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

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

MOBILESOFT TECHNOLOGY, INC., Opposer, v. MY MY STAR, INC., Applicant.	Opposition No. 91248764 Serial Nos. 87836135 Mark: MY MY STAR

DEFENDANT'S BRIEF

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I. STATEMENT OF THE CASE

For more than twenty (20) years, Applicant My My Star, Inc. ("Applicant") has been substantially and continuously using the mark MY MY STAR (the "Senior Mark"), and has been doing so in commerce for more than fourteen (14) years. 10 TTABVUE 1-3: Wilson Decl. at ¶¶ 1-10; 14 TTABVUE 41-42, 48: Wilson Tr. at 38:17-25, 39: 1, 45:18. In particular, Applicant began using the Senior Mark in connection with advertising services, marketing services, and digital video production services at least as early as November 1, 2000. 10 TTABVUE 1-2: Wilson Decl. at ¶ 4. Since at least as early as January 1, 2006, Applicant has been continuously providing digital content, including but not limited to online and broadcast advertising content, downloadable and non-downloadable videos, banner advertisements, social media marketing campaigns, software applications, online games, and other digital production studio products under the Senior Mark in commerce. 10 TTABVUE 1-2: Wilson Decl. at ¶¶ 4-5. At least as early as this time, Applicant established common law rights and exceedingly valuable goodwill in and to the Senior Mark. 10 TTABVUE 3: Wilson Decl. at ¶ 10. Since this time, the Senior Mark has become extremely well-known and distinctive to Applicant's actual and potential consumers as it is applied to Applicant's goods and services. 10 TTABVUE 3: Wilson Decl. at ¶ 12.

Applicant filed U.S. Trademark Application Serial No. 87836135 for the Senior Mark on March 15, 2018, which properly alleges a first use date of November 1, 2000 and a first use in commerce date of January 1, 2006. To further demonstrate Applicant's continuous use of the Senior Mark, Applicant has owned and utilized the domain www.mymystar.com since at least as early as 2005 to market and offer its advertising services, marketing services, and digital video production services. *See* 10 TTABVUE 3, 47-49: Wilson Decl. at ¶ 8, Ex. C. Applicant has been

continuously incorporated under the name "My My Star, Inc." since 2010. *See* 10 TTABVUE 3, 51-53: Wilson Decl. at ¶ 9, Ex. D.

Furthermore, Applicant's vast clientele to whom Applicant has sold goods and services under the Senior Mark include Google, Nike, Toyota, The Coca-Cola Company, Target, J.P. Morgan/Chase, Disney, AMC, and numerous others. 10-11 TTABVUE: Wilson Decl. at ¶¶ 6-7, Ex. A-B. These and other actual and potential customers of Applicant have continuously referred to Applicant as "MY MY STAR." 14 TTABVUE 123-124: Wilson Tr. at 120:1-2, 121:18-20. In addition, Applicant's goods and services under the Senior Mark are marketed through word of mouth in the relevant industries, including digital production, media production, social media production, and advertising. 14 TTABVUE 30: Wilson Tr. at 27:9-16. Overall, Applicant has conducted millions of dollars in business transactions under the Senior Mark. 10 TTABVUE 2-3: Wilson Decl. at ¶ 7.

Years after Applicant commenced its use of the Senior Mark, on September 16, 2016 and January 22, 2017, Opposer MobileSoft Technology, Inc. ("Opposer") filed U.S. Trademark Applications Serial Nos. 87184374 and 87309628 for the marks, MYMY and 

, respectively (each, a "Junior Mark" and collectively, the "Junior Marks"). 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22. In both applications, Opposer alleged a date of first use of March 25, 2017. *Id.* Opposer's first use of the Junior Marks occurred more than a decade and a half after Applicant began using the Senior Mark. 10 TTABVUE 1-2, 4: Wilson Decl. at ¶¶ 4, 13. Opposer therefore lacks priority in the Junior Marks.

Applicant promptly filed a Notice of Opposition against the application for registration of Opposer's Junior Marks. 10 TTABVUE 4, 55-73: Wilson Decl. at ¶ 14, Ex. E. Thus, since at least the date on which Applicant filed the Notice of Opposition in that case, Opposer has been aware

of Applicant's predating common law trademark rights to the Senior Mark. *Id.* On June 12, 2019, Opposer initiated the present Opposition proceeding in bad faith. 1 TTABVUE. Opposer claims the Senior Mark is not entitled to registration, despite the predating date of first use alleged therefor. *Id.* Because Applicant claims priority of use of the Senior Mark as compared to Opposer's Junior Marks, this Opposition should be dismissed and the Senior Mark allowed to proceed to registration.

II. LEGAL ISSUES PRESENTED

Opposer's purported grounds for opposing registration of Applicant's Senior Mark include (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); (2) dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); and (3) dilution by tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). *See* 1 TTABVUE. Accordingly, the legal issues before the Board are:

(a) Whether Opposer has priority of use in the Junior Marks against Applicant's Senior Mark;

(b) Whether Opposer has properly demonstrated that the registration of the Senior Mark for Applicant's goods and services is likely to cause consumer confusion with Opposer's Junior Marks; and

(c) Whether Opposer's Junior Marks are sufficiently famous and distinctive such that the registration of the Senior Mark for Applicant's goods and services is likely to dilute the Junior Marks by blurring; and

(d) Whether Opposer has properly demonstrated that registration of the Senior Mark is likely to harm the reputation of the Junior Marks such that the registration of the Senior Mark for Applicant's goods and services is likely to dilute the Junior Marks by tarnishment.

III. RECORD BEFORE THE BOARD

The record before the Board consists of:

(a) Opposer's Notice of Opposition, 1 TTABVUE;

(b) Applicant's Answer, 4 TTABVUE;

(c) U.S. Trademark Application Serial No. 87836135 for Applicant's Senior Mark, "MY MY STAR," in International Classes 035 and 041;

(d) U.S. Registration No. 6069693 for Opposer's Junior Mark, "MYMY," in International Classes 009, 038, 041 and 042, 9 TTABVUE;

(e) U.S. Registration No. 6053635 for Opposer's Junior Mark, 

, in International Classes 009, 038 and 041, 8 TTABVUE;

(f) Steven A. Sjoblad Testimony Declaration and exhibits thereto, 6 TTABVUE;

(g) Joseph L. Brim Testimony Declaration and exhibits thereto, 7 TTABVUE;

(h) Len Wilson Testimony Declaration and exhibits thereto, 10 TTABVUE;

(i) Steven A. Sjoblad Testimony Rebuttal Declaration and exhibits thereto, 13 TTABVUE; and

(j) Len Wilson Cross-Examination Transcript, 14 TTABVUE.

IV. ARGUMENT

As grounds for this opposition, Opposer alleges it will be harmed by registration of the Senior Mark by way of likelihood of confusion and dilution by blurring and tarnishment. Importantly, Opposer lacks priority in the Junior Marks as Applicant commenced using the Senior Mark more than sixteen (16) years prior to Opposer's first use of the Junior Marks. Because Opposer cannot demonstrate priority of use, Opposer cannot prove likelihood of confusion nor

dilution arising from registration of the Senior Mark. For this and other reasons, this Opposition proceeding should be dismissed with prejudice.

A. Applicant Retains Superior Rights to the Senior Mark

Applicant has been continuously using its Senior Mark in connection with the applied-for goods and services since at least as early as November 1, 2000. 10 TTABVUE 1-2: Wilson Decl. at ¶¶ 4-5. Years later, on March 25, 2017, Opposer began using its Junior Marks. 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22. Applicant's prior use of the Senior Mark establishes its superior common law rights thereto. *See In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) (property rights to a mark are established by prior use).

In summarily concluding that Opposer has superior rights to use the Junior Marks, it cites the *L'Oreal v. Macron* decision. There, the Board pointed out that priority cannot be disputed when an opposer properly introduces its registrations into the record which themselves demonstrate priority. *L'Oreal S.A. v. Marcon,* 102 USPQ2d 1434, 1436 (TTAB 2012). To that end, in the *L'Oreal* case, the opposer was the senior user per the trademark applications/registrations on the record and had been using its mark since 1921. *Id.*at 1440. On the other hand, the defendant in that case had filed a § 1(b) application and had not yet used the mark in commerce. *Id.* at 1461. Differently, here, Opposer's registrations assert a first use date of March 25, 2017 while Applicant has been using its marks since November 1, 2000, which is also alleged in the Senior Mark application. 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22. Because priority is disputed, Opposer's registrations are not entitled to the same deference.

B. Opposer's Section 2(d) Claim Fails Because Applicant Has Priority of Use

To properly state a claim of likelihood of confusion, an opposer must plead and later prove that (1) applicant's mark, as applied to its goods or services, so resemble opposer's mark or trade

name as to be likely to cause confusion, mistake, or deception; and (2) it has priority of use. *See* 15 U.S.C. § 1052(d); *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). As Opposer cannot meet the threshold inquiry of priority of use, no likelihood of confusion is possible.

Additionally, any doubts regarding likelihood of confusion are to be resolved against the newcomer. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.,* 22 USPQ2d 1453, 1458 (Fed. Cir. 1992), *cert. den.,* 113 S.Ct. 181 (1992); *J & J Snack Foods Corp. v. McDonald's Corp*, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Chatam Int'l, Inc.*, 380 F.3d 1340, 1345 (Fed. Cir. 2004). In this case, Applicant's first use of the Senior Mark took place on November 1, 2000 and Opposer allegedly commenced use of the Junior Marks on March 25, 2017. 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22. If anything, Opposer's Junior Marks are confusingly similar to Applicant's Senior Mark. 14 TTABVUE 28: Wilson Tr. 25:13-14 (Opposer's "logo looks like it was copying my logo"). Because Opposer is clearly the relative newcomer, any doubts are resolved against Opposer and in favor of Applicant. Applicant's Senior Mark is not confusingly similar to Opposer's Junior Marks.

C. Dilution of Opposer's Junior Marks By Applicant's Senior Mark is Impossible

The Trademark Act provides for a cause of action for the dilution of famous and distinctive marks:

> [T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence of absence of actual or likely confusion, of competition, or of actual economic injury.

Section 43(c)(1), 15 U.S.C. § 1125(c)(1). Section 13(a) of this Act makes dilution by blurring or tarnishment under Section 43(c) a basis for opposing registration. 15 U.S.C. § 1063(a).

A successful claim for federal trademark dilution by blurring requires an "association arising from the similarity between a mark…and a famous mark that impairs the distinctiveness of the famous mark." Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). Differently, a federal trademark dilution by tarnishment claim exists when there is "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." Section 43(c)(2)(C), 15 U.S.C. § 1125(c)(2)(C). Opposer is unable to demonstrate that registration of Applicant's Senior Mark will dilute the Junior Marks by blurring or tarnishment.

i. Opposer's Junior Marks Are Not Famous

To prevail on a dilution claim, the plaintiff's mark must have achieved fame prior to any established, continuous use of the defendant's mark. 15 U.S.C. § 1125(c). Fame for dilution requires widespread recognition by the general public. 15 U.S.C. § 1125(c)(2)(A). To establish this requisite level of fame, Opposer must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark. *The Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). Opposer must show that when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Id.* at 118; *see also Coach Servs. v. Triumph Learning, LLC*, 668 F.3d 1356, 1373, 1010 USPQ2d 1713, 1730 (Fed. Cir. 2012) *quoting Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir. 2004) (defining a famous mark as one that has become a "household name"). Opposer has proffered no such evidence.

Fame for dilution purposes is a high bar that is significantly more stringent than fame for likelihood of confusion purposes. *See Coach Servs.*, 101 USPQ2d at 1724; *Palm Bay Imps. Inc. v.*

Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Accordingly, a mark can acquire sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007). Indeed, it is well-established that dilution fame is difficult to prove. *Toro*, 61 USPQ2d at 1177; *Coach Servs.*, 1010 USPQ2d at 1731. At best, Opposer has been using the Junior Marks for approximately three years and therefore, cannot establish fame even under the lower standard for likelihood of confusion. 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22.

In its brief, Opposer only discusses the alleged fame of its Junior Marks with regard to its likelihood of confusion analysis. 15 TTABVUE 37. In so doing, Opposer throws out a number of statements and figures purporting to support this claim of famousness. 15 TTABVUE 39-40. For instance, Opposer claims to have invested "more than $1.837 million in advertising and promoting" of its goods and services offered under the Junior Marks. *Id.* However, Opposer has provided no context within which to evaluate these figures and as such, Opposer's assertions bear minimal, if any, weight. *See Bose Corp. v. QSC Audio Prods., Inc.*, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) (providing the example of "a 30-second spot commercial shown during a Super Bowl football game" which "may cost a vast sum, but the expenditure may have little if any impact on how the public reacts to the commercial message.") Additionally, Opposer's registration is not evidence of the nature and extent of opposer's use and advertising of the Junior Marks and is, therefore, not probative of consumer reaction to the mark. *Martha White, Inc. v. American Bakeries Co.*, 157 USPQ 215, 217 (TTAB 1968). Because Opposer has insufficiently plead and proven fame for likelihood of confusion purposes, the requisite level of fame for dilution is certainly not satisfied.

Further, to succeed on its dilution claim, Opposer's alleged fame in the Junior Marks must have been established prior to Applicant's first use of the Senior Mark and must also exist at the time of trial. *Coach Servs.*, 1010 USPQ2d at 1729; *Tivo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1109 (TTAB 2018); *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012). Opposer apparently relies on the filing date of Applicant's Senior Mark application as the constructive use date of the Senior Mark. 15 TTABVUE 41. In this manner, Opposer cites *Chanel, Inc. v. Makarczyk* to stand for the proposition that "Opposer may rely on the filing date of Applicant's application as Applicant's constructive use date." 15 TTABUE 41. However, Opposer fails to acknowledge the remainder of this premise which clearly provides that Applicant's constructive use date applies **only where the record contains no evidence of Applicant's use**. *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2024 (TTAB 2014); *see also Toro*, 61 USPQ2d at 1174 (noting that "[i]n a use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the party alleging fame must show that the mark had become famous prior to the applicant's use of the mark.") As such, the March 15, 2018 filing date is irrelevant to this analysis.

To the contrary, "such use" as used in Section 43(c) of the Trademark Act "could refer to any use by the defendant in commerce," or "could refer to the particular use being challenged in the litigation." *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 330 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (explaining that no opposition based on dilution can subsist "where the allegedly famous mark did not achieve fame prior to any use by the accused infringer.") The record is replete with evidence demonstrating Applicant's first use date of November 1, 2000 and first use in commerce date of January 1, 2006. *See, e.g.,* 10 TTABVUE 1-2: Wilson Decl. at ¶ 4. Applicant's use of the Senior Mark, including as alleged in the application therefor, began at least

as early as January 1, 2006, which is more than a decade prior to Opposer's alleged first use of the Junior Marks. Accordingly, Opposer has not and cannot establish that the alleged fame of the Junior Marks was established prior to Applicant's first use of the Senior Mark.

ii. Consumers Will Not and Do Not Associate Applicant's Senior Mark With Opposer's Junior Marks

For dilution to be likely, there must exist an association arising from the similarity of the parties' marks so as to impair the distinctiveness of a plaintiff's famous mark. Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). Primarily, consumers viewing Applicant's Senior Mark are unlikely to conjure Opposer's Junior Marks. In particular, Opposer has submitted no evidence of actual or likely consumer association of the Senior Mark with Opposer's Junior Marks. Rather, it is far more likely that consumers will associate the Junior Marks with Applicant's Senior Mark due to Applicant's far predating initial use of the Senior Mark. 8-9 TTABVUE 5-10: Opposer's Not. of Reliance, Ex. 20, 22; 10 TTABVUE 1-2: Wilson Decl. at ¶ 4.

Further, because Opposer's Junior Marks are not famous, they are far less likely to be "remembered and associated in the public mind." *Recot Inc. v. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894 (Fed. Cir. 2000). Instead, the Junior Marks are weak and therefore, cast little, if any, shadow of protection which must be avoided by competitors. *Kenner Parker Toys,* 963 F.2d at 353, 22 USPQ2d at 1456. Since consumers are unlikely to even associate the Junior Marks with Opposer, consumers are even less likely to associate the Senior Mark with Opposer or the Junior Marks.

iii. Opposer Has Presented No Evidence That Applicant's Mark Will Tarnish Opposer's Junior Marks

A plaintiff alleging dilution by tarnishment must demonstrate the existence of an association between a famous mark and this association ***harms the reputation of the famous mark***. *See* 15 U.S.C. § 1125(c)(2)(C); *see also Coach Servs.,* 1010 USPQ2d at 1729. For instance, courts have held that tarnishment can arise from negative association, sexual or pornographic innuendo, or provision of inferior products or services. *Moseley v. V Secret Catalogue, Inc.* 537 U.S. 418 (2003) (accused use involved sex-related products); *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 111 (2d Cir. 2010) (finding that harm "generally arises when the plaintiff's trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner's product"); *Harris Research, Inc. v. Lydon*, 505 F.Supp.2d 1161 (N.D. Ut. 2007) (tarnishment present because it created a negative association). In addition to the fact that Opposer's Junior Marks are not famous, Opposer has also presented no evidence that Applicant's use of the Senior Mark will harm the reputation of the Junior Marks.

In its brief, Opposer makes the bare assertion that "Applicant is attempted to or is using its [Senior Mark]…in an attempt to gain market share for its own product or to harm the reputation of Opposer's Marks." 15 TTABVUE 46. By itself, competition does not constitute harm to the Junior Marks' reputation. Moreover, because Applicant's use far predates Opposer's use of the Junior Marks, Applicant's adoption of the Senior Mark was not and could not be aimed at harming the reputation of the later-conceived Junior Marks. In this manner, Opposer has stated no cognizable harm to the reputation of Opposer's Junior Marks. As such, Applicant's Senior Mark is not likely to tarnish Opposer's Junior Marks.

V. SUMMARY

As Opposer has failed to establish the requisite degree of fame to prevail on a claim of dilution by blurring or tarnishment, and Opposer has not proven that Applicant's Senior Mark is confusingly similar to the Junior Marks, Applicant respectfully requests the Board dismiss the Opposition proceeding with prejudice and allow Applicant's Senior Mark application to proceed to allowance and registration.

Respectfully submitted,

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Dated: November 30, 2020

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing DEFENDANT'S BRIEF has been served on counsel for Opposer, Michelle Kallenbach, by forwarding said copy on November 30, 2020 via email to mitzikallenbach@comcast.net.

Dated: November 30, 2020

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