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

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 REPLY BRIEF

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Thomas McCarthy,
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Plaintiff, The Christian Broadcasting Network, Inc. (“Plaintiff”), hereby replies to Defendant, Delicious Ltd.’s (“Defendant”) Trial Brief (filed on October 31, 2019) as follows:

1. Defendant ignored controlling law, which holds that the identification of the services in the registrations/applications determines the similarity of the services (*DuPont* factor #2). Plaintiff explained in its main brief that since “Board proceedings are concerned with registrability and not use of a mark, . . . the identification of [services] in the respective registrations . . . frames the issue.” (28 TTABVUE at 9 (quoting *Alfacell Corp. v. Anticancer, Inc.*, 71 U.S.P.Q.2d 1301, 1304 (TTAB 2004)). Plaintiff explained that under this controlling law the parties’ services are legally identical with respect to international classes 36 and 41, and closely related with respect to international class 38. (28 TTABVUE at 9-13.)

Defendant ignores this controlling law, and instead focuses entirely on an alleged lack of similarity of the services in the “contexts in which they are offered in the marketplace.” (29 TTABVUE at 7.) This analysis is irrelevant in a case before this Board. In *Alfacell*, the respondent similarly argued that the parties’ goods “look dramatically different from one another.” 71 U.S.P.Q.2d at 1304-1305. The Board disregarded that argument, because such “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.” Notably, Defendant cited no cases refuting this controlling law. Defendant instead made arguments contrary to the law with no other support. (see 29 TTABVUE at 9 (“Opposer simply relies on an alleged overlap of goods in Classes 36, 38, and 41 – which does not decidedly tip the balance in Opposer’s favor, given the stark commercial differences between the parties’ use of their marks.”)). Defendant has failed to address Plaintiff’s arguments that are based on controlling law. Defendant has therefore conceded, as it must, that the parties’ services are legally identical with respect to international classes 35 and 41, and closely

related with respect to international class 38.

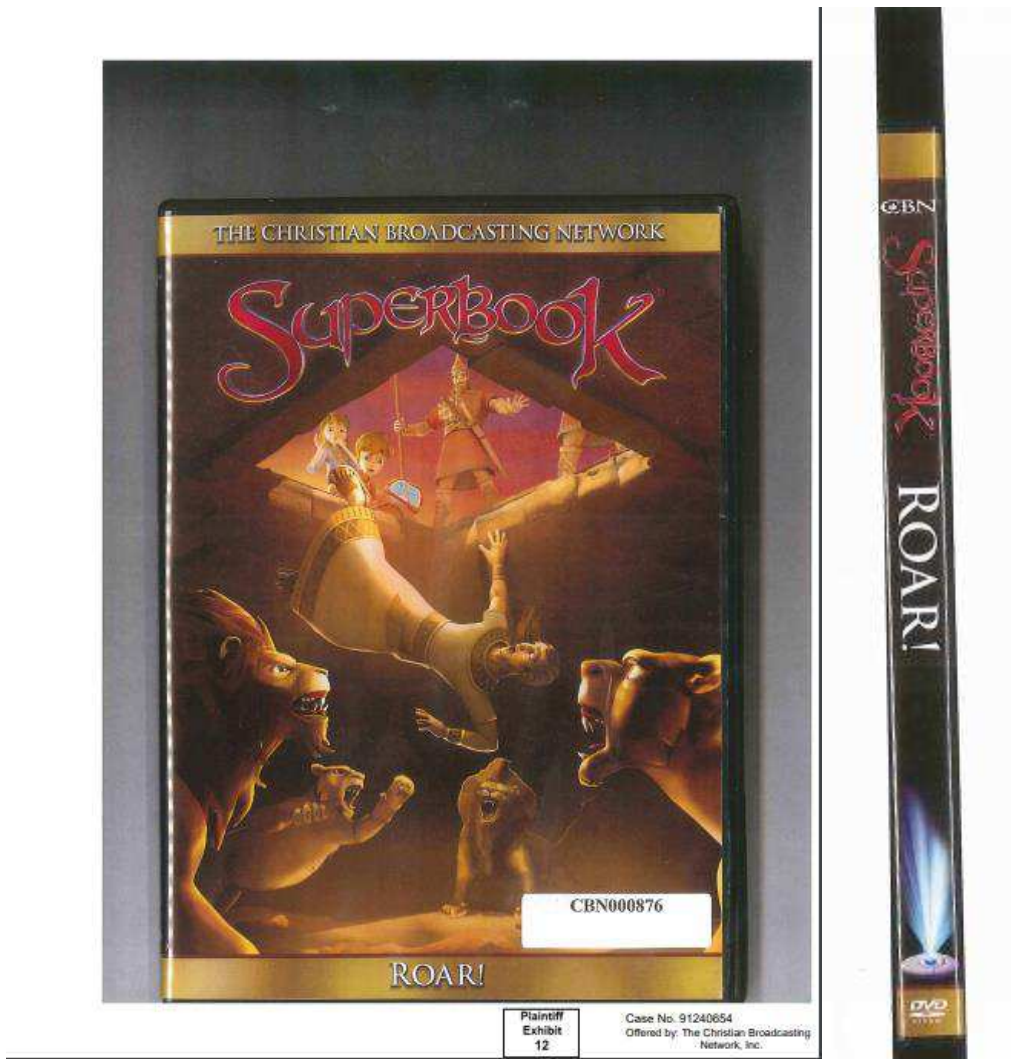
2. Defendant’s assertions that its services are directed to children is irrelevant.

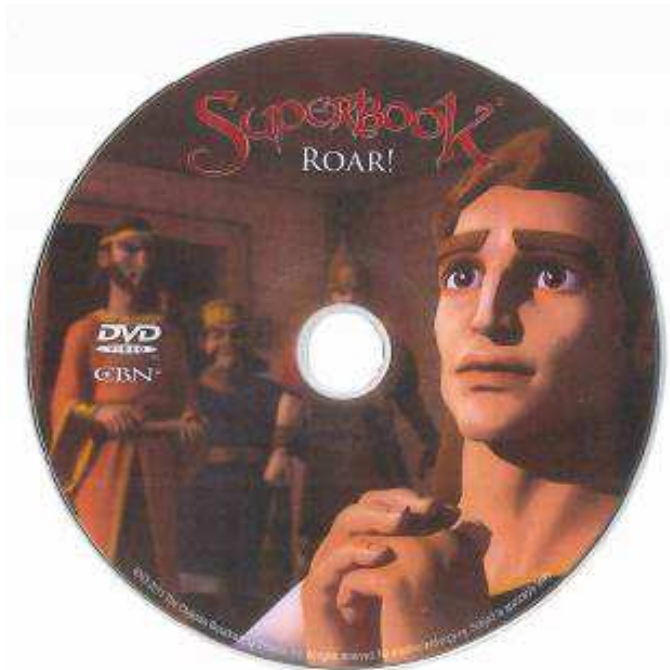
Defendant states several times that Defendant’s services are directed to children in an attempt to distinguish Defendant’s services from Plaintiff’s. (29 TTABVUE at 5, 8.) Plaintiff has already pointed out, however, that this distinction is irrelevant. (28 TTABVUE at 16.) This Board has recognized that 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.”) Defendant failed to address this point.

3. Plaintiff did provide evidence that Plaintiff produces content directed toward children that is branded with the CBN mark. Plaintiff cited evidence that it produces content directed towards children—including in connection with the topic of anti-bullying. (28 TTABVUE at 10-11, 17, 20-21.) Defendant incorrectly alleged “Opposer’s content that is directed toward children is not branded with the CBN mark, but with the mark SUPERBOOK.” (29 TTABVUE at 8.) Defendant cites to deposition testimony of Mr. Robertson to assert—incorrectly—that one of Plaintiff’s SUPERBOOK DVDs related to bullying, titled “ROAR!,” “is not even outwardly branded with the CBN mark.” *Id.* at 9. Defendant fails to mention, however, that Mr. Robertson testified that the CBN mark is displayed on the title page when the DVD is played. (25 TTABVUE

at 29:12-20.) Defendant also did not show the physical DVD itself to Mr. Robertson, which prominently displays the CBN mark. (*Compare* 9 TTABVUE at Ex. 12 *with* 25 TTABVUE at Ex. 4.)

In addition, the spine of the jacket of the “ROAR!” DVD is clearly branded with the CBN mark. (*See* 9 TTABVUE at Ex. 12.) Excerpts from Plaintiff’s exhibit 12, reproduced below, clearly show the CBN mark on the “ROAR!” DVD itself and the spine of the jacket.





(9 TTABVUE at Ex. 12.)

Further, Defendant cites Mr. Robertson's deposition testimony to argue that a SUPERBOOK figurine does not prominently display the CBN mark. (29 TTABVUE at 9.) Mr. Robertson's testimony makes the opposite point:

Q This is a Superbook figurine. It says David. Can you show me where on this packaging it's prominently branded with CBN or the Christian Broadcasting Network.

A (Indicating.)

Q Do you call that prominent?

A It's on the back, yes. It's on the package.

Q Does that mean it's prominent?

A I think that's prominent. . . . In my opinion, that's prominent. I turn it over, I see CBN. I can see it from across the room.

(25 TTABVUE at 31:11-32:1) Plaintiff also produced and cited numerous articles that Plaintiff has published, including on social media, related to children and bullying prevention, which is branded with the CBN mark. (9 TTABVUE at Exs. 10, 11.) Accordingly, the evidence of record disproves Defendant's assertion that Plaintiff's content directed to children is not branded with the CBN mark.

4. The Parties' Marks Are Similar As to Appearance, Sound, Connotation, and Commercial Impression (*DuPont* factor #1), and Defendant's attempt to link its mark to a slogan not mentioned in its applications must fail. As explained in detail in Plaintiff's main brief, Defendant's mark BCBN is quite similar to Plaintiff's mark CBN. (28 TTABVUE at 13-15.) Defendant argues that "Applicant's Mark is used in proximity to BE COOL BE NICE™ and understood to be an abbreviation thereof." (29 TTABVUE at 10.) Defendant also argues that "[c]onsumers encountering Applicant's Mark BCBN™ in its commercial context will understand it to be part and parcel of the BE COOL BE NICE™ kids' anti-bullying campaign." (*Id.*) Both of these arguments are irrelevant, however, based on the controlling law of this Board. In *Hercules Inc. v. National Starch and Chemical Corp.*, 223 U.S.P.Q. 1244, 1248 (TTAB Sept. 21, 1984), the applicant argued that the opposer "always" used the generic term in conjunction with its mark, and that both parties used their brand names in association with the marks at issue. The Board found those arguments "irrelevant" because "[w]hile such indications might be relevant in a civil action involving the question of infringement, their use in association with the marks is relevant in a proceeding concerning registrability only if they are included as a part of the mark as it is registered and as it is presented for registration." *Id.* (emphasis added). Here, the application for BCBN does not include BE COOL BE NICE, and thus Defendant's arguments regarding BE COOL BE NICE are similarly irrelevant.

Implicitly admitting that BCBN is nearly identical to CBN, Defendant cites *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1361 (Fed. Cir. 2012) for the proposition that "[e]ven where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity." But in *Coach Servs.* it was undisputed that the goods and services listed in the registrations were completely unrelated—educational

goods for the applicant versus luxury goods for the opposer. *Id.* at 1360-1362 (“It is undisputed that [opposer] is not in the education or test-preparation industry, [and] does not consider [applicant] a competitor”). The court explained in that case that the commercial impressions were different because the word COACH evokes carriage or travel accommodations when applied to luxury goods like travel bags, while the word COACH evokes a tutor when applied to education. *Id.* at 1369. In other words, the different commercial impressions were discernible on the face of the application and the registration. In this case, Defendant’s attempt to shoehorn the slogan BE COOL BE NICE into this analysis is simply legally wrong.

5. The marks are similar because BCBN completely contains CBN in the same sequence of letters. Defendant argues, somewhat curiously, that because marks that do not contain the string of letters CBN, such as NBC, do not give Plaintiff “cause for concern,” Defendant’s mark which does contain the string of letters CBN should not either. (29 TTABVUE at 11.) Plaintiff’s Mr. Robertson testified that the reason marks such as NBC do not concern Plaintiff is that the “sequence of letters is important” because of “top of mind recall.” (25 TTABVUE at 11:2-9.) As Plaintiff explained in its main brief (28 TTABVUE at 14-15), “[I]ikelihood 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 ISOFTTEL similar to SOFTTEL).

6. Defendant’s argument that 90 percent of Plaintiff’s audience is outside the

U.S. is irrelevant. Defendant makes the point that Mr. Robertson stated that 90 percent of Plaintiff's audience is outside of the United States (29 TTABVUE at 12). But this statement is meaningless absent the context of how many people are included in that 10% in the United States, especially considering that less than 5% of the world's population is located in the United States. In reality, Plaintiff produced and cited more than sufficient evidence to demonstrate both the size of CBN's U.S. market and that the CBN mark is famous. (28 TTABVUE at 7-9.) Indeed, this Board has already held that the CBN mark is famous. *The Christian Broadcasting Network, Inc. v. ABS-CBS Int'l*, 84 U.S.P.Q.2d 1560, 1567 (TTAB 2007).

7. The lack of actual confusion is neutral, given the paucity of evidence of use of the BCBN mark. Defendant concedes that the "probative value of the absence of actual confusion depends on there being a significant opportunity for actual confusion to occur." (29 TTABVUE at 13.) While Plaintiff admits in its main brief that Defendant's "potential audience is [] very large," Plaintiff specified that "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." (28 TTABVUE at 22.) And as Plaintiff previously explained in its main brief (28 TTABVUE at 20), "[i]t is very difficult to find in [Defendant's produced] 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.'" (28 TTABVUE at 20 (citing 22 TTABVUE at Exs. A-M).) Thus, Defendant's statement that "Opposer admits that Applicant's Mark has garnered significant attention" (29 TTABVUE at 13) is false.

8. Defendant concedes that *DuPont* factors 3, 4, 6, 9, 11, and 12 favor finding a likelihood of confusion. Plaintiff met its burden to show that *DuPont* factors 1, 2, 3, 4, 5, 6, 9, 11, and 12 favor a finding of likelihood of confusion. (28 TTABVUE at 5-23.) Of those factors,

Defendant only addressed *DuPont* factors 1, 2, and 5 in its trial brief. Defendant therefore concedes that factors 3 (the similarity or dissimilarity of established, likely-to-continue trade channels), 4 (the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing), 6 (the number and nature of similar marks in use on similar goods), 9 (the variety of goods on which a Mark is or is not used (house Mark, “family” Mark, product Mark)), 11 (the extent to which applicant has a right to exclude others from use of its Mark on its goods), and 12 (the extent of potential confusion, i.e., whether de minimis or substantial), all favor finding a likelihood of confusion. *In Re Morinaga Nyugyo Kabushiki Kaisha*, 120 U.S.P.Q.2d 1738, 1740 (T.T.A.B. 2016) (“Apparently conceding the issue, Applicant did not address these du Pont factors in its brief”).

9. This Board has already recognized that Defendant’s cited law requiring the marks to be “identical or very or substantially similar” for dilution by blurring was overturned by the 2006 TDRA. Defendant argues that for dilution by blurring the marks must be “identical or very or substantially similar,” and cites *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2D 1164, 1182 (TTAB 2001) for support. (29 TTABVUE at 15.) This Board has recognized, however, that after the 2006 Trademark Dilution Revision Act, substantial similarity is no longer required to find a likelihood of dilution. *UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2D 1868, 1888 (TTAB 2011) (“Under the 2006 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. . . .’” (quoting *Nike Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1029-30 (TTAB 2011))). The proper question for dilution purposes is “whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when

confronted with the second mark.” *Id.* In *UMG Recordings*, the Board used the same analysis for Section 2(d) and dilution purposes to find the respective marks sufficiently similar.¹ *Id.*; *see also 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). In this case, the marks CBN and BCBN are highly similar, as Plaintiff previously explained. (28 TTABVUE at 13-15.)

10. Defendant’s argument that there can be no likelihood of dilution because Defendant’s goods are different from Plaintiff’s services is misplaced. Defendant makes arguments such as: “Opposer’s registrations do not cover, and Opposer has not claimed it uses its CBN-formative marks in connection with, the goods listed in Applicant’s application;” and “The goods recited in Applicant’s Application Serial No. 79/197,514, too, are entirely different from Opposer’s service offerings.” (29 TTABVUE at 16, 17.) These arguments are inapposite in the likelihood of dilution analysis, which is primarily concerned with situations where the respective goods or services are not competing. *See* 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.74 (“[T]o apply an antidilution law in a situation where the goods or services of the parties are competitive makes no sense. Like an attorney who wears his shoes on his hands for a court appearance, antidilution law is out of its proper place in a case of competing parties. What should be applied in such cases is traditional infringement law”); *see also Nike*,

¹ Even if “substantial similarity” was required to find a likelihood of dilution, the marks in this case would satisfy that standard. As explained, Defendant’s mark BCBN completely incorporates Plaintiff’s mark CBN in the same sequence and only adds a single letter, which is a common practice in television broadcasting. (28 TTABVUE at 14-15.) In *Toro*, the applicant’s mark was a design mark, which added a bull’s head and the letters MR. *Toro*, 61 U.S.P.Q.2D 1164 at 1183 (TTAB 2001).

100 U.S.P.Q.2d at 1031 (“The dilution doctrine was designed to provide a remedy where the goods or services involved were neither competitive nor necessarily related.”); *Research in Motion Ltd. v. Defining Presence Mktg. Group, Inc.*, 102 U.S.P.Q.2d 1187, 1200 (TTAB 2012) (finding a likelihood of dilution between opposer’s BLACKBERRY registrations for electronic messaging and electronic devices and applicant’s CRACKBERRY for clothing). Defendant’s cited case on this point, *Coach Servs. V. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600 (TTAB 2010) is distinguishable. In that case, the common word COACH had distinct meanings when applied to opposer’s goods, luxury goods such as handbags, and applicant’s services, educational tools. *Id* at 1613. Here, in contrast, neither BCBN nor CBN is a common word, nor is there any evidence that either evokes any particular meaning with respect to the goods and services at issue.

11. Plaintiff’s mark is famous for dilution purposes. Plaintiff met its burden to establish that its mark CBN is famous for likelihood of dilution purposes. (28 TTABVUE at 23-26.) Plaintiff explained in detail in its main brief why the CBN mark is famous in view of the four factors the Lanham Act sets out to determine fame for dilution. *Id*. Rather than make any genuine attempt at rebutting Plaintiff’s thorough argument, Defendant simply states with no support or evidence that it is “abundantly clear that any fame Opposer *does* enjoy exists only in the niche field of evangelical-focused services. . . .” (29 TTABVUE at 17.) This Board has already found Plaintiff’s CBN mark famous for at least “television broadcasting services” and “evangelical services.” *Christian Broadcasting Network*, 84 U.S.P.Q.2d at 1567. There are few services as ubiquitous in the public’s conscious as “television broadcasting services.” It is disingenuous on Defendant’s part to argue that “television broadcasting services” are a “narrow field.” (29 TTABVUE at 18); *see, e.g., N.Y. Yankees*, 114 U.S.P.Q.2d at 1503 (citing the fact that the Yankees Top Hat logo had been displayed on television broadcasts as evidence of fame).

Additionally, the evidence that Plaintiff produced and cited more than establishes that Plaintiff's CBN mark is famous, especially as compared to other marks that this Board has found famous for purposes of dilution. (28 TTABVUE at 23-26); *see 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).

CONCLUSION

For each of the above reasons and for those set out in Plaintiff's Trial Brief, the Board should sustain the Opposition and refuse registration of Application Serial Nos. 79/975,367 and 79/197,514.

Respectfully submitted,

Date: November 13, 2019

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CERTIFICATE OF SERVICE

I do hereby certify that on November 13, 2019, I filed via electronic means (ESTTA) this
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