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

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| Proceeding | 91240654 |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial Nos. 79/975,367 and 79/197,514

The Christian Broadcasting Network, Inc.,

Plaintiff,

v.

Delicious Ltd.,

Defendant.

Opposition No. 91240654

PLAINTIFF'S TRIAL BRIEF

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DESCRIPTION OF THE RECORD

The evidence of record consists of the following items:

1. Plaintiff's Notice of Opposition. (1 TTABVUE.)
2. Declaration of Gordon Robertson. (9 TTABVUE.)
3. Declaration of Mihai Bocarnea. (7 TTABVUE, 8 TTABVUE.)
4. Rebuttal Declaration of Mihai Bocarnea. (23 TTABVUE, 24 TTABVUE.)
5. Plaintiff's First Notice of Reliance. (6 TTABVUE; 13 TTABVUE.)
6. Plaintiff's Second Notice of Reliance. (10 TTABVUE.)
7. Plaintiff's U.S. Registration Nos. 1,108,225, 2,087,580, 3,799,169, 2,520,307, 5,286,207, and 5,321,978, made of record by Plaintiff's First Notice of Reliance. (6 TTABVUE at Ex. 1; 13 TTABVUE.)
8. Deposition testimony of Gordon Robertson taken by Defendant (25 TTABVUE.)
9. Deposition testimony of Mihai Bocarnea taken by Defendant (26 TTABVUE, 27 TTABVUE.)
10. Declaration of Gerry DeVeaux. (22 TTABVUE.)

STATEMENT OF THE ISSUE

Plaintiff, The Christian Broadcasting Network, Inc., owns (1) an incontestable registration for the mark CBN for, *inter alia*, television broadcasting services (Class 38) and entertainment services in the nature of televised religious, educational, news and variety programs (Class 41), (2) an incontestable registration for the mark CBN in Class 41 for educational services, namely, seminars, workshops, and conferences in the fields of Christian living, finances, marriages,

veterans and songwriting, and (3) an additional registration for the mark CBN for charitable fundraising in Class 36.¹

Defendant, Delicious Ltd., a for-profit, limited liability company organized under the laws of the Bahamas, seeks registration of the mark BCBN for (1) charitable fundraising, namely, charitable collections, management and monitoring of charitable funds in Class 36, (2) entertainment, namely, in the nature of variety television shows in class 41, and (3) communication by electronic communications networks on social media platforms for social networking in Class 38. Defendant also seeks registration of the mark BCBN in connection with a plethora of auxiliary goods in classes 3, 9, 14, 16, 25, and 28 across a broad spectrum ranging from perfume, jewelry, and clothing to computer software for podcasts (“Defendant’s Auxiliary Goods”).

The issues in this case are, therefore:

1. Whether, in light of the *DuPont* factors, Defendant’s use of the mark BCBN for “charitable fundraising, namely, charitable collections, management and monitoring of charitable funds” is likely to cause confusion with Plaintiff’s use of the mark CBN for the legally identical services of “charitable fundraising.”
2. Whether, in light of the *DuPont* factors, Defendant’s use of the mark BCBN for “entertainment, namely in the nature of variety television shows” is likely to cause confusion with Plaintiff’s use of the mark CBN for the legally identical services of “entertainment services in the nature of televised variety programs.”
3. Whether, in light of the *DuPont* factors, and in light of the omnipresent practice by companies like both Plaintiff and Defendant of associating themselves with social media, Defendant’s use of the mark BCBN for “communication by electronic

¹ Plaintiff also owns incontestable registrations for the marks CBN NEWS and CBN RADIO, among others.

communications networks on social media platforms for social networking” is likely to cause confusion with Plaintiff’s use of the mark CBN for “television broadcasting services.”

4. Whether, in light of the *DuPont* factors and the common practice of television broadcasting companies to combine new letters with their main trademark in connection with affiliated television broadcasts (*e.g.*, NBC and MSNBC), Defendant’s use of the mark BCBN in connection with services that are identical and closely related to those provided by Plaintiff is likely to cause confusion.
5. Whether Defendant’s use of the mark BCBN in connection with Defendant’s Auxiliary Goods is likely to cause dilution by blurring, thereby diluting the distinctive quality of Plaintiff’s famous mark CBN.

The Key Registrations That Frame the Issues

Plaintiff has made six registrations of record by way of Plaintiff’s First Notice of Reliance, but the following three registrations are sufficient to demonstrate the likelihood of confusion and dilution present in this case:

1. Incontestable U.S. Trademark Registration No. 1108225 for the mark CBN for “television broadcasting services” in international class 38 and for “entertainment services in the nature of televised religious, educational, news and variety programs” in international class 41.
2. Incontestable U.S. Trademark Registration No. 2087580 for the mark CBN for “educational services, namely, seminars, workshops and conferences in the fields of Christian living, finances, marriages, [veterans, and song writing]” in international

class 41 and for “Christian evangelical ministerial services including outreach, counseling, and discipleship” in international class 42.

3. U.S. Trademark Registration No. 5286207 for the mark CBN for “charitable fundraising” in international class 36.

Brief Background and Summary of the Evidence

Plaintiff began using the mark CBN in 1961. In a precedential opinion issued in 2007, this Board held that Plaintiff’s mark CBN was a famous mark. In the intervening twelve years, the mark has certainly not lost any of its fame, as exemplified by extensive, nationwide use, advertising expenditures, and revenues. Highlights of this extensive use include: (1) Plaintiff’s CBN programming can be seen by 97% of U.S. households; (2) CBN’s flagship show has an average daily audience of 650,000; and (3) in 2018, Plaintiff sent out 14.5 million pieces of regular mail and 221.9 million emails displaying the CBN mark. The mark CBN, therefore, continues to be entitled to a wide scope of protection. Defendant’s mark BCBN adds one letter in front of Plaintiff’s exact mark. Defendant’s identifications of services are legally identical to Plaintiff’s registered services in both classes 36 and 41. Defendant’s services in class 38 are closely related to Plaintiff’s services in both classes 38 and 41, especially in view of the pervasive use by companies (and, well, almost everyone in the United States) of social media. Confusion is likely.

Moreover, the common practice of broadcasting companies to add a letter or letters to their main trademarks in connection with affiliated broadcasts (e.g., NBC and MSNBC; ESPN and ESPNU; CBS and CBSSN) simply adds greater weight to tip the *DuPont*-factor scale decisively in Plaintiff’s favor. And the fame of Plaintiff’s mark, along with both the distinctive nature of Plaintiff’s mark and Plaintiff’s substantially exclusive use, makes Defendant’s use of its mark in connection with the plethora of Defendant’s Auxiliary Goods likely to cause dilution by blurring.

ARGUMENT

I. STANDARD FOR DETERMINING LIKELIHOOD OF CONFUSION

A determination of likelihood of confusion is a legal conclusion based on underlying facts. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 U.S.P.Q.2d 1842, 1843-44 (Fed. Cir. 2000) (citation omitted). This determination is made based on the thirteen factors set forth in *In re E.I DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973), the relevant ones of which are bolded below:

- (1) **The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.** (Addressed below; favors Plaintiff)
- (2) **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.** (Addressed Below; favors Plaintiff)
- (3) **The similarity or dissimilarity of established, likely-to-continue trade channels.** (Addressed Below; favors Plaintiff)
- (4) **The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.** (Addressed below; favors Plaintiff)
- (5) **The fame of the prior Mark (sales, advertising, length of use).** (Addressed Below; favors Plaintiff)
- (6) **The number and nature of similar marks in use on similar goods.** (Addressed Below; favors Plaintiff)
- (7) **The nature and extent of any actual confusion.** (Neutral)
- (8) **The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.** (Neutral)
- (9) **The variety of goods on which a Mark is or is not used (house Mark, “family” Mark, product Mark).** (Addressed Below; favors Plaintiff)
- (10) The market interface between applicant and the owner of a prior Mark. (N/A)
- (11) **The extent to which applicant has a right to exclude others from use of its Mark on its goods.** (Addressed Below; favors Plaintiff)

(12) **The extent of potential confusion, i.e., whether de minimis or substantial.**
(Addressed below; favors Plaintiff)

(13) Any other established fact probative of the effect of use. (N/A)

Id. at 1361, 177 USPQ at 567 (emphasis added).

II. CONFUSION IS LIKELY HERE WITH RESPECT TO DEFENDANT'S SERVICES

A discussion of each of the applicable *DuPont* factors follows. The factors weigh heavily in Plaintiff's favor. For purposes of efficiency, the first two factors and the fifth factor are treated out of order. The first two factors are the most important factors, and the fifth factor can be (and is in this case) entitled to great weight. Indeed, it is well-settled law that two "key" considerations in any likelihood of confusion analysis are the similarities or dissimilarities between the good/services and the similarities or dissimilarities between the marks. *Alfacell Corp. v. Anticancer, Inc.*, 71 U.S.P.Q.2d 1301, 1304 (TTAB 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (CCPA 1976).

In addition, the fifth factor, fame of the senior mark, "plays a dominant role in the likelihood of confusion analysis" if it exists. *The Christian Broadcasting Network, Inc. v. ABS-CBS Int'l*, 84 U.S.P.Q.2d 1560, 1567 (TTAB 2007); *see also Recot, Inc. v. Bector*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1898 (Fed. Cir. 2000) ("Although fame alone cannot overwhelm the other *DuPont* factors as a matter of law, *see University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.3d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983), fame deserves its *full measure of weight* in assessing likelihood of confusion" (emphasis added)). Moreover, "the proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public." *Palm Bay Imports, Inc., v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1375, 73 U.S.P.Q.2d 1689, 1695 (Fed. Cir. 2005).

A. Plaintiff's CBN Mark is Famous (*DuPont* factor #5)

This Board has previously held that Plaintiff's CBN mark is famous. The Board stated as follows:

Based on the facts that petitioner's programming is regularly viewed in 16% of the homes in the United States, that its viewership is nearly twice that of MSNBC and CNN (except for LARRY KING LIVE and the show following LARRY KING LIVE), that petitioner has had substantial revenues and advertising expenses, and that the CBN mark is prominently displayed in all of petitioner's activities, petitioner has established that the CBN mark is famous for television broadcasting services and evangelical services, and therefore is entitled to a wide scope of protection.

The Christian Broadcasting Network, 84 U.S.P.Q.2d at 1567.

Indeed, Plaintiff has used the mark CBN in commerce in connection with television broadcasting services, entertainment services, and educational services since at least as early as 1969. (9 TTABVUE at ¶ 3-4.) Plaintiff has used the mark CBN in commerce in connection with charitable fundraising since at least as early as 1961. (*Id.* at ¶ 7.) Over those many years, the mark CBN has become a famous mark, as demonstrated by this Board's previous finding and the exemplary evidence made of record again, and supplemented for the passage of time, in the present case.

In that regard, both Gordon Robertson, Plaintiff's CEO, and Dr. Mihai Bocarnea, Plaintiff's Vice President of Research, testified in the present case and presented documentary evidence about the extensive, nationwide use, advertising, and sales under the CBN trademark. By way of example, Plaintiff's programming associated with the CBN marks can be seen in 97% of U.S. households. (7, 8 TTABVUE at ¶ 4.) As of 2006, compared with MSNBC and CNN, the number of viewers for CBN's flagship program, The 700 Club, was nearly twice the audience of programs broadcast on those networks, with the exception of Larry King Live. (*Id.* at ¶ 3.) The *daily* average audience for CBN's most popular television shows in 2018, The 700 Club and the 700 Club

Interactive, was about 650,000 households. (*Id.* at ¶ 4.) Plaintiff's Exhibit 23 demonstrates the consistently large viewing audience for The 700 Club and The 700 Club Interactive. (*Id.* at ¶ 13, Ex. 23.) In 2018, Plaintiff's websites associated with the CBN mark, including CBN, CBN News, and Superbook, received approximately 4.7 million unique visitors per month from around the world. (*Id.* ¶ 4.) In 2018, Plaintiff sent out approximately 14.5 million pieces of mail displaying the CBN mark and approximately 221.9 million emails also displaying the CBN mark. (*Id.*)

In addition, Plaintiff's revenues and advertising expenditures associated with CBN television and internet programming have been extensive over the years. Plaintiff's Dr. Bocarnea testified in detail about these numbers, as reflected in Plaintiff's Exhibits 16, 17, 18, 19, and 25. Although Plaintiff will not report all of those numbers in this brief (which is not filed under seal), suffice it to say that, over the past several years, Plaintiff's revenues have approached or exceeded \$175 million per year. (7, 8 TTABVUE at Ex. 17.) In addition, over the past several years, Plaintiff's overall advertising expenses have approached or exceeded \$75 million per year. (7 TTABVUE at ¶ 8, Ex. 18, Ex. 19.) Plaintiff's Exhibit 25 demonstrates that a large percentage of Plaintiff's revenue is generated by internet advertising. (23 TTABVUE at Ex. 25.)

The CBN mark is used prominently with Plaintiff's programming, mailings, and advertising. Plaintiff's Mr. Robertson explained that the CBN mark is used prominently on paper mailers and emails. (9 TTABVUE at ¶ 14.) Dr. Bocarnea testified that 90% of Plaintiff's direct mailings utilize the CBN mark prominently. (23 TTABVUE at ¶ 2.) Mr. Robertson also explained that each episode of The 700 Club, Plaintiff's flagship television variety show, begins with a visual and audio statement that "The following programming is presented to you by CBN." (9 TTABVUE at ¶ 15.) Mr. Robertson also testified that the CBN mark is used prominently and frequently in all CBN programming. (*Id.*)

CBN is a major broadcasting network, which has had its own White House correspondents and currently has 8 reporters with press credentials at the White House. (9 TTABVUE at ¶ 16.) Over the years, Plaintiff’s television programs have featured many interviews with prominent celebrities and political figures, including former House Speaker Paul Ryan, Denzel Washington, Oprah Winfrey, Angelina Jolie, Tim Tebow, Kathie Lee Gifford, and Tyler Perry, among many others. (9 TTABVUE at ¶ 18.)

B. The Similarity of the Parties’ Respective Services (*DuPont* factor #2)

The second *DuPont* factor is: “The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use” Since “Board proceedings are concerned with registrability and not use of a mark, . . . the identification of [services] in the respective registrations . . . frames the issue.” *Alfacell*, 71 U.S.P.Q.2d at 1304. The parties’ services are legally identical with respect to classes 36 and 41. With respect to the services listed in international class 38, while the services are not legally identical, they are still closely related, and therefore this second *DuPont* factor weighs strongly in Plaintiff’s favor.

i. The Services Are Legally Identical With Respect to International Classes 36 and 41

With respect to the parties’ services in international classes 36 and 41, the services are legally identical, and therefore this second *DuPont* factor weighs decidedly and completely in Plaintiff’s favor. Plaintiff’s services, identified in its pleaded registrations, include: (1) “entertainment services in the nature of **televised** religious, educational, news and **variety programs**” in international class 41 for Reg. No. 1108225; (2) “**charitable fund raising**” in international class 36 for Reg. No. 5286207; and (3) “educational services, namely, seminars, workshops, and conferences in the fields of Christian living, finances, and marriages” in

international class 41 for Reg. No. 2087580. Defendant's services correspondingly include: (1) "entertainment, namely, in the nature of **variety television shows**" in international class 41; (2) "**charitable fund raising**, namely, charitable collections, management and monitoring of charitable funds" in international class 36; and (3) "education relating to children, namely, conducting classes, seminars, and instructions in the field of bullying prevention or promoting friendliness" in international class 41.

As shown by the words in bold above, Plaintiff's and Defendant's services in international classes 36 and 41 are nearly literally identical. Indeed, exact identity is not even required for legal identity, though it is for all intents and purposes present here. *See Alfacell*, 71 U.S.P.Q.2d at 1304 (holding that "pharmaceuticals, namely, cancer-treating drugs" are "legally identical" to "therapeutic compositions containing reagents for in vivo anti-cancer use"). In *Alfacell*, the respondent argued that the parties' legally identical goods (i.e., cancer-treating drugs) looked in real life "dramatically" different from one another and were used in distinct treatment regimes, but the Board stated that, "[s]imply put, these distinctions are of little moment in our likelihood of confusion analysis which, to reiterate, is based on a comparison of the goods as identified in the involved registrations. Moreover, the question is whether the relevant classes of purchasers are likely to confuse the source of the goods, not the goods themselves." *Id.* at 1305.

There can be no doubt that Defendant's class 36 "charitable fundraising services, namely, charitable collections, management and monitoring of charitable funds" are legally identical to Plaintiff's class 36 "charitable fundraising services," or that Defendant's class 41 "variety television shows" are legally identical to Plaintiff's class 41 "televised variety programs." In addition, the parties' respective educational services overlap, as it is certainly not a stretch to conclude that anti-bullying is part of Christian living. Moreover, Gordon Robertson testified about

Plaintiff's own anti-bullying campaigns directed to children and their parents, and he included several exhibits demonstrating the same. (9 TTABVUE at ¶¶ 12-13, Exs. 10-13.) The Board treats encompassed or overlapping services as legally identical, and therefore Defendant's educational services are also legally identical to Plaintiff's educational services. *See Rocket Trademarks Pty Ltd. v. Phard S.P.A.*, 98 U.S.P.Q.2d 1066, 1073-1074 (TTAB 2011) (finding that goods listed in an application that "overlap" or are "encompassed by" goods listed in opposer's registration are "legally identical."); *see also Legacy Health v. Western States Lodging & Mgmt., L.C.*, 2015 TTAB LEXIS 172, *25-26 (TTAB June 3, 2015); *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 U.S.P.Q.2d 1913, 1917 (TTAB 2015) (finding that identified services that "overlap" were "identical-in-part").

Importantly, "[i]n the context of likelihood of confusion, it is sufficient to find likelihood of confusion as to the entire class if likelihood of confusion is found with respect to use of the mark on any item in a class that comes within the description of goods." *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1745 (TTAB 2014). "[I]f priority and likelihood of confusion are established as to any of the goods or services identified in an opposed class of goods or services, the opposition to registration of the mark as to all of the goods or services identified in that class will be sustained." *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 U.S.P.Q.2d 1844, 1847 n.9 (TTAB 2004). Thus, Defendant's services listed in international classes 36 and 41 are legally identical to Plaintiff's registered services.

ii. The Parties' Services Are Closely Related With Respect to International Class 38

Plaintiff's services registered in class 38 are identified as "television broadcasting services." Defendant's services in international class 38 include "communication by electronic communications networks on social media platforms for social networking." Accordingly,

“television broadcasting” is closely related to “communication by electronic communications networks on social media platforms for social networking” because the public expects television broadcasters to have social media presences.

A “likelihood of confusion can be found ‘if the respective products are related in some manner and/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. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 U.S.P.Q.2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1724 (TTAB 2007)). In *On-Line Careline, Inc. v. Am. Online, Inc.*, the Federal Circuit affirmed the Board’s finding that providing internet connection services was related to providing internet content, although the two services were different. 229 F.3d 1080, 1086-87, 56 U.S.P.Q.2d 1471, 1475-76 (Fed. Cir. 2000). In *On-Line Careline*, the Federal Circuit found that, “although the services are different, it is reasonable to believe that the general public would likely assume that the origin of the services are the same.” *Id.*

In this case, the general public would likely assume that the sources of the identified services are the same, as many (if not all) television broadcasting companies, including Plaintiff, have social media presences. For example, Plaintiff’s Mr. Robertson explained that “CBN, as do almost all companies today, including other television broadcasters, has a large social media presence. Indeed CBN has had a Facebook, Instagram, Twitter, You Tube and Pinterest account since approximately April 2010, May 2015, February 2009, March 2008, and February 2014, respectively.” (9 TTABVUE at ¶ 11, Ex.11.) Additionally, CBN.com, Plaintiff’s home web page, invites the public to follow CBN on social media. (10 TTABVUE at 1, Ex. 1.) Further, the evidence demonstrates that it is common for television broadcasters to have social media presences, and that many television broadcasters also direct the public to their social media accounts. For example,

Plaintiff's Second Notice of Reliance identified numerous television broadcasters, including CBS, NBC, CNBC, MSNBC, NBCSPORTS, and ESPN, which also invite the public to follow them on social media. (10 TTABVUE at 1-2, Ex. 1 Part 2.) Thus, the general public would likely assume that a company providing television broadcasting services is likely to engage in communication on social media platforms.

C. The Parties' Marks Are Similar As to Appearance, Sound, Connotation, and Commercial Impression (*DuPont* factor #1)

This factor, too, weighs heavily, if not decidedly, in Plaintiff's favor. That is especially the case with respect to the services listed in international classes 36 and 41, since the parties' services in those classes are legally identical. "When marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v Century Life of America*, 970 F.2d 874, 877, 23 U.S.P. Q.2d 1698, 1700 (Fed. Cir. 1992); *Alfacell*, 71 U.S.P.Q.2d at 1305. With respect to the services listed in international class 38, as explained above, the services are still closely related and likely to be considered by the public to emanate from the same source. *North Face Apparel Corp. v. Neus Trading, Inc.*, 2011 TTAB LEXIS 299, *12 (TTAB September 20, 2011) ("we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion") (citing *Century 21*, 970 F.2d 874).

Considering the marks in their entireties, the marks are quite similar as to sound and appearance. Indeed, the only difference between the marks is the addition of the single letter "B" before CBN. Moreover, as discussed directly below, the evidence of record demonstrates the similarity in connotation and commercial impression, and there is no evidence to the contrary.

As to the connotation of the marks, the common term, CBN, is a distinctive term. This is true as a matter of law because Plaintiff's CBN marks have become incontestable. *See, e.g., Park'n*

Fly, Inc. v. Dollar Park And Fly, Inc., 469 U.S. 189, 196 (1985) (“The language of the Lanham Act also refutes any conclusion that an incontestable mark may be challenged as merely descriptive.”); *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 210 (2000). Because the common term of the parties’ marks (i.e., CBN) is distinctive, the likelihood of confusion increases. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (In comparing the marks VEUVE CLICQUOT and VEUVE ROYAL, the Court stated that “[h]ere, the common term—VEUVE—is distinctive, and as such its presence in both parties’ marks enhances the likelihood of confusion.”).

Indeed, as BCBN entirely incorporates CBN and only adds the single letter “B” (such that the mark CBN comprises 75% of the mark BCBN), the commercial impressions conveyed by the marks are quite similar. “Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark.” *In re Celestial Movie Channel Ltd.*, 2008 TTAB LEXIS 714, *13-23 (TTAB Feb. 19, 2008) (Finding KCFX similar and likely to be confused with CFX); *In re MingShih Chao*, 2016 TTAB LEXIS 231, *8 (TTAB May 27, 2016) (finding APXX and APX similar, stating “because both marks consist of the three identical letters in the same sequence, they convey very similar commercial impressions.”); *Softel Commc’ns., Inc. v. Isoftel, Inc.*, 2005 TTAB LEXIS 534, *9-10 (TTAB Dec. 5, 2005) (finding ISOFTEL similar to SOFTEL); *see also In re Densi*, 225 U.S.P.Q. 624, 625-626 (TTAB 1985) (PERRY’S PIZZA for restaurant services specializing in pizza and PERRY’S for restaurant and bar services); *Johnson Publ’g Co., Inc. v. International Development Ltd.*, 221 U.S.P.Q. 155, 156 (TTAB 1982) (EBONY for cosmetics similar to EBONY DRUM for hairdressing and conditioner); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 U.S.P.Q.2d 1816, 1823-25 (TTAB 2015) (finding WINEBUD similar to BUD).

The evidence of record further demonstrates the similarity in the commercial impressions of the parties' respective marks made on the members of the public. Of particular note, many television broadcasters combine new letters with their main trademarks for affiliated broadcasts. Plaintiff's First Notice of Reliance provided several well known examples, such as: CBS with CBSSN; NBC with MSNBC, CNBC with NBCSN; and ESPN with ESPNU. (6 TTABVUE; 13 TTABVUE.) Accordingly, the public is likely to assume that CBN has similarly added a letter to the beginning of its main trademark, and therefore associate BCBN with the services already associated with the CBN mark.

Finally, in keeping with the precept that fame is entitled to great weight in the overall likelihood of confusion analysis, the Board has held that marks are more likely to be considered similar when one mark is famous, as is the CBN mark (discussed above). *See Inter IKEA*, 110 U.S.P.Q.2d at 1741 (TTAB 2014) ("In view of the foregoing, we find that the marks are similar when considered in light of a purchaser's general recollection or imperfect recall of marks and the absence of a situation whereby side-by-side comparisons of the marks would be readily available. This is especially true in this case where we have found opposer's IKEA mark to be famous for certain services and, as discussed above, the fame of opposer's mark necessarily weighs heavily in opposer's favor.")

D. The Established, Likely-to-Continue Trade Channels Weigh In Favor of a Likelihood of Confusion (*DuPont* factor #3)

This third *DuPont* factor also weighs heavily in Plaintiff's favor. With respect to the services in international classes 36 and 41, this is true as a matter of law. If the "identification of goods do not include any limitations, it is assumed that the goods move through the same trade channels, namely all trade channels normal for goods of this type" *Alfacell*, 71 U.S.P.Q.2d at 1305; *The Christian Broadcasting Network, Inc. v. ABS-CBS Int'l*, 84 U.S.P.Q.2d 1560, 1568

(TTAB 2007) (“Because there are no restrictions as to the channels of trade in petitioner’s registrations pertaining to television broadcasting services, we must consider petitioner’s television broadcasting services as if they were rendered in all of the normal channels of trade to all of the normal purchasers of such services”).

For international class 36, there are no restrictions in either the Plaintiff’s or the Defendant’s identifications of services with respect to the classes of purchasers or trade channels. And for international class 41, Plaintiff’s and Defendant’s entertainment services are not restricted as to televised variety programs. To the extent that Defendant alleges that its educational services are restricted to “children” and Plaintiff’s services are restricted to “Christian living, finances [and] marriage,” at a minimum the trade channels overlap, and thus are legally “identical-in-part.” *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 U.S.P.Q.2d 1913, 1917-1918 (TTAB 2015) (finding that identified services that “overlap” were “identical-in-part” and stating that “[b]ecause the services described in the application and the cited registration are identical-in-part, we must presume that the channels of trade and classes of purchasers overlap as well.”)

Additionally, this Board has recognized that adult parents are often the actual purchasers of goods and services for children. *See, e.g., In re Hope Found. for A Better Tomorrow, Inc.*, 2019 TTAB LEXIS 107, *22 (TTAB April 4, 2019) (“it is likely that adult consumers who are parents or educators would encounter Applicant’s services [directed to children] in the course of searching for programs, after-school programs, and summer camps on behalf of their middle and high school students”); *In re USCANTEEN, Inc.*, 2010 TTAB LEXIS 87, *5 (TTAB April 7, 2010) (“As to the classes of purchasers, we note that the purchase of children’s clothing is often undertaken by the parents of the children. Thus, to the extent that many adults are parents (and certainly most parents are adults), the classes of purchasers overlap.”)

With respect to the services identified in international class 38, the evidence shows that the trade channels for Plaintiff's "television broadcasting" overlap with the trade channels for Defendant's "communication by electronic communications networks on social media platforms for social networking." As set forth in Plaintiff's Second Notice of Reliance, television broadcasting companies – and, indeed, pretty much all companies these days – have social media presences and direct the public to their social media pages. (10 TTABVUE at 1-2, Exhibit 1 Part 2; 9 TTABVUE at ¶ 11.) In that regard, and as mentioned above, Plaintiff has had Facebook, Instagram, Twitter, You Tube and Pinterest accounts associated with its television broadcasting services for many years now (9 TTABVUE at ¶ 11.), and Plaintiff has also posted numerous articles about anti-bullying on social media, which Defendant claims is one of its main subjects. (*Id.* at ¶ 12.)

Additionally, Plaintiff has a large web presence in accordance with its television broadcasting services. Plaintiff's Mr. Robertson explained that CBN's main website at CBN.com includes various material related to its television broadcasting services, such as its The 700 Club television program (*Id.* at ¶ 11, Ex. 9), and Plaintiff has published numerous articles related to the prevention of bullying on its website as well. (*Id.* at ¶ 12, Ex. 10.)

E. The Audience Is, On Average, Not Sophisticated (*DuPont* factor #4)

The fourth *DuPont* factor is: "The conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." This factor favors Plaintiff, or is at least a neutral factor in the balance. As the Board previously found in 2007, "[i]n view of the nature of [Plaintiff's] services, and [Plaintiff's] testimony that its services are rendered to the general television viewing public, the relevant viewers would be expected to exercise nothing more than ordinary care in purchasing or viewing decisions." *The Christian Broadcasting Network*, 84

U.S.P.Q.2d at 1568.² Additionally, based on current demographic data, Plaintiff's audience remains broad in scope. Plaintiff's programming is distributed throughout the United States and all over the world. (9 TTABVUE at ¶ 2.) Demographic data shows that audiences for Plaintiff's main TV programs, The 700 Club and The 700 Club Interactive, have large and diverse audiences. (7, 8 TTABVUE at ¶ 10, Ex. 20.) Moreover, and importantly, the audience includes Christian and non-Christian members alike. (23, 24 TTABVUE at ¶¶ 4-5.) Thus, while within this broad scope of audience many viewers may not be impulse buyers, certainly any viewer who comes upon Plaintiff's broadcasts while "channel surfing," or information about the broadcasts while browsing the internet or social media, would indeed fall into the impulse buyer category.

Furthermore, even where there is evidence that some of the consumers at issue are sophisticated, evidence that some of the consumers are of average or below average sophistication requires that the least sophisticated consumer in the class must govern under the fourth *DuPont* factor. *See, e.g., Checkpoint Sys., Inc. v. Check Point Software Tech.*, 269 F.3d 270, 285, 60 U.S.P.Q.2d 1609, 1618 (3d Cir. 2001) ("If there is evidence that both average consumers and specialized commercial purchasers buy goods, there is a lower standard of care because of the lack of sophistication of some of the relevant purchasers."); *Alfacell*, 71 U.S.P.Q.2d at 1306; *Palm Bay Imports*, 73 U.S.P.Q.2d at 1695.

F. There Are No Similar Marks In Use In Connection With Similar Services (*DuPont* factor #6)

The sixth *DuPont* factor is: "The number and nature of similar marks in use on similar

² In his deposition, Plaintiff's Dr. Bocarnea testified that Plaintiff's loyal customers are "sophisticated" in that they "know what content they want" with regard to CBN programming in particular. (26 TTABVUE at 41.) Dr. Bocarnea was not testifying as to the legal definition of "sophisticated," nor was Dr. Bocarnea directing the comment to the broad scope of potential viewers as a whole, which would include channel surfers. His comment was directed to those who are already familiar with Plaintiff's content.

goods.” This factor, too, weighs in Plaintiff’s favor.

As Plaintiff’s Mr. Robertson testified, other than an entity named “Capitol Broadcast News” that tried to use the name “CBN”— which use Plaintiff successfully stopped by way of litigation—to Plaintiff’s knowledge, Plaintiff has always been, since its inception in 1961, the only television production company and the only entertainment services company in the United States that uses the mark CBN. (9 TTABVUE at ¶ 17.) In addition, there is no record evidence of any third-party use of the mark CBN in connection with any of the registered services or any similar services.

G. The Lack of Evidence of Actual Confusion is Neutral (*DuPont* factors #7 and #8)

The seventh and eighth *DuPont* factors, which make sense to discuss together in this case, are respectively: “The nature and extent of any actual confusion” and “The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” These factors are at least neutral for the reasons discussed below.

Of course it is well-settled law that Plaintiff need not present any evidence of actual confusion in order to find that a likelihood of confusion exists. *See, e.g., Hydrotechnic Corp. v. Hydrotech Int’l, Inc.*, 196 U.S.P.Q. 387, 392-93 (TTAB 1978); *Guardian Prods. Co. v Scott Paper Co.*, 200 U.S.P.Q. 738, 742 (TTAB 1979). Moreover, Defendant alleges that it only began using the BCBN mark in 2016 (22 TTABVUE at ¶ 3). Thus there has been minimal time for any actual confusion to occur. *See Cooper Indus., Inc. v. Repcoparts Usa, Inc.*, 218 U.S.P.Q. 81 (TTAB) (“in this case there has, in fact, been no extended history of contemporaneous use of [the marks] nor does the record offer sufficient details as to the nature and extent of applicant’s use to offer significant support for a conclusion, as per applicant’s cited cases, that confusion was not likely”); *Alltrade Inc. v. Star Pipe Products, Inc.*, 2001 WL 792699, at *4 (TTAB July 12, 2001) (“both opposer’s and applicant’s products have been in the market for just a few years. Thus, the chance

for actual confusion to have occurred has been minimal.”)

This Board has also recognized “that evidence of actual confusion is difficult to obtain.” *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 U.S.P.Q.2d 1826, 1834 (TTAB 2012). Additionally, given the minimal evidence of actual use produced by Defendant, there is little evidence that there has been opportunity for actual confusion. See Defendant’s Exhibits to the DeVeaux declaration (22 TTABVUE at Exs. A-M). It is very difficult to find in this evidence any use of the mark BCBN at all, other than a few, relatively obscure uses that appear to be ancillary to the mark “Be Cool Be Nice.” See *In Re Porous Media Corp.*, 2005 WL 363386, at *2 (Jan. 11, 2005) (“Applicant has not even indicated the number of air filters it has sold bearing its mark CHEMFLEX. For all this Board knows, applicant’s sales of its CHEMFLEX air filters could be so minimal that there has been no meaningful opportunity for actual confusion to even occur.”)

H. Plaintiff Has Also Used Its CBN Marks in Connection with a Variety of Other Goods and Services (*DuPont* Factor #9)

The ninth *DuPont* factor is: “The variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark).” Again, the record evidence relevant to this factor supports a finding of a likelihood of confusion.

In addition to Plaintiff’s decades-old use of its mark CBN for television broadcasting services, Plaintiff has used its CBN marks in a variety of other ways. Plaintiff makes extensive use of its CBN marks in connection with its website and social media accounts. (9 TTABVUE at ¶ 11.) Online, the CBN marks are used in connection with, among other things: The 700 Club; CBN NEWS programs for viewing and reading; various articles related to Christian living; information about CBN’s ministries of prayer, counseling, and humanitarian aid; various online Christian music radio stations including Superbook Radio, which is a station directed to children; and an animation series for children entitled “SUPERBOOK.” (*Id.*) Plaintiffs have also produced various

animated videos, including several DVDs, directed to, among other things, the topic of preventing bullying, in connection with the CBN marks. (*Id.* at ¶¶ 12-13.)

Plaintiff's Mr. Robertson has also testified he has personal knowledge that the CBN marks have been used in connection with the services identified in the pleaded registrations. (9 TTABVUE at ¶¶ 3-8.) For example, Plaintiff holds conferences and seminars on the topics of Christian living, finances, marriages, veterans, song writing, outreach, counseling, and discipleship. (*Id.* at ¶ 4.) Plaintiff receives approximately 178,000 calls per month from people who participate in prayer and counseling services. (*Id.*) Plaintiff also uses the registered mark CBN RADIO in commerce in connection with radio broadcasting. (*Id.* at ¶ 6.) Plaintiff also uses the registered CBN NEWS mark in commerce in connection with television shows and providing current event news via a global computer network. (*Id.* at ¶¶ 5, 8.)

Plaintiff extensively uses the CBN marks in connection with both regular mail and email communications to its viewers. Back in 2006, Plaintiff sent out approximately 20 million pieces of mail under the CBN name. (*Id.* at ¶ 14.) In 2018, Plaintiff sent out approximately 14.5 million pieces of mail displaying the CBN service mark and approximately 221.9 million emails which use the CBN mark prominently. (*Id.*)

I. Plaintiff Has Actively Policed Its Mark (*DuPont* Factor #11)

The eleventh³ *DuPont* factor is: "The extent to which applicant has a right to exclude others from use of its marks on its goods." This *DuPont* factor has been interpreted to consider the extent to which the prior user has policed its mark. *See, e.g., Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 13 U.S.P.Q.2d 1257, 1278 (S.D.N.Y. 1989). Here, again, this factor weighs heavily in Plaintiff's favor because Plaintiff has carefully policed its mark and has been successful in doing

³ There is no evidence in this case that applies to the tenth *DuPont* factor.

so. (9 TTABVUE at ¶ 17.)

Moreover, as mentioned above in connection with the sixth *DuPont* factor, Plaintiff has always been, since its inception in 1961, the only television production company and the only entertainment services company in the United States that used the mark CBN (9 TTABVUE at ¶ 17), and, again, there is no record evidence of any third-party use.

J. The Extent of Potential Confusion Is Substantial (*DuPont* Factor # 12)

The twelfth⁴ *DuPont* factor is: “The extent of potential confusion, i.e., whether de minimis or substantial.”

The extent of potential confusion here is substantial, and can in no way be characterized as “de minimis.” The parties’ programming reaches a wide audience. Plaintiff’s CBN programming can be seen in 97% of the households in the United States. (7, 8 TTABVUE at ¶ 4.) The average daily audience for Plaintiff’s most popular shows, *The 700 Club* and *The 700 Club Interactive*, was about 650,000 households in 2018. (*Id.*) Plaintiff’s programming associated with the CBN marks is also syndicated on over 90 TV stations across the United States, and can also be seen on smartphones, tablets, and smartTVs. (*Id.*) Plaintiff’s websites, which prominently display the CBN marks, receive approximately 4.7 million unique visitors per month from around the world. (*Id.*)

In addition, Defendant’s potential audience is also very large. Defendant’s Mr. DeVeaux testified that celebrities, such as Kendall Jenner, Willow Smith, Mark Jacobs, and Lenny Kravitz, as well as large entities such as Viacom Media Networks, and Unicef, have promoted the BCBN mark (22 TTABVUE at ¶ 15.), although it certainly appears from Defendant’s proffered evidence that these celebrities have promoted the “Be Cool Be Nice” mark, as opposed to the BCBN mark itself. Mr. DeVeaux also testified that the campaign associated with BCBN has garnered “a great

⁴ As to the thirteenth, and final factor, which is “any other established facts probative of the effect of use,” Plaintiff will rely, at this time, on the discussion of the other factors set forth in this brief.

amount of attention online.” (*Id.* at ¶ 16.)

K. Conclusion

For all of the above reasons, a likelihood of confusion exists here. Plaintiff therefore requests that the Board sustain Plaintiff’s opposition and refuse registration of Defendant’s Application Serial No. 79/975,367 for all of Defendant’s identified services.

III. DEFENDANT’S USE OF THE MARK BCBN IN CONNECTION WITH ITS PLETHORA OF AUXILIARY GOODS WILL LIKELY DILUTE PLAINTIFF’S FAMOUS CBN MARK

Plaintiff’s mark CBN was famous (and, therefore, distinctive) long prior to the date Defendant began to use the BCBN marks, and, as discussed more fully below, Defendant’s use of the mark BCBN in connection with its auxiliary goods is likely to blur the distinctiveness of Plaintiff’s CBN mark. *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 1886-90 (TTAB 2011).

A. Standard For Determining a Likelihood of Dilution By Blurring

To prevail on a claim of dilution, a plaintiff must prove: “(1) the plaintiff owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff’s famous mark; (3) the defendant’s use of its mark began after the plaintiff’s mark became famous; and (4) the defendant’s use of its mark is likely to cause dilution by blurring or by tarnishment.” *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 U.S.P.Q.2d 1497, 1501-02 (TTAB 2015).

B. Plaintiff’s CBN Mark Is Also Famous For Purposes Of Dilution

In order to establish fame for dilution purposes, a party must show that its mark “is widely recognized by the general consuming public of the United States.” 15 U.S.C. § 1125(c)(2)(A). The Lanham Act sets forth four factors that should be considered when determining whether a mark qualifies as “famous” for purposes of dilution: (1) the “duration, extent, and geographic reach of

advertising and publicity of the mark,” (2) the “amount, volume, and geographic extent of sales of goods or services under the mark,” (3) the “extent of actual recognition of the mark,” and (4) whether “the mark was registered.” *Id.*

As discussed above in Section II.A, Plaintiff’s CBN mark has already been held to be famous for purposes of the likelihood of confusion inquiry. In fact, this Board found that Plaintiff’s CBN mark is famous almost a decade before Defendant began using the mark BCBN. *See The Christian Broadcasting Network, Inc. v. ABS-CBS International*, 84 U.S.P.Q.2d 1560, 1567 (TTAB 2007). And, in the context of likelihood of dilution, Plaintiff’s extensive use and nationwide promotion of the mark CBN satisfies the above factors readily.

In that regard, for 50 years (since at least as early as 1969), Plaintiff has had a CBN branded television program airing every day. (9 TTABVUE at ¶ 15.) Moreover, The 700 Club—which begins each show with a prominent reference to the mark CBN—has aired Monday through Friday for approximately 58 years. (*Id.*) The CBN mark has been registered since at least 1978. (*Id.* at Ex. 1; 6 TTABVUE at Ex. 1; 13 TTABVUE.)

In addition, and as mentioned above, as of 2006, Plaintiff’s CBN programming could be viewed in 96% of U.S. households, and that number was 97% as of 2018. (7, 8 TTABVUE at ¶¶ 3-4.) In 2006, Plaintiff’s most popular show was viewed by an average of over 17 million unique households in the United States. (*Id.*) As of 2006, the number of viewers of The 700 Club was nearly twice the audience of programs broadcast on MSNBC and CNN, with the exception of Larry King Live. (*Id.*) As of 2018, The 700 Club is viewed by a daily average of approximately 650,000 households per day, and is syndicated on over 90 TV stations across the United States. (*Id.* at ¶ 4.) CBN’s programming can also be viewed online including a CBN YouTube channel, as well as on smartphones, tablets, and smartTVs. (*Id.* at ¶¶ 4, 12; 9 TTABVUE at ¶ 11.) Further,

as of 2006, Plaintiff's website at cbn.com received approximately 1.5 million unique visitors per month from around the world, and in 2018 the website received approximately 4.7 million unique visitors per month. (*Id.* at ¶¶ 3-4.)

As also explained above in Section II.A, Plaintiff's revenues in connection with CBN mark from the years 1980 through 2018 are reflected in Plaintiff's Exhibit 17. While Plaintiff will not report all of those numbers in this brief (which is not filed under seal), over the last 20 years, Plaintiff's revenue has approached or exceeded \$100 million per year. Plaintiff has extensively promoted its CBN mark for many years. For example, between 2003 and 2005, Plaintiff's advertising expenses were approximately \$67 million per year, and, during the last four years, advertising expenses approached or exceeded \$75 million per year. (7, 8 TTABVue at ¶¶ 7-8.)

Plaintiff also extensively uses the CBN marks in connection with mail communications to its viewers. Back in 2006, Plaintiff sent out approximately 20 million pieces of mail under the CBN name. (*Id.* at ¶ 3.) In 2018, Plaintiff sent out approximately 14.5 million pieces of mail displaying the CBN service mark and approximately 221.9 million emails doing the same. (*Id.* at ¶ 4.)

Significant actual recognition of Plaintiff's mark may thus be inferred from the strong record of public exposure to Plaintiff's CBN mark. *See, e.g., UMG Recordings*, 100 U.S.P.Q.2d at 1887 (inferring actual public recognition based on use of mark for almost 50 years, extensive nationwide sales of opposer's recordings as well as numerous concerts and television appearances featuring its music and artists and extensive nationwide promotion of mark through traditional advertising and sale of collateral goods); *N.Y. Yankees*, 114 U.S.P.Q.2d at 1503-04 (finding opposer's top hat mark (let alone the main YANKEES mark itself) famous based on its display during game broadcasts over 50 years, its display on the team website, and its association with

\$1.5 billion in sales over a 20 year period).

C. Defendant Is Using The BCBN Mark In Commerce

In this case, Defendants have admitted a date of first use of the BCBN marks of 2016. (22 TTABVUE at ¶ 3). Accordingly, for purposes of dilution, Defendant is using the BCBN mark in commerce. *See DC Comics v. Rivetti*, 2017 TTAB LEXIS 318, *15 (TTAB August 17, 2017).

D. Defendant's BCBN Mark Is Likely to Dilute the Distinctive Quality of Plaintiff's CBN Mark

The Lanham Act defines dilution by blurring as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). “Dilution by 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*, 100 U.S.P.Q.2d at 1888.

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 an association with the famous mark; and (6) any actual association between the marks. 15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

In this case, the first four factors highly favor a finding of a likelihood to dilute, and the last two factors do not outweigh the first four factors.

i. BCBN Is Highly Similar to CBN

The test for similarity in the dilution context is “whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *UMG Recordings*, 100 U.S.P.Q.2d at 1888. The marks in this case are highly similar, as addressed above (*see* Section II.C *supra*). Consumers are especially likely to conjure up the mark CBN when confronted with the use of BCBN because of the common practice of broadcasting companies to add letters to their main mark for affiliated broadcasts (*see* Section II.C, *supra*). *See, e.g., Research in Motion Ltd. v. Defining Presence Mktg. Group, Inc.*, 102 U.S.P.Q.2d 1187, 1198 (TTAB 2012) (finding same evidence establishing similar commercial impression for likelihood of confusion purposes also proved marks highly similar for dilution purposes).

ii. CBN is Highly Distinctive

As an incontestable mark, CBN is entitled to a presumption of distinctiveness. *See, e.g., Park’n Fly, Inc. v. Dollar Park And Fly, Inc.*, 469 U.S. 189, 196 (1985) (“The language of the Lanham Act also refutes any conclusion that an incontestable mark may be challenged as merely descriptive.”); *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 210 (2000). Moreover, the CBN mark is entitled to a presumption of inherent distinctiveness as it issued without a Section 2(f) showing of acquired distinctiveness. *See National Pork Board v. Supreme Lobster and Seafood Co.*, 96 U.S.P.Q.2d 1479, 1497 (TTAB 11, 2010) (incontestable mark that issued upon a claim of use without a 2(f) showing “is entitled to a presumption of inherent distinctiveness.”); *Nike Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1028 (TTAB 2011).

Further, the CBN mark is famous, and has acquired substantial distinctiveness over fifty years of widespread and exclusive use. *N.Y. Yankees*, 114 U.S.P.Q.2d at 1507 (“[W]e found above that the mark is famous, which necessarily subsumes a finding that the mark has high acquired distinctiveness”). Plaintiff has engaged in substantially exclusive use of the CBN mark for

approximately fifty years, and Plaintiff incorporates here by reference the extensive sales and advertising figures mentioned above and in evidence here.

iii. Plaintiff Is Engaging In Exclusive Use of the CBN Mark

As explained in Sections II.F and II.I above, Plaintiff has engaged in substantially exclusive use of the CBN mark for approximately fifty years. (*See* 9 TTABVUE at ¶ 17.), and there is no evidence of any third-party use of the mark CBN.

iv. The CBN Mark Is a Widely Recognized Famous Mark

As discussed in Sections II.I and IV.B above, the record reflects that CBN is a famous and widely recognized mark. Plaintiff incorporates here by reference the substantial evidence, outlined above, of public exposure of the CBN mark. The Board may infer substantial recognition of a famous mark. *See UMG Recordings*, 100 U.S.P.Q.2d at 1887, 1889 (inferring substantial recognition based on “extensive” public exposure to the MOTOWN mark).

v. The Lack of Evidence of Bad Faith and Actual Association Do Not Outweigh the Other Factors

Defendant’s duration and extent of use of its BCBN mark have been minimal, and thus it is not surprising that there is a lack of evidence of actual association at this time. *See e.g., UMG Recordings*, 100 U.S.P.Q.2d at 1889-90 (“Because . . . applicant actually used its mark for only two years, there is no actual association shown between the marks.”); *N.Y. Yankees*, 114 U.S.P.Q.2d at 1509 (“[T]he record shows that Applicant has sold only 22 shirts bearing its marks. Thus, there has been a limited opportunity for the public to make any actual association between the parties’ design marks.”).

Further, these two factors do not outweigh the other four factors, which strongly favor finding a likelihood of blurring in this case. This is especially true given that, as noted above, Defendant’s use of the mark BCBN, as opposed to BE COOL BE NICE, has been paltry at best.

See e.g., UMG Recordings, 100 U.S.P.Q.2d at 1889-90 (“Because . . . applicant actually used its mark for only two years, there is no actual association shown between the marks, nor is there evidence of a bad faith intent in applicant’s adoption of its mark. However, these latter two factors do not outweigh the other dilution factors noted herein.”); *Nike*, 100 U.S.P.Q.2d at 1031 (“While there does not appear to be an actual association between the marks (nor could there be at present because applicants' mark is not yet in use), and the record does not reflect a bad faith intent on applicants’ part in adopting the mark, these two factors do not outweigh the other dilution factors.”).

E. Conclusion

For the reasons explained above, Defendant’s BCBN mark is likely to dilute the distinctiveness of Plaintiff’s famous CBN mark. Plaintiff therefore requests that the Board sustain Plaintiff’s opposition and refuse registration of Application Serial No. 79/197,514 for Defendant’s Auxiliary Goods.

CONCLUSION

For all of the foregoing reasons, the Opposition should be sustained in favor of Plaintiff.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I do hereby certify that on September 30, 2019, I filed via electronic means (ESTTA) this
PLAINTIFF'S TRIAL BRIEF with the:

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