

ESTTA Tracking number: **ESTTA1110095**

Filing date: **01/25/2021**

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

Proceeding	91240829
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Attachments	bmb bmu applicants trial brief.pdf(179481 bytes)

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

In the Matter of Trademark Application Serial Nos. 87547298; 87547487

Mark: BAD MOMS BIBLE; BAD MOMS UNLIMITED

Published: December 26, 2017; March 20, 2018

)	
STX FINANCING, LLC)	
OPPOSER)	
)	
v.)	Opposition No. 91240829
)	
STACEY MICHELLE TERRAZAS)	
APPLICANT)	
)	

APPLICANT’S TRIAL BRIEF

Pursuant to 37 C.F.R. §§ 2.126 and 2.128 and TBMP §§ 801.02 and 801.03, Applicant, Stacey Michelle Terrazas, by and through her counsel, hereby submits her trial brief in connection with this opposition proceeding.

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I. INTRODUCTION

Stacey Michelle Terrazas (Applicant) filed two applications with the United States Patent and Trademark Office on July, 28, 2017, Application Serial Nos. 87547298 and 87547487 for BAD MOMS BIBLE and BAD MOMS UNLIMITED respectively. The examining attorney assigned to the application, approved the applications on November 7, 2017 and February 7, 2018 respectively. STX Financing, LLC (Opposer) filed a Notice of Opposition on April 24, 2018. The Applicant will show by the evidence property of record and arguments presented that Applicant's marks, BAD MOMS BIBLE and BAD MOMS UNLIMITED, are not likely to cause confusion as to source, or dilution of Opposer's marks.

II. DESCRIPTION OF THE RECORD

The evidence properly on record in this opposition proceeding consist of the following evidence listed below:

- A. Third party registrations for the following registered marks: ICE AGE; ICE AGE; ICE AGE; ICE AGE; ICE AGE MEALS; ICE AGE SHIFTERS; DISNEY'S BEAUTY AND THE BEAST; BEAUTIES AND THE BEAST; BEAUTY & THE BEAST; THE BEAUTY AND THE BEAST; TITANIC; TITANIC CREATIONS; TITANIC HOTEL AND CASINO; TITANIC; TITANIC; JAWS; JAWS TWIST TIES; JAWS; JAWS; JAWS; JAWS; JAWS LADDER; JAWS OF LIFE; FAST & FURIOUS; FAST & FURIOUS; FAST & FURIOUS; FAST & FURIOUS; DISNEY FROZEN; FROHZEN;

FROZEN HAPPINESS; FROZEN LAKE; IRON MAN; IRONMAN; IRONMAN;
DISNEY ALADDIN; ALADDIN; ALADDIN; BLACK PANTHER; PLACK
PANTHER; BLACK PANTHER; BLACK PANTHER SAFARIS; SPECTRE;
SPECTRE; SPECTRE SHIELD; SPECTRE; SPECTRE; SKYFALL; SKYFALL;
SKYFALL LOUNGE; THE HANGOVER EXPERTS; THE HANGOVER; TOOTH
MONSTER INC; MONSTER INK; .

- B. Official office actions from the examining attorney for the following applications: Serial Nos. 87978144; 87978156; 87978157; 87562322; 87562646; 87562365; 87562399; 87562482; 87562530; 87562556; 87315506; 87562696; 87562582; 87562596; 87562616; 87562628; and 87562655.
- C. Internet articles and merchandise webpages of the following websites: facebook.com, etsy.com, radio.com, eventbrite.com, theatlantic.com, goodhousekeeping.com, books.google.com, abcnews.go.com, marvel.com, theparentcue.org, parenthood.topix.com, realclearpolitics.com, rockawaytimes.com, moonshineink.com, scottsdale.momcollective.com, cbs8.com, redbubble.com, pintrist.com, herviewfromhome.com, spreadshirt.com, and bonfire.com.
- D. Dictionary websites and internet articles on the following websites: anglefire.com, gramorphopia.com, usatoday.com, onlineslangdictionary.com
- E. Opposers responses to Applicant's First Set of Interrogatories.

III. STATEMENT OF THE ISSUES

- A. Whether registration of the Applicant's proposed trademarks, BAD MOMS BIBLE and BAD MOMS UNLIMITED when used in commerce is likely to cause confusion, mistake or to deceive as to source of the goods.
- B. Whether the Opposer's trademark is famous.
- C. Whether registration and use of Applicant's proposed trademark is likely to cause dilution of Opposer's trademarks.
- D. Whether Applicant lacks a bona fide intent to use the trademarks.

IV. STATEMENT OF FACTS

Stacey Michelle Terrazas (Applicant), filed an application for BAD MOMS BIBLE and BAD MOMS UNLIMITED trademarks on July 28, 2017. STX Financing, LLC (Opposer) first filed a Request for Extension to file an opposition on December 27, 2017. Opposer later filed a Notice of Opposition with the Trademark Trial and Appeal Board (Board) on April 24, 2018. Applicant answered the notice on May 22, 2018. Trial dates were set and then suspended pending Opposer's motion to to amend pleading, and again for two motions for extension of trial dates. Motions of reliance were filed by both parties. Opposer filed a motion to strike Applicant's notice of reliance. Motion to strike was decided by the Board on August 26, 2020. Applicant filed a motion to reopen discovery. The motion was denied and the Board's trial dates remain as set in schedule issued August 26, 2020.

V. ARGUMENT

A. Whether registration of the Applicant's proposed trademarks BAD MOMS BIBLE and BAD MOMS UNLIMITED when used in commerce is likely to cause confusion, mistake or to deceive as to source of the goods or services.

In determining likelihood of confusion, the Board applies the factors in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). There is no single test for determining likelihood of confusion, rather a number of factors to be considered, and “each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.” *In re E.I. du Pont*, 177 U.S.P.Q. at 567.

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

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. *In re Ginc UK Limited*, Serial No. 78618843, (TTAB 2007). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related; rather, taking into account all of the relevant facts of a particular case. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

The root of alleged confusing similarity in most cases is the fact that the marks in issue have at least some portion in common. However, the mere fact that the marks in issue share elements, even dominant elements, does not compel a conclusion of likely confusion. *Gen. Mills*,

Inc. v. Kellogg Co., 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“The use of identical, even dominant, words in common does not automatically mean that two marks are similar.”), citing *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1183, 226 U.S.P.Q. 123, 127 (11th Cir. 1985); see also *Penta Hotels Ltd. v. Penta Tours*, 9 U.S.P.Q.2d 1081, 1098 (D. Conn. 1988); *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 3 U.S.P.Q.2d 1194, 1203 (D.N.J. 1987), *aff’d*, 834 F.2d 368, 5 U.S.P.Q.2d 1073 (3d Cir. 1987). The marks at issue in this proceeding share words in common, however, the appearance of Applicant’s marks are distinguished by the addition of non-descriptive words BIBLE and UNLIMITED, which changes the appearance, sound, and meaning.

Turning to meaning, in Applicant’s marks, the word BAD refers to the slang or alternative definition of the word bad (bad meaning very good, great, or excellent). See Notice of Reliance, Exhibit D. The word BIBLE is meant to connote a book or in Applicant’s case, a resource considered authoritative in its field, or the ultimate resource for moms in need of financial assistance. Similarly, the word UNLIMITED is meant to connote ultimate or unrestricted as applied to the various goods sold under the mark in classes 09, 16 and 25.

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if... the marks in their entireties convey significantly different commercial impressions. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). “The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545-46, 40 S.Ct. 414, 64 L.Ed. 705 (1920). Applicant believes the

examining attorney reviewed the entire mark BAD MOMS BIBLE and BAD MOMS UNLIMITED against all of Opposer's thirteen applications for BAD MOMS and BADMOMLIFE and correctly determined no likelihood of confusion.

Differences in connotation and commercial impression can weigh strongly in the likelihood of confusion analysis. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (per curiam) (affirming dismissal based on different commercial impressions of CRYSTAL CREEK and CRISTAL); *H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1729 (TTAB 2008) (finding ONE FAB FIT makes different commercial impression from ONE TRUE FIT); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1017-18 (TTAB 2007) (finding BM BODYMAN and design differs in connotation and commercial impression from BOD MAN); *In re Sydel Lingerie Co.*, 197 USPQ 629 (TTAB 1977) (finding BOTTOMS UP for ladies' and children's underwear projects different commercial impression from BOTTOMS UP for men's suits, coats and trousers). Similarly, BAD MOMS BIBLE for charitable foundation services is different in connotation and commercial impression from BAD MOMS for motion picture services, as well as the various classes of goods included in Opposer's other seven BAD MOMS applications and as well as the five BADMOMLIFE applications. Equally, Applicant's BAD MOMS UNLIMITED mark is different in overall commercial impression as compared to Opposer's BAD MOMS and BADMOMLIFE applications.

"The proper test is ... '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). The appearance and meaning of the word BIBLE in Applicant’s mark greatly contributes the overall commercial impression. The three words together, BAD MOMS BIBLE in sound and meaning create a distinct commercial impression when encountered by the consumer. The overall commercial impression is that of a bible or authoritative source, the ultimate resource for moms who the charitable foundation considers great or excellent. The overall commercial impression is different than Opposer’s BAD MOMS or BADMOMLIFE marks. Similarly, BAD MOMS UNLIMITED creates a different commercial impression. A consumer is not likely to believe Applicant’s charitable foundation services or it’s goods are connected to Opposer’s motion picture services or it’s goods. The marks, BAD MOMS BIBLE and BAD MOMS UNLIMITED, are dissimilar in overall commercial impression. No assumption of a connection, confusion is unlikely.

Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. See, e.g., *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB’s finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE). In a similar way, MOMS is disclaimed in both marks, making BAD and BIBLE the more dominant or source indicating features of the marks.

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless

the overall combinations have other commonality. See, e.g., *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I'M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN' HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion). Here, the common element, BAD MOMS is weak and descriptive of Opposer's services, specifically in the application for motion picture services, featuring a movie about bad moms. As evidence of a descriptive or weak common element, Applicant produced proof of third party common law trademark use of BAD MOMS as associated with a number of different goods and services. See Notice of Reliance, Exhibit C. Numerous social groups, organizations, articles, and merchandise companies all use BAD MOMS to promote, offer and sell their goods and services. There is such widespread commercial use of the term "bad moms", consumers could not possibly believe all the goods and services associated with the respective third parties, emanate from Opposer. If Opposer had truly considered its movie title a trademark, it would have policed unauthorized use of its mark. Instead, same or similar BAD MOMS marks are widely used as common law trademarks by third parties as associated with many different good and services. See Notice of Reliance, Exhibit C. The genie is out of the bottle, "bad moms" has taken on a life of its own.

Third-party registrations offer strong probative evidence that other similar registrations coexist. This third-party evidence should be afforded great weight to show the Trademark Office has a history of approving for registration trademarks that appear and sound similar. See *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003). “[S]ufficient evidence of third-party use of similar marks can ‘show that customers . . . “have been educated to distinguish between different . . . marks on the basis of minute distinctions.”’ *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015), citing 2 *McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed. 2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (T.T.A.B. 1976)). The Applicant provided as evidence, numerous third party registrations where a movie title was registered for motion picture services and similar, even identical marks were allowed to register for non-related goods or services. The numerous registrations of same or similar trademarks, specifically movie titles for motion picture services, show the Trademark Office has a history of allowing the marks to coexist so long as the goods or services are not related, and movie titles are not afforded any special status. See Notice of Reliance, Exhibit A.

The examining attorney reviewed Opposer’s seven applications for BAD MOMS, including the application for motion picture services, and five applications for BADMOMLIFE and either approved for publication on first review or indicated in an office action “The trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).” See Notice of Reliance, Exhibit B. Only two of Opposer’s applications, for classes 09 and 25 were suspended pending Applicant’s

prior pending application for BAD MOMS UNLIMITED in classes 09 and 25.

2. The similarity or dissimilarity of the goods and services.

The facts in each case vary and the weight to be given each relevant *du Pont* factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See, e.g., *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (regarding alcoholic beverages); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171–72 (TTAB 1987) (regarding food products); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (regarding clothing); see also *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate). Additionally, where goods and services are not identical, like here, the degree of similarity between the marks necessary to find a likelihood of confusion is even greater. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992) (emphasis added); see also *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012).

The test is not to determine if the goods and or services are similar or competitive. Instead, the appropriate test is to compare the respective goods and or services and determine if they are related in some manner. *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The marks must be viewed in the context of the whole as they are encountered

by the consumers in the marketplace. *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925 (10th Cir. 1986). A consumer is likely to encounter BAD MOMS BIBLE and BAD MOMS UNLIMITED on Applicant's websites, or at events sponsored by the charitable foundation. By contrast, a consumer is likely to encounter advertising or promotion for Opposer's motion picture services very differently. It is obvious to a consumer when a motion picture is being advertised on television, print ads, internet, or other social media. A consumer is not likely to presume BAD MOMS BIBLE for charitable foundation services or BAD MOMS UNLIMITED for goods are related, in any manner, to Opposer's marks for motion picture services, its movie title BAD MOMS or its goods sold under BAD MOMS. Compared, Applicant's goods and services are not related to Opposer's goods and services, with the exception of BAD MOMS UNLIMITED mark in classes 09 and 25.

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection

classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks). In the same way, Applicant's charitable foundation services are not related or marketed in the same way Opposer would advertise, promote or market its motion picture services or a movie. Therefore, a consumer seeing BAD MOMS BIBLE or BAD MOMS UNLIMITED would not mistakenly believe the goods and services emanate from Opposer. The confusion as to source needs to be likely not merely possible. Confusion unlikely.

Third-party registrations entered on the record, offer strong probative evidence that a number of registrations coexist with same or similar marks, but unrelated goods or services. This third-party evidence should be afforded great weight to show the Trademark Office has a history of approving for registration trademarks with same or similar marks, but unrelated goods or services. Evidence of third-party use is relevant to show the strength or weakness of a trademark. See *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003). In addition, sufficient evidence of third-party use of similar marks can "show that customers ... have been educated to distinguish between different... marks on the basis of minute distinctions." *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (T.T.A.B.1976). It held third-party evidence was powerful on its face and...relevant to prove that the elements used by third parties are well understood for a descriptive or suggestive meaning, thus leading to the conclusion that the element is relatively

weak. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334 (2015). Applicant once again points to evidence of registrations where a movie title exists for motion picture services, and similar or even identical registrations coexist having dissimilar goods or services. See Notice of Reliance, Exhibit A. Additionally, as discussed earlier with the first *du Pont* factor, the words BAD MOMS is widely used in commerce as a common law trademark by numerous different social groups, organizations, and is referred to in articles and used in sale of merchandise, mostly in a descriptive or suggestive way. The descriptive, or suggestive use by third parties prove BAD MOMS is relatively weak. See Notice of Reliance, Exhibit C.

The lack of evidence showing an overlap in the channels of trade for applicant's and registrants' products is pivotal. See, e.g., *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010). The goods and services offered do not travel in the same channels of trade. Mothers looking for financial assistance will seek out BAD MOMS BIBLE charitable foundation services, not BAD MOMS motion picture services. Additionally, consumers looking to purchase Applicant's goods will look to Applicant's website, or see the goods offered for sale under the BAD MOMS UNLIMITED mark, at charity events or programs. Consumers will not likely encounter Applicant's marks under the same conditions Opposer's marks are usually advertised, promoted or offered. Different trade channels, as well as dissimilar conditions under which the service are offered, makes it unlikely that there will be confusion as to source. Consumers believe movie titles are just that, movie titles, and not trademarks used as a source indicator to identify goods or services. Accordingly, Applicant's

charitable foundation services and Opposer's motion picture services move through distinct trade channels to distinct classes of consumers, and therefore, they are not likely to be confused as to source of the services.

The examining attorney reviewed eight BAD MOMS applications and five BADMOMLIFE applications, and found the goods and services recited in Opposer's applications were not related to the goods and services recited in Applicant's prior pending applications, with exception of class 09 and 25 for BAD MOMS UNLIMITED. See Notice of Reliance, Exhibit B. Therefore, Opposer has not established by a preponderance of the evidence that Applicant's goods and services are related to Opposer's goods and services, with the possible exception applications for BAD MOMS UNLIMITED in classes 09 and 25. The second *du Pont* factor thus weighs heavily against a finding that confusion is likely.

3. The number and nature of similar marks in use on similar goods and services.

If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak"). As evidence, Applicant provided numerous examples of BAD MOMS used as a common law trademark on goods

similar to goods recited in Opposer's registrations in classes 03, 18 and 21. See Notice of Reliance, Exhibit C. This evidence establishes that BAD MOMS is relatively weak.

4. Bad faith, and Applicant's intent in adopting mark

In order to determine whether the application was made in bad faith, it is the intention of the applicant at the time the application was submitted that is important. In this respect, it should be noted that the intention of the applicant at the time of the application is a subjective factor which should be determined on the basis of the objective circumstances of the particular case. In other words, an overall assessment should be made, taking into account all the relevant factual circumstances as they existed at the time the application was submitted.

Applicant's intent was to create a trademark that included the word moms, which would be the main consumer target group for the charitable foundation services. The word bad was added, but with the slang or alternative meaning of bad, meaning very good, great or excellent. See Notice of Reliance, Exhibit D. The word bible was added to connote the authoritative or ultimate resource for moms in the similar way the bible is considered the authoritative book for religion. Applicant wished to convey that moms could find all the resources they needed on the charitable foundation website or through its events or programs. Prior to filing, the Applicant initiated a comprehensive search for possible conflicts. The search results appeared clear of conflicts. At the time of filing, July 28, 2017, there were no identical or similar marks. Opposer's thirteen applications were all submitted on August 9, 2017. Opposer's Bad Moms movie released on July 29, 2016. Bad Moms Christmas released on Nov. 1, 2017. Applicant was not seeking to exploit or otherwise take advantage of the reputation of Opposer's marks or

movies. Additionally, Applicant did not apply for the BAD MOMS BIBLE and BAD MOMS UNLIMITED marks to prevent Opposer from gaining access to the market or register similar marks in unrelated classes. The contrary is true, all but three of Opposer's applications were approved on first examination, all reviewed against Applicant's two prior pending applications. In reviewing Opposers thirteen marks filed on August 9, 2017, the examining attorney found no similar marks that would bar registration. See exhibit B. Additionally, a film or motion picture is considered a single creative work and must be refused registration under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127. The exception being if the title is used in a series of creative works. The second motion picture Bad Moms Christmas released November 2017, therefore, the BAD MOMS application for motion picture services could not be considered a series until after the second movie was advertised or promoted, which occurred after Applicant applied for its two marks.

B. Whether the Opposer's trademark is famous.

Opposer did not specifically claim BADMOMLIFE is famous, nor provide any evidence to support such a claim. The BADMOMLIFE marks were all submitted as intent to use and are currently in various stages of extension, with three applications in their final extension due to go abandoned in April 2020 after the statutory three year extension period expires. The Opposer owns no registrations for BADMOMLIFE.

Large amounts of money spent on advertising a mark can bolster a fame argument but, standing alone, will generally not be sufficient to establish fame. See, e.g., *Schutte Bagclosures*

Inc. v. Kwik Lok Corp., 48 F. Supp. 3d 675, 702 (S.D.N.Y. 2014). With BAD MOMS, while the Opposer made reference to advertising and revenue of its BAD MOMS movies, that does not in and of itself equal fame or public recognition. The BAD MOMS trademark does not enjoy wide public recognition for anything more than the title of a movie. Opposer's own production of documents fails to show BAD MOMS used as a trademark while it was advertised and promoted. A TM symbol was never used to give notice to the public that Opposer was using BAD MOMS as a source indicator. Further, the movie title was heavily promoted in 2016 and 2017, but since then, has not been largely advertised or promoted, as is typical in the motion picture industry. With new movies constantly being released, the consumer is conditioned to move on to the next big movie. The Opposer finally applied for the BAD MOMS trademark for motion picture services on August 9, 2017, a year after the movie released. Even then, Opposer's application for motion picture services was refused by the examining attorney citing "activities are not a registerable service". See Notice of Allowance, Exhibit B.

Further, and most revealing was Opposer response to interrogatory no. 15, admitting it did not own a federal registration for BAD MOMS for motion picture services. See Notice of Reliance, Exhibit E. The lack of a registration for motion picture services means Opposer would not be entitled to all the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including the validity and Opposer's exclusive right to use BAD MOMS in commerce for such services. Opposer owns registrations for BAD MOMS in classes 03, 18 and 21, but did not provide any evidence showing the mark in those particular classes was famous. The goods in those classes are not sold by Opposer, instead the Opposer licensed companies to provide and

sell goods to promote it's BAD MOMS movie.

Thus, a party who asserts that its mark is famous must submit evidence clearly establishing that its mark is viewed by relevant purchasers as a famous mark. See, e.g., *In re Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1409 (TTAB 1998). Opposer has not clearly establish that its mark is viewed by relevant consumers as a famous mark, as no evidence was offered in the way of consumer surveys or other consumer driven evidence.

Additionally, extensive and commercially significant third party uses of the same or similar marks (especially for unrelated goods/ services) would weigh against fame because the mark would be associated with multiple entities and not just plaintiff. Thus, showing an extensive amount of commercially significant third party uses points towards a mark not being famous. As evidence, Applicant provided numerous examples of third party use of BAD MOMS by various social groups, organizations and companies for unrelated goods and services. See Notice of Reliance, Exhibit C.

Therefore, Opposer's unregistered BAD MOMS mark for motion picture services, has not risen to the level of fame, a level reserved for a very select few trademarks. Opposer's application for BAD MOMS for motion picture services along with the other twelve BAD MOMS and BADMOMLIFE applications should only be accorded a normal scope of protection, not the expanded scope of protection famous marks enjoy.

C. Whether registration and use of Applicant's proposed trademark is likely to cause dilution of Opposer's trademark.

The Board carefully distinguishes fame for likelihood of confusion purposes from fame

for dilution purposes. Fame for dilution purposes is a higher standard and includes only a select few in this class of marks. Relatively few marks qualify as famous under the TDRA, aside from those that are truly “household names” or “part of the collective national consciousness.” *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir. 2002); see also *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1011 (9th Cir. 2004) (dilution is a cause of action “reserved for a select class of marks—those marks with such powerful consumer associations that even non-competing uses can impinge on their value”). Opposer has not proven it’s BAD MOMS mark ranks among the small amount of marks accorded the “famous” status for purposes of a dilution claim.

Fame is a high standard that is hard to meet. Plaintiffs 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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012). Fame for dilution purposes requires direct evidence of consumer recognition. Opposer offered no evidence of a powerful association, that when the public encounters the BAD MOMS trademark in any context, it recognizes and associates it only with Opposer’s motion picture services or goods.

“The marks must be similar enough that a significant segment of the target group sees the two marks as essentially the same.” *The Toro Company v. ToroHead, Inc.*, Opposition No. 114,061, (TTAB 2001). We agree that the dilution statutes do not prohibit all use of a distinctive mark that the owners prefer not be made [W]e agree with the Fourth Circuit that the dilution statutes do not create a ‘property right in gross’); *Nabisco*, 191 F.3d at 224 n.6, 51 USPQ2d at

1894. ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection"). In light of the above guidance, we start by noting that, unlike in likelihood of confusion cases, we will not resolve doubts in favor of the party claiming dilution. *I.P. Lund*, 163 F.3d at 47, 49 USPQ2d at 1239.

While federal registration is not required to bring a dilution claim under the TDRA, the lack of a Principal Register registration weighs against a finding of fame (and, as a practical matter, courts are very unlikely to find an unregistered mark famous absent strong evidence of fame under the other factors). See, e.g., *Hershey Foods Corp. v. Mars, Inc.*, 998 F. Supp. 500, 517 (M.D. Pa. 1998) (noting that "failure to register counts against a finding of fame" as a person "would be expected to register a famous mark;") Reese's unregistered trade dress found not famous); *Juice & Java, Inc. v. Juice & Java Boca, LLC*, 2017 U.S. Dist. LEXIS 6913, at *16 (S.D. Fla. Jan. 17, 2017) (noting that "one could logically infer lack of fame from a lack of registration"). Opposer lacks a federal registration for BAD MOMS, specifically in connection with its motion picture services, which it relies on for its fame and dilution argument. Opposer admitted the mark is unregistered in interrogatory no. 15. See Notice of Reliance, Exhibit E.

Essentially, if a plaintiff's mark was a common word used by numerous third parties, such a fact would weigh against a finding of fame. See, e.g., *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 878 (9th Cir. 1999) (AVERY DENNISON not famous); *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 132 (D. Mass. 1999) (CLUE not famous). When "a mark is in widespread use, it may not be famous for the goods or services of one business." Report Recommendation, 77 Trademark Rep. at 461; see *Accuride*, 871 F.2d at 1539 (affirming the

district court's holding that widespread use of elements of a trademark helped to defeat a dilution claim). As evidence that BAD MOMS is a common phrase, Applicant provided numerous articles where BAD MOMS was used, but Opposer's movie was not discussed, advertised or promoted. Further, Applicant provided numerous examples of widespread use of BAD MOMS by third party social groups, organizations and companies selling merchandise. The widespread use of common words goes against a claim of dilution. See Notice of Reliance, Exhibit C.

D. Whether Applicant lacks a bona fide intent to use the BAD MOMS BIBLE and BAD MOMS UNLIMITED trademarks.

In a footnote of the Board's decision in this proceeding relating to Opposer's motion to amend pleading, the Board stated "Applicant is correct that a finding that Applicant lacked a bona fide intent to use some of the goods identified in its involved application would not necessarily result in a finding that the entire application is void ab initio. Rather, the appropriate remedy is a deletion of the goods. *Grand Canyon West Ranch LLC*, 78 USPQ2d at 1697 ("The case law is clear that holding an application to be void is an appropriate remedy when the pleaded ground either is fraud, or that the applicant has not used the applied-for mark on any of the goods or services identified in the application prior to the filing of the application.") (emphasis added); see also 6 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:73 (5th ed. 2019) (citing "The Grand Canyon Rule")."

Applicant objectively proved intent to use by taking clear steps towards providing charitable foundation services under the BAD MOMS BIBLE trademark, as well as selling

goods under the BAD MOMS UNLIMITED trademark. A 501(c) non-profit company was established, a Board of Directors was appointed, a website was created, actual goods in classes 09, 16 and 25 were produced and sold to consumers. Additionally, women have used the resources of the charitable foundation services via the website and various events and programs. Applicant produced proof of all these steps in discovery.

VI. CONCLUSION

Even identical marks have been held not to be confusing where the goods and services are not related. See, e.g., *Shen Mfg.*, 73 USPQ2d 1355- 56. Here, the potential for confusion appears to be a mere possibility not a probability. See *Electronic Design*, 21 USPQ2d at 1393. For the foregoing reasons, the Applicant respectfully request the Board deny the opposition, and affirm the examining attorney's approval of the applications, and the application Serial Nos. 87547298 and 87547487 be allowed to proceed to registration on the Principal Register of the United States Patent and Trademark Office.

Respectfully Submitted

January 25, 2021

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CERTIFICATE OF TRANSMITTAL

I hereby certify that a true and correct copy of the following Applicant's Trial Brief is being filed electronically with the TTAB via ESTTA on January 25, 2021.

_____/edd/_____
Edd Vasquez, Esq.

