

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

R. Josephs Licensing Inc.

v.

Laguna Beach Football Club

Opposition No. 91264741

Erik M. Pelton of Erik M. Pelton & Associates, PLLC
for R. Josephs Licensing Inc.

Jeffrey L. Van Hoosear, Jonathan A. Menkes and Charles K. Crane of
Knobbe, Martens, Olson & Bear, LLP
for Laguna Beach Football Club.


Before Taylor, Coggins and Hudis,
Administrative Trademark Judges.


Opinion by Hudis, Administrative Trademark Judge:

Laguna Beach Football Club (“Applicant”) seeks registration of the following mark
on the Principal Register:



for: “Hats; sweatshirts; t-shirts; track pants; athletic uniforms; track jackets” in International Class 25.¹ In the Application, “LAGUNA BEACH,” “LB,” and “FOOTBALL CLUB” all have been disclaimed.

In its Notice of Opposition,² R. Josephs Licensing Inc. (“Opposer”) opposes registration of Applicant’s  mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods identified in the Application, so resembles Opposer’s marks registered on the Principal Register:



Mark	Registration No. Issue Date	Goods
	1050106 October 12, 1976 ³	Swimwear and t-shirts, Cl. 25

¹ Application Serial No. 88793060 was filed on February 11, 2020, based upon Applicant’s allegation of first use of the mark anywhere and first use in commerce since at least as early as January 10, 2020, under Trademark Act Section 1(a), 15 U.S.C. §1051(a). The Application also recites services in International Class 41, but those services are not the subject of the present opposition.

The Application contains the following description of the mark: “The mark consists of a black shield with rounded top and pointed bottom and a gold single line along the border of the shield. The stylized gold letters ‘LB’ appear in the center of the shield, the wording ‘LAGUNA BEACH’ appears in gold above the letters ‘LB,’ and the wording ‘FOOTBALL CLUB’ appears in gold below the letters ‘LB’. Two small gold waves are below the wording ‘Football Club’ at the bottom of the shield.”

² Notice of Opposition, 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

³ Registration No. 1050106 has been renewed. The Registration contains the following lining statement: “The drawing is lined for the colors blue and yellow.” Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the USPTO’s color lining system. The color lining system required applicants to line their drawings using certain patterns designated for certain colors, and to provide a color-lining statement describing where the colors appeared. The color lining system was discontinued effective

Mark	Registration No. Issue Date	Goods
LAGUNA	1541125 May 30, 1989 ⁴	Men's, and boys' clothing, namely, swim suits, swim wear, sport shirts, t-shirts, underwear, shoes, women's, and girls' clothing, namely, shorts, pants, jeans, Cl. 25
 LAGUNA	4885627 January 12, 2016 ⁵	Swim suits; swim wear; t-shirts, Cl. 25
	4886056 January 12, 2016 ⁶	Swim suits; swim wear; t-shirts, Cl. 25

as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the Notice of Opposition in its Answer.⁷

Applicant asserted several defenses in its Answer, none of which were pursued at trial or in Applicant's Brief on the case. Applicant therefore has forfeited these

October 30, 1999; however, during a transitional period between October 30, 1999 and November 2, 2003, the USPTO continued to accept drawings that showed color by using this lining system. For applications filed on or after November 2, 2003, the USPTO does not accept black-and-white drawings lined for color. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 808.01(b) (July 2022).

⁴ Registration No. 1541125 has been renewed.

⁵ For Registration No. 4885627, an Affidavit of Use pursuant to Trademark Section 8, 15 U.S.C. § 1058, has been accepted; a Declaration of Incontestability pursuant to Trademark Act Section 15, 15 U.S.C. § 1065, has been acknowledged. The Registration contains the following description of the mark: "The mark consists of the word 'LAGUNA' beneath the design of a heart having a second heart spaced inside and a hibiscus flower inside the inner heart."

⁶ For Registration No. 4886056, an Affidavit of Use pursuant to Trademark Section 8 has been accepted; a Declaration of Incontestability pursuant to Trademark Act Section 15 has been acknowledged. The Registration contains the following description of the mark: "The mark consists of the word 'LAGUNA' with the design of a crashing wave to the right side inside three rhombus."

⁷ Answer, 5 TTABVUE.

defenses, and we give them no further consideration. *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at *5 n.14 (TTAB 2022) (various affirmative defenses deemed waived because no evidence or argument presented at trial); *see also In re Google Tech. Holdings LLC*, 980 F.3d 858, 2020 USPQ2d 11465, at *3 (Fed. Cir. 2020) (“[F]orfeiture is the failure to make the timely assertion of a right[.]”).

The case is fully briefed. Opposer bears the burden of proving its Trademark Act Section 2(d) claim by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951 (Fed. Cir. 2000); *Jansen Enters., Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). Having considered the evidentiary record, the parties’ arguments and applicable authorities, as explained below, we find that Opposer has not carried its burden, and we dismiss the Opposition.

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application.⁸ In addition, the parties introduced the following evidence:

A. Opposer’s Evidence for its Case in Chief

- Abstracts of Opposer’s pleaded Registration Nos. 1050106, 1541125, 4885627 and 4886056 from the USPTO’s TSDR database, showing their active status and Opposer’s ownership thereof; attached as Exhibits 1-4 to the Notice of Opposition.⁹

⁸ Page references herein to the application record for Application Serial No. 88793060 refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system.

⁹ 1 TTABVUE 13-43.

B. Applicant's Evidence for its Case in Chief

- Applicant's Notice of Reliance ("ANOR") on third-party registrations, as well as screen captures of Opposer's website, Applicant's website and third-party websites.¹⁰
- The Testimony Declaration of Lucie Martlin ("Martlin Decl."), Applicant's Director of Operations and an advisor to its Board of Directors, with an exhibit.¹¹

C. Opposer's Rebuttal Evidence

- Opposer's First Notice of Reliance on screen captures of third-party websites.¹²
- Opposer's Second Notice of Reliance on Notices of Opposition Opposer has filed with the Board in other proceedings, Board decisions issued in other opposition and cancellation proceedings filed by Opposer, and refusals to register third-party applications in which Opposer's trademark registrations were cited as a bar under Trademark Act Section 2(d).¹³
- Opposer's Third Notice of Reliance on copies, and abstracts from the USPTO's TSDR database, of Opposer's pleaded Registration Nos. 1050106, 1541125, 4885627 and 4886056 showing their active status and Opposer's ownership thereof.¹⁴
- The Testimony Declaration of Ronald H. Josephs, Opposer's President and owner.¹⁵

II. Applicant's Evidentiary Objections

Before proceeding to the merits of the Opposition, we address Applicant's evidentiary objections.

¹⁰ 15 TTABVUE.

¹¹ 16 TTABVUE.

¹² 17 TTABVUE.

¹³ 18 TTABUVE.

¹⁴ 19 TTABVUE.

¹⁵ 20 TTABVUE.

A. Prior Rulings of the Board in this Proceeding

Pursuant to Applicant's consented motion to extend the trial schedule in this proceeding,¹⁶ granted by the Board,¹⁷ Opposer's testimony period for its case-in-chief opened on September 19, 2021, and closed on October 18, 2021. Opposer did not take any testimony or make documentary evidence of record during its testimony period.

After Opposer's testimony period closed, Applicant moved for judgment pursuant to Trademark Rule 2.132(a), 37 C.F.R. § 2.132(a).¹⁸ Opposer responded to Applicant's motion for judgment and cross-moved to reopen its testimony period.¹⁹

Because Opposer made its pleaded registrations of record with its Notice of Opposition, the Board held that Applicant's motion for judgement pursuant to Trademark Rule 2.132(a) was inappropriate and therefore denied the motion.²⁰ On Opposer's cross-motion to reopen, the Board found that Opposer had not established its failure to take testimony or submit evidence during its testimony period was the result of excusable neglect, and therefore denied the cross-motion.²¹

B. Was Applicant's Objection to Opposer's Rebuttal Evidence Timely Asserted?

As indicated above, the only evidence Opposer made of record in support of its case-in-chief was its pleaded registrations. In its brief on the case, Applicant objects

¹⁶ Consent Motion to Extend, 8 TTABVUE, filed August 2, 2021.

¹⁷ Board Order extending dates, 9 TTABVUE, issued on August 2, 2021.

¹⁸ Applicant's motion for judgment, 10 TTABVUE, filed November 30, 2021.

¹⁹ Opposer's response and cross-motion to reopen, 12 TTABVUE, filed December 19, 2021.

²⁰ Board Order of March 24, 2022, 14 TTABVUE 3-4.

²¹ *Id.* at 5-9.

to Opposer's First, Second and Third Notices of Reliance, and Mr. Joseph's Testimony Declaration, all submitted during Opposer's Rebuttal Period, as improper rebuttal.²² Before we consider the merits of Applicant's evidentiary objection, we must first decide whether the objection was timely.

"As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived." *Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *4 (TTAB 2020) (quoting *Nahshin v. Prod. Source Int'l, LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013)), *appeal filed*, (E.D. Va., Case No. 3:20-cv-00400-MHL, June 5, 2020). "[O]bjections to ... testimony[] on substantive grounds, such as that the proffered evidence constitutes ... improper rebuttal ..., generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly." *Id.* (quoting TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 707.04 (2022); *see also Int'l Dairy Foods Ass'n v. Interprofession du Gruyère*, 2020 USPQ2d 10892 *3-4 (TTAB 2020) ("Applicants raised numerous hearsay objections for the first time in their main brief; these objections are timely."), *appeal filed*, (E.D. Va., Case No. 1:20-cv-01174, October 6, 2020).

We find Applicant's objection that Opposer's First, Second and Third Notices of Reliance, and Mr. Joseph's Testimony Declaration, constituted improper rebuttal was not a procedural objection which Opposer could have cured had Applicant raised the objection earlier. Rather, Applicant's improper rebuttal objection was substantive in

²² Opposer's Brief, 28 TTABVUE 7-8.

nature, such that Applicant appropriately waited to raise the objection in its brief on the case. Applicant's improper rebuttal objection therefore was timely asserted.

C. Was Opposer's Evidence Improper Rebuttal?

During a plaintiff's rebuttal testimony period, the plaintiff may introduce evidence and testimony to deny, explain or discredit facts and witnesses adduced by the defendant. *Gen. Elec. Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) (rebuttal testimony and evidence is intended to be limited to denials, refutations or explanations of defendant's testimony and evidence). However, in an extended line of decisions, the Board considers evidence to be improper rebuttal where it does not serve to do the above, but rather where it relates to witness testimony and factual materials that more appropriately should have been introduced during the plaintiff's case-in-chief. *See Illyrian Imp., Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at *9-10 (TTAB 2022) (Board considered Opposer's rebuttal testimony declaration and exhibits only to the extent that it rebutted the testimony of Applicant's witnesses, but not testimony and material that Opposer should have introduced as part of its case-in-chief); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1958 (TTAB 2008); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Carefirst of Md. Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1498 (TTAB 2005), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

A plaintiff's contention that it has offered evidence to contradict the testimony or other evidence introduced by the defendant does not necessarily make the plaintiff's evidence the proper subject of rebuttal. *See Seven-Up Co. v. Get Up Corp.*, 123 USPQ

87, 89 (TTAB 1959) (“Evidence ... [that] would have been a substantive part of opposer’s case, and the fact that it was offered to contradict the testimony of applicant’s president does not, under the circumstances, make it proper rebuttal.”).

Applicant argues:

All of Opposer’s testimony and evidence submitted during its rebuttal period should have been presented in Opposer’s testimony period so that Applicant had an opportunity to investigate the evidence and submit responsive evidence. By waiting until its rebuttal period, Opposer stripped Applicant of its right to review and respond with testimony and additional evidence.²³

Opposer responds:

In its testimony period, Applicant put forth evidence that attempted to show the relative weakness [of] Opposer’s marks, including evidence of third-party registrations and websites.

In rebuttal, Opposer then submitted testimony evidence to demonstrate the relative strength of Opposer’s marks. This evidence ... is intended to rebut Applicant’s attempted display of weakness. Opposer’s First Notice of Reliance features screenshots of LAGUNA products for sale on the Internet by ... [third-party retailers and Applicant], to show the strength of Opposer’s marks by providing evidence of their widespread presence in the marketplace. ... Opposer’s Second Notice of Reliance features official records of previous [T]rademark Trial and Appeal Board cases demonstrating Opposer’s enforcement and strength of its LAGUNA marks. ... Opposer’s Third Notice of Reliance features records of Opposer’s trademark registrations, which are identified in the pleadings, and are relevant to the strength of Opposer’s marks and Opposer’s claims. ... Finally, Opposer’s testimony declaration of Ronald H. Josephs features details about the enforcement of Opposer’s mark, Opposer’s sales, and related details relevant to the strength or weakness of the pleaded marks.

Opposer’s rebuttal testimony ... goes to the claims that Opposer’s marks are weak or diluted. The rebuttal testimony submitted in this proceeding has clearly been used by Opposer to “to deny, explain or

²³ Applicant’s Brief, 28 TTABVUE 8.

discredit applicant's testimony and evidence" and thus is entirely appropriate.²⁴




Applicant's improper rebuttal objection is well taken, and we disagree with Opposer's explanations as to why its First, Second and Third Notices of Reliance, and Mr. Joseph's Testimony Declaration, constituted proper rebuttal. Evidence as to the "widespread presence [of Opposer's branded products] in the marketplace," Opposer's trademark enforcement efforts, the status and title of Opposer's pleaded registrations,²⁵ and Opposer's sales as well as other details about the use and enforcement of its marks, all were subjects of what should have been presented during Opposer's case-in-chief regarding the elements of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also Primrose Retirement Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1040 (TTAB 2016) ("Opposer has the burden of proof and must establish its likelihood of confusion claim by a preponderance of the evidence").

We therefore give Opposer's First, Second and Third Notices of Reliance, and Mr. Joseph's Testimony Declaration, no further consideration. The only evidence we consider in support of Opposer's case are the abstracts of Opposer's pleaded Registration Nos. 1050106, 1541125, 4885627 and 4886056 from the USPTO's TSDR database attached to the Notice of Opposition.

²⁴ Opposer's Reply Brief, 29 TTABVUE 6-7

²⁵ Opposer's Third Notice of Reliance on Opposer's pleaded trademark registrations in any event was unnecessarily duplicative of the same evidence already made of record with Opposer's Notice of Opposition.

III. The Parties

Opposer, a California corporation located in Encino, California, is the owner of record of Registration Nos. 1050106, 1541125, 4885627 and 4886056 for the respective marks , LAGUNA,  and  identified above, for various clothing goods.²⁶ Applicant is a soccer club located in Laguna Beach, California.²⁷

IV. Entitlement to Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the U.S. Court of Appeals for the Federal Circuit and the Board, is an element of the plaintiff’s case 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); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at *4 (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-

²⁶ Notice of Opposition, 1 TTABVUE 5, 13-43, ¶¶ 2-5, Exhs. 1-4; Answer, 5 TTABVUE 3-4, ¶¶ 2-5.

²⁷ Martlin Decl., 16 TTABVUE 2, ¶ 2.

70 (2014)); *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022); *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic* 2020 USPQ2d 10837, at *3; *Empresa Cubana*, 111 USPQ2d at 1062. There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at *4. Thus, “a party that demonstrates a real interest in [oppos]ing a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3].” *Id.*, 2020 USPQ2d 11277 at *7.

Opposer has demonstrated through the USPTO database printouts made of record with its Notice of Opposition that it is the owner of its pleaded registrations comprised of the term LAGUNA for various clothing goods and that the registrations are valid and subsisting. Because its registrations are of record, Opposer has established its entitlement to bring a Trademark Act Section 2(d) claim that is not wholly without merit. *See Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *6 (TTAB 2020).

V. Priority

Because Opposer's pleaded registrations are of record, and Applicant did not assert any counterclaims to cancel them, priority in this Opposition is not at issue with respect to the goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

VI. Likelihood of Confusion: Applicable Law and Analysis

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *DuPont* 177 USPQ at 567 (the "*DuPont*" factors) (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record bearing on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We have considered 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). However, 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) ("the various evidentiary factors may play more

or less weighty roles in any particular determination”). Moreover, “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 applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source, and to protect registrants from damage caused by registration of marks for goods or services that are likely to cause confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

A. The Similarity or Dissimilarity of the Respective Goods, Channels of Trade and Prospective Consumers

1. Goods

We first turn to a comparison of the goods at issue, the second *DuPont* factor, *DuPont*, 177 USPQ at 567. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s Application and Opposer’s Registrations. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)).

We need not consider whether each of Opposer's identified goods is related to Applicant's goods for purposes of a *DuPont* analysis; it is sufficient if likelihood of confusion is found with respect to use of an applicant's mark in connection with any product in a particular International Class. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

One of Applicant's identified goods, "t-shirts," appears in all of Opposer's pleaded registrations. Because of the identity of these goods, the second *DuPont* factor supports a finding that confusion is likely.

2. Channels of Trade and Potential Customers

The third *DuPont* factor "considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). The trade channels factor considers the modalities and means (e.g., print, media, store aisles or shelves, or online) by which the respective goods are marketed, *see In re Majestic Distilling*, 65 USPQ2d at 1204, sold or distributed, *see Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

Because the goods described in Opposer's Registrations and Applicant's Application are in part legally identical, we presume that the channels of trade and classes of purchasers for those goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to

similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....’”). Accordingly, the trade channels and prospective consumers overlap.

The third *DuPont* factor thus supports a finding that confusion is likely.

B. Similarity or Dissimilarity of the Marks

1. Strength of Opposer’s Marks

Before we evaluate the similarity or dissimilarity of the respective marks, we first consider the strength of Opposer’s LAGUNA marks. The strength of Opposer’s marks affects the scope of protection to which they are entitled. The strength of a mark rests on the extent to which “a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

Thus, we consider the conceptual strength of Opposer’s marks, based on the nature of the marks themselves, and their commercial strength, based on the marketplace recognition of the marks. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength ...”). The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567.



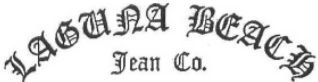
Seeking to demonstrate that Opposer's LAGUNA marks are conceptually weak, Applicant argues, with supporting evidence, that "there are several third-party registrations that incorporate the term 'LAGUNA' which are not owned by Opposer"²⁸ "Third-party registrations 'may bear on conceptual weakness if a term is commonly registered for similar goods or services.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)). Third-party registrations alone may be relevant, in the manner of dictionary definitions, "to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted); *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if "there is no evidence of actual use" of "third-party registrations," such registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used").

"Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be conceptually weak because the more descriptive a term




²⁸ Applicant's Brief, 28 TTABVUE 20-23.

is, the less likely prospective purchasers are to attach source-identifying significance to it.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745-46 (TTAB 2016). However, for third-party registrations to have probative value in this regard, they must be registered in connection with goods that are the same as or similar to those for which Opposer has registered them and in which Opposer claims rights. *Tao Licensing*, 125 USPQ2d at 1059 (citing *In re i.am.symbolic, llc*, 866 F.3d 1315 , 123 USPQ2d 1744, 1751 (Fed. Cir. 2017)).

Consequently, of the registered third-party “LAGUNA” marks that Applicant made of record, we consider only the following:²⁹

Mark	Reg. No.	Goods
	2325728	Clothing, namely, shirts, tops, tank tops, t-shirts, long sleeve t-shirts, polos, sweatshirts, sweatpants, jackets, shorts, swimsuits, blouses, socks, sweatbands, caps, cloth bibs, hats, vests, visors, sweaters, gloves, ties, and jumpsuits, Cl. 25
	3005350	Clothing, namely sweatshirts, t-shirts, golf and tennis shirts, jackets, hats, caps, sun visors, socks, patches, shorts, sportswear and bathing suits, Cl. 25
	3,995,320	Designer luxury belts, designer luxury caps, designer luxury denims, designer luxury hats, designer luxury jeans, designer luxury leather belts, designer luxury shirts, designer luxury shoes, designer luxury shorts, designer luxury skirts, designer luxury sweat shirts,

²⁹ ANOR, 15 TTABVUE 14-46. The third-party registrations that we afford no probative value, because they recite irrelevant goods or services, are Reg. Nos. 1237738, 2325675, 2344966, 2830951, 3344602, 3596773 and 5102159. ANOR, 15 TTABVUE 47-85.

Mark	Reg. No.	Goods
	4102330	designer luxury tank-tops, designer luxury tops, Cl. 25
	5709936	Caps; Shirts; Tops, Cl. 25
	5808725	Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; clothing wraps; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic tops and bottoms for adults, children; bottoms as clothing; bottoms as clothing for adults, children; children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; children's and infants' apparel treated with fire and heat retardants, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; fashion hats; gloves for apparel; gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices; kerchiefs; neckerchiefs; neckerchieves; pocket kerchiefs; shapewear; sweatshirts for adults, children; thong beachwear; thong footwear; thong underwear; tops as clothing; tops as clothing for adults, children, Cl. 25

Seeking to demonstrate that Opposer's LAGUNA marks are commercially weak, Applicant asserts, with supporting evidence, that "the word 'LAGUNA' is not only non-distinctive, it is also commonly used in connection with clothes, swimwear,

accessories, art, and many other products and services.”³⁰ The commercial strength of the mark is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567. “As to commercial weakness, [t]he probative value of third-party trademarks depends entirely upon their usage.” *Tao Licensing*, 125 USPQ2d at 1059 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). Third-party uses may bear on the commercial weakness of a mark, *Tao Licensing*, 125 USPQ2d at 1057, and may be “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).

Of the third-party uses of LAGUNA marks (on websites) that Applicant made of record, we find the following pertinent:³¹

Website URL

WEATHERTECH RACEWAY LAGUNA SECA 65
(store.weathertechraceway.com/collections/new-arrivals/products/mens-fleece-jacket)

Goods Shown

Jackets, t-shirts

³⁰ Applicant’s Brief, 28 TTABVUE 23.

³¹ ANOR, 15 TTABVUE 118-134, 158-185. The third-party website evidence that we find irrelevant consists of uses of “LAGUNA” names or marks that were not used in connection with clothing. ANOR, 15 TTABVUE 135-157.

Website URL	Goods Shown
SANTOS LAGUNA (clubsantosshop.com/collections/apparel)	T-shirts
LAGUNA BEACH JEAN CO. (poshmark.com/brand/Laguna%20Beach%20Jean%20Co.)	Jeans, shirts, hats, skirts
CATMOSPHERE LAGUNA (catmospherelaguna.com/shop/p/mens-t-shirt)	T-shirt
LAGUNA SUPPLY (lagunasupply.com/)	Clothing store
THE SHOP LAGUNA BEACH (theshoplaguna.com/)	Women's bathing suits and beachwear
LAGUNA MADRE (lagunamadreclothing.com/)	Shirts, hats and outerwear
LAGUNA APPAREL CO. (fashiongo.net/lagunaapparelco)	Women's t-shirts
SIMPLE LAGUNA (simplelaguna.com/collections/all-clothing)	Women's pullovers, sweaters, shorts, dresses and hoodies
STELLA LAGUNA BEACH (shopstellalagunabeach.com/)	Women's bodysuits, dresses, tops and beachwear

We find on this record, within the clothing, swimwear and beachwear market, on a spectrum from very strong to very weak, the conceptual and commercial strength of Opposer's LAGUNA marks falls toward the weaker end of the spectrum. Therefore, while Opposer's marks are entitled to the protection afforded marks registered on the Principal Register pursuant to Trademark Act Section 7(b), 15 U.S.C. § 1057(b), their degree of protection is somewhat limited in scope in the relevant market as described immediately above. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734. (A mark's

renown within a specific product market is the proper standard, along a spectrum from very strong to very weak).




2. Comparison of the Parties' Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Opposer's and Applicant's marks in their entireties, considering their appearance, sound, meaning and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 128 USPQ2d at 1048. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).


The test is not whether the marks can be distinguished in 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. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The parties' marks "must be considered ... in light of the fallibility of memory" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, the focus is on the recollection of the average consumer – here, the purchaser of clothing products – who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Further, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)).

On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). That is, more or less weight may be given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161; *see also In re Nat'l Data*, 224 USPQ at 751 (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”).

The only word element in Opposer’s , LAGUNA,  and  marks is the term “LAGUNA.” In Opposer’s three marks that contain design

elements, “LAGUNA” remains the dominant element. “In marks consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Sabhnani*, 2021 USPQ2d 1241, at *31 (internal quotation deleted). “LAGUNA,” a noun of Spanish origin, means, “lagoon, lake, [or] pond.”³²

Applicant’s  mark is comprised of several elements: the words “LAGUNA BEACH,” the words “FOOTBALL CLUB,” the letters “LB,” a shield design and a right-facing double wave design. The largest literal element of Applicant’s mark is the letters “LB,” and the largest design element is the shield. “LAGUNA BEACH” is a residential and resort city located in Orange County, California; also a town located in Bay County, Florida.³³

³² Definition of “LAGUNA” FROM MERRIAM-WEBSTER online (<https://www.merriam-webster.com/dictionary/laguna>, last visited February 6, 2023). 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 McGowen Precision Barrels, LLC v. Inc Proof Rsch.*, 2021 USPQ2d 559, *24 n.93 (TTAB 2021).

³³ References to “LAGUNA BEACH” from COLUMBIA GAZETTEER OF THE WORLD ONLINE (<http://www.columbiagazetteer.org/main/ViewPlace/75644> and <http://www.columbiagazetteer.org/main/ViewPlace/75645>, last visited February 6, 2023). The COLUMBIA GAZETTEER is a geographic encyclopedia provided by the U.S. Patent and Trademark Office and edited by Columbia University Press. *See also* reference to “LAGUNA BEACH” from ENCYCLOPEDIA BRITANNICA online (<https://www.britannica.com/search?query=laguna+beach>, last visited February 6, 2023) “Laguna Beach, city, Orange county, southwestern California, U.S. Lying along the Pacific Ocean, Laguna Beach is about 50 miles (80 km) south of Los Angeles.” The Board may take judicial notice of information from encyclopedias and other standard reference works. *DC Comics*, 2022 USPQ2 1249, at *42 n.88.

Applicant argues that LAGUNA BEACH is the dominant portion of Applicant's mark, because it is the first term in the mark, citing *Palm Bay Imps.*, 73 USPQ2d at 1692 (2005); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); and *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). While this is an accurate statement of legal principle, "there is no mechanical test to select the dominant element of a mark." *Tao Licensing*, 125 USPQ2d at 1059. While the first term in a mark is often considered to be the feature that will be called for, and so remembered, by consumers, this is not invariably the case.

As noted above, in the opposed Application, Applicant was required to disclaim each literal element of Applicant's  mark, the Examining Attorney stating:

Applicant must disclaim the wording "LAGUNA BEACH," "LB," and "FOOTBALL CLUB" because ... [these elements are] merely descriptive The wording "LAGUNA BEACH" and "LB" is geographically descriptive because it refers to the geographic location where the goods and services originate and/or are provided, according to the application and the attached Internet evidence which shows that "LB" is used as an acronym for "Laguna Beach." ... The wording "FOOTBALL CLUB" is descriptive, if not generic, for a soccer club. ... Applicant may respond to this issue by submitting a disclaimer in the following format: No claim is made to the exclusive right to use "LAGUNA BEACH," "LB," and "FOOTBALL CLUB" apart from the mark as shown.³⁴

Applicant complied with this disclaimer requirement.³⁵

Opposer makes much of the disclaimer of these elements, arguing:

Here, LAGUNA BEACH is the dominant portion of Applicant's mark. ... No other portion of Applicant's mark is distinctive or memorable and thus no other portion of Applicant's mark can be said to be more


³⁴ Application Serial No. 88793060, Office Action of May 7, 2020, at TSDR 1.

³⁵ Application Serial No. 88793060, Response to Office Action of July 13, 2020, at TSDR 1.

dominant than the first word. All of the additional wording in the mark is disclaimed, including “BEACH,” “LB,” and “FOOTBALL CLUB.” Therefore, Applicant’s other wording does not avoid a likelihood of confusion.³⁶

In this argument, however, Opposer fails to recognize it was “LAGUNA BEACH” – not just “BEACH” – that was disclaimed.


Considering the totality of Applicant’s mark and how it would be perceived by the public, we disagree with Opposer’s argument. “The disclaimed elements of a mark ... are relevant to the assessment of similarity. ... This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.” *Shen Mfg. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (internal citation omitted); *see also In re Offshore Tech. Corp.*, 201 USPQ 861, 863 (TTAB 1978); (“[A]lthough disclaimed, the [disclaimed] words ... cannot be ignored in considering the question of likelihood of confusion since they are not physically removed from the mark, the public is not aware of disclaimers or of their significance, and these [disclaimed] words would be the means by which ... [Applicant’s goods] would be identified and referred to.”).

By sheer comparative size, we find that the dominant literal element of Applicant’s  mark is the letters “LB,” and the dominant design element is the shield. The other portions of Applicant’s mark, “LAGUNA BEACH,” “FOOTBALL CLUB,” and the right-facing double wave design are subordinate elements.

³⁶ Opposer’s Brief, 24 TTABVUE 21.

Additionally, the letters “LB” emphasize to consumers that the origin of Applicant’s clothing items is “LAGUNA BEACH.”

The point of similarity between the literal elements of Opposer’s marks and Applicant’s mark is the term “LAGUNA” versus the words “LAGUNA BEACH.”³⁷ Given the limited scope of protection afforded to “LAGUNA” in connection with clothing, swimwear and beachwear, within the context of comparing the parties’ marks in their entirety, as well as the comparatively smaller size and subordinate nature of “LAGUNA BEACH” in Applicant’s mark, this is not a sufficient point of similarity for confusion to be likely.

Opposer also asserts that the right-facing double wave design within Applicant’s mark is similar to the right-facing single wave design within the  mark of Registration No. 4886056.³⁸ The single wave design is emphasized much more in Opposer’s mark than the double wave design is within Applicant’s mark. In fact, within the context of Applicant’s overall mark as a whole, the right-facing double wave design is almost imperceptible. Opposer’s single wave design also is confined within a free-standing parallelogram, whereas Applicant’s double wave design is

³⁷ Opposer also notes that its pleaded LAGUNA mark of Registration No. 1541125 is in standard characters, such that it covers all fonts, styles and designs. Opposer’s Brief, 24 TTABVUE 22. This is not entirely correct. While a standard character mark does cover all fonts and styles, Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a), it does not cover rights to use the mark in connection with any and all design elements. *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) (“[R]ights associated with a word mark in standard character (or typed) form reside in the wording and not in any particular display of the word. ... Generally, rights in the word would not be extended to include protection for that word combined with, for example, other words or a design element.”).

³⁸ Opposer’s Brief, 24 TTABVUE 16, 22, 25.

longer, more free-flowing and is de-emphasized at the bottom of Applicant's shield design. We find that, within the context of the parties' overall composite word-and-design marks as a whole, the right-facing wave designs are not a sufficient point of similarity for confusion to be likely.

In sum, when we compare Applicant's mark and each of Opposer's marks in their entirety by the elements of appearance, sound, meaning and commercial impression, we find they are more different than they are similar. "LAGUNA" has a limited scope of protection, such that "LAGUNA" and "LAGUNA BEACH" appear and sound different, have different meanings, and differ in overall commercial impression. The respective right-facing wave designs are insufficiently similar, and the other elements of Applicant's mark are further points of difference. The first *DuPont* factor does not support a finding that confusion is likely.

C. The Absence of Actual Confusion

The seventh *DuPont* factor considers "[t]he nature and extent of any actual confusion[,]" and the eighth factor considers "[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion." *DuPont* 177 USPQ at 567. Applicant argues:

Applicant's Mark and Opposer's Marks have co-existed in the marketplace for nearly three years without any instance of actual confusion. Indeed, Opposer has not identified a single instance of actual confusion between the parties' respective marks. ... Applicant has no records of communications from customers regarding confusion between any of Applicant's products or marks and any of Opposer's products or marks. Likewise, Opposer has failed to come forward with any evidence showing alleged actual confusion. This is not surprising given the differences in the parties' marks, trade channels, and the fact that

Applicant's Mark is entirely distinguishable from each of Opposer's Marks.³⁹

“The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [A]pplicant of its mark for a significant period of time in the same markets as those served by [O]pposer under its marks.” *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (quoting *Gillette Can. Inc. v. Ranir Corp.*, 1768, 1774 (TTAB 1992)). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Id.* (citing *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007)).

“[O]ur analysis of the second, third, and fourth *DuPont* factors, discussing the similarity or dissimilarity of the ... [goods], channels of trade, and relevant consumers, is based ... on the identifications **as set forth** in the in the [A]pplication and the ... [R]egistration[s at issue].” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020) (emphasis in original). “The eighth *DuPont* factor, by contrast — ‘[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,’ *see DuPont*, 177 USPQ at 567 — requires us to look at **actual market conditions**, to the extent there is evidence of such conditions in the record.” *Id.* (emphasis in original). Accordingly, we must look to the parties’ actual activities in the marketplace to determine whether there has “been a

³⁹ Applicant's Brief, 28 TTABVUE 27-28.

reasonable opportunity for confusion to have occurred.” *Citigroup*, 94 USPQ2d at 1660.

On this record, we have insufficient information from which to render meaningful findings under the seventh and eighth *DuPont* factors. Applicant made of record pages from Opposer’s website captured at a single point in time, April 15, 2022,⁴⁰ as well as pages from Applicant’s own website and social media pages (Instagram and Facebook) captured at another single point in time, May 10, 2021.⁴¹ Further than that, however, the Testimony Declaration of Lucie Martlin, Applicant’s Director of Operations and advisor to its Board of Directors,⁴² lacks sufficient detail for us to determine the nature, extent and duration of Applicant’s use of its mark.

We therefore find the absence of any actual confusion does not weigh in Applicant’s favor. *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” where evidence of as to the use of Applicant’s merchandise during the time in question was not presented). In any event, “it is unnecessary to show actual confusion in establishing likelihood of confusion.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). We consequently find the absence of actual confusion neutral regarding our consideration as whether confusion is likely. *See Double Coin Holdings Ltd. v. Tru*

⁴⁰ ANOR, 15 TTABVUE 86-97.

⁴¹ ANOR, 15 TTABVUE 98-117.

⁴² Martlin Decl., 16 TTABVUE 2-4, 6-10, ¶¶ 2-7, Exh. 1.

Dev., 2019 USPQ2d 377409, at *9 (TTAB 2019) (finding the absence of actual confusion a neutral factor due to lack of sufficient evidence for the Board to make adequate findings).

VII. Likelihood of Confusion: Balancing the *DuPont* Factors

Balancing the *DuPont* likelihood of confusion factors on which there has been evidence and argument, we recognize that the parties' goods are in part identical. Consequently, controlling case law states we must presume that the parties' trade channels and target consumers overlap, and that in such situations less is required for a finding that the parties' marks are similar. *Cai v. Diamond Hong, Inc.*, 127 USPQ2d at 1801 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1095, 1908 (Fed. Cir. 2012)).

However, given the limited conceptual and commercial strength of LAGUNA for clothing, swimwear and beachwear, we find that the overall difference between Applicant's mark and Opposer's marks is a controlling factor to the outcome of this Opposition; namely, its dismissal. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (“[O]ne *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”); *see also Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed.Cir.1991) (stating that “[w]e know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive” and holding that “substantial and undisputed differences” between two competing marks justified a conclusion of no likelihood of confusion on summary judgment).

Opposition No. 91264741

Decision:

The Opposition is dismissed.