

This Opinion is Not a
Precedent of the TTAB

Mailed: March 5, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

MobileSoft Technology, Inc.

v.

My My Star, Inc.
—

Opposition No. 91248764
—

Michelle M. Kallenbach, Esq.
for MobileSoft Technology, Inc.

Omid E. Khalifeh, Ariana Santoro and Lara A. Peterson of Omni Legal Group PLC
for My My Star, Inc.
—

Before Thurmon, Deputy Chief Administrative Trademark Judge,
Mermelstein and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

My My Star, Inc. (“Applicant”), seeks registration on the Principal Register of the
mark MY MY STAR in standard characters for “advertising services; marketing

services” in International Class 35, and “digital video production services” in International Class 41.¹

MobileSoft Technology, Inc. (“Opposer”) opposes registration of the applied-for mark in both classes on the grounds of likelihood of confusion, dilution by blurring, and dilution by tarnishment. Opposer pleaded, inter alia, ownership of the now-registered mark MYMY for the following goods and services:²


Computer software for enabling transmission, storage, sharing, collection, editing, organizing and modifying audio, video, messages, images and other data for personal computers and mobile devices in International Class 9;

Sound and video broadcasting of music and films via the Internet, telephony, or satellite broadcasting; providing on-line chat rooms and discussion forums for transmission of messages and digital pictures among users in the field of general interest; telecommunications on the Internet, namely, audio and video transmission in International Class 38;

Entertainment services, namely, providing online non-downloadable music, non-downloadable videos in the field of music and computer games; Entertainment services, namely, providing an online searchable database via a communication network featuring non-downloadable music, non-downloadable videos in the field of music and online computer games; Entertainment services, namely, music production; Entertainment services, namely, providing online computer games; Entertainment services, namely, providing rental services for musical recordings, videos, and computer games via a communication network for personal computers and mobile devices in International Class 41; and

¹ Application Serial No. 87836135 was filed on March 15, 2018, based on Applicant’s allegation of first use of the mark in commerce, as to both classes of services, on November 1, 2000, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² 1 TTABVUE 5-6 (Not. of Opp. ¶ 1), referencing Opposer’s pleaded application Serial No. 87184374. This application matured into Registration No. 6069693 on June 2, 2020, which, as explained further in this decision, has been made of record in this proceeding.

Opposer also pleaded ownership of a registration (Reg. No. 5444433) for the design mark , and one other application (Ser. No. 87309628) for a mark that incorporates the same design and the wording MYMY and matured into Registration No. 6053635.

Providing temporary use of on-line non-downloadable computer software for use in the delivery, distribution, and transmission of digital music and entertainment-related audio, video, text, and multimedia content for personal computers and mobile devices in International Class 42.

With respect to the likelihood of confusion claim, Opposer alleges that “Applicant has alleged in [a prior opposition proceeding between the same parties] that Opposer’s MYMY . . . mark [is] likely to be confused with Applicant’s alleged common law trademark MY MY STAR”;³ that “consumers are likely to be confused between Applicant’s Mark and Opposer’s MYMY mark as used on or in connection with similar goods and services”;⁴ “consumers are likely to be confused and to mistakenly believe that Applicant’s goods and services offered under Applicant’s Mark either emanate from or are licensed by, sponsored by, or associated with Opposer”;⁵ and “Applicant’s Mark is confusingly similar to Opposer’s MYMY mark and is likely, when applied to the goods of the Applicant, to cause confusion, mistake and/or deception among consumers, within the meaning of Trademark Act § 2(d), all to the detriment of Opposer.”⁶

³ 1 TTABVUE 8 (Not. of Opp. ¶ 6). Opposer references the prior proceeding, Opposition No. 91236066, wherein the Board dismissed an opposition filed by Applicant (in position of opposer and plaintiff) against Opposer’s pleaded applications in this proceeding (*see n.2*).

⁴ *Id.*, (Not. of Opp. ¶ 11).

⁵ *Id.* at 9, (Not. of Opp. ¶ 13).

⁶ *Id.* at 11, (Not. of Opp. ¶ 33).

In its answer, Applicant admits that, in a prior proceeding between the parties, it alleged that Opposer's MYMY mark and Applicant's MY MY STAR are likely to be confused.⁷ Applicant also makes the following admissions:⁸

- Applicant's Mark is substantially similar to Opposer's MYMY mark.
- Consumers are likely to be confused between Applicant's Mark and Opposer's MYMY mark as used on or in connection with similar goods and services.

Applicant otherwise denies the salient allegations of the Notice of Opposition.

The parties have briefed this opposition proceeding.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), Applicant's application file.

Opposer, during its main trial period, introduced:

- (First) testimony declaration, with exhibits, of Steven A. Sjoblad, a board member of Opposer.⁹
- Testimony declaration, with exhibits, of Joseph L. Brim, Chief Executive Officer for MyMy Music, Inc., described as "one of Opposer's businesses."¹⁰
- Notices of reliance on USPTO records.¹¹

⁷ 4 TTABVUE 3 (Answer ¶ 6).

⁸ *Id.* (Answer ¶¶ 9 and 11, respectively).

⁹ 6 TTABVUE.

¹⁰ 7 TTABVUE; Brim Decl. ¶ 1.

¹¹ 8-9 TTABVUE.

Applicant, during its trial period, submitted the testimony declaration, with exhibits, of Len Wilson, Applicant's founder and President.¹² Opposer took oral cross-examination testimony of Mr. Wilson and filed a copy of the transcript with exhibits.¹³

During its rebuttal trial period, Opposer submitted the (second) testimony declaration, with exhibits, of Steven A. Sjoblad.¹⁴

II. Opposer's Entitlement to Statutory Cause of Action

Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." We now refer to standing as entitlement to a statutory cause of action. *Peterson v. Awshucks SC, LLC*, 2020 BL 509515, at *5 n. 34 (TTAB 2020); *Major League Soccer, LLC v. F.C. Int'l Milano S.p.A.*, 2020 USPQ2d 11488, at *5 n. 18 (TTAB 2020). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). As the Court of Appeals for the Federal Circuit has observed, there is "no meaningful, substantive difference between the analytical frameworks" in the prior "standing" case law, under which an opposer must show a real interest in the proceeding and a reasonable basis for its belief in damage, see *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), and the current "entitlement" case law, under which an opposer

¹² 10-11 TTABVUE.

¹³ 12 TTABVUE (Opposer's notice of taking testimony) and 14 TTABVUE (deposition transcript and exhibits).

¹⁴ 13 TTABVUE.

must show an interest falling within the zone of interests protected by statute and damage proximately caused by registration. *Corcamore v. SFM*, 2020 USPQ2d 11277, at *4. Thus, “a party that demonstrates a real interest in [opposing registration of] ... 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].” *Id.* at *7.

Here, Opposer’s pleaded applications that matured into registrations (see Note 2), particularly Opposer’s registration for its MYMY mark (Reg. No. 6069693), have been properly introduced into the record.¹⁵ Furthermore, as already noted, Applicant admitted in its Answer that it alleged in a prior Board proceeding that Opposer’s MYMY mark is “likely to be confused with” Applicant’s MY MY STAR mark. This evidence, in conjunction with the entire record, shows that Opposer has a reasonable belief in damage by the registration of Applicant’s mark and establishes that Opposer is entitled to oppose registration of Applicant’s mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

III. Priority Is Not at Issue

As discussed, Opposer pleaded ownership of the application that subsequently issued as Reg. No. 6069693 for the mark MYMY and covering the same goods and

¹⁵ 13 TTABVUE 16-21 (Sjoblad Exh. 38).

services listed above in Classes 9, 38, 41, and 42, and this registration is of record. As such, the Notice of Opposition is deemed as providing sufficient notice to Applicant of Opposer's intention to rely on the later-issued registration for purposes of its Section 2(d) likelihood of confusion claim. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014) (when an opposer pleads ownership of an underlying application, opposer may make of record subsequently issued registration of that application without amending pleading); *Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1563 n.6 (TTAB 2011) (an applicant is on notice that an opposer intends to rely on a registration that matured from a pleaded application), *rev'd on other grounds*, slip op, No. 11-3684 (D.N.J. August 29, 2017); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006); *DC Comics v. Pan Am. Grain Mfg. Co.*, 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); *M & T Chems. Inc. v. Stepan Chem. Co.*, 150 USPQ 570, 571 (TTAB 1966).

Because Opposer's registration is of record, and Applicant has not counterclaimed to cancel it, priority is not at issue in connection with the likelihood of confusion claim as to the mark, and goods and services, covered by the registration vis-à-vis Applicant's mark and services listed in the application at issue. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016).

Applicant nevertheless argues at length that it is the senior user with respect to its mark and that “Opposer’s Section 2(d) claim fails because Applicant has priority of use.”¹⁶ Indeed, Applicant makes no substantive argument against Opposer’s likelihood of confusion claim, but conclusively states that “[a]s Opposer cannot meet the threshold inquiry of priority of use, no likelihood of confusion is possible.”¹⁷

Although Applicant acknowledges and cites to both the *King Candy* and *L’Oreal* decisions in its brief, it apparently does not believe they are applicable to this case. Applicant attempts to distinguish its position from that of the applicant in *L’Oreal* – by arguing that “the opposer [in *L’Oreal*] was the senior user per the trademark applications/registrations on the record and had been using its mark since 1921” while “[d]ifferently, here, Opposer’s registrations assert a first use date of March 25, 2017 while Applicant has been using its marks since November 1, 2000.”¹⁸

Whether an applicant may actually have prior use vis-à-vis the owner of an unchallenged registration is irrelevant in the context of a Board opposition proceeding. As the Board clearly advised the applicant in *L’Oreal*, and the same advice bears repeating here, “[w]hat applicant seems to ignore is that there can be no priority dispute when an opposer properly introduces its registrations into the record, and the applicant fails to file a counterclaim to cancel them.” *L’Oreal S.A.*, 102 USPQ2d at 1436. The Court of Claims and Patent Appeals in *King Candy* even

¹⁶ 16 TTABVUE 10.

¹⁷ *Id.* at 11.

¹⁸ *Id.* at 10.

contemplated the situation that Applicant asserts here – an “applicant/prior user” challenged by an “opposer/registrant” without use prior to applicant’s – but explains why the wording in the statute allows the proceeding to go forward on likelihood of confusion without a determination of priority:

Section 2(d) says an applicant can register, unless his mark is likely to cause confusion with a mark “**registered** in the Patent Office **or** . . . previously used . . .” (emphasis added) [and a] requirement that the registrant-opposer also be a prior user impermissively negates the statutory distinction (“or”) in Section 2(d) between a registered mark and a previously-used-but-unregistered mark, [and] would permit simultaneous registration of the same mark for the same goods to different parties . . .

King Candy, 182 USPQ at 110 (emphasis in original).¹⁹

In sum, priority is not an issue in this proceeding and we need only consider whether Applicant’s mark, when used in connection with the services listed in the application, is likely to be confused with Opposer’s registered marks for the goods and services listed in the registrations.

IV. Likelihood of Confusion

As already discussed, Trademark Act Section 2(d), 15 U.S.C. § 1052(d), prohibits the registration of a mark that [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. The fundamental purposes underlying Trademark Act Section

¹⁹ The court in *King Candy* noted that prior users are not without potential remedy. “The right to exclusive use, in such cases, may be determined in an appropriate action in a district court.” *Id.* at 111.

2(d) are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 566 (CCPA 1973) (“*DuPont*”).

In this case, although Opposer pleaded ownership of several MYMY-formative marks, we focus our likelihood of confusion analysis on Opposer’s pleaded Registration No. 6069693 for the standard character mark MYMY because this mark bears the strongest resemblance to Applicant’s standard character mark, MY MY STAR.²⁰ If we do not find confusion likely between this registered mark and Applicant’s mark, we would also not find confusion likely between Opposer’s other registered marks and Applicant’s mark. *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Our analysis is based on all of the probative evidence of record. *DuPont*, 177 USPQ 567. In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). In any

²⁰ Opposer’s pleaded registrations also each cover the same goods and services.

likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

The burden is on Opposer, as plaintiff, and, in order to prevail in order to prevail on its Section 2(d) claim, it must prove by a preponderance of the evidence that Applicant’s use of its mark in connection with the services identified in the application is likely to cause confusion, mistake, or deception as to the source or sponsorship of the parties’ goods and services. *Cunningham*, 55 USPQ2d at 1844 (plaintiff must prove priority and likelihood of confusion by a preponderance of the evidence); *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

A. Similarity of the Marks

We initially address the first *DuPont* factor, which considers the “similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 177). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal v. Marcon*, 102 USPQ2d 1438; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In comparing Registrant's MYMY mark with Applicant's MY MY STAR, we point out once again that Applicant admits that it previously alleged, in a related prior proceeding between the parties, that these marks "are likely to be confused" and that the marks are "substantially similar."²¹ In its brief, Applicant does not disavow these admissions or argue to the contrary.

Applicant's admissions are consistent with our finding that the involved marks are overall very similar given the first two words of Applicant's mark are essentially the same as the registered mark. This makes the marks aurally and visually very similar. The "identity of the marks' initial two words is particularly significant because consumers typically notice those words first." *In re Detroit Athletic*, 128 USPQ2d 1049. We further point out that Applicant seeks registration of its mark in standard character format, like the registered mark, and thus both marks may be

²¹ See Notes 7 and 8.

displayed in the same font styles, colors and sizes. See *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”)

The omission or addition of a space between the repeated term MY in the marks, does very little to distinguish the marks. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that DESIGNED TO SELL does not create a distinct commercial impression from DESIGNED2SELL). There is no evidence or persuasive argument to counter the likelihood that consumers perceive the repeated MY[]MY element in the marks as the same, and conveying the same connotation as a repeated adjective expressing possession or as an interjection expressing astonishment.²² There is no evidence to suggest that this common element in the marks is suggestive or otherwise weak based on extensive third-party use.

The addition of the term STAR at the end of Applicant’s mark is a point of difference, but it ultimately does not overcome the overall strong similarity of the marks. Applicant does not argue how the addition of this term conveys a new or different overall commercial impression. At most, we find the term STAR may be

²² We take judicial notice of the definition of “my” as “a form of the possessive case of I used as an attributive adjective” and the interjection “my-my” as being “used as an exclamation of mild surprise or dismay,” both taken from website Dictionary.Com, which uses Random House Unabridged Dictionary as a proprietary source for definitions. (<https://www.dictionary.com/browse/my?s=t>) (last accessed Feb. 25, 2021). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *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).

slightly suggestive of Applicant's advertising services, e.g., helping create a "star" celebrity.

Viewing the marks in their entirety, as we must, we find they are overall very similar. Applicant's mark, MY MY STAR, begins with and essentially incorporates the entirety of the registered mark, MYMY. The two marks are thus overall very similar in appearance, sound, and commercial impression.

Accordingly, this *DuPont* factor strongly supports a finding of a likelihood of confusion.

B. Relatedness of the Goods and Services

We turn now to the second *DuPont* factor regarding the similarity or dissimilarity of the parties' respective goods and services. *DuPont*, 177 USPQ at 567. Our determination here is based on the "nature of the goods or services as described in an application or registration." *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

It is well settled that goods or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. *See Safety-*

Klean Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1639 (TTAB 2007); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988).

At the outset of our analysis involving the parties' goods and services, we again point out that Applicant admitted in its Answer that consumers are likely to be confused between the marks "as used on or in connection with similar goods and services."²³ We do not construe this admission, however, as acknowledgement that the involved goods and services are actually related. We further note that Applicant does not argue in its brief that the parties' goods and services are unrelated. At the same time, we note that Applicant does not have to make this argument; rather, it is Opposer, as plaintiff in this proceeding, who has the burden proving at least a viable relationship by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1844; *Hydro-Dynamics*, 1 USPQ2d at 1773.

1. Applicant's Digital Video Production Services in Class 41

Opposer submitted the declaration testimony of Mr. Brim and Mr. Sjoblad, both of whom provided relevant testimony regarding a relationship between Applicant's "digital video production" and Opposer's software (and services involving the use of such software) that is used for enabling, editing and modifying video, as well as its provision of online entertainment services in the field of music and video games. Specifically, Mr. Brim avers that he is a chief executive officer for one of Opposer's

²³ 4 TTABVUE 3 (Answer ¶ 11).

businesses, with “over 25 years of experience in the entertainment industry” and is responsible for “decisions relating to the creation, product management, marketing, promoting and use of Opposer’s trademarks.”²⁴ He states that Opposer utilizes digital production studios in connection with its software in order to produce its music, audio, video and related services, under its MYMY mark.²⁵ Mr. Brim states that Opposer’s principal shareholder, in fact, owns two digital video production studios.²⁶ Mr. Sjoblad, a “long-time board member of Opposer with “more than forty years of corporate leadership, strategy and marketing expertise,” corroborated the testimony of Mr. Brim.²⁷ Applicant’s president and witness, Mr. Len Wilson, explained that its video production services involve “the development, marketing, and sale of 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.” In other words, Mr. Wilson acknowledges that digital video production services, like Applicant’s, may be used in connection with the development of various types of content, including video entertainment and broadcast material which Opposer provides.

The testimony of Brim and Sjoblad, as well as Applicant’s witness, Wilson, is sufficient to establish that Applicant’s digital video production services are related to

²⁴ 7 TTABVUE 4-5 (Brim Decl. ¶¶ 1, 4-5).

²⁵ *Id.* at 10; (Brim Decl. ¶ 17).

²⁶ *Id.*, referencing Ex. 18.

²⁷ 6 TTABVUE 5 (Sjoblad Decl. ¶¶ 3, 12).

Opposer's software (and services related to allowing access to the software) for enabling transmission, storage, sharing, collection, editing, organizing and modifying video, as well Opposer's online entertainment services in the field of music and video.

Accordingly, with respect to Applicant's Class 41 digital video production services, the *DuPont* factor involving relatedness of the parties' goods and services supports a finding of a likelihood of confusion.

2. Applicant's Marketing and Advertising Services in Class 35

As to Applicant's advertising and marketing services, Opposer fails to explain how these services are related to any of its own goods and services. Although Opposer conclusively asserts in its brief that "consumers would have every reason to believe the goods and services emanate from the same source," this statement appears to only relate to Applicant's digital video production services, not advertising and marketing services.²⁸ Opposer does not argue with any particularity how Applicant's advertising or marketing services are related to any of Opposer's goods or services as they are identified in the registration. Based on the evidence, including the testimony of Messrs. Brim, Sjoblad and Wilson, with exhibits, we do not find a viable relationship exists between Applicant's advertising or marketing services and any of the goods and services listed in Opposer's registration.

²⁸ 15 TTABVUE 45.

In view thereof, with respect to Applicant's Class 35 marketing and advertising services, we find the *DuPont* factor involving relatedness of the parties' goods and services weighs against finding likelihood of confusion.

C. Alleged Fame of Opposer's MYMY mark

We turn next to the fifth *DuPont* factor, which considers the "fame" or strength of the prior mark, *DuPont*, 177 USPQ at 567. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame, or strength of a mark, "may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods or services] sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods or services] identified by the mark[]; and the general reputation of the [goods or services]." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017). The determination of the strength or fame of a mark is not a binary analysis, but rather is the examination of a continuum from the weakest to the most famous. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) ("The TTAB applied a legally incorrect

standard in applying an all-or-nothing measure of ‘fame,’ more akin to dilution analysis.”)

Opposer’s MYMY mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). Opposer, however, goes further and argues that the record “demonstrates the fame” of its MYMY mark.²⁹ In support, Opposer points to the following:³⁰

- “Since March 25, 2017, Opposer has continuously used the MYMY word [mark] in connection with” its goods and services.
- “Sjoblad testified that as the result of Opposer’s enforcement activities, other than the Applicant’s mark challenged in this proceeding, Opposer’s use of the MYMY word and design marks are substantially exclusive, [and] he is aware of no third parties using the MYMY word mark . . . in connection with Opposer’s Goods/Services”
- “Sjoblad testified that Opposer has invested more than \$1.837 million in advertising and promoting its Goods/Services under the MYMY word [mark]”
- “All advertisements and promotions prominently featured the MYMY word [mark]”
- “Sjoblad and Brim testified that Opposer advertises its Goods/Services through its website . . ., which prominently displays its MYMY word and design mark at the top of every page, including but not limited to the Website home page, featured artist page, voting page, trending page, newly promoted tracks and on each useful links and about company”
- “Brim testified that last year alone (May 14, 2019 – May 14, 2020), the Website generated more than 59,000 new users and more than 202,000 hits”

²⁹ 15 TTABVUE 50.

³⁰ *Id.* at 47-49 (Opposer’s brief, with citations to record).

- “While most of Opposer’s customers are engaged through the Website and app, Opposer also uses social media to advertise its Goods/Services under its MYMY word and design marks, including pages on Facebook, Twitter, and YouTube. Opposer’s Facebook, Twitter, and YouTube pages promoting Opposer’s MYMY word and design marks’ Goods/Services”
- “Brim testified that over the years, Opposer’s Goods/Services have garnered numerous unsolicited national and international media coverage”

We note a number of shortcomings in Opposer’s evidence. For example, Opposer does not provide evidence of sales figures for its MYMY-branded goods or services, the number of units sold for its MYMY-branded goods, or an approximate number of customers to whom it has rendered any of its MYMY-branded services. Without this information, we cannot estimate how many consumers have actually purchased or used Opposer’s goods and services under the MYMY mark, let alone place those numbers into context with other business entities. In other words, we cannot gauge Opposer’s position in relation to competitors. *Bose Corp.*, 63 USPQ2d at 1309 (“[S]ome context in which to place raw statistics is reasonable”); *cf. Mini Melts v. Reckitt Benckiser*, 118 USPQ2d 1480 (probative value of sales revenue figures quantified as doses sold is diminished by the fact that the amount is just a raw number without context as to applicant’s market share or whether this amount is significant in the industry).

Opposer’s advertising and promotion expenditures and its uses of social media to advertise its goods and services, do not show that Opposer’s MYMY mark has acquired any degree of renown. Opposer did not provide additional evidence to indicate with any sort of specificity the reach of its promotional efforts. Also, the fact that Opposer’s website “generated more than 59,000 new users and more than

202,000 hits,” is not very meaningful without context and further evidence showing how these “new users” are exposed to Opposer’s mark. In comparison to the type and amount of evidence found to be persuasive for purposes of demonstrating some renown or fame in a mark, Opposer’s evidence falls short. *See, e.g., Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018) (significant exposure to mark based on extensive evidence regarding social media following, millions of customers targeted through direct mail advertising, nationwide retail locations, as well as national print, radio and TV ads, unsolicited movie and TV publicity).

Finally, as to Brim’s testimony that “over the years, . . . Opposer’s goods/services have garnered unsolicited media coverage,” much of evidence of this “media attention” given to Opposer’s MYMY mark appear to be press releases prepared by Opposer or write-ups in a few blogs or online articles, without any indication as to the scope of their distribution and circulation.³¹ It is not possible to estimate the extent of consumer exposure to the press releases and online articles without knowing the reach or extent of readers or persons who may have viewed these materials.

Opposer has not proven its MYMY mark is a “very strong” or “famous” mark, when placed in the spectrum of strength of marks for purposes of the likelihood of confusion analysis. At best, Opposer has shown that it has enjoyed moderate commercial

³¹ 7 TTABVUE 8 (Brim Dec. ¶ 14, referencing Brim Exh. 17). Brim Exh. 17 (7 TTABVUE 50-64) comprises three press releases, an article from www.blackenterprise.com, an article from what appears to be a music festival blog (blog.a3cfestival.com), and an article from www.thehypemagazine.com).

success with its MYMY mark in the relatively short amount of time the mark has been in use, since 2017. To the extent Opposer has been successful in promoting its brand in these last four years, the fifth *duPont* factor only slightly favors Opposer. *Tao Licensing*, 125 USPQ2d at 1056.

D. Conclusion

Opposer's registered mark, MYMY, is inherently distinctive, with some commercial success. Considered in their entirety, Opposer's mark is very similar to Applicant's MY MY STAR mark. Moreover, because Opposer's goods and services are related to Applicant's digital video production services in Class 41, we conclude that a likelihood of confusion exists as to this class.

However, because we find no demonstrated relationship between Opposer's goods and services and Applicant's advertising and marketing services in Class 35, we do not conclude that a likelihood of confusion exists between the parties' marks as to this class.

II. Dilution by Blurring and by Tarnishment

The Trademark Act defines dilution by blurring as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). Dilution by tarnishment is defined as an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C).

Thus, to succeed on either dilution claim, the statute requires that Opposer must show it owns a famous mark. Additionally, “[f]ame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. ... Accordingly, a mark can acquire ‘sufficient public recognition and renown for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.’” *Coach Servs.*, 101 USPQ2d at 1724. *See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Because, Opposer’s MYMY mark does not meet the lesser standard of fame for purposes of likelihood of confusion, it cannot be famous for purposes of dilution. *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1250 (TTAB 2015) (“Where, as here, a mark is not proven famous for purposes of likelihood of confusion, it will certainly not meet the higher threshold for fame required to prove dilution.”). Accordingly, Opposer has not demonstrated a required element of its dilution claims and we dismiss Opposer’s claims under Section 43(c) of the Trademark Act.

Decision: The opposition is sustained on the ground of likelihood of confusion as to the services in Class 41 of the application. However, the opposition is dismissed as to the services in Class 35 of the application.

Opposer’s dilution grounds for opposition are also dismissed.

The application will proceed to registration solely as to Class 35.