

<p>This Opinion is Not a Precedent of the TTAB</p>
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Hearing: April 6, 2021

Mailed: May 14, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Coca-Cola Company

v.

Robert Troy Hoff

Opposition No. 91244286

Bruce W. Baber and Kathleen E. McCarthy of King & Spalding LLP
for The Coca-Cola Company.

Steven Ivy of Steven Ivy PC for Robert Troy Hoff.

Before Shaw, Kuczma, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Robert Troy Hoff (“Applicant”) seeks registration on the Principal Register of the stylized mark shown below for “Hats; Hoodies; Jackets; Jerseys; Sweaters; T-shirts; Graphic T-shirts; Short-sleeved or long sleeved-t-shirts; Sports jerseys,” in International Class 9:



The Coca-Cola Company (“Opposer” or “TCCC”) has opposed registration of Applicant’s mark under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c), on the grounds that Applicant’s mark is likely to be confused with, and is likely to dilute by blurring, the stylized mark shown below (the “Coca-Cola Script Mark”), which Opposer has registered and used for soft drinks and numerous other goods:



¹ Application Serial No. 87822744 was filed on March 6, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. Applicant describes his mark as “consist[ing] of the stylized words ‘CONCEAL-CARRY’ positioned directly above the stylized words ‘REGISTERED HANDGUN’”. The background is for shading purposes only and is not claimed as a feature of the mark.” Applicant has disclaimed the exclusive right to use the words CONCEAL CARRY REGISTERED HANDGUN apart from the mark as shown, and does not claim color as a feature of the mark.

The case is fully briefed,² and counsel for Opposer appeared at a video hearing before the panel on April 6, 2021.³ We sustain the opposition on the basis of Opposer's likelihood of dilution claim and do not reach its likelihood of confusion claim.

I. Evidentiary Issues

Before we describe the record, we address (1) Opposer's objections in its main brief, 26 TTABVUE 12 & n.2, to our consideration of the materials submitted by Applicant under his Notice of Reliance, 19 TTABVUE, and (2) Opposer's objections in its reply brief, 28 TTABVUE 8-11, to Applicant's references in his brief to "several factual Internet materials that are not of record," *id.* at 8, and to "numerous factual assertions and arguments that are unsupported by any evidence of any kind." *Id.* at 9.

A. Opposer's Objections to Materials Submitted Under Applicant's Notice of Reliance

On January 23, 2020, Opposer filed a consented motion to extend the various remaining case management dates, including the parties' respective trial periods. 14 TTABVUE 1. The Board granted the motion the same day. 15 TTABVUE 1. Under the revised schedule, Applicant's trial period began on March 24, 2020 and ended on April 24, 2020.

² Citations in this opinion to the briefs and other docket entries refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer's main brief appears at 26 TTABVUE and its reply brief appears at 28 TTABVUE. Applicant's brief appears at 27 TTABVUE.

³ Applicant elected not to participate in the hearing. 32 TTABVUE 2.

Applicant filed his Notice of Reliance on March 11, 2020, 19 TTABVUE, 13 days before the opening of his trial period. The Notice of Reliance covered an Illinois state registration of the same mark that he seeks to register in the United States Patent and Trademark Office (“USPTO”), a copy of his Initial Disclosures, and a copy of his Response to Opposer’s First Set of Interrogatories. *Id.* at 1-27. Because Applicant filed his Notice of Reliance prior to the opening of his trial period, it was premature.

Opposer objected to Applicant’s Notice of Reliance for the first time in Opposer’s main brief. Opposer argues that Applicant “did not properly make any evidence of record at all during his trial testimony period” because Applicant filed his Notice of Reliance “on the day after Applicant’s pretrial disclosures were due and approximately two weeks before Applicant’s trial period began.” 26 TTABVUE 12. Opposer argues alternatively that if the Board deems the Notice of Reliance to have been timely filed, the materials that it covers should be excluded because

(1) the Illinois state registration is not authenticated, is irrelevant to this proceeding, and provides no defense to Applicant . . . ; (2) Applicant may not introduce or rely on his counsel’s unsworn initial disclosures for any purpose; and (3) while TCCC may rely on Applicant’s interrogatory answers, Applicant may not rely on his own interrogatory answers as evidence.

Id. n.2 (citations omitted). Applicant does not respond to any of Opposer’s objections in his brief.

“Some grounds for objection to a notice of reliance are waived unless promptly made (generally errors of any kind which might be obviated or cured if promptly presented) while other grounds that cannot be cured may be raised at any time.”

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section

707.02(a) (June 2020). The objections that may be waived if not promptly asserted are “procedural” in nature, and “should be raised promptly, preferably by motion to strike if the defect is one that can be cured.” TBMP Section 707.02(b). Such procedural grounds include the filing of a notice of reliance prior to the opening of a party’s trial period. *See, e.g., ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1037 n.2. (TTAB 2012) (where the petitioner’s notices of reliance were filed 11 days prior to the opening of its trial period, but the respondent did not timely object to their premature filing, “any objection as to early filing of the notices of reliance is deemed to be waived” because “the premature filing of the notices of reliance could have been cured if a prompt objection was made”). Because Opposer first objected to Applicant’s premature filing of his Notice of Reliance in Opposer’s trial brief, long after Applicant could have cured this procedural defect, Opposer’s objection based on the premature filing of the Notice of Reliance is deemed waived.

As noted above, however, Opposer also objects to the materials submitted under Applicant’s Notice of Reliance on the grounds that they are “incompetent, irrelevant, or immaterial.” TBMP Section 707.02(c). Such “substantive” objections may properly be “raised in or with the objecting party’s brief on the case or in an appendix or separate statement of objections attached to the brief.” *Id.* Opposer’s substantive objections are thus timely.

With respect to Applicant’s initial disclosures and discovery responses, in the absence of a stipulation of the parties, *see Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.8 (TTAB 2020), Trademark Rule 2.120(k)(5) provides that

initial disclosures and answers to interrogatories “may be submitted and made part of the record only by the receiving or inquiring party” unless the inquiring party makes of record “fewer than all of the . . . answers to interrogatories,” in which case “the responding party may introduce under a notice of reliance any other . . . answers to interrogatories . . . which should in fairness be considered so as to make not misleading what was offered by the . . . inquiring party.” 37 C.F.R. § 2.120(k)(5).

Under its own First Notice of Reliance, 16 TTABVUE 4-18, Opposer made of record the entirety of Applicant’s Response to Opposer’s First Set of Interrogatories, so the exception in Trademark Rule 2.120(k)(5) does not apply. Trademark Rule 2.120(k)(7) provides, however, that “[w]hen . . . an answer to an interrogatory . . . has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.” 37 C.F.R. § 2.120(k)(7). Because Opposer made Applicant’s responses to Opposer’s interrogatories of record during its trial period, Applicant was entitled to refer to his responses without separately submitting them. Accordingly, we overrule as moot Opposer’s objection to Applicant’s submission of his responses under his Notice of Reliance. Because Opposer did not submit Applicant’s Initial Disclosures, we sustain Opposer’s objection to Applicant’s submission of them under his Notice of Reliance, and have given them no consideration in our decision.

Applicant’s Illinois state registration may properly be made of record under Applicant’s Notice of Reliance, TBMP Section 704.03(b)(1)(A) (citing Trademark Rule 2.122(e)), but it “is incompetent to establish that the mark shown therein has ever

been used, or that the mark is entitled to federal registration.” *Id.* (citing, inter alia, *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (Nevada state registration stipulated into the record held to be “incompetent to prove anything material to this proceeding”); *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240, 243-44 (TTAB 1963) (“Puerto Rican registration as in the case of State or foreign registrations is not determinative or controlling on the question of the registrability of a particular designation under the provisions of the” federal Trademark Act)). We sustain Opposer’s objection to Applicant’s state registration, and have given it no consideration in our decision.

B. Opposer’s Objections to Internet Citations and Statements in Applicant’s Brief

Opposer argues in its reply brief that “Applicant’s brief refers to and seeks to rely on several factual Internet materials that are not of record,” 28 TTABVUE 8, and “objects to such references and asks the Board to disregard them and the arguments based on them.” *Id.* Opposer also argues that “Applicant’s brief also makes numerous factual assertions and arguments that are unsupported by any evidence of any kind,” and “objects to such assertions and arguments and asks that the Board disregard them.” *Id.* at 9.

Opposer’s reply brief provides tables of the Internet citations and arguments to which Opposer objects. *Id.* at 8-11. For ease of reference in following our analysis, we reproduce below the table regarding the Internet materials:

Referenced Materials	Location Referenced
What Font Is; Title: What fonts are similar to Commercial Script (Mec)? 100 Free fonts alternatives to Commercial Script (Mec) Location: https://www.whatfontis.com/Commercial-Script-Mec.similar	Appl. Br. 7 n.1
MentalFloss.com; Title: These Kids Cannot Wrap Their Minds Around Blockbuster Video Location: https://www.mentalfloss.com/article/84072/these-kids-cannot-wrap-their-minds-around-blockbuster-video	Appl. Br. 9 n.2
Walmart; Title: Blue Oval Logo Ford T-Shirt Location: shorturl.at/mxV02	Appl. Br. 9 n.3

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Referenced Materials	Location Referenced
Fine Art America Location: https://fineartamerica.com/featured/oldsmobile-oldsmobile-cursive-logo-brand-a.html	Appl. Br. 9 n.4

Id. at 8-9.

Applicant’s Internet citations involve the listing of links to various webpages. 27 TTABVUE 8 n.1, 10 nn.2-4. Opposer correctly notes that providing an Internet link to a webpage is insufficient to make the referenced materials of record. 28 TTABVUE 8. Because of the ephemeral nature of Internet websites, the “Board does not accept Internet links as a substitute for submission of a copy of the resulting page.” *TV Azteca, S.A.B. v. Martin*, 128 USPQ2d 1786, 1789 n.15 (TTAB 2018) (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1194 n.21 (TTAB 2018); *In re Olin*

Corp., 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)). Because Applicant did not make the referenced webpages of record, we have given the links to them and Applicant's accompanying arguments no consideration in our decision.

With respect to Opposer's objections that various arguments made by Applicant are unsupported by record evidence, we are capable of determining whether and to what extent arguments are supported by the evidence on which they are based without making specific evidentiary rulings in that regard. We "simply accord the evidence whatever probative value it deserves, if any at all" after "weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence." *Hunt Control Sys. Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011); *see also Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017). We have kept Opposer's "objections" in mind in assessing Applicant's arguments.

II. Record

Following our evidentiary rulings above, the record consists of the pleadings,⁴ the file of the opposed application, by operation of Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following materials submitted by Opposer:

⁴ In addition to its likelihood of confusion and likelihood of dilution claims, Opposer's Notice of Opposition pleaded a claim under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), that Applicant's mark falsely suggests a connection with Opposer, 1 TTABVue 12 (Not. of Opp. ¶ 14), and a claim that Applicant lacked a bona fide intention to use his mark in commerce when he filed the opposed application. *Id.* (Not. of Opp. ¶ 16). In its main brief, Opposer states that it "relies only on its likelihood of confusion and likelihood of dilution

- Opposer’s First Notice of Reliance on Applicant’s Responses to Opposer’s First Sets of Interrogatories and Requests for Production of Documents, 16 TTABVUE 2-38;
- Opposer’s Second Notice of Reliance on USPTO electronic records of various of Opposer’s registrations of the Coca-Cola Script Mark in various forms, 17 TTABVUE 2-134; and
- The testimony declaration of Jaideep Kibe (“Kibe Decl.”),⁵ Opposer’s Vice President, Coca-Cola TM, and Exhibits A-S thereto. 18 TTABVUE 3-192.

III. Entitlement to a Statutory Cause of Action⁶

Entitlement to a statutory cause of action is a threshold issue in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370,

claims herein,” 26 TTABVUE 26 n.3, and it thus has waived the other claims. Applicant’s Answer asserted seven self-styled “Affirmative Defenses.” Five of them are amplifications of his denials of likelihood of confusion and likelihood of dilution, 6 TTABVUE 7-8 (Ans. Aff. Defs. ¶¶ 1-5), and two of them, failure to state a claim upon which relief can be granted and Applicant’s reservation of rights to amend his answer, *id.* at 8 (Ans. Aff. Defs. ¶¶ 6-7), are not true affirmative defenses. *See U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *4 (TTAB 2021) (failure to state a claim); *FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) (reservation of right to add affirmative defenses). “[B]ecause Applicant raised them in the Answer but did not pursue them at trial, we consider them waived.” *Tempting Brands*, 2021 USPQ2d 164, at *4.

⁵ We will cite the Kibe Declaration by paragraph and exhibit number and, where helpful in following our analysis, by TTABVUE pages as well (e.g., “Kibe Decl. ¶ 13; Ex. A-M (18 TTABVUE 18-56)”).

⁶ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. § 1063-64, under the rubric of “standing.” The parties here have done so as well. 26 TTABVUE 26-27; 27 TTABVUE 6 (stating that “Applicant does not contest Opponent’s standing.”). Despite the change in nomenclature, the substance of the analysis of this issue in our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remains applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020).

As noted above, Applicant does not dispute Opposer’s entitlement to a statutory cause of action, and such entitlement “is established with respect to its likelihood of confusion and dilution claims by its registrations” of its pleaded Coca-Cola Script Mark, “which the record shows to be valid and subsisting, and owned by Opposer.” *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). “If a plaintiff can show [entitlement to a statutory cause of action] on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding.” *Id.* (citing *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011)). Opposer is thus entitled to assert both its likelihood of confusion and likelihood of dilution claims.

IV. Opposer’s Dilution by Blurring Claim

“Dilution by blurring is ‘association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.’ Trademark Act Section 43(c)(2)(B). Dilution may be likely ‘regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.’

Section 43(c)(1).” *N.Y. Yankees*, 114 USPQ2d at 1501 (quoting 15 U.S.C. § 1125(c)(1) and (2)(B)). The statute’s concern is that “the gradual whittling away of distinctiveness will cause the trademark holder to suffer ‘death by a thousand cuts.’” *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). Opposer must prove dilution by blurring by a preponderance of the evidence. *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012).

The Federal Circuit “has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (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;⁷ and
- (4) the defendant’s use of its mark is likely to cause dilution by blurring or by tarnishment.”

N.Y. Yankees, 114 USPQ2d at 1501-02 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012)).

A. Opposer’s Ownership of a Famous Mark That is Distinctive

A mark is famous for dilution purposes “if it is widely recognized by the general consuming public of the United

⁷ To be entitled to protection against dilution, a mark must have become famous as of the time when the challenged use began, and it must remain famous up to the time of trial. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1113 (TTAB 2018).

States as a designation of source of the goods or services of the mark's owner." There are four non-exclusive factors to consider when determining whether a mark is famous:

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

Id. at 1502 (quoting Trademark Act Section 43(c)(2)(A)).

Opposer argues that "[i]t is not an exaggeration to say that the COCA-COLA Script Mark is one of the most famous marks both in the United States and in the world, and it has been consistently recognized as such by commentators and the courts." 26 TTABVue 7 (citations omitted). According to Opposer, the "COCA-COLA Script Mark is one of the 'household names' that are widely recognized by the consuming public in the United States." *Id.* at 8. Opposer further argues that

The evidence of record establishes the fame of the COCA-COLA Script Mark and is similar to the evidence on which the Board has relied in recent cases to find a mark to be famous for purposes of Section 43(c). The COCA-COLA Script Mark has been widely and extensively promoted for over one hundred and thirty years nationwide, in virtually all available media and channels of trade. . . . The sales of products bearing the COCA-COLA Script Mark have been extraordinarily high, as have the amounts spent on advertising and promotion of those goods by TCCC, its bottlers, retailers and others. . . . Since long prior to the filing of Applicant's application for the "Conceal-Carry" mark, the COCA-COLA Script Mark has often been recognized as an iconic mark by third parties and by courts,

and the proof of “actual recognition” of the COCA-COLA Script Mark as an indicator of source is strong. . . . And the COCA-COLA Script Mark has been registered for over 125 years, is registered on the Principal Register, and the majority of TCCC’s registrations of the COCA-COLA Script Mark are incontestable. The COCA-COLA Script Mark is a famous mark, eligible for protection under Section 43(c), and has been famous since long prior to Applicant’s filing date.

Id. at 36 (record citations omitted).

Applicant “acknowledges that to some groups of people the Opposer’s Mark is known and recognizable, but this recognition is of limited strength, and is declining rapidly.” 27 TTABVUE 12. In the likelihood of confusion section of his brief, Applicant similarly acknowledges that “Opposer’s Mark is well known, but the level of this knowledge is generation-dependent. Specifically, older generations may recognize the Opposer’s Mark, however, younger generations do not.” *Id.* at 9. Applicant argues that “[i]t would be disingenuous to claim that every mark, including the Opposer’s Mark, able to establish fame or some level of recognition, is and will be able to maintain this recognition indefinitely; case in point Polaroid and/or Blockbuster Video marks which are virtually unrecognizable to individuals under the age of 25.” *Id.* at 9-10.

Mr. Kibe’s testimony in his declaration and the exhibits to his declaration comprise most of Opposer’s evidence of the fame of its Coca-Cola Script Mark, and much of the evidence pertains to matters occurring long ago, in some instances more than 100 years ago. Rule 602 of the Federal Rules of Evidence, made applicable to this proceeding by Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a), provides that “[a] witness may testify to a matter only if evidence is introduced sufficient to support a

finding that the witness has personal knowledge of the matter” and that “[e]vidence to prove personal knowledge may consist of the witness’s own testimony.” Fed. R. Evid. 602.

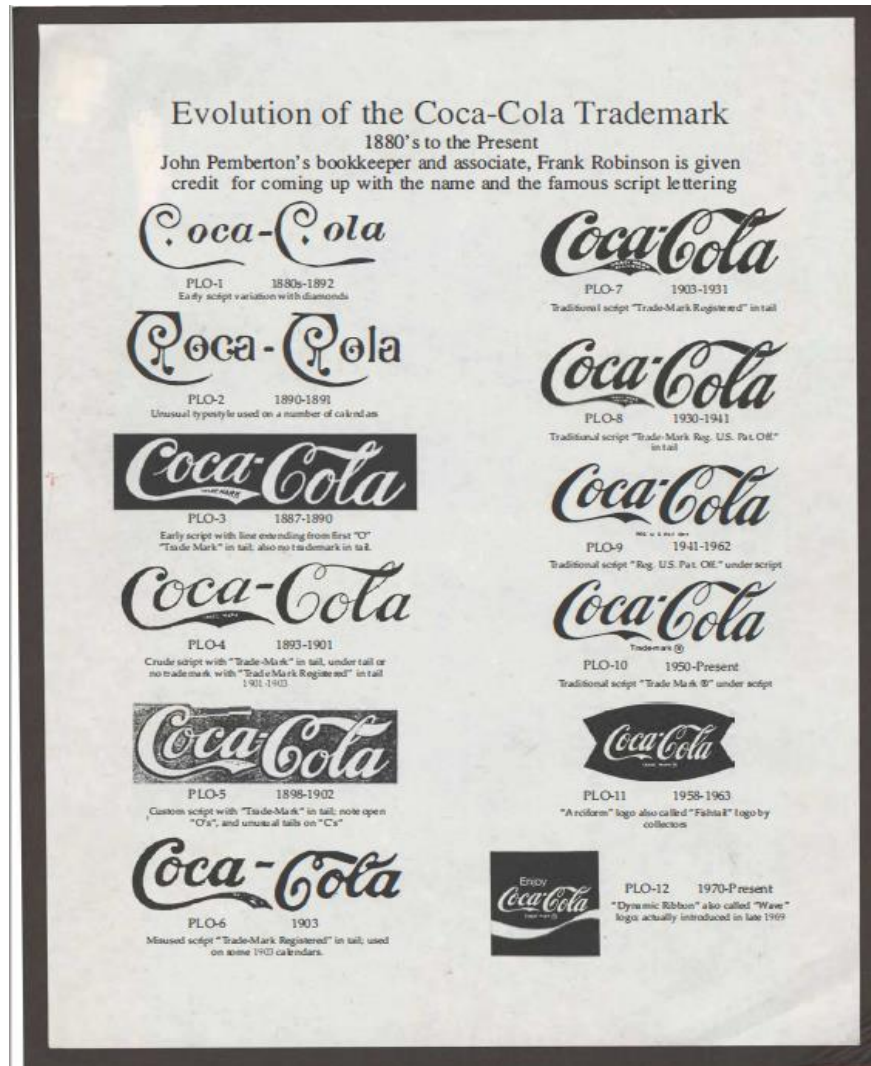
At the time of his declaration, Mr. Kibe had been employed by Opposer, or its Indian affiliate, since March 1997. Kibe Decl. ¶ 1. He was Opposer’s Global Brand Director for the Coca-Cola brand between July 2013 and May 2017, and had served as Vice President, Coca-Cola TM since May 2017. Kibe Decl. ¶ 3. He testified that he had “had specific responsibility for TCCC’s COCA-COLA brand products since 2013,” Kibe Decl. ¶ 4, and “[i]n connection with those roles (as well as my prior positions), [had] become familiar with TCCC’s COCA-COLA marks and other brand properties, including [the Coca-Cola Script Mark].” Kibe Decl. ¶ 4. In connection with his declaration in this case, he “requested that certain historical files and records of TCCC be reviewed and the results of that review compiled for my consideration.” Kibe Decl. ¶ 5. He testified that “I believe that those results are reliable and accurately reflect the facts stated herein, and I rely on that review and those results in connection with my Declaration.” Kibe Decl. ¶ 5.

We find that Mr. Kibe’s uncontradicted and unchallenged testimony regarding his employment with Opposer, his job responsibilities, and the results of the review of Opposer’s historical files and records is sufficient to establish that he has personal knowledge to testify on matters relating to Opposer’s historical activities, including its use of the Coca-Cola Script Mark. *See generally City Nat’l Bank v. OPGI Mgmt. GP Inc.*, 106 USPQ2d 1668, 1673 (TTAB 2013) (“[T]estimony by a person that his job

responsibilities require him to be familiar with the activities of the company that occurred prior to his employment may be sufficient to lay a foundation for his subsequent testimony.”). *See also Transamerica Fin. Corp. v. Trans-Am. Collections, Inc.*, 197 USPQ 43, 44 n.6 (TTAB 1977) (party may rely on historical documents maintained by the corporation over the years, in the normal operation thereof provided that the material is made of record subject to the scrutiny and cross-examination of the adverse party).

1. Duration, Extent, and Geographic Reach of Advertising and Publicity of the Coca-Cola Script Mark

Opposer’s corporate archives contain examples of historical advertising and promotional materials bearing the Coca-Cola Script Mark. Kibe Decl. ¶¶ 12-13; Exs. A-M. The evolution of the Coca-Cola Script Mark that is reflected in the historical advertisements and other materials in the record is summarized in a document from Opposer’s archives entitled “Evolution of the Coca-Cola Trademark 1880’s to the Present,” which we reproduce below:



Kibe Decl. ¶ 15; Ex. O (18 TTABVue 82).

The record contains examples of advertising displaying the Coca-Cola Script Mark in each decade since the 1890s. Kibe Decl. ¶ 13. We depict below examples from decades in the 19th and 20th Centuries:



Kibe Decl. ¶ 13; Ex. A (18 TTABVUE 20) (1890s coupon)



Kibe Decl. ¶ 13; Ex. B (18 TTABVUE 23) (1900s sign).



Kibe Decl. ¶ 13; Ex. C (18 TTABVUE 26) (1910s serving tray).



Kibe Decl. ¶ 13; Ex. D (18 TTABVUE 29) (1920s advertisement).



Kibe Decl. ¶ 13; Ex. E (18 TTABVUE 32) (1930s advertisement).



Kibe Decl. ¶ 13; Ex. F (18 TTABVUE 35) (1940s outdoor sign).



Kibe Decl. ¶ 13; Ex. G (18 TTABVUE 38) (1950s advertisement).



Kibe Decl. ¶ 13; Ex. H (18 TTABVUE 40) (1960s outdoor sign).



Kibe Decl. ¶ 13; Ex. I (18 TTABVUE 43) (1970s advertisement).



Kibe Decl. ¶ 13; Ex. J (18 TTABVUE 47) (1980s advertisement).



Kibe Decl. ¶ 13; Ex. K (18 TTABVUE 50) (1990s advertisement).

There are numerous other examples of historical advertising in a booklet from Opposer's archives entitled "125 years of sharing happiness – A Short History of the Coca-Cola Company," which was created in 2011 for Opposer's 125th anniversary. Kibe Decl. ¶ 14; Ex. N (18 TTABVUE 57-80).

Mr. Kibe testified that "the Coca-Cola Script Mark has been prominently displayed in a wide variety of settings that result in the exposure of significant numbers of persons to the Coca-Cola Script Mark," Kibe Decl. ¶ 22, giving as examples the appearance of outdoor advertising in Times Square in New York City for many decades and Opposer's sponsorship of the Olympic Games since 1928 and of the FIFA soccer World Cup since 1978. Kibe Decl. ¶ 22. He further testified that advertising "featuring the Coca-Cola Script Mark has appeared in arenas and

stadiums and on television broadcasts of Olympic and World Cup events (and many other sporting events) for many years.” Kibe Decl. ¶ 22.

With respect to Opposer’s historical expenditures on advertising and promoting goods under the Coca-Cola Script Mark, Mr. Kibe testified that

Because the Coca-Cola Script Mark has been in use for more than 130 years, it is difficult to state with accuracy the total amounts spent advertising, promoting and marketing the Coca-Cola Script Mark and TCCC’s products bearing that mark. The amounts spent would include not only amounts spent by TCCC itself, but would also include amounts spent by TCCC’s bottlers, who prepare and market (and advertise and promote) the finished products; by TCCC’s licensees, who manufacture and sell licensed merchandise bearing the Coca-Cola Script Mark; and by the multitude of retailers who sell Coca-Cola products at retail to consumers. The amounts that TCCC itself spends is therefore only a portion of the total amounts spent on advertising and promotion that features the Coca-Cola Script Mark.

Kibe Decl. ¶ 23.

Mr. Kibe provided specific figures for only the five years between 2015 and 2019. He testified that during that period, Opposer expended more than \$575 million annually on advertising, marketing and promotional activities in the United States involving the Coca-Cola Script Mark, for a total spend of about three billion dollars. Kibe Decl. ¶ 24. He explained that these advertising and promotional activities have taken the form of television and radio commercials, outdoor advertising, print advertising, online advertising, product packaging and point-of-sale materials. Kibe Decl. ¶ 24. He also testified that Opposer engages in advertising, marketing and promotional activities relating specifically to licensed merchandise bearing the Coca-

Cola Script Mark, and spent more than \$500 thousand annually on such activities in the United States over the five-year period. Kibe Decl. ¶ 25.

Opposer's 2015-2019 advertising and promotional expenditures figures cover an infinitesimal fraction of the more than 130 years in which Opposer has advertised and promoted products bearing the Coca-Cola Script Mark,⁸ and Opposer's expenditures after Applicant's March 6, 2018 filing date are irrelevant. *Cf. N.Y. Yankees*, 114 USPQ2d at 1503 (testimony regarding \$1.5 billion sales figures for period between 1995 and 2015 faulted for not specifying "how much of that \$1.5 billion in sales was from the time frame most relevant for dilution - that is, before Applicant filed its application in 2008 . . ."). Nevertheless, the figures for just the three-year snapshot prior to Applicant's filing date are staggering, and standing alone might be sufficient to establish that the Coca-Cola Script Mark is famous. *See Chanel*,

⁸ The Board made findings regarding the extent of Opposer's advertising expenditures during various portions of the 130-year period in some previous reported cases. In 1966, the Board found in *Coca-Cola Co. v. Davis Bottling Co.*, 152 USPQ 338, 339 (TTAB 1966), that "the soft drink known and identified by the mark 'COCA-COLA' has been extensively advertised in practically every available mass media, at a cost during the period from 1923 through 1964, inclusive, of approximately six hundred million dollars." In 1967, the Board found in *Coca-Cola Co. v. Essential Prods. Co.*, 154 USPQ 449, 449 (TTAB 1967), that since 1900, Opposer had "spent in excess of \$800,000,000 in promoting this product through practically every available advertising medium." In 1972, the Board found in *Coca-Cola Co. v. Triple "AAA" Co.*, 173 USPQ 55, 55 (TTAB 1973), that between 1923 and 1969, Opposer "spent approximately \$800,000,000 to advertise its products under the mark 'COCA-COLA' in the United States." In 1973, the Board found in *Coca-Cola Co. v. Seven-Up Co.*, 178 USPQ 309, 310 (TTAB 1973), that since 1886, Opposer had "spent in excess of \$1,400,000,000 promoting its beverage through practically every available advertising medium." These earlier expenditures are very substantial taking into account the value of the U.S. dollar during the relevant periods. In addition, as discussed below, the United States Supreme Court noted the rapid increase in Opposer's advertising during the period between 1900 and 1920 in *Coca-Cola Co. v. Koke Co.*, 254 U.S. 143, 146 (1920), and in 1972, a federal district court discussed Opposer's widespread "advertising of all kinds" in *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 175 USPQ 56, 57-58 (E.D.N.Y. 1972).

Inc. v. Makarczyk, 110 USPQ2d 2013, 2020-21 (TTAB 2014) (advertising expenditures of \$275 million between 2000-2007 and \$200 million between 2009-2012 found to be substantial and to support a finding that the opposer's CHANEL mark was famous); *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1026 (TTAB 2011) (advertising expenditures of approximately \$6 billion over a 20-year period were "extensive and widespread" and supported a finding that the opposer's JUST DO IT mark was famous); *Nat'l Pork Bd.*, 96 USPQ2d at 1495 (expenditures of more than \$25 million annually, and more than \$550 million dollars total, over a 20-year period of use of the opposer's mark THE OTHER WHITE MEAT supported a finding that the mark was famous). When Opposer's 2015-2018 figures are considered against the backdrop of its advertising and promotion of goods bearing the Coca-Cola Script Mark for the preceding 100-plus years, including the expenditures discussed in the cases noted above, the first factor strongly supports a finding that the Coca-Cola Script Mark is famous.

2. The Amount, Volume, and Geographic Extent of Sales of Goods Under the Coca-Cola Script Mark

No one living today had been born when Opposer first sold products bearing a form of the Coca-Cola Script Mark in 1887. Kibe Decl. ¶ 6. The first federal registration of a form of the Coca-Cola Script Mark issued in 1893 for "tonic beverages," Kibe Decl. ¶ 8, and subsequent registrations of the Coca-Cola Script Mark for "beverages and syrups for the manufacture of beverages" and "soft drinks" issued in 1928 and 1983, respectively. Kibe Decl. ¶ 8. Registrations of the Coca-Cola Script

Mark for numerous other goods, including clothing, issued in the 1980s. Kibe Decl. ¶ 9.

The record is replete with evidence of the historical use of the Coca-Cola Script Mark. We depict below a few examples of use of the mark in connection with soft drinks, apparel, and other goods:



Kibe Decl. ¶ 13; Ex. B (18 TTABVUE 22) (1900s bottle).



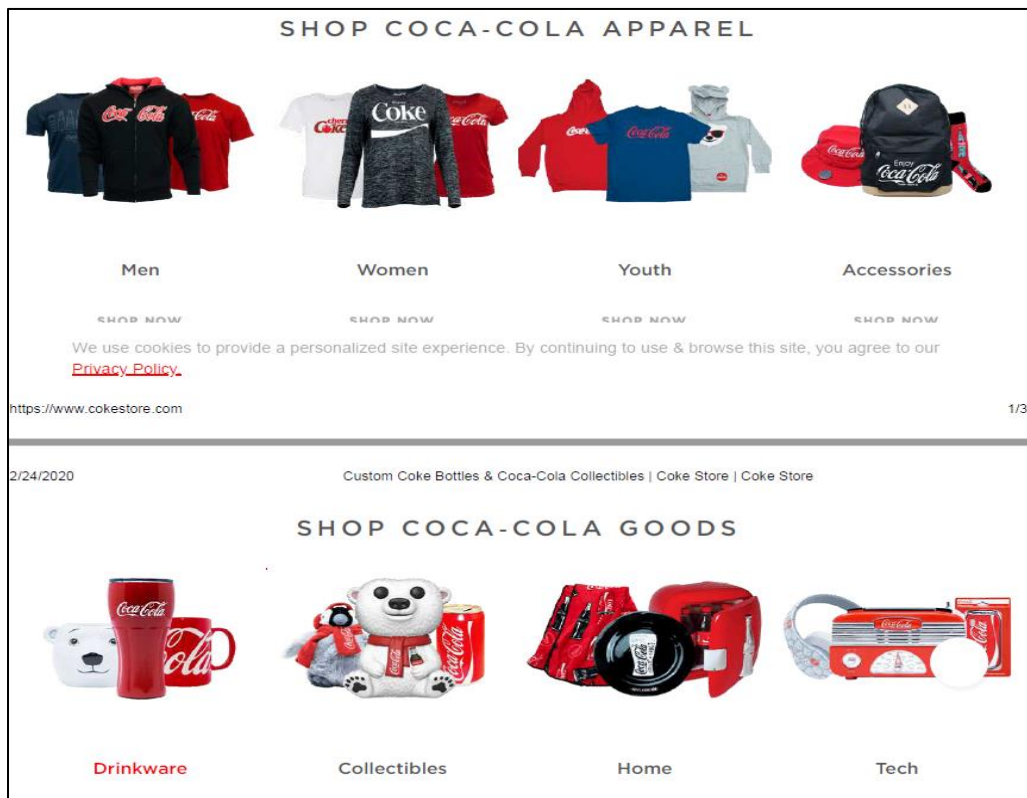
Kibe Decl. ¶ 13; Ex. G (18 TTABVUE 37) (1950s advertisement).



Kibe Decl. ¶ 13; Ex. L (18 TTABVUE 52) (2000s cooler).



Kibe Decl. ¶ 18; Ex. R (18 TTABVUE 137) (current product packaging).



Kibe Decl. ¶ 19; Ex. S (18 TTABVUE 140-41) (branded merchandise).

Mr. Kibe testified that it “is also difficult to state with accuracy the total volume of historical sales of products bearing the Coca-Cola Script Mark.” Kibe Decl. ¶ 26. He again provided figures only for the period 2015-2019, during which Opposer’s annual revenues from the sale of beverages bearing the Coca-Cola Script Mark in the United States exceeded \$1.8 billion, Opposer’s annual total net revenues from the sale of apparel and other non-beverage products bearing the Coca-Cola Script Mark in the United States exceeded \$150 million, and Opposer’s total net revenues from the sale of all products bearing the Coca-Cola Script Mark in the United States exceeded \$10 billion. Kibe Decl. ¶ 26.

As in the case of their advertising expenditure counterparts, these sales figures are enormous even for the short period between 2015 and March 2018,⁹ and they too compare favorably with sales figures in cases in which the Board has found marks to be famous. *See, e.g., Nike*, 100 USPQ2d at 1026 (net retail sales of clothing bearing the opposer's JUST DO IT mark of approximately \$175 million for the period between 1989 and 2011 supported a finding that the mark was famous). When Opposer's sales figures for 2015-2018 are considered against the backdrop of Opposer's historical sales since the late 19th Century, the second factor also strongly supports a finding that the Coca-Cola Script Mark is famous.

3. The Extent of Actual Recognition of the Coca-Cola Script Mark

“Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used.” *TiVo Brands*, 129 USPQ2d at 1104 (quoting *Nike*, 100 USPQ2d at 1024). Opposer offers no direct evidence of the extent of actual recognition of the Coca-Cola Script Mark, such as a survey, but “[u]nsolicited media attention and advertising by third parties may be considered . . . under factor three, the extent of actual recognition of the mark.”). *Id.*;

⁹ In 1920, the Supreme Court found that “[s]ince 1900 the sales have increased at a very great rate corresponding to a like increase in advertising.” *Koke Co.*, 254 U.S. at 146. In 1966, the Board found that between 1923 and 1964, Opposer's sales “exceeded three billion gallons.” *Davis Bottling*, 152 USPQ at 339. In 1972, the Board found that between 1923 and 1969, Opposer's domestic sales “exceeded four billion gallons.” *Triple “AAA” Co.*, 173 USPQ at 55. In 1973, the Board found that Opposer's total historical sales “have amounted to more than 6,000,000,000 gallons.” *Seven-Up Co.*, 178 USPQ at 310.

see also Nike, 100 USPQ2d at 1024-26 (discussing media references to and brand rankings of the JUST DO IT mark).

Opposer made of record a number of unsolicited media articles discussing the Coca-Cola Script Mark. Kibe Decl. ¶¶ 16-17; Exs. P-Q. One 2014 article on the website of bebrilliant.com entitled “Iconic Brands & Brilliant Experiences-Part 2: Coca-Cola” begins as follows: “The bold red script with its gentle curves. You recognize that logo right away. Even if you don’t drink Coke.” Kibe Decl. ¶ 16; Ex. P (18 TTABVUE 88). This article, which describes itself as the second part of a five-part series on iconic brands, discusses the history of the mark and states that the elegant penmanship of Opposer’s co-founder Frank Robinson, who developed the Coca-Cola Script Mark, “is still a classic to customers 127 years later.” 18 TTABVUE 89.

A 2015 blog article on the website of fineprintart.com entitled “History of the Coca Cola Logo” begins as follows:

The Coca Cola Company has earned the distinctive privilege of owning probably the world’s most widely recognized brand. Whether written in a serif font, script or a completely different language, there is no mistaking the look and feel of that logo. While it has morphed into various iterations throughout its lifetime, there is a classic quality to this logo that has never gone away, a timeless trait which has no doubt helped the company build the global brand recognized by billions today.

Id. at 109. The article discusses the development of the Coca-Cola Script Mark and states that when the time came to display the COCA-COLA mark in a stylized manner, Frank Robinson’s “excellent penmanship skills would pay off in the form of the script logo that we are all familiar with.” *Id.* at 110. The article displays and discusses various versions of the Coca-Cola Script Mark and its registration in the

USPTO, *id.* at 110-20, and concludes that “[i]t’s amazing how the creative vision of two people can create something so globally ubiquitous. And it’s even more telling that, despite how many visual remixes it’s undergone, the essence of the brand has remained the same over the span of a century.” *Id.* at 120.

A November 21, 2005 article on the website of creativebloq.com entitled “Design Icon: Coca-Cola” begins as follows: “Coca-Cola’s famous logo is widely regarded as the most successful brand in the world.” *Id.* at 122. It continues that “Coca-Cola possesses one of the most recognized brand designs in history.” *Id.* The article discusses the history of the Coca-Cola Script Mark and states that as of 2005, “the brand is regarded as the biggest in the world and has come top of an Interbrand poll of all global brands for the fourth time in a row.” *Id.* The article discusses what it describes as “urban myths” regarding hidden meanings of the Coca-Cola Script Mark, and states that “[w]idely debunked though these rumours are, the power of the brand makes it an easy target for such mythology.” *Id.*

The Coca-Cola Script Mark is listed on the website famouslogos.net. *Id.* at 124. The accompanying article states that “Coca-Cola is probably the most widely known and valuable trademark in the world,” *id.*, and that the “Coca-Cola logo, much like the beverage itself, is widely regarded as one of the greatest and most instantly recognizable logos ever created.” *Id.*

Coca-Cola was listed as the most valuable soft drink brand in a 2019 Brand Finance Ranking, *id.* at 129, and as the sixth most valuable worldwide brand, and

the only non-tech brand in the top seven, in Forbes' survey of The World's Most Valuable Brands 2018. *Id.* at 133.

The Coca-Cola Script Mark has also been recognized by courts and the Board as famous. More than 100 years ago, the Supreme Court stated that "[w]hatever may have been its original weakness, the mark for years has acquired a secondary significance and has indicated the plaintiff's product alone." *Koke Co.*, 254 U.S. at 145. The Court further noted that "[s]ince 1900 the sales have increased at a very great rate corresponding to a like increase in advertising," and that "[t]he name now characterizes a beverage to be had at almost any soda fountain" and "means a single thing coming from a single source, and well known to the community." *Id.* at 146.

Nearly 50 years ago, the district court in the *Gemini Rising* case preliminarily enjoined the sale of a poster that the court described as "an exact blown-up reproduction of plaintiff's familiar 'Coca-Cola' trademark and distinctive format except for the substitution of the script letters 'ine' for '-Cola', so that the poster reads 'Enjoy Cocaine.'" *Gemini Rising*, 175 USPQ at 57. The court found that "[s]ince the original registration [of the Coca-Cola Script Mark] in 1893 plaintiff has displayed the trademark 'Coca-Cola' in distinctive stylized script lettering with the lower portion of the 'C' in 'Coca' extending under the remaining letters in the form of a curved dash." *Id.* The court found that the Coca-Cola Script Mark had been "widely presented to the public in white lettering against a bright red background in advertising of all kinds, *e.g.*, magazines, newspapers, billboards, display materials, television, truck panels and the like," *id.* at 57-58; that "'Coca-Cola' has been

described as ‘one of the three most-recognized trademarks in the world,’” *id.* at 57 n.1 (quoting THE BUSINESS LAWYER, Nov. 1971, at 309 n.51); that the Supreme Court had recognized the strength of the mark in 1920 in the *Koke Co.* case, *id.*; and that when consumers viewed the poster, “one would have to be a visitor from another planet not to recognize immediately the familiar ‘Coca’ in its stylized script and accompanying words, colors, and design.” *Id.* at 58.

The Board has also characterized Opposer’s mark as famous in cases in which the mark was not even involved. In *Bos. Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581 (TTAB 2008), the Board discussed the *Gemini Rising* case, and distinguished that case from the one before it, in part because in *Gemini Rising*, “the defendant’s mark not only contained the same script and color as the famous COCA-COLA mark, but some of the same wording.” *Id.* at 1592. In *Eurostar, Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1275 (TTAB 1994), a concurring opinion discussed a hypothetical in which an “applicant seeks to register a mark for juice drinks that is strikingly similar to the long registered and very famous mark COCA-COLA.”

The record shows that there has been substantial third-party recognition of the Coca-Cola Script Mark over an extended period of time. The third factor supports a finding that the Coca-Cola Script Mark is famous.

4. Registration of the Coca-Cola Script Mark

The Coca-Cola Script Mark has been registered under three different historical iterations of the United States Trademark Act. It was first registered for tonic beverages in 1893 “under the Act of March 3, 1881,” Trademark Act Section

43(c)(2)(A)(iv), and was later registered in 1928 under “the Act of February 20, 1905,” *id.*, for “[b]everages and syrups for the manufacture of such beverages,” and those registrations are valid and subsisting. 16 TTABVUE 8-18 (Second Not. of Reliance Exs. C-D). It has also been registered on the Principal Register under the 1946 Lanham Act in one form or another for soft drinks, syrups, and numerous other goods, including clothing. *Id.* at 40-133 (Second Not. of Reliance Exs. F-M). This factor supports a finding that the Coca-Cola Script Mark is famous.¹⁰

5. Conclusion Regarding Fame

All of the non-exclusive factors set forth in Section 43(c)(2)(A) of the Trademark Act support a finding that the Coca-Cola Script Mark is a distinctive mark that became extremely famous long ago and remains so today.¹¹

¹⁰ Opposer must show that the Coca-Cola Script Mark is not only famous, but distinctive. *Coach Servs.*, 101 USPQ2d at 1723-24. The Coca-Cola Script Mark in Opposer’s multiple registrations, 17 TTABVUE 8-133, “registered on the Principal Register as an inherently distinctive mark without resort to Section 2(f) or subject to a disclaimer,” and each registration “is over five years old [and] not subject to challenge under Trademark Act § 2(e).” *TiVo Brands*, 129 USPQ2d at 1112. But even if the Coca-Cola Script Mark lacked inherent distinctiveness when it was first used, it acquired distinctiveness long ago as a result of extensive sales and advertising of goods bearing the mark. Indeed, as discussed above, the Supreme Court opined that the mark had acquired distinctiveness by 1920. *Koke Co.*, 254 U.S. at 145.

¹¹ Applicant’s claim that recognition of the Coca-Cola Script Mark “is of limited strength, and is declining rapidly,” 27 TTABVUE 12, is based solely on the argument of its counsel, which is “no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). *See also In re Simulations Publ’ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (“Statements in a brief cannot take the place of evidence.”) The record shows that Opposer’s sales and advertising activities have not abated recently, and that the Coca-Cola Script Mark is no less famous now than it has been historically. *Cf. TiVo Brands*, 129 USPQ2d at 1117 (noting that “the majority of Opposer’s evidence is from the years before 2010, and while it is consistent with a finding that the fame of Opposer’s mark TIVO has continued to the present, we infer that the degree of consumer recognition has somewhat weakened over time.”).

B. Applicant's Use of the Allegedly Diluting Mark in Commerce

Opposer must show that Applicant is using a mark in commerce that dilutes the famous Coca-Cola Script Mark. *N.Y. Yankees*, 114 USPQ2d at 1501-02. “Under the 1999 amendments to the Federal Trademark Dilution Act, we held that an application based on intent to use a mark in commerce under Trademark Act Section 1(b) satisfied the commerce requirement.” *Id.* at 1505 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001)). “The Trademark Dilution Revision Act of 2006 (TDRA) does not change this result.” *Id.* at 1505-06 (citing *Chanel*, 110 USPQ2d at 2023 (holding that an opposer asserting a dilution claim in a Board proceeding against an application based on an allegation of actual use in commerce pursuant to Section 1(a) may prove applicant's use in commerce by direct evidence or rely on the application filing date as the date of constructive use)). Opposer has satisfied this element of its dilution by blurring claim. *Id.* at 1506.

C. The Fame of Opposer's Mark Prior to Applicant's First Use of His Mark

Opposer must show that its Coca-Cola Script Mark became famous before Applicant “commence[d] use of a mark . . . in commerce that is likely to cause dilution by blurring” 15 U.S.C. § 1125(c)(1). Applicant's application was filed on March 6, 2018, which represents Applicant's constructive date of first use of his mark in commerce under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c) (contingent on registration, the “filing of the application to register [a] mark shall constitute constructive use of the mark”). In response to Opposer's Interrogatory No. 5 requesting Applicant to “[s]tate the date on which Applicant first used each of

Applicant's Alleged Marks and describe the way(s) in which the marks were used on such dates," Applicant responded that he "utilized the Mark for the first time in August of 2015, by creating hand-made sketches of the Mark." 16 TTABVUE 8. Applicant's creation of a sketch of the mark does not constitute use of the mark earlier than his constructive use filing date. Accordingly, Opposer must show that its Coca-Cola Script Mark became famous before Applicant's March 6, 2018 filing date. Opposer easily satisfies this requirement for the reasons discussed above in connection with our analysis of the fame of the Coca-Cola Script Mark.

D. Whether Applicant's Mark is Likely to Cause Dilution

"[D]ilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner." *N.Y. Yankees*, 114 USPQ2d at 1506 (citing *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011)).

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

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

Id. (quoting 15 U.S.C. § 1125(c)(B)(i)-(vi)).

In weighing the record evidence, “some of these statutory dilution factors may be given more weight than others, depending on the evidence of record.” *Omega SA v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (citing *Citigroup Inc. v. Capital City Bank Grp.*, 94 USPQ2d 1645, 1667 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)).

1. The Degree of Similarity Between the Marks

“[A]n important question in a dilution case is whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *N.Y. Yankees*, 114 USPQ2d at 1506 (quoting *Nat’l Pork Bd.*, 96 USPQ2d at 1497). We do not conduct a Section 2(d) likelihood of confusion analysis of the similarity or dissimilarity of the marks, but “we still consider the degree of similarity or dissimilarity of the marks in their entirety as to appearance, connotation, and commercial impression.” *Id.* (citing *Research in Motion*, 102 USPQ2d at 1198). “In the dilution context, ‘the similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.’” *TiVo Brands*, 129 USPQ2d at 1115 (quoting *Nike*, 100 USPQ2d at 1029).¹²

¹² “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

Opposer argues in the dilution section of its main brief that the parties' "marks are similar in their overall impressions; Applicant's alleged mark unquestionably will cause consumers to 'conjure up' [the] famous COCA-COLA Script Mark, and 'associate the two.'" 26 TTABVUE 37-38 (quoting *N.Y. Yankees*, 114 USPQ2d at 1507). Elsewhere in its main brief, Opposer argues that

The primary element of Mr. Hoff's graphic—the phrase "Conceal-Carry" in Spencerian script—is a blatant imitation of the COCA-COLA Script Mark. . . . Like "Coca-Cola," the "Conceal-Carry" element consists of two words, each of which begins with the letter "C," separated by a hyphen. The "Conceal-Carry" graphic includes each of the three Distinctive Capital C Elements of the COCA-COLA Script Mark, i.e., (a) the long "tail" on the "C" in "Conceal," which mimics the "C" in "Coca," extends below the remaining letters of "Conceal" and includes two distinctive points towards the end of the "tail"; (b) the distinctive loop and swirl element at the top of the "C" in "Carry," which mimics the "C" in "Cola" and extends over the remaining letters of "Carry"; and (c) the distinctive lower portion of the "C" in "Carry" that, like the "C" in "Cola," includes two distinctive points. Mr. Hoff's alleged mark also includes, below the "Conceal-Carry" element, the phrase "Registered Handgun"—which mimics the "Trade-Mark Registered" legend that TCCC has historically used in a similar manner, below the COCA-COLA Script Mark.

Id. at 25 (citations omitted).

Applicant responds that

[T]he degree of similarity between the Opposer's Mark and the Applicant's Mark is negligible. Specifically, applicant emphasizes that the Applicant's Mark CONCEAL-CARRY REGISTERED HANDGUN comprises of [sic] four words, whereas the Opposer's Mark comprises of [sic] two words

mark at issue is no longer the standard for dilution by blurring; rather, the amended statutory language refers only to 'degree of similarity.'" *UMG Recordings*, 100 USPQ2d at 1888 (citations omitted).

COCA-COLA. The explicit, or literal meaning of these two marks is completely disassociated. Moreover, the words in the Opposer's Mark have nothing in common with the words in the Applicant's Mark, they do not have a similar meaning, nor do they possess the same, or even similar, cultural or emotional association.

27 TTABVUE 12.

For ease of reference in following our analysis under this factor, we reproduce below the Coca-Cola Script Mark and Applicant's mark:¹³



The visual similarity between the two marks is obvious and striking. The unique, instantly-recognizable stylization of the Coca-Cola Script Mark is replicated slavishly in Applicant's mark. As in the Coca-Cola Script Mark, Applicant's mark contains two two-syllable words that begin with the letter "C," and that are joined by a hyphen. The words "Conceal-Carry" are positioned relative to each another in almost exactly the same manner in which the words "Coca-Cola" are positioned relative to each other in the Coca-Cola Script Mark.

The words in the two marks are obviously different, but all of the words in Applicant's mark have been disclaimed because they are non-source identifying.

¹³ A side-by-side comparison of the marks would be inappropriate in an analysis of their similarity or dissimilarity for purposes of likelihood of confusion, *see, e.g., In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), but we may employ it for purposes of assessing the degree of their similarity on Opposer's dilution claim. *N.Y. Yankees*, 114 USPQ2d at 1507 (considering the involved marks side-by-side).

Without its stylization, Applicant's mark effectively would be no mark at all, and the visual identity of the script in Applicant's mark to the script in the Coca-Cola Script Mark is thus the critical driver of the similarity of the marks in appearance, particularly when Applicant's mark is viewed on a garment when it is worn.

In *N.Y. Yankees*, the Board considered a dilution by blurring claim brought by the New York Yankees against the design mark show below on the left based on the two composite word-and-design marks shown below on the right:



The Board found that “[t]he overall similarity between the two design marks is immediately apparent.” *N.Y. Yankees*, 114 USPQ2d at 1507. The Board “acknowledge[d] that there are significant differences between the marks, the most obvious being that Applicant’s mark replaces Opposer’s bat with a syringe and its round baseball design with the round universal prohibition symbol” and that “Applicant’s top hat is slightly different in shape, bigger relative to the rest of the design, and extends outside the circle, while Opposer’s top hat lies within the circle. Opposer’s primary logo also includes the word ‘Yankees.’” *Id.* The Board stated that “[n]onetheless, when considered in their entirety, we find that the appearance of

the marks overall is sufficiently similar that Applicants mark will ‘trigger consumers to conjure up’ Opposer’s famous mark.” *Id.*

We similarly find here that “consumers encountering Applicant’s mark will immediately be reminded of Opposer’s famous [Coca-Cola Script Mark] and associate the two.” *Id.* This factor supports a finding of a likelihood of dilution by blurring.

2. The Degree of Distinctiveness of the Coca-Cola Script Mark

As discussed above, the multiple registrations of the Coca-Cola Script Mark all issued over the years without the requirement of a showing of acquired distinctiveness, indicating that the mark is inherently distinctive for all of the goods for which it is registered. But “[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding that the mark has high acquired distinctiveness. This factor favors a likelihood of dilution.” *Id.*

3. The Extent of Exclusive Use of the Coca-Cola Script Mark

There is no requirement that the use of a famous mark be absolutely exclusive for its owner to prevail on a dilution by blurring claim, but evidence of the substantially exclusive use of a famous mark is probative of the likelihood that the mark will be diluted by blurring through the use of the same or a similar mark. *See, e.g., McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1289-90 (TTAB 2014).

There is no record evidence of any third-party use of any mark similar to the Coca-Cola Script Mark, and we find that Opposer is making at least substantially exclusive use of the mark, which supports a finding of a likelihood of dilution by blurring.

4. The Degree of Recognition of the Coca-Cola Script Mark

“This factor requires a determination as to the level of fame, which we approach from the perspective of a sliding scale; the likelihood of an association between the famous mark and the defendant’s mark thus becomes proportional to the extent of the mark’s fame.” *TiVo Brands*, 129 USPQ2d at 1117. As discussed above, the Coca-Cola Script Mark became extremely famous long ago, and has been recognized as such in brand rankings, articles regarding famous marks, and several judicial decisions, including ones in 1920 and 1972. This factor supports a finding of a likelihood of dilution by blurring.

5. Whether Applicant Intended to Create an Association With the Coca-Cola Script Mark

In its main brief, Opposer argues that “Applicant’s apparent copying of the COCA-COLA Script Mark and its Distinctive Capital C Elements shows Applicant’s intent to create an association between his mark and the COCA-COLA Script Mark, and to trade on the goodwill of TCCC and the COCA-COLA Script Mark.” 26 TTABVUE 38.

In his brief, Applicant “emphasizes he did not create the Applicant’s Mark in attempt to create an association with the Opposer’s mark” or to “tarnish the reputation of the Opooser’s [sic] Mark.” 27 TTABVUE 12. He further argues that his mark “was created to place emphasis on legal, and responsible practice of carrying a handgun or other weapon in public, and on continuation of the campaign design [sic] to make everyone aware of the ongoing erosion of our constitutional rights, such as the Second Amendment to the United States Constitution.” *Id.*

In its reply brief, Opposer argues that Applicant's response to Opposer's dilution claim "is yet another unsupported passage of three sentences regarding Applicant's creation of his mark that have no basis in the record." 28 TTABVUE 19. Opposer argues that "[i]f Applicant wished to share, in an admissible way, some statements regarding why and how he claims to have created his mark, he had every opportunity to do so during his trial testimony period," and that "[h]is brief on the merits is not the place to do so for the first time." *Id.* at 20.

As noted above, arguments of counsel are no substitute for evidence, and we must examine the record as a whole to determine whether there is evidence supporting either party's position on Applicant's intent. Applicant points to no evidence supporting his counsel's arguments, and Opposer points to no direct evidence of Applicant's intent to associate his mark with the Coca-Cola Script Mark, such as testimony, documents,¹⁴ or admissions made in discovery.¹⁵ In the absence of such

¹⁴ Request No. 3 in Opposer's First Set of Requests for Production of Documents sought the production of all documents "concerning Applicant's selection and adoption of Applicant's Alleged Marks including, without limitation, documentation of meetings or discussions concerning the design, selection and adoption of Applicant's Alleged Marks, documentation concerning the reasons for selecting Applicant's Alleged Marks, and documentation concerning the consideration of any alternatives to Applicant's Alleged Marks." 16 TTABVUE 23. Applicant responded that "[d]ocuments addressing the above-defined content(s) do not exist." *Id.*

¹⁵ Interrogatory No. 4 in Opposer's First Set of Interrogatories asked Applicant to "describe the rationale behind Applicant's selection and adoption of Applicant's Alleged Marks." 16 TTABVUE 8. Applicant responded that he "was intrigued by the recent changes to Illinois' concealed carry gun laws, and believed that said change will spur the sale of his products (t-shirts and sweatshirts)." *Id.* Interrogatory No. 8 asked Applicant to "[d]escribe the overall connotation or meaning of Applicant's Alleged Marks when used in connection with Applicant's Goods and Services." *Id.* at 9. Applicant responded that "[t]he Mark, CONCEAL CARRY REGISTERED HANDGUN, was designed to express the support for the Second Amendment of the United States Constitution, and the stemming therefrom laws permitting concealed carry of registered handguns." *Id.* These responses neither support Opposer's claim that Applicant intended to associate his mark with the Coca-Cola Script

direct evidence, however, Applicant's intent may be inferred from his slavish copying of elements of the Coca-Cola Script Mark.

There were countless ways in which Applicant could have displayed the words "Conceal Carry" on his goods to communicate his claimed messages regarding gun rights, but he chose to display those words in a script that we have found above immediately conjures up the famous Coca-Cola Script Mark, particularly from the vantage point of observers of the goods when they are worn. There is no credible explanation for this choice by Applicant other than a desire to have his mark stand out because of its striking similarity to the famous Coca-Cola Script Mark.

Applicant's mark also notably contains the two-syllable word "Conceal," not the three-syllable word "Concealed," in the hyphenated phrase "Conceal-Carry," giving those words the same syntactic structure as the words "Coca-Cola" in the Coca-Cola Script Mark. The phrase "concealed carry," rather than "conceal carry," appears to be the term of art in gun legislation, as evidenced by Applicant's references in his discovery responses to "recent changes to Illinois' concealed carry gun laws," 16 TTABVue 8 (Applicant's Response to Opposer's Interrogatory No. 4), and "laws permitting concealed carry of registered handguns." *Id.* at 10 (Applicant's Response to Opposer's Interrogatory No. 8). The pertinent Illinois statute is one entitled "Firearm Concealed Carry Act." 430 ILCS 66. Applicant's choice of the hyphenated

Mark nor the contrary argument of Applicant's counsel. Applicant's responses were not made under oath or signed by Applicant, as required under Rules 33(b)(3) and (5) of the Federal Rules of Civil Procedure, but Opposer did not object to them on either basis, so we have considered them.

phrase “Conceal-Carry” is explicable only by his desire to make the phrase mimic its counterpart “Coca-Cola” in the Coca-Cola Script Mark.

Applicant’s mark also contains the block letter term “REGISTERED HANDGUN,” which Mr. Kibe testified mimics Opposer’s historical uses of the terms “Trade-Mark Registered” and “Reg. U.S. Pat. Off.” below the Coca-Cola Script Mark, Kibe Decl. ¶ 33, as shown above on the document entitled “Evolution of the Coca-Cola Trademark” and as shown below on a bottle from the 1910s. Kibe Decl. Exs. C, O (18 TTABVUE 25, 83):



18 TTABVUE 25.¹⁶

Like his selection of Spencerian script and his use of the awkward hyphenated term “Conceal-Carry,” Applicant’s inclusion of the word REGISTERED in his mark is “eyebrow-raising,” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1063 (TTAB 2017), because it appears to be completely gratuitous. Applicant provides no evidence that handguns are “registered,” and there appears to be no requirement under Illinois’ Firearm Concealed Carry Act, which Applicant claimed in discovery was the inspiration for his mark, that a handgun be “registered” to permit its owner to engage in concealed carry.¹⁷ The only credible explanation for Applicant’s inclusion of the term REGISTERED in his mark is that he intended to use the term to reinforce the association of the mark as a whole with the famous Coca-Cola Script Mark.

Finally, Mr. Kibe testified that Opposer “has also consistently used the Coca-Cola Script Mark in the color red. My own experience and the historical records of the Company confirm that [Opposer’s] use of the Coca-Cola Script Mark in red and white has been ubiquitous, consistent and sustained for many decades.” Kibe Decl. ¶ 11. His testimony is corroborated by multiple examples, shown and discussed above, of

¹⁶ Other and more recent uses of these registration legends are shown and discussed in Kibe Decl. Ex. P (18 TTABVUE 93-117).

¹⁷ The Act instead requires that a person be licensed to carry a concealed handgun. 430 ILCS 66/5 (defining “License” as “a license issued by the Department of State Police to carry a concealed handgun” and “Licensee” as “a person issued a license to carry a concealed handgun”).

the historical use of the colors red and white in the display of the Coca-Cola Script Mark.

Applicant also chose to display his mark in white against a red background on half of the handful of garments that he has offered for sale on eBay:



19 TTABVUE 12.



16 TTABVUE 32.

Applicant's choices regarding the elements of his mark and their display culminate in his mark's striking resemblance to the Coca-Cola Script Mark on these garments, and make the conclusion that Applicant intended his mark to be associated

with the famous Coca-Cola Script Mark inescapable. “We therefore find that [A]pplicant is attempting to trade on the goodwill and fame generated by the [Coca-Cola Script Mark] mark in order to promote and market his own [goods]. As such, this dilution factor also favors [O]pposer.” *Chanel*, 110 USPQ2d at 2026.

6. Actual Association Between the Marks

There is no evidence of any actual association between Opposer’s Coca-Cola Script Mark and Applicant’s mark. Applicant’s application was filed on an intent-to-use basis, however, and Applicant admitted in discovery that “[a]s of August 7, 2019, Applicant has not recorded any sales of product bearing the Mark.” 16 TTABVue 6 (Applicant’s Response to Opposer’s Interrogatory No. 2). “Thus, there has been a limited opportunity for the public to make any actual association between the parties’ design marks. We find this factor to be neutral.” *N.Y. Yankees*, 114 USPQ2d at 1509.

7. Conclusion Regarding Likelihood of Dilution Factors

All of the factors that we have considered weigh in favor of a finding of a likelihood of dilution by blurring, with the exception of the sixth factor, which is neutral. The marks are strikingly similar in appearance, particularly from the standpoint of an observer of Applicant’s goods when they are worn; the Coca-Cola Script Mark is highly distinctive and there is no evidence that Opposer has not made substantially exclusive use of it; the Coca-Cola Script Mark has long had a very high degree of public recognition; and there is no doubt that Applicant intended to associate his mark with the Coca-Cola Script Mark. The factors collectively strongly support a finding of the likelihood of dilution by blurring.

“The statute requires opposer to prove impairment of the distinctiveness of opposer’s famous mark.” *Chanel*, 110 USPQ2d at 2026. Mr. Kibe testified that although Opposer often takes public positions on issues of public interest, Kibe Decl. ¶ 28, it “has not to date taken a position on any issues relating to firearms, gun control or the Second Amendment.” Kibe Decl. ¶ 29. He expressed Opposer’s concern that if it “was incorrectly associated with a position that TCCC had not adopted or with which TCCC did not agree, TCCC would lose control of at least a portion of its goodwill and reputation that the Coca-Cola Script Mark symbolizes, especially with consumers who do not agree with the position.” Kibe Decl. ¶ 29.

Opposer’s concerns are legitimate. There is a fervent debate in the United States between proponents of gun rights, such as Applicant, and proponents of limitations on those rights. In that debate, Opposer, like Applicant, has the right to take one side or the other, or not to participate at all. We have found above, however, that Applicant’s mark will immediately conjure up Opposer’s famous Coca-Cola Script Mark, resulting in the association of Opposer with a particular position in the minds of purchasers and observers of Applicant’s clothing.¹⁸ Even if that association is ephemeral for some persons, it compromises Opposer’s ability to exercise exclusive control over the goodwill symbolized by the Coca-Cola Script Mark. For members of the public who have been exposed to Applicant’s mark, Opposer may appear to be a

¹⁸ Applicant does not claim that his mark is intended to “parody or to make any type of social commentary regarding opposer, opposer’s famous mark, or opposer’s goods. Instead, [he] is seeking to use [his] mark for . . . social commentary, and attempt[s] to take a ‘free ride’ on the mark’s association with the famous mark for economic gain,” and to amplify his pro-gun message. *Nike*, 100 USPQ2d at 1031.

hypocrite if it later elects to take the opposite position in the gun rights debate or simply remains neutral.

On the basis of the record as a whole, we find that Opposer has shown, by a preponderance of the evidence, that Applicant's use and registration of his mark is likely to dilute by blurring the distinctiveness of the famous Coca-Cola Script Mark.

Decision: The opposition is sustained on the basis of Opposer's dilution claim.¹⁹

¹⁹ Because we have found for Opposer on its dilution claim, we need not decide its likelihood of confusion claim. *TiVo Brands*, 129 USPQ2d at 1118 (citing *N.Y. Yankees*, 114 USPQ2d at 1512).