key ă)."). In that regard, as explained above, we must assume that Applicant's mark could be displayed as "SoniStream," as it appears in his drawing, which would highlight the dominant "Soni-" prefix and separate it from the "-Stream" suffix.

Based on common pronunciations of the letters "i" and "y" in United States English, it is plausible that the letter "i" in Applicant's SoniStream mark may be pronounced as a long "e" (ē), making Applicant's mark as a whole sound like "SonyStream." *Cf. Citigroup Inc. v. Capital City Bank Grp.*, 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (noting that the words CITI and CITY in the opposer's CITIBANK-formative family of marks and in the applicant's CAPITAL CITY BANK marks were aurally identical, but affirming the Board's finding under Section 2(d) that the identity of the words in sound was outweighed by the "distinctive spellings of the marks at issue, third-party [*57] usage of the phrase 'City Bank' in the financial services industry, and the role of the word 'Capital' in distinguishing [the applicant's] marks from Citigroup's marks") (citing *Citigroup Inc. v. City Holding Co.*, 171 F. Supp. 2d 333, 345 (S.D.N.Y. 2001)); *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1646 (TTAB 2009) (marks CYNERGY and SYNERGIE found to be "highly similar, if not identical, phonetic equivalents.").

Applicant acknowledged that "there might be a few people who pronounce" "Soni" as "Sony," Campbell Tr. 35:2-4 (69 TTABVUE 38), and there is nothing in the record to suggest that the pronunciation of his mark as "SonyStream" is not at least a reasonable possibility. In the *StonCor* case that Applicant cites, the opposer provided testimony regarding the pronunciation of its mark STONSHIELD as the phonetic equivalent of STONESHIELD by its sales force, which marketed its products directly to prospective consumers. *StonCor*, 111 USPQ2d at 1651. Here, Applicant has offered no evidence of how his mark has actually been pronounced by consumers, or that he or others have pronounced it to prospective consumers as "saw-n?-stream" to condition them to pronounce it in that manner, as he testified that "I did not mention the name to anyone who's in the business especially, in any business, [*58] any kind of business, especially technology business." Campbell Tr. 44:13-16 (69 TTABVUE 47).

Instead, he cites 15 videos in which persons pronounce other marks, including "Sonicare," a brand of electric toothbrush, and "Sonifresh" and "Sonisoft," brands of replacement brush heads for the Sonicare toothbrush.²⁷ For the reasons discussed below, even if the videos have some probative value in identifying all the reasonable

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Video Nos. 2-4 are the same "unboxing" video for Sonifresh replacement brush heads for the Sonicare toothbrush, so there are actually only 13 different videos.

possibilities for the pronunciation of the marks verbalized in the videos, they have no probative value in excluding "SonyStream" from the list of all the reasonable possibilities for the pronunciation of Applicant's SoniStream mark.

The videos involve the pronunciation of the mark Sonicare by a handful of people, the pronunciation of the mark Sonisoft by two people (one of whom sounds like she is pronouncing it as "Sonysoft"), and the pronunciation of the mark Sonifresh by one person. The pronunciation of another mark for a replacement brush head for the Sonicare toothbrush is indecipherable. With respect [*59] to marks for other goods, the Sonibel mark is pronounced by two people, and the Sonifex, Sonisphere, Sonist, Soniguard, and Sonitrol marks are pronounced by one person each. Viewed as the functional equivalent of surveys of how the respective marks might be pronounced by United States consumers, in the nature of the survey offered by Opposer's expert Mingsu Zhang discussed below, Applicant's single-digit "samples" are so miniscule as to make it impossible to draw any conclusions about all the reasonable possibilities for the pronunciation of the respective marks. *Cf. Anheuser-Busch*, 115 USPQ2d at 1830-32 (concluding that the results of a sample of 201 respondents in a likelihood of confusion survey were "probative, although not strong, evidence that confusion is likely," but noting that "at some point, a small sample may provide results potentially so low or so imprecise as to be of little or no value in inferring the rate of confusion among all relevant consumers."). ²⁸

There are additional reasons why the videos are not probative of all the reasonable possibilities for the pronunciation of the other marks, much less of all the reasonable possibilities for the pronunciation of SoniStream. None of the other marks display the "Soni-" prefix in the manner in which it appears in Applicant's SoniStream mark. ²⁹ Almost half of the videos involve the Sonicare toothbrush, ³⁰ and the word "sonic" is actually present in the telescoped mark **Sonicare**, which combines "sonic" and "care," and which is promoted as involving [*61] "sonic technology." A telescoped mark like Sonicare is presumed to be read by consumers as the combination of the telescoped terms, and it is thus unlikely that a consumer would pronounce the Sonicare mark other than as "Sonic Care." *See In re Greenliant Sys., Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010) (finding that "[w]hen the terms NAND and drive are combined into the compressed term NANDRIVE, the mark is equivalent in sound and meaning to the individual terms."). We agree with Opposer that it is not surprising that consumers would also pronounce the prefix Soni- in the marks Sonifresh and Sonisoft in the same manner as in the mark Sonicare because the replacement heads sold under the latter marks are used with Sonicare electric toothbrushes.

We cannot find, on the basis of the pronunciation of marks other than SoniStream by a handful of people, that consumers would [*62] invariably pronounce Applicant's SoniStream mark as "Saw-nĕ-stream" and not as "SonyStream," and that the latter pronunciation is not one of the reasonable possibilities for the pronunciation of Applicant's mark.

²⁸

Ms. Zhang conducted a "survey of 77 Asian Americans in my professional and personal networks in the United States to gather empirical data on how the term 'SoniStream' is likely to be pronounced by Asian Americans" and reported [*60] that "[o]f the 77 participants, 36 (or approximately 47%) responded that they would pronounce the trademark as /s?unistri:m/ (similar to 'SonyStream')." Zhang Decl. PP 6, 12 (39 TTABVUE 3). Ms. Zhang did not show that she has any expertise in conducting surveys, her sample was obviously not randomly selected, and it consisted of 77 persons, a size much greater than Applicant's "samples," but still too small to yield any meaningful results even if her survey otherwise followed accepted protocols. *Anheuser-Busch*, 115 USPQ2d at 1830-32. We have given her testimony no consideration in our analysis of all the reasonable possibilities for the pronunciation of SoniStream.

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The same is true for the multiple "Soni-" formative marks listed in Exhibit C to Mr. Hochman's Declaration. Hochman Decl. P 7; Ex. C (67 TTABVUE 6, 86-87).

³⁰

Video No. 1 is a commercial for the Sonicare toothbrush, and five other videos are unboxing or product demonstration videos for replacement brush heads for the toothbrush (Nos. 2, 5-7, and 10).

Our conclusion is buttressed by the testimony of Opposer's linguist Jasmine Prezeau. "Generally we find it unnecessary to rely upon linguistics experts to tell us how marks are pronounced," *Rsch. in Motion*, 102 USPQ2d at 1193 n.19 (citations omitted), but Applicant did not object to Ms. Prezeau's testimony and addressed it on the merits. She opined, based on her fluency in English, French, Italian, Spanish, and Portuguese, that "there is no discernable difference in pronunciation between 'SoniStream' and 'SonyStream'" among native speakers of French, Italian, Spanish, and Portuguese, including U.S.-based speakers of Spanish, French, Italian and Portuguese who are also proficient in English. Prezeau Decl. PP 1, 8, 12 (40 TTABVUE 4, 6).³¹ She further opined that "the short 'o' that is represented by the letter 'o' in the American English words 'mop,' 'pot,' 'sock,' 'sonic,' 'dolphin,' or 'box' is not a letter-sound relationship that exists within the phonemic orthography of French, Italian, [*63] Portuguese, and Spanish," and that "[i]n order for the 'o' in 'Soni' to be pronounced similar to the 'o' in sonic, it would have to be written out as an 'a' (or, depending on the surrounding letters, another vowel or combination of vowels) for speakers of French, Italian, Portuguese, and/or Spanish--never as an 'o.'" Prezeau Decl. P 15 (40 TTABVUE 7) (emphasis added). She testified that "[i]n the case of variant capitalizations utilized in 'SoniStream' (e.g., Sonistream, sonistream, SONISTREAM, etc.), my opinions with respect to pronunciation as indicated above would not change." Prezeau Decl. P 16 (40 TTABVUE 8). She "conclude[d] that the vast majority of these individuals, when exposed to the word 'SoniStream,' will hear it as synonymous with 'SonyStream.'" In other words, the two will be taken to have the same sound and, thus, imply the brand 'Sony.'" Prezeau Decl. P 18 (40 TTABVUE 8).

Applicant attacks Ms. Prezeau's testimony only "about the pronunciation of SoniStream and SonyStream among U.S. Spanish and English speakers." 93 TTABVUE 8. He argues that

the use here of only phonetics to construct a predicted pronunciation has produced a Spanish pronunciation for Sony where the o sound is very close to the american English pronunciation of "ah" which is very different than the long "oh" sound always used in Sony's own pronunciation of "Sony" in their advertising in the U.S. over the last fifty years, and which contradicts Sony's own statement about the pronunciation of their name on page 18 of the Notice of Opposition: "Sony selected the SONY mark for its simple pronunciation that is the same in any language." In short, Ms. Prezeau's claim that the Spanish pronunciation of SoniStream is indistinguishable from SonyStream (or "corriente de Sony") is supported primarily by comparing the phonetically correct Spanish pronunciation of SoniStream with the phonetically correct Spanish pronunciation of Sony which: 1. Is not consistent [*65] with Sony's pronunciation of their name in in their advertising. 2. Contradicts Sony's own statement that the pronunciation of their name is "the same in any language."--which would include Spanish and English. 3. Is not supported by survey evidence demonstrating that any Spanish speakers in the U.S. actually pronounce "Sony" in the manner predicted by the Spanish phonetics.

Id.

Applicant further argues that

In describing the third basis for her predictions Ms. Prezeau states that "Such prevalence" [of the Sony brand] "can in many cases contribute to the verbal pronunciation of "SoniStream" and "SonyStream" being the same or phonetically indistinguishable among U.S. speakers of French, Italian, Portuguese, and/or Spanish.

In this statement Ms. Prezeau appears confident that the pronunciation of SONY will affect the pronunciation Sonibut not the pronunciation of SONY itself among Spanish speakers in the US because her phonetically and orthographically-based Spanish pronunciation of Sony doesn't sound like the English pronunciation of Sony used in Sony's own advertising in the US, or the Spanish pronunciation which Sony states is the same.

³¹

We find that Ms. Prezeau is qualified by virtue of her knowledge, experience, training, and education as an interpreter, translator, and editor to offer expert opinions regarding the way in which the word "Soni" would be pronounced by U.S.-based speakers of French, Italian, Spanish, and Portuguese, [*64] including those who are also proficient in English. Prezeau Decl. PP 2-7; Ex. A (40 TTABVUE 2-3, 11-13). See Fed. R. Evid. 702; *Kohler Co. v. Honda Giken K.K.*, 125 USPQ2d 1468, 1483-85 (TTAB 2017).

She also states her conclusion applies to English-bilingual [*66] Spanish speakers [sic] but since her conclusion is absolutely definitive (the pronunciation of "SoniStream" and "SonyStream" are "indiscernible"), she provides no quantitative evidence that she has taken into account the fact that 56.8% of Spanish speakers [sic] report being *proficient* in English in the 2017 American Community Survey (footnote 8 of the "Languages of the United States" Wikipedia article referenced above).

In regard to the statistic that [sic] 56.8% of Spanish speakers [sic] report being proficient in English, it is surprising that Ms. Prezeau has given no weight to the influence that English pronunciation patterns would have on the pronunciation of SoniStream by US-based Spanish speakers.

The most pertinent English pronunciation pattern in this case is how an l at the end of a word that is pronounced long (like Eye or Be) is usually pronounced short (like It) when followed by two or more consonants. Examples of this are Mini / Minimal, Multi / Multiple, and Omni / Omnipotent.

If Ms. Prezeau's phonological arguments correctly predicted actual pronunciation of SoniStream by U.S. Spanish speakers then Sony would easily have been able to produce a survey of Americans [sic] [*67] which would have yielded 14% of the respondents pronouncing "SoniStream" exactly the same as "SonyStream". Why they didn't do that is inexplicable.

Id. at 9-10.

We agree with Opposer that Applicant's arguments here are "both incoherent and ignore[] the phonological and orthographic rules set forth in Prezeau's report." 94 TTABVUE 14. Applicant did not offer expert linguists of his own, and he testified that he has "no formal education in linguistics," Campbell Tr. 9:18-19 (69 TTABVUE 12), and speaks no foreign languages. Campbell Tr. 9:22-23 (69 TTABVUE 12). As discussed above, Ms. Prezeau testified without contradiction that the short "o" sound (as in "sonic") on which Applicant's argument relies "is not a letter-sound relationship that exists within the phonemic orthography of" Spanish, and that "o" would never be pronounced "as to resemble the wide-mouthed short 'o' of 'sonic' that is phonetically transcribed as [ʔsanik]." Prezeau Decl. P 15 (40 TTABVUE 7).

We find that Ms. Prezeau's testimony is sufficient to establish that most speakers of Spanish and the other referenced Romance languages in the United States, including speakers of these languages who are also proficient in English, are [*68] likely to pronounce the word "Soni" in the mark "SoniStream" in the same manner as Opposer's mark. The ways in which members of these linguistic groups are likely to pronounce "Soni" have relevance, as the Board has "consistently found that Spanish is a 'common language' in the United States," *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *7 (TTAB 2019), and Applicant acknowledges that the members of U.S. population who speak Spanish or the other referenced Romance languages amount to about 45,000,000 people, or around 15% of the U.S. population. 93 TTABVUE 7.

The record as a whole establishes that while "SonyStream" is certainly not the only possible pronunciation of "SoniStream," and may not even be the most likely one, it is at least among "all the reasonable possibilities" for its pronunciation, and we must consider it in our analysis of the similarity of the marks in sound. *Inter IKEA Sys.*, 110 USPQ2d at 1740 n.19. The pronunciation of Applicant's "SoniStream" mark as "SonyStream" would instantly "trigger consumers to conjure up" Opposer's famous SONY mark. *Spotify*, 2022 USPQ2d 37, at *29 (citation omitted).

Applicant's arguments against the similarity of the marks in connotation and commercial impression are all based on their claimed dissimilarity [*69] in appearance and sound. 93 TTABVUE 22. As discussed above, the marks are sufficiently similar in both appearance and sound to cause consumers to conjure up Opposer's famous SONY mark,

and the meaning of the word "stream" in Applicant's mark SoniStream does not make that any less likely. To the contrary, Applicant testified that the word "sounds streaming," Campbell Tr. 95:12-13 (69 TTABVUE 98), and Opposer has offered a variety of streaming services under and in connection with the famous SONY mark, Suzuki Decl. PP 34-39 (55 TTABVUE 13-15), and has registered the mark for "providing downloadable streaming and wireless entertainment content in the nature of audiovisual works, motion pictures, trailers, television programming, music and games by means of an interactive global computer and communications networks." 36 TTABVUE 43 (Registration No. 4938522). The presence of the suffix "-Stream" in Applicant's SoniStream mark may actually increase the likelihood that the mark as a whole will conjure up the famous SONY mark because Applicant's mark may evoke the music and entertainment streaming services offered under the mark. *Cf. Spotify*, 2022 USPQ2d 37, at *32 ("Because the marks SPOTIFY and POTIFY are used for software products that [*70] perform analogous functions, and are so similar in appearance and sound, their commercial impressions are similar even if consumers take different meanings from SPOT and POT.").

We have found above that "the appearance of the marks overall is sufficiently similar that Applicant's mark will 'trigger consumers to conjure up' Opposer's famous mark. That is, consumers encountering Applicant's mark will immediately be reminded of Opposer's famous [SONY] mark and associate the two." *N.Y. Yankees P'ship*, 114 USPQ2d at 1507. We also find that the marks are sufficiently similar in their entireties in sound, meaning and commercial impression "that Applicant's mark will 'trigger consumers to conjure up' Opposer's famous [SONY] mark. This weighs in favor of finding dilution by blurring." *Id.*

2. The Degree of Distinctiveness of the SONY Mark

"This factor requires us to analyze how distinctive or 'unique' the mark is to the public. The inquiry is made even when it is undisputed that opposer's mark is registered on the Principal Register." *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 2003). "The more inherently distinctive and memorable the mark, the more it is likely to be blurred by the use of other identical or similar marks. [*71] The more descriptive the mark, the less likely it is to be blurred by uses of identical or similar marks." *Chanel*, 110 USPQ2d at 2025 (internal citation omitted). "As explained throughout this decision, Opposer's [SONY] mark is nothing if not distinctive. It is coined, fanciful, registered on the Principal Register without a disclaimer or resort to Section 2(f) of the Act, and is among the most highly recognized marks in the United States." *Spotify*, 2022 USPQ2d 37, at *22. "This factor also weighs in favor of finding dilution by blurring." *Id.*

3. The Extent to Which Opposer is Engaging in Substantially Exclusive Use of Its SONY Mark ³²

As discussed above, Opposer provided unchallenged evidence that it has used its SONY mark in the United States for more than 60 [*72] years, and that it has controlled use of that mark through extensive licensing. *See Chanel*, 110 USPQ2d at 2025 (discussing the opposer's licensing of its famous CHANEL mark). "On this record, [Opposer] has shown that it engages in substantially exclusive use of the mark [SONY] with respect to competitive, as well as non-competitive goods and services. The evidence does not show the term [SONY] alone used as a mark by others." *TiVo Brands*, 129 USPQ2d at 1116. "[T]his dilution factor favors Opposer." *Id.*

4. The Degree of Recognition of Opposer's SONY Mark

The evidence discussed above establishes that Opposer's SONY mark is among the most widely recognized marks in the United States. "This factor weighs heavily in favor of finding dilution by blurring." *Spotify*, 2022 USPQ2d 37, at *34.

³²

Applicant's arguments pertaining to third-party uses of "Soni-" formative marks are misplaced in the dilution context. The statutory text requires us to determine the exclusivity of Opposer's use of **its** mark. By contrast, in assessing the impact of third-party marks on the strength or weakness of a plaintiff's mark on a Section 2(d) claim, the relevant inquiry is the "number and nature of **similar** marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (emphasis added).

5. Whether Applicant Intended to Create an Association With Opposer's SONY mark

Applicant argues that

I created the name SoniStream from "sonic" and "stream" with the intention to suggest the functionality of a completely integrated radio broadcast system including music scheduling, commercial scheduling/billing, and audio payout. . . . I had no intention of constructing a name that sounded like any other company; quite the opposite: I wanted to create a unique mark to [*73] build a brand. I believe I achieved that and was surprised and dismayed when I received a letter in July 2018 from the Trademark Office that Sony was opposing my registration. Coming off as another company would [sic] be against my ethics and business interests so I hope, when deciding the claim of dilution by blurring, the Board will consider the fact that I have no intention to create an association with SONY. . . . Coming off as another company would be against my ethics and business interests so I hope, when deciding the claim of dilution by blurring, the Board will consider the fact that I have no intention to create an association with SONY.

93 TTABVUE 25. He asks the Board to "read my sworn testimony on this on p. 29 of my Feb 2020 deposition (69 TTABVUE):

The music and program scheduler, the traffic scheduler and billing system, which is the second piece, and the payout system, I wanted to build a product that would do three things and I wanted to come up with a name that would describe that. And that name would not be "payout," would not be "scheduler." It would have to be something more vague but suggestive of what it's about. It's about sound. That's the "Soni" part, and [*74] "Stream," that's about broadcasting.

Id. (citing Campbell Tr. 28:15-24 (69 TTABVUE 31)).

We have reviewed this testimony and Applicant's other testimony regarding the origin of his mark. Campbell Tr. 27:8-28:8; 28:15-32:10; 34:2-35:6; 36:16-25; 55:23-24; 56:7-11; 65:3-4; 72:8-9; 76:20-77:4; 80:10-11, 20:21; 84:6-7; 95:4-14; 102:9-12; 111:11-112:2, 5-19 (69 TTABVUE 30-35, 37-39, 58-59, 68, 75, 79-80, 83, 87, 98, 105, 114-15). Applicant's explanation of the selection and adoption of his SONISTREAM mark is entirely credible, and we find that he did not intend to associate his mark with Opposer's SONY mark. As a result, "this dilution factor is neutral." *TiVo Brands*, 129 USPQ2d at 1117.

6. Any Actual Association between Applicant's SoniStream Mark and Opposer's SONY Mark

As discussed above, there has been no use of Applicant's mark, or public exposure of it. The Board has "found that where an application challenged on the ground of dilution is based on an intent to use and the applicant 'has not engaged in any actual use of the junior mark, it is impossible to present any evidence of actual association between the marks in the marketplace,'" but that this "does not preclude a finding of dilution when the balance [*75] of dilution factors weighs in favor of such a finding." *Spotify*, 2022 USPQ2d 37, at *36 n.17 (quoting *Nat'l Pork Bd.*, 96 USPQ2d at 1498). "Indeed, we have found dilution in several cases despite there being no evidence of actual association, when the balance of the dilution by blurring factors in 15 U.S.C. § 1125(c)(2)(B)(i-vi) weighed in favor of finding dilution." *Id.* (citing *TiVo Brands*, 129 USPQ2d at 1117-18; *N.Y. Yankees P'ship*, 114 USPQ2d at 1509-10, 1512; *Nike*, 100 USPQ2d at 1030-32). We find that this factor is neutral in our analysis of the likelihood of dilution by blurring. *Id.*, at *36.

E. Summary and Conclusion

Four of the factors used to determine whether Applicant's mark SoniStream is likely to dilute Opposer's famous SONY mark by blurring support a finding of likely dilution, while the other two are neutral. Applicant's SoniStream mark is sufficiently similar to the SONY mark to trigger consumers of Applicant's goods to conjure up Opposer's famous mark; Opposer's mark is a coined term and is thus inherently (and highly) distinctive; and Opposer's use of its famous SONY mark has been at least substantially, if not entirely, exclusive in the United States. Applicant's

innocent adoption of his mark, and the absence of any actual association between the marks owing to the fact that Applicant's mark has not been used, do "not change [*76] the result, given our determinations regarding the other dilution factors." *Spotify*, 2022 USPQ2d 37, at *35.

"The statute requires [O]pposer to prove impairment of the distinctiveness of [O]pposer's famous mark." *Chanel*, 110 USPQ2d at 2026. As discussed above, Opposer and its affiliates operating under the famous SONY mark offer a variety of goods and services involving the streaming of music or entertainment properties. We find that Applicant's use of the SoniStream mark, which he admits evokes "streaming," is likely to impair the distinctiveness of the famous SONY mark, particularly if Opposer were to elect to use the mark "SONY STREAM" or "SONY STREAMING" with its current goods, or to use its SONY mark with the type of goods identified in the application. *Id.* (finding the possibility of the expansion of the opposer's use of its famous CHANEL mark from cosmetics and other goods into the real estate and hotel industries "sufficient to show that opposer is likely to suffer an impairment of the distinctiveness of its CHANEL mark."). Impairment of distinctiveness through blurring may be found, of course, even if Applicant's goods "are neither competitive nor necessarily related" to Opposer's streaming goods and services. *TiVo Brands* [*77], 129 USPQ2d at 1118.

On the basis of the record as a whole, we find that Opposer proved, by a preponderance of the evidence, its entitlement to a statutory cause of action and that Applicant's SoniStream mark is likely to dilute Opposer's famous SONY mark by blurring. We thus need not and do not reach Opposer's Section 2(d) claim. *Spotify*, 2022 USPQ2d 37, at *37 n.19.

Therabody, Inc. v. Shanghai Three Gun (Grp.) Co., 2022 TTAB LEXIS 420

Trademark Trial and Appeal Board

November 17, 2022, Decided

Opposition No. 91264121

Reporter

2022 TTAB LEXIS 420 *

Therabody, Inc., by change of name from Theragun, Inc.¹ v. Shanghai Three Gun (Group) Co., Ltd.

Disposition: [*1] Decision: The opposition on the ground of likelihood of confusion under Trademark Act Section 2(d) is dismissed.

Core Terms

massage, apparatus, registrations, marks, gun, likelihood of confusion, LLC, consumers, electric, therapy, impression, instruments, third-party, dissimilar, reply brief, identification, similarity, pleaded, purchasers, vibrating, factors, muscles, judicial notice, Percussive, trademark, personal use, advertising, appearance, appliances, registered

Counsel

Diane C. Ragosa of Parker Ibrahim & Berg LLP, for Therabody, Inc.²

John P. Murtaugh and Una L. Lauricia of Pearne & Gordon LLP, for Shanghai Three Gun (Group) Co., Ltd.

Panel: Before Taylor, Greenbaum and Hudis, Administrative Trademark Judges.

1

At footnote 1 of its brief (20 TTABVUE 2), Opposer states that it changed its name from Theragun, Inc. to Therabody, Inc., and that "[t]he change of name has been recorded with the United States Patent and Trademark Office." Although Opposer did not specify where the name change is recorded, a review of Office records shows that the change of name was executed on October 1, 2021, and recorded in the Assignment Recordation Branch on March 25, 2022 at Reel/Frame 7671/0532. Opposer filed both non-confidential (20 TTABVUE) and confidential (21 TTABVUE) versions of its brief and footnote 1 is the same in each.

Citations to the record or briefs in this decision are to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer.

2

Rod S. Berman and Jessica Bromall Sparkman of Jeffer Mangels Butler & Mitchell, LLP represented Opposer prior to Opposer's filing of its reply brief.

Opinion By:

Taylor, Jyll

Opinion

This Opinion is Not a Precedent of the TTAB

Opinion by Taylor, Administrative Trademark Judge:

Shanghai Three Gun (Group) Co., Ltd. ("Applicant") seeks registration on the Principal Register of the stylized mark **THREEGUN** for the following goods:

Air cushions for medical purposes; Blankets, electric, for medical purposes; Clothing extension support devices for use during pregnancy for medical purposes; Corsets for medical purposes; Draw-sheets for sick beds; Electric acupuncture instruments; Feeding bottles; Heating cushions for medical purposes; Inflatable cushions for medical use; Masks for use by medical personnel; Massage apparatus; Orthopedic cushions; Physical exercise apparatus for medical purposes; [*2] Respiratory masks for medical purposes; Sanitary masks for medical purposes; Sterile sheets, surgical; Suture materials; Vibromassage apparatus; Clothing especially for operating rooms," in Class 10. ³

Therabody, Inc. ("Opposer") opposes registration on the ground that Applicant's mark, when used in connection with Applicant's goods, is likely to cause confusion. Opposer alleges ownership and use of the mark THERAGUN (with and without other matter as set forth in the registrations listed below) for a variety of goods, including massage apparatus, since long prior to the March 12, 2020 filing date of Applicant's application. ⁴ Opposer, in its notice of opposition, pleads ownership of the following seven registrations, summarized below:

Registration No.	Mark	Goods
5213141	THERAGUN	A variety of massage apparatus, instruments and electric appliances, in Class 10; Hats; T-shirts; Baseball caps and a variety of athletic apparel, in Class 25
6081408	THERAGUN G3	A variety of massage apparatus, instruments and electric appliances, in Class 10
6043891	THERAGUN G3PRO	A variety of massage apparatus, instruments and electric appliances, in Class 10

³ Application Serial No. 88832281 was filed on March 12, 2020, and is based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

⁴ 1 TTABVUE.

Registration No.	Mark	Goods
6043917	THERAGUN LIV	A variety of massage apparatus, instruments and electric appliances, in Class 10
6060204	THERAGUN NETWORK (Network disclaimed)	Affiliate marketing; Promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by means of sponsorship relationships, in Class 35
6030995	THERAGUN RESET	Percussive therapy services in the nature of massage therapy using percussive technology; Salon and day spa services, namely, massage therapy; massage; massage therapy services; Bodywork therapy services, namely, massage therapy, in Class 44
4760327	THERAGUNZ	Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes, in Class 10

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⁵ The goods are set forth with particularity later in this decision, where applicable.

⁶ Issued May 20, 2017.

⁷ Issued June 16, 2020.

⁸ Issued April 28, 2020.

⁹ Issued April 28, 2020.

Applicant, in its answer, admits Opposer is the record owner of each of the pleaded registrations, but otherwise denies the salient allegations in the notice of opposition.¹³

Both Opposer and Applicant filed briefs. Opposer also filed a reply brief. However, Opposer's reply brief does not include a certificate of service as required by Trademark Rule 2.119, 37 C.F.R. § 2.119. A review of the circumstances [*4] surrounding Opposer's filing of its reply brief show that Opposer's current (then new) counsel entered an appearance on July 1, 2022.¹⁴ That same day, Opposer's new counsel filed a motion, with Applicant's consent, for additional time to file Opposer's reply brief, which was granted on July 7, 2022.¹⁵ Consequently, Applicant's counsel knew to expect a reply brief which, along with a confidential version of the reply brief, was timely filed on July 11, 2022, albeit without the certificates of service.¹⁶

There is no indication Applicant's counsel made any inquiries regarding non-receipt of the reply brief, nor did Applicant move to strike it for any reason. In any event, Applicant is not prejudiced by this filing because there is nothing more Applicant could have filed in this case after the reply brief was filed. Under these circumstances, and because the reply brief serves as a roadmap for the Board to Opposer's arguments and evidence as they pertain to Applicant's brief on the case, to expedite matters, we exercise our discretion and consider Opposer's reply brief. *See Coffee [*5] Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 n.7 (TTAB 2019) ("[T]he Board may exercise its inherent authority under individual circumstances to consider a filing on the merits where service issues are present."). We add that even if we had not considered the reply brief, our decision would be the same. *See generally*, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") Section 113.02 (2022).

Opposer must, within ten days of the mailing date of this decision, serve copies of both the confidential and redacted versions of its reply brief on counsel for Applicant and proof of such service with the Board.¹⁷ If Opposer fails to comply, the confidential version will be made public so that Applicant's proceeding records are complete.

I. Preliminary Issues

A. Opposer's Request the Board Take Judicial Notice of Office Records

Opposer, in its main brief, requests the Board take judicial notice of the fact that a search of the Office's Trademark Electronic Search System ("TESS") database for live, use-based, federal trademark registrations including both "massage apparatus" and "masks for use by medical personnel" returned 784 results.¹⁸ Opposer also requests the

¹⁰ Issued May 19, 2020.

¹¹ Issued [*3] April 7, 2020.

¹² Issued June 23, 2015.

¹³ 4 TTABVUE. Applicant also raised two purported affirmative defenses, which are not true affirmative defenses. As to the first, the asserted defense of failure to state a claim is not a true affirmative defense because it asserts insufficiency of the pleading. *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010). As to the second, Applicant improperly "reserves the right to assert additional affirmative defenses in the event that discovery indicates that such additional affirmative defenses are available." 4 TTABVUE 4. The assertion of the right to put forward additional defenses is improper under the Federal Rules of Civil Procedure, inasmuch as it does not give Opposer fair notice of such defenses. *See Philanthropist.com, Inc. v. The Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *4 n.6 (TTAB 2021).

¹⁴ 24 TTABVUE.

¹⁵ 25 TTABVUE, 26 TTABVUE.

¹⁶ See 27 TTABVUE (confidential version), 28 TTABVUE.

¹⁷ Opposer's redacted reply brief can be found at 28 TTABVUE.

¹⁸ 20 TTABVUE 15 (Opposer's brief, p. 10 n.26). The TESS results are appended as Ex. A to Opposer's brief.

Board [*6] take judicial notice of printouts from the TESS database of 50 live, use-based trademark registrations, all of which include both masks and massage devices.¹⁹

Citing TBMP § 704.12(a), Opposer argues that consideration of the facts and registrations are appropriate subjects of judicial notice in that they are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. Opposer further explains that "[t]he foregoing facts and registrations are relevant in view of Applicant's motion to amend its application and limit its applied-for goods to clothing for operating rooms and masks, which motion was not filed until after the close of Opposer's testimony period." Opposer's brief, p. 10 n.26.²⁰

While we appreciate that Opposer's evidentiary record may be adversely affected if Applicant's proposed amendment is accepted, given the timing of Applicant's submission (discussed in detail below), Opposer's request does not encompass facts or records [*7] of which the Board takes judicial notice. Notwithstanding that the accuracy of records residing in the TESS database of the United States Patent and Trademark Office cannot reasonably be questioned, it is well established that the Board does not take judicial notice of office records related to third-party registrations, and we do not take judicial notice of the late-filed third-party registrations here. *See e.g., Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 USPQ2d 714, at *31 n.57 (TTAB 2022) (citing *Cities Service Co. v. WMF of Am., Inc.*, 199 USPQ 493 (TTAB 1978) ("judicial notice of third-party registrations may not be taken where no copies thereof are submitted"); *In re Thomas Nelson, Inc.* 97 USPQ2d 1712, 1717 n.18 (TTAB 2011) ("[T]he Board's well-established practice is not to take judicial notice of third-party registrations....").

As to the TESS listing, even if it were properly of record, it is not competent evidence to demonstrate the relatedness of the respective goods. Mere listings of third-party registrations are not sufficient to make those registrations of record. *See e.g., Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 155 (TTAB 2012) (TESS listing has little, if any, probative value); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); see also TBMP § 1208.02 and the authorities cited therein. While Opposer did submit 50 copies of the listed [*8] third-party registrations with its brief, they are manifestly untimely. A party may introduce testimony and evidence only during its assigned testimony period. Trademark Rule 2.121, 37 C.F.R. § 2.121 (assignment of times for taking testimony and presenting evidence). *See, e.g., Baseball Am. Inc. v. Powerplay Sports*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (documentary evidence submitted outside assigned testimony period given no consideration).

Accordingly, we give no further consideration to the TESS listing and the third-party registrations submitted as Exs. A and B to Opposer's brief.

B. Applicant's Motion to Amend

We next address Applicant's motion to amend the identification of goods in its application, filed November 11, 2021, nearly a month after the September 14, 2021 closing date of Opposer's testimony period in chief.²¹ By order issued November 24, 2022, the Board suspended this proceeding to allow Applicant time to obtain Opposer's consent to the amendment, failing which the proposed amendment would be deferred until final decision.²² When no response was received, this proceeding was resumed and consideration of the proposed amendment was deferred.

Turning then to the proposed amendment, Applicant seeks [*9] to amend its identification of goods from:

Air cushions for medical purposes; Blankets, electric, for medical purposes; Clothing extension support devices for use during pregnancy for medical purposes; Corsets for medical purposes; Draw-sheets for sick beds; Electric acupuncture instruments; Feeding bottles; Heating cushions for medical purposes; Inflatable cushions for medical use; Masks for use by medical personnel; Massage apparatus; Orthopedic cushions; Physical

¹⁹ *Id.* The printouts of the registrations are appended as Ex. B to Opposer's brief.

²⁰ *Id.*

²¹ 14 TTABVUE.

²² 16 TTABVUE.

exercise apparatus for medical purposes; Respiratory masks for medical purposes; Sanitary masks for medical purposes; Sterile sheets, surgical; Suture materials; Vibromassage apparatus; Clothing especially for operating rooms, in Class 10

to:

Masks for use by medical personnel; Respiratory masks for medical purposes; Sanitary masks for medical purposes; Clothing especially for operating rooms, in Class 10.

Applicant argues that its proposed amendment falls under *Johnson & Johnson v. Striker Corp.*, 109 USPQ2d 1077 (TTAB 2013), ²³ and urges that "[i]f the proposed amendment is granted immediately, the scope of discovery and presentation of evidence on opposer's Section 2(d) claim will be narrowed and simplified." Mot. to Amend, p. 4. ²⁴

We agree with Applicant that its requested amendment comports with the first three *Striker* conditions [*11] and that the fourth is not applicable. However, unlike in *Striker* where the amendment was filed prior to the close of the discovery period, here, Applicant did not seek to amend its identification until after the close of Opposer's testimony period in chief.

Because Applicant failed to file its motion early enough to provide Opposer with sufficient notice of its proposed change before trial, as is apparent by Opposer's attempt to supplement its record with the untimely submissions appended to its brief, Applicant's motion to amend must be denied. See, e.g., *ProQuest Info. and Learning Co. v. Island*, 83 USPQ2d 1351, 1353-54 (TTAB 2007) (Board denied applicant's requests in his brief to narrow his identification of goods to avoid any likelihood of confusion); *Personnel Data Sys., Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863 (TTAB 1991) (Board denied as untimely, respondent's motion to amend the identification of goods in its registration which request was filed with respondent's brief on the case); *Int'l Harvester Co. v. Int'l Tel. and Tel. Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of [*12] goods); *Gulf States Paper Corp. v. E-Z Por Corp.*, 157 USPQ 450 (TTAB 1968) (Board denied applicant's motion to amend the identification of goods filed after opposer had put on his case, noting that the timing would prejudice opposer). See also TMEP § 514.03, and the authorities cited therein.

Applicant's motion to amend the identification of goods therefore is denied, and this proceeding will go forward on the current identification of goods.

²³ In *Striker*, the Board [*10] set forth the following conditions for allowing an amendment of an opposed application:

- 1) the proposed amendment must serve to limit the broader identification of goods or services;
- 2) applicant must consent to entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;
- 3) if the applicant wishes to avoid the possibility of a res judicata effect by the entry of judgment on the original identification, the applicant must make a prima facie showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial; and
- 4) where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and applicant must then introduce evidence during its testimony period to prove use of its mark with the remaining goods or service prior to the relevant date as determined by the application's filing basis.

Striker, 109 USPQ2d at 1078-79.

²⁴ 14 TTABVUE 5.

II. The Record

The record in this case consists of the pleadings and, by rule, the file of Applicant's application. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

During its assigned testimony period, Opposer submitted the following:

. Opposer's Notice of Reliance (NOR) on: (1) TESS printouts showing the current status and title of Opposer's pleaded registrations (Exs. 1-7); (2) printouts from the TESS database showing the current status and title of five additional registrations for THERAGUN and THERAGUN- formative marks owned by Opposer ²⁵ (Exs. 8-12); (3) Applicant's responses to Opposer's First set of Interrogatories and First Request for Production of Documents and Things ²⁶ (Exs. 13-16); and (4) Printout of articles from websites and publications, including, e.g., Vogue, Sports Illustrated, Men's Health, Shape **[*13]** and Health (Exs. 17-34).

. The Testimony declaration of Kevin Tsao, Opposer's Sr. Vice-President of Digital, with Exs. 35-51. ²⁷

During its assigned testimony period, Applicant submitted the following:

. Applicant's notice of reliance on: (1) a printout from the USPTO's Trademark Status & Document Retrieval



(TSDR) database of Applicant's Registration No. 2072348 for the design mark for various clothing items ('348 Registration) (Ex. 1); (2) specimens submitted to the Office in connection with the procurement and maintenance of Applicant's '348 registration (Ex. 2-4); (3) printouts of third-party registrations of GUN-formative marks from the TSDR database (Exs. 5-21); **[*15]** (4) a printout from amazon.com showing sales of Applicant's THREEGUN masks (Ex. 22); and (5) printouts from third-party websites purportedly "relevant to the strength of Applicant's THREEGUN mark" (Exs. 23-27). ²⁸

²⁵ The registrations include: Registration No. 6126360 (THERAGUN MINI); Registration No. 6126362 (THERAGUN PRO); Registration No. 6126363 (THERAGUN ELITE); Registration No. 6218258 (THERAGUN PRIME); and Registration No. 6206626 (THERAGUN). "While an unpleaded registration cannot be used as a basis for the opposition, it, like third-party registrations, may be considered for 'whatever probative value' it may lend to opposer's showing under the *du Pont* factors in its case in chief." *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1035 (TTAB 2010). See also TBMP § 704.03(b)(1)(A) (2014) (distinguishing between a federal registration owned by the plaintiff in an opposition or cancellation proceeding and one pleaded by the plaintiff in its complaint)." *Fujifilm Sonosite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014). However, we give them little to no probative value as they (as opposed to evidence regarding the use of some of the subject marks) were not the focus of Opposer's arguments, save as to ownership.

²⁶ 9 TTABVUE. Notably, responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents **[*14]** produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); see also *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance). Accordingly, we consider Applicant's responses to Opposer's document requests only to the extent that they state Applicant has no responsive documents.

²⁷ 10 TTABVUE (11 TTABVUE, confidential version).

²⁸ 18 TTABVUE.

. The testimony Declaration of Zhao Dandi, the General Manager of Shanghai Dragon Imp. & Exp. Co., Ltd., a subsidiary of Shanghai Dragon Corporation of which Applicant is also a subsidiary.²⁹

III. Entitlement to Statutory Cause of Action

Entitlement to a statutory cause of action "is an element of the plaintiff's case in every inter partes proceeding." *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671, 210 L. Ed. 2d 833 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82, 211 L. Ed. 2d 16 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 134 S. Ct. 1377, 188 L. Ed. 2d 392, 109 USPQ2d 2061, 2067 n.4 (2014)).

To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration or continued registration of the mark. *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *1 (TTAB 2020) (citing *Corcamore*, 2020 USPQ2d 11277 at *4). *See also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); **[*16]** *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).


Opposer's pleaded registrations for the THERAGUN marks have been made of record,³⁰ and because these registrations form the basis of Opposer's plausible likelihood of confusion claim, we find it has established a reasonable belief of damage that is proximately caused by the potential registration of Applicant's proposed mark. *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (pleaded registration demonstrated entitlement to bring a statutory cause of action); *Barbara's Bakery v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (pleaded registration of record and opposer's likelihood of confusion claim was plausible). The opposition therefore falls within the zone of Opposer's interest protected by Section 13 of the Trademark Act, 15 U.S.C. § 1063(a).

IV. Priority

In view of Opposer's submission into evidence of valid and subsisting registrations for its pleaded marks, and in the absence of any counterclaims to cancel those registrations,³¹ priority is not in issue with respect to the marks and

²⁹ 19 TTABVUE.

³⁰ 9 TTABVUE 6, 9-10 (Opposer's NOR, Exs. 1-7).

³¹ Applicant's allegation of priority, based on its previously registered **[*17]** design mark  (Registration No. 2072348) for various clothing items, or any common law use of the THREEGUNS mark, is an impermissible collateral attack with respect to Opposer's pleaded registrations in the absence of a timely filed counterclaim. Trademark Rule 2.106(b)(3)(ii), 37 C.F.R. § 2.106(b)(3)(ii) ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration."); *see also, e.g., Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (absent a counterclaim, Board cannot consider arguments against the validity of a pleaded registration). Accordingly, we do not consider further Applicant's arguments and evidence directed solely to Applicant's claim of prior use. Applicant's contention that THERAGUN is merely descriptive likewise is an impermissible collateral attack on Opposer's pleaded registrations. We will, however, consider those arguments and supporting evidence to the extent they relate to Applicant's arguments regarding the weakness of Opposer's pleaded THERAGUN marks.

To the extent, Applicant intended its arguments to be in the nature of a prior registration or *Morehouse* defense, *see Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 56 C.C.P.A. 946 (CCPA 1969), **[*18]** such defense was not pleaded nor is it available. *See id.* at 717 ("the opposer cannot be damaged, within the meaning of section 13 of the statute, by the issuance to the applicant of a second registration where applicant already has an existing registration of the same mark for the same goods"). Here, both Applicant's mark and goods differ from those in the prior registration, so the *Morehouse* defense is inapplicable even if it was timely asserted (which it was not).

the goods listed therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d). "In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence." *Stratus Networks v. UBTA-UBET Commc'ns, Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000)).

Our analysis under Section 2(d) is based on all of the probative evidence of record relevant to the factors bearing [*19] on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). "In discharging this duty, the thirteen *DuPont* factors 'must be considered' 'when [they] are of record.'" *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case." *Stratus Networks v. UBTA-UBET Commc'ns*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (citing *Dixie Rests.*, 41 USPQ2d at 1406-07). "Each case must be decided on its own facts and the differences are often subtle ones." *Industrial Nucleonic's Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. 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 record evidence but 'may focus ... on dispositive factors, such as similarity of the marks [*20] and relatedness of the goods.'") (quoting *Herbko Int'l v. Kappa Books, Inc.*, 64 USPQ2d at 1380). We discuss below these and other factors for which there is either evidence or argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence and argument).

While we consider all of Opposer's pleaded registrations, for the sake of judicial economy, we confine our analysis to the THERAGUN mark in Opposer's pleaded Registration No. 5213141 and the goods identified therein because the parties primarily directed their arguments and evidence to the mark and goods in that registration. In addition, the THERAGUN mark includes less points of difference between it and Applicant's mark than Opposer's other pleaded marks. If we find a likelihood of confusion as to this mark, we need not find it as to the others; conversely, if we do not find a likelihood of confusion as to this mark, we would not find it as to the others. See *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity/Dissimilarity of the Goods, Trade Channels and Classes of Consumers

We turn first to the *DuPont* factor involving consideration of the "similarity or dissimilarity and nature of the goods ... as described [*21] in an application or registration." *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Under this *DuPont* factor, we need not find similarity as to each and every

product listed in Applicant's identification of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *i.am.symbolic*, 116 U.S.P.Q.2d (BNA) at 1409; *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014). For ease of reference, we list the respective goods below (emphasis added).

Applicant's goods:

Air cushions for medical purposes; Blankets, electric, for medical purposes; Clothing extension support devices for use during pregnancy for medical purposes; Corsets for medical purposes; Draw-sheets for sick beds; Electric acupuncture instruments; Feeding bottles; Heating cushions for medical purposes; Inflatable cushions for medical use; Masks for use by medical personnel; **Massage apparatus**; Orthopedic cushions; Physical exercise apparatus for medical purposes; Respiratory masks for medical purposes; Sanitary masks for medical purposes; Sterile [*22] sheets, surgical; Suture materials; **Vibromassage apparatus**; Clothing especially for operating rooms (Class 10); and

Opposer's goods:

Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; **Electric massage appliances, namely, electric vibrating massager**; Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus (Class 10).³²

We find the parties' goods in-part identical in that they both include "massage apparatus" and legally identical as to Applicant's "vibromassage apparatus," because Opposer's broadly worded "massage apparatus" encompasses Applicant's more narrowly identified "vibromassage apparatus." [*23] See *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518 (TTAB 2016) ("Inasmuch as Registrant's goods are encompassed within the scope of Applicant's goods, the respective goods are legally identical in part."); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). Because Applicant's and Opposer's goods are identical to the extent noted above, "there is no need for us to further consider the relatedness of the goods." *In re FabFitFun*, 127 USPQ2d 1670, 1672 (TTAB 2018).

In addition, because Applicant's and Opposer's goods are in-part identical, we presume that the channels of trade and classes of purchasers are the same for those goods. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (*cited in Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods...."). Therefore, the channels of trade and [*24] classes of purchasers overlap.

We accordingly find the *DuPont* factors concerning the relatedness of the goods, trade channels and classes of purchasers favor a finding of likelihood of confusion.

B. Purchaser Sophistication and Consumer Care

³² Opposer's registration additionally includes goods in Class 25, namely, "Hats; T-shirts; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baseball caps and hats; Short-sleeved or long-sleeved t-shirts."

Applicant argues that "Opposer's goods are relatively 'expensive' as compared to Applicant's masks and protective clothing, thereby making confusion less likely. Purchasers of Applicant's massage gun devices, which are generally priced between \$ 200 and \$ 600 for one product, are likely to give careful consideration to such products as they are generally purchased infrequently." Applicant's brief, p. 19.³³ Applicant's argument stems from its mistaken assumption that its untimely-filed motion to amend its application would be granted. Because it was not, Applicant's goods also include massage apparatus. While we have no pricing information regarding Applicant's massage apparatus, as there has been no demonstrated use in the United States, the record nonetheless shows the prices of various massage devices ranging between \$ 120 and \$ 600.

Because neither Opposer's nor Applicant's identification of goods contains limitations as to [*25] classes of purchasers or price of products, we must consider that purchasers may include ordinary consumers who may purchase lesser expensive models. Moreover, precedent requires that we base our decision on the least sophisticated potential purchasers. *Stone Lion*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class").

We therefore find the *DuPont* factor regarding purchaser sophistication and care neutral in our analysis.

C. Lack of Actual Consumer Confusion

We next consider the *DuPont* factor concerning the nature and extent of any actual confusion and the related *DuPont* factor, the extent of the opportunity for actual confusion.

Applicant, in its brief, maintains that despite coexisting in the market place for approximately 8 years,³⁴ "Opposer has not offered one instance of actual confusion" Applicant's brief, p. 22³⁵ and, in addition, Applicant's declarant, Mr. Dandi, testified that to his knowledge "there has been no actual consumer confusion regarding the THREEGUN brand and the THERAGUN brand. Dandi decl. P 15.³⁶

The absence of any reported instances of confusion, however, is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Put another way, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery v. Landesman*, 82 USPQ2d at 1287 (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) [*27] ("[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring"). Here, Mr. Dandi testified that Applicant has not exported any "massage apparatus, vibromassage apparatus, or physical exercise apparatus" or "any non-textile products" to the United States in connection with the THREEGUN trademark. Dandi decl. at PP 13 and 14.³⁷ (19 TTABVUE 3). Accordingly, there has been no opportunity for actual, or potential, confusion to occur. As such, we find these

³³ 22 TTABVUE 20.

³⁴ Applicant's argument focuses on Applicant's use of the THREEGUN mark in connection with clothing. However, [*26] our likelihood of confusion analysis focuses on the goods as originally identified in Applicant's involved application, and in particular, Applicant's identified massage apparatus and vibromassage apparatus. The only "clothing items" identified in the application are for medical purposes, i.e., "clothing extension support devices for use during pregnancy," "corsets" and "clothing especially for operating rooms."

³⁵ 22 TTABVUE 23.

³⁶ 19 TTABVUE 3.

³⁷ 19 TTABVUE 3.

DuPont factors (absence of actual confusion and opportunity for such confusion to have occurred) to be neutral in our analysis.

D. The Marks

1. Strength of the Pleaded Mark

Opposer maintains that its THERAGUN mark "is quite strong and deserving of a wide scope of protection." Opposer's brief, p. 12.³⁸

The strength of a mark rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). **[*28]** In determining the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010).

a. Inherent or Conceptual Strength

To determine the conceptual strength of Opposer's THERAGUN mark, we evaluate where they lie "along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum...." *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014)), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). Because Opposer's mark is registered on the Principal Register, with no claim of acquired distinctiveness under Section 2(f), we presume it is inherently distinctive, i.e., that it is at worst suggestive of the goods. 15 U.S.C. § 1057(b) (registration is "prima facie evidence of the validity of the registered mark"); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, "we must assume that it is at least suggestive").

Even so and contrary to Opposer's contention, evidence that a mark, or an element of a mark, was adopted or at some time appropriated by many different third-party registrants may undermine the common element's conceptual or inherent strength as an indicator of a single source. **[*29]** *Jack Wolfskin Austrang Fur Draussen GmbH & Co. KGAA v. New Millennium 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, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason)); *see also Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011) (third-party registrations indicate term CLASSIC has suggestive meaning as applied to tobacco products).


Applicant submitted 17 use-based, third-party registrations for GUN-formative marks,³⁹ arguing "that the THERAGUN mark has coexisted with many of the same or similar products sold in the same or similar stores proves that Opposer's rights are narrowly defined and strongly suggests that using a different mark with the same "gun" suffix for different products is not likely to lead to confusion." Applicant's brief, p. 20. **[*30]**⁴⁰ The registration information highlighted in Applicant's brief is noted in the table below:

Registration No.	Mark	Goods
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³⁸ 20 TTABVue 17.

³⁹ 18 TTABVue 30-86 (Applicant's NOR, Exhs. 5-21).

⁴⁰ 22 TTABVue 21. Although Applicant contends that the "[t]he number and nature of similar marks in use on similar goods, strongly favors Applicant," Applicant's brief, p. 20 (22 TTABVue 21), Applicant did not submit any evidence of third-party use evidence.

Registration No.	Mark	Goods
5768183	RXGUN	Electrical stimulation apparatus for muscles for rehabilitative and pain management purposes; Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; among others.
5875922	BFGUN	Electric handheld muscle massager
5886760	MUSCLEGUN	Massage apparatus; massage apparatus and instruments; massage apparatus for massaging injured muscles; massaging apparatus for personal use; vibrating apparatus used to stimulate muscles and increase strength and physical performance
5931798	ECOGUN	Massage apparatus; Massage apparatus and instruments; among others
5972074		Massage apparatus; Massage apparatus and instruments; Electric massage apparatus for household use; Electric massage appliances, namely, electric vibrating massager
5997055	POWERGUN	Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus; Massage

Registration No.	Mark	Goods
		<p>apparatus; Massage apparatus and instruments; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes</p>
6071108	<p>PHYSIO GUN</p> <p>(Gun disclaimed)</p>	<p>Massage apparatus; Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging neck, shoulder, back, legs, and other general body parts; Massaging apparatus for personal use; Electric massage apparatus for household use; Electric massage appliances, namely, electric vibrating massager</p>
6085382	KRAFTGUN	<p>Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus; Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes</p>
6096246	DAGUN	<p>Facial toning machines for cosmetic use; Massage apparatus; Massage apparatus; Massaging apparatus for personal use;</p>

Registration No.	Mark	Goods
		Vibromassage apparatus; Electric massage appliances, namely, electric vibrating massager
6101879	CROSSGUN	Massage apparatus; Medical apparatus and instruments for treating osteoarthritis and osteoporosis; Vibromassage apparatus; among others
6106473	FLEXGUN	Massage apparatus; Massage apparatus for massaging percussion, massage gun; Massaging apparatus for personal use; Foot massage apparatus
6117627	CHAMPIONGUN	Massage apparatus
6335145		Massage apparatus
6351920	HAPPYGUN	Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging muscles; Massaging apparatus for personal use
6383299	ACCUGUN	Massage apparatus
6508542	REVITAGUN	Massage apparatus
6578580	MASSAGUN	Massage apparatus; medical apparatus and instruments for use in surgery; vibromassage apparatus; moxibustion apparatus; electric acupuncture instruments; gloves for massage; teething rings; abdominal belts

Opposer contends Applicant's argument that the term "gun" is weak should fail because Applicant did not provide evidence showing use by third parties of the term "gun" associated with the same goods as those of Opposer. We find Opposer's contention unavailing. As noted, "third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Juice Generation*, 115 USPQ2d at 1675 (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2015)). Here, the 17 third-party registrations Applicant made of record demonstrate that the term "gun" forms a part

of numerous registered marks, in a manner used to [*31] describe certain types of massage apparatus, including those of Opposer.

Other parts of the record corroborate that the term "gun" often is used to describe certain types of massage apparatus. For example, an article by Bryan Hood for the *Robb Report* titled "The Best Massage Guns for Your Workout" discusses "Four massage guns to help take your workout to the next level," and includes Opposer's "Theragun G3 Percussive Therapy Device," WuBeFine Massage Gun and Vybe V2 Percussion Massage Gun.⁴¹ Another article from cnet.com discusses the best massage gun(s) for 2021⁴² as does an article from wired.com.⁴³ In fact, Opposer in its brief states "[i]n 2015, Opposer introduced its ... THERAGUN massage device, jumpstarting a wave of similar massage guns into the market." Opposer's brief, p. 1 and 11.⁴⁴

The third-party registration and use evidence thus confirm the highly suggestive, if not descriptive, meaning of "gun" in the massage apparatus industry. We accordingly find that the term GUN is weak and diluted for massage apparatus.

The record also shows that the THERA [*32] portion of Opposer's THERAGUN mark may be perceived by consumers as a shortened form of the word "therapy." For example, a Therabody Instagram excerpt highlights a quote from Dr. J Wersland, Therabody founder, which states: "Your body has adaptive ways to hide stress and that's why percussive therapy and massage therapy are so powerful."⁴⁵ Another example from an article featuring the THERAGUN mini massager entitled "Theragun just rolled out an affordable, quiet mini massager" (<https://www.fastcompany.com>) expounds: "The new Theragun models feature other upgrades as well -- including varied speed control, wireless charging capabilities, seven massage head attachments, two times battery life of prior modes, and the proprietary Percussive Therapy tech. Percussive Therapy is a scientifically calibrated combination of depth, speed, and force that allows Theragun massages to reach 60% deeper than consumer-grade vibration massagers."⁴⁶ As a final example, we note that the THERAGUN G3 massage apparatus has been categorized by the Robb Report (<https://robbreport.com>) "LIFESTYLY / PRODUCT RECOMMENDATION" section as a "Percussive Therapy Device."⁴⁷

In addition to the third-party registrations, we consider the third party uses Applicant made of record as showing the public's understanding of the term "gun" often being used to describe certain types of massage apparatus, and the term "thera" as being perceived by consumers as a shortened form of the word "therapy." See *In re Gen'l Foods Corp.*, 177 USPQ 403, 404 (TTAB 1973) (from the material made of record, the term "TREAT" or "TREATS" in Applicant's PUDDING TREATS mark was shown as having been widely used in the sale and advertising of foods and in articles pertaining to food products in a descriptive manner, and extensively used in conjunction with general food designations to indicate a particular type of "treat").

In view thereof, Opposer's mark THERAGUN, as a whole, is somewhat suggestive of the identified massage apparatus.

b. Commercial Strength

⁴¹ 10 TTABVUE 64-65.

⁴² *Id.* at 138.

⁴³ *Id.* at 149.

⁴⁴ 20 TTABVUE 6 and 16 (citing 9 TTABVUE 155 (Opposer's NOR., Exh. 24)).

⁴⁵ 10 TTABVUE 20. (Tsao decl., ex. [*33] 36).

⁴⁶ *Id.* at 37 (Tsao decl., ex. 38).

⁴⁷ *Id.* at 62. (Tsao decl., ex. 40).

We next analyze the commercial strength of Opposer's THERAGUN mark(s). A commercially strong or famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). "Fame of an opposer's mark, if it exists, plays a 'dominant role in the process of balancing the [*34] DuPont factors.'" *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)).

In the likelihood of confusion analysis, fame varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Because of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting 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); *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009).

Commercial strength or fame of a mark for likelihood of confusion purposes "may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods or services] sold [or provided] under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods and services] identified by the mark []; and the general reputation of the [goods and services]." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017); *see also Bose* 63 USPQ2d at 1305-06. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, [*35] for example, market share or sales or advertising figures for comparable types of goods and services. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

?? extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;

?? the number of consumers that Opposer solicits through its advertising throughout the year;

?? local, regional, and national radio and television advertising campaigns, freestanding print campaigns, and mentions in national publications;

?? unsolicited media attention; and

?? product placement in television and in movies.

Omaha Steaks Int'l v. Greater Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1691-91 (Fed. Cir. 2018).

To demonstrate the commercial strength of its THERAGUN mark(s), Opposer relies on internet evidence submitted with its notice of reliance, and the declaration testimony of its Senior Vice-President of Digital, Kevin Tsao and accompanying exhibits. In his declaration, Mr. Tsao testifies that:

?? Opposer is "a leader" in the massage gun market, with eight retail and service locations in the United States⁴⁸;

?? Opposer advertises [*36] and promotes its THERAGUN mark for massage devices, including through its own presence on various social media platforms, including Facebook where it has more than 96,000 followers, and Instagram, where it has more than 639,000 followers⁴⁹;

⁴⁸ 10 TTABVUE 2 (Tsao decl. P 2).

⁴⁹ 10 TTABVUE 2 (Tsao decl. P 2, exs. 35 and 36).

?? Opposer purchases advertising on various online platforms, including Facebook, Google, Amazon, LinkedIn, and Twitter, with most advertising featuring the THERAGUN mark ⁵⁰;

?? Opposer's advertising figures for its THERAGUN branded products are confidential, but have steadily increased from 2018 through June 2021 ⁵¹;

?? Opposer and its THERAGUN mark and products have been featured in various publications and on several websites, including Wired.com, the Chicago Tribune, The Strategist website, HealthLine.com ⁵²;

?? Opposer, and its THERAGUN branded devices have been the recipient of various industry accolades and design awards. By way of example: "Opposer's THERAGUN product was named Golf Digest's article 'Best Fitness Equipment for Golfers'" ⁵³; the THERAGUN device was named in Self Magazine's article "The 23 Best New Trackers, Gym Bags, Accessories, and Workout Tools of 2019" ⁵⁴; The THERAGUN G3Pro devices is an A' Design Award and Competition **[*37]** Winner in the Digital and Electronic Devices Design Category, 2018-19 ⁵⁵; and

?? Opposer's THERAGUN device won Gold at the New York Design Awards in 2019. ⁵⁶

In addition to the uses highlighted in the Tsao declaration, Applicant adduced evidence that THERAGUN branded massage devices have been used by many athletes and celebrities, including by Atlanta Falcons player Julio Jones during Super Bowl LI and by NBA player Kyrie Irving during the 2017 NBA Finals, and other athletes and celebrities, including by way of example, Marvin Jones, Ashley Graham, Kevin Hart, Marcus Peter, Kerri Walsh-Jennings **[*38]** and Chris Hemsworth. ⁵⁷

Opposer's THERAGUN branded massage devices also have been the subject of numerous write-ups and reviews in, for example, Vogue, TeenVogue, US Weekly, Shape, SELF, GQ, and Men's Health, including articles titled "7 Gadgets Star Athletes Can't Live Without," "All About the TheraGun, the Self-Massage Device That's Taking Over Instagram," "Meet the Theragun, the NBA's Secret Sideline Weapon," "Why Celebrities and Athletes are Going Gaga for this Massage Gadget," and "The Celeb-Favorite Massage Tool Taking Over the Fitness World," "Why Celebs Are Obsessed With Theragun -- and Why You Will Be Too." ⁵⁸

We find some deficiencies in Opposer's evidence that preclude us from a finding of commercial strength or fame. Particularly, Opposer provided no sales information, and the advertising information provided by Opposer's witness does not specify the subject marks, and lacks context as to how Opposer's **[*39]** advertising measures compare

⁵⁰ 10 TTABVUE 2 (Tsao decl. P 3).

⁵¹ 11 TTABVUE (Tsao confidential decl.).

⁵² 10 TTABVUE 5, 6, and 149-198 (Tsao decl. PP 18-21, exs. 46-49). We give no consideration to the testimony and evidence regarding the review of THERAGUN devices in Glamour UK, because we are unable to ascertain whether it was viewed by U.S. consumers.

⁵³ 10 TTABVUE 4 and 45-60 (Tsao decl. P 12, ex. 39).

⁵⁴ *Id.* at 5 and 95-96 (Tsao decl. P 14, ex. 41).

⁵⁵ *Id.* at 5 and 123-125 (Tsao decl. P 16, ex. 43).

⁵⁶ *Id.* at 5 and 128-132 (Tsao decl. P 17, ex. 44).

⁵⁷ 20 TTABVUE 17; 9 TTABVUE 101, 123-29, 137-38, 155, 163, 167-68, 184, 202-03, 221-22 (NOR. Exs. 18, p. 2; 19, p.2; 21 pp. 1-4; 22, pp. 1-2; 23, pp. 3-4; 24, p. 2; 25, p. 1; 26, pp. 1-2; 29, p.1 and 31, pp. 1-2).

⁵⁸ 20 TTABVUE 16-17; 9 TTABVUE 89-232 (NOR, exs. 17-34).

with other massage product companies, making the information less probative. "Raw numbers of ... advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading." *Bose*, 63 USPQ2d at 1309; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2009) ("[T]he problem that we have in assessing the effectiveness of the advertising expenditures is that there is no testimony or evidence regarding whether opposer's advertising expenditures are large or small vis-à-vis other comparable medical products."). See also *Omaha Steaks*, 128 USPQ2d at 1690 (contextual evidence needed "to arrive at a proper understanding of whether customers would recognize the mark").

Similarly, Opposer provided limited evidence relating to the extent of consumer exposure to its social media platforms. With regard to its Instagram presence, it only provided the number of followers, but no evidence of other analytics or metrics, the specific time periods that Opposer used that social media accounts, or that the number of followers were limited to U.S. consumers. With regard to its presence on Facebook (in addition to number of followers), and on Google, Amazon, LinkedIn, and [*40] Twitter, Opposer, for the six-month period from January 1, 2021 through June 30, 2021, provided (under seal) only the total numbers of "impressions" and "clicks to the THERAGUN website" from those platforms.⁵⁹ Opposer, did not indicate whether the impressions were discrete or were made by the same individuals visiting the site on multiple occasions, or whether the visits were only from consumers located in the United States. Again, the lack of specifics makes this information less probative.

Overall, the evidence presented by Opposer regarding the commercial strength of its THERAGUN mark does not convince us that it is so commercially strong or famous such that it is entitled to a wide latitude of protection. Nonetheless, based on Opposer's advertising presence across multiple social media platforms and the unsolicited exposure in the written press and online, as well as the various industry accolades, we find that Opposer has established that its pleaded registered THERAGUN mark has garnered some renown, which is not offset by its somewhat suggestive nature.

Accordingly, we find Opposer's THERAGUN mark is entitled to a slightly broader scope [*41] of protection than that to which marks with inherently distinctive terms are entitled.

2. Similarity or Dissimilarity of the Marks

We now consider "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay*, 73 USPQ2d at 1692 (citing *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d at 1812), *aff'd*, 777 Fed. Appx. 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 55 C.C.P.A. 903, 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.'" *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721 (Fed. Cir. 2012)). 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, 58 C.C.P.A. 972, 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). [*42] Here, the average customer is someone who buys massage apparatus, including for personal use. Above, we found that this group includes ordinary consumers exercising no more than ordinary care in their purchasing decisions.

In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d

⁵⁹ 11 TTABVUE (Tsao confidential decl.).

874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

We compare Applicant's stylized **THREEGUN** mark with Opposer's pleaded standard character mark THERAGUN. Opposer argues that the marks are similar in sight, sound and meaning and that the stylization of Applicant's mark does not distinguish it. As to sight, Applicant particularly argues that the marks are identical except that the third and fourth letters are transposed and the fifth letter in Applicant's mark is an "e" rather than an "a." A determination of likelihood of confusion, however, is not made on a purely mechanical basis, counting the number of words, [*43] syllables or even letters that are similar or different. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) ("Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both."). While the marks are both eight letters in length and begin with the letters "th" and end with the suggestive word "gun," it is the difference in the middle letters, which comprise the first term or portion in each, that is key in distinguishing one mark from the other. Principally, because Applicant's mark begins with the clearly recognizable English word "three" and Opposer's mark begins with what is likely to be recognized by consumers as a shorted form of the word "therapy," given that Applicant's devices are touted and recognized as "percussive therapy devices," the marks are more dissimilar than similar in appearance.

Moreover, this distinction in the first term or portion of each mark is important since "it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT [*44] because "veuve" is the first word in the mark). So long as we "analyze[] the marks as a whole[, i]t is not improper for the Board to determine that, 'for rational reasons,' ... [we] give 'more or less weight ... to a particular feature of the mark[s]' provided that ... [our] ultimate conclusion regarding ... likelihood of confusion 'rests on [a] consideration of the marks in their entireties.'" *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, *2-3 (Fed. Cir. 2021) (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000) and *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

We have not relied on the stylization of Applicant's mark in our finding that the marks are dissimilar in appearance. Opposer's pleaded mark is a standard character mark, and is not limited to any special stylization or colors, so it could be displayed in a font style and color similar to Applicant's mark. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) ("Standard character" marks are registered "without claim to any particular font style, size, or color."); *see also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display."). However, because the uppercase-block font adopted by Applicant is not very unique, it does [*45] not create a unique commercial impression apart from the words themselves so, even if adopted by Registrant, it is unlikely to be recognized as a source indicator.

As to sound, Opposer contends that because the marks are similar in structure and length, i.e., starting with the letters 'TH' and ending with the same word 'GUN' and with two of the remaining letters being 'R' and 'E,' "these same components result in similar, though not exact, pronunciations." Opposer's reply brief, p. 5.⁶⁰ We disagree. Applicant's and Opposer's marks obviously end with the same word, GUN, and accordingly sound alike in that respect. However, the first term or portion of each mark -- THREE in Applicant's mark and THERA in Opposer's mark -- is likely to be perceived and pronounced differently by consumers. Consumers are likely to pronounce Applicant's THREEGUN mark with two syllables, the first containing the long e vowel sound, and Opposer's THERAGUN mark with three syllables, the first containing the short e vowel sound and the second syllable containing the schwa,⁶¹ or "uh" sound. We thus find the marks, as a whole, aurally dissimilar.

⁶⁰ 28 TTABVue 10.

⁶¹ We take judicial notice of the definition [*46] of "schwa," defined in MERRIAM-WEBSTER Dictionary in relevant part as: "an unstressed mid-central vowel (such as the usual sound of the first and last vowel of the English word *America*)." www.merriam-

Turning then to connotation, we begin our analysis by taking judicial notice of the definition of the word "three," ('thrē') defined in part as "something having three units or members."⁶² We also repeat that the "thera" portion of Opposer's mark is likely to be perceived by consumers as an abbreviation or shortened form of the word "therapy," ('ther-⌲-pē') defined in MERRIAM-WEBSTER DICTIONARY as "therapeutic medical treatment of impairment, injury, disease, or disorder."⁶³

We are not persuaded by Opposer's argument that Applicant's THREEGUN mark and Opposer's THERAGUN mark have similar connotations because they are [*47] so similar in appearance and pronunciation. For the reasons just explained, we find the marks dissimilar in appearance and sound. Also, While the THERA portion of Opposer's mark may not be an "actual word[]" in any known language," Applicant's Reply brief, p. 5, the words that comprise Applicant's compound mark THREEGUN, THREE and GUN, as well as the GUN portion of Opposer's THERAGUN mark, obviously are words in the English language with known meanings. The absence of a space between the terms in the marks is an inconsequential difference. See *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEAGUARD and SEA GUARD "are, in contemplation of law, identical"). Considering the plain meanings of the words and terms that comprise the two marks, even when viewed against the backdrop of identical massage apparatus, would likely be perceived by consumers as conveying different connotations and commercial impressions. Applicant's THREEGUN mark is likely to be perceived by consumers as conveying the meaning of multiple guns or multiple gun-type massage devices, while Opposer's THERAGUN mark is likely to be perceived as conveying the meaning of a therapeutic massage device. These distinctly different connotations [*48] and commercial impressions clearly distinguish the two marks. See e.g., *Inter-state Oil Co., Inc. v. Questor Corp.*, 209 USPQ 583 (TTAB 1980) (applicant's mark GOERLICH and shield design found to convey a dissimilar commercial impression from opposer's INTERSTATE OIL and shield design mark); *Clayton Mark & Co. v. Keystone Brass and Rubber Co.*, 119 USPQ 265 (TTAB 1958) (applicant's mark SUMARK found to convey a distinctly different commercial impression than opposer' trademark MARK).

In sum, despite the slightly broader scope of protection to which Opposer's THERAGUN mark is entitled, when considered in their entirety, we find that Applicant's mark THREEGUN and Opposer's mark THERAGUN differ in sight, sound, meaning and overall commercial impression.

Accordingly, the first *DuPont* factor, the similarity of the marks, weighs heavily against a finding of likelihood of confusion.

C. Conclusion

Any of the *DuPont* factors may play a dominant role in the likelihood of confusion analysis. Indeed, in some cases, a single factor (such as the differences in the marks) may be dispositive. *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) ("[A] single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single [*49] factor is the dissimilarity of the marks."); *Kellogg Co. v. Pack'em Enters Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). We find that to be the case here.

Notwithstanding that Opposer's THERAGUN mark has some renown for massage apparatus, the in-part identical goods and their presumed overlapping channels of trade, we find, on balance, the marks are simply too dissimilar for confusion to arise. While there is some similarity in appearance, they are more dissimilar than similar, sound nothing alike, and convey different meanings and commercial impressions. Confusion is therefore unlikely. See e.g., *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) (affirming Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL

webster.com, last visited November 10, 2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *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).

⁶² www.merriam-webster.com, last visited November 8, 2022.

⁶³ www.merriam-webster.com, last visited November 10, 2022.

CREEK); *Kellogg Co. v. Pack'em*, 21 USPQ2d at 1142 (affirming Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 , 9 USPQ2d 1736, 1739-40 (Fed. Cir. 1989) (affirming Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES in commercial impression); *cf. Stouffer Corp. v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900, 1906 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir 1987) ("while the fame of opposer's mark and the identity of the parties' goods and their channels [*50] of trade tend to favor opposer's case, we are not persuaded that these circumstances are sufficient to refuse registration to applicant in view of our finding that LEAN CUISINE and LEAN LIVING, applied to the goods herein are not confusingly similar in sound, appearance or commercial impression").

Although Opposer has proved its entitlement to a statutory cause of action and priority by a preponderance of the evidence, it failed to prove likelihood of confusion, a key element of its Section 2(d) claim.

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Vill. Recorder v. Bigfoot Internet Ventures Pte. Ltd., 2020 TTAB LEXIS 209

Trademark Trial and Appeal Board

May 1, 2020, Decided

Cancellation No. 92064373

Reporter

2020 TTAB LEXIS 209 *

The Village Recorder v. Bigfoot Internet Ventures Pte. Ltd.

Disposition: [*1] Decision: Petitioner's Amended Petition to Cancel is granted based on its Section 2(d) claim. Petitioner's dilution and abandonment claims were not proven and are therefore dismissed. Respondent's Registration No. 4948560 will be canceled. Respondent's Petition to Cancel Registration No. 2478744 based on abandonment is granted. Petitioner's Registration No. 2478744 will be canceled.

Core Terms

Registration, VILLAGE, shirts, marks, recording studio, consumers, music, cancellation, likelihood of confusion, abandonment, goods and services, Counterclaim, dilution, records, sound recording, fame, original petition, similarity, trademark, Notice, famous, allegations, commerce, photographs, artists, factors, resume, discovery response, streaming, proven

Counsel

Michael P. Martin, of Fischbach Perlstein Lieberman & Almond LLP for The Village Recorder

Roman A. Popov of Morton & Associates LLP for Bigfoot Internet Ventures Pte. Ltd.

Panel: Before Thurmon, Deputy Chief Administrative Trademark Judge, Kuczma and Goodman, Administrative Trademark Judges.

Opinion By:

Thurmon

Opinion

This Opinion Is Not a Precedent of the TTAB

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

Bigfoot Internet Ventures Pte. Ltd. ("Respondent") owns the registered mark shown below



for goods and services that all involve, to some extent, music. ¹ The Village Recorder ("Petitioner") seeks cancellation, alleging priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), dilution under Section 43(c) of the Act, 15 U.S.C. § 1125(c), and non-use abandonment under Section 14(3) of the Act, 15 U.S.C. § 1064(3). ² Respondent counterclaimed to cancel one of Petitioner's registrations alleging non-use abandonment under Section 14(3). ³

We grant in part and deny in part the Amended Petition and we grant the Counterclaim. As to the Section 2(d) claim in the Amended Petition, we find Petitioner has standing and has proven priority and a likelihood of confusion as to the goods and services identified in Respondent's Registration. Petitioner has not proven dilution or abandonment, and we, therefore, deny its Amended Petition as to those claims. Respondent's Registration will be cancelled. Respondent has standing and has proven that Petitioner abandoned the mark identified [***3**] in Registration No. 2478744, and we, therefore, grant the Counterclaim and order cancellation of that Registration.

I. The Claims and the Record

A. A Funny Thing Happened on the Way to Trial

About ten years ago, Petitioner brought an opposition proceeding against a third-party who sought to register the mark MUSIC VILLAGE (standard characters). ⁴ Petitioner brought claims under Section 2(d) (priority and likelihood of confusion) and Section 43(c) (dilution), just as it did in the original Petition here. In the prior case, Petitioner relied on a testimony deposition of Jeffrey Greenburg, which included testimony about Petitioner's business and trademark uses, plus exhibits showing use and promotion of its marks. Petitioner prevailed on its Section 2(d) claim in the prior case, but not on its dilution claim. ⁵

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Registration Number 4948560 registered on the Principal [***2**] Register on May 3, 2016 based on a request for extension of protection filed on November 12, 2014 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f. The specific goods and services identified in the Registration are recited below.

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

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18 TTABVUE (Motion to Amend Petition to Cancel); 19 TTABVUE (Board Order granting the Motion and accepting the Amended Petition). The Amended Petition added the abandonment claim.

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17 TTABVUE (Answer and Counterclaim).

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Opposition 91195190.

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Id. at 36 TTABVUE 29-30. The Board denied the dilution claim because Petitioner failed to prove its marks were famous.

Petitioner appears to view this proceeding as just a replay of the prior one. In its initial evidence, Petitioner submitted the prior Greenburg testimony deposition and exhibits.⁶ When Respondent moved to strike that evidence from the prior proceeding, we granted the motion.⁷ This result should [*4] surprise no one. We decide each case on its merits, and the Respondent in this case is unrelated to the applicant in the prior opposition. The marks are different, there are different goods and services, and years have passed since the evidence was submitted in the previous proceeding.

Petitioner did not rely solely on the evidence from the prior case, but its new evidence proves very little. In a declaration, Mr. Greenberg refers to exhibits by letter, but there are no exhibit labels on any of the evidence. To make matters worse, we are told only general information about the evidence, such as Exhibit B (wherever it starts and ends) purportedly is a "photo gallery of legendary recording artists and other famous individuals who have visited and recorded various music, television or motion picture projects at the Village."⁸ There are many pages of photographs, but none of the pages or photographs are labeled, identified, [*5] or explained in any way.⁹

Petitioner's evidence is very limited. We cannot take judicial notice of the fame of artists or consumer awareness of how the recording process works, let alone of what particular recording studio was responsible for a song or album the consumer has heard or seen. There are too many gaps in this evidence and the responsibility for that falls entirely on Petitioner.

Given the lack of evidence introduced by Petitioner, it may be surprising that Petitioner has prevailed on its Section 2(d) claim. That result is fortuitous for Petitioner, because it did not even submit proper evidence of the trademark registrations relied upon for its Section 2(d) claim. By chance, one of its asserted Registrations is properly in evidence, and for the reasons given below, we find confusion is likely between the THE VILLAGE mark and the services identified in that registration and Respondent's mark and the goods and services identified in Respondent's Registration.

We offer these remarks to make clear to the parties, and to others who may read this decision, that it is risky to assume a past win in a Board proceeding means a later case will produce the same result. Petitioner was lucky [*6] here, and the aphorism "better lucky than good" is nice when it works, but a dangerous way to litigate disputes.

B. The Claims

Petitioner initially pleaded the following four registrations as the basis for its claims:¹⁰

Mark	Registration No.	Goods or Services
THE VILLAGE	2071311	Recording studio services in International

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¹⁰ TTABVUE 107-59 (Greenberg deposition transcript); ¹² TTABVUE (exhibits from Greenberg deposition). In an apparent effort to ensure we were aware of our prior decision, Petitioner provided a copy of it, too. ¹¹ TTABVUE 8-37.

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²⁵ TTABVUE 4-5; ²⁹ TTABVUE 5-6.

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Id. at 6.

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Id. at 20-46.

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¹ TTABVUE.

Mark	Registration No.	Goods or Services
		Class 41
THE VILLAGE	2478744	Clothing, namely, shirts in International Class 25
VILLAGE STUDIOS	3665377	Recording studio services in International Class 41
THE VILLAGE	4516887	Streaming of audio, visual and audiovisual material via a global computer network; Streaming of live musical performances and audiovisual material on the Internet.

During discovery, Respondent asked Petitioner to identify uses of its asserted marks.¹¹ Petitioner described uses of its marks for recording studio services and streaming, but did not provide any responses about uses of its marks on clothing, namely, shirts. Respondent then moved to amend its Answer by adding a counterclaim for cancellation of Registration Number 2478744.¹² We granted the motion and allowed Respondent to bring the counterclaim.¹³ Petitioner filed an Answer to the Counterclaim, denying the salient allegations.¹⁴

After the Board allowed Respondent's Counterclaim, Petitioner moved to amend its original Petition in two respects: 1) it dropped its reliance on Registration No. 2478744 (i.e., the one for shirts); and, 2) it added a claim for non-use abandonment, alleging that Respondent only intended to use its mark on a television program.¹⁵ We allowed Petitioner's amended [*7] claims and Respondent filed an amended Answer, denying the salient allegations.¹⁶

C. The Record

There are two matters that require explanation before we can provide a summary of the record:

1. Petitioner's Evidence of Its Pleaded Registrations; and,
2. Respondent's Motion to Strike and the Evidence Petitioner Submitted After the Board Granted that Motion.

1. Petitioner's Registration Evidence

If a party relies on a registration as the basis for a claim, the party must prove that it owns the registration (title) and that the registration is in force (status). Though registrations are presumed valid under the Trademark Act, 15

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⁸ TTABVUE 5-6 (citing to discovery requests and responses).

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Id.

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¹⁶ TTABVUE.

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²¹ TTABVUE.

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¹⁸ TTABVUE (Motion to Amend and Amended Petition).

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¹⁹ TTABVUE (Order granting motion and allowing the amended Petition); ²³ TTABVUE (Respondent's Amended Answer).

U.S.C. § 1057(b), years may pass from the issuance of a registration and ownership of the mark may pass to other parties. Similarly, deadlines may have passed for submitting proof of continued use or for renewals of the registration, and, as a consequence, the registration may no longer be in force. For this reason, the Board requires evidence that the party relying upon a registration prove the registration remains [*8] in force and is owned by the party. *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978) (plain copies of registrations introduced through testimony which established ownership of the registrations but failed to establish that they were currently subsisting were not considered); *Maybelline Co. v. Matney*, 194 USPQ 438, 440 (TTAB 1977) (pleaded registration was not considered of record where testimony introduced original certificate of registration into evidence but failed to establish current status and title).

"[A] party predicated its claim of damage upon ownership of a pleaded registration may make the registration of record in any one of three ways." *A.R.A. Mfg. Co. v. Equip. Co.*, 183 USPQ 558, 558 (TTAB 1974). First, it may submit with its opposition or petition "an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration." 37 C.F.R. § 2.122(d)(1). Second, a party may submit essentially the same evidence with a Notice of Reliance during an appropriate testimony period. *Id.* at 2.122(d)(2). Third, a party "may introduce the registration into [*9] evidence as an exhibit in connection with the trial testimony of a witness having knowledge thereof." *A.R.A. Mfg.*, 183 USPQ at 558.

Petitioner did not submit evidence of its registrations with its Amended Petition.¹⁷ Instead, Petitioner submitted records relating to its pleaded registrations with a Notice of Reliance filed on November 8, 2017.¹⁸ For the two older registrations (i.e., Registration Nos. 2071311 and 3665377), Petitioner submitted a printed record of the registrations from the Trademark Electronic Search System (TESS) and information about the most recent renewal of each registration.¹⁹ The '311 Registration was renewed on June 5, 2017, just over five months before the Notice of Reliance was submitted in this proceeding and about ten months after the original Petition was filed. The '377 Registration was renewed on August 31, 2015, over two years and two months before the evidence was filed in this proceeding and about a year before the original Petition was filed. For the more recent Registration (i.e., the 4516887 Registration for streaming services), Petitioner submitted only a copy of the Registration Certificate, which issued on April 22, 2014. This Registration issued over three and a half years prior to the [*10] submission in this proceeding and a year and a half before the original Petition was filed.

The evidence Petitioner submitted did not show status and title at either the date the original Petition was filed (August 15, 2016) or the date the Notice of Reliance was filed (November 8, 2017). If evidence shows status and title on a date that is "reasonably contemporaneous" with the filing of the Petition or the Notice of Reliance, it will suffice to prove "current" status and title. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041-43 (TTAB 2014) (explaining the requirement for reasonably contemporaneous evidence). We find the renewal information for the '311 Registration was reasonably contemporaneous with the filing of the Notice of Reliance, but the dated materials submitted for the '377 and '887 Registrations were not close enough in time to the filing of the original Petition to Cancel or the Notice of Reliance. Thus, the '311 Registration is of record and the other two Registrations will not be considered. The '311 Registration identifies [*11] only "recording studio services," and for

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¹⁸ TTABVUE. Nor did Petitioner submit such records with its original Petition. 1 TTABVUE.

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¹¹ TTABVUE.

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Id. at 248-49 ('311 registration), 250-51 ('377 registration).

that reason, Petitioner's arguments based on music streaming services (identified in the '887 Registration only) will not be considered.²⁰

2. Respondent's Motion to Strike and Petitioner's Evidence

After the parties' amended claims were finalized and answered, Respondent filed a Motion to Strike some of the evidence submitted by Petitioner.²¹ We granted the motion in part--striking Petitioner's discovery responses; its submission of Respondent's responses to Requests for Admissions that did not contain any admissions; and its submission of evidence from a prior Board proceeding that did not involve Respondent (as noted above).²² We allowed Petitioner an opportunity to resubmit any parts of the stricken evidence that were otherwise admissible in this proceeding.²³

Petitioner accepted this invitation and submitted new exhibits Y and Z, which it described as follows: **[*12]**

Exhibit Y is a true and correct copy of a small sampling of screenshots of audio and video performance sessions recorded by world famous recording artists and streamed online under the mark THE VILLAGE and the VILLAGE mark shown thereon in connection with the live streamed recorded performances.

Exhibit Z is a true and correct copies [sic] of a small sampling of gold and platinum records, album covers, DVD inlays and plaques for world famous recording artist [sic] and their albums recorded at THE VILLAGE and the VILLAGE mark shown thereon which establish the fame and notoriety of Petitioner's Village recording studios.²⁴

Petitioner describes Exhibit Y as evidence of use "in connection with the live streamed recorded performances," which are the type of services identified only in the '887 registration. That registration is not in evidence and for that reason Exhibit Y is of limited relevance to this proceeding.²⁵

Most of the items in Exhibits Y and Z are of extremely poor quality. *See In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, *7 n.23 (TTAB 2019) ("the Board will consider evidence, or a portion of the evidence, only if it is clear and legible"); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) ("the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board"), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.). While it is possible to see the VILLAGE trademark on some of these materials, and some artist

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The '377 Registration also identified recording studio services, so its exclusion is of less significance. The '377 Registration is for the mark VILLAGE STUDIOS, while the '311 Registration is for the mark THE VILLAGE.

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²⁵ TTABVUE.

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²⁹ TTABVUE 3, 5, 6.

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Id. at 6.

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³¹ TTABVUE 6.

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Petitioner's description of Exhibit Y also states the sessions were "recorded" and perhaps that act falls within the "recording studio services" identified in the '311 registration that is of record. We will consider Exhibit Y for that limited purpose. **[*13]**

names are legible, there is no information explaining or providing context for these materials. We do not exclude these materials from the record, but our reliance upon them is limited by their poor quality and lack of context.

3. Summary of the Record

Subject to the limitations noted above, the evidence of record can be summarized as follows:

1. Respondent's Registration No. 4948560 through Trademark Rule 2.122(b)(1)--the Registration Petitioner seeks to cancel;
2. Petitioner's Registration No. 2478744 through Trademark Rule 2.122(b)(1)--the Registration Respondent seeks to cancel;
3. Petitioner's Registration No. 2071311 based on the TESS and renewal evidence, as explained above;²⁶
4. Petitioner's Declaration of Jeffrey Bruce Greenberg dated November [*14] 8, 2017 ("Greenberg I"), together with exhibits A-V;²⁷
5. Petitioner's Declaration of Jeffrey Bruce Greenberg dated March 4, 2019 ("Greenberg II"), together with exhibit 17;²⁸
6. Petitioner's Declaration of Jeffrey Bruce Greenberg dated May 31, 2019 ("Greenberg III"), together with exhibits 1, 2, 5, 6, 11, 12;²⁹
7. Petitioner's Declaration of Jeffrey Bruce Greenberg dated July 2, 2019 ("Greenberg IV"), together with exhibits Y and Z;³⁰
8. Petitioner's Notice of Reliance dated July 2, 2019;³¹ and,
9. Respondent's Notice of Reliance May 2, 2019.³²

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11 TTABVUE 248-49.

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10 TTABVUE (exhibits W and X were stricken, as explained above). [LK: I did not see W and X mentioned above. I may have missed them. However, if they weren't specified above, it may be helpful to note them in a corresponding footnote to what was "explained above."]

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24 TTABVUE.

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28 TTABVUE (exhibits 3, 4, 7-10 were stricken, as explained above).

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31, 32 TTABVUE.

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30 TTABVUE (selected discovery responses of Respondent).

³²

II. Standing

Standing is a threshold issue that must be proven by the plaintiff in every [*15] inter partes case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). We discuss standing of Petitioner and Respondent/Counterclaimant separately.

A. Petitioner's Standing

Petitioner has submitted into evidence a copy of its pleaded Registration No. 2071311 for THE VILLAGE mark and alleges that Respondent's registered mark is likely to cause confusion and dilution. Petitioner further alleges that it "has been damaged as a proximate result of the U.S. Patent & Trademark Office's issuance of the challenged registration." ³³ This evidence, taken with these allegations, shows Petitioner has a "real interest" in the proceeding and "a reasonable basis for [its] belief of damage." *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 171 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); see also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012). Petitioner has established its standing to challenge Respondent's Registration.

B. Respondent's Standing

Respondent has standing because Petitioner asserted Registration No. 2478744 as a basis for the original Petition to Cancel Respondent's Registration. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014) ("Applicant has standing based on opposers' assertion of their [*16] marks and registrations against applicant in their notice of opposition."). The fact that Petitioner later withdrew Registration No. 2478744 as a basis for its Section 2(d) claim is irrelevant, because standing is assessed at the time the counterclaim is filed. *Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013). When Respondent filed its Counterclaim, Registration No 2478744 had been asserted as a basis for the Petition to Cancel Respondent's Registration. Respondent, therefore, has standing to seek cancellation of Registration No. 2478744.

III. Analysis

A. Petitioner's Section 2(d) Claim

1. Priority

Petitioner has submitted status and title evidence of its 2071311 Registration, which has a statutory priority date of January 11, 1996, the filing date of its underlying application. Respondent's Registration claims an international filing priority date of August 18, 2014, and Respondent offers no prior evidence of use. Respondent does not seek cancellation of the '311 Registration, and therefore, Petitioner has established priority for purposes of its Section 2(d) claim. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

2. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the probative [*17] facts in evidence that are relevant to the factors enunciated in *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.*, 575 U.S. 138, 135 S. Ct. 1293, 191 L. Ed. 2d 222, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *du Pont* factor for which

36 TTABVUE (selected discovery responses and a screenshot of an Internet page).

33

18 TTABVUE 12-13.

there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonic's Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("[T]he various evidentiary factors may play more or less weighty roles in any particular determination"). Two key considerations in most cases are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) ("The likelihood of confusion analysis considers all *du Pont* factors for which there is record evidence but 'may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.'")).

i. Similarity of Goods, Trade Channels, and Buying Conditions

We begin [*18] with these factors ³⁴ because they play a critical role in our decision in this case. "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed." *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1355 (Fed. Cir. 2009) (same rule in cancellation proceeding); *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Petitioner's Section 2(d) claim is based on its 2071311 Registration of THE VILLAGE for "recording studio services" in International Class 41. Respondent's Registration identifies the following goods and services:

Computer software for streaming, broadcasting, transmitting and reproducing music; compact discs featuring music; digital music downloadable from the Internet; downloadable music via the Internet and wireless devices; sound recordings featuring music; video recordings featuring music in International Class 9; and,

Audio and video recording services; consultation and advice regarding musical selections and arrangements for sound recordings and live performances; entertainment services in the nature of recording, production and post-production services in the field of music; entertainment services, namely, providing a website featuring non-downloadable pre-recorded musical performances, musical videos, film video clips related to music, photographs in the field of musical artists and bands, and other multimedia materials featuring musical artists and bands, namely, non-downloadable articles [*20] in the field of music, non-downloadable photographs related to the field of music, non-downloadable pre-recorded audio clips featuring interviews with musical artists and bands, reviews, recommendations and commentary on music, music related events and activities related to the field of music in International Class 41.

The parties' Class 41 services overlap. Respondent's Registration includes the following specific services:

. audio and video recording services;

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Our analysis here covers the second, third and fourth *du Pont* factors: "The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;" "The similarity or dissimilarity of established, likely-to-continue trade channels;" and, "The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." *du Pont*, 177 USPQ at 567. We group [*19] these three *du Pont* factors because of the shared focus on the identification of the goods and services.

- . consultation and advice regarding musical selections and arrangements for sound recordings and live performances; and,
- . production and post-production services in the field of music.

The evidence submitted by Petitioner shows that it provides audio recording services as part of its recording studio services.³⁵ There is no direct evidence that Petitioner's recording studio services include production and post-production services in the field of music, but the testimony by Mr. Greenburg support the inference that such services fall within the scope of the more broadly stated recording studio services. We find the parties' Class 41 services are highly similar in part. This fact increases the likelihood of confusion as to the Class [*21] 41 services in Respondent's Registration.

Respondent's Class 9 goods relate to music and some are the physical form or carrier for music (e.g., compact discs and sound recordings). These goods appear to be the most closely related to Petitioner's recording studio services. There is evidence that Petitioner's mark is presented on the sound recordings made at its studio.³⁶ Though such goods are not covered by Petitioner's '311 Registration, this evidence shows that consumers have seen goods like those identified in Respondent's Registration bearing the trademark of a recording studio.³⁷ We find Respondent's "compact discs and sound recordings" goods are related to Petitioner's "recording studio services," and this relationship increases the likelihood of confusion.³⁸ The connection, however, between Respondent's Class 9 goods and Petitioner's Class 41 services is less direct than that between the parties' respective Class 41 services. For that reason, we give this factor less weight in connection with Respondent's Class 9 goods.

We further find the likely trade channels for the parties' goods and services overlap. At least some of the sound recordings identified in Respondent's Registration, will be created in recording studios like the one operated by Petitioner, showing the likely overlap of the trade channels. The overlapping trade channels make confusion more likely.

Finally, we find the relevant consumer is an ordinary listener or purchaser of music, and particularly of sound recordings. There is no evidence that such consumers exercise a high degree of care in making purchasing decisions. Respondent argues that consumers of Petitioner's recording studio services [*23] are sophisticated and likely to exercise great care.³⁹ We agree, but the likelihood of confusion inquiry is not limited to Petitioner's recording studio clients. If consumers of Respondent's compact discs and sound recordings believe those goods come from or are associated with Petitioner's recording studio, which is a relevant form of confusion. For that

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10 TTABVUE 11-12.

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Id. at 11 ("The Village Recorder has always been referred to as The Village Recorder, Village Studios, The Village and Village, [*22] in advertisements and on sound recordings."), *Id.* at 13 ("For most recordings, The Village mark is displayed on the sound recordings that were recorded at The Village, either on the album or the inlay, and sometimes on a plaque.").

³⁷

Id. at 13 ("hundreds of millions of albums have been sold which contain the mark 'The Village' thereon worldwide").

³⁸

Respondent's Registration identifies both "recording services" in Class 41 and "sound recordings and compact discs" in Class 9, so Respondent cannot credibly contend that such goods and services are unrelated.

³⁹

34 TTABVUE 22-23.

reason, it is the broader class of music consumers that we must take into account here.⁴⁰ Because we find such consumers exercise an ordinary degree of care in making purchasing decisions, this consideration is neutral in our evaluation of the likelihood of confusion.

ii. Strength of Petitioner's Mark

In identifying "strength" as a single factor, we are combining two of the *du Pont* factors.⁴¹ "A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)." *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *see also Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011); *Tea Bd. 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. 2019). Our focus is on the strength of Petitioner's THE VILLAGE mark.

To evaluate conceptual strength of word marks, we place the mark in one of the following classes: "(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 764 (2d Cir. 1976). We find Petitioner's THE VILLAGE mark is either suggestive or arbitrary and thus is conceptually [*25] strong.⁴²

Petitioner argues THE VILLAGE mark is famous, which, if true, would represent a very high degree of market strength. The evidence shows that Petitioner's mark has been used with recording studio services for over 50 years.⁴³ Petitioner presented evidence that it has recorded music for many well-known artists over the years and that many of these recordings have been quite successful.⁴⁴ Respondent does not dispute these facts, but notes that no evidence was submitted to show consumer awareness of Petitioner's mark or the marketing and advertising efforts for Petitioner's mark.⁴⁵

We agree with Respondent that the evidence of record fails to show that Petitioner's THE VILLAGE mark is famous. There is evidence that music consumers are exposed to this mark, but that evidence is not quantified.⁴⁶ We have

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See, e.g., 10 TTABVUE 13 (Greenberg testimony that "hundreds of millions of albums have been sold which contain the mark 'The Village'"); 96-106 (November 7, 2017 Los Angeles Times article titled "A day at the Village--hos [??] L.A.'s legendary record studio cleaned up its act and survived the YouTube age."). The Los Angeles Times article discusses the history of Petitioner's studio and mentions current activities there. It is evidence that some consumers are aware of the relationship between a recording studio and sound recordings. [*24]

⁴¹

In *du Pont*, the court identified the fifth and sixth factors as follows: "the fame of the prior mark" and "the number and nature of similar marks in use on similar goods." *du Pont*, 177 USPQ at 567. These two factors go to the strength of Applicant's mark and, therefore, are treated together here.

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We note, of course, that the word "studios" is descriptive or generic of Petitioner's services and so the focus of our conceptual strength analysis is on the word "village."

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10 TTABVUE 13.

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Id. at 1-2, 14; 31 TTABVUE 6, Exhibit Z (showing gold and platinum records).

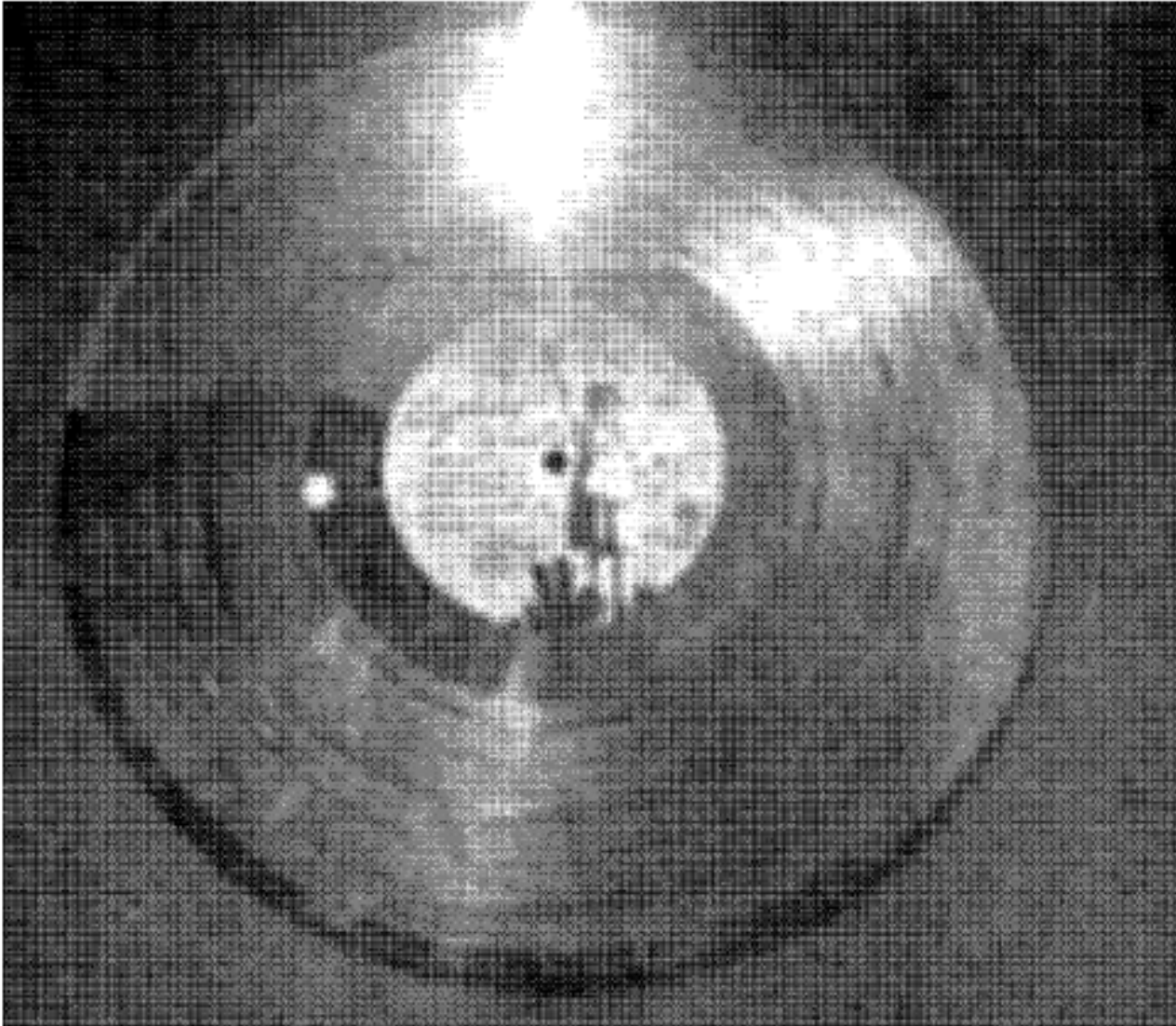
⁴⁵

34 TTABVUE 24.

⁴⁶

no brand awareness studies. We have no legible samples of typical sound recordings [*26] bearing Petitioner's mark. We have no sales volume evidence and only a few media articles that mention Petitioner's studio.⁴⁷ This evidence shows some market strength, but not fame.

We have "a small sampling of gold and platinum records, album covers, DVD inlays and plaques for world famous recording artist [sic] and their albums recorded at THE VILLAGE and the VILLAGE mark shown thereon ..." in Exhibit Z, but as we noted above, most of that evidence is very difficult to read. A few examples of this evidence follow:



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10 TTABVUE 13 (Greenberg statement that THE VILLAGE mark appears on sound recordings made it Petitioner's studio); 32 TTABVUE (Petitioner's mark is legible on some of the photocopies provided in this evidence).

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See, e.g., 10 TTABVUE 96 (Los Angeles Times article about Petitioner's studio).

⁴⁸

31 TTABVUE 55.



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These examples are typical of the evidence found in Exhibit Z. It is possible to read the name of the artist on some of these materials, and on some albums the recording label can be read (e.g., the Epic mark seen above). But it is almost impossible to find legible uses of Petitioner's THE VILLAGE [*27] mark on this evidence. As a result, we are left with two statements by Mr. Greenberg asserting that the mark is used on sound recordings and a few marginally legible examples of Petitioner's mark on sound recordings. The nature and impact of such uses is impossible to determine from this evidence. It is the burden of the party claiming its mark is famous to submit evidence to support such a finding. *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1192 (TTAB 2012). Petitioner failed to do so here.

Petitioner's THE VILLAGE mark is conceptually strong and has some market strength. We do not find this mark famous. The evidence falls far short of proving that THE VILLAGE is a household name with music consumers. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) (fame evaluated within the relevant market segment); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) (spending alone does not prove fame).

iii. Similarity of the Marks

We compare the marks in their entireties 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 [*28] Bottling Co.*, 390 F.2d 728, 55 C.C.P.A. 903, 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 test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Though we compare the marks in their entireties, we also note that different elements of a mark may have different impacts on consumers. For example, the first term in a multi-word mark is likely to be more noted and remembered by consumers. *See, e.g., Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692; *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)). Consumers are also more likely to remember the more distinctive elements of a mark, and for that reason, we place less [*29] weight on descriptive or generic terms found in multi-word marks. *See, e.g., Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

Respondent's mark is a design mark with the literal elements intertwined with the design elements:



The marks are not similar in appearance. We cannot ignore the significant impact of the design elements in Respondent's mark, and these create a different visual impression from Petitioner's THE VILLAGE mark. We find the meaning and commercial impressions created by the marks are also dissimilar due in large part to the design elements of Respondent's mark.

The marks, however, are similar in sound. Most consumers are likely to use only the literal elements of Respondent's mark to ask for its goods or services. In this important context, the proper comparison is between MUSIC VILLAGE and THE VILLAGE. The word "music" is descriptive of Respondent's goods or services, and for that reason will likely be less noted or remembered by consumers. The term "village," on the other hand, is an arbitrary term for the goods and services at issue here and is likely to have a stronger impact on consumer memory of the marks. This shared term makes the [*30] marks similar in sound and meaning which increases the likelihood of confusion.

iv. Conclusion -- Weighing the Factors

We find confusion is likely. The goods and services are similar or related. The issue is close as to the Class 9 goods. There is not much probative evidence showing use or consumer awareness of Petitioner's THE VILLAGE mark for sound recordings. In addition, most of Petitioner's arguments concerning Respondent's Class 9 goods are based on a registration that is not in evidence.⁵¹ Despite the weakness of the evidence, at least some of

Respondent's Class 9 goods (e.g., compact discs and sound recordings) are related to Petitioner's Class 41 recording studio services. That relationship, taken together with the strength of Petitioner's mark and the similarity of the marks makes confusion likely. For this reason, we grant the Petition to Cancel Respondent's Registration under Section 2(d) of the Act.

B. Petitioner's [*31] Dilution Claim

In addition to its § 2(d) claim, Petitioner has asserted a dilution claim under § 43(c) of the Trademark Act. Petitioner contends that Respondent's mark will "blur" the distinctiveness of Petitioner's THE VILLAGE mark.⁵² Dilution by blurring is an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. It is, therefore, necessary to consider the fame of Petitioner's mark.

Fame for likelihood of confusion and dilution is not the same; fame for dilution requires a more stringent showing. *Palm Bay Imports*, 73 USPQ2d at 1694; and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). A mark may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 49 USPQ2d 1225, 1239 (1st Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection"). **[*32]** We found above that Petitioner's evidence is insufficient to prove fame for purposes of likelihood of confusion, so it follows that Petitioner's evidence is insufficient to prove fame for purposes of dilution. Petitioner's dilution claim is denied.

C. Petitioner's Abandonment Claim

Respondent's Registration issued on May 3, 2016, under Section 66(a) of the Trademark Act.⁵³ Use in commerce prior to registration is not required for registrations issued pursuant to Section 66(a). See Trademark Act Section 68(a)(3), 15 U.S.C. § 1141h(a)(3) ("Extension of protection shall not be refused on the ground that the mark has not been used in commerce."); *Dragon Bleu (SARL) v. Venm*, 112 USPQ2d 1925, 1929 (TTAB 2014) ("Use of the applied-for mark in United States commerce is not a prerequisite to registration of a mark filed under Section 66(a).").⁵⁴ A registration obtained through Section 66(a), however, is subject to the same grounds for cancellation as those registrations issued under Section 1 or Section 44(e), including abandonment. See, e.g., *Saddlesprings, Inc.*, 104 USPQ2d at 1951 ("once a U.S. registration issues based on Section 66(a), the registration is subject to the same grounds for cancellation as those registrations issued under Section 1 or Section 44(e)") (citations omitted).

Registration No. 4516887 identified "Streaming of audio, visual and audiovisual material via a global computer network; Streaming of live musical performances and audiovisual material on the Internet" in Class 41. That registration, however, was not properly put into the record by Petitioner.

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Petitioner alleges dilution of the three registered marks cited in the amended Petition, but only the '311 Registration for THE VILLAGE mark is in evidence.

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Registration No. 4948560.

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"Under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), the holder of an international registration may file a **[*33]** request for extension of protection of that registration to the United States. An applicant who files such a request must declare its intention to use the mark in the United States, Section 66 of the Trademark Act, 15 U.S.C. § 1141f(a), and the resulting U.S. application is subject to examination and opposition, Section 68 of the Trademark Act, 15 U.S.C. § 1141h." *Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012).

Petitioner alleges in its amended Petition to Cancel that "Registrant is not using and has not used the mark" and that "Registrant does not intend to resume use of its mark ..." ⁵⁵ This claim adequately alleges abandonment under the Act. 15 U.S.C. § 1127 ("A mark shall be deemed to be 'abandoned' ... [w]hen its use has been discontinued with intent not to resume such use."). Petitioner's abandonment claim seeks cancellation of the entire registration, and therefore, Petitioner must prove abandonment of the mark as to each of the classes of goods and services. *Cf. Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 28 (CCPA 1976) ("We conclude, therefore, that this opposition proceeding as to four classes of a combined application is, effectively, four different oppositions which require four different factual determinations and four different conclusions on the ultimate **[*34]** issue of likelihood of confusion under § 2(d).").

Respondent concedes that it has not used its mark in commerce in the United States. ⁵⁶ Respondent, however, disputes the intent element and argues that it has not started use of the mark because of Petitioner's legal actions against it. ⁵⁷ Petitioner bears the burden of proving an intent not to resume use, but the only evidence it cites is a single discovery response by Respondent. When asked about intended uses of its mark, Respondent replied: "Registrant responds that [sic] will use the MARK in connection with a TV production that explores the link between music and various lifestyles across the globe." ⁵⁸ Petitioner argues that this response proves Respondent has no intent to use its mark on the goods and services identified in the Registration.

We disagree. Respondent's statement about a future "TV production" is not evidence of an intent not to resume use on the specific goods and services identified in the Registration. This evidence describes one intended use. It is not evidence that no other uses are intended. Nor **[*35]** does it indicate what specific goods and services might be provided as part of a TV production about music. In addition, "a TV production that explores the link between music and various lifestyles across the globe" is likely to involve at least some of the following specific services identified in the Registration:

- . audio and video recording services;
- . entertainment services in the nature of production and post-production services in the field of music; and,
- . providing a website featuring non-downloadable pre-recorded musical performances, musical videos, film video clips related to music, photographs in the field of musical artists and bands, and other multimedia materials featuring musical artists and bands.

We further find that such a TV production about music might use or offer goods including the following:

- . sound recordings featuring music; and,
- . video recordings featuring music.

This discovery response falls far short of proving an intent not to resume use of Respondent's mark. Petitioner attempts to read this response in a very limited matter, by suggesting that a TV production is different from the

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¹⁸ TTABVUE 11.

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³⁴ TTABVUE 26 ("Bigfoot has yet to use its Mark in U.S. commerce ...").

⁵⁷

Id.

⁵⁸

Id.

goods and services identified in the Registration.⁵⁹ Proving intent is difficult, [*36] and far better evidence than this general discovery response is needed. Petitioner's abandonment claim is denied.

D. Respondent's Abandonment Counterclaim

Petitioner cited four registrations in support of its original Petition to Cancel, including one for "clothing, namely, shirts."⁶⁰ When Petitioner failed to identify in its discovery responses any uses of its marks on shirts, Respondent moved for leave to file a Counterclaim to cancel Petitioner's registration of THE VILLAGE mark for shirts.⁶¹ We granted the motion,⁶² and Petitioner denied the allegations.⁶³

Petitioner then provided a supplemental discovery response relating to use of its mark on shirts.⁶⁴ This response constitutes the entire record evidence on this issue. It consists of a group of photographs and the following two statements by Mr. Greenberg, the CEO and Owner of Petitioner:

Attached hereto as Exhibit 17 are true and correct copies of photographs of a sampling of clothing items that have been in use in commerce at various [*37] times over the years.

The mark THE VILLAGE was first use [sic] on clothing at least as early as 1995, and THE VILLAGE has been in continuous use in U.S. commerce on and in connection with clothing items, namely shirts since that date.⁶⁵

Petitioner provided five photographs of shirts with THE VILLAGE mark and one photograph of a shirt with a list of artists and www.villagestudios.com.⁶⁶ Upon closer examination, this evidence shows two shirts, one black and one white, with THE VILLAGE mark and a door design.⁶⁷ There are five photos of these two shirts. The photos appear

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35 TTABVUE 11-12.

⁶⁰

1 TTABVUE 2 (Registration No. 2478744).

⁶¹

8 TTABVUE 3.

⁶²

16 TTABVUE 6-7 (granting motion, but requiring a clearer pleading of the Counterclaim by Respondent).

⁶³

21 TTABVUE.

⁶⁴

24 TTABVUE.

⁶⁵

Id.

⁶⁶

Id. at 9-14. The shirt with the URL does not display THE VILLAGE mark and is, therefore, irrelevant to Respondent's Counterclaim. Petitioner also submitted photographs of persons wearing jackets bearing THE VILLAGE mark. The Registration specifically identifies "shirts" and jackets are not [*38] shirts. But the photographs of the jackets fail to prove use in commerce for the same reasons noted below for the shirts.

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Id. at 9-12, 14.

to be of the same person in the same location. The same flooring and backing wall can be seen in most of the photos. One photo shows what appears to be a group of gold records on the wall behind the person wearing the shirt, so we infer the photographs were taken at Petitioner's recording studios.⁶⁸

This evidence proves almost nothing. It shows that Petitioner has at least two t-shirts bearing THE VILLAGE mark, but nothing more. The photographs are not dated. They do not prove the mark was used on shirts sold or otherwise transported in commerce. We are left to speculate and guess about how these shirts were used by Petitioner. This evidence does not prove use in commerce of THE VILLAGE mark on shirts at any time.

There is evidence of only one other shirt, but it does not prove use in commerce either. This shirt is featured on an Etsy.com listing by a third party, who identifies it as a "Vintage item from the 1970s."⁶⁹ This t-shirt bears the words "the village recorder streaking team."⁷⁰ It is a stretch to say this is a use of THE VILLAGE mark on a shirt, but even if it was, there is no indication that Petitioner was involved in any way in this listing. This Etsy.com listing is not evidence of current use of the mark by Petitioner on shirts, but rather evidence that a variation of the mark was used on a shirt at some point (maybe the [*39] 1970s, as the listing states) and is now being sold by someone else as a vintage item.

There is no evidence of a bona fide use of THE VILLAGE mark on a shirt in the ordinary course of trade. Petitioner argues that it was not required to sell shirts, and while that may be true, it had to make some use in the ordinary course of trade. We have only Mr. Greenberg's self-serving statement that THE VILLAGE mark "has been in continuous use in U.S. commerce" with shirts. Without some corroboration, we cannot give any weight to this statement. *See e.g., ShutEmDown Sports*, 102 USPQ2d at 1043-1044 ("A party's response to an interrogatory is not without evidentiary value, but generally is viewed as 'self-serving.'"); *Tao Licensing, LLC v. Bender Consulting Ltd*, 125 USPQ2d 1043, 1053 (noting lack of any records or other documentation corroborating testimony that respondent distributed product samples). We agree with Respondent that if Petitioner really has been using THE VILLAGE mark continuously on shirts it would have at least some documentary evidence of such use.⁷¹ *See, e.g., Cerveceria Modelo, S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1303 (TTAB 2000) (rejecting self-serving statements of party alleged to have abandoned its mark).

There is no evidence of any bona fide use of THE VILLAGE mark on shirts in the ordinary course of trade. Respondent, therefore, has proven **at least** three years of nonuse of the mark on shirts. This showing triggers the statutory presumption and shifts the burden to Petitioner to present evidence of use or an intent to resume use. 15 U.S.C. § 1127. No such evidence was submitted other than the self-serving statement of Mr. Greenberg about continuous use of the mark on shirts. That statement is not evidence of use or an intent to resume use. Respondent has proven its abandonment Counterclaim.

End of Document

⁶⁸

Id. at 11.

⁶⁹

Id. at 15-16.

⁷⁰

Id. at 15-16.

⁷¹

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

In the Matter of Application Serial No. 87/459,649
Mark: AIRBLUE

JETBLUE AIRWAYS CORPORATION,

Opposer,

v.

AIRBLUE LIMITED,

Applicant.

Opposition No. 91239609

**APPLICANT AIRBLUE LIMITED'S STATEMENT OF OBJECTIONS TO OPPOSER
JETBLUE AIRWAYS CORPORATION'S EVIDENCE**

Applicant hereby responds to Opposer JetBlue Airways Corporation's Statement of Objections to Applicant Airblue Limited's Evidence. 101 TTABVUE 57-62.

I. JetBlue's Objection's to Applicant's Notice of Reliance

A. Paragraphs and Exhibits 8-14, 16, and 19-50

The objected to paragraphs and exhibits relate to third party use of blue-formative trademarks and use of the term "blue" in the airline industry. 65 TTABVUE 6-9, 14-24. Each exhibit is properly submitted under T.B.M.P. § 704.08(b). *See also* 37 C.F.R. § 2.122(e) ("Internet materials may be admitted into evidence under a notice of reliance . . . so long as the date the internet materials were accessed and their source (e.g., URL) are provided.").

They are properly offered to show that third parties use blue-formative marks and that the term "blue" has an understood meaning in the airline industry. *See The Sports Authority Michigan, Inc. v. The P.C. Authority, Inc.*, 63 U.S.P.Q.2d 1782, 1798 (T.T.A.B. 2002) ("website uses [are]

probative evidence that marks using a descriptive or suggestive term . . . are adopted to convey the suggestive connotation . . . and that such marks often co-exist and are distinguished because of the other terms used in connection with [the commonly used term].”); *see also Jack Wolfskin Austrustung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015) (third party use of a term is “powerful on its face, even where the specific extent and impact of the usage has not been established”). These exhibits and corresponding paragraphs should not be excluded.

B. Paragraphs and Exhibits 17-18

These paragraphs and exhibits relate to TESS and TSDR printouts of third party registrations and applications for blue-formative marks. 65 TTABVUE 9-14. TTAB rules provide that a party may submit “a print out or copy” of third-party trademark registrations and applications “from the Office’s electronic database records.” T.B.M.P. §§ 704.03(b)(1)(B) and 704.03(b)(2). That is what Applicant did and there is no basis to exclude these exhibits or corresponding paragraphs. Further, they are entitled to weight “to show the meaning of a mark, or portion of a mark.” *Id.* § 704.03(b)(1)(B).

Third party registrations and applications are relevant to show that JetBlue operates in a crowded field, “even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 U.S.P.Q.2d at 1136. They are also relevant to show the existence of marks in the industry containing “blue” and that the term “may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that [term] is relatively weak.” *Id.* at 1374. These exhibits and corresponding paragraphs should not be excluded.

C. Paragraph and Exhibit 51

Exhibit 51 is an article that quotes JetBlue’s CEO and other JetBlue employees. 65

TTABVUE 24. JetBlue contends the statements therein cannot be used to prove the truth of the matter asserted, however the quoted statements from JetBlue representatives are “opposing party statements” and are not hearsay. Fed. R. Evid. 901(d)(2). This exhibit and corresponding paragraph should not be excluded.

D. Paragraphs and Exhibits 53-69 and 66-78

The objected to exhibits and paragraphs are articles or webpages relating to Applicant’s goods and services and are examples of Applicant’s use of the AIRBLUE mark. Each exhibit is properly submitted under T.B.M.P. § 704.08(b). *see also* 37 C.F.R. § 2.122(e) (“Internet materials may be admitted into evidence under a notice of reliance . . . so long as the date the internet materials were accessed and their source (e.g., URL) are provided.”). The exhibits and corresponding exhibits are relevant to show Applicant has been mentioned in third party publications and should not be excluded.

E. Paragraphs and Exhibits 60-65

JetBlue treats these exhibits and paragraphs as if they are internet materials. 101 TTABVUE 58. However, each is an official record from the United States government, bearing dates, signatures, and government seals, and are printed publications available to the general public. 65 TTABVUE 28-29. They are properly submitted under T.B.M.P § 704.07 and § 704.08. *See* 37 C.F.R. § 2.122(e) (“printed publications” and “official records” “may be introduced in evidence by filing a notice of reliance on the material being offered”).

In addition, Mr. Chaudhary’s testimony makes clear that he accessed, reviewed and relied on these documents, providing a sufficient foundation for their introduction. 73 TTABVUE 13-14. The exhibits and corresponding paragraphs should not be excluded.

II. JetBlue’s Objections to Mr. Chaudhary’s Testimony

JetBlue claims Mr. Chaudhary lacks personal knowledge relating to aviation agreements

between the U.S. and Pakistan, rules and regulations for the U.S. airline industry, and the International Civil Aviation Organization. 101 TTABVUE 60. To the contrary, Mr. Chaudhary explained that he has experience “obtaining regulatory approval” from the Pakistani Civil Aviation Authorities in association with Applicant’s prior expansions (73 TTABVUE 3-4, 13), “in the application and review process necessary to get regulatory approval from the DOT” (73 TTABVUE 4, 14), and that he accessed, reviewed, and relied on Open Skies agreements between Pakistan and the U.S. DOT (73 TTABVUE 13-15). He also testified at length during his cross-examination on these topics. 94 TTABVUE 292-301. Mr. Chaudhary has extensive personal knowledge and experience and JetBlue’s objections are baseless.

JetBlue objects to Mr. Chaudhary’s testimony purportedly related to “[REDACTED] [REDACTED].” 101 TTABVUE 60 (objecting to 73 TTABVUE 17). The objected to testimony is merely that he is not aware of any actual confusion despite the fact that JetBlue claims [REDACTED] [REDACTED] 73 TTABVUE 17. Mr. Chaudhary is not testifying as to [REDACTED] [REDACTED], he is merely testifying that he is unaware of any instances of actual confusion. There is nothing improper about this testimony.

JetBlue objects to Mr. Chaudhary’s testimony relating to the International Civil Aviation Organization (ICAO). 101 TTABVUE 60 (objecting to 73 TTABVUE 18). However, Mr. Chaudhary did testify that he knows what ICAO is and what it does, including that they “issue call codes to each major airline from the member companies” including airblue. 73 TTABVUE 18. He has personal knowledge and experience in this area.

CONCLUSION

Applicant respectfully request that the Board overrule each of JetBlue’s objections to Applicant’s evidence and testimony.

Respectfully Submitted,
DORSEY & WHITNEY LLP

Dated: March 6, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of March, I caused to be served a true and correct copy of the foregoing by email on Opposer JetBlue Airways Corporation's attorneys of record at the following addresses:

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

In the Matter of Application Serial No. 87/459,649
Mark: AIRBLUE

JETBLUE AIRWAYS CORPORATION,

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Opposition No. 91239609

**APPLICANT AIRBLUE LIMITED'S STATEMENT OF OBJECTIONS TO OPPOSER
JETBLUE AIRWAYS CORPORATION'S EVIDENCE**

Pursuant to T.B.M.P. § 707.02 and 707.03, Applicant Airblue Limited (“airblue” or “Applicant”) hereby submits its objections to certain evidence introduced by Opposer JetBlue Airways Corporation’s (“JetBlue” or “Opposer”) in this proceeding. Applicant respectfully requests that the objected to evidence be excluded, or in the alternative, that the Board consider these objections when assessing the weight to give to the evidence. *See RxD Media, LLC v. IP Application Development LLC*, 125 U.S.P.Q.2d 1801, 1804 (T.T.A.B. 2018).

I. Objections to JetBlue’s Notices of Reliance

A. Printed Publications and Internet Materials

It is well-established that printed publications and Internet Materials “made of record by notice of reliance under 37 C.F.R. § 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein.” T.B.M.P. § 704.08(a). *See, e.g., Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 U.S.P.Q. 443, 445 (T.T.A.B. 1974) (articles from

trade publications not admissible to show that information therein is true); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 U.S.P.Q.2d 1584, 1592 (T.T.A.B. 2011) (as to matter submitted under notice of reliance, Board would “not consider[] them for the truth of the matter asserted therein, inasmuch as the statements therein constitute hearsay”). As such, the Board should exclude Exhibits 1-31 to Opposer’s First Notice of Reliance (48 TTABVUE 8-139), Exhibits 121-122 to Opposer’s Fourth Notice of Reliance (53 TTABVUE 5-8), Exhibits 124-137 to Opposer’s Sixth Notice of Reliance (56 TTABVUE 11-353), and Exhibits 138-152 to Opposer’s Rebuttal Notice of Reliance (94 TTABVUE 16-84) as hearsay to the extent JetBlue seeks to rely on these exhibits for the truth of the matters asserted therein.

B. JetBlue’s 10-K Forms

Exhibit 124 to JetBlue’s Sixth Notice of Reliance are “Opposer’s 10-K reports for 2013, 2016, and 2019” which Opposer accessed from the SEC website. 56 TTABVUE 2, 11-213. Opposer seeks to admit them as “Internet documents” under Rule 2.122(e). *Id.* It is well established that 10-K filings are not official records nor printed publications available to the general public and cannot be submitted under 37 CFR § 2.122(e). *Midwest Plastic Fabricators Inc. v. Underwriters Labs., Inc.*, 12 U.S.P.Q.2d 1267, 1270 n. 5 (TTAB 1989), *aff’d* 906 F.2d 1568 (Fed. Cir. 1990); *Research in Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 1929 (TTAB 2009) (financial reports “submitted by opposer to the [SEC] . . . do not qualify as official records and are thus not proper subject matter for a notice of reliance”). JetBlue’s attempt to rely on Section 2.122(e) is improper and the 10-K should be stricken. *See* TBMP § 528.05(e).

Even if the 10-K are properly submitted, they are still hearsay. *Overstock.com Inc. v. J. Becker Mgmt.*, Opp. No. 91203624, 2015 BL 222740, at * 3 (TTAB 2015) (Opposer cannot rely on 10-K reports “for purposes of establishing the truth of the matter asserted, the annual report has no real probative value with respect to the factor of fame”). JetBlue relies on the figures reported

in the 10-K forms to prove the amounts JetBlue has expended on advertising costs and the amount of revenue JetBlue generated—i.e., JetBlue relies on these reports for the truth of matters asserted therein. 100 TTABVUE 16-17. This is classic hearsay and should be excluded as such.¹ *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007).

JetBlue attempts to cure this defect by having Ms. Windram testify that they are “business records.” 57 TTABVUE 12-13. However, Opposer has not provided any testimony demonstrating that Ms. Windram has personal knowledge relating to the 10-K forms or is otherwise competent to testify to their contents. Ms. Windram merely testified she is “familiar” with the 10-K forms. 57 TTABVUE 12-13.

Applicant further objects to the 2019 10-K to the extent JetBlue relies on it to show the strength or fame of its marks. Applicant filed the Challenged Application on May 22, 2017 and “an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding.” *The Toro Company v. ToroHead, Inc.*, 61 USPQ.2d 1164, 1174 (TTAB 2001). Financial data post-dating Applicant’s filing date is irrelevant and should not be considered. *Id.*

II. Objections to JetBlue’s Testimonial Declarations

A. Ms. Windram’s Testimony

Ms. Windram makes statements that are conclusions of law and/or unqualified expert testimony. These include:

- That JetBlue’s marks are “unique indicators of the source of its products.” 57 TTABVUE 4
- That JetBlue owns or has rights in “a family or group of marks that all center on ‘blue.’” 57 TTABVUE 7

¹ Applicant’s reliance on the 10-K forms in its trial brief to show JetBlue has admitted certain facts is not hearsay. *See* Fed. R. Evid. 801(d)(2) (Opposing Party’s Statements are not hearsay).

- “As a result of JetBlue’s extensive efforts, investment and success, the JETBLUE brand is an incredibly strong and famous trademark.” 57 TTABVUE 30.
- “Registration or use of the AIRBLUE mark in the U.S. for airline and credit card services would harm JetBlue’s brand, as consumers are likely to think that AIRBLUE-branded air travel (and a credit card offered in connection with an airline) is a service offered by or in connection with JetBlue, and the existence of AIRBLUE in the U.S. would dilute the distinctiveness of the famous JETBLUE brand.” 57 TTABVUE 32.

Ms. Windram is not testifying as an expert and her conclusions of law should be disregarded. *Satco Prods., Inc. v. Thread Grp, Inc.*, 2020 BL 34959, at *4 (T.T.A.B. 2020) (legal conclusion from lay witness given no “determinative weight”).

B. JetBlue’s 10-K Forms and Related Testimony

Exhibits B, N and O to the Windram Declaration are “excerpts” from JetBlue’s 10-K forms from 2013, 2016, and 2019. 57 TTABVUE 12-13, 209-214. For the reasons stated above, these excerpts should be excluded or given no weight, as should testimony summarizing the contents of the exhibits. *See supra* Section I.B.

C. DVD Relating to JetBlue Advertisements

Exhibit Q to the Windram Declaration is a DVD with a sampling of video advertisements. 57 TTABVUE 17. Applicant objects to Exhibit Q to the extent JetBlue relies on statements made in such videos to prove the truth of the matters asserted. The statements made therein were made out of court, by third party advertising agencies. 57 TTABVUE 17-18. This is hearsay and should be excluded. *We Vote v. LeYef, LLC*, 2020 TTAB LEXIS 331, at *6-7 (T.T.A.B. June 26, 2010).

In addition, Ms. Windram does not authenticate or lay a foundation for the introduction of Exhibit Q, which included videos made by third-party advertising agencies. 57 TTABVUE 17-18. The Exhibit is merely submitted with her declaration, and should be given no weight. Fed. R. Civ. P. 902; *People United for Christ, Inc. v. People United for Christians, Inc.*, 2017 BL 275643 at *2 (T.T.A.B. July 21, 2017).

D. Spreadsheet Purporting to Show the Number of Consumers who Visited JetBlue’s Website

Exhibit AA to the Windram Declaration is a “chart summarizing” the monthly number of “U.S. located consumers” who “visited the JetBlue website or used its mobile app.” 57 TTABVUE 24, 320-22. Applicant objects to the exhibit and the data therein as unreliable, misleading, and prejudicial and on the grounds that Ms. Windram lacks personal knowledge required to authenticate and introduce this exhibit.

First, Ms. Windram testified that the spreadsheet shows the number of *consumers* who visited the JetBlue website and app (*id.*), however, Ms. van Wijnbergen testified [REDACTED]

[REDACTED]

[REDACTED] 65 TTABVUE Ex. 5 (120:17-121:7). Second, Ms. Windram testified

[REDACTED] (57 TTABVUE 24); Ms.

van Wijnbergen testified [REDACTED]

[REDACTED] 65 TTABVUE Ex. 5 (118:3-119:3). Third, Ms. van Wijnbergen testified [REDACTED]

[REDACTED]

[REDACTED] *Id.* (119:4-14).

Ms. Windram has not shown she has personal knowledge of the creation or contents of this Exhibit and it should be excluded. *See Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 1923 (TTAB 2006). In addition, Ms. van Wijnbergen’s testimony suggests the spreadsheet was prepared for litigation and is not a regularly kept business record, any data therein is hearsay. *Id.* (“summary sheets” prepared “for purposes of litigation” “are hearsay and will not be considered”).

E. Third Party Articles and Webpages

Exhibits Y and GG to the Windram Declaration are printouts of third party websites, such

as CNN and Amazon. 57 TTABVUE 24. Ms. Windram does not claim to have personal knowledge relating to the content of these exhibits and Applicant objects to the extent Opposer relies on these printouts to prove the truth of the matter asserted. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 U.S.P.Q.2d 1584, 1592 (T.T.A.B. 2011) (articles not considered “inasmuch as the statements therein constitute hearsay”).

Further, Exhibit GG is comprised of articles from foreign publications, which are irrelevant to JetBlue’s rights in the U.S. or any other issue in this proceeding. *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 U.S.P.Q.2d 10596, 11 (TTAB 2020).

F. Exhibits Relating to JetBlue’s Social Media Followers

Exhibits BB and CC to the Windram Declaration purportedly show the number of followers JetBlue has on various social media accounts. 57 TTABVUE 25-26. Exhibit BB is merely Internet printouts from JetBlue’s Facebook, Instagram, LinkedIn, and Twitter accounts. 57 TTABVUE 323-783. They cannot be used to prove the truth of the matter asserted, namely how many followers JetBlue has on each platform. Even if they could, the data is from 2019 and is irrelevant to the strength or fame of the JETBLUE Mark prior to Applicant’s filing date. *The Toro Company*, 61 USPQ.2d at 1174.

Exhibit CC is a series of bar and pie graphs prepared by third party Social Breakers. 57 TTABVUE 26; 58 TTABVUE 132-138. It summarizes data kept by the third party social media platforms. 65 TTABVUE Ex. 5 (39:5-13). JetBlue lacks any testimony or information relating to how the third party social media platforms keep this information or how Social Breakers prepared this information. It should be excluded as hearsay.

Further, both of these exhibits include data relating to JetBlue’s global business; any non-U.S. information is irrelevant. *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 U.S.P.Q.2d 10596, 11 (TTAB 2020).

G. Chart Summarizing Impressions in Third-Party Media.

Exhibit FF to the Windram Declaration is “document tracking impressions” for the JETBLUE Mark, which was “compiled from records.” 57 TTABVUE 27-28; 58 TTABVUE 157-485. JetBlue relies on this data to show third parties published articles mentioning JetBlue, that “Tier 1 publications (publications with readership greater than 1 million readers)” published such articles, and the number of impressions those articles received. *Id.* Ms. Windram again lacks personal knowledge to authenticate this Exhibit. She testified that it was prepared under Ms. van Wijnbergen’s direction, and Ms. van Wijnbergen testified [REDACTED]. [REDACTED]. 65 TTABVUE Ex. 5 (135:4-13).

JetBlue also lacks any evidence to show what the readership is of third-party publications, how many impressions the articles received, or even what “impressions” means. *See* 65 TTABVUE Ex. 5 (144:17-21) (“[REDACTED]”). This data comes from an unknown source, reports third party data, and is clearly hearsay. Further, any data post-dating Applicant’s filing date, such as the 2019 data referenced in paragraph 79 of the Windram Declaration, is irrelevant to show the strength or fame of the JETBLUE Mark. *The Toro Company*, 61 USPQ.2d at 1174.

CONCLUSION

Applicant respectfully request that the Board exclude the above identified evidence and testimony submitted by Opposer JetBlue.

Respectfully Submitted,
DORSEY & WHITNEY LLP

Dated: March 6, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of August, I caused to be served a true and correct copy of the foregoing by email on Opposer JetBlue Airways Corporation's attorneys of record at the following addresses:

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