

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: January 13, 2022

Mailed: September 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Giorgio Armani S.p.A.
v.
SEH International, Ltd.
—

Opposition No. 91252482
—

Paolo A. Strino of Gibbons P.C.,
for Giorgio Armani S.p.A.

John P. Fredrickson, Mathew E. Corr, and Marriam Lin of Boyle Fredrickson, S.C.,
for SEH International, Ltd.

—
Before Taylor, Coggins, and Hudis,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

SEH International, Ltd. (“Applicant”) seeks registration on the Principal Register

of the stylized mark  for

Sports equipment, namely, soccer uniforms, namely, shirts and shorts; jackets, pants and sweatshirts, belts for clothing, and socks, in International Class 25; and

Sports equipment, namely, soccer equipment in the nature of soccer balls, futsal balls, goalkeepers gloves, and soccer ball goal nets, in International Class 28.¹

Giorgio Armani S.p.A. (“Opposer”) opposes registration of Applicant’s mark, in Class 25 only, on the bases of likelihood of confusion under Section 2(d) and dilution under Section 43(c) of the Trademark Act. 15 U.S.C. §§ 1052(d) & 1125(c).² Opposer claims ownership of Registration No. 4239644 on the Principal Register for the standard-character mark **AX** for goods and services in several International Classes, including:

Clothing, namely, pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweatpants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, tights, vests, waistcoats, jumpers, tracksuits, blousons, gym suits, knickers, T-shirts, anoraks, suspenders, loungewear, underwear, beachwear, sleepwear, overalls, gloves and scarves; headgear, namely, hats and caps; shoes, sandals, boots and slippers, in International Class 25;³

and prior common law use of the marks **AX** and **AX ARMANI EXCHANGE** for decades prior to Applicant’s filing date for a variety of products including the clothing goods identified above.

¹ Application Serial No. 88289218 was filed on February 5, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere at least as early as April 30, 2017, and first use in commerce at least as early as November 30, 2017, for each class. According to the application: “The mark consists of [t]he word ‘AXIO’ with a stylized ‘X.’” Color is not claimed as a feature of the mark.

² The Class 28 goods are not opposed. See 1 TTABVUE. Citations to the record and briefs reference TTABVUE, the Board’s online docket system. See, e.g., *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020). Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

³ Registration No. 79039260 issued on November 13, 2012; Sections 71 and 15 combined declaration accepted and acknowledged.

In its answer, Applicant denied the salient allegations of the Notice of Opposition.⁴

The case is fully briefed. An oral hearing was held on January 13, 2022. For the reasons explained below, we dismiss the opposition in its entirety.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's application. In addition, the parties introduced the testimony and evidence listed below:

A. Opposer's Testimony and Evidence

- Testimony declaration of Antonio Croce, Opposer's global Intellectual Property Manager, with Exhibits A-E (17 TTABVUE);⁵
- Rebuttal Testimony Declaration of Antonio Croce, with Exhibits A-B (31 TTABVUE);⁶
- First Notice of Reliance on USPTO electronic database records for Registration No. 4239644 (9 TTABVUE);
- Second Notice of Reliance on material printed from the Internet relating to Opposer's advertising campaigns (10 TTABVUE);
- Third Notice of Reliance on material printed from the Internet relating to Opposer's mobile applications and smart watches (11 TTABVUE);

⁴ Applicant alleged five purported affirmative defenses, but four are merely amplifications of its denials to the opposition and not true affirmative defenses, so we do not address them as such. *See, e.g., DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *1 (TTAB 2020). Likewise, we do not address Applicant's "defense" of failure to state a claim upon which relief may be granted, which was not pursued and is therefore forfeited. *See John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010).

⁵ Confidential version at 18 TTABVUE.

⁶ Confidential version at 30 TTABVUE.

- Fourth Notice of Reliance on Applicant's responses to Opposer's first sets of interrogatories and requests for admission (12 TTABVUE);⁷
- Fifth Notice of Reliance on material printed from Opposer's website (14 TTABVUE);
- Sixth Notice of Reliance on material printed from Applicant's website (15 TTABVUE);
- Seventh Notice of Reliance on various material printed from the Internet purporting to link Opposer with sports and athletes (16 TTABVUE); and
- First Rebuttal Notice of Reliance on records from other Board proceedings in which Opposer was the plaintiff, as well as TESS database records relating thereto (32 TTABVUE).

B. Applicant's Testimony and Evidence

- Testimony declaration of Duncan Hall, Records Request Processor at the Internet Archive which operates the Wayback Machine, with Exhibit A (23 TTABVUE);
- Testimony declaration of Marriam Lin, Applicant's counsel, with Exhibits A1-G3 consisting of material printed from and photographs of clothing purchased through various third-party websites (25 TTABVUE);⁸
- Applicant's First Notice of Reliance on responses to Office actions from the file of the application underlying Opposer's pleaded Registration No. 4239644 (20 TTABVUE);
- Applicant's Second Notice of Reliance on USPTO electronic database records for AX-formative third-party registrations and a non-pleaded registration owned by Opposer (27 TTABVUE);
- Applicant's Third Notice of Reliance on Opposer's responses to Applicant's first sets of interrogatories and requests for admission (22 TTABVUE);⁹

⁷ Confidential version at 13 TTABVUE.

⁸ A "corrected" copy adding a certificate of service was submitted at 26 TTABVUE.

⁹ Confidential version at 21 TTABVUE.

- Applicant's Fourth Notice of Reliance on various materials printed from the Internet purporting to show third-party use of AX-formative marks, and Internet search engine results related to the term AX (24 TTABVUE); and
- Applicant's Fifth Notice of Reliance on material printed from Opposer's website and social media pages (28 TTABVUE).

II. Evidentiary Issues

Before proceeding to the merits of the opposition, we consider Opposer's objections to much of Applicant's evidence. Opposer objects on the grounds of relevancy and hearsay to six sets of documents submitted by Applicant, comprised of Internet evidence or records from the USPTO.¹⁰ In particular, Opposer argues that the materials "are not relevant, because their contents do not contain facts of consequence in determining this proceeding and its outcome," and "[t]o the extent Applicant uses these printouts to show the truth of any matter asserted therein, they are inadmissible hearsay." 35 TTABVUE 2-4.

Opposer's hearsay objections are moot because we consider Internet materials only for what they show on their face, not for the truth of the matters stated in them, "whether there is an objection or not." *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 n.18 (TTAB 2018) (citing *Safer, Inc. v.*

¹⁰ Specifically, the objections relate to: (1) Internet Archive material submitted with the Hall Declaration; (2) third-party websites submitted with the Lin Declaration; (3) Opposer's responses to Office actions from the application file underlying its pleaded registration, submitted with Applicant's First Notice of Reliance; (4) third-party registrations submitted with the Second Notice of Reliance; (5) website evidence of third-party use of AX-formative marks submitted with the Fourth Notice of Reliance; and (6) Opposer's website and social media pages submitted with the Fifth Notice of Reliance. *See* 35 TTABVUE.

OMS Invs., Inc., 94 USPQ2d 1031 (TTAB 2010)). We need not address Opposer’s relevance objections because we are “capable of weighing the relevance and strength or weakness of the objected to testimony, including any inherent limitations [and] [a]s necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought.” *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *4 (TTAB 2020), *aff’d in relevant part, vacated in part*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)). “In short, ‘we simply accord the evidence whatever probative value it deserves, if any at all.’” *Id.* (quoting *Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011), *rev’d in part on other grounds*, No. 11-3684 (SRC) (CLW), 2017 WL 3719468 (D.N.J. Aug. 29, 2017)).

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *See 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). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by registration of the mark. *See Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *6 (TTAB 2020) (citing *Corcamore*, 2020 USPQ2d 11277, at *6-7). *See also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert.*

denied, 142 U.S. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

“[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].” *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *17 (TTAB 2022) (quoting *Corcamore*, 2020 USPQ2d 11277 at *7).

Opposer made of record a copy of its pleaded AX registration from the TSDR electronic database.¹¹ Accordingly, Opposer’s entitlement “is established with respect to its likelihood of confusion and dilution claims by its registration [of the standard-character mark AX] . . . which the record shows to be valid and subsisting, and owned by Opposer.” *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d at 1501 (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). *See also Primrose Ret. Cmtys., LLC v. Edward Rose Sr. Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (entitlement established based on pleaded registration made of record).

¹¹ 1 TTABVUE 18-27; 9 TTABVUE 8-21.

IV. Priority

Because Opposer made of record its valid and subsisting pleaded Registration No. 4239644 for the mark AX,¹² and Applicant has not challenged the registration by way of any cancellation counterclaim, “priority is not at issue for the mark[] and the goods . . . identified in” that registration. *New Era Cap v. Pro Era*, 2020 USPQ2d 10596, at *9 (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)). *See also Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at *17 (same).

V. Likelihood of Confusion

Section 2(d) of the Trademark Act 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, or a mark or trade name previously used in the United States by another and not abandoned, 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.

15 U.S.C. § 1052(d). “In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.” *Stratus Networks v. UBTA-UBET Commc’ns. Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (citing *Cunningham v. Laser Golf*, 55 USPQ2d at 1848).

Our analysis under Section 2(d) is based on all of the probative evidence of record relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de*

¹² Opposer also relies on prior common law rights as alleged in its notice of opposition; however, in light of our determination below on the issue of likelihood of confusion, we need not make any determination regarding priority of Opposer’s pleaded common law marks for clothing.

Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks v. UBTA-UBET Commc’ns*, 2020 USPQ2d 10341, at *3 (citing *Dixie Rests.*, 41 USPQ2d at 1406-07).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l v. Kappa Books, Inc.*, 64 USPQ2d at 1380).

We focus our analysis on the standard-character mark in Opposer's pleaded Registration No. 4239644 rather than the variations thereof in which Opposer claims common law rights. Not only does Opposer rely heavily on this registered mark in its brief, but the registered standard-character mark is closer to Applicant's mark than the variations of the common law marks AX and AX ARMANI EXCHANGE pleaded and used by Opposer in the marketplace.¹³ If we find a likelihood of confusion as to this mark, we need not find it as to the others; conversely, if we do not find a likelihood of confusion as to this mark, we would not find it as to the others. *See Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of Goods, Channels of Trade, and Buyers to Whom Sales are Made

"We begin with the second and third *DuPont* factors, which respectively consider '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,' and 'the similarity or dissimilarity of established, likely-to-continue trade channels.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567)). "We also discuss the portion of the fourth *DuPont* factor that addresses the 'buyers to whom sales are made.'" *Id.* (quoting *DuPont*, 177 USPQ at 567). We make our determinations for

¹³ See, for example, multiple different "stylized configurations" of the pleaded AX mark highlighted in paragraphs 31 and 32 of Mr. Croce's testimony declaration, 17 TTABVUE 13-14, as well as additional stylized iterations of the mark displayed on clothing at Opposer's website, 17 TTABVUE 28-73.

these factors based on the goods as they are identified in the application and asserted registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Dixie Rests.*, 41 USPQ2d at 1534.

The application and pleaded registration each list “jackets,” “sweatshirts,” “belts,” and “socks” in the identification of goods. In addition, the “trousers” identified in Opposer’s pleaded registration are legally identical to the “pants” identified in Applicant’s application.¹⁴

The identity of certain goods within the respective identifications means that no more is necessary to demonstrate a finding of similarity of goods to support a likelihood of confusion. *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Because Applicant’s clothing goods are in-part identical to Opposer’s clothing goods, we presume that they travel in the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed.

¹⁴ The semicolon in the identification of Applicant’s goods prior to “jackets, pants and sweatshirts, belts for clothing, and socks” indicates that these items of clothing are a separate category of goods from the “sports equipment” listed just prior. *See In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1166 & n.4 (TTAB 2013) (finding that semicolon in an identification separates services into discrete categories); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01(a) (July 2022). Accordingly, Applicant’s “jackets, pants and sweatshirts, belts for clothing, and socks” are not limited to “sports equipment.”

Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019), (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

Accordingly, the second and third *DuPont* factors, and the portion of the fourth *DuPont* factor regarding the buyers to whom sales are made, favor a finding of likelihood of confusion. *Sabhnani*, 2021 USPQ2d 1241, at *19-20.

B. Actual Confusion

Opposer argues there has been no meaningful opportunity for actual confusion to occur because Applicant's goods have been sold under the proposed mark for only approximately three years; and, at any rate, proof of actual confusion is not necessary to establish a likelihood of confusion.¹⁵ Applicant introduced Opposer's answer to Interrogatory No. 12 in which Opposer stated that it has not identified any inquiries regarding confusion or association between the parties, their marks, or their goods.¹⁶

“[T]he absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Although we presume the goods are sold in the same channels of trade to the same

¹⁵ Opposer's Brief, 33 TTABVUE 44-45.

¹⁶ 21 TTABVUE 20 (confidential).

consumers, we cannot gauge from Applicant's evidence whether or the extent to which there has been a meaningful opportunity for actual confusion to occur. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value here because ... no evidence was presented as to the extent of [applicant's] use of [its] mark on the merchandise in question in prior years ..."); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). Assuming that the marks have been in contemporaneous use for only a little over three years, that affords little opportunity by itself for actual confusion to have occurred. *See Primrose Ret. Cmtys.*, 122 USPQ2d at 1039-40. This factor is neutral.

C. Strength or Weakness of Opposer's AX Mark

Before we evaluate the similarity or dissimilarity of the parties' marks, we first consider the strength or weakness of Opposer's asserted AX mark under the fifth and sixth *DuPont* factors as that may affect the scope of protection to which Opposer's mark is entitled. The fifth *DuPont* factor enables Opposer to expand the scope of protection afforded its pleaded mark by adducing evidence of "[t]he fame of the prior mark (sales, advertising, length of use)," while the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of "[t]he number and nature of similar marks in use on similar goods." *See Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at *17 (quoting *DuPont*, 177 USPQ at 567).

In determining the strength of a mark, we consider both its conceptual strength, based on the nature of the mark itself, and, if there is probative evidence in the record,

its commercial strength, based on marketplace recognition of the mark. *New Era Cap v. Pro Era*, 2020 USPQ2d 10596 at *10; *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 . . . and its marketplace strength . . .”).


1. Conceptual Strength

As to conceptual strength, Opposer’s AX mark is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of Trademark Act, 15 U.S.C. §1052(f); therefore, it is presumed to be inherently distinctive for the identified goods. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511 (TTAB 2016) (quoting *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (“inasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least suggestive”). Indeed, AX appears to be an arbitrary designation for clothing, having no descriptive or geographic meaning when used in connection with the goods, and therefore appears to have some inherent strength. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks).

On the other hand, evidence that a mark, or an element of a mark, was adopted or at some time appropriated by many different third-party registrants may undermine the common element’s conceptual or inherent strength as an indicator of a single source. *Jack Wolfskin Austrang Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both

parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason)); *see also Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011) (third-party registrations indicate term CLASSIC has suggestive meaning as applied to tobacco products).

Applicant introduced the following 12 use-based, third-party registrations of AX-formative marks for clothing and footwear.¹⁷

Registration No.	Mark	Goods
1778731	AXO	motorcycle clothing
2276574	AXIST	clothing
2458619	AXXENTS	outerwear
3059453	AXIOS	clothing
3062694	AXT	socks
5053860	Axesea	clothing, beachwear, shoes
5366268	 ALETTERHIN	clothing and outerwear
5611178	 axion	clothing and footwear

¹⁷ 25 TTABVUE 12-48.

Registration No.	Mark	Goods
5703025	AXCENT	outerwear
6111102	AXXIOM	footwear
6158439	axial	clothing
6179658	AXELLION	boots and shoes

Applicant argues these third-party registrations identifying clothing and for marks beginning with the element AX demonstrate that AX has not been exclusively appropriated by any one entity in the field of apparel and that customers distinguish between AX-formative marks when additional letters are used.¹⁸

Opposer’s Intellectual Property Manager, Antonio Croce, testified about Opposer’s efforts to enforce its rights in the AX trademark, and stated that the marks in the 12 third-party registrations submitted by Applicant did not, in his opinion, “present an issue from [Opposer’s] perspective for various reasons including but not limited to differences in the trademarks’ appearances, sounds, meanings, and overall commercial impressions”¹⁹

While the marks in the third-party registrations all begin with AX, we agree with Opposer that the differences between Opposer’s registered AX mark and these marks’ appearances, sounds, and overall commercial impressions diminish their probative

¹⁸ Applicant’s Brief, 38 TTABVUE 31.

¹⁹ Croce Rebuttal Decl. ¶ 9; 31 TTABVUE 7.

value. The majority of the registered third-party marks made of record by Applicant comprise the initial letters A-X with multiple other letters suggesting complete words that engender commercial impressions that greatly differ from the term AX alone. Even the two marks that add only one additional letter (i.e., AXO and AXT) convey different commercial impressions than AX standing alone. In each of the third-party registered marks, the commercial impression of the stand-alone AX element is lost to the average consumer. In short, Applicant's third-party registration evidence does not serve to diminish the conceptually arbitrary nature of Opposer's AX mark in connection with clothing.

2. Commercial Strength

Opposer submits arguments and evidence that its AX mark has acquired commercial strength and is famous through use and recognition in the marketplace.²⁰ Market or commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Likelihood of confusion fame varies along a spectrum from very strong marks to very weak marks. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). A famous mark is commercially strong and has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir.

²⁰ Opposer's Brief, 33 TTABVUE 41-42, 48-50; Reply Brief, 40 TTABVUE 17-20, 21-22.

1992). A mark is considered “famous” for likelihood of confusion purposes when “a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imps.*, 73 USPQ2d 1689 at 1694. Such a mark “casts a long shadow which competitors must avoid.” *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012) (quoting *Kenner Parker Toys*, 22 USPQ2d at 1456).

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to prove the alleged fame of its AX mark clearly. *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at *31 (citing *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

The indicia used to measure likelihood of confusion fame is very much the same as that used to measure commercial strength generally. That is, fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014). See also *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689-90 (Fed. Cir. 2018) (indirect indicia of fame may include “the

volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident”) (quoting *Bose Corp.*, 63 USPQ2d at 1305); *New Era*, 2020 USPQ2d 10596, at *10-11.

Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Bose*, 63 USPQ2d at 1309. Other ways Opposer can place its raw financial data in context include proofs of the general reputation of its products sold and services rendered in connection with the AX mark, or other contextual evidence of the type of advertisements and promotions Opposer uses to gain sales to show that the consuming public has been regularly exposed to Opposer’s mark on a nationwide scale. *See, e.g., Omaha Steaks*, 128 USPQ2d at 1690 (“Market share is but one way of contextualizing ad expenditures or sales figures.”).

To demonstrate the fame of its mark, Opposer submitted a variety of evidence indicating that since at least 1991 Opposer has regularly and continuously used the AX mark in interstate commerce on clothing. In particular, Mr. Croce, Opposer’s Intellectual Property Manager, testified about Opposer’s use of the AX mark, Opposer’s geographic trading area, sales revenues, and advertising expenditures.²¹ Mr. Croce stated that since 1991, Opposer “conservatively calculates that it has sold hundreds of thousands of units of products bearing AX on the product itself in every

²¹ Mr. Croce testified to many of Opposer’s international endeavors, for example that Opposer “is an international fashion house” with a global presence and a sponsor of the Italian Olympic team, a Milan marathon, and a Milan basketball team. *See, e.g., Croce Testimony Decl.* ¶¶ 6, 7, 13, 15, 16 (17 TTABVUE 7-9). We consider only those activities demonstrated to bear on commerce and consumers in the United States.

state of the United States;”²² Opposer derived over one billion dollars in sales revenue between 2015 and 2019 for goods bearing the AX mark in the U.S.;²³ Opposer has for many years advertised its mark through print media, billboards, sponsored celebrity endorsements and testimonials, brand ambassadors, targeted ads in department stores, social media campaigns, and sponsored product placement;²⁴ Opposer spent a few million dollars per year on direct media expenditures between 2015 and 2019, related solely to goods sold under the AX mark;²⁵ from 1991 through 2020 Opposer executed advertising campaigns in the U.S. under its AX mark²⁶ within such magazines over the years as Vogue, Teen Vogue, Interview, W, Jane, Marie Claire, Glamour, Elle, People, Out, GQ, Details, Cosmopolitan, and Men’s Health;²⁷ and as of July 2020 Opposer’s Facebook and Instagram accounts each have two million followers.²⁸

The sales and advertising information provided by Opposer’s witness lacks context as to how these measures of commercial success compare with other clothing companies, making the information less probative. “Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but

²² Croce Testimony Decl. ¶ 19 (17 TTABVUE 9).

²³ Croce Testimony Decl. ¶ 19 (17 TTABVUE 10). Because precise dollar figures here and elsewhere in the record are confidential, we discuss them only generally and to the extent revealed in Opposer’s brief.

²⁴ Croce Testimony Decl. ¶¶ 14, 24, 45 (17 TTABVUE 8, 11, 19).

²⁵ Croce Testimony Decl. ¶ 30 (17 TTABVUE 13).

²⁶ Croce Testimony Decl. ¶¶ 36-37 (17 TTABVUE 15).

²⁷ Croce Testimony Decl. ¶¶ 36-37, 40, Ex. C (17 TTABVUE 15, 16, 79-1076).

²⁸ Croce Testimony Decl. ¶ 27 (17 TTABVUE 12).

raw numbers alone in today's world may be misleading.” *Bose*, 63 USPQ2d at 1309; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2009) (“[T]he problem that we have in assessing the effectiveness of the advertising expenditures is that there is no testimony or evidence regarding whether opposer’s advertising expenditures are large or small vis-à-vis other comparable medical products.”). *See also Omaha Steaks*, 128 USPQ2d at 1690 (contextual evidence needed “to arrive at a proper understanding of whether customers would recognize the mark”).

Similarly, Opposer does not provide the extent of distribution or reach of its advertising campaigns and print advertisements, nor explain the frequency of the ads. *See Omaha Steaks*, 128 USPQ2d at 1690-92 (discussing testimony about how and where the opposer promoted its products to the public through catalogs, direct mailings, email marketing, customer calls, television, radio, magazine and newspaper campaigns, digital marketing, and social media, as well as the volume of these efforts and their impact upon the creation of customer recognition of the opposer’s marks); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (“The advertisements of record do not support an inference of distinctiveness inasmuch as the evidence fails to disclose information from which the number of people exposed to the design could be estimated--such as circulation of the publications in which the advertisements appear, advertising expenditures, number of advertisements published, volume of sales of the soccer balls, and the like.”).

In addition, Applicant counters that Opposer's sales and advertising figures fail to distinguish between the various iterations of the AX mark. However, because we consider Opposer's registration of the mark in standard characters, separate sales and advertising figures for the various iterations of the AX mark are not particularly probative. The rights associated with a standard-character mark reside in its wording, not in any particular display. *See* Trademark Rule 2.52, 37 C.F.R. § 2.52 (a standard-character mark is "without claim to any particular font style, size, or color").

Applicant also argues Opposer's AX mark is rarely advertised standing alone; instead, it is frequently displayed in conjunction with Opposer's ARMANI EXCHANGE mark.²⁹ Applicant posits it is impossible to determine how much revenue and advertising is attributable to AX alone. Indeed, on every complete page from Opposer's website,³⁰ in almost every advertising campaign,³¹ on its social media pages,³² and in most print advertisements,³³ Opposer displays the AX mark along with the expression ARMANI EXCHANGE.

Applicant draws parallels between this case and a nonprecedential Board decision,³⁴ *Blue Nile, Inc. v. Brent Neale LLC*, Opp. 91239053, 2020 WL 2302386

²⁹ Applicant's Brief, 38 TTABVUE 35-36.

³⁰ *See, e.g.*, Croce Testimony Decl. Ex. A, 17 TTABVUE 44-45, 47-48, 49-50; Applicant's 5th Notice of Reliance, 28 TTABVUE 11, 19.

³¹ *See, e.g.*, Croce Testimony Decl. Ex. B, 17 TTABVUE 75-78.

³² Applicant's 5th Notice of Reliance, 28 TTABVUE 12-17.

³³ *See, e.g.*, Croce Testimony Decl. Ex. C, 17 TTABVUE 83 (Vibe), 87 (Vogue), 99 (Marie Claire), 107 (Elle).

³⁴ "Non-precedential decisions are not binding on the Board, but may be cited to and considered for whatever persuasive value they may hold." *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014).

(TTAB 2020), which found that the opposer therein failed to prove that its cited registered mark, BN (stylized), was commercially strong for jewelry because it almost invariably used the stylized BN in conjunction with its trade name Blue Nile.³⁵ In that case, the opposer's trade name was presented as a larger element that eclipsed its stylized letter mark. In the present case, however, ARMANI EXCHANGE is always presented in a smaller format, with AX as the larger mark.

Further, Opposer counters that "many of the clothing items sold under Opposer's AX[®] Mark do not show the expression ARMANI EXCHANGE at all."³⁶ However, many instances of Opposer's use of AX as a mark or ornamental design on its clothing goods do include the designation ARMANI EXCHANGE.³⁷ We are presented with a mixed record demonstrating that sometimes the expression ARMANI EXCHANGE appears with AX on clothing, but sometimes it does not.

We agree with Applicant to the extent that the persuasiveness of Opposer's evidence is reduced because of the ubiquitous presence of ARMANI EXCHANGE with AX in Opposer's advertising. *See, e.g., ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1245 (TTAB 2015) ("It is well-settled that, where, as here, a party's advertising and sales data is based on materials and packaging in which the mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition."). On the

³⁵ Applicant's Brief, 38 TTABVUE 35-36.

³⁶ Opposer's Reply Brief, 40 TTABVUE 19.

³⁷ *See, e.g.,* Applicant's 5th Notice of Reliance, 28 TTABVUE 22, 28, 34, 38, 40, 50, 52.

other hand, we also agree with Opposer to the extent that the evidence is still somewhat probative of the strength of AX because that mark is always the larger element when accompanied by ARMANI EXCHANGE. *Compare Bose Corp.*, 63 USPQ2d at 1306-07 (“the consumer is presented through the advertising and other promotional material with frequent references to the marked product standing alone and apart from the famous house mark” allowing the consumer to disassociate the product mark from the house mark).

Opposer provided limited evidence relating to the extent of consumer exposure to its social media platforms (e.g., only the number of followers on Facebook and Instagram as of July 2020) but no evidence of other analytics or metrics, the specific time periods that Opposer used these social media accounts, or that the number of followers were limited to U.S. consumers. Although Twitter, YouTube, Pinterest, and Tik Tok were named as other social media platforms by which Opposer advertises its products, no metrics or other evidence was provided by Opposer about its presence on those platforms.³⁸

The commercial strength of a mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567; *In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018) (“Evidence of third-party use may reflect commercial weakness.”). As to this facet of the fame inquiry, Applicant introduced 13 examples of third-party use of AX-formative marks for clothing. Ten of the examples are uses by the third-party registrants for the registered marks

³⁸ Croce Testimony Decl. ¶¶ 25-27 (17 TTABVUE 11-12).

mentioned earlier,³⁹ while three are uses by additional third parties for the marks AXE, AX Paris, and AXNY in connection with clothing.⁴⁰ Opposer's witness testified that Opposer successfully opposed registration of the mark AXNY and reached an agreement with the owner of that mark.⁴¹

Although "extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established," *Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation*, 115 USPQ2d at 1674, we have no such showing in this case. Applicant has presented, at most, uses of three similar marks (i.e., AXE, AX Paris, and AXNY) – well short of the powerful volume of evidence found convincing in *Jack Wolfskin* and *Juice Generation*. See also *Primrose Ret. Cmtys.*, 122 USPQ2d at 1034-36 (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

³⁹ These uses are of AXIST (25 TTABVUE 41-61), AXION (*id.* at 63-77), AXELLION (24 TTABVUE 8-10), AXESEA (*id.* at 14-21), AXT (*id.* at 23-28), AXIOS (*id.* at 32-51), AXO (*id.* at 53-60), AXIAL (*id.* at 63-64), AXCENT (*id.* at 66-72), and AXXIOM (*id.* at 75-85).

⁴⁰ AXE (axeworkwear.com, 25 TTABVUE 7-12) for flame-resistant apparel, AX Paris and AxParis (amazon.com, *id.* at 14-25; macys.com, *id.* at 27-39) for women's clothing, and AXNY (axny.com, *id.* at 79-87) for men's pants.

⁴¹ Croce Rebuttal Decl. ¶¶ 11-13 (31 TTABVUE 8); confidential settlement agreement submitted.

3. Conclusion Regarding Strength


Opposer's mark has inherent, conceptual strength. Although Opposer demonstrated that it has used the AX mark since 1991, it provided sales and advertising figures for only five of those years and did not provide context for those numbers or present evidence of market share. The probative value of Opposer's sales and advertising figures are further tempered by the fact that Opposer frequently uses and advertises its AX mark along with the designation ARMANI EXCHANGE, rendering it more difficult to discern the strength of AX alone for clothing.

Overall, the evidence demonstrates that Opposer is a successful company and that the mark AX likely has some commercial strength. The evidence does not, however, demonstrate that AX is a famous mark. In consideration of Opposer's evidentiary shortcomings, but also recognizing the sums reported for Opposer's advertising and sales, we find Opposer's mark is conceptually strong and has some commercial strength and therefore falls on the stronger side of the spectrum from very strong to very weak, *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, and is entitled to a somewhat enhanced scope of protection. By no means, however, has Opposer proved that its AX mark is famous.

D. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps.*, 73 USPQ2d at 1691. The proper test regarding similarity "is not a side-by-side comparison of the marks, but instead whether the

marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted). In this case, the average consumer is an ordinary consumer of clothing.

Opposer’s registered mark is **AX** in standard characters, and Applicant’s mark is a stylized .

Opposer contends that because its mark is registered in standard characters, it is not limited in the manner in which it may display its AX mark, and we must assume that Opposer could display the mark in a stylization similar to Applicant’s mark.⁴² This is accurate. *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (marks in standard character form “could be used in any typeface, color, or size, including the same stylization actually used or intended to be used by the other party, or one that minimizes the differences or emphasizes the similarities between the marks.”).

Opposer continues, arguing that even though Applicant’s mark also contains the letters “IO,” consumers would focus primarily on the first “AX” portion because of the

⁴² Opposer’s Brief, 33 TTABVUE 35.

noticeably larger size of the letter X.⁴³ Opposer also argues that “Applicant display[s] the additional literary element ‘IO’ in a manner that highlights the AX-formative element thus leading the relevant consuming public to read the letters ‘AX’ and ‘IO’ in isolation. Applicant’s mark even displays the letters ‘IO’ using a sans-serif font-type rendering it effectively identical to the number ‘10’, and presenting AXIO . . . as an iterative version of an AX[®]-branded product, [i.e.,] ‘AX No. 10.’”⁴⁴

We disagree with Opposer that consumers would focus on the AX portion of Applicant’s mark. The sweeping, arcing line of the exaggerated ascending stroke in Applicant’s letter “X” creates a connection between the letters preceding and following it. The ascending stroke touches the “A” and reaches over the top of the “I” such that there is a visual connection from left to right, leading the eye across the complete mark, not just the first two letters. Further, because the sans-serif font begins with the first letter and is continued by the ending “IO,” and there is no additional or exaggerated space between the “X” and the following “I,” there is no reason to believe that a consumer is likely to view the “IO” portion of the mark as the number ten, nor has Opposer adduced evidence that a consumer would do so.

We find that while both marks are similar in appearance to the extent they contain the letters “AX” and may be presented in the same stylization, they also differ in appearance because of the additional “IO” in Applicant’s mark which is visually connected to the rest of the mark.

⁴³ Opposer’s Brief, 33 TTABVUE 36-37.

⁴⁴ Opposer’s Reply Brief, 40 TTABVUE 8.

Opposer acknowledges Applicant's argument that Opposer's AX mark "would be pronounced as 'ā eks'" (i.e., as the two separate letters "A" and "X"), and has no objection to this assertion.⁴⁵ We agree it is likely Opposer's mark would be perceived and pronounced as the two letters "A" and "X" where the parties have not adduced evidence or argued that AX is a recognized English word, and where the evidence demonstrates that Opposer frequently advertises and associates its mark with the designation ARMANI EXCHANGE, the letters "AX" being a reference thereto. Opposer also responded to Request for Admission Nos. 8 and 9 stating that it "admits that the pronunciation of [its word mark] AX is 'ā eks' and that it has not changed over time."⁴⁶

However, AX also may be an abbreviation for "axiom" or "axis," or even a variant of "axe," and in the latter instance could be pronounced as "äks."⁴⁷ In its brief, Opposer contends that "at least some consumers . . . might pronounce it[s mark]" that way;⁴⁸ and in an elaborated response to Request for Admission Nos. 8 and 9 that is "is conceivable that at least some consumers presented with [its mark] would pronounce it as 'äks'."⁴⁹ While we acknowledge such a pronunciation is "conceivable," on this

⁴⁵ Opposer's Brief, 33 TTABVUE 37; Applicant's Brief, 38 TTABVUE 25.

⁴⁶ 22 TTABVUE 39-40.

⁴⁷ "Ax" from MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) and THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (ahdictionary.com), accessed September 28, 2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 n.10 (TTAB 2020).

⁴⁸ Opposer's Brief, 33 TTABVUE 37.

⁴⁹ 22 TTABVUE 39-40.

record we do not believe, and Opposer has not demonstrated, that such pronunciation is likely. Indeed, Opposer argued in its brief that its AX mark “has no meaning, albeit it originally started as an abbreviation of the expression ARMANI EXCHANGE.”⁵⁰

Acknowledging the concession that its mark is pronounced as “ā eks” (i.e., as the two separate letters “A” and “X”), Opposer posits that the significant visual emphasis on the letter “X” in Applicant’s mark would encourage consumers to pronounce that mark similarly as “ā eks aɪə,” or “more likely as ‘ā eks ten.”⁵¹ We agree with Applicant, however. It is more likely Applicant’s mark will be pronounced as “ak’sē-ō”⁵² as that is a natural pronunciation of the combined letters AXIO. Similar to our analysis of the 12 third-party registrations of AX-formative marks for clothing discussed above, we note that Applicant’s mark comprises the initial letters “AX” with multiple other following letters suggesting a complete word that engenders a pronunciation (here, “ak’sē-ō”) which differs from Opposer’s mark.⁵³

Most significantly, we find the parties’ marks engender very different commercial impressions. Opposer argues “[b]ecause the parties’ marks are so similar in

⁵⁰ Opposer’s Brief, 33 TTABVUE 38.

⁵¹ Opposer’s Brief, 33 TTABVUE 37.

⁵² Applicant’s Brief, 38 TTABVUE 25.

⁵³ In its brief, Applicant asks us to take judicial notice from an online medical dictionary (at medical-dictionary.thefreedictionary.com/axio-) that the prefix “axio-” is pronounced “ak’sē-ō.” 38 TTABVUE 25. Opposer objects because Applicant has not shown that the dictionary exists in a printed or regular fixed edition. 40 TTABVUE 13. Inasmuch as Applicant did not provide a printout from the website nor any information about the lexicographer, the objection is sustained. While the Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions, *see In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006), there is no indication that is the situation here.

appearance, sound, and meaning (or lack thereof), they create highly similar commercial impressions.”⁵⁴ However, as we just discussed, the marks’ appearances and pronunciation are not so similar. Additionally, to the extent a consumer would view the stylized, ascending stroke of the “X” as a check mark, the commercial impression of Applicant’s mark would be even further from Opposer’s AX mark.

We also find the following four marks of the third-party registrations Applicant introduced to be as close or closer in similarity to Opposer’s mark than is Applicant’s mark: AXO, AXIOS, AXT, and AXION. *Cf. Palisades Pageants, Inc. v. Miss Am. Pageant*, 442 F.2d 1385, 169 USPQ 790, 793 (CCPA 1971) (“[A]ppellant’s mark is closer to appellee’s than even the closest of the third-party registrations.”). Opposer’s Intellectual Property Manager testified that these marks (in fact, all of the marks of the 12 third-party registrations) did not “present an issue” from Opposer’s perspective for various reasons including the differences in those marks’ appearances, sounds, meanings, and overall commercial impressions.⁵⁵

While we acknowledge both parties’ marks contain the letters “AX,” we find the marks in their entirety are dissimilar and purchasers will not ascribe a common source or sponsorship to the apparel sold thereunder. The overall differences in the marks visually, aurally, and in the commercial impressions engendered by the marks outweigh the similarities. We find the parties’ marks are not similar in appearance,

⁵⁴ Opposer’s Brief, 33 TTABVUE 39.

⁵⁵ Croce Rebuttal Decl. ¶ 9; 31 TTABVUE 7.

sound, connotation, or commercial impression. Accordingly, this factor favors a finding of no likelihood of confusion.

E. Balancing the DuPont Factors

Any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. In fact, in some cases, a single factor (such as the differences in the marks) may be dispositive. *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[A] single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”); *Kellogg Co. v. Pack'em Enters Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). We find that to be the case here.

Opposer emphasizes when the goods of the parties are identical, as they are in this opposition, the degree of similarity between the marks necessary to support a determination that confusion is likely declines.⁵⁶ We acknowledge this principle. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

Although we find the respective goods are in-part identical and presumed to be sold in the same channels of trade to the same classes of consumers, and Opposer's AX mark is entitled to a somewhat enhanced scope of protection, these factors are outweighed by the dissimilarity of the marks. For that reason, we find the first

⁵⁶ Opposer's Reply Brief, 40 TTABVUE 10.

DuPont factor to be pivotal, and that confusion is unlikely. *See, e.g., Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (affirming Board dismissal of opposition based on dissimilarity of the marks MAYA and MAYARI); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) (affirming Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em*, 21 USPQ2d at 1142 (affirming Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739-40 (Fed. Cir. 1989) (affirming Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES in commercial impression); *Sock It To Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *13 (TTAB 2020) (dismissing likelihood of confusion claim based on dissimilarity of the marks SOCK IT TO ME and SOCK IT UP).

In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *DuPont* factors, as well as all of the parties' arguments with respect thereto. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). We find that Opposer has failed to show by a preponderance of the evidence a likelihood of confusion between Applicant's mark and Opposer's pleaded registered mark AX.

Opposer's likelihood of confusion claim under Section 2(d), 15 U.S.C. § 1052(d), is dismissed.

VI. Dilution

Dilution by blurring is "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." Trademark Act Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). Dilution may be likely "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." Trademark Act Section 43(c)(1), 15 U.S.C. § 1125(c)(1).

The U.S. Court of Appeals for the Federal Circuit has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (1) [the plaintiff] owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
- (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs. Inc. v. Triumph Learning LLC., 101 USPQ2d at 1723-24.

As noted above, fame for purposes of likelihood of confusion is a matter of degree that "varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards*, 122 USPQ2d at 1734 (quoting *Coors Brewing*, 68 USPQ2d at 1063). However, fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. *Coach Servs.*, 101 USPQ2d at

1724. *See also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:104 (5th ed. Sept. 2022 update) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic likelihood of confusion test.”). While fame for dilution “is an either/or proposition” – it either exists or does not – fame for likelihood of confusion is a matter of degree along a continuum. *Coach Servs.*, 101 USPQ2d at 1724 (citing *Palm Bay Imps.*, 73 USPQ2d at 1694). 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.” *Coach Servs.*, 101 USPQ2d at 1724 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007)).

Fame for dilution requires widespread recognition by the general public. 15 U.S.C. § 1125(c)(2)(A). To establish the requisite level of fame, Opposer must show that, when the general public encounters the mark “in almost any context, it associates the term, at least initially, with [Opposer].” *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 n.8 (TTAB 2001)). In other words, a famous mark is one that has become a “household name.” *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Nissan Motor Co. v. Nissan Comput. Corp.*, 378 F.3d 1002, 72 USPQ2d 1078, 1083 (9th Cir. 2004)). It is well established that dilution fame is difficult to prove. *See Coach Servs.*, 101 USPQ2d at 1724 (citing *Toro*, 61 USPQ2d at 1180) (“Fame for dilution purposes is difficult to prove.”); 4 MCCARTHY § 24:104 (noting that fame for dilution is “a difficult and demanding requirement,” “difficult to

prove,” and that, although “all ‘trademarks’ are ‘distinctive’ – very few are ‘famous’”). With this framework in mind, we turn to Opposer’s evidence of fame and our analysis discussed above.

Given our determination above that Opposer has failed to prove the fame of its AX mark for purposes of its likelihood of confusion claim, Opposer falls far short of the quantum and quality of evidence required to prove that its AX mark is famous for dilution purposes and thus cannot meet its burden of proving dilution in this proceeding.

Opposer’s dilution claim under Section 43(c), 15 U.S.C. § 1125(c), is therefore dismissed.

VII. Decision

The opposition to registration of the mark in Class 25 of Application Serial No. 88289218 is dismissed on both grounds of likelihood of confusion under Section 2(d), and dilution under Section 43(c). The application will proceed to registration in both classes.