

This Opinion Is Not a
Precedent of the TTAB

Mailed: November 30, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

Advance Magazine Publishers Inc.

v.

Brenda Joan Hollifield

—
Opposition No. 91247611
Cancellation No. 92072531¹
—

Jordan LaVine and Eric R. Clendening of Flaster Greenberg PC for Advance Magazine Publishers Inc.

Sandra P. Thompson of Finlayson Toffer Roosevelt & Lilly LLPP for Brenda Joan Hollifield.

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Before Kuhlke, Cataldo and Allard, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

¹ These proceedings were consolidated in a July 24, 2020 interlocutory order. 13 TTABVUE 8-9. References to the trial history, record and briefs will be to the parent Opposition No. 91247611 unless otherwise noted.

Defendant Brenda Joan Hollifield voluntarily surrendered her Registration No. 5413139, subject of previously consolidated Cancellation No. 92072499, without the written consent of Plaintiff Advance Magazine Publishers Inc. 19 TTABVUE. The Board consequently entered judgment against Defendant as to that registration. 20 TTABVUE.

References to trial record and briefs refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020).

Brenda Joan Hollifield (Defendant or Hollifield) is the owner of application Serial No. 86354391 on the Principal Register for the mark VOGUE VEGAN (in standard characters, “VEGAN” disclaimed) identifying the following goods: “Cosmetics and cosmetic preparations; Cosmetics and make-up; Cosmetics in general, including perfumes; all of the aforementioned goods containing no animal products or by-products,” in International Class 3;² and Registration No. 4811170 issued on the Principal Register for the mark VOGUE VEGAN (in standard characters, “VEGAN” disclaimed) identifying the following services: “Personal shopping for others who want goods containing no animal products or by-products; Personal wardrobe styling services for vegans or those who do not want to wear goods containing animal products or by-products,” in International Class 45.³

Advance Magazine Publishers Inc. (Plaintiff or Advance) opposes registration of Defendant’s application Serial No. 86354391 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Defendant’s mark VOGUE VEGAN for the identified goods so resembles Plaintiff’s previously used VOGUE and VOGUE – formative marks for a variety of goods and services in the field of fashion to be likely to cause confusion among consumers as to the source of the goods and services; and that Defendant’s VOGUE VEGAN mark is likely to dilute by blurring with or

² Filed on July 31, 2014 under Trademark Act Section 1(b); 15 U.S.C. 1051(b) asserting Applicant’s bona fide intent to use the mark in commerce.

³ Issued on September 15, 2015. Section 8 affidavit received; Section 15 affidavit acknowledged.

tarnishment of Plaintiff's famous VOGUE and VOGUE – formative marks under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).⁴

Plaintiff has petitioned to cancel Registration No. 4811170 on the grounds of fraud and abandonment.⁵

Defendant, in her answers, denied the salient allegations in the notice of opposition⁶ and petition for cancellation.⁷ In addition, Defendant asserted as counterclaims that her Registration No. 4811170 “has priority” over Plaintiff's pleaded Reg. Nos. 5069495 for the mark VOGUE RUNWAY, 5904850 for the mark VOGUEWORLD, and 6479563 for the mark VOGUE WEDDINGS.⁸ Defendant also asserts that the “word VOGUE on its own is not distinctive and multiple marks owned by multiple parties, which contain the word VOGUE, exist in commerce.”⁹

In its answer to the counterclaim, Plaintiff denied the salient allegations of both claims.¹⁰

⁴ 1 TTABVUE.

⁵ 1 TTABVUE in Cancellation No. 92072531.

⁶ 4 TTABVUE.

⁷ 14 TTABVUE 1-4 in Cancellation No. 92072531. Defendant asserted certain matters as affirmative defenses, (14 TTABVUE 4-5 in Cancellation No. 92072531) but did not pursue them at trial. Accordingly, they are deemed forfeited. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff'd* 565 F. Appx. 900 (Fed. Cir. 2014).

⁸ 14 TTABVUE 6 in Cancellation No. 92072531.

⁹ 14 TTABVUE 6-7 in Cancellation No. 92072531.

¹⁰ 18 TTABVUE in Cancellation No. 92072531. Plaintiff, as counterclaim defendant, asserted certain matters as affirmative defenses, (18 TTABVUE 4 in Cancellation No. 92072531) but did not pursue them at trial. Accordingly, they are deemed forfeited. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d at 1753 .

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Defendant's application and registration files.¹¹

Plaintiff introduced the following testimony and evidence.

1. Plaintiff's 1st Notice of Reliance upon the following federal trademark registrations owned by Plaintiff:¹²

- Registration No. 3069976, registered on March 21, 2006, for the trademark **VOGUE** for "providing information about beauty via a global computer network" in International Class 44 and "providing information about fashion via a global computer network" in Class 45. The date of first use of the mark in commerce for the goods and services in each of the above noted classes is September 18, 2000.
- Registration No. 2592452, registered on July 9, 2002, for the trademark **VOGUE.COM** for "providing fashion and beauty information distributed over television, satellite, wireless and global computer networks" in International Class 42. The date of first use of the mark in commerce for the services in this class is September 18, 2000.
- Registration No. 2835164, registered on April 20, 2004, for the trademark **TEEN VOGUE** for "providing fashion information over the internet" in International Class 45. The date of first use of the mark in commerce for the services in this class is September 2, 2003.
- Registration No. 3436616, registered on May 27, 2008, for the trademark **TEEN VOGUE** for "promoting the goods and services of others by distribution and transmission of advertisements in the nature of audio, video, text messages and emails via wireless and mobile devices" in International Class 35; for "Transmission of information through video and audio via digital networks and electronic communications networks" in International Class 38; and for "Providing information about fashion via wireless mobile devices, satellite, cable and global computer networks" in International Class 45. The date of

¹¹ Thus, it was unnecessary for Defendant to introduce copies of her application and registration (51 TTABVUE) because they were automatically part of the record.

¹² 23 TTABVUE.

first use of the mark in commerce for the services in each of the above noted classes is August 1, 2007.

- Registration No. 4989919, registered on June 28, 2016, for the trademark **TEEN VOGUE** for “providing courses of instruction at college and graduate level and distribution of course material in connection therewith; coordinating and providing educational seminars, classes, conferences and in-person forums relating to fashion, style, beauty and culture; providing training of fashion designers for certification in the fields of fashion, style, beauty and culture” in International Class 41. The date of first use of the mark in commerce for the services in this class is September 15, 2015.¹³
- Registration No. 6034637, registered on April 14, 2020, for the trademark **VOGUE BUSINESS** for “membership program services, namely, providing members with access to products and services in the fields of fashion and beauty, special offers and discounts on products in the fields of fashion and beauty, and discounts and special access to fashion and beauty events and venues; advertising and marketing services; providing employment information in the fashion and beauty industry; online business research services that compile data and track insights and trends in the fashion, style and beauty industry” in International Class 35. The date of first use of the mark in commerce for the services in this class is February 15, 2019.
- Registration No. 5904850, registered on November 5, 2019, for the trademark **VOGUEWORLD** for “providing fashion information via digital networks; providing style information in the nature of fashion styles via digital networks” in International Class 45. The date of first use of the mark in commerce for the services in this class is February 15, 2019.
- Registration No. 5069495, registered on October 25, 2016, for the trademark **VOGUE RUNWAY** for “computer software applications for use in connection with smartphones, PDA devices, tablet computers and portable and handheld digital electronic devices, namely, software for accessing, viewing, interacting with and downloading content and information from websites and magazines in the fields of style, beauty and fashion” in International Class 9, and for “providing a website featuring information on fashion, namely, coverage of international fashion show, reports, on seasonal clothing trends, news and information concerning latest style trends and industry developments.”

¹³ This registration subsequently expired.

The date of first use of the mark in commerce for the goods and services in each of the above noted classes is September 1, 2015.

- Registration No. 4459325, registered on December 31, 2013, for the trademark **VOGUE WEDDINGS** for “entertainment services, namely, the provision of continuing movies, films television programs, featuring fashion, style, and beauty delivered by digital networks in the nature of television, cable, satellite, and the internet; providing an ongoing television series featuring fashion, style and beauty provided via cable, network and the internet” in International Class 41. The date of first use of the mark in commerce for the services in this class is June 24, 2013.
- Registration No. 6479563, registered on September 7, 2021, for the trademark **VOGUE WEDDINGS** for “online social networking services; social networking services provided via a website; social networking services provided via online computer databases and online searchable databases; providing information in the field of social networking; providing fashion distributed over television, satellite, wireless and global computer networks; provision of information in the field of fashion by means of electronic communication networks including global computer networks; information services, namely, online information relating to fashion” in International Class 41. The date of first use of the mark in commerce for the services in this class is August 20, 2020.

2. Plaintiff’s 2nd Notice of Reliance upon Defendant’s Responses to Plaintiff’s First Set of Interrogatories, dated August 18, 2019.¹⁴

3. Plaintiff’s 3rd Notice of Reliance upon Defendant’s Responses to Plaintiff’s First Set of Requests for Admissions, dated August 19, 2019.¹⁵

4. Plaintiff’s 4th Notice of Reliance upon Printouts of articles from the LexisNexis database that were published in *USA Today* from May 7, 2001, to July 22, 2021, in which Plaintiff’s **VOGUE** trademark appears.¹⁶

¹⁴ 24 TTABVUE.

¹⁵ 25 TTABVUE.

¹⁶ 26 TTABVUE.

5. Plaintiff's 5th Notice of Reliance upon Printouts of articles from the LexisNexis database that were published in *The New York Times* from April 25, 2000, to July 26, 2021, in which Plaintiff's **VOGUE** trademark appears.¹⁷

6. Plaintiff's 6th Notice of Reliance upon Printouts of articles from the LexisNexis database that were published in *The Wall Street Journal* from April 14, 2000, to March 14, 2019, in which Plaintiff's **VOGUE** trademark appears.¹⁸

7. Plaintiff's 7th Notice of Reliance upon Printouts of articles from the LexisNexis database that were published in *Newsweek* from November 23, 1998, to March 16, 2018, in which Plaintiff's **VOGUE** trademark appears.¹⁹

8. Plaintiff's 8th Notice of Reliance upon Deposition testimony of Defendant Brenda Joan Hollifield and Exhibits A-D from that deposition.²⁰

9. Plaintiff's 9th Notice of Reliance upon Defendant's Responses to Plaintiff's Second Set of Interrogatories, dated August 16, 2021.²¹

10. Plaintiff's 10th Notice of Reliance upon Printouts of Trademark Trial and Appeal Board proceedings and decisions from the TTABVUE database from 2017 to 2021 in which Plaintiff successfully opposed an application or canceled a registration for a mark containing the term "VOGUE."²²

¹⁷ 27 TTABVUE.

¹⁸ 28 TTABVUE.

¹⁹ 29 TTABVUE.

²⁰ 30 TTABVUE.

²¹ 31 TTABVUE.

²² 32 TTABVUE.

11. Plaintiff's 11th Notice of Reliance upon Printouts of articles and sections of Plaintiff's VOGUE website.²³

10. Trial Testimony of Anna-Lisa Yabsley, Global Digital Strategy Lead and U.S. Director of Content Strategy for Plaintiff, and Exhibits A-E thereto.²⁴

Defendant introduced the following testimony and evidence.

1. Defendant's First Notice of Reliance upon printouts of articles and websites showing third party usage of the word "Vogue" as a portion of their branding efforts and internet presence.²⁵

2. Defendant's Second Notice of Reliance upon printouts of articles and websites showing Plaintiff's acknowledgement of the vegan and vegetarian community only recently (and years after Defendant's marks were used in the marketplace) and the longstanding and conflict between the vegan community and Plaintiff.²⁶

3. Defendant's Third Notice of Reliance upon printouts of articles from Plaintiff that show various goods and services included in their publication under Plaintiff's marks.²⁷

²³ 35 TTABVUE.

²⁴ 33 TTABVUE (public version); 34 TTABVUE (confidential version).

²⁵ 37 TTABVUE.

²⁶ 36 TTABVUE.

²⁷ 38 TTABVUE.

4. Defendant's Fourth Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.²⁸

5. Defendant's Fifth Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.²⁹

6. Defendant's Sixth Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.³⁰

7. Defendant's Seventh Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.³¹

8. Defendant's Eighth Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.³²

²⁸ 39 TTABVUE.

²⁹ 40 TTABVUE.

³⁰ 41 TTABVUE.

³¹ 43 TTABVUE.

³² 42 TTABVUE.

9. Defendant's Ninth Notice of Reliance upon official records of third-party trademark registrations showing third party usage of the word "Vogue" as an element in their registered trademarks.³³

10. Defendant's Tenth Notice of Reliance upon printouts of websites showing third party usage of the word "Vogue" as a portion of their branding efforts and internet presence.³⁴

11. Defendant's Eleventh Notice of Reliance upon Defendant's Responses to Plaintiff's First Set of Requests for Admission,³⁵ Defendant's Responses to Plaintiff's First Set of Requests for Interrogatories, and Defendant's Responses to Plaintiff's Second Set of Requests for Interrogatories.³⁶

12. Defendant's Twelfth Notice of Reliance upon Defendant's Responses to Plaintiff's First Set of Requests for Production.³⁷

13. Defendant's Thirteenth Notice of Reliance upon Defendant's Responses to Plaintiff's Second Set of Requests for Production and Defendant's Supplemental Responses to Plaintiff's Second Set of Requests for Production.³⁸

³³ 44 TTABVUE.

³⁴ 45 TTABVUE.

³⁵ Denials to admission requests cannot be submitted under notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497,1501 n.11 (TTAB 2015) (Board considered only opposer's admissions, not denials, in response to applicant's requests for admission); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477 (TTAB 2014) (concurrent use defendant's objection to submission of denial to admission request sustained; "rule does not extend to denials").

³⁶ 46 TTABVUE.

³⁷ 47 TTABVUE.

³⁸ 48 TTABVUE.

14. Defendant's Fourteenth Notice of Reliance upon Defendant's Responses to Plaintiff's Second Set of Requests for Interrogatories.³⁹

15. Defendant's Fifteenth Notice of Reliance upon Plaintiff's response to Defendant's First Set of Requests for Admission, Plaintiff's Response to Defendant's First Set of Interrogatories, Plaintiff's Response to Defendant's First Set of Requests for Production,⁴⁰ and Plaintiff's response to Defendant's Second Set of Interrogatories, Requests for Production, and Requests for Admission.⁴¹

16. Defendant's Sixteenth Notice of Reliance upon TESS and TSDR printouts for Defendant's active registration and pending application for VOGUE VEGAN marks.⁴²

17. Trial Testimony of Defendant Brenda Joan Hollifield and Exhibits CI, CJ, CK, CM, CN, and CO thereto.⁴³

³⁹ 49 TTABVUE.

⁴⁰ Pursuant to Rule 2.122(j)(3), 37 C.F.R. § 2.120(j)(3), a party that has received documents produced by another party in response to a request for production of documents may not make such documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, "[d]ocuments obtained through disclosure or by request for production of documents under Fed. R. Civ. P. 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under Fed. R. Civ. P. 34." TBMP § 704.11(8) & n.6. To the extent both parties submitted produced documents from the opposing party, we will treat them as having been stipulated into evidence. *See Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 59 n.4 (TTAB 1984); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 USPQ 566, 568 n.1 (TTAB 1977).

⁴¹ 50 TTABVUE.

⁴² 51 TTABVUE. As noted above, these records were automatically part of the record.

⁴³ 52 TTABVUE.

II. Entitlement to a Statutory Cause of Action

A plaintiff's entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021). To establish entitlement to a statutory cause of action under Trademark Act Sections 13 and 14, 15 U.S.C., §§ 1063, 1064, a plaintiff must demonstrate “an interest falling within the zone of interests protected by the statute and ... proximate causation.” *Corcamore*, 2020 USPQ2d 11277, at *4 (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)). Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277, at *4. Thus, “a party that demonstrates a real interest in [oppos]ing a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration

of a trademark demonstrates proximate causation within the context of § 106[3].” See *Corcamore*, 2020 USPQ2d 11277 at *7.

Plaintiff made of record copies of its pleaded registrations for its pleaded VOGUE and VOGUE – formative marks,⁴⁴ which the record shows are valid, subsisting and owned by Opposer. See, e.g., *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844; *N.Y. Yankees P’ship*, 114 USPQ2d at 1501. Its entitlement to a statutory cause of action is further supported by its assertion of claims of likelihood of confusion, dilution, abandonment and fraud that are plausible on their face.⁴⁵ As such, Plaintiff has established that it has a direct and personal stake in these consolidated proceedings and a reasonable basis for its belief of damage stemming from registration of a similar mark for assertedly related goods and services. See *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1480-81 (TTAB 2017).

Once a plaintiff shows entitlement on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. See *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011) (because petitioners alleged standing as to at least one ground, primarily geographically deceptively misdescriptive, they may assert any other legally sufficient claims including those under Section 2(a), the Pan American Convention and fraud); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), citing *Liberty Trouser Co. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983).

⁴⁴ 23 TTABVUE.

⁴⁵ 1 TTABVUE (in both proceedings).

Defendant's entitlement to a statutory cause of action as counterclaim plaintiff is inherent in its position as defendant in the underlying opposition and cancellation. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007). See also, e.g., *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005) ("Applicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations", citing *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999)).

III. Counterclaims

A. Priority

Defendant's pleading of her counterclaim for priority reads, in its entirety, as follows:⁴⁶

37. The VOGUE RUNWAY registration (US Registration No. 5069495) in Classes 009 and 045 was filed on April 16, 2015, whereas the Registrant's VOGUE VEGAN trademark application referenced above was filed on July 31, 2014. Therefore, with respect to the goods in Class 045, Registrant's Registration has priority.

38. The VOGUEWORLD registration (US Registration No. 5904850) in Class 045 was filed on September 27, whereas the Registrant's VOGUE VEGAN trademark application referenced above was filed on July 31, 2014. Therefore, with respect to the goods in Class 045, Registrant's Registration has priority.

39. The VOGUE WEDDINGS application (US Serial No. 88523677) in Class 045 was filed on July 19, 2019, whereas the Registrant's VOGUE VEGAN trademark application referenced above was filed on July 31, 2014. Therefore, with respect to the goods in Class 045, Registrant's Registration has priority.

In her brief, Defendant repeats the above allegations, and adds: "Therefore, Applicant's registration has priority over Opposer's registrations with respect to both

⁴⁶ 14 TTABVUE 6 in Cancellation No. 92072531.

filing date and date of first use.”⁴⁷ Defendant does not argue in her brief that Plaintiff’s three registrations noted above should be cancelled. In her reply brief, Defendant “respectfully requests that Opposer’s [three challenged trademark registrations] be canceled as not having priority over Applicant’s VOGUE VEGAN registration.”⁴⁸

A claim of priority is a necessary element of a claim of likelihood of confusion brought against a registered mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). *See, e.g., West Florida Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1105-06 (TTAB 2007). However, Defendant does not assert a claim of likelihood of confusion under Section 2(d). To the contrary, Defendant argues:

Opposer states that Applicant has not addressed the issue of likelihood of confusion; however, Applicant has done nothing but point out at every step of the process, whether in arguments to the USPTO or in front of the TTAB, that marks containing the word “vogue” are not confusing in view of one another and should all be allowed to remain registered in commerce.

In this instance the Opposer has cited marks that do not have priority over Applicant’s marks in its petition to oppose and cancel. Applicant is merely pointing out through this counterclaim that Opposer cannot create a longstanding family of registered marks, where one doesn’t exist, by just listing their most recent registrations, whether they are relevant to this proceeding or not.

⁴⁷ 55 TTABVUE 49.

⁴⁸ 59 TTABVUE 5.

Applicant's registration has priority over Opposer's registrations with respect to both filing date and date of first use.⁴⁹

Priority, even if proven, does not provide a basis for opposition or cancellation of a mark and Defendant cites to no authority for her position that Plaintiff's three challenged registrations should be cancelled if Defendant can demonstrate priority of use of her own registration. In light of the foregoing, Defendant's counterclaim based on priority fails to provide a basis for the relief sought, and is denied. We nonetheless construe Defendant's arguments and evidence in support of her assertions of priority as amplifications of her arguments in favor of registration.

B. Defendant's Claim that the Word VOGUE is Not Distinctive

Defendant's pleading of her counterclaim based on the asserted lack of distinctiveness of VOGUE reads, in its entirety, as follows:⁵⁰

41. Plaintiff's Marks Cited as Basis for Cancellation are not distinctive.

42. There are trademark registrations in the United States that contain the word VOGUE, in class 045 or related classes, currently in use in similar channels of trade, and owned by various entities and third parties that are not the Plaintiff.

43. The word VOGUE on its own is not distinctive and multiple marks owned by multiple parties, which contain the word VOGUE, exist in commerce.

In her brief, Defendant argues:⁵¹

A mark acquires secondary meaning when it has been used so long and so exclusively by one company in association with its products or services in that particular industry that the "word, term, name, symbol, or device" has come to mean that those products or services are the

⁴⁹ 59 TTABVUE 7.

⁵⁰ 14 TTABVUE 6 in Cancellation No. 92072531.

⁵¹ 55 TTABVUE 52, 55.

company's trademark. *Gimix, Inc.*, 699 F.2d at 907. In this case, the word "vogue" means "the prevailing fashion or style at a particular time" and "popular, fashionable". As has been pointed out throughout this Brief, the word "vogue" has been and is currently being used alone or in combination with other words by dozens of companies and entities as trademarks, on their websites, and in marketing campaigns. The idea that the word "vogue" can be associated with only the Opposer – given all of the other uses of the word "vogue" in the marketplace by other entities who are not the Opposer is nonsense. It also cannot possibly have acquired secondary meaning either – because it is not being used exclusively by Opposer.

There are literally dozens of registrations and websites that contain the word "vogue" in them for similar classes of goods and services and have remained unchallenged by Opposer to this day. The Opposer states that they challenge other marks that include the word "vogue". However, Opposer's challenging of other marks containing the word "vogue" only started, by their own admission, five years ago in April 2017 with many of them coming in 2018, 2019 and 2020. In all but one of the "successful oppositions" that Opposer cited, they were default judgments with the defendant never responding. (TTABVUE Doc. No. 32 at 5-117). In the last one, the defendant's application was withdrawn without an answer being filed. (TTABVUE Doc. No. 32 at 107).

It is hard to imagine how the word "vogue" is distinct and associated only with Opposer and also that it has somehow acquired secondary meaning because of its use by the Opposer. Opposer is just one of many entities that use and continue to use the word "vogue" as part of its branding and marketing efforts. The marketplace can apparently sustain many different trademarks and branding campaigns that include the word "vogue" and the consuming public can discern the differences between them with respect to the sources of the respective goods and services.

Defendant's claim does not assert a statutory basis for its allegations that the mark VOGUE is not distinctive (e.g., failure to function, mere descriptiveness, lack of acquired distinctiveness, 15 U.S.C. §§ 1, 2, 45). Rather, the pleading, argument and evidence appear to address a factor used in a likelihood of confusion analysis, namely, that in view of third-party use the mark is weak and essentially devoid of source-

indicating significance. Nonetheless, we consider the arguments and evidence on the question of “distinctiveness” in the context of this purported counterclaim.

Plaintiff argues that its VOGUE mark is conceptually and commercially strong, rising to the level of being famous for purposes of likelihood of confusion and dilution. Our determination of whether VOGUE is distinctive requires us to evaluate its relative strength as a mark. “In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength ...”); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2023 Update) (“McCarthy”) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

Conceptually, the word VOGUE itself, used in connection with a fashion magazine and goods and services connected with the magazine (e.g., providing information about beauty via a global computer network; providing information about fashion via a global computer networks; promoting the goods and services of others via digital

and mobile networks) is somewhat suggestive of the subject matter. As Defendant argues above, “vogue” is defined as “something in fashion, as at a particular time.”⁵²

Despite some conceptual suggestiveness, the evidence of record points to extremely high commercial strength of the mark VOGUE for magazines and online content in the field of fashion and even more generally in the field of fashion (e.g., partnerships with celebrities, sponsorship of large fashion events).⁵³ Plaintiff’s witness testifies that VOGUE is considered “one of the most recognizable and well-known fashion brands in the United States” and a recognized leader in the field of fashion and style.⁵⁴ This sentiment is borne out by the record with unsolicited media references to Vogue Magazine as having a “star image” (*The New York Times* August 6 2009);⁵⁵ the “world’s most influential fashion franchise” (*The New York Times* September 2008);⁵⁶ and “the industry bible” (*The Wall Street Journal*, September 16, 2003)⁵⁷. Plaintiff’s advertising and sales figures were submitted under seal and we do not reference specific numbers but they are very high. In addition, the evidence shows broad and sustained consumer exposure to Plaintiff’s VOGUE

⁵² We exercise our discretion to take judicial notice of this definition from Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2023). The Board may take judicial notice of dictionary definitions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

⁵³ Much of this evidence is confidential and has been submitted under seal. We will endeavor to discuss any confidential testimony or evidence only in general terms.

⁵⁴ 33 TTABVUE 12.

⁵⁵ 27 TTABVUE 22-23 .

⁵⁶ 27 TTABVUE 25-26.

⁵⁷ 28 TTABVUE 12.

mark for over one hundred years.⁵⁸ Plaintiff's monthly magazine readership is approximately 8.3 million people, and Vogue's website receives 14 million unique visitors over a period of 6 months.⁵⁹ These visitors collectively spend 37 million minutes on the website per month. Plaintiff's Vogue YouTube channel has approximately 11 million subscribers and its videos have accumulated over 735 million video views in 2021 alone.⁶⁰ Plaintiff has over 70 million followers on its social media pages: 10 million on Facebook; over 43 million on Instagram; and over 16 million on X / Twitter.⁶¹ Plaintiff collaborates with high-profile celebrities (e.g., Madonna, Lady Gaga, Beyonce, Michelle Obama, Taylor Swift and Serena Williams) and partners with high profile brands to offer VOGUE-branded products, editorial content, and events.⁶² One of the larger events is the annual Met Gala that has garnered more "buzz" on Twitter than the Super Bowl, Academy Awards, Coachella and New York Fashion Week.⁶³ VOGUE magazine is referenced in many widely circulated publications such as THE NEW YORK TIMES, USA TODAY, THE WALL STREET JOURNAL and NEWSWEEK.⁶⁴

Plaintiff aggressively enforces its VOGUE mark, including against goods and services in numerous International Classes including Class 3. Plaintiff submitted

⁵⁸ 33 TTABVUE 3.

⁵⁹ 33 TTABVUE 6.

⁶⁰ 33 TTABVUE 12.

⁶¹ 33 TTABVUE 12.

⁶² 33 TTABVUE 6.

⁶³ 33 TTABVUE 13.

⁶⁴ 25 TTABVUE – 29 TTABVUE.

eight instances where the Board ruled in favor of Opposer and sustained oppositions and cancellations with respect to marks containing the term VOGUE for the marks VOGUE VENUS (cell phone cases), VOGUISH (various electronic goods), DÉCOR IN VOGUE (meat thermometer), VOGUE BOOTH (photo kiosks), WOVOGUE (covers for smart phones), VOUGERY (batteries battery chargers cell phone cases), VOGUETECH (cell phone cases) and EVOGUE NEW YORK (various perfumes, lotions, cosmetics and essential oils).⁶⁵ In all but two cases, the proceeding ended in default for failure to answer and there was no disposition on the merits of Plaintiff's claims. The success Plaintiff has enjoyed may reflect the inability or unwillingness on the part of the various defendants to expend funds defending a mark. By definition, these defaults are not probative of consumer exposure, but they do show Plaintiff's active policing program to assert a broad scope of protection.

Defendant has submitted evidence of third-party use and registration of VOGUE formatives for various goods and services. These uses include:

- Texon Vogue, a “durable and practical washable paper” used as a leather substitute and for clothing labels, cases, furniture and luggage tags;⁶⁶
- Vegan Vogue, a vegan food website located in the United Kingdom (UK);⁶⁷
- Vegan mattresses by Vogue Beds, a UK mattress company;⁶⁸

⁶⁵ 54 TTABVUE 22; 32 TTABVUE 1-117.

⁶⁶ 37 TTABVUE 1-26.

⁶⁷ 37 TTABVUE 27-57.

⁶⁸ 37 TTABVUE 58-66.

- Vogue Fabrics Online Fabric Store offering fabrics, trims and accessories;⁶⁹
- Vogue College of Cosmetology offering cosmetology instruction in Texas and New Mexico;⁷⁰
- Vogue Bike offering e-bikes;⁷¹
- Vert&Vogue offering sustainably sourced and manufactured clothing;⁷² and
- Vogue Theatre – “Vancouver’s Premiere Live Event Venue.”⁷³

The registrations include:⁷⁴

- Reg. No. 5405778 for the mark BEAUTI VOGUES (BEAUTY disclaimed) identifying retail services featuring beauty products;
- Reg. No. 4122368 for the mark BELLE VOGUE BRIDAL (BRIDAL disclaimed) identifying bridal store services;
- Reg. No. 4727231 for the mark BurVogue and design identifying various items of clothing;
- Reg. No. 5580963 for the mark COASTAL VOGUE identifying furniture;

⁶⁹ 45 TTABVUE 17-32.

⁷⁰ 45 TTABVUE 33-46.

⁷¹ 45 TTABVUE 47-50.

⁷² 45 TTABVUE 51-64.

⁷³ 45 TTABVUE 65-70.

⁷⁴ 39 TTABVUE 5-34; 40 TTABVUE 5-42; 41 TTABVUE 5-36; 42 TTABVUE 5-52. Marks displayed in standard characters unless otherwise noted. We have considered only those marks which were shown to be registered and based on actual use. The marks that have been registered under the provisions of the Madrid protocol or pursuant to Section 44(e) have no probative value because they do not require use in commerce to be registered and therefore are not evidence that the marks therein have ever been encountered by consumers in the marketplace. *See In re 1st USA Realty Pros., Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

- Reg. Nos. 5010685 and ‘686 for the marks en Vogue and en Vogue Sculptured Nail Systems Inc. in stylized form (SCULPTURED NAIL SYSTEMS INC. disclaimed) identifying various products for fingernails and toenails;
- Reg. No. 4000978 for the mark EN VOGUE BRIDAL ACCESSORIES (BRIDAL ACCESSORIES disclaimed) identifying bridal veils and headbands;
- Reg. No. 5417148 for the mark EVOGUES APPAREL (APPAREL disclaimed) identifying retail apparel stores;
- Reg. No. 5246044 for the mark FTVOGUE identifying various items of clothing;
- Reg. No. 5401138 for the mark JOLLYVOGUE identifying wigs, hairpieces and hair accessories;
- Reg. No. 4169073 for the mark MISS VOGUE identifying footwear;
- Reg. No. 1896976 for the mark VICTORIA VOGUE identifying cosmetic applicators, powder puffs, sponges, brushes and cleansing pads;
- Reg. Nos. 4951223 and 4955444 for the mark VIVID & VOGUE identifying various manicure and hair care appliances and hair dryers; and
- Reg. No. 5062039 for the mark Vogue Professional and design identifying hair and nail dryers.⁷⁵

We note first that Plaintiff’s VOGUE marks are registered on the Principal Register without a claim of acquired distinctiveness, and therefore are presumed to be distinctive. *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *10 (TTAB 2020). The evidence of record points to VOGUE being slightly suggestive of Plaintiff’s

⁷⁵ Defendant submitted copies of approximately twenty additional third-party registrations for marks and/or goods and services that are too far removed from the marks and goods involved herein to be of significant probative value.

identified goods and services. Suggestive marks are, nonetheless, inherently distinctive. In addition, Plaintiff has made a very strong showing of commercial success and unsolicited recognition of its VOGUE marks. Defendant's evidence of third-party use and registration of various "vogue" – formatives for a variety of goods and services, none of which include a fashion magazine and goods and services connected with the magazine, fail to convince us that Plaintiff's VOGUE mark should be considered less than inherently distinctive.

In light of the foregoing, Defendant's counterclaim based on the asserted lack of distinctiveness of Plaintiff's VOGUE marks is denied. As above, we construe Defendant's arguments and submitted evidence in support of her lack of distinctiveness claim as amplifications of her arguments in favor of registration.

IV. Dilution

To prevail on a claim of dilution by blurring, a plaintiff must show that: (1) it owns a famous mark that is distinctive; (2) Defendant is using a mark in commerce that allegedly dilutes Plaintiff's famous mark; (3) Defendant's use of its mark began after Plaintiff's mark became famous; and (4) Defendant's use of its mark is likely to cause dilution by blurring or tarnishment. *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting *Coach Servs.*, 101 USPQ2d at 1723-24). To show Applicant's mark is likely to cause dilution by blurring we consider:

(i) the degree of similarity between Defendant's mark and Plaintiff's famous mark;

(ii) the degree of inherent or acquired distinctiveness of Plaintiff's mark;

(iii) the extent to which Plaintiff is engaging in substantially exclusive use of its mark;

(iv) the degree of recognition of Plaintiff's mark;

(v) whether Defendant intended to create an association with Plaintiff's mark; and

(vi) any actual association between Defendant's mark and Plaintiff's mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

In the context of a dilution claim, in considering the similarity of the marks it is sufficient if the defendant's mark "trigger[s] consumers to conjure up" the plaintiff's mark. In other words, "upon seeing the junior party's use of a mark on its goods, [consumers] 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." *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1030 (TTAB 2011) (quoting *Toro Co. v. Torohead Inc.*, 61 USPQ2d 1164, 1183 (TTAB 2001)).

A. Plaintiff Owns a Distinctive, Famous Mark

As discussed above, Plaintiff's VOGUE mark is inherently distinctive. It is registered on the Principal Register without a claim of acquired distinctiveness, and is therefore presumed distinctive. *Sock It to Me*, 2020 USPQ2d 10611, at *10. As for whether the mark is sufficiently "famous" to be entitled to protection against dilution, we must determine whether it "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting

15 U.S.C. § 1125(c)(2)(A)). In doing so, we consider:

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

15 U.S.C. § 1125(c)(2)(A).

(i) Advertising and Publicity

As discussed above, Plaintiff's mark has enjoyed extensive publicity for over 100 years, including advertising by Plaintiff itself, and its promotional partners.

(ii) Sales of Goods and Services Under the VOGUE Mark

Plaintiff's sales as measured by subscriptions through its various outlets are quite significant. The evidence is persuasive and corroborative of the advertising and publicity evidence.

(iii) Actual Recognition of the 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 LLC v. Tivoli, LLC*, 129 USPQ2d at 1104 (quoting *Nike*, 100 USPQ2d at 1024). It would be difficult to overstate the extent of public recognition of the VOGUE mark. As discussed above in the context of Defendant's counterclaim based upon lack of distinctiveness,

the evidence shows widespread recognition of the mark by a substantial portion of the United States population and is famous. Dilution requires a higher showing of fame and the evidence shows VOGUE is so widely recognized in the United States to meet that level.

(iv) VOGUE is Registered on the Principal Register

Opposer's VOGUE marks have been registered on the Principal Register for 100 years. The registrations are not based on a claim of acquired distinctiveness and many are incontestable.

By any and all measures, the evidence establishes that VOGUE is a famous mark, and entitled to protection against dilution under 15 U.S.C. § 1125(c).

B. Defendant is using VOGUE VEGAN, a Mark That Allegedly Dilutes Plaintiff's VOGUE Mark

Defendant asserts a bona fide intent to use her VOGUE VEGAN mark in commerce and seeks to register it in the United States. Because Plaintiff bases one of its grounds for opposition on its allegation that VOGUE VEGAN dilutes Opposer's VOGUE mark, this element is also satisfied. *See Chanel, Inc., v. Makarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014).

C. Plaintiff's VOGUE Mark Was Famous Before Defendant's First Use of VOGUE VEGAN

There is no question that Plaintiff's VOGUE mark was famous well before Defendant's July 31, 2014 constructive first use date.⁷⁶

⁷⁶ 33 TTABVUE 12; 27 TTABVUE 22-23; 27 TTABVUE 25-26; 28 TTABVUE 12.

D. Defendant's Use of Its VOGUE VEGAN Mark is Likely to Cause Dilution By Blurring

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

The concern is that “the gradual whittling away of distinctiveness will cause the trademark holder to suffer ‘death by a thousand cuts.’” *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). *See also, Enter. Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1816 (Fed. Cir. 2003) (“dilution law is intended to protect a mark’s owner from dilution of the mark’s value and uniqueness”). Blurring may occur “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)).

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

- i. the degree of similarity between Defendant’s mark and Plaintiff’s famous mark;

- ii. the degree of inherent or acquired distinctiveness of Plaintiff's mark;
- iii. the extent to which Plaintiff is engaging in substantially exclusive use of its mark;
- iv. the degree of recognition of Plaintiff's mark;
- v. whether Defendant intended to create an association with Plaintiff's mark; and
- vi. any actual association between Defendant's mark and Plaintiff's mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

1. The Marks are Similar

We “consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression.” *N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *Rsch. in Motion Ltd. v. Defining Presence Marketing Grp. Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012). “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). We must determine whether Defendant's VOGUE VEGAN mark is sufficiently similar to Plaintiff's VOGUE mark as to “trigger consumers to conjure up” Plaintiff's mark. *Nike*, 100 USPQ2d at 1030 (quoting *Nat'l Pork Bd.*, 96 USPQ2d at 1497).

As discussed above, the marks are similar, with Defendant's mark appropriating the entirety of Plaintiff's mark and adding the descriptive, disclaimed term VEGAN to distinguish them. Because Defendant's mark includes

the entirety of Plaintiff's mark the marks look similar. *Rsch. in Motion*, 102 USPQ2d at 1198 ("we find that there is a high degree of similarity between applicant's mark [CRACKBERRY] and opposer's famous mark [BLACKBERRY]"). They also sound similar. *Cf. Russell Chem. Co. v. Wyandotte Chem. Corp.*, 337 F.2d 660, 143 USPQ 252 (CCPA 1964) (SENTOL similar in sound to SEN-TROL). Although the following term VEGAN in Defendant's mark creates a difference in meaning and commercial impression, indicating an absence of animal product or by-product, this could be understood as a variation on Plaintiff's VOGUE mark.

2. Plaintiff's Mark is Inherently Distinctive

Plaintiff's mark is presumed inherently distinctive based on the registrations issuing without reliance on acquired distinctiveness under Section 2(f). However, it does have some conceptual suggestiveness in the context of a fashion magazine as found in the counterclaim.

3. Plaintiff's Use of VOGUE is Substantially Exclusive

There is no record evidence demonstrating use of VOGUE for goods or services similar or related to Plaintiff's goods and services. Defendant's evidence, discussed above, shows use and registration of VOGUE – formative marks for a variety of goods and services. However, none of them identify a fashion magazine or goods and services associated with a fashion magazine. In addition, and as further discussed above, Plaintiff has demonstrated that it has successfully opposed or sought to cancel registrations for VOGUE – formatives that it believes

are confusingly similar to or dilute its VOGUE marks.

4. Plaintiff's VOGUE Mark is Widely Recognized in the United States

As discussed above, the record shows the VOGUE mark is widely recognized in the United States.

5. The Record Does Not Show that Defendant Intended to Create an Association with Plaintiff's VOGUE Mark

There is no evidence of record on this factor.

6. Actual Association Between VOGUE VEGAN and VOGUE

There is no evidence of record on this factor.

V. Conclusion – Use of Defendant's Mark Will Impair the Distinctiveness of Plaintiff's Famous and Distinctive VOGUE Mark

There is no question that VOGUE is a famous mark, that VOGUE goods and services are widely used and recognized by a large percentage of the United States population, or that Plaintiff's VOGUE mark is distinctive. This was the case prior to Defendant's proven date of first use of its mark.

With the exception of intent and evidence of actual association, the dilution factors favor finding that there is a likelihood of dilution. Therefore, we find that Defendant's registration of VOGUE VEGAN would impair the distinctiveness of Plaintiff's VOGUE marks and is likely to dilute the distinctive quality of VOGUE.

In light of our finding that Defendant's mark is likely to dilute Plaintiff's VOGUE marks, we need not make a determination as to Plaintiff's likelihood of confusion claim. *See Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (citing *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1172 (TTAB 2013)).

VI. Abandonment

A. Statement of the Law

The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. *See* Section 14 of the Trademark Act, 15 U.S.C. §1064.

Under Section 45 of the Trademark Act, 15 U.S.C. §1127, a mark is considered abandoned when “its use has been discontinued with intent not to resume such use.”

The definition of abandonment is found in this provision, as follows:

A mark shall be deemed to be “abandoned” if either of the following occurs:

- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

...

15 U.S.C. §1127.

Because registrations are presumed valid under the law, the party seeking their cancellation bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence. *See On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Cerveceria Centroamericana*, 13 USPQ2d at 1309; *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). If the petitioner presents a prima facie case of abandonment, the burden of production (i.e., going forward), then shifts to the trademark holder to rebut the prima facie showing with evidence. *Cerveceria Centroamericana*, 13 USPQ2d at 1311.

Abandonment is a question of fact. *See Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 667 (Fed. Cir. 1984). Thus, any inference of abandonment must be based on proven fact. Section 45 of the Trademark Act. *See also Cerveceria Centroamericana*, 13 USPQ2d at 1310 (“The protection due the registrant is provided by requiring that the inference have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and ‘there is no basis ... to infer nonuse,’ a prima facie case of abandonment must fail.”) (quoting *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 332-33, 196 USPQ 801, 804-05 (CCPA 1978)); *Stetson v. Howard D. Wolf & Assoc’s*, 955 F.2d 847, 21 USPQ2d 1783, 1785 (2d Cir. 1992) (A party claiming that a mark has been abandoned must show “non-use of the mark by the legal owner and no intent by that person or entity to resume use.”).

Proof of non-use for three consecutive years constitutes prima facie evidence of abandonment, because it supports an inference of a lack of intent to resume use. Section 45 of the Trademark Act. *See also Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1533 (TTAB 2018); *On-line Careline Inc. v. Am. Online Inc.*, 56 USPQ2d at 1476 (“The party seeking cancellation establishes a prima facie case of abandonment by showing proof of nonuse for three consecutive years.”); *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 56 USPQ2d 1343 (4th Cir. 2000). As noted above, if the plaintiff establishes non-use for three consecutive years, the burden shifts to the defendant to rebut the prima facie case by

either disproving the three years of nonuse or showing an intent to resume use.

Cerveceria Centroamericana, 13 USPQ2d at 1312.

B. Evidence of Use of Defendant's Mark

Defendant testified in her discovery deposition regarding her use of the VOGUE VEGAN mark as follows.⁷⁷

Q. Okay. But you think it was approximately the same year that you applied for the trademark that you began using the services or --

A. It was before that, 2012.

Q. And have you recorded sales under this brand, Vogue Vegan, for every year from 2012 to the present?

A. I have used the mark in commerce since then every year.

Q. Which years have you recorded sales under the Vogue Vegan brand since 2012?

A. I'm not sure.

Q. Have you recorded sales within the last three years?

A. Yes.

Q. Have you recorded sales in each of the last three years?

A. No. I'm not sure. I'm not sure. I have to look.

Q. But there are some years between 2012 and present when you did not record any sales under the Vogue Vegan brand; is that correct?

A. I'm not sure.

Q. Now, I believe you testified that you used the mark in commerce from 2012 to present in each of those years. What do you mean by "use the mark in commerce"?

A. Promoting, advertising, word of mouth, public speaking.

Q. I'm sorry, I didn't mean to interrupt.

A. Public speaking, basic life, videos.⁷⁸

⁷⁷ 30 TTABVUE.

⁷⁸ 30TTABVUE 10-11.

...

Q. Do you recognize this document?

A. Yes, I do.

Q. What is it?

A. It's the mark for Vogue Vegan.

Q. And is this also the front page of the website voguevegan.com?

A. Yes.

Q. So this is your website, correct?

A. Yes.

Q. And who designed the VV logo that is on this website?

A. A graphic artist.

Q. Who is that?

A. It's an artist in Atlanta. Her name is Susan Spencer.

Q. I'm sorry, could you repeat the name?

A. Susan Spencer.

Q. And what year was this designed for you?

A. I don't recall exactly.

Q. Do you recall if it was within the last few years or if it was more like seven to ten years ago?

A. It was certainly after I had the trademark.

Q. But you can't be more specific?

A. When I was designing business cards and I can't tell you the exact year. I'm sorry.

Q. The website currently says "The destination for vegan fashion, coming soon." Has the website always been under construction, so to speak, or have you ever had a website with additional content on it?

A. I have consulted with designers as recently as last year about building it. Obviously, the last two years since Vogue has challenged the mark, I chose not to spend money proceeding with that.

Q. I believe you testified earlier that you registered the website around 2012; is that right?

A. Yes.

Q. So since 2012, has there ever been any content on this website or has it always been under construction?

A. I'm trying to recall if I have posted pictures. I think it has been a plan as soon as I had merchandise to sell.

Q. Okay. So you can't specifically recall any time

since 2012 when you have actually had merchandise, or services, or anything like that offered on your voguevegan.com website?

A. Right.⁷⁹

I believe you testified earlier that you cannot recall any specific time when your website, voguevegan.com, had merchandise or any content on it. Is it also true that you can't recall a time when you ever sold anything through your website, voguevegan.com?

A. I have not set my website up for sales.

Q. Right. And you have never sold --
The destination for vegan fashion is really advertising.

Q. I just want to clarify for the record, you have no recollection of ever selling a good or service through your website, voguevegan.com; is that correct?

A. That is correct.⁸⁰

Defendant testified and submitted evidence of the following examples of use of her VOGUE VEGAN mark in connection with "Personal shopping for others who want goods containing no animal products or by-products; Personal wardrobe styling services for vegans or those who do not want to wear goods containing animal products or by-products."

Purchase of a faux leather jacket in 2012 for \$50 and several pairs of shoes at unspecified later dates for Dr. John Debanto, her former husband;⁸¹

Purchase in July 2012 of a tuxedo and later purchase at unspecified dates of shirts, pants, shoes and jackets for Prabhat Gautam, a business associate and collaborator

⁷⁹ 30 TTABVUE 12.

⁸⁰ 30 TTABVUE 13.

⁸¹ 30 TTABVUE 14; 28; 52 TTABVUE 25.

in the vegan movement who states that he will continue to hire Defendant for such purchases;⁸²

Dr. Richard Casteen, who sought Defendant's consulting services in August 2016 regarding vegan clothing for himself and his practice for \$1,500;⁸³ and

Wendell Wellman who indicated Defendant assisted him with personal shopping and wardrobe styling at unspecified dates. His statement is supported by an invoice from Defendant and a March 18, 2021 check to Defendant for \$70.

Defendant has supplied documentation of the following purchases, assertedly as part of her services under the VOGUE VEGAN mark:⁸⁴

April 8, 2012 faux leather jacket and personal shopping services:

July 26, 2012 men's tuxedo;

July 31, 2014 women's shoes;

January 21, 2016 boots;

January 25, 2017 Men's faux down packable hooded jacket;

A March 8, 2018 check from Ray Ortega to Defendant for \$2,000; and

March 24, 2021 hooded jacket.

⁸² 30 TTABVUE 15-16; 52 TTABVUE 27.

⁸³ 30 TTABVUE 16; 48 TTABVUE 32. Defendant also discusses a series of videos promoting veganism in 2020 for Dr. Drema Mace. 48 TTABVUE 37-44. However, these are not included among the services at issue in Defendant's challenged registration. Defendant further discusses a "West Virginia consulting trip" in 2020, however it is unclear from her testimony whether that reflects the work she did for Dr. Mace or another consultation. Defendant further discusses consultations relating to creating a brand for Greenfields, a cannabis company. 48 TTABVUE 33-36. However, Defendant does not explain how these services are included among those in her challenged registration.

⁸⁴ 48 TTABVUE 28-169.

Defendant's website states "The destination for Vegan fashion...Coming Soon!
Mail to: voguevegan@gmail.com.⁸⁵ There is no additional content present on the
webpage. Defendant asserts the following revenues for her services under the
registered VOGUE VEGAN mark:

Year Revenue/Estimated Revenue

2012 Less than \$5000
2013 Less than \$5000
2014 Less than \$5000
2015 Less than \$10000
2016 Less than \$10000
2017 Less than \$10000
2018 \$2000
2019 \$0
2020 \$1200
2021 (estimated to
date) \$100⁸⁶

Defendant asserts the following advertising expenditures for her services under
the registered VOGUE VEGAN mark:

**Year Expenditures/Estimated
Expenditures**

2012 Less than \$1000
2013 Less than \$1000
2014 Less than \$1000
2015 Less than \$2000
2016 Less than \$2000
2017 Less than \$2000
2018 \$785
2019 \$571
2020 \$1099
2021 \$100⁸⁷

⁸⁵ 30 TTABVUE 24.

⁸⁶ 31 TTABVUE 9.

⁸⁷ 31 TTABVUE 10.

Plaintiff argues in support of its abandonment claim:⁸⁸

The record evidence is clear that over the last ten years, Applicant is not using her VOGUE VEGAN mark in commerce consistently and at a level that constitutes a bona fide use of the mark, as opposed to trying to reserve her rights in the mark. Applicant registered the voguevegan.com web domain in 2012 but has never posted content on the website, and it still says “under construction” ten years later. Applicant’s purported social media engagement with respect to “VOGUE VEGAN” has never resulted in revenues. Applicant’s only customers for the first two to three years of her purported business were her business partner and ex-husband. Applicant recorded \$0 in revenues in 2019. Applicant has not offered any evidence to demonstrate sufficient revenues in any other year since 2012. Applicant testified the primary way people hear about her business is through a third-party Facebook page called Jane Unchained, yet she admitted that she has never made any money through Jane Unchained. In sum, Applicant’s initial “sales” for the first three years were to a business partner and former spouse, and through this proceeding, she has failed to produce evidence showing bona fide use in commerce of the VOGUE VEGAN mark. There is also no evidence to show consistent advertising and marketing of the VOGUE VEGAN mark. Applicant’s VOGUE VEGAN mark has been abandoned.

However, the above evidence shows that Defendant used her VOGUE VEGAN mark in commerce in connection with her wardrobe styling and personal shopping services at least in 2012, 2014, 2016, 2017 and 2021, i.e., the time of trial. The absence of revenue in 2020 may be attributable to the ongoing COVID pandemic rendering it difficult to perform such services. Defendant is not required to produce evidence of a functioning website or evidence of use on Facebook or another social media site. The record, while slender, shows use of the VOGUE VEGAN mark from 2012 to 2021, i.e., the time of trial, in connection with the recited services.

⁸⁸ 54 TTABVue 42-43.

Reviewing the evidence, Plaintiff has not presented a prima facie case of abandonment. While use in commerce of a service mark requires rendering the services, it does not require updates to a website, doing business on social media, or advertising or marketing in certain trade channels. Further, there is nothing in Section 45 of the Trademark Act or our decisional law that negates the probative value of rendering services to family members, spouses or former spouses, business associates or friends. *Cf. Christian Faith Fellowship Church v. Adidas*, 841 F.3d 986, 120 USPQ2d 1640, (Fed. Cir. 2016) (sale of two “ADD A ZERO” – marked hats to an out of state resident constitutes use in commerce under the Lanham Act).

Abandonment is a question of fact; thus, any inference of abandonment must be based on proven fact. *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389 1393 (TTAB 2007). The record consists only of circumstantial evidence of abandonment, and documented evidence of Defendant’s use of her mark. Plaintiff did not cross-examine Defendant on her declaration testimony or supporting documents to ascertain the nature and extent of Defendant’s use to of her mark. Therefore, Plaintiff has failed to make a prima facie showing that there is no use of Defendant’s registered mark for the services identified in her registration over a three-year period.

Although the record includes slender evidence of Defendant’s use of her mark in commerce, it fails to establish that Defendant abandoned her VOGUE VEGAN mark. Rather, it shows that Defendant has used her mark and not abandoned use. Therefore, Plaintiff has not proved abandonment by a preponderance of the evidence

and has failed to demonstrate sufficient cause to cancel Defendant's registration on the ground of abandonment.

VII. Fraud

We next consider Plaintiff's fraud claim based on Defendant's alleged lack of use of her mark in commerce at the time of filing her underlying application and declaration in support thereof. Specifically, Plaintiff argues:⁸⁹

Applicant has failed to offer any evidence to dispute the fact that her only sales between 2012 and 2014 were "token" sales to her business partner in the VOGUE VEGAN venture and to her ex-husband in an effort to reserve her rights in the VOGUE VEGAN mark. These sales do not constitute bona fide use of the mark in commerce. Applicant's attorney signed a declaration providing that the mark was being used in commerce with reckless disregard for the truth, since she clearly knew that the only sales were tokens sales made to her business partner and ex-husband. The Trademark Law Revision Act was explicitly amended to prevent token use of a mark from allowing applicants to squat on a mark and obtain a registration. Accordingly, Applicant's VOGUE VEGAN registration should be canceled due to fraud.

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939-40, (Fed. Cir. 2009) ("[W]e hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO."); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Luxco, Inc. v. Consejo*

⁸⁹ 54 TTABVUE 42.

Regulador del Tequila, A.C., 121 USPQ2d 1477, 1501 (TTAB 2017); *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1521 (TTAB 2016).

The relevant standard for proving fraud requires a showing of the following four elements:

- (1) registrant made a false representation to the USPTO;
- (2) the false representation is material to the registrability of the mark;
- (3) registrant had knowledge of the falsity of the representation; and
- (4) registrant made the representation with the intent to deceive the USPTO.

In re Bose, 91 USPQ2d at 1941.

Plaintiff, as the party alleging fraud in Defendant's procurement of a registration, "bears the heavy burden of proving fraud with clear and convincing evidence." *In re Bose*, 91 USPQ2d at 1243 (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)); *see also Daniel J. Quirk v. Village Car*, 120 USPQ2d at 1148 (fraud must be proven "to the hilt" with clear and convincing evidence); *Enbridge, Inc. v. Excelerate Energy Ltd. Partnership*, 92 USPQ2d 1537, (TTAB 2009) ("[E]vidence of deceptive intent must be clear and convincing. The rigorous clear and convincing evidence standard is strictly applied.").

Based on the evidence discussed above relative to its abandonment claim, Plaintiff has not provided sufficient evidence to show that Defendant made a false representation in obtaining or maintaining her Registration. Specifically, Plaintiff failed to demonstrate that Defendant abandoned her trademark and, as a result, cannot demonstrate that Defendant or her counsel made a false statement in signing

the declaration underlying Defendant's challenged registration. Plaintiff's fraud allegation also fails because there is no evidence of Defendant's intent to deceive the USPTO. Without evidence of intent to deceive the USPTO, Plaintiff's allegations of fraud fail. In addition, even assuming Defendant's statements were false, Plaintiff has not established that Defendant submitted any material statements to the USPTO with intent to defraud the USPTO. Accordingly, Plaintiff has not met its burden of proof to show that Defendant committed fraud in the procurement and maintenance of her Registration.

VII. Conclusion

Plaintiff has demonstrated its standing to maintain these proceedings and that Defendant's applied-for VOGUE VEGAN mark dilutes the distinctive quality of Plaintiff's VOGUE marks by a preponderance of the evidence. Plaintiff has failed to demonstrate by a preponderance of the evidence that Defendant abandoned her registered VOGUE VEGAN mark; and failed to demonstrate by clear and convincing evidence that Defendant committed fraud on the USPTO in obtaining or maintaining her registered VOGUE VEGAN mark. Defendant failed to demonstrate that her purported claim for priority should result in cancellation of Plaintiff's challenged registrations; and failed to demonstrate that Plaintiff's VOGUE mark lacks distinctiveness.

Decision: The Opposition to registration of application Serial No. 86354391 is granted on the ground of dilution. The Petition to Cancel Registration No. 4811170 is

Opposition No. 91247611; Cancellation No. 92072531

dismissed on both grounds. The counterclaim for cancellation is dismissed on both grounds.