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

Proceeding no.	91277240
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SUN BUM LLC,

Opposer,

v.

BRONZEBUM LLC,

Applicant.

Opposition No. 91277240

MARK: BRONZEBUM

App. Ser. No. 90/826,296

**OPPOSER'S REBUTTAL BRIEF**

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## Introduction

Applicant Bronzebum LLC makes numerous unsupported and incorrect contentions to wrongly assert that (i) Applicant's goods are dissimilar to those of the Opposer Sun Bum LLC, (ii) there exists a crowded field of "Bum" marks, (iii) Opposer's marks are weak, and (iv) Applicant's mark is dissimilar to Opposer's marks. These issues are addressed below, as well as Applicant's undue reliance on there being a lack of evidence of actual confusion when Applicant's sales have been *de minimis*.

### A. Applicant's Applied for Goods are Identical to Opposer's Goods

Applicant wrongly asserts its tanning oil products are "not identical to, or even competitive with" Opposer's products. (14 TTABVUE 6 (App. Brief pg. 1)). To this end, Applicant mischaracterized Opposer's goods as merely being "sunscreen and other beach/outdoor products." *Id.*

Applicant completely disregards Opposer's registered "suntanning preparations" and "self-tanning preparations" of U.S. Reg. No. 5,863,379 (18 TTABVUE 426-33 (Ex. B6)), which are identical to Applicant's applied for tanning oils. For example, Ms. Elsha Kim states in the declaration submitted by Applicant, "[d]uring the development process, I noticed the product imparted a rich bronze color when applied." (14 TTABVUE 18 (App. Brief, Decl. of Elsha Kim, ¶2)). Applicant's tanning oil is thus both a "suntanning preparation" and a "self-tanning preparation" as it functions to impart a bronze tan color when applied to skin.

Moreover, Applicant overstates any distinctions between Applicant's tanning oils and other of Opposer's skin care related products, including Opposer's "sunscreen cream" of Reg. No. 3,572,365 (18 TTABVUE 394-99 (Ex. B1)), "non-medicated sun care preparations" of Reg. No. 4,289,452 (18 TTABVUE 407-13 (Ex. B3)), and "sun screen preparations" of the '379 Registration (18 TTABVUE 426-33 (Ex. B6)), which are all substantially similar to Applicant's tanning oils. Applicant attempts to distinguish Applicant's goods and those of Opposer by claiming Applicant's tanning oil products are "not competitive with Opposer's sunscreen products". (14 TTABVUE 14 (App. Brief pg. 9)). This, however, is a misstatement of the likelihood of confusion analysis:

When analyzing the similarity of the goods, “it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.” Instead, likelihood of confusion can be found “if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.”

*Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1724 (T.T.A.B. 2007))

As further stated by the Federal Circuit, the relatedness of goods can be shown, for example, by showing that a single company sells the goods of both parties. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis....”) quoted in *In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (T.T.A.B. 2016).

Sun Bum itself sells tanning oils and browning lotions along with its various sunscreens and sun care preparations. There can thus be no doubt that Applicant’s applied for “tanning oils” are substantially related to at least Opposer’s “sunscreen cream” of the ‘365 Registration (Ex. B1), “non-medicated sun care preparations” of the ‘452 Registration (Ex. B3), and “sun screen preparations” of the ‘379 Registration (Ex. B6). (18 TTABVUE 394-99, 407-13, 426-33).

Applicant additionally attempts to make a distinction between the tanning oil product that it sells and Opposer’s products by asserting that none of Applicant’s products “contain any SPF or other sun protection”. (14 TTABVUE 7 (App. Brief pg. 2)). The appropriate comparison, however, is between the goods identified in Applicant’s subject application and Opposer’s registrations, and there are no such distinctions contained therein. *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ 2d 10596, at \*13, 2020 WL 2853282, at \*16 (TTAB 2020); *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 281 F.3d 1261, 1267 (Fed. Cir. 2002). Regardless, two facts are worth noting as to Applicant’s alleged distinction. One, although Opposer sells various tanning oils and browning lotions that do provide SPF protection, Opposer has been selling its Natural Browning Lotion since 2016 that does not provide SPF protection. (16 TTABVUE 43-45 (Ex. A, Smith Dec. ¶¶9-10); 16 TTABVUE

148 (Ex. A2 (SBB000453)); 16 TTABVUE 307 (Ex. A5 (SBB000491))). Second, Applicant itself has worked to develop a tanning oil that provided SPF protection. (See 18 TTABVUE 515-16 (Ex. E, Applicant's Responses to Interrog. No. 15, stating, "Applicant [ ] conducted three (3) panels of consumer reaction testing for an SPF version of the...product for FDA approval in summer 2022.")).

Applicant's applied for goods are identical to Opposer's registered goods. "When the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different." *Bridgestone Americas Tire Operations, LLC v. Federal Corp.*, 102 U.S.P.Q.2d 1061, 673 F.3d 1330, 1336 (Fed. Cir. 2012), citing *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir.) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.")

### **B. Alleged Crowded Field of "Bum" Marks**

Applicant asserts that "over 200 other marks bearing the term 'BUM' exist and are registered with the USPTO", and also included in its brief a table listing certain marks it asserts to be registered in Class 3. (14 TTABVUE 8-10 (App. Brief pgs. 3-5)).

Per TBMP §704.03(b)(1)(B), a party wishing to make a third-party registration of record must do so by submitting a copy of the registration or information from the U.S. Patent & Trademark Office's electronic database. *Id.* ("a party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it".) In this case, the Parties' stipulation to use of the TTAB's Accelerated Case Resolution provided that each Party could submit such documents on which they would rely with their accompanying briefs. (8 TTABVUE 3 (Stip. pg. 2, ¶4)). Applicant did not, however, submit any copies of records from the Office's electronic database. Accordingly, there is no evidence of record of any third-party registrations and Applicant's arguments in this regard are moot. *See, e.g., Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550, 2012 WL 1267961, at \*4 (TTAB 2012) (regarding "the listing that applicant has submitted...the registrations listed therein

are not of record, and the list itself has little, if any, probative value.”); *Jansen Enterprises, Inc. v. Rind et al.*, 85 USPQ2d 1104, 1110, 2007 WL 809857, at \*6 (TTAB 2007) (“respondent’s mere reference in his brief to the [third-party] registrations did not suffice to make them of record...In any event, with respect to third-party registrations, such evidence, even if properly of record, is of little probative value in deciding consumer confusion because they do not prove that the marks are in use or that the public is familiar with them.” (citation omitted)).

Notwithstanding, in the event the Board were to consider any part of Applicant’s reference to third-party registrations, Applicant’s reference to there being “over 200 other marks” can only be understood in reference to unrelated goods and services, which in any event have no probative value. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *In re Inn at St. John’s*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

Opposer further notes with regard to the table listing asserted registrations in Class 3 in Applicant’s brief that none of the goods there listed state sun tanning or self-tanning products, in contrast to Applicant’s goods, and those marks contain additional elements that cause each of them to be less similar to SUN BUM than Applicant’s BRONZEBUM. For example, Applicant listed the marks BEACH BUM SOAPERY for various soaps, BUMBEE for hair care products and BUM for automobile soap, waxes and polishes. (14 TTABVUE 8-9 (App. Brief pgs. 3-4)).

Regardless, Applicant has not presented any evidence of *use* of any marks utilizing “BUM”. As the Federal Circuit explained in a prior decision affirming a Board’s refusal to register a mark:

The probative value of third-party trademarks depends entirely upon their usage....While the Beverage Media Guide is compelling evidence that distributors were aware that the term VEUVE was used for other alcoholic products, it is not evidence that the consuming public was likewise aware...As this court has previously recognized where the “record includes no evidence about the *extent of [third-party] uses*...[t]he probative value of this evidence is thus minimal.”



*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005) (emphasis in original, other citation omitted).

Although third-party use of a similar mark is a relevant consideration, third-party registrations are not evidence of use or consumer awareness of such marks. See, e.g., *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269–70 (CCPA 1973); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462–63 (CCPA 1973) (purchasing public is not aware of registrations reposing in the USPTO). Third-party registrations are thus of little or no relevance in determining the strength of a registration. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). For example, as stated by the Federal Circuit in *AMF Inc. v. Am. Leisure Prods., Inc.*, 177 U.S.P.Q. 268, 474 F.2d 1403, 1406 (C.C.P.A. 1973):

It appears that the board relied heavily upon the existence of third-party trademark registrations in reaching its decision. We have frequently said that little weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

*Id.* See also *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 236 F.3d 1333, 1338 (Fed. Cir. 2001) (“the record includes no evidence about the extent of those [third-party] uses. The probative value of this evidence is thus minimal.”); *Stanadyne, Inc. v. Lins*, 180 U.S.P.Q. 649, 490 F.2d 1396, 1397 (C.C.P.A. 1974) (“in the absence of evidence of the extent of actual continuing use of registered marks, mere registrations are entitled to little weight in establishing whether there is likely to be confusion because registrations by themselves do not indicate how the public mind may have been conditioned.”).

### **C. Strength of Opposer’s Marks**

Applicant makes the untenable assertion that “Opposer’s Marks are neither conceptually nor commercially strong or well-known.” (14 TTABVue 15 (App. Brief pg. 10)).

Sun Bum's marks are registered on the Principal Register without claims of acquired distinctiveness and are therefore conceptually strong. There is no evidence of record of any third party registrations or uses of marks containing BUM on similar goods. To the extent Applicant attempts to rely on its listing of Class 3 marks, those marks are all distinguishable based on other terms in those marks and because none of them are directed to suntanning or self-tanning preparations, let alone sunscreens.

Applicant asserts that "the common element between Applicant's Mark and Opposer's Marks is the term 'BUM,' which is - at most - merely suggestive of where both parties' skin care products could be applied." (14 TTABVUE 12 (App. Brief pg. 7)). Applicant additionally wrongly contends that the common term "BUM" between its BRONZEBUM mark and Applicant's SUN BUM, BABY BUM and TRUST THE BUM marks "is highly suggestive, and therefore conceptually weak". (14 TTABVUE 13 (App. Brief pg. 8)).

It is well understood that the term "BUM" has alternative meanings other than with respect to anatomy, including with reference to a person who avoids work - as in "a lazy bum" - or with reference to a person that is enthusiastic about a recreational activity, such as a "ski bum". Applicant's assertion that "BUM" when used in connection with Applicant's goods can only refer to a location on a body on which Applicant's products are applied is thus without merit, particularly so when sun tanning products are clearly intended to be applied to many areas of a person's body.

Applicant's assertion that Opposer's marks are not commercially strong is also clearly incorrect. It is well established that commercial strength may be measured indirectly, such as by the volume of sales and advertising expenditures in connection with the goods sold under the marks, as well as the length of use of the marks and third-party recognitions of the goods associated with the marks. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d 1303, 1308, 293 F.3d 1367, 1371 (Fed. Cir. 2002).

Opposer has submitted extensive sales and marketing evidence reflecting the sales of tens of millions of SUN BUM products totaling hundreds of millions of dollars over many years, and the corresponding millions of dollars spent on marketing. (16 TTABVUE 8, 19, 20 (Opp. Brief pgs. 2, 13-14); 16 TTABVUE 43-45, 48 (Ex. A Smith Decl. ¶¶8-10, 18); 17 TTABVUE (Ex. A Smith Decl. ¶¶8-10, 18, Exhibits A3, A4, A6 and A13)). Opposer has additionally submitted widespread evidence of the appearance of Opposer's goods in connection with its marks in various printed and online publications, and in broadcast media, as well as evidence of numerous awards and recognitions of Opposer's goods. In view thereof, Opposer's mark is commercially very strong. (16 TTABVUE 20-27 (Opp. Brief pgs. 14-21); 16 TTABVUE 48-58 (Ex. A Smith Decl. ¶¶19-34) 16 TTABVUE 369-388 (Ex. A15 (SBL00302-305), A16A, A16B); 18 TTABVUE 3-40 (Exs. A17A, A17B); 17 TTABVUE (Ex. A Smith Decl. ¶¶19-34, Exs. A16C, A18A-A18N, A19)).

Moreover, Applicant wrongly asserts that "Opposer has only produced evidence of sales for the past ten years (2014-2023)". (14 TTABVUE 15 (App. Brief pg. 10)). In contrast, Opposer provided sales figures and testimony for sales since 2010, as well as provided testimony regarding sales of sunscreen dating back to 2008. (16 TTABVUE 43, 72 (Ex. A, Smith Decl. ¶¶8, 58); 17 TTABVUE (Exs. A3, A4)).

Bronzebum's assertion that Sun Bum's marks are "neither conceptually nor commercially strong or well-known" is also directly opposite to the Board's findings in a prior opposition brought by Sun Bum in which the Board found "Opposer's composite SUN BUM mark shown in the '379 Registration is conceptually strong and we have placed it on the 'strong' end of the commercial strength spectrum from very strong to very weak and have found that it is entitled to more than the normal scope of protection." (*Sun Bum LLC v. Healthbomb LLC*, Opp. No. 91264019, 42 TTABVUE 74-75.) That decision included sales and marketing evidence by Opposer through 2020. In the present opposition, Opposer has introduced sales and marketing evidence through 2022, where each year those sales and marketing expenditures have grown substantially year-over-year. This includes both

Opposer's sales and marketing expenditures in 2021 and 2022 each being substantially higher than in 2020 and years prior. (17 TTABVUE (Exs. A4, A13)). Accordingly, the strength of Sun Bum's marks has only grown.

#### **D. Similarity of Marks**

Applicant asserts that the term "bronze" in its BRONZEBUM mark is dominant and that its use of "BUM" is "merely suggestive" of where its product is applied. (14 TTABVUE 12 (App. Brief pg. 7)). In stark contrast, the term "bronze" is descriptive of Applicant's goods and thus should be given less weight than the common term "BUM" when determining the connotation and commercial impressions of the marks in their entirety. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) ("in 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 entirety.") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985))).

As noted above, Applicant's declarant stated, "[d]uring the development process, I noticed the product imparted a rich bronze color when applied." (Declaration of Eslha Kim, 14 TTABVUE 18.) Likewise, in discovery Opposer asked Applicant to "[d]escribe in detail what Applicant's 'tanning oils' that are the subject of Applicant's Application Serial No. 0/826,296 are used for and how they are used." Applicant's response stated, "Applicant's tanning oil is made...to create a tanning oil that leaves a rich bronze color on skin when applied." (18 TTABVUE 519 (Ex. E, Applicant's Response to Interrog. No. 18)).

Not only does the term "bronze" thus describe the color Applicant's product imparts to skin, but "bronzers" are a known constituent used with tanning oils.

Submitted with the declaration of Mr. Dustin Smith were articles that discussed the inclusion of "bronzers" in tanning oils. (16 TTABVUE 66 (Smith Decl. Ex. A ¶41); 18 TTABVUE 168-175,

192-198 (Exs. A30 and A33)). As stated in the article of Exhibit A30 under the heading “Bronzer”, “[s]ome tanning oils include a bronzer to help speed up the tanning process even further. This is a good choice if you hope to see results quickly...” (Ex. A30, SBB000687.) The article of Exhibit A33 was published by the providers of Australian Gold sun care products and is titled “What is Bronzer, and How Does it Work?” Under the heading “What is bronzer (and how is it different from fake tan?)”, that article states “[a] bronzer is essentially a product that helps to make your skin look darker - and is similar, but not identical to, fake tan. Bronzers are designed to provide those who use them with a darker complexion temporarily.” (Ex. A33, SBB000692.)

And as noted in Opposer’s Trial Brief, definitions of the word “bronze” have a direct connotation to sun and the color of skin. (18 TTABVUE 486-503 (Ex. C, p.4, Ex. D, pp.1-2), dictionary definitions of the word “bronze”, which include “to make brown as by exposure to the sun”, and provide the exemplary sentence, “The sun bronzed his face.” (emphasis added)).

The marks SUN BUM and BRONZEBUM are thus substantially similar. In addition to each having two syllables, they also both comprise two words, the second of which is identical and the first of which are highly similar. The prefix words “SUN” and “BRONZE” both include an “N” sound and, significantly, both generate a similar meaning and convey the same idea due to the clear meaning and association of the word “BRONZE” with “SUN”. The marks SUN BUM and BRONZEBUM are thus highly similar and both evoke an outdoor sun tanning connotation and meaning.

### **E. Actual Confusion**

Applicant endeavors to make much of Opposer having no evidence of actual confusion. This, however, is hardly surprising given the *de minimis* sales to date by Applicant.

Without citation, Applicant’s brief states that “Opposer possesses zero evidence of actual confusion between Applicant’s Proposed Mark and any of Opposer’s Marks”. (Brief, pg. 12 (emphasis in original)). The declaration by Applicant’s Declarant, Ms. Elshia Kim, did not make mention of whether Applicant is aware of any instances of actual confusion. (14 TTABVUE 18-19 (Kim Decl.)).

Accordingly, Applicant is understood to be referencing Opposer's response to Applicant's Interrogatory No. 17 (14 TTABVUE 52-53 (Interrog. Resp. pgs. 29-30)), to which Opposer responded on May 18, 2023.

Applicant's declarant testified that Applicant began selling its products "in or around August 2021", with sales being on Applicant's website [www.bronzebum.com](http://www.bronzebum.com), Amazon and through Applicant's Etsy storefront. (14 TTABVUE 19 (Kim Decl., ¶6)). It was thus less than two years from the time Applicant began selling its product to the time of Opposer's interrogatory response. Moreover, as noted in Opposer's brief, Applicant had sold at most approximately 2,710 units as of April 23, 2023, but it is unclear from Applicant's discovery responses if this number was just of Applicant's tanning oils, or if it also included Applicant's "GLOW capsules" and "APRES SUN lotion". (18 TTABVUE 506-07, 512 (Ex. E, Applicant Responses to Interrog. Nos. 1, 2 and 9)).

"[F]or the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred." *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 94 U.S.P.Q.2d 1645, 1660 (T.T.A.B. 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). Here, due to the appreciably small number of sales over a short duration and through a limited number of outlets, there has not been a reasonable opportunity for confusion to have occurred.

In contrast, the extent of potential confusion is substantial due to the similarity of the marks and due to the goods, channels of trade and consumers being identical, including due to the widespread distribution of Opposer's products through its many thousands of retail partners. (16 TTABVUE 45-47, 58-59 (Ex. A, Smith Decl. ¶12-15, 35, 36); 17 TTABVUE (Exs. A, A7, A12)).

### **Conclusion**

Applicant's BRONZEBUM mark on tanning oils in Class 3 is likely to cause confusion with Opposer's SUN BUM marks and registrations, and with Opposer's family of "BUM" marks for tanning products. Accordingly, registration of Applicant's BRONZEBUM mark should be refused.

Dated: August 28, 2023

Respectfully Submitted,

By: *Karl T. Ondersma*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
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SUN BUM LLC	)	
	)	
Opposer,	)	
	)	
vs.	)	Proceeding No. 91277240
	)	Application No. 90826296
BRONZEBUM LLC,	)	
	)	
Applicant.	)	

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing **OPPOSER’S REBUTTAL BRIEF** has been served this day by emailing a copy of same, to counsel for Applicant at the email address below:

John Begakis <john@altviewlawgroup.com>

This 28<sup>th</sup> day of August 2023.

/Karl T. Ondersma/  
Karl T. Ondersma  
Attorney for Opposer Sun Bum LLC



**APPENDIX 1 - NON-PRECEDENTIAL DECISIONS:**

*Amazon Technologies, Inc. v. Jeffrey S. Wax,*

Opp. No. 91187118, 2012 WL 1267957 (T.T.A.B. March 30, 2012)

*Elektra Entertainment Group, Inc. v. Elektra Trading & Consulting Group, S.A. DE C.V.,*

Opp Nos. 91186906, 91190824, 2012 WL 3224739 (T.T.A.B. July 18, 2012)

*H-D U.S.A., LLC v. Schmidiger,*

Opp. No. 91223860, 2018 WL 1082095 (T.T.A.B. February 23, 2018)

*In re Popp,*

Ser. No. 86140200, 2017 WL 512756 (T.T.A.B. January 20, 2017)

*Mixnet Corporation v. Tomeka Harris and Chan'Drieka Morrison,*

Cancellation No. 92067984, 2020 WL 859854 (T.T.A.B. February 19, 2020)

*Sun Bum LLC v. Health Bomb LLC*

Opp. No. 91264019, (T.T.A.B. March 10, 2022)

*Volvo Trademark Holding AB v. Wolvol Inc.,*

Opp. No. 91207836, 2019 WL 4034463 (T.T.A.B. July 29, 2019)

**FILED IN ACCORDANCE WITH T.B.M.P. 801.03**

2012 WL 1267957 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

AMAZON TECHNOLOGIES, INC.

v.

JEFFREY S. WAX

Opposition No. 91187118  
to [application Serial No. 78001126](#)

March 30, 2012

filed on March 27, 2000

\*1 [Linda K. McLeod](#) and [Stephanie H. Bald](#) of Finnegan, Henderson, Farabow, Garrett & Dunner for Amazon Technologies, Inc.

Jeffrey S. Wax, pro se.

Before [Quinn](#), [Kuhlke](#) and [Wellington](#)

Administrative Trademark Judges

Opinion by [Quinn](#)

Administrative Trademark Judge:

On March 27, 2000, Jeffrey S. Wax (“applicant”) and Steven M. Freeland jointly filed an intent-to-use application to register the mark AMAZON VENTURES, in typed form and with VENTURES disclaimed, for “investment management, raising venture capital for others, investment consultation, and capital investment consultation.”<sup>1</sup> Amazon Technologies, Inc. (“opposer”) opposes registration of the mark under Section 2(d) of the Trademark Act, [15 U.S.C. §1052\(d\)](#), on the ground that applicant’s mark, when used in connection with applicant’s services, so resembles opposer’s previously-used and registered mark AMAZON.COM (and variations thereof) for a variety of services, including credit card services and providing a searchable on-line database featuring goods and services of others in the field of finances, as to be likely to cause confusion. In its “revised” amended notice of opposition, filed January 27, 2010, opposer also asserts additional claims, which are addressed below. In his answer, applicant denies the salient allegations in the amended notice of opposition, and asserts as an affirmative defense that he has “constructive use priority over Opposer’s asserted common law rights and cited registrations.”<sup>2</sup>

### **Relevant Prior Decisions and ACR Stipulation**

This case has a rather extensive, tortured history, including multiple motions for sanctions and multiple motions for summary judgment. While that entire history need not be rehashed here, suffice it to say that in its order of August 31, 2010, the Board granted applicant’s cross-motion for summary judgment on opposer’s claim that the assignment of the involved application from Mr. Freeland to Mr. Wax violated Section 10 of the Trademark Act, and accordingly dismissed that claim. In the same order, the Board denied opposer’s motion for summary judgment on its claim that the original joint owners of the involved application did not have a continuing bona fide intention to use the applied-for mark. Later, in its order of December 21, 2011, the Board denied the parties’ subsequently-filed cross-motions for summary judgment<sup>3</sup> on opposer’s claims of priority and likelihood of confusion and dilution (the “cross-motions”).

\*2 In the December 21, 2011 order, the Board noted the already “extensive” record in this proceeding, and recommended that the parties consider resolving it by means of the Board’s accelerated case resolution (“ACR”) procedure, “either on the current record, or on the current record as supplemented by the parties ....” Order of December 21, 2011 at p. 8. Ultimately, in their February 8, 2012 stipulation, the parties agreed to resolve this proceeding via ACR, based on the evidence submitted with their cross-motions for summary judgment, each of which was denied in the Board’s December 21, 2011 order. In other

words, the parties chose not to supplement the record prior to final decision. The Board approved the parties' ACR stipulation in its order of February 13, 2012. As a result of the parties' approved ACR stipulation, the ACR record in this case relates only to opposer's claims of priority and likelihood of confusion and dilution (which were the only claims at issue in the parties' cross-motions for summary judgment). Therefore, opposer has effectively declined to pursue its claim that the original joint owners of the involved application did not have a continuing bona fide intention to use the applied-for mark, and we have not further considered that claim.

### **The Record and Evidentiary Objections**

In their ACR stipulation, the parties agreed that this case will be resolved "based on the parties' cross-motions for summary judgment, responses and reply briefs filed in support thereof, and evidence and testimony submitted therewith, the subject Application Serial No. 78001126, and the pleaded registrations attached to Opposer's Revised Amended Notice of Opposition." Accordingly, and more specifically, the record includes:

(1) The pleadings, including copies of the registration certificates for, and printouts from Office records concerning, opposer's pleaded registrations;

(2) The file of the opposed application;

(3) Documents from the files of opposer's pleaded registrations, TESS printouts of third-party registrations, printouts from opposer's website, applicant's discovery requests and opposer's discovery responses, all submitted with applicant's motion for summary judgment and/or applicant's response to opposer's cross-motion;

(4) The declarations of Stephanie H. Bald, one of opposer's attorneys, submitted with opposer's response to applicant's motion for summary judgment and cross-motion, and opposer's reply brief, respectively ("Bald Dec. I" and "Bald Dec. II"), the Declaration of Craig Berman ("Berman Dec."), opposer's Vice President of Public Relations, submitted with opposer's response and cross-motion, and the Declaration of Stephen Kolozvary ("Kolozvary Dec."), Vice President for Ad Services Operations for nonparty VMS, submitted with opposer's response and cross-motion; and

(5) The exhibits to opposer's declarations, which include opposer's and third-parties' annual reports, copies of articles and news reports, excerpts from books, copies of opposer's advertisements, dictionary definitions, TESS printouts of third-party applications and registrations, printouts from TTABVue concerning Board proceedings, copies of complaints from federal district court cases, opposer's discovery requests and applicant's responses thereto, printouts from applicant's, opposer's and third-party websites, applicant's discovery deposition transcript, opposer's press releases, third-party reports on famous brands, domain name records, and copies of opposer's advertisements and reports thereon.

\*3 The parties stipulated that this evidence is "authentic" and "properly of record," but that it remains subject to certain objections made in connection with the parties' cross-motions for summary judgment. ACR Stipulation ¶¶ 3, 5. For the reasons stated in the Board's order of December 21, 2011 at pp. 4-5, applicant's objections to opposer's unpleaded registrations are sustained, but applicant's other objections are overruled, and applicant's motion to strike is denied.

### **The Parties**

Opposer is an online retailer, which began selling books via its website in 1995. Berman Dec. ¶ 8. Opposer grew quickly, expanded the offerings on its website and had its initial public offering in 1997. *Id.* ¶¶ 9-13. The evidence of record establishes opposer's ownership, and the validity, of the following pleaded registrations, the applications for which were filed before applicant's filing date:

AMAZON.COM, in typed form, Registration No. 2078496, issued July 15, 1997 for "computerized on line ordering service featuring the retail distribution of books"; [Renewed; Section 15 Affidavit acknowledged];

AMAZON.COM, in typed form, Registration No. 2167345, issued June 23, 1998 for "computerized on line search and ordering service featuring the wholesale and retail distribution of books, music, motion pictures, multimedia products and

computer software in the form of printed books, audiocassettes, videocassettes, compact disks, floppy disks, CD ROMs, and direct digital transmission”; [Renewed; Section 15 Affidavit acknowledged];

AMAZON.COM, in typed form, Registration No. 2559936, issued April 9, 2002 for “retail department stores; retail online department stores; retail convenience stores; retail on-line convenience stores; computerized on-line ordering featuring general merchandise and general consumer goods; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing a searchable on-line advertising guide featuring the goods and service of other on-line vendors; database management services”; “providing a searchable on-line database featuring goods and services of others in the field of finances, banking, real estate and vehicles”; and “computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network; and providing electronic greeting cards via a global computer network”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged];

\*4 AMAZON.COM AUCTIONS, in typed form with AUCTIONS disclaimed, Registration No. 2518043, issued December 11, 2001 for “commodity trading for others”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged];

AMAZON.COM, in typed form, Registration No. 3411872, issued April 15, 2008 for “credit card services; and charge card services”;

<<Unknown Symbol>>, Registration No. 3414814, issued April 22, 2008 for “credit card services; and charge card services”;

<<Unknown Symbol>>, Registration No. 2789101, issued December 2, 2003 for “advertising services, namely, dissemination of advertising for others via an on-line electronic communications network; business management; business administration; retail department stores, retail on-line department stores; retail convenience stores; online retail convenience stores; computerized on-line ordering featuring general merchandise and general consumer goods; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; providing a searchable on-line advertising guide featuring the goods and services of other on-line vendors; database management services; electronic classified advertising services; on-line classified advertising services, electronic auction services; and on-line auction services”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged];

<<Unknown Symbol>>, Registration No. 2696140, issued March 11, 2003 for “computer services, namely, providing search engines for locating information, resources, and the websites of others on the internet; providing a wide range of general interest information via the internet; providing electronic greeting cards via the internet”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged];

<<Unknown Symbol>>, Registration No. 2684128, issued February 4, 2003 for “providing interactive chat rooms for transmission of messages among computer users and subscribers concerning general merchandise and general consumer goods, product reviews and purchase information on the Internet”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged]; and

AMAZON.COM OUTLET, in typed form with OUTLET disclaimed, Registration No. 2649373, issued November 12, 2002 for “electronic retailing services via computer featuring books, music, videotapes, audiocassettes, compact discs, floppy discs and CD-Roms, printed matters, phonographs, recorded music, toys, household electronic appliances; applied electronic machines and apparatus, photography instruments, musical instruments and fittings thereof; photographs, stationery, jewelry, horological instruments and parts thereof, motor vehicles and parts and accessories thereof, manual and power tools, measuring instruments, physical and chemical instruments, chemicals, soaps, perfumery, cosmetics, paints, adhesive for industrial purposes, preservatives, leather, imitation leather, bags and their substitutes, umbrellas, walking sticks, saddlery, materials for building and construction, furniture, fabric, indoor ornaments of textile, tobacco (not of medical use), smokers articles, plants, pharmaceuticals, lights, irons and steels, pots, tableware, heaters, cosmetic utensils, yarns and thread for textile use, kitchen and household utensils, games and playthings, electronic publications and greeting cards; and providing an on-line searchable database featuring books, music, videotapes, audiocassettes, compact discs, floppy discs and CD-Roms, printed matters, phonographs, recorded music, toys, household electronic appliances; applied electronic machines and

apparatus, photography instruments, musical instruments and fittings thereof; photographs, stationery, jewelry, horological instruments and parts thereof, motor vehicles and parts and accessories thereof, manual and power tools, measuring instruments, physical and chemical instruments, chemicals, soaps, perfumery, cosmetics, paints, adhesive for industrial purposes, preservatives, leather, imitation leather, bags and their substitutes, umbrellas, walking sticks, saddlery, materials for building and construction, furniture, fabric, indoor ornaments of textile, tobacco (not of medical use), smokers articles, plants, pharmaceuticals, lights, irons and steels, pots, tableware, heaters, cosmetic utensils, yarns and thread for textile use, kitchen and household utensils, games and playthings, electronic publications and greeting cards”; [Section 8 Affidavit accepted; Section 15 Affidavit acknowledged].

\*5 Amended Notice of Opposition Ex. A; Bald Dec. I Exs. 1-8.

As noted, applicant is an attorney. At the time applicant filed the involved application, he worked for a patent law firm in Silicon Valley. Applicant “intended to create the Amazon Ventures business to help individuals and businesses (with or without an intellectual property portfolio) raise capital from venture capital firms, angel investors, equity investment companies, or other interested parties.” Applicant’s Reply Brief and Response to Opposer’s Cross-Motion at pp. 9-10. According to applicant’s website, Amazon Ventures also assists with “management of financial matters including maintaining financial records, and management and investment of capital received. We prepare financial reports ....” Bald Dec. I ¶ 25 and Ex. 917.

### **Standing and Priority**

Opposer’s standing to oppose registration of applicant’s mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by opposer. See, e.g., [Cunningham v. Laser Golf Corp.](#), 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party’s ownership of pleaded registration establishes standing).

In addition, and as set forth in the December 21, 2011 order denying the parties’ cross-motions, because opposer’s pleaded registrations are of record, priority is not an issue with respect to the services covered by opposer’s pleaded registrations. [Penguin Books Ltd. v. Eberhard](#), 48 USPQ2d 1280, 1286 (TTAB 1998) (citing [King Candy Company v. Eunice King’s Kitchen, Inc.](#), 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). These services include:

- “credit card services; and charge card services” (Registration No. 3411872 for AMAZON.COM);
- “commodity trading for others” (Registration No. 2518043 for AMAZON.COM AUCTIONS); and
- “providing a searchable on-line database featuring goods and services of others in the field of finances, banking ...” (Registration No. 2559936, for AMAZON.COM)

In addition, opposer has established common law priority of use of, among others, the marks AMAZON.COM, AMAZON PAYMENTS, AMAZON MOBILE PAYMENTS and the trade name “Amazon.com Payment, Inc.” in connection with “payment services.” Berman Dec. ¶¶ 16-19 and Exs. 8-9. Opposer’s “payment services” allow “individuals and small businesses to accept credit card payments.” *Id.* ¶ 18.

### **Likelihood of Confusion**

“We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant’s [services] originate from the same source as, or are associated with,” opposer’s services. [In re Majestic Distilling Co., Inc.](#), 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider all probative facts in evidence which are relevant to the likelihood of confusion factors set forth in [In re E.I. du Pont de Nemours & Co.](#), 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. [Cunningham](#), 222 F.3d at 943, 55 USPQ2d at 1848.

### **Fame**

\*6 It is well-settled that where fame exists, it “plays a ‘dominant role in the process of balancing the DuPont factors,’ ... and

‘[f]amous marks thus enjoy a wide latitude of legal protection.’” Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)(quoting Recot Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). Indeed, a strong mark “casts a long shadow which competitors must avoid.” Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Furthermore, fame remains “a dominant factor in the likelihood of confusion analysis ... independent of the consideration of the relatedness of the goods.” Recot, 214 F.3d 1322, 54 USPQ2d at 1898. In fact, “when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark.” Bose Corp., 293 F.3d 1367, 63 USPQ2d at 1310.

While consumer surveys may provide direct evidence of fame, they are not necessary. Rather, “fame of a mark may be measured indirectly, among other things, by 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.” Id., 293 F.3d 1367, 63 USPQ2d at 1305. Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” Coach Services Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Here, opposer’s AMAZON.COM mark is its primary trademark and domain name, and we will focus our attention on this mark. AMAZON.COM is the address for the website through which opposer offers the bulk of its goods and services, and opposer has used AMAZON.COM continuously for its goods and services since 1995. Berman Dec. ¶ 8. Opposer has established that the mark was famous prior to applicant’s filing date, and that the mark is even more famous today. Specifically, before the filing date of applicant’s intent-to-use application:

- opposer’s net sales to U.S. customers exceeded \$1.8 billion; Berman Dec. ¶¶ 64, 66;
- while the exact figures are confidential, opposer’s annual marketing and advertising expenditures, “a significant amount” of which are attributable to the United States, were substantial, and exceeded \$100 million; id. ¶¶ 73-74;
- \*7 • in 1999 opposer was named “Marketer of the Year” by *Advertising Age*, in an article entitled “Dot-commerce: World’s biggest e-tail brand writes book on marketing savvy”; id. ¶ 72 and Ex. 36;
- opposer received unsolicited media attention in, among many other publications, the *Los Angeles Times*, the *Washington Post*, the *New York Times*, the *New York Post*, the *Chicago Tribune*, *Business Week*, the *Atlanta Journal and Constitution*, and the *Miami Herald*; Bald Dec. I ¶ 4 and Exs. 50-119; and
- opposer received unsolicited media attention on national television and radio, including reports on CNBC, CNN, NPR and ABC; Id.

Opposer’s fame has only increased since applicant filed his involved application. Specifically, from applicant’s filing date through 2011:

- opposer’s net sales to U.S. customers have exceeded \$35 billion; Berman Dec. ¶¶ 65-66;
- opposer’s advertising expenditures in the United States, while confidential, have exceeded \$1 billion; id. ¶¶ 73-74;
- *Newsday*, the *Miami Herald* and the *Boston Globe* referred to opposer as a “household name,” the *Washington Post* and *San Diego Union-Tribune* referred to opposer as “famous” and the *New York Times*, *Pittsburgh Post-Gazette*, *Milwaukee Journal Sentinel*, *Chicago Tribune*, *Boston Herald*, *St. Petersburg Times*, *Baltimore Sun*, *Philadelphia Inquirer*, *Harvard Business Review* and CNN referred to opposer as “well known”; Bald Dec. I Exs. 123, 127-129, 131, 145, 146, 150, 155, 157, 165, 171, 189, 208 and 263;
- Since 2001, Interbrand has ranked opposer among the 80 most famous global brands, and in 2011, Interbrand ranked opposer #9 on its list of “Best Retail Brands”;<sup>4</sup> Berman Dec. ¶ 86; Bald Dec. I ¶ 27 and Ex. 919; and
- Since 2002 *Fortune* magazine has ranked opposer as one of the 500 largest corporations in the United States; Berman Dec.



¶ 87.

According to *Barron's*, “E-commerce now starts and ends with Amazon ....” *Id.* Ex. 260. At least 17 books reference the AMAZON or AMAZON.COM marks in their titles. *Id.* Exs. 514-529, 531.

In short, the evidence of record clearly establishes that opposer’s AMAZON.COM mark is famous for its services, and significantly so.<sup>5</sup> Moreover,

[t]he law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, and there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises “but one inference - that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark,” and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

\*8 *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)); *see also*, *Kenner Parker Toys*, 963 F.2d at 350, 22 USPQ2d at 1456.

This du Pont factor weighs in opposer’s favor.

### **Similarity of the Marks**

We consider the similarities and dissimilarities of the parties’ marks in appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). As the fame of a mark increases, and here opposer’s AMAZON.COM marks enjoy significant fame, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d at 1311-12.

In this case, the parties’ marks, AMAZON.COM and AMAZON VENTURES, are similar in sound, appearance and meaning, and the marks create similar overall commercial impressions because AMAZON is the dominant component of each. Indeed, with respect to opposer’s AMAZON.COM mark, it is well-settled that the “.com” top-level domain indicator is not distinctive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004);<sup>6</sup> *see also*, *In re theDot Communications Network LLC*, 101 USPQ2d 1062 (TTAB 2011) and *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002). Similarly, with respect to applicant’s mark AMAZON VENTURES, the disclaimed word VENTURES is at best merely descriptive of applicant’s services. *Bass Pro Trademarks, LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008)(disclaimer may constitute admission of descriptiveness). In fact, applicant’s identification of services includes “raising venture capital for others,” and opposer has introduced evidence that well over 100 marks containing a disclaimer of the word VENTURES are registered by third parties in connection with venture capital, financial or investment services. *Bald Dec. I* ¶ 10 and Exs. 591-780. Third-party registrations such as those opposer relies on here are “competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. We can also note from such registrations that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade ....” *In re Hamilton Bank*, 222 USPQ 174, 177 (TTAB 1984); *see also*, *American Lebanese Syrian Associated Charities, Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1029 (TTAB 2011)(“third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive ...”). In short, it is well-settled that merely descriptive or otherwise non-distinctive elements of a mark, such as “.com” and VENTURES in this case, may be given less weight. *Cunningham*, 222 F.3d at 943, 55 USPQ2d at 1846. Furthermore, the fame of opposer’s AMAZON.COM mark magnifies the similarities between AMAZON.COM and AMAZON VENTURES. *Kenner Parker Toys*, 963 F.2d at 350, 22 USPQ2d at 1457.<sup>7</sup>

\*9 There is no evidence of record to establish that the term “AMAZON” has a particular meaning in connection with the parties’ services; to the contrary, we find that the term is arbitrary. In any event, to the extent that purchasers perceive any meaning conveyed by the term, the connotation would be the same for both parties’ marks.

We therefore find that the parties’ marks are confusingly similar. This du Pont factor weighs in opposer’s favor.

### **Similarity of the Parties’ Services and Channels of Trade**

It is well-settled that consumer confusion may arise even if the parties’ goods and/or services are not “similar or competitive, or even offered through the same channels of trade.” [Kohler Co. v. Baldwin Hardware Corp.](#), 82 USPQ2d 1100, 1109 (2007). Rather

[i]t is sufficient that the respective goods [and/or services] of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of goods [and/or services] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.

[Kohler Co.](#), 82 USPQ2d at 1109.

Here, opposer has established its ownership of a registration for AMAZON.COM for “credit card services,”<sup>8</sup> and has introduced undisputed evidence that many third-party marks are registered for credit card services on the one hand, and venture capital and/or investment services on the other. Bald Dec. I ¶ 13 and Exs. 856-892. This evidence suggests that these services are related. [In re 1<sup>st</sup> USA Realty Professionals, Inc.](#), 84 USPQ2d 1581, 1584 (TTAB 2007); *see also*, [Recot](#), 214 F.3d 1322, 54 USPQ2d at 1898 (in considering whether pet and human food are related, the Board erred in not considering evidence that “several large [third-party] companies produce and sell both pet and human food”); [In re Albert Trostel & Sons Co.](#), 29 USPQ2d 1783, 1785-86 (TTAB 1993). Opposer has also established prior common law rights in AMAZON.COM (and AMAZON PAYMENTS, among others) for “payment services,” and the third-party registrations upon which opposer relies show that such services may be offered by the same entity under the same marks which are also used for investment management or venture capital services, thereby suggesting that these services are related. *See e.g.*, Bald Dec. I Exs. 857, 858, 861, 862, 865, 867, 868, 871. In circumstances analogous to those presented here, where opposer’s mark is quite famous and the parties’ marks are similar, different types of financial “services” have been found to be related. *See e.g.*, [In re 1<sup>st</sup> USA Realty](#), 84 USPQ2d at 1581 (real estate brokerage and listing services found to be related to banking and credit card services); [The Corporation of Lloyd’s v. Louis D’Or of France, Inc.](#), 202 USPQ 313, 316 (TTAB 1979) (“it would not be unreasonable for purchasers encountering ‘LLOYD’S OF LONDON’ after-shave cologne and perfume to assume falsely that” a well known insurer “has licensed, sponsored, recommended, insured or otherwise guaranteed the quality of these products”); [Advantus Capital Management, Inc. v. Aetna, Inc.](#), 81 USPQ2d 1743 (D. Minn. 2006) (health care insurance plans found to be related to investment services).

\*10 Furthermore, neither opposer’s pleaded Registration No. 3411872 for AMAZON.COM for “credit card services,” nor applicant’s involved application, contain any limitations with respect to channels of trade. We therefore presume that the parties’ services, as recited in the pleaded registrations and involved application, move in all normal channels of trade for such financial services. *See, e.g.*, [Octocom Systems, Inc. v. Houston Computers Services, Inc.](#), 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); [Venture Out Properties LLC v. Wynn Resorts Holdings, LLC](#), 81 USPQ2d 1887, 1893 (TTAB 2007). Further, the record establishes that both parties target their financial services to start-up and other small businesses. *Compare* Berman Dec. ¶¶ 18, 22, 58 *with* Applicant’s Reply Brief at pp. 9-10. Accordingly, we find that the classes of purchasers for the parties’ services are at least similar, if not the same.

While applicant claims that opposer’s “credit card services” are in fact provided by or with a third-party partner of opposer’s, and that his own financial services are “specialized,” we are bound to assess likelihood of confusion based on the identifications of services in opposer’s pleaded registrations and applicant’s involved application. [Octocom Systems](#), 918 F.2d at 937, 16 USPQ2d at 1787.

In short, because opposer’s AMAZON.COM mark is famous and the parties’ marks are similar, the degree of relatedness necessary to find a likelihood of confusion is significantly less in this case than it would be in a case not involving similar marks, or not involving a mark which is famous. Under the circumstances presented here, we find that the parties’ services



are related, and their channels of trade and classes of purchasers similar. These du Pont factors weigh in opposer's favor.

### **Third-Party Use of Similar Marks**

To the extent that applicant argues that opposer's mark is not entitled to a broad scope of protection because third-parties are using similar marks, applicant has failed to introduce any evidence of third-party use. And the third-party registrations upon which applicant relies are not evidence of use. [Smith Bros. Mfg. Co. v. Stone Mfg. Co.](#), 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973).

Moreover, applicant's argument that confusion between the parties' marks is not likely because opposer consented to the registration of AMAZONTAN and AMAZON for cosmetic preparations is not well-taken. Cosmetic preparations are entirely different from applicant's venture capital and investment services, and there is no evidence that either AMAZONTAN or AMAZON are currently being used for cosmetic preparations.

This du Pont factor is neutral.

### **Conditions of Sale/Sophistication of Purchasers**

\*11 While applicant argues that consumers of financial services are sophisticated, he has not introduced any evidence in this regard. Furthermore, even assuming that the parties' customers are sophisticated, it is well-settled that even sophisticated purchasers are not immune from source confusion, especially in cases, such as this one, involving similar marks and related services. See, [In re Research and Trading Corp.](#), 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing [Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.](#), 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)) ("Human memories even of discriminating purchasers ... are not infallible."); see also, [In re Decombe](#), 9 USPQ2d 1812, 1814-15 (TTAB 1988). We find that the similarities between the marks and the services sold thereunder outweigh any sophisticated purchasing decision. See [HRL Associates, Inc. v. Weiss Associates, Inc.](#), 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, [Weiss Associates, Inc. v. HRL Associates, Inc.](#), 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Thus, to the extent that this du Pont factor would weigh in favor of applicant, it is outweighed by the other factors.

### **Conclusion**

After a careful review of all evidence of record and the parties' arguments, only some of which have been specifically addressed here, and based on a preponderance of the evidence, we find that there is a likelihood of confusion between opposer's mark AMAZON.COM and applicant's mark AMAZON VENTURES for their respective services.

In view of our determination on the likelihood of confusion claim under Section 2(d), we do not reach the dilution claim under Section 43(c).

**Decision:** The opposition is sustained and registration to applicant is refused.

### Footnotes

<sup>1</sup> Application Serial No. 78001126. Mr. Freeland assigned his interest in the mark and application to Mr. Wax on October 20, 2008, prior to commencement of this opposition, as recorded in the Assignment Branch records at Reel 4007, Frame 0486.

<sup>2</sup> We note that applicant is an attorney.

<sup>3</sup> Applicant filed his motion for summary judgment on opposer's claims of priority and likelihood of confusion and dilution on June 14, 2011, and opposer filed its cross-motion on the same claims on July 19, 2011.

4 The list ranks Coach #8 and Dell #10.

5 While applicant attempts to make much of the difference between the marks AMAZON and AMAZON.COM, the distinction is not particularly relevant, nor is it significant, as explained below. Indeed, the evidence establishes that both marks are famous, and in any event, since the 1990's, "the national media and Amazon's consumers have referred to and identified Amazon.com as simply AMAZON." Berman Dec. ¶ 14. Opposer has introduced substantial evidence that AMAZON alone was a famous mark before applicant's intent-to-use filing date. Bald Dec. II Exs. 946-1146.

6 We cannot help but notice that in In re Oppedahl & Larson, in dicta, the Federal Circuit specifically considered a hypothetical involving opposer's AMAZON.COM mark, and indicated that "[i]n that setting, the addition of '.com' adds no source-identifying significance, which is likely to be the case in all but the most exceptional case." In re Oppedahl & Larson, 373 F.3d, 71 USPQ2d at 1173.

7 While opposer appears to plead ownership of "an overall family of marks," Amended Notice of Opposition ¶ 13, it did not introduce evidence or present arguments concerning its alleged family of marks, and we have therefore considered each of opposer's pleaded marks individually, rather than as part of an alleged "family."

8 Applicant attempts to make much of opposer's deletion of various types of "financial services" from some of its pleaded registrations. We have only considered the current identifications of goods and services in each of opposer's pleaded registrations, and those goods and services for which opposer has established prior use. Opposer's deletion of certain services from its registrations does not mean that it is not offering other types of financial services, or that opposer is not offering services which are related to those in applicant's involved application.

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2012 WL 1267957 (Trademark Tr. & App. Bd.)

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2012 WL 3224739 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

ELEKTRA ENTERTAINMENT GROUP, INC.

v.

ELEKTRA TRADING & CONSULTING GROUP, S.A. DE C.V.

Opposition Nos. 91186906, 91190824 to [application Serial Nos. 77010715, 77010763](#)<sup>1</sup>  
July 18, 2012

\*[1 Andrew I. Gerber](#) of Kilpatrick Townsend & Stockton LLP for Elektra Entertainment Group, Inc.

[Thomas A. Zeigler](#) of AlvaradoSmith APC for Elektra Trading & Consulting Group, S.A. de C.V.

Before [Quinn](#), [Cataldo](#) and [Mermelstein](#)

Administrative Trademark Judges

Opinion by [Cataldo](#)

Administrative Trademark Judge:

Applicant, Elektra Trading & Consulting Group, S.A. de C.V., filed two applications to register on the Principal Register the mark displayed below for

Retail stores featuring general consumer goods such as home appliances, electronics, electric appliances, furniture and household goods; and advertising, namely, the commercialization of goods such as home appliances, electronics, electric appliances, furniture and household goods,

in International Class 35;<sup>2</sup> and

publicity, commercial business management, commercial business administration, office work

in International Class 35.<sup>3</sup>



Registration has been opposed by Elektra International Group, Inc. (“opposer”). As grounds for opposition, opposer asserts that it is the owner of numerous ELEKTRA and ELEKTRA-formative marks, including the mark ELEKTRA (typed or standard characters), previously used and registered on the Principal Register for prerecorded phonograph records, audio and video tapes, cassettes, and compact disks featuring entertainment

in International Class 9.<sup>4</sup>

In its notices of opposition, opposer alleges that its ELEKTRA and ELEKTRA-formative marks are well-known and strong; that applicant’s marks and opposer’s previously used and registered marks are highly similar; that applicant’s services and

opposer's goods are closely related; and that, as a result, confusion, mistake and deception are likely among consumers as to the source thereof under Trademark Act Section 2(d); and that opposer will be damaged thereby.<sup>5</sup>

Applicant's answers consist of a general denial of the allegations in the notice of opposition.<sup>6</sup>

### Evidentiary Matters

Applicant objects to evidence introduced by opposer in its Notice of Reliance Nos. 5, 6, 9, 10, 12, 14 and 15, primarily on the ground of relevance. We note, however, that none of the evidence sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

### The Record

\*2 The record consists of the pleadings, and the files of the involved applications. In addition, opposer took the depositions, with accompanying exhibits, of Jac Holzman, founder of Elektra Records and currently senior advisor to the chairman of Warner Music Group; and Ariel Taitz, senior vice president of business affairs and development for Warner Elektra Atlantic Corp. Opposer also filed notices of reliance.

Applicant took the testimony deposition, with exhibits, of Enrique Rodriguez Macias, its chief of business. Applicant also filed notices of reliance.<sup>7</sup>

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief.

### Opposer's Standing

Opposer has properly made of record copies of its pleaded registrations.<sup>8</sup> Opposer further has shown, by its use and registration of marks that are at least arguably similar to applicant's marks, that it has a legitimate commercial interest in this matter and a reasonable belief in damage. Accordingly, we find that opposer has established its standing to oppose registration of applicant's marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

### Priority of Use

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therein and goods identified thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

### Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

For purposes of the *du Pont* factors that are relevant to this case we will consider applicant's involved marks and opposer's ELEKTRA mark in typed or standard characters that is the subject of its Registration No. 1633872. Opposer's other pleaded registrations feature the term ELEKTRA along with designs and/or additional wording. If likelihood of confusion is found as to the mark and goods in this registration, it is unnecessary to consider opposer's other pleaded registrations for marks which are less similar to applicant's involved marks than opposer's ELEKTRA mark. Conversely, if likelihood of confusion is not found as to the mark and goods in this registration, we would not find likelihood of confusion as to the marks and goods in

opposer's other pleaded registrations.

#### Strength of Opposer's ELEKTRA Mark

\*3 While opposer does not argue that its ELEKTRA mark is famous as contemplated by the fifth *du Pont* factor, it nonetheless has presented the following arguments and evidence that its mark is distinctive and strong.<sup>9</sup> The ELEKTRA mark has been in continuous use since 1951 in connection with musical sound recordings. Opposer's products under the ELEKTRA mark are distributed throughout the United States by such companies as Apple iTunes, Amazon, AT&T, Verizon, Wal-Mart, Best Buy and Target. Opposer and its retailers advertise opposer's goods under the ELEKTRA mark through billboards, general interest publications such as The New Yorker, music magazines and music trade publications, catalogs and the internet. Opposer has released recordings for well-known and popular artists such as The Doors, Queen, Eagles, The Cars, AC/DC, The Beach Boys and Bruno Mars. Opposer has sold hundreds of millions of copies of musical recordings under its ELEKTRA mark, including 75 million copies of musical recordings by the band The Doors. Opposer has received extensive, unsolicited media attention for its artists and goods under the ELEKTRA mark, including articles in The Wall Street Journal, Los Angeles Times, Daily Variety, The New York Times, USA Today, and Reuters News. The founder of Elektra Records, Jac Holzman, was inducted into the Rock and Roll Hall of Fame in 2011 in recognition of his and Elektra's influence and contribution to the music industry. Sales of opposer's goods under the ELEKTRA mark are quite substantial.

Applicant, for its part, argues and introduces evidence that opposer's ELEKTRA mark is weak in light of third-party registrations for various ELEKTRA marks for such goods as comic books, watches, espresso machines, rechargeable batteries, boats and snowshoes.<sup>10</sup> Certain of these registrations are cancelled and, contrary to applicant's contentions, possess no probative value. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything"). We further note that these third-party registrations recite goods that are dissimilar from those identified in opposer's pleaded registrations, notwithstanding applicant's contention that they include "electronic-related goods." In any event, while third-party use of the same or similar mark is a relevant consideration, third-party registrations are not evidence of the use of such marks, or that consumers are familiar with them. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973); and *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462-63 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the USPTO). Such registrations are therefore of little or no relevance in determining the strength of a registration. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). As a result, we cannot say that these registrations demonstrate that ELEKTRA is a weak mark that is entitled to a limited scope of protection.

\*4 Based upon the evidence of record, we find that opposer's ELEKTRA mark has achieved significant recognition and strength in the musical recording market and that the mark therefore is entitled to a broader scope of protection than might be accorded a less distinctive mark.

#### The Marks

We now turn our attention to a comparison of the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and services offered under the respective marks is likely to result.

In comparing opposer's ELEKTRA mark with applicant's marks,



we note that applicant's marks incorporate the entirety of opposer's mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing). Thus, the word portion of applicant's marks is identical to opposer's mark in sound and connotation and nearly identical in appearance.

We further find that ELEKTRA is the dominant element of applicant's marks -- and the only element in opposer's '872 Registration - and accordingly it is entitled to the greatest weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant's marks comprise both a word and a design. In such a case, the word portion of the marks is normally accorded greater weight because it would be used by purchasers to request the services identified thereby. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For these reasons, we consider ELEKTRA to be the dominant feature of applicant's marks.

\*5 As discussed above, the term ELEKTRA as it appears in applicant's marks is nearly identical to opposer's mark. Applicant's mere addition of a design to a term that comprises the totality of opposer's mark is insufficient to create a commercial impression that is distinct therefrom. We thus find the marks are highly similar in appearance, sound and connotation and that, when viewed in their entireties, they convey highly similar commercial impressions. As a result, this *du Pont* factor favors a finding of likelihood of confusion.

#### The Goods and Services

Turning to our consideration of the recited goods and services, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the goods and services at issue be identical or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing thereof are such that they would or could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, opposer's goods are  
prerecorded phonograph records, audio and video tapes, cassettes, and compact disks featuring entertainment.

Applicant's services in its application Serial No. 77010715 are  
Retail stores featuring general consumer goods such as home appliances, electronics, electric appliances, furniture and household goods; and advertising, namely, the commercialization of goods such as home appliances, electronics, electric appliances, furniture and household goods;

and the services in its application Serial No. 77010763 are  
publicity, commercial business management, commercial business administration, office work.

Applicant has testified and submitted evidence demonstrating that its retail stores are similar to a Wal-Mart or Best Buy directed toward a Hispanic market featuring, *inter alia*, several major brands of consumer electronic goods, including MP3

players, full-size and compact stereos that play radio, CDs and MP3s, and accessories therefor.<sup>11</sup> Presently, applicant does not appear to sell electronic goods that are themselves branded with its applied-for mark; however, applicant's retail stores, which along with its internet website are identified by the applied-for mark, provide electronic goods manufactured by such third parties as Sony, Panasonic, LG, Samsung, Motorola, HP and Daewoo.<sup>12</sup> Opposer has submitted evidence corroborating this.<sup>13</sup> In addition, applicant acknowledges that "some of Opposer's goods may be compatible with some of the goods sold in Applicant's retail stores or through its catalogs"<sup>14</sup> while arguing nonetheless that "they are not competitive or intrinsically related."<sup>15</sup>

\*6 Opposer further made of record 46 third-party registrations reciting both opposer's goods and applicant's services. Third-party registrations which individually cover a number of different items and which are based on use in commerce may serve to suggest that the listed goods are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988). We find that most of these registrations are not probative because they are not based upon use in commerce. See *Albert Trostel*, 29 USPQ2d at 1785-86. We nonetheless find the following 8, use-based registrations to be probative on the issue of the relatedness of the parties' goods and services:

Registration No. 3339943 reciting, *inter alia*,

audio recordings featuring music, prerecorded video cassettes featuring musical artists, prerecorded video tapes featuring musical artists, video discs featuring musical artists;

video stores;

advertising and publicity services ...;

Registration No. 3386278 reciting, *inter alia*,

compact discs featuring music;

online retail store services featuring music related items;

Registration No. 3949140 reciting, *inter alia*,

pre-recorded CD-ROMs, DVDs, compact discs, and video discs, featuring entertainment related to films, games and music;

retail store and computerized on-line retailing and ordering services featuring books and strategy guides, apparel, toys, collectibles, gadgets, posters and art, interactive software, computer game software, interactive video games and interactive computer games;

Registration No. 3587093 reciting, *inter alia*,

audio recordings, prerecorded CDs, video tapes and DVDs featuring music, musical sound recordings, musical video recordings;

on-line retail store services featuring a wide variety of consumer goods, namely, ... audio recordings, prerecorded CDs and DVDs featuring music;

Registration No. 3805259 reciting, *inter alia*,

prerecorded music and videos on CD, DVD and other prerecorded media ...;

advertising and information distribution services ..., online retail store services featuring digitized products including ... sound recordings, videos, media players, portable media players, video equipment and audio equipment ...;

Registration No. 3555356 reciting, *inter alia*,



audio digital tapes featuring music, film, television, audio discs featuring music, film, television, audio recordings featuring music, film, television, audio tapes featuring music, film, television;

advertising and marketing, business management consultation with relation to strategy, marketing, production, personnel and retail sale matters;

\*7 Registration No. 3227562 reciting, *inter alia*,

Compact discs, DVDs, vinyl phonograph records featuring music, prerecorded video discs featuring music;

Online retail store services featuring musicrelated consumer products; and

Registration No. 3292474 reciting, *inter alia*,

audio and video discs featuring music, music videos and movies;

retail store services featuring pre-recorded audio-video products, namely, audio and video tapes, discs, compact discs and video discs ....

Based upon the testimony and evidence of record, we find that opposer has established that its various audio and video phonographs, tapes, cassettes and discs featuring entertainment are related to applicant's retail store services featuring, *inter alia*, electronic goods that may be used to play opposer's goods. Indeed, applicant's own testimony and evidence supports such a finding, and the eight registrations noted above further suggest that such goods and services are related in that they are of a type which may emanate from a single source. As a result, we find that opposer's goods and applicant's services in its application Serial No. 77010763 are related for purposes of our likelihood of confusion determination.<sup>16</sup>

However, we find that opposer has failed to establish that its goods are related to applicant's services recited in application Serial No. 77010763. Opposer has made of record two use-based, third-party registrations reciting goods and services similar to those in its pleaded registration and applicant's involved application Serial No. 77010763. There is little, if any, additional testimony or evidence of record to support a finding that the goods and services are related in such a way that consumers encountering them under the marks at issue here would likely be confused. We find this evidence to be insufficient to support opposer's contention that the goods and services are related.

In its brief, opposer argues it has used "the ELEKTRA Marks for decades to publicize and promote its goods and services"<sup>17</sup> and that, because application Serial No. 77010763 contains no limitations on the type of publicity or business management provided, "it must be presumed that [applicant's] services would be in connection with Applicant's claimed retail stores which seek to sell electronics and other goods."<sup>18</sup> However, a service is an activity performed for the benefit of others, *e.g.*, *In re Reichhold Chems., Inc.*, 167 USPQ 376, 377 (TTAB 1970) ("It is well settled that promoting the sale and use of one's goods is not, *per se*, a service within the meaning of the statute"), and opposer neither explains how publicizing and promoting its own goods is a service nor provides any evidence to support its presumption that applicant intends to simply publicize and provide business management for its own retail stores. Simply put, opposer's arguments are based more upon speculation than evidence, and fail to support a finding that its goods are related to the services in application Serial No. 77010763.

\*8 We find, as a result, that the *du Pont* factor of relatedness of the goods and services favors a finding of likelihood of confusion as to application Serial No. 77010715 but favors a finding of no likelihood of confusion as to application Serial No. 77010763.

#### Channels of Trade

Because there are no recited restrictions as to the channels of trade or classes of purchasers of the services identified in application Serial No. 77010715 or the goods identified in opposer's registration, we must assume that the goods and services



are available in all the normal channels of trade to all the usual purchasers for such goods and services. See *Octocom Systems, Inc. v. Houston Computers Services 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.”). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”). As such, the parties’ goods and services are presumed to be marketed to the general public through all normal trade channels therefor. Furthermore, the goods and services of both parties, as identified, are the type of goods and services that are offered to the general public and, therefore, the classes of consumers are the same.

In addition, the evidence of record discussed above demonstrates that applicant’s retail stores carry products such as cassette and compact disc players that allow users to play opposer’s goods. Thus, there is at least some overlap in the purchasers of the parties’ goods and services. Thus, we are not persuaded by applicant’s arguments that its services are directed solely “towards Hispanic consumers in the U.S. and other consumers previously familiar with its business and goodwill in Mexico....”<sup>19</sup> Simply put, we will not impose trade channel limitations not present in applicant’s recitation of services.

However, as discussed above we have found insufficient evidence that opposer’s goods are related to applicant’s services in its application Serial No. 77010763. Similarly, we have insufficient evidence that the goods and services would be marketed in the same channels of trade to the same classes of purchasers.

As a result of the foregoing, we find that this *du Pont* factor also favors a finding of likelihood of confusion as to application Serial No. 77010715, but not application Serial No. 77010763.

#### Actual Confusion

\*9 Another *du Pont* factor discussed by the parties is the lack of instances of actual confusion. Applicant asserts that the absence of evidence of actual confusion between the marks despite co-existence “since at least 1986 in the Mexican market”<sup>20</sup> suggests no likelihood of confusion. Nonetheless, trademarks are territorial in nature, and applicant seeks registration of its mark in the United States. Our determination of registrability must thus be based on whether relevant consumers in the U.S. market are likely to be confused, not whether consumers in the Mexican market are likely to experience such confusion. But even to the extent this argument is relevant, applicant fails to provide any evidence of lack of confusion among “the countless Mexican citizens who have immigrated in the U.S. over the last 25 years who are undoubtedly familiar with Applicant’s retail store.”<sup>21</sup> Nor is there any evidence in the record reflecting the extent and nature of opposer’s business in the Mexican market. *Cunningham*, 55 USPQ2d at 1847 (absence of actual confusion not significant unless accompanied by evidence demonstrating that in light of the parties’ actual business activities, confusion, if likely, would have occurred). Applicant’s mere assertions regarding the familiarity with its mark among Mexican citizens living in the United States and the absence of confusion with opposer’s mark by such individuals provide no evidence upon which we may base such a finding.

Furthermore, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Evidence of actual confusion often is very difficult to obtain, and while such evidence may support a finding of likelihood of confusion, the absence thereof does not necessarily suggest that confusion is unlikely.

Accordingly, this *du Pont* factor must be considered to be neutral.

#### **Conclusion**

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties’ arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude, in view thereof, that opposer has proven its standing and priority of use.

We also find that opposer has proven that a likelihood of confusion exists between its mark and goods and the mark and

services in application Serial No. 77010715. We make this finding based primarily on the similarities between the parties' marks, the goods and services identified thereby, and the presumption that such goods and services move in the same channels of trade and are marketed toward the same classes of purchases.

**\*10** However, we find that opposer has failed to prove that a likelihood of confusion exists between its mark and goods and the mark and services in application Serial No. 77010763. We make this finding primarily on the basis of the lack of evidence of a similarity between the parties' goods and services or their channels of trade.

**Decision:** The oppositions are sustained as to application Serial No. 77010715 and dismissed as to application Serial No. 77010763.

#### Footnotes

- <sup>1</sup> These proceedings were consolidated in a Board order issued on August 24, 2009.
- <sup>2</sup> Application Serial No. 77010715, filed under Section 44(e) of the Trademark Act, based upon Mexican Registration No. 587847.
- <sup>3</sup> Application Serial No. 77010763, filed under Section 44 (e) of the Trademark Act, based upon Mexican Registration No. 583608.
- <sup>4</sup> Registration No. 1633872 issued on February 5, 1991. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Second renewal.
- <sup>5</sup> In its brief, opposer also raises a cursory argument that applicant lacks a bona fide intent to use its applied-for marks in commerce. Applicant, in its brief, makes an equally cursory response thereto. However, such issue was not pleaded. Further, we find that the parties' treatment thereof does not give rise to a finding that it was tried by their express or implied consent. *See Fed. R. Civ. P. 15(a) and (b)*. As a result, the parties' arguments in this regard have been given no consideration, except to the extent that they may relate to the pleaded ground of priority and likelihood of confusion.
- <sup>6</sup> Applicant also asserted certain affirmative defenses but did not pursue them by motion or at trial. Accordingly, they are deemed waived, except to the extent that they may be construed as amplifications of its denial of the allegations in the notices of opposition.
- <sup>7</sup> Both parties have designated portions of their testimony depositions and evidence as "confidential." In this decision, we will endeavor to discuss those portions of the parties' testimony and evidence that contain confidential information only in general terms.
- <sup>8</sup> Opposer's Second Notice of Reliance.
- <sup>9</sup> Holzman testimony and Taitz testimony, and exhibits thereto.

<sup>10</sup> Applicant's First Notice of Reliance.

<sup>11</sup> Macias Testimony and exhibits thereto.

<sup>12</sup> *Id.*

<sup>13</sup> Opposer's Ninth Notice of Reliance.

<sup>14</sup> Applicant's brief, p. 22.

<sup>15</sup> *Id.*

<sup>16</sup> Because we find that applicant's "Retail stores featuring general consumer goods such as home appliances, electronics, electric appliances, furniture and household goods" are related to the goods in opposer's pleaded registration, we need not also determine the similarity or dissimilarity of opposer's goods to the other services identified in applicant's application Serial No. 77010715, *i.e.*, "advertising, namely, the commercialization of goods such as home appliances, electronics, electric appliances, furniture and household goods." Similarity as to *any* of the goods or services identified in the application and pleaded registration will suffice as a basis for finding the respective goods and services to be similar for purposes of the second *du Pont* factor. *See, for example, Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

<sup>17</sup> Opposer's brief, p. 28.

<sup>18</sup> *Id.*

<sup>19</sup> Applicant's brief, p. 25.

<sup>20</sup> *Id.* at 31.

<sup>21</sup> *Id.*

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2012 WL 3224739 (Trademark Tr. & App. Bd.)

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2018 WL 1082095 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

H-D U.S.A., LLC

v.

SCHMIDIGER

Opposition No. 91223860

February 23, 2018

\*1 Linda K. McLeod and David M. Kelly of Kelly IP, LLP for H-D U.S.A., LLC

Jürg Schmidiger, pro se

Before Kuczma, Masiello, and Heasley

Administrative Trademark Judges

Opinion by Masiello

Administrative Trademark Judge:

Jürg Schmidiger (“Applicant”) filed an application<sup>1</sup> for extension of protection to the United States of his International Registration of the mark shown below

The image shows a stylized, cursive logo for 'Harlie Harper'. The letters are thick and black, with a fluid, handwritten style. The 'H' and 'A' are particularly large and prominent, and the overall script is elegant and flowing.

for the following goods:

Footwear; Woven articles of clothing, namely, suits for men and women, pantsuits, track suits, dress suits, suits, business suits, three-piece suits, blazers, jackets, smoking jackets, tuxedos, shirts, shirts for suits, dress shirts, formal shirts, casual shirts, short-sleeve shirts, long-sleeve shirts, golf shirts, Hawaiian shirts, Hawaiian shirts with front button closure, open-necked shirts, tank tops for sports, short-sleeve sports shirts, moisture-wicking sports shirts, polo shirts, bowling shirts, neckties, ascots, bolo ties, mufflers, bandanas, neckerchiefs, underwear, underwear for men, long underwear, boy shorts, thermal underwear, sweat-absorbent underclothing; water-resistant clothing, namely, jackets; wind-resistant jackets, dress socks for men, athletic footwear, footwear for sports, sports shoes, shoes for playing drums; Clothing for sports, namely, track suits, sports jackets, fishing jackets, wet suits for surfing, wet suits for surface water sports, bathing suits, bathing suits for women, bathing suits for men, fitted swimming costumes with bra cups, tank tops for sports, short-sleeve sports shirts, moisture-wicking sports shirts, bowling shirts, polo shirts, rain slickers; Headgear, namely, hats, caps, hoods, beanies; Footwear, namely, athletic footwear, footwear for sports, sports shoes, motorcycle boots, footwear for men and women, pumps; Leather or imitation leather clothing, namely, suits of leather, motorcycle jackets, motorcyclists pants, belts, shoes, boots, motorcycle boots, footwear for men and women, pumps; Motorists clothing, namely, motorcycle boots, rain suits for motorcyclists, motorcycle jackets; high-strength synthetic fiber woven clothing, namely, motorcyclists pants and jackets, water-resistant jackets, tear-cut and heat proof motorcyclists jackets, tear-cut and heat proof motorcyclists pants, tear-cut and heat proof motorcyclists shirts, in International Class 25.

H-D U.S.A., LLC (“Opposer”) has opposed registration of the mark on the ground that it so resembles Opposer’s earlier used and registered marks HARLEY and HARLEY-DAVIDSON (in standard character and stylized forms) as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and on the ground that

Applicant's mark is likely to cause dilution of the distinctive quality of Opposer's marks under Section 43(c), 15 U.S.C. § 1125(c). Applicant, in his answer, admitted many of Opposer's allegations, including the following:<sup>2</sup>

\*2 • That Applicant "thinks the trademark HARLEY-DAVIDSON is a world wide well known trademark and the company is having good commercial success";

- That "Opposer owns the trademarks as listed in the Opposer's Notice of Opposition";

- That "Opposer owns and has owned the trademarks HARLEY and HARLEY-DAVIDSON prior to the Applicants Harlie Charper trademark application."

- That "for the pronunciation in American English it is may true that there is an affinity in between the two HARLEY and Harlie";

- That Applicant "has the intention to produce motorcycle clothing not because of a 'bad faith intent' for the company Harley Davidson and their business. But he (Applicant) has ideas for new innovative motorcycle clothing as he is a motorcyclist himself and can comprehend their needs";

- That "the company Harley Davidson has good success in business since decades";

- That "the HARLEY-DAVIDSON trademark has become famous long before the Applicant has filed his application."

Applicant denied other salient allegations of the notice of opposition. In particular, Applicant denied "that Opposer has gained high profile under the specific HARLEY trademark itself";<sup>3</sup> Applicant asserted that he "has never seen any products labelled with the trademark HARLEY nor such advertising so far";<sup>4</sup> and maintains that the difference between his mark and Opposer's marks "is so obvious that the mental capacity of someone who would seriously confound those different marks maybe should be doubted."<sup>5</sup>

Opposer filed a substantial amount of trial evidence and a brief on the case. Applicant has neither presented evidence nor filed a brief.

#### A. The record.

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application file for the opposed mark. Opposer has filed the testimony declaration of Joanne M. Bischmann, Vice President, Communications for Harley-Davidson, Inc., and President of Harley-Davidson Foundation, Inc. (31 TTABVUE (confidential); public version at 30 TTABVUE) with exhibits thereto (32-77 TTABVUE). Opposer has also filed seven notices of reliance on the following evidence:

- Status and title information, from the online records of the USPTO, regarding 26 U.S. registrations owned by Opposer (14 TTABVUE).

- Opposer's Annual Reports on Form 10-K for 2011-2016 (15 TTABVUE).

- Applicant's responses to select requests for admission (16 TTABVUE).

- Decisions relating to Opposer's enforcement of its trademark rights (18 TTABVUE).

\*3 • Applicant's responses to select interrogatories (19 TTABVUE).

- Excerpts from published books referring to Opposer (20-29 TTABVUE).

- Press notices referring to Opposer (78 TTABVUE).

B. Standing.

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). The plaintiff must show that it has a real interest in the proceeding beyond that of a mere intermeddler and that it has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer has pleaded and proven<sup>6</sup> that it owns the following 13 subsisting U.S. registrations covering the clothing-related goods listed below (among other goods):



Reg. No.	Mark	Clothing-related Goods
1406876	HARLEY	clothing; namely-- tee shirts for men, women and children; knit tops for women and girls; and children's shirts

1683455	HARLEY	shirts, tank tops, boots, and sweatshirts
1708362	HARLEY	embroidered patches for clothing
0507163	HARLEY-DAVIDSON	motorcycle shirts, sweaters, breeches, neckties, coveralls, rain coats and hats, jackets, helmets, caps, and boots
1234404	HARLEY-DAVIDSON	Clothing-Namely, Jackets, Pants, Shirts, T-Shirts, Vests, Jeans, Riding Suits, Bandannas, Rain Suits, Shorts, Nightgowns, Halters, Underwear, Tank Tops, Sweatshirts, Night Shirts, Socks, Gloves, Hats, Caps and Boots  Sunglasses and Protective Helmets for Motorcyclists
1450348	HARLEY-DAVIDSON	sweat pants, sweaters, suspenders, scarves, bandanas, leather clothing, namely, jackets, vests, gloves, jeans, chaps, tops, boots, shorts, caps, belts, and parts of footwear, namely boot tips
3393840	HARLEY-DAVIDSON	House mark for a full line of clothing, footwear and headwear
3558739	HARLEY-DAVIDSON	Leather and imitations of leather, and goods made of these materials, namely,

dog leashes, dog collars, dog clothing

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1793137 HARLEY OWNERS GROUP

clothing, namely, shirts, sweatshirts, t-shirts, caps, hats, jacket, vests, bandanas, belt buckles and ornamental patches

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3490890 HARLEY-DAVIDSON

House mark for a line of motorcycles, structural parts for motorcycles and related motorcycle accessories, namely ... (*etc.*)

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1571032

clothing, namely, jeans, t-shirts and jackets

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3447304

a full line of clothing

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1710643

shirts, sweatshirts, t-shirts, caps, embroidered patches

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**\*4** Opposer has also demonstrated that over a period of years it has used the marks HARLEY and HARLEY-DAVIDSON on and in connection with a range of apparel.<sup>7</sup> Thus, Opposer has shown that it has a real interest in this proceeding and a reasonable basis for its belief that it will be damaged by registration of Applicant's mark, and has established its standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 50 USPQ2d at 1025-6; and *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).



C. Opposer’s claim under Section 2(d).

Opposer opposes registration of Applicant’s mark under Trademark Act § 2(d), on the ground that Applicant’s mark “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by [Opposer] and not abandoned, as to be likely, when used on or in connection with the goods of [Applicant], to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). In view of Opposer’s ownership of valid and subsisting registrations of its pleaded marks, priority is not at issue with respect to the marks and the goods identified in the registrations. *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In our analysis, below, we have considered all factors with respect to which there is evidence of record.

D. The fame of Opposer’s marks.

We will first address Opposer’s contention that its marks HARLEY-DAVIDSON and HARLEY “are among the most famous marks in the U.S.”<sup>8</sup> Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). For purposes of analysis of likelihood of confusion, fame is not an “all-or-nothing factor”; rather, it “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). Fame is “determined from the viewpoint of consumers of like products,” and not from the viewpoint of the general public. *Id.* at 1735. 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, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). As we have noted above, Applicant has conceded that “the HARLEY-DAVIDSON trademark has become famous long before the Applicant has filed his application.”<sup>9</sup> Applicant has made no such concession regarding the mark HARLEY.

<sup>8</sup>To demonstrate the fame of its marks, Opposer has submitted testimony that Opposer commenced manufacturing motorcycles in 1903 under the brand HARLEYDAVIDSON and is now the largest manufacturer of motorcycles in the United States.<sup>10</sup> “For decades, [Opposer] has been referred to by ... the shortened name Harley ....”<sup>11</sup> According to Opposer’s witness, Opposer has used its marks for motorcycles and apparel of various types from the dates set forth below:<sup>12</sup>



Mark	Goods	Date
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HARLEY-DAVIDSON	Motorcycles.	1903
HARLEY	Motorcycles.	1903
HARLEY-DAVIDSON	T-shirts, jackets, pants, jeans, rain coats, rain suits, hats, sweatshirts, gloves, helmets, belts, and boots.	1914-15
HARLEY-DAVIDSON	Sweat pants, suspenders, scarves, bandanas, leather clothing, boots, caps, and belts.	1947
HARLEY	Clothing.	1981
	Jeans, jackets, t-shirts.	1 9 8 8
HARLEY OWNERS GROUP	Clothing and hats.	1 9 8 4

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HOG LADIES OF HARLEY	Clothing and caps.	1
		9
		8
		7

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\*6 For the purpose of demonstrating the fame of its marks, Opposer has disclosed (confidentially) financial data relating to its revenues from motorcycle sales and from licensing revenues for t-shirts, other apparel, footwear, eyewear, and juvenile apparel.<sup>13</sup> Apparel revenues are substantial, although revenues from motorcycles are much greater. Opposer's marketing of apparel heavily emphasizes an association between the apparel and Opposer's core product, motorcycles, *i.e.*, promoting the apparel as motorcycle accessories or as particularly suitable for use in motorcycling.

Opposer has also submitted substantial evidence regarding its marketing and promotional activities across all product categories, including its advertising through print, television, radio, direct mail, signs, billboards, and digital media, product placement on television and in films, and sponsorship of sporting events, motorcycle rallies, and other events.<sup>14</sup> The evidence includes figures for advertising expenditures between 2006 and 2016, inclusive.<sup>15</sup> Opposer has conducted advertising campaigns specifically dedicated to its clothing products, including print catalogues for its "Motorclothes," and Opposer has provided voluminous examples of such catalogues issued between 2002 and 2017.<sup>16</sup>

Opposer has also provided information regarding unsolicited/unearned media attention that it has received.<sup>17</sup> Opposer has made of record hundreds of pages of press coverage relating to itself, its goods, and its marks. HARLEY-DAVIDSON has been referred to as "an iconic American brand";<sup>18</sup> a "famous name,"<sup>19</sup> "famous brand,"<sup>20</sup> and "famous trademark."<sup>21</sup> The design form of Opposer's mark has been referred to as a "famous logo."<sup>22</sup> The press notices also show recognition of HARLEY as Opposer's brand, *e.g.* "Harley motorcycles,"<sup>23</sup> "Harley bike,"<sup>24</sup> "Harley hogs,"<sup>25</sup> "Harley engine,"<sup>26</sup> "Harley apparel,"<sup>27</sup> "Harley dealers," "Harley leathers."<sup>28</sup> Opposer's motorcycles are often referred to as "Harleys."<sup>29</sup> Opposer itself is often referred to as "Harley."<sup>30</sup> The press coverage, which issued over a period spanning many decades, demonstrate an extremely high degree of recognition of both HARLEY-DAVIDSON and HARLEY as trademarks and trade names associated with Opposer, as well as the writers' expectation that readers will be familiar with these marks and names and have an interest in reading about them. We find the evidence of record sufficient to persuade us that Opposer's marks HARLEY-DAVIDSON and HARLEY enjoy a high degree of fame in the United States market. The fame of Opposer's marks enhances the likelihood that customers would perceive a trademark similar to HARLEY or HARLEY-DAVIDSON as being associated with Opposer.

#### E. The goods.

\*7 We turn next to the similarity or dissimilarity of the goods at issue, as identified in the Applicant's application and Opposer's pleaded registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Comparing first Applicant's goods to the goods for which Opposer has registered its HARLEY mark in standard character form, we see that the application and one or more of the pleaded registrations cover "shirts," "tank tops," and "boots"; that Applicant's "shirts" are identified with sufficient breadth to include within their scope Opposer's more narrowly identified "tee shirts" and "children's shirts"; and that Opposer's boots are identified with sufficient breadth to include within their scope Applicant's more narrowly identified "motorcycle boots." Therefore, Applicant's goods are, in part, identical or legally identical to goods for which Opposer has registered its mark HARLEY.

Comparing next Applicant's goods to the goods for which Opposer has registered its HARLEY-DAVIDSON mark in standard character form, we see that the application and one or more of the pleaded registrations cover "neckties," "hats,"

“caps,” “jackets,” “boots,” “shirts,” and “underwear”; that Opposer’s “rain coats” are essentially identical to Applicant’s “rain slickers”; and that Opposer’s “shorts,” “tank tops,” “socks,” “pants,” “boots,” and “rain suits” are identified with sufficient breadth to include within their scope Applicant’s more narrowly identified “boy shorts,” “tank tops for sports,” “dress socks for men,” “motorcyclists pants,” “motorcycle boots,” and “rain suits for motorcyclists.” Therefore, Applicant’s goods are, in part, identical or legally identical to goods for which Opposer has registered its mark HARLEY-DAVIDSON.

We need not consider whether each of Applicant’s identified goods is related to Opposer’s goods; for purposes of a *du Pont* analysis, it is sufficient if likelihood of confusion is found with respect to any of Applicant’s goods in a given International Class. See *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007). In sum, we find that the *du Pont* factor of the similarity or dissimilarity of the goods favors a finding of likelihood of confusion.

#### F. Trade channels; customers.

The parties’ goods are, in part, identical or legally identical. With respect to those identical goods, we must presume that the channels of trade and classes of customers are the same. See *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). See also *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). The customers for clothing items include ordinary consumers who have no particular sophistication and who would exercise only an ordinary degree of care in selecting the goods; and we must base our analysis “on the least sophisticated potential purchasers.” *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 (internal quotation marks omitted). The *du Pont* factors relating to trade channels and customers favor a finding of likelihood of confusion.

#### G. The marks.

\*8 Next we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test 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.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748, quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). While we consider each mark in its entirety, 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 that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “Indeed, this type of analysis appears to be unavoidable.” *Id.*

We will first compare Applicant’s mark to Opposer’s mark HARLEY, in standard characters. The initial component of Applicant’s mark is HARLIE, in stylized form, which is essentially identical in sound to the entirety of Opposer’s mark. HARLIE is also, in part, visually similar to HARLEY inasmuch as both terms share the letters HARL and E, in the same order. The stylized lettering of Applicant’s mark and the additional term CHARPER are points of difference in appearance as compared to Opposer’s mark. We generally give less weight to the stylization of a mark than to its wording, because the wording would be used by consumers to request the goods. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). See also *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation’s Food Serv., Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Moreover, Opposer’s mark is registered in standard character form, such that it is not limited to any particular form of display, and could be displayed in stylized letters that resemble those of Applicant’s mark. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); see also *In re i.am.symbolic*, 123 USPQ2d at 1748. Indeed, the record shows that Opposer has sometimes displayed its marks in exuberant script styles that somewhat resemble the cursive script of Applicant’s mark:



*Things Are Different On A Harley.* 33

31

32

33

\*9 In terms of the meanings of the marks, HARLEY is likely to be perceived as a proper name, either a given name or a surname. HARLIE, too, because of its pronunciation, is likely to be perceived as a proper name, although evidence of such a significance is lacking in the record. CHARPER, the second term in Applicant's mark, is an unusual term: there is no evidence that this term has any meaning, but viewed in the context of the mark as a whole, HARLIE CHARPER is likely to be perceived as a personal name. Overall, the CHARPER element of Applicant's mark is a point of difference with respect to the appearance, sound, and meanings of the two marks.

The overall commercial impressions created by the two marks are similar in part with respect to appearance, sound, and meaning. To the extent of these similarities, the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

Turning to a comparison of Applicant's mark with Opposer's other standard character mark, HARLEY-DAVIDSON, we note again the similarities in appearance, sound, and meaning between the marks' initial components HARLIE and HARLEY, while also noting the distinction created by the stylized lettering of Applicants' mark. The respective, second components of the marks, CHARPER (in stylized letters) and -DAVIDSON are quite different in appearance and sound. In

terms of meaning or connotation, both CHARPER and -DAVIDSON are likely to be perceived as personal names. The two marks, considered in their entirety, both give the overall impression of a combination of two personal names; moreover, the two marks commence with phonetically identical names, HARLIE and HARLEY. Although the marks have notable differences and are similar only in part, to the extent of their similarities the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

#### H. Balancing the factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The parties' goods are, in part, identical or legally identical. These goods would be offered to the same classes of customers through the same channels of trade. The customers are ordinary consumers who would exercise only ordinary care in selecting the goods, and there is no evidence suggesting that any particular conditions of sale would affect the likelihood of confusion. The marks are partly similar in appearance, sound, and meaning. In commercial impression, the marks all suggest personal names or the combination of personal names, beginning with HARLEY or HARLIE. Giving due regard to the differences between the marks, we nonetheless bear in mind that when identical goods are at issue, the degree of similarity of the marks that is necessary to find a likelihood of confusion is not as great as where the goods are disparate. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, we have found HARLEY and HARLEY-DAVIDSON to be famous, at least with respect to apparel related to motorcycles or motorcycling. A famous mark "casts a long shadow which competitors must avoid." *Bose v. QSC*, 63 USPQ2d at 1305. See also *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456 ("[T]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark."). Famous marks are given a broad scope of protection "because of the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any resemblance thereto." *R. J. Reynolds Tobacco Co. v. R. Seeling & Hille*, 201 USPQ 856, 860 (TTAB 1978). We find that the similarity between the designations HARLEY and HARLIE outweighs the differences between the marks and renders confusion likely. Accordingly, we **SUSTAIN** the opposition on the basis of Opposer's claim under Section 2(d).

**\*10** Inasmuch as we have determined that registration of Applicant's mark should be refused on grounds of likelihood of confusion, we need not and do not reach Opposer's claim of dilution.

**Decision:** The opposition is **SUSTAINED** on Opposer's claim of likelihood of confusion under Section 2(d).

#### Footnotes

<sup>1</sup> Application Serial No. No. 79160951 was filed on January 7, 2015 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1236951 dated January 7, 2015, with a priority filing date of August 8, 2014. The mark consists of the wording HARLIE CHARPER in stylized, cursive script. Color is not claimed as a feature of the mark. The application includes a statement that HARLIE CHARPER does not identify a living individual.

<sup>2</sup> Answer ¶¶ 13, 18, 24, 25, 27, 30, and 32, 8 TTABVue 3-6.

<sup>3</sup> *Id.* ¶ 13, 8 TTABVue 3.

<sup>4</sup> *Id.* ¶ 30, 8 TTABVue 6.

<sup>5</sup> *Id.*, Amplifying Denials ¶ 1, 8 TTABVue 7.

<sup>6</sup> 14 TTABVUE. Opposer also demonstrated its ownership of 13 other subsisting registrations, which are of record.

<sup>7</sup> *See, e.g.*, Bischmann dec. ¶¶ 25, 27-28, 31 TTABVUE 16-17; and 57-61 TTABVUE (clothing catalogues).

<sup>8</sup> Opposer’s brief at 38, 80 TTABVUE 45.

<sup>9</sup> Answer ¶ 32, 8 TTABVUE 6.

<sup>10</sup> Bischmann dec. ¶ 12, 31 TTABVUE 4-5.

<sup>11</sup> *Id.* at ¶ 20, 31 TTABVUE 6.

<sup>12</sup> *Id.* ¶¶ 22, 24-25, 28, 30-31, 31 TTABVUE 7-17.

<sup>13</sup> *Id.* ¶¶ 84-86, 31 TTABVUE 44-46, and Exhibit 55, 73 TTABVUE 55.

<sup>14</sup> *Id.* ¶¶ 42-79, 31 TTABVUE 27-42.

<sup>15</sup> 73 TTABVUE 4. The figures include a breakout of costs for Opposer’s “Motorclothes Catalogue.”

<sup>16</sup> 53-61 TTABVUE.

<sup>17</sup> Bischmann dec. ¶ 80-81, 31 TTABVUE 43, and Exhibit 54, 73 TTABVUE 6-53.

<sup>18</sup> 78 TTABVUE 34; *see also* 78 TTABVUE 25, 44, 58.

<sup>19</sup> *See* 78 TTABVUE 83, 117, 317, 340, 347, 386, 389, 398, 570.

<sup>20</sup> *See* 78 TTABVUE 88, 110, 144, 156, 225, 343, 367, 370, 379, 382.



<sup>21</sup> See 78 TTABVUE 372, 375.

<sup>22</sup> See 78 TTABVUE 65, 73, 170, 321.

<sup>23</sup> 78 TTABVUE 318.

<sup>24</sup> 78 TTABVUE 37.

<sup>25</sup> 78 TTABVUE 76, 380, 471, 491, 498, 560.

<sup>26</sup> 78 TTABVUE 216.

<sup>27</sup> 78 TTABVUE 382.

<sup>28</sup> 78 TTABVUE 453.

<sup>29</sup> 78 TTABVUE 67, 94- 96, 347, 435, 445, 590, 594.

<sup>30</sup> 78 TTABVUE 28, 31, 40, 51, 394, 472, 486, 501.

<sup>31</sup> 58 TTABVUE 72, 88.

<sup>32</sup> 59 TTABVUE 69, 83.

<sup>33</sup> 75 TTABVUE 106.

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2018 WL 1082095 (Trademark Tr. & App. Bd.)

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2017 WL 512756 (Trademark Tr. & App. Bd.)

This Opinion is not a Precedent of the TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

## IN RE POPP

Serial No. 86140200

January 20, 2017

\*1 **Shane M. Popp** of The Law Office of Shane M. Popp for Lisa Popp.

**Paul Ferrer**

Trademark Examining Attorney

Law Office 122

John Lincoski, Managing Attorney

Before **Quinn**, **Wellington** and **Lykos**

Administrative Trademark Judges

Opinion by **Lykos**

Administrative Trademark Judge:

Lisa Popp (“Applicant”) seeks to register on the Principal Register the mark **Stillwater** in standard characters for, as amended, “[c]lothing, namely, women’s shirts, sweatshirts, dresses, pants, and suits” in International Class 25.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant’s mark pursuant to Section 2(d) of the Trademark Act of 1946, [15 U.S.C. § 1052\(d\)](#), on the ground that Applicant’s mark so resembles the registered mark displayed below for “[c]lothing, namely, [m]en’s and [w]omen’s jackets and vests” in International Class 25,<sup>2</sup> that, when used on or in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive.



When the refusal was made final, Applicant appealed and requested reconsideration. The Trademark Examining Attorney maintained the refusal to register and denied the request for reconsideration. Thereafter, the appeal was resumed and is now fully briefed.

For the reasons set forth below, we affirm the Section 2(d) refusal.

### I. Applicable Law

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below (see *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006)) keeping in mind that “each

case must be decided on its own facts, rather than on the basis of any so-called ‘per se’ rule” when clothing items are involved. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1027 (TTAB 1984).

#### A. The Marks

\*2 We commence with the first *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (“*Palm Bay*”) (quoting *du Pont*, 177 USPQ at 567). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“*Stone Lion*”). Rather, we are obliged to consider the marks in their entireties. *Id.* 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.”).

Applicant argues that the involved marks are “quite different in appearance and sound” and offers a side-by-side comparison of the marks in her briefs. See Applicant’s Appeal Brief, pp. 4-6, 7 TTABVUE 5-7. See also Applicant’s Reply Brief, pp. 1-2, 10 TTABVUE 2-3. Applicant contends that the Examining Attorney improperly focused on the element which is identical to both marks (the literal term STILLWATER) while discounting the importance of the disclaimed wording SUPPLY CO. and design in the cited mark. In Applicant’s view, the addition of SUPPLY CO. and the duck design to Registrant’s mark alters the connotation by evoking hunting, sportswear or outdoor apparel. Applicant contends that consumers are less likely to attribute this meaning to her single word mark **Stillwater** for goods limited to women’s clothing.

In urging that we make a side-by-side comparison, Applicant misapprehends the first *du Pont* factor analysis. “The proper test 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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). Furthermore, contrary to Applicant’s assertion, 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 a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161. Keeping these principles in mind, we observe that Applicant’s and Registrant’s marks are comprised, either in whole or in part, of the term STILLWATER which is arbitrary in relation to clothing. See *Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 188 USPQ 105, 106 (CCPA 1975) (“When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion.”). In addition, STILLWATER is the first element in the cited mark, which when coupled with its arbitrary nature, makes it the dominant element. “[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions.” *Palm Bay*, 73 USPQ2d at 1692. See also *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). STILLWATER is also likely to be accorded more weight by consumers because the remaining wording SUPPLY CO. is, at a minimum, descriptive of Registrant’s goods as indicated by the disclaimer. As such, SUPPLY CO. is less likely to make an impact in the minds of consumers. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks). See also *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 753 (Fed. Cir. 1985).

\*3 Likewise, the graphics in the cited mark fail to mitigate the similarities with the applied-for mark. It is an often-recited principle that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. See, e.g., *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). See also *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). Moreover, since the dominant word portion of the cited mark is identical in appearance, sound, connotation, and commercial impression to the entirety of Applicant’s mark, the addition of a design element does not

obviate the similarity of the marks. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Lastly, to argue that the duck design necessarily engenders a connotation excluding women's clothing is unconvincing since women also participate in outdoor recreational and activities, and purchase sportswear.

Thus, when comparing the marks overall, we find that the involved marks are similar in sound, appearance, connotation and commercial impression. In view of the forgoing, the first *du Pont* factor favors a finding that confusion is likely.

## B. The Goods

The next step in our analysis is a comparison of the goods identified in Applicant's application vis-à-vis the goods identified in the cited registration, the second *du Pont* factor. See *Stone Lion*, 110 USPQ2d at 1161; *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective goods need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that goods emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). See also *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. See, e.g., *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

\*4 The Examining Attorney made of record active third-party, used-based registrations showing that the same entity has registered a single mark identifying Applicant's and Registrant's goods or the legal equivalent thereof.<sup>3</sup> By way of illustration, we note the following:<sup>4</sup>

Reg. No. 4501077 for the mark LANY on the Principal Register for "... Dresses; ... Jackets; Pants; Shirts; ... Sweat shirts; ... Vests."

Reg. No. 4501464 for the mark GOALIE MOM on the Principal Register for "Apparel, namely, shirts, pants, jackets ... Vests; ..."

Reg. No. 4842887 for the mark CELERY SEED on the Principal Register for "... Dresses for women; ... Jackets; ... Men's and women's jackets ... vests; ... Women's clothing, namely, shirts, dresses ..."

Reg. No. 4803770 for the mark TREND EMPIRE on the Principal Register for "...Dresses; ... Men's and women's jackets ... vests; Pants; ... Shirts; ... Suits; ... Sweatshirts; ..."

Reg. No. 4831903 for the mark FEEL LIBERATED on the Principal Register for "Clothing, namely, pants ... dresses ... shirts ... sweatshirts ... jackets ... vests ..."

Reg. No. 4822244 for the mark JACOBIE BEVERLY HILLS (stylized) on the Principal Register for "... Dresses for women ...; Men's and women's jackets ... vests; ... women's suits; ... Shirts for women ... Sweatshirts for women..."

Reg. No. 4821894 for the mark GEAR FOR GOALS on the Principal Register for "Clothing, namely, shirts, ... sweatshirts, ... dresses, ... vests, jackets, ... suits, pants, ..."

Reg. No. 4803770 for the mark TREND EMPIRE on the Principal Register for "... Dresses; ... Men's and women's jackets ... vests; Pants; ... Suits; ... Sweatshirts; ..."

Reg. No. 4819837 for the mark FELDSPAR BROOK on the Principal Register for “Clothing, namely, shirts, ... vests, ... jackets, pants, ... sweatshirts, ... dresses, ... women’s suits, ...”

As a general proposition, although use-based third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they may serve to suggest that the goods are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The Examining Attorney also submitted Internet evidence from clothing manufacturers that sell directly to consumers via their own e-commerce websites:

\*5 • Eddie Bauer ([www.eddiebauer.com](http://www.eddiebauer.com)) offering for sale men’s and women’s jackets; men’s and women’s vests; women’s shirts, dresses and skirts; and men’s pants under the Eddie Bauer trademark. *See* Office action dated April 4, 2014.

• GAP ([www.gap.com](http://www.gap.com)) offering for sale women’s jackets, coats and blazers; men’s jacket’s, parkas and zip sweatshirts; women’s and men’s vests; women’s sweaters, dresses, sweatshirts, skirts, khakis, pants, jeans, and shoes; and men’s t-shirts and tank-tops, shirts, sweaters, sweatshirts, jeans, pants shorts, socks and shoes under the GAP trademark. *See* Office action dated April 4, 2014.

• L.L. Bean ([www.llbean.com](http://www.llbean.com)) offering for sale men’s jackets and coats; women’s jackets and coats; men’s and women’s vests; and women’s shirts, fleece tops, sweatshirts, dresses, pants and capris. *See* Office action dated November 5, 2015.

• J. Crew ([www.jcrew.com](http://www.jcrew.com)) offering for sale men’s blazers and vests; men’s jackets; women’s coats, jackets and vests; and women’s shirts, sweatshirts, sweatpants, pants, dresses, and skirts. *See* Office action dated November 5, 2015.

• Brooks Brothers ([www.brooksbrothers.com](http://www.brooksbrothers.com)) offering for sale men’s jackets, coats, and vests; women’s jackets and blazers; women’s shirts, dresses, pants, trousers, skirts, and suits. *See* Office action dated November 5, 2016.

This constitutes further evidence that consumers may expect to find both Applicant’s and Registrant’s goods as identified in the involved application and cited registration as emanating from a common source under a single brand name. Although we acknowledge that these marks may be viewed as house marks, the evidence still demonstrates that the same consumers may encounter the involved goods in the same context. And given that these clothing items could be worn together (for example women’s sweatshirts and women’s jackets), we can conclude that they are complementary products. As such, the involved goods are closely related.

Applicant dismisses the probative value of the website evidence, arguing that it merely shows that clothing is sold at department stores and online which is an insufficient basis for finding the Applicant’s and Registrant’s goods to be related. Applicant overlooks, however, that the Examining Attorney’s website evidence is not from brick and mortar department stores or “big box” online retailers selling a wide variety of goods but rather from clothing manufacturers’ direct-to-consumer sales websites. This targeted type of retailing is narrower in scope, and as such is entitled to a higher degree of probative weight.

In view thereof, we find that the goods identified in the application and registration are closely related and complimentary in nature. Thus, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

### C. Trade Channels

We now direct our attention to the established, likely-to-continue channels of trade, the third *du Pont* factor. Applicant argues that pages from the L.L. Bean, J. Crew, and Brooks Brothers e-commerce websites do not demonstrate confusion as to source because “the sale of the product does not take place in a similar type store or similar type centralized location. Rather, a consumer will view the goods of each entity in a discreet marketing environment.” Appeal Brief, p. 11, 7 TTABVUE 12.

\*6 Because the identifications in the application and cited registration have no restrictions on channels of trade, we must

presume that the goods travel in all channels of trade appropriate for such goods, such as traditional brick and mortar retail stores featuring clothing from a variety of manufacturers under different brand names. *See Octocom*, 16 USPQ2d at 1787. *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”). In addition, both parties’ goods may be encountered by the same prospective consumers, namely women shopping for clothing. As such, the third *du Pont* factor regarding the similarity or dissimilarity of established, likely to continue trade channels also favors a finding of likelihood of confusion.

#### D. Conditions of Sale

We turn now to the conditions under which the goods are likely to be purchased, *e.g.*, whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant argues that the average purchaser of her clothing is “sophisticated in nature and takes the time to carefully select the highest quality goods.” Applicant’s Brief, p. 11, 7 TTABVUE 12. In support thereof, she points to her specimens displaying the mark **Stillwater** on hang tags as well as excerpts from her website of advertising her clothing line as “Style Designed & Made in Los Angeles.”

Applicant’s arguments are unavailing. The identifications in the application and cited registration include women’s apparel items at no specified price point. We cannot assume, as Applicant urges, that these items are rendered to different classes of buyers in different marketing contexts at different prices. Rather, we must assume that the types of buyers overlap to include both the sophisticated fashionista as well as the ordinary bargain hunter. Ordinary consumers of women’s apparel are likely to exercise only ordinary care, and given the lack of price restrictions in the identifications, may even buy inexpensive clothing items on impulse. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”). Accordingly, this factor is neutral as well.

#### E. The Number and Nature of Similar Marks in Use on Similar Goods

\*7 The next *du Pont* factor raised by Applicant is the sixth, the number and nature of similar marks in use on similar goods.<sup>5</sup> As to third-party uses, Applicant sets forth the following argument:

[T]he number and nature of marks in use on similar goods (clothing) is relatively high. That is to say, the general category of goods such as clothing and apparel is supported by a substantial number of marks which sell similar types of goods. Specifically, Applicant asserts that there are over several thousand marks that relate to shirts (both men’s and women’s) and consumers are unlikely to be confused as to source.

(Emphasis in original). Applicant’s Brief, p. 12, 7 TTABVUE 13.

Applicant has introduced no evidence of third-party uses or registrations 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.” *Palm Bay*, 73 USPQ2d at 1694. *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). Indeed, Applicant appears to misunderstand the appropriate evidence for consideration of this *du Pont* factor by arguing that there are literally thousands of *other* trademarks for clothing. Evidence of “ubiquitous” use of the term STILLWATER as a source indicator on clothing by third parties would have been relevant. *See Jack Wolfskin*, 116 USPQ2d at 1136. Accordingly, this factor is neutral.<sup>6</sup>

#### F. Nature and Extent of any Actual Confusion

Applicant points to the absence of evidence of actual confusion, the seventh *du Pont* factor, as weighing in her favor. A showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. The



opposite is not true, however. The lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). The issue before us is the likelihood of confusion, not actual confusion. *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (actual confusion not required). Further, any suggestion that there has been no actual confusion between the marks based on the coexistence of Applicant's mark and the cited registration is entitled to little probative value in the context of an ex parte appeal. *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). Therefore, this *du Pont* factor is neutral.<sup>7</sup>

## G. The Right to Exclude Others and Extent of Potential Confusion

\*8 Lastly we consider the eleventh and twelfth factors as argued by Applicant, the extent to which Applicant has a right to exclude others from use of her mark on her goods, and the potential for confusion, i.e., whether de minimis or substantial.

Applicant argues that without the benefit of a federal registration, she will be foreclosed from requesting U.S. Customs officials from barring the importation of goods bearing infringing marks. Applicant's argument misses the point. This *du Pont* factor pertains to any evidence showing that Applicant has a right to exclude third parties from using her applied-for mark. There is nothing in the record on this issue. See *McDonalds Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1284 (TTAB 2014) ("[T]he mere assertion of common law use does not in itself sufficient to establish the extent to which an applicant has a right to exclude others from use of the mark."); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009) ("Nor does applicant's mere assertion of common-law use of its mark for ten years in itself suffice to establish that applicant has any significant right to exclude others from use of the mark). The eleventh *du Pont* factor is therefore neutral.<sup>8</sup>

With regard to the twelfth *du Pont* factor, we cannot find that it favors Applicant. At issue in this case are clothing items. These are the type of goods that would be marketed to and purchased by significant numbers of purchasers exercising only ordinary care. The potential for confusion therefore cannot be deemed to be de minimis. See *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009). The twelfth *du Pont* factor therefore is neutral, at best.

## II. Conclusion

After considering all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, the first, second and third *du Pont* factors discussed above favor a finding of likelihood of confusion. The remaining factors discussed above are neutral, and we treat as neutral any *du Pont* factors for which there is no evidence of record. We therefore find that given the similarities of the Applicant's and Registrant's marks in connection with highly related goods in overlapping trade channels as identified in the application and cited registration, there is a likelihood of confusion.

*Decision:* The Section 2(d) refusal is affirmed.

## Footnotes

<sup>1</sup> Application Serial No. 86140200, filed December 11, 2013 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). On August 21, 2014, Applicant filed an amendment to allege use and specimens which were accepted on August 28, 2014. The amendment to allege use claims January 1, 2014 as the date of first use anywhere and in commerce.

<sup>2</sup> Registration No. 3334168, issued November 13, 2007 on the Principal Register; alleging October 30, 2006 as the date of first use anywhere and November 10, 2006 as the date of first use in commerce; Section 8 affidavit accepted. The description of the mark is as follows: "The mark consists of Stillwater Supply Co. with a fanciful design of a duck against an oval background." Color is not claimed as a feature of the mark. "SUPPLY CO." has been disclaimed apart from the mark as shown.

<sup>3</sup> By this we mean that an identification listing "jackets" as unrestricted necessarily encompasses both men's and women's jackets.

- <sup>4</sup> We have not considered any third-party registrations not based on use in U.S. interstate commerce. *In re I<sup>st</sup> USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007).
- <sup>5</sup> Applicant also argues that the cited mark is inherently weak due to the disclaimer of the wording SUPPLY CO. and therefore entitled to only a limited scope of protection. “In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.” *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011) (citing *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) and *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2011) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”)). We cannot find, based solely on the disclaimed wording, that Registrant’s mark as a whole is inherently weak. The cited mark is registered on the Principal Register, meaning there is no basis for us to conclude that STILLWATER is descriptive or generic when applied to clothing. Moreover, as explained in the context of the similarity of the marks, *infra*, the disclaimer Applicant references is actually a factor that increases the similarity of the marks and, ultimately, a likelihood of confusion.
- <sup>6</sup> Applicant identifies the fifth and sixth *du Pont* factors as “overlapping issues” and “merges” their discussion in her brief. Applicant’s Brief, p. 11, 7 TTABVUE 12. The fifth *du Pont* factor pertains to the fame of the cited mark. As is typical of trademark examination practice, the Examining Attorney in this case did not introduce any evidence regarding the fame of the cited mark during prosecution. *See* Trademark Manual of Examining Procedure (“TMEP”) § 1207.01(d)(ix) (Oct. 2016) (“Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the examining attorney to submit evidence as to the fame of the cited mark in an ex parte proceeding.”) (citing *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). This factor is therefore neutral. *See id.*
- <sup>7</sup> As with the fifth and sixth *du Pont* factors, Applicant identifies the seventh, eighth, ninth and tenth factors as “related” and “merges” their discussion in her brief but only offers specifics regarding the seventh factor (lack of actual confusion). Applicant’s Brief, p. 12, 7 TTABVUE 13. As such, we deem *du Pont* factors 8-10 neutral.
- <sup>8</sup> One prominent commentator suggests that if the other *du Pont* factors indicate that there is a likelihood of confusion, the strength of an applicant or registrant’s rights vis-a-vis third parties should be irrelevant. 4 J. Thomas McCarthy, *McCarthy On Trademarks And Unfair Competition* § 24:43 (4<sup>th</sup> ed. 2016).

2020 WL 859854 (Trademark Tr. & App. Bd.)

This Opinion Is Not A Precedent Of The TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

MIXNET CORPORATION  
v.  
TOMEKA HARRIS AND CHAN'DRIEKA MORRISON

Cancellation No. 92067984

February 19, 2020

\*[1 Eric J. Menhart](#) of Lexero Law Firm, for Mixnet Corporation.

[James T. Hollin, Jr.](#) of J.T. Hollin, Attorney at Law, P.C., for Tomeka Harris and Chan'Drieka Morrison.

Before [Cataldo](#), [Ritchie](#), and Coggins

Administrative Trademark Judges

Opinion by Coggins

Administrative Trademark Judge:

Tomeka Harris and Chan'Drieka Morrison (collectively "Respondents") own a Principal Register registration for the mark



(with SOLUTIONS disclaimed) for "income tax consultation; income tax preparation; tax advisory services; tax and taxation planning, advice, information and consultancy services; tax filing services," in International Class 35.<sup>1</sup>

In its petition for cancellation, Mixnet Corporation ("Petitioner") seeks cancellation of Respondents' registration under Trademark Act Section 2(d), [15 U.S.C. § 1052\(d\)](#), on the basis of likelihood of confusion with its prior common law use of the mark TAXPERT since December 2014 with "the provision and advertising of tax preparation services."<sup>2</sup> Petitioner also alleges that Respondents' registration was cited as a bar to registration of Petitioner's pending application Serial No. 87190128 for the mark TAXPERT.<sup>3</sup>

In their answer, Respondents admit that Petitioner's pleaded application was refused registration under Section 2(d) based on Respondents' registration,<sup>4</sup> and deny the remaining salient allegations in the petition for cancellation.<sup>5</sup> As noted below, only Petitioner filed a brief. For the reasons discussed herein, we grant the petition.

#### I. Procedural Issues

Before proceeding to the merits of the petition, we address procedural and evidentiary matters.

Petitioner timely filed a brief. Respondents' brief on the case was due Saturday, August 17, 2019.<sup>6</sup> [Trademark Rule 2.128\(a\)](#), [37 C.F.R. § 2.128\(a\)](#). On Sunday, August 18, 2019, Respondents submitted a motion for a one-day extension of time to file their brief, accompanied by the declaration of their counsel and what appears to be a copy of the specimen from Petitioner's



pleaded application. Although the certificate of service for the motion to extend indicates that a final brief on the case accompanied the motion, no brief accompanied that motion. In fact, no brief was ever filed. Pursuant to [Trademark Rule 2.196](#), 37 C.F.R. § 2.196, when the last day for taking an action falls on a Saturday, Sunday, or federal holiday, the action may be taken on the next succeeding day that is not a Saturday, Sunday, or holiday. *See also* 35 U.S.C. §21(b). Therefore, Respondents could have filed their brief until Monday, August 19, 2019, without the need to file a motion.

\*2 To the extent Respondents sought a one-day extension until Monday, August 19, 2019, (or perhaps even mistakenly thought they needed to reopen the time by one day, until Sunday, August 18, 2019, in view of the technical deadline of Saturday, August 18th) in which to file their main brief on the case, the motion was unnecessary and is moot in view of [Trademark Rule 2.196](#). To the extent Respondents attached to their motion what appears to be a copy of the specimen from Petitioner's pleaded application, that document is already in evidence as part of Exhibit 6 to Petitioner's testimonial declaration, *see* 8 TTABVUE 32, and was unnecessary. *See Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1092 (TTAB 2012) (not necessary to submit duplicates of material that is already in record). Similarly, inasmuch as the attachment appears to be a duplicate of evidence Petitioner itself entered into the record, Petitioner's September 3, 2019 motion to strike the document was unnecessary and is hereby denied.

## II. The Record

The record includes the pleadings and, by operation of [Trademark Rule 2.122\(b\)\(1\)](#), 37 C.F.R. § 2.122(b)(1), the file for the challenged registration. In addition, Petitioner submitted the following:

- Testimony declaration of Arnold Thielen, general manager of Petitioner; and exhibits thereto, consisting of:
  - Archived screenshots of the taxpert.com website
  - Current screenshot of the taxpert.com website
  - Invoice from Acquisio
  - Summary from Google Ads
  - Invoices from Croma Technolabs
  - File of pleaded application Serial No. 87190128
  - File of application underlying Registration No. 5120567
  - Screenshot of Respondents' Facebook page
  - Screenshot from Morrison Accounting website
  - Google search hit list
  - Screenshot from IRS website
  - Screenshot from Clayton County, Georgia court case inquiry.<sup>7</sup>
- Notice of Reliance on Respondent Tomeka Harris' responses to Petitioner's first set of interrogatories.<sup>8</sup>
- Notice of Reliance on Respondents' Answer and duplicates of several of the same documents submitted with Mr. Thielen's declaration.<sup>9</sup> Respondents did not submit any testimony or evidence.<sup>10</sup>

## III. Standing

Standing is a threshold issue that must be proven in every inter partes case. See *Empresa Cubana del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish standing in an inter partes proceeding, Petitioner must show both “a real interest in the proceedings as well as a ‘reasonable’ basis for [its] belief of damage.” See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Id.* at 1026.

\*3 Petitioner introduced evidence that its pleaded application Serial No. 87190128 has been refused registration based on an asserted likelihood of confusion with the mark in Respondents’ Registration No. 5120567, see 7 TTABVUE 34-39, and Respondents admitted this circumstance in their answer to the petition, see 5 TTABVUE 3. This suffices to show that Petitioner has a real interest in this proceeding and a reasonable basis for its belief of damage, and, therefore, has standing. See *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“[T]o have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant’s] registration”); see also *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (evidence of petitioner’s pending application refused registration based on respondent’s registration sufficient to establish standing).

#### IV. Priority

“A party claiming prior use of a registered mark may petition to cancel the registration on the basis of such prior use pursuant to section 14 of the Lanham Act. 15 U.S.C. Section 1064.” *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994). However, “a presumption of validity attaches to” Respondents’ involved registration, and Petitioner, the alleged prior user, bears the burden of proving its claim of priority by a preponderance of the evidence. *Id.*; *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1105-06 (TTAB 2007).

“To establish priority, the petitioner must show proprietary rights in the mark that produce a likelihood of confusion. These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (internal citations omitted).

In the absence of evidence establishing earlier use of its mark, a party may rely for priority purposes on the filing date of the application that matured into its registration. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c); see also *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1283-84 (TTAB 1998); *Am. Standard Inc. v. AQM Corp.*, 208 USPQ 840, 842 (TTAB 1980). Because Respondents did not introduce any testimony or other evidence, the earliest date on which they may rely for priority is September 22, 2015, the filing date for the application underlying their registration.

\*4 Petitioner’s general manager Arnold Thielen testified that Petitioner has owned, operated, and continually maintained the website taxpert.com offering tax preparation software and services since December 15, 2014;<sup>11</sup> and “has expended substantial time, money, and resources developing, marketing, advertising, and promoting tax preparation services under the TAXPERT Mark.”<sup>12</sup> To corroborate his testimony regarding priority, Mr. Thielen authenticated several archival webpages from taxpert.com which Petitioner introduced through notice of reliance and also attached as Exhibit 1 to the declaration.<sup>13</sup> Two of the webpages (dated January 1 and March 11, 2015) were archived earlier than Respondents’ September 22, 2015 filing date.<sup>14</sup> In view thereof, Petitioner has proven through uncontroverted testimony and evidence, when taken as a whole, that it has priority for the mark TAXPERT for income tax preparation services.

#### V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant or for which there is argument or evidence of record.<sup>15</sup> See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

“[E]ach 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) (internal citations removed). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations in most cases are the similarities between the marks and the similarities between the goods or services, the first two *DuPont* factors. 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 [or services] 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, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1380)).

#### A. Second *DuPont* factor

\*5 We begin by considering the second *DuPont* factor which pertains to the similarity or dissimilarity of the services. *DuPont*, 177 USPQ at 567. Where, as here, Petitioner is relying upon common law use of its mark, consideration of the question of likelihood of confusion must be confined to the specific services on which the mark has been used. Petitioner has shown use of its pleaded mark for income tax preparation services.

Respondents’ services identified in the involved registration are “income tax consultation; income tax preparation; tax advisory services; tax and taxation planning, advice, information and consultancy services; tax filing services.”

The parties’ services are identical in part. The fact that one of the services listed in the involved registration (i.e., “income tax preparation”) is identical to Petitioner’s service is sufficient to support a finding that there is a likelihood of confusion. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 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 items that come within the identification of goods in the application). Because Respondent’s services are identical in part to Petitioner’s service, the second *DuPont* factor favors a finding of a likelihood of confusion.

#### B. Third and Fourth *DuPont* factors

We next consider the third *DuPont* factor involving the established and likely-to-continue channels of trade. *DuPont*, 177 USPQ at 567. Because Petitioner relies on its common-law rights, for the purposes of this analysis Petitioner can claim only those channels of trade and classes of consumers which it has established on the record. We cannot rely on a presumption that because the services are identical in part they move in the same channels of trade. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (no presumptions attach to unregistered common law mark).

Mr. Thielen testified that Petitioner uses digital marketing online and offers its services at taxpert.com.<sup>16</sup> Because the identification in the involved registration has no restrictions on channels of trade, or classes of consumers, we must presume that Respondents’ services travel in all channels of trade appropriate for such services, and to all usual purchasers of them, which necessarily includes Petitioner’s actual channels of trade and classes of consumers for the identical in part services. *Bell’s Brewery*, 125 USPQ2d at 1345; Cf. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Accordingly, the third *DuPont* factor favors a finding of likelihood of confusion.

\*6 The fourth *DuPont* factor considers conditions under which and buyers to whom sales are made, e.g., whether the services are purchased on impulse or after careful consideration, as well as the degree, if any, of sophistication of the potential purchasers. *DuPont*, 177 USPQ at 567. There is no evidence of record on the purchasing process for tax preparation services or any evidence of purchaser sophistication. Petitioner’s website indicates that consumers may be able to use Petitioner’s “basic” tax preparation service for free.<sup>17</sup> When considering that relevant customers would include ordinary consumers using an ordinary degree of care we find the fourth *DuPont* factor is neutral.

C. Fifth *DuPont* Factor

Before we turn to the similarity of the marks (i.e., the first *DuPont* factor), we consider the strength of Petitioner's mark, as that will affect the scope of protection to which it is entitled.

The fifth *DuPont* factor requires consideration of the fame of Petitioner's mark. *DuPont*, 177 USPQ at 567. The strength of a mark under the fifth *DuPont* factor 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)). This factor involves assessing the mark "along a spectrum from very strong to very weak." *Id.* (internal citations omitted). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. See *Palm Bay Imps.*, 73 USPQ2d at 1694 (strong marks "enjoy wide latitude of legal protection" and are "more attractive as targets for would-be copyists"). In determining fame, or the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Bell's Brewery*, 125 USPQ2d at 1345.

There is no evidence in the record as to the conceptual strength of Petitioner's TAXPERT mark. We note, however, that the mark is a portmanteau of "tax" and "expert" - two words which, by themselves, are descriptive of Petitioner's services.<sup>18</sup>

\*7 The commercial strength of a mark may be measured indirectly by the volume of sales and advertising expenditures in connection with the services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the services identified by the marks; and the general reputation of the services. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); see also *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). Mr. Thielen testified that Petitioner spent \$15,000 to optimize its digital search campaign, and spent "tens of thousands of dollars promoting" its website taxpert.com via online marketing such as Google Ads.<sup>19</sup> He also stated that Petitioner has "grown the traffic and profile of" its taxpert.com website over the years of its operation<sup>20</sup> and provided evidence of over 10,000 clicks to taxpert.com from its overall online advertising. In addition, Petitioner argues that use of the mark since 2014 has contributed to "at least some degree of recognition and strength in the market for tax preparation" services.<sup>21</sup>

Petitioner provides no context for any of its advertising, traffic, or website maintenance numbers, and appears to conflate advertising of the services under the mark TAXPERT with promotion, operation, and maintenance of its website in general. Similarly, there is no evidence as to Petitioner's sales or how many of the advertising clicks translated into purchase of Petitioner's services. On balance we find that Petitioner's mark falls in the middle of the spectrum from very strong to very weak, and we accord Petitioner's mark the normal scope of protection; therefore, the fifth *DuPont* factor is neutral.

D. First *DuPont* factor

We compare the marks "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We also bear in mind that, given the in part identical services, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the services at issue are income tax preparation services, the average purchaser is an ordinary person who must file federal or state income tax returns.

\*8 Respondents' mark is



. Petitioner's mark is TAXPERT. The marks are similar in sound, appearance, meaning, and commercial impression to the extent that each contains the identical coined term TAXPERT. Respondents' mark fully incorporates Petitioner's mark TAXPERT and contains the additional letters TP and the descriptive (and disclaimed) term "solutions."

"[T]he presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (finding ML in standard characters confusingly similar to ML MARK LEES in stylized form). *Cf. Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (finding STONE LION CAPITAL confusingly similar to LION and LION CAPITAL); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN likely to be confused with TITAN). We recognize that the initials TP are a large element of Respondents' mark, which also contains the non-distinctive term "solutions." Nonetheless, in this case Respondents' TP merely reinforces the commercial impression of the mark as TAXPERT because that middle term in the mark is presented with a capital T and P.

Based upon the foregoing, we find Respondents' composite mark



is more similar to than dissimilar from Petitioner's TAXPERT mark in appearance, sound, and connotation and, overall creates a similar commercial impression. The marks appear to be variations of each other that suggest a single source, pointing to a tax expert. Overall, the first *DuPont* factor favors a finding of a likelihood of confusion.

#### E. Twelfth *DuPont* factor

Petitioner argues that the twelfth factor, the extent of potential confusion, *DuPont*, 177 USPQ at 567, weighs in its favor because "the potential for confusion between the two trademarks is substantial."<sup>22</sup> Petitioner's arguments about the similarity of the services, channels of trade, consumers, and marks are essentially a reargument of the first, second, third, and fourth *DuPont* factors. Nonetheless, we agree to the extent that because we have found that the services are in-part identical and are offered under similar marks containing or comprised of the same portmanteau TAXPERT and are of the type that would be marketed to and purchased by the same consumers, the potential for confusion cannot be deemed de minimis. Accordingly, the twelfth *DuPont* factor favors Petitioner.

#### F. Conclusion on likelihood of confusion

\*9 We have considered all of the evidence of record and all of the arguments presented as they pertain to the relevant *DuPont* likelihood of confusion factors. We find by a preponderance of the evidence that Petitioner has established prior trademark rights in its TAXPERT mark in the United States; and that first, second, third, and twelfth *DuPont* factors weigh in favor of a finding of likelihood of confusion, while the other *DuPont* factors are neutral. We therefore find that Respondents' mark



, as used in connection with the services identified in the registration, so resembles Petitioner’s mark TAXPERT as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

#### VI. Decision

The petition to cancel is granted.

#### Footnotes

<sup>1</sup> Registration No. 5120567, issued January 10, 2017, from an application (serial no. 86764042) filed September 22, 2015, and claiming September 1, 2016 as the date of first use anywhere and the date of first use in commerce. The registration contains the following statement: “The mark consists of the capital letters ‘T’ and ‘P’ joined by an upper horizontal bar, with the word ‘TaxPert’ written directly below on a second line of print and the word ‘Solutions’ written horizontally on a third line of print.” Color is not claimed as a feature of the mark.

<sup>2</sup> Petition, ¶ 21 (1 TTABVUE 5).

<sup>3</sup> *Id.*, ¶¶ 8 and 12 (1 TTABVUE 4).

<sup>4</sup> Answer, ¶¶ 8 and 12 (5 TTABVUE 3).

<sup>5</sup> The only valid affirmative defense in Respondents’ answer is “failure to state a claim,” which was not pursued at trial and has been waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014). Similarly, as the Board explained shortly after the answer was filed, *see* 6 TTABVUE, Respondents’ purported “counterclaim” has been given no consideration.

<sup>6</sup> 2 TTABVUE 3 (trial schedule).

<sup>7</sup> 8 TTABVUE.

<sup>8</sup> 7 TTABVUE 164-172.

<sup>9</sup> 7 TTABVUE 6-163.

<sup>10</sup> Although Respondents filed a notice of reliance purporting to introduce various documents, discovery responses, and the



declaration of Arnold Thielen, *see* 10 TTABVUE 2-3, no such discovery, documents, or declaration was submitted with the notice of reliance. However, as to Respondents' reference to the application underlying the challenged registration, as noted above, the file for the challenged registration is automatically of record; and as to Respondents' reference to Petitioner's pleaded application, and the declaration of Mr. Thielen, "[w]hen evidence has been made of record by one party in accordance with [the Trademark Rules] it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence." [Trademark Rule 2.122\(a\)](#), [37 C.F.R. § 2.122\(a\)](#). We consider all of the evidence of record for such probative value as it may have. Even if Respondents had made additional material of record, it is difficult to see how the outcome of this proceeding would have changed.

11 Thielen Dec., ¶¶ 7, 10-12, 16 (8 TTABVUE 3-4).

12 *Id.*, ¶ 17 (8 TTABVUE 4).

13 8 TTABVUE 4 (declaration ¶¶ 12-16); 7 TTABVUE 6-14 and 8 TTABVUE 10-18 (screen shots).

14 8 TTABVUE 10 and 11.

15 We address the factors for which there is evidence and substantive argument; but, we need not address those factors Petitioner threw in its brief to merely announce they are "irrelevant."

16 Thielen Dec., ¶¶ 18-20, 16 (8 TTABVUE 4).

17 Thielen Dec., Exhibit 2 (8 TTABVUE 19).

18 We take judicial notice that "tax" means "a charge usually of money imposed by authority on persons or property for public purposes," and "expert" means "one with the special skill or knowledge representing mastery of a particular subject." Merriam-Webster.com at <https://www.merriam-webster.com/dictionary/tax> and /expert (last visited February 12, 2020). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

19 Thielen Dec., ¶¶ 19-20 (8 TTABVUE 4).

20 *Id.*, ¶ 24 (8 TTABVUE 5).

21 Brief, p. 18 (11 TTABVUE 23).

<sup>22</sup> Brief, p. 19 (11 TTABVUE 24).

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2020 WL 859854 (Trademark Tr. & App. Bd.)

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This Opinion is Not a  
Precedent of the TTAB

Mailed: March 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Sun Bum LLC*

*v.*

*Health Bomb LLC*

Opposition No. 91264019

Karl T. Ondersma, Terence J. Linn, and Zakary S. McLennan of Gardner, Linn,  
Burkhart & Ondersma for Sun Bum LLC.

Amanda Milgrom and Lindsey J. Brown of Milgrom & Daskam for Health Bomb  
LLC.

Before Zervas, Wellington, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Health Bomb LLC (“Applicant”) seeks registration on the Principal Register of the  
standard-character mark SKI BUM for “Face creams, non-medicated face serum” in  
International Class 3.<sup>1</sup>

<sup>1</sup> Application Serial No. 88802495 was filed on February 19, 2020 under Section 1(b) of the  
Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention  
to use the mark in commerce in connection with the goods identified in the application.

Sun Bum LLC (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that SKI BUM so resembles Opposer’s registered and alleged common-law marks SUN BUM, BABY BUM, and TRUST THE BUM for various goods as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

The case is fully briefed.<sup>2</sup> We sustain the opposition.

## **I. Record**

The parties “stipulate[d] to final disposition of this proceeding on the merits via Accelerated Case Resolution (‘ACR’) subject to the approval of the Trademark Trial and Appeal Board (‘Board’).” 11 TTABVUE 2. The parties’ ACR Stipulation set forth detailed provisions regarding the quantity and nature of evidence that each party could submit, and an agreed-upon trial schedule. *Id.* at 2-4. Following a conference with the parties to discuss the use of ACR, the Board approved the ACR Stipulation. 12 TTABVUE 1.<sup>3</sup>

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<sup>2</sup> Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. The TTABVUE page numbers do not correspond to the numbered pages in briefs and other numbered docket entries. The parties designated portions of their briefs as “Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)” under the Board’s Standard Protective Order. Opposer’s redacted main brief appears at 34 TTABVUE and its redacted reply brief appears at 39 TTABVUE. Applicant’s redacted brief appears at 36 TTABVUE.

<sup>3</sup> We commend the parties and their counsel for their cooperation in using ACR to resolve this case, which obviated the need to consider evidentiary issues, facilitated our review of an extensive record, and enabled the Board to focus on the merits of the case.

Pursuant to the parties' ACR Stipulation, the record consists of the pleadings,<sup>4</sup> the Declaration of Dustin Smith, Opposer's International Account & Training Manager, and Exhibits A1-A39 thereto ("Smith Declaration" or "Smith Decl."), 13-15 TTABVUE;<sup>5</sup> Opposer's Revised Submission of Exhibits B1-B19 pursuant to paragraph 4 of the ACR Stipulation, 25 TTABVUE 1-314;<sup>6</sup> the Declaration of Ayssa DiPietro, Applicant's founder and owner, and Exhibits 1-19 thereto ("DiPietro Declaration" or "DiPietro Decl."), 22 TTABVUE 1-205;<sup>7</sup> Applicant's Submission of Exhibits 1-67 pursuant to paragraph 4 of the ACR Stipulation, 20 TTABVUE 1-320;<sup>8</sup> the cross-examination deposition of Mr. Smith and exhibits thereto, taken pursuant

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<sup>4</sup> Applicant denied the material allegations of Opposer's Notice of Opposition and did not interpose any cognizable affirmative defenses. 4 TTABVUE 2-4.

<sup>5</sup> Opposer designated certain portions of the Smith Declaration as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the Smith Declaration and Exhibits at 13-15 TTABVUE. We will cite the Smith Declaration by paragraph and exhibit number (e.g., "Smith Decl. ¶ 6; Ex. A1") as well as by TTABVUE pages.

<sup>6</sup> Paragraph 4 of the ACR Stipulation provides in pertinent part that "each party shall submit by filing with the TTAB any documents or discovery responses they wish to rely on during the Evidentiary Period, without the need for accompanying testimony." 11 TTABVUE 2-3. Opposer initially submitted Exhibits 1-67 at 17 TTABVUE 1-196, but later filed an uncontested motion to allow it to submit Revised Exhibits containing status copies of Opposer's registrations in Exhibits B1-B5 and B8-B14, and a statement pursuant to Trademark Rule 2.122(g). 24 TTABVUE 2. The Board granted the motion. 27 TTABVUE 1.

<sup>7</sup> Applicant designated certain portions of the DiPietro Declaration as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the DiPietro Declaration and Exhibits at 22 TTABVUE. We will cite the DiPietro Declaration in the same manner as the Smith Declaration.

<sup>8</sup> Applicant designated certain portions of its Notice of Reliance as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the Notice at 20 TTABVUE.

to paragraph 5 of the ACR Stipulation, 26 TTABVUE 1-117;<sup>9</sup> and the parties' Stipulation of Facts ("Stipulation" or "Stip."). 30 TTABVUE 1-7.<sup>10</sup>

## **II. The Parties' Marks and Businesses<sup>11</sup>**

### **Opposer**

Opposer has its headquarters in Encinitas, California and has a second facility in Cocoa Beach, Florida. Smith Decl. ¶ 1. Opposer produces and markets goods in five general categories described as "Sun," "Lifestyle," "Hair," "Baby," and "Lip." Smith Decl. ¶ 5 (13 TTABVUE 4).

The "Sun" category includes skin care products such as sunscreen lotions and sprays, aloe lotions and sprays, and browning lotions sold under the SUN BUM word and composite marks discussed below. Smith Decl. ¶ 5 (13 TTABVUE 4).<sup>12</sup> The "Lifestyle" category includes apparel, towels, toy figures, beach flyers, paddleball sets, footballs, water balls, and umbrellas sold under the SUN BUM word and composite marks. Smith Decl. ¶ 5 (13 TTABVUE 4). The "Hair" category includes shampoo, hair lighteners and toners, conditions, hair mists, sprays and detanglers,

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<sup>9</sup> We will cite the Smith cross-examination transcript by page and line numbers and by exhibit numbers (e.g., "Smith Tr. 16:14-20; Ex. 1") as well as by TTABVUE pages.

<sup>10</sup> We will cite the Stipulation by paragraph number (e.g., "Stip. ¶ 2") as well as by TTABVUE pages. The Stipulation pertains to the parties' ownership of various registrations and applications for registration. The parties stipulated that all of their respective registrations are subsisting. Stip. ¶¶ 2-14.

<sup>11</sup> In this section, we set forth general findings regarding the parties and their marks and businesses. We make additional findings in Section IV below in connection with specific issues on Opposer's likelihood of confusion claim.

<sup>12</sup> Mr. Smith testified on cross-examination that this category also includes towelettes. Smith Tr. 26:11-14 (26 TTABVUE 28).

enhancers, oils, protectors, hair masks, and combs sold under the SUN BUM word and composite marks. Smith Decl. ¶ 5 (13 TTABVUE 4). The “Baby” category includes branded lotions, creams, shampoos and washers, hand sanitizer, sunscreens, detangler, balm, bubble bath, and bath and beach toys sold under the BABY BUM word and composite marks discussed below. Smith Decl. ¶ 5 (13 TTABVUE 4). The “Lip” category includes lip balm, sunscreen lip balm, and tinted lip balm products sold under the SUN BUM marks. Smith Decl. ¶ 5 (13 TTABVUE 4). Opposer has expanded its skin care product line from sunscreen and cool down lotions into additional lotions, as well as sunscreen moisturizers, and hydrating products. Smith Decl. ¶ 36 (13 TTABVUE 16); Smith Tr. 18:16-20 (26 TTABVUE 20).

Opposer owns the following registrations of the mark SUN BUM in standard characters:

- Registration No. 3572365 for “sunscreen cream” in Class 3;
- Registration No. 4289452 for “non-medicated sun care preparations” in Class 3;
- Registration No. 4870901 for “stickers” in Class 16, “headwear; T-shirts” in Class 25, and “toy animals” in Class 28;
- Registration No. 4012130 for “flying discs; footballs; paddle ball games” in Class 28; and
- Registration No. 5032467 for “hair care preparations; lip balm” in Class 3.

Stip. ¶¶ 3-7 (30 TTABVUE 2-3).

Opposer owns Registration No. 5863379 of the composite mark shown below:



for “Disposable wipes impregnated with cleansing chemicals or compounds for personal use; fragrances; non-medicated lip care preparations; lip balm; sun screen preparations; antiperspirants and deodorants for personal use; body sprays; body and beauty care cosmetics; cosmetic preparations, namely, firming creams and lotions; selftanning preparations; facial moisturizers; hair care preparations; suntanning preparations; liquid soap; bar soap; toothpaste” in Class 3; “stationery; notebooks; stickers; decals” in Class 16; “all-purpose carrying bags; travel bags; school bags; sport bags; wallets; umbrellas” in Class 18; “Pillows; accent pillows; plastic key chains; beach chairs; outdoor furniture; lounge chairs” in Class 20; “hair combs; hairbrushes; beverageware; coffee mugs; dinnerware; plates; cups; water bottles sold empty” in Class 21; “bath linen; towels; blanket throws; hooded towels; textile wall hangings; blankets for outdoor use; cushion covers” in Class 24; “clothing, namely, beachwear, beach cover ups, shirts; rash guards; sun protective clothing, namely, shirts; hats; wrist bands” in Class 25; and “toys, namely, action figures, water toys, inflatable toys, stuffed and plush toys; balls for sports; flying discs; paddle ball games” in Class 28. Stip. ¶ 8 (30 TTABVUE 3-4).

Opposer owns the following registrations of BABY BUM in standard characters:

- Registration No. 4321382 for “non-medicated sun care preparations” in Class 3;
- Registration No. 5555990 for “baby bubble bath; baby hand soap; baby lotion; baby shampoo; body cream; hair care preparations; lip balm; sunscreen cream” in Class 3; “towels” in Class 24; and “hats; T-shirts; underclothes; wraps” in Class 25; and
- Registration No. 5555991 for “plastic beach toy items, namely, sand toys, toy pails and toy shovels, and beach balls; toy animals” in Class 28.

Stip. ¶¶ 9-11 (30 TTABVue 4).

Opposer owns Registration No. 6205913 of the composite mark shown below:



for “baby bubble bath, hair care preparations for children, baby lotion, baby wipes, bath oil, sun screen preparations” in Class 3; “accent pillows, bedroom furniture” in Class 20; “drinking cups for babies and children, hair combs, hairbrushes” in Class 21; and “toys, namely, action figures, water toys, crib toys, bath toys, inflatable toys, stuffed toys; plastic beach toy items, namely sand toys, toy pails and toy shovels, and beach balls; balls for sports” in Class 28. Stip. ¶ 12 (30 TTABVue 4-5).

Opposer owns the following registrations of TRUST THE BUM in standard characters:

- Registration No. 3990792 for “Sunscreen cream” in Class 3; “stickers” in Class 16; and “T-shirts” in Class 25; and
- Registration No. 4129596 for “flying discs; footballs; paddle ball games” in Class 28.

Stip. ¶ 14 (30 TTABVue 5).

Opposer also owns pending applications to register (1) SUN BUM in standard characters for “Skin cream; Night cream; Eye cream; Face creams; Non-medicated skin serums; Beauty serums; Skin cleansers; Skin lotions; Moisturizing body lotions; Skin moisturizer; Skin masks; Non-medicated exfoliating preparations for skin; Facial washes; Skin toners; Skin clarifiers; Non-medicated face mists for skin care; non-medicated face mask for skin care; Mineral lotions for skin care; Non-medicated skin care preparations; Non-medicated skin brightening preparations, namely, exfoliating face wash, serum, cream, cleanser” in Class 3; “Reusable water bottles provided empty” in Class 21; and “Headbands” in Class 25; and (2) the SUN BUM composite mark shown above for “Skin cream; Night cream; Eye cream; Face creams; Nonmedicated skin serums; Beauty serums; Skin cleansers; Skin lotions; Moisturizing body lotions; Skin moisturizer; Skin masks; Non-medicated exfoliating preparations for skin; Facial washes; Skin toners; Skin clarifiers; Non-medicated face mists for skin care; nonmedicated face mask for skin care; Mineral lotions for skin care; Non-medicated skin care preparations; Non-medicated skin brightening preparations, namely, exfoliating face wash, serum, cream, cleanser” in Class 3; “Reusable water bottles provided empty” in Class 21; and “Headbands” in Class 25,



and (3). Stip. ¶¶ 15-17 (30 TTABVUE 5-6). These applications have filing dates that are later than the filing date of the opposed application.

**Applicant**

Applicant was founded in July 2017 by Ms. DiPietro, who resides in Miami, Florida. DiPietro Decl. ¶¶ 1-2, 63 (22 TTABVUE 3, 12). Ms. DiPietro founded Applicant in the course of transitioning from work in coastal engineering into the consumer-packaged goods space. DiPietro Decl. ¶ 7 (22 TTABVUE 4).

Applicant sells skincare products under what Ms. DiPietro called its “Miami Beach Bum brand,” which consists of products bearing either the MIAMI BEACH BUM mark or the SKI BUM mark. DiPietro Decl. ¶ 8 (22 TTABVUE 4). The MIAMI BEACH BUM product line was started in March 2018, DiPietro Decl. ¶ 9 (22 TTABVUE 4), and the MIAMI BEACH BUM mark was first used in April 2019. DiPietro Decl. ¶ 16 (22 TTABVUE 6). Applicant sells bum and body cream, face and body spritzer, leave-in conditioner, natural bug repellent, face cream, and various kits and apparel under the MIAMI BEACH BUM mark. DiPietro Decl. ¶ 35 (22 TTABVUE 8). Applicant owns Registration No. 6342955 of the mark MIAMI BEACH BUM in standard characters for “hair conditioners, face creams” in Class 3, and “clothing, namely, t-shirts, sweaters, hoodies, crop tops, rash guards, tank tops” in Class 25, Stip. ¶ 2, and Registration No. 5968556 of the mark MIAMI BEACH BUM in standard characters for “Body creams.” 20 TTABVUE 38-61. Opposer did not oppose registration of either MIAMI BEACH BUM mark. DiPietro Decl. ¶ 20 (22 TTABVUE 6).

Ms. DiPietro was the only person involved in the selection and adoption of Applicant's SKI BUM mark, 25 TTABVUE 293 (Applicant's Answer to Opposer's Interrogatory No. 7), and selected the mark in January 2019. DiPietro Decl. ¶ 24 (22 TTABVUE 7). As of the time of trial, Applicant was using the SKI BUM mark only in connection with a facial moisturizer product. DiPietro Decl. ¶¶ 27, 56, 73 (22 TTABVUE 7, 11, 14). Applicant does not currently sell any sunscreen or sun-protection products. DiPietro Decl. ¶ 60 (22 TTABVUE 12).

### III. Statutory Entitlement to Oppose<sup>13</sup>

Applicant does not address Opposer's statutory entitlement to oppose, but "[a] plaintiff's entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case even if, as here, the defendant does not contest the plaintiff's entitlement." *Sabhnani*, 2021 USPQ2d 1241, at \*14-15 (citing *Chutter*, 2021 USPQ2d 1001, at \*10) (citing *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)). As the party in the position of plaintiff, Opposer may oppose Applicant's application if Opposer's claim is within the zone of interests protected by

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<sup>13</sup> "Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act under the rubric of 'standing.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*13 n.14 (TTAB 2021). "We now refer to what previously had been called standing as 'entitlement to a statutory cause of action.' But our prior decisions and those of the Federal Circuit interpreting 'standing' under §§ 13 and 14 remain applicable." *Id.* (quoting *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*10 n.39 (TTAB 2021)).

the statute, 15 U.S.C. § 1063, and Opposer has a reasonable belief in damage that is proximately caused by registration of Applicant's mark. *Sabhnani*, 2021 USPQ2d 1241, at \*14.

Opposer has shown its entitlement to oppose registration of Applicant's mark based on the parties' stipulation to Opposer's ownership of subsisting registrations of various SUN BUM marks, which gives Opposer both an interest falling within the zone of interests protected by 15 U.S.C. § 1063, and a reasonable belief in damage that is proximately caused by registration of Applicant's mark. *Id.*

#### **IV. Analysis of Section 2(d) Claim**

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). Opposer must prove both priority and likelihood of confusion by a preponderance of the evidence. *See, e.g., WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

##### **A. Priority**

Because the parties stipulated to Opposer's ownership of valid and subsisting Registrations Nos. 3572365, 4870901, 4289452, 4012130, 5032467, 5863379, 4321382, 5555990, 5555991, 6205913, 3990792, and 4129596, Stip. ¶¶ 4-14 (30 TTABVUE 3-5), and Applicant did not counterclaim to cancel any of them, "priority is not at issue

for the marks and the goods . . . identified in each individual registration.” *New Era*, 2020 USPQ2d 10596, at \*9.

## **B. Likelihood of Confusion**

Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter*, 2021 USPQ2d 1001, at \*29 (citing *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)). Opposer invokes nine of the 13 *DuPont* factors, 34 TTABVUE 14-36, while Applicant invokes a tenth and argues that five of the *DuPont* factors “weigh conclusively against a likelihood of confusion,” and the “other factors weigh either against a likelihood of confusion or are neutral.” 36 TTABVUE 12.

We will focus our *DuPont* analysis on the SUN BUM composite word-and-design mark shown in Registration No. 5863379 (the “379 Registration”) for, among other things, numerous Class 3 goods, including “body and beauty care cosmetics,” “cosmetic preparations, namely, firming creams and lotions,” and “facial moisturizers,” which the record shows is Opposer’s “main trademark.” *New Era*, 2020

USPQ2d 10596, at \*11. “If we find a likelihood of confusion as to that mark and those goods, we need not find it as to Opposer’s other registered marks; conversely, if we do not find a likelihood of confusion” as to that mark and those goods, “we would not find it as to Opposer’s other registered marks for the goods identified therein.” *Id.*, at \*9-10.

**1. Similarity or Dissimilarity of the 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*, 2021 USPQ2d 1241, at \*19 (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).

“[W]e compare the goods as they are identified in the involved application and Opposer’s registration.” *New Era*, 2020 USPQ2d 10596, at \*13 (citing *Stone Lion Capital Partners LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The goods identified in Applicant’s

application are “Face creams” and “non-medicated face serum.”<sup>14</sup> As noted above, the goods identified in the ’379 Registration include “body and beauty care cosmetics” and “facial moisturizers.” The goods broadly identified as “body and beauty care cosmetics” in the ’379 Registration must be deemed to include all types of such “cosmetics.” *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). We take judicial notice that “cosmetics” are “substances that you put on your face or body that are intended to improve your appearance.”<sup>15</sup> There is no doubt that the “body and beauty care cosmetics” identified in the ’379 Registration encompass the “face creams” and “non-medicated face serum” identified in the application. These goods are thus legally identical. *See, e.g., In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018); *Skincode GA v. Skin Concept AG*, 109 USPQ2d 1325, 1328 (TTAB 2013).

Moreover, as Opposer notes, 34 TTABVUE 27, Ms. DiPietro repeatedly referred in her testimony to the “face cream” that is sold by Applicant under the SKI BUM mark as a “facial moisturizer,” thus equating those goods identified in the application

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<sup>14</sup> Opposer need not show a likelihood of confusion as to both goods identified in the application, *Sabhnani*, 2021 USPQ2d 1241, at \*19 n.17, but we find below that both goods are identical to at least one of the goods identified in the ’379 Registration.

<sup>15</sup> CAMBRIDGE DICTIONARY (dictionary.cambridge.org, last accessed on March 7, 2022). “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format.” *Chutter*, 2021 USPQ2d 1001, at \*36 n.72.

and in the '379 Registration, respectively.<sup>16</sup> DiPietro Decl. ¶¶ 10 (Applicant's "SKI BUM facial moisturizer targets a damaged skin barrier and dry skin" and "[e]ach product in our skincare and body care collection, including the facial moisturizer sold under the SKI BUM mark, keeps the skin's natural biology top of mind as we formulate our products.") (22 TTABVUE 5); 56 ("The SKI BUM mark is currently used to market a facial moisturizer.") (22 TTABVUE 11); 57 ("SKI BUM facial moisturizer is a high-end beauty product.") (22 TTABVUE 11); 58 ("SKI BUM facial moisturizer is priced for sophisticated, discerning, high-end consumers and would not be considered an impulse buy.") (22 TTABVUE 11-12); 59 ("SKI BUM facial moisturizer is intended for use on the face only.") (22 TTABVUE 12); 61 ("SKI BUM facial moisturizer is sold online and in certain high-end boutique stores.") (22 TTABVUE 12); 62 ("SKI BUM facial moisturizer is sold nationwide online.") (22 TTABVUE 12); 67 ("SKI BUM is also sold under conditions in which the consumer is seeking a facial moisturized to prevent dry skin.") (22 TTABVUE 13). On the basis of Ms. DiPietro's testimony, we find that the goods identified in the application as "face creams" are equivalent to the goods identified in the '379 Registration as "facial moisturizers," and that those goods are legally identical.

Because both of the goods identified in Applicant's application are legally identical to at least one of the goods identified in the '379 Registration, "the second *DuPont*

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<sup>16</sup> Ms. DiPietro testified that as of the time of trial, "the SKI BUM mark is only used on one product: face cream." DiPietro Decl. ¶ 73 (22 TTABVUE 14).

factor strongly supports a finding of a likelihood of confusion.” *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at \*4 (TTAB 2020).<sup>17</sup>

With respect to the third *DuPont* factor regarding channels of trade, and the portion of the fourth *DuPont* factor pertaining to the buyers of the involved goods, Applicant again focuses on Opposer’s sun care products, arguing that

the class of purchasers are different based on the different purposes of the goods. Because sun protectant products are important for everyday outdoor activities, such goods are often purchased by the general public, and used by men, women, and children. However, face creams are typically purchased by individuals who are invested in skin care and who prioritize their skin health and appearance. Unlike sunscreen, face cream is not typically purchased by the general public or by people of all ages (and Applicant’s product is targeted to women of a ceratin [sic] age group.) Accordingly, the class of purchasers is different, weighing further against a likelihood of confusion.

36 TTABVUE 34.

Ms. DiPietro also testified that it was her “understanding that the products sold under the SKI BUM mark are sold in different trade channels than products sold under SUN BUM” and that “SKI BUM products are sold in high end retailers, while I believe that SUN BUM targets surfing and other outdoor retailers,” DiPietro Decl. ¶ 66 (22 TTABVUE 13), and that “SKI BUM facial moisturizer is priced for

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<sup>17</sup> Applicant’s arguments on the second *DuPont* factor are directed primarily to “Opposer’s core products and branding,” which Applicant argues “focus on sun protection for everyone.” 36 TTABVUE 33. To the extent that Applicant addresses the other cosmetics identified in the ’379 Registration, its argument implicitly concedes the similarity of the goods, as it argues that the mark shown in the ’379 Registration “is substantially different from Applicant’s Mark in appearance, sound, connotation, and commercial impression, such that, **regardless of any similarity of the goods**, there is no likelihood of confusion between these marks.” *Id.* at 34 (emphasis added).



sophisticated, discerning, high-end consumers and would not be considered an impulse buy” and “is not marketed towards families or children” but instead “is targeted at women, ages 25-45, as a skin rejuvenation tool, a way to repair the skin barrier and prevent dehydration from harsh, dry, and/or cold climates and environmental skin stressors.” DiPietro Decl. ¶ 58 (22 TTABVUE 11-12).

Applicant’s arguments and evidence directed to the actual channels of trade and classes of consumers for its and Opposer’s goods are unavailing. The identifications of goods in the application and in the ’379 Registration contain no restrictions or limitations as to channels of trade or classes of purchasers, and the legally identical goods in the application and in the ’379 Registration are thus “presumed to travel in the same channels of trade to the same classes of purchasers.” *Sabhnani*, 2021 USPQ2d 1241, at \*20 (quoting *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*5 (TTAB 2019) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018)). “The third *DuPont* factor and the portion of the fourth *DuPont* factor regarding the buyers to whom sales are made thus also strongly support” a finding of a likelihood of confusion. *Id.*, at \*21.

## **2. The Strength of Opposer’s Mark**

The fifth *DuPont* factor is the “fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. Opposer argues that its SUN BUM mark is “famous and therefore entitled to a wide latitude of protection,” 34 TTABVUE 15, while Applicant argues that “Opposer has not provided sufficient evidence to show that the SUN BUM mark has achieved the level of recognition necessary for a mark to be considered famous.” 36 TTABVUE 35.

“In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength.” *New Era*, 2020 USPQ2d 10596, at \*10 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006)).

**a. Inherent or Conceptual Strength**

The inherent or conceptual strength of the composite mark shown in the '379 Registration “is not seriously at issue. [The] mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.” *Id.* (citing *Tea Bd. of India*, 80 USPQ2d at 1899). The '379 Registration “is ‘prima facie evidence of the validity of the registered mark,” *id.* (quoting 15 U.S.C. § 1057(b)), and as we find below in our discussion of the first *DuPont* factor,<sup>18</sup> there is “minimal evidence of registrations of

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<sup>18</sup> Applicant’s arguments regarding the conceptual weakness of Opposer’s marks appear in the portion of its brief devoted to the first *DuPont* factor regarding the similarity or dissimilarity of the marks, 36 TTABVue 13-17, in which Applicant argues that Opposer’s marks “are weak marks that should be afforded narrow protection.” *Id.* at 13. Applicant relies on third-party registrations of, and applications to register, marks containing the word BUM to show that the word BUM in Opposer’s mark is weak, *id.* at 13-14, and such evidence “goes only to the conceptual weakness of” Opposer’s mark. *Sabhnani*, 2021 USPQ2d 1241, at \*24. We have considered Applicant’s arguments regarding the conceptual weakness of the word BUM in Opposer’s mark in our analysis below of the first *DuPont* factor. *See Guild Mortg.*, 2020 USPQ2d 10279, at \*3 (finding that it was appropriate to consider the applicant’s evidence of the conceptual weakness of the cited mark under the first *DuPont* factor because “an analysis of the similarity between marks may include an analysis of the conceptual strength or weakness of the component terms and of the cited mark as a whole”) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)).

marks [containing BUM] for the same or similar goods that might demonstrate the inherent weakness of the [BUM] component as a source identifier.” *Id.* On the record here, we find that the mark shown in the ’379 Registration “is conceptually strong, and as discussed below, Applicant has not shown that the mark has been weakened.” *Id.*

**b. Commercial Strength**

“Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source.” *Id.* “Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown.” *Id.* (citing *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)). 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, it is the duty of the party asserting that its mark is famous to clearly prove it.” *Id.* (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (internal citation omitted)).

Unlike fame for purposes of protection against dilution, which Opposer does not claim here, 39 TTABVue 10, “likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay*

*Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). “[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.” *New Era*, 2020 USPQ2d 10596, at \*11 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734).

The commercial strength of a mark may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Id.*, at \*10-11.

Opposer argues that its SUN BUM mark is famous based on the length and extent of sales bearing the marks, the extent of its advertising and promotional expenditures, media exposure of the goods, social media impressions, Opposer’s promotional events and sponsorships, product awards, and Opposer’s enforcement efforts, 34 TTABVue 15-23, concluding that “‘the fame of the [SUN BUM] mark plays a dominant role’ in this case.” *Id.* at 23 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).<sup>19</sup> Opposer also cites a September 2020 “Brand Equity Tracking Study” (the

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<sup>19</sup> Opposer designated its sales and advertising figures, testimony regarding its social media and retail presence, and certain other testimony and exhibits in the Smith Declaration as “Confidential-Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive).” 34 TTABVue 16, 21 (citing Smith Decl. ¶¶ 8, 10-11, 13-15, 19-20, 23, 37 (13 TTABVue 5-9, 11-12, 17; 16 TTABVue 5-12, 17)). “[T]he Board must be able to discuss the record evidence in its opinions, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board’s decisions,” *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (quoting *Noble House Home Furnishings, LLC v.*

“Tracking Study”) as direct evidence that there is “no doubt that a significant portion of consumers across the United States are acutely aware and immediately recognize SUN BUM personal care products,” 34 TTABVUE 21-22 (citing Smith Decl. ¶ 33; Ex. A29 (13 TTABVUE 15; 15 TTABVUE 17; 16 TTABVUE 15, 199-207), while redacting the findings of the Tracking Study in both its brief and in the Smith Declaration on the ground that they are “Confidential-Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive).”<sup>20</sup>

### **i. Sales and Advertising**

Mr. Smith testified that Opposer’s “SUN BUM trademarked products have had significant growth and sales success.” Smith Decl. ¶ 8 (13 TTABVUE 5).<sup>21</sup> Between 2010 and mid-2014, annual dollar sales of products in Opposer’s “Sun” and “Lip” categories increased from high five figures in 2010 to mid seven figures as of June 2014. Smith Decl. ¶ 8; Ex. A3 (16 TTABVUE 5, 21). Between 2014 and 2020, annual

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*Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2006)), and we “may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.” Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g). We will honor the parties’ legitimate confidentiality designations consistent with our duty to explain the basis of our findings and ultimate decision by, for example, referring to evidence designated as confidential in general terms where possible or omitting information designated as confidential that is not germane to our analysis.

<sup>20</sup> Opposer discusses the Tracking Study in its fame argument in the unredacted versions of its main brief, 33 TTABVUE 21-22, and reply brief, 40 TTABVUE 11, Applicant discusses the Tracking Study in its argument against fame in the unredacted version of its brief, 37 TTABVUE 36-37, and we find that the Tracking Study is highly probative of the alleged fame of Opposer’s mark. Accordingly, we will discuss its methodology and contents in general terms to the extent necessary to explain our finding under the fifth *DuPont* factor.

<sup>21</sup> Mr. Smith refers generally to the SUN BUM marks in his testimony, but the record shows that the composite mark shown in the ’379 Registration has consistently been used on Opposer’s products that do not bear its BABY BUM or TRUST THE BUM marks, and, as noted above, the record shows that the mark is Opposer’s primary mark.

dollar sales of products in Opposer's "Sun" category increased from mid seven figures in 2014 to very high eight figures in 2020, annual dollar sales of products in Opposer's "Hair" category increased from zero in 2014 to low eight figures in 2020, and annual dollar sales of products in Opposer's "Lip" category increased from very low seven figures in 2014 to very low eight figures in 2020. Smith Decl. ¶ 8; Ex. A4 (16 TTABVUE 5, 27). Total sales between 2010-2020 of products bearing Opposer's SUN BUM marks in its "Sun," "Hair," and "Lip" categories have been several hundred million dollars.<sup>22</sup> Opposer currently sells its goods in the United States through more than 6,000 brick-and-mortar world retailers of various sorts, and has such retailers in all 50 states as well as in the District of Columbia and the Virgin Islands. Smith Decl. ¶¶ 11-12; Ex. A7 (16 TTABVUE 6-7, 30-32). Opposer also sells its goods through online platforms, including Amazon, Facebook, and Opposer's website at sunbum.com, as well as the online platforms of its retailers. Smith Decl. ¶ 13; Exs. A8-A-11 (13 TTABVUE 7, 398-450).

Opposer advertises and promotes its SUN BUM products in multiple manners, including on social media, its website, and YouTube, in print advertisements, through event and venue sponsorships, and through celebrity or athlete endorsements. Smith Decl. ¶ 18 (13 TTABVUE 9). Opposer's total estimated marketing expenditures, which cover numerous categories of expenses including merchandising cost/store displays, trade marketing, trade show expenses, promotional samples expenses,

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<sup>22</sup> Opposer also had sales revenues in the mid to high six figures over that period in its "Lifestyle" category.

advertising/media buys, ambassadors/influencers, sales materials/rep supplies, public relations expenses, agency fees, creative production, digital advertising, promotional events, and lifestyle and brand partnerships, have increased from very low seven figures in 2016 to very low eight figures in 2020, with total expenditures over that period in the low eight figures. Smith Decl. ¶ 19 (16 TTABVUE 9).

Applicant correctly notes that these figures do not compare favorably in absolute terms to the sales and advertising figures in cases in which the Federal Circuit has found marks to be famous under the fifth *DuPont* factor. 36 TTABVUE 35-36 (citing *Coach Servs.*, 101 USPQ2d at 1720 (finding fame of the opposer's COACH mark based in part on 2008 sales of roughly \$3.5 billion and advertising expenditures of about \$30-60 million); *Bridgestone Americas Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063-64 (Fed. Cir. 2012) (finding that the opposer's secondary marks were commercially strong based in part on "billions of dollars of sales")). See also *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (fame of OMAHA STEAKS mark supported by advertising expenditures of \$45 million in 2011 and over \$50 million in 2012 and 2013); *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark supported by annual sales in excess of \$50 million and annual advertising expenditures of more than \$5 million over the 17 years of use of the mark prior to 2002); *Recot*, 54 USPQ2d at 1896 (fame of FRITO-LAY mark shown by expenditures in 1996 of about \$80 million and other evidence, including the facts that "[i]n any given year, over 90 percent of American households purchase at least one FRITO-

LAY brand product” and that “FRITO-LAY products enjoyed a greater than 50 percent market share in the estimated \$12.1 billion domestic snack chip industry.”); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (fame of HUGGIES mark supported by sales in excess of \$300 million and advertising expenditures in excess of \$15 million in 1982 alone); *AutoZone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (fame of AUTOZONE mark supported by advertising expenditures of over \$750 million during 23-year period of use, with the Board finding that although petitioner had “not placed its sales and advertising figures in context,” such context was “not necessary here in view of the volume of sales and advertising expenditures and the fact that petitioner’s advertising reaches over 90% of the U.S. population numerous times each year.”).

Because Opposer’s sales and advertising figures are not nearly of the magnitude of the figures in these cases, “some context in which to place [Opposer’s] raw statistics is reasonable,” *Bose*, 63 USPQ2d at 1309, but Mr. Smith did not testify as to how Opposer’s sales and advertising figures compare to those of its competitors. Instead, Opposer argues in its main brief that “[t]hese sales of tens of millions of SUN BUM branded products totaling hundreds of millions of dollars over many years, and the corresponding millions of dollars spent on marketing, thus establish the ‘fame’ of the SUN BUM mark in the context of the fifth *DuPont* factor,” 34 TTABVUE 17, and in its reply brief that it “is not required to show billions of dollars of sales and use of the mark for upwards of 50 years to establish the fame of its SUN BUM marks.” 39



TTABVUE 10. Opposer claims that its sales and advertising figures are comparable to those in one “Unpublished” Federal Circuit decision, *Money Station, Inc. v. Cash Station, Inc.*, 70 F.3d 1290, 38 USPQ2d 1150 (Fed. Cir. 1995) and in one Board decision, *Andrew Jurgens Co. v. Sween Corp.*, 229 USPQ2d 394 (TTAB 1986), if the sales and advertising figures in those two cases are expressed in current dollars after adjusting for inflation. *Id.* at 10-11.

The Federal Circuit has held that there are multiple ways in which to “contextual[ize] ad expenditures and sales figures,” *Omaha Steaks*, 128 USPQ2d at 1690, including “evidence of the type of advertisements and promotions [the plaintiff] uses to gain sales,” *id.*, and Opposer provides some such evidence, which we discuss below. In addition, there is direct evidence of the effectiveness of Opposer’s sales and advertising vis-à-vis its competitors in the form of the Tracking Study, which we also discuss below.

## **ii. Length of Use**

Opposer argues that “[t]hrough its predecessor in interest, Agility Sports LLC, SUN BUM branded sunscreen was first used in early 2008.” 34 TTABVUE 16 (citing 25 TTABVUE 16 (Ex. B1)). Opposer cites a copy of its Registration No. 3572365 of the mark SUN BUM in standard characters for sunscreen cream, which recites a first use date of January 1, 2008, 25 TTABVUE 16, but the “allegation . . . in a registration, of a date of use is not evidence on behalf of the . . . registrant; a date of first use of a mark must be established by competent evidence,” Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), and Mr. Smith, who joined Opposer in September 2010, Smith Decl. ¶ 1 (13 TTABVUE 3), did not testify to any use of the mark before January 2010,

when Opposer used the SUN BUM trademarks in connection with goods in the “Sun,” “Lip,” and “Lifestyle” categories at a trade show. Smith Decl. ¶ 6; Ex. A1 (13 TTABVUE 4-5, 25-28). Applicant concedes the claimed earlier use in 2008, however, when it argues in its brief that “the SUN BUM mark has only been in use for about 14 years,” 36 TTABVUE 36, and the parties have thus agreed that the mark has been used since 2008.

Opposer’s 13 years of use of the SUN BUM mark at the time of trial is modest in comparison to the periods of use of marks in multiple cases in which the Federal Circuit and the Board have found marks to be famous under the fifth *DuPont* factor. *See, e.g., Bose*, 63 USPQ2d at 1306 (collecting cases); *New Era*, 2020 USPQ2d 10596, at \*11 (use of the opposer’s NEW ERA mark since the 1930s and other evidence supported a finding that the mark was “on the much higher end of the commercial strength spectrum”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1821 (TTAB 2015) (use of the opposer’s BUDWEISER mark “since 1876, interrupted only by Prohibition,” supported a finding that the mark met “the applicable standard for fame”); *AutoZone Parts*, 100 USPQ2d at 1361-62 (23 years of use and other evidence supported a finding that the petitioner’s AUTOZONE marks was famous).

Each type of indirect evidence of fame cannot be considered in isolation, however, and a relatively short period of use may not be inconsistent with a finding of fame if the record contains sufficient other evidence to show that the mark has become famous during that period. *See, e.g., Rsch. in Motion Ltd. v. Defining Presence Mktg.*

*Grp., Inc.*, 102 USPQ2d 1187, 1192-93 (TTAB 2012) (although the opposer's BLACKBERRY mark had been in use for only 13 years, the Board found that the mark was famous where the record showed billions of dollars in sales, tens of millions of dollars in advertising and promotional expenditures, intense media attention, the ranking of the mark as "among the most famous and valuable trademarks in the world by industry publications that track the powerful reach of global brands," and that by the mid-2000s, products bearing the mark "had become ubiquitous in the United States, and proved to be an important tool for business executives, government officials and many other professionals as a means for round-the-clock mobile communications."). The Tracking Study (discussed below) directly measures the fame of Opposer's mark resulting from its use for slightly more than a decade.

### **iii. Media Coverage**

Opposer and its Sun Bum mark and products have received unsolicited exposure in the electronic and print media (including in online form). Smith Decl. ¶¶ 20-21; Exs. A15-A17 (13 TTABVUE 10-12; 14 TTABVUE 113-44, 146-83; 16 TTABVUE 159-82). In the electronic media, Opposer's sunscreen bearing the mark shown in the '379 Registration was featured on a November 13, 2020 episode of the Today Show in a segment devoted to the PEOPLE magazine Beauty Awards, which episode reportedly generated more than 3,000,000 media "impressions."<sup>23</sup> Smith Decl. ¶ 20; Ex. A15 (13 TTABVUE 10; 14 TTABVUE 115). The November 23, 2020 issue of PEOPLE

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<sup>23</sup> Mr. Smith did not testify about how the numbers of media "impressions" were determined, but Applicant did not object to this evidence, so we will consider it for whatever probative value it has notwithstanding its hearsay nature.

containing the Beauty Awards and designating Opposer's sunscreen as "Best Face Sunscreen" reportedly generated more than 7,000,000 impressions. Smith Decl. ¶ 20; Ex. A15 (13 TTABVUE 10; 14 TTABVUE 116-17). Opposer's Sun Bum lip balm was featured on a July 12, 2019 segment of Good Morning America entitled "Summer Beauty Secrets," which reportedly generated more than 3,000,000 impressions. Smith Decl. ¶ 20; Ex. A16C (13 TTABVUE 11; 16 TTABVUE 169, 179).<sup>24</sup>

Opposer's products have also been featured in magazines such as MEN'S HEALTH, COSMOPOLITAN, FITNESS, TOWN & COUNTRY, TEEN VOGUE, MARIE CLAIRE, MEN'S JOURNAL, BETTER HOMES & GARDENS, ESSENCE, STAR, WOMAN'S DAY, SHAPE, SNOW, and LIFE & STYLE, with each publication reportedly generating substantial numbers of impressions, Smith Decl. ¶ 20; Ex. A16 (13 TTABVUE 10-11; 14 TTABVUE 118-44), as well as on multiple websites, including those of THE WALL STREET JOURNAL, BUSINESS INSIDER, THE NEW YORK TIMES, USA TODAY, MEN'S JOURNAL, and THE HUFFINGTON POST. Smith Decl. ¶¶ 20-22; Exs. A17-A18 (13 TTABVUE 10-12; 14 TTABVUE 150, 155, 157, 164-66, 181-83).

#### **iv. Product Awards**

Mr. Smith testified that Opposer's "product packaging and store displays have been recognized in the industry." Smith Decl. ¶ 24; Exs. A20-A22 (13 TTABVUE 12; 14 TTABVUE 188-94). Opposer issued a press release in 2011 regarding its

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<sup>24</sup> Opposer designated this exhibit, captioned 2019 "Summer Coverage Recap Press & Media Highlights," as "Confidential-Attorneys' Eyes Only (Trade Secret/Commercially Sensitive)," but it contains essentially the same information that Opposer made of record in the public files regarding the Today Show episode, so we have referred to it and summarized its information.

nomination for one of these awards, the Image Award of the Surf Industry Manufacturers Association (“SIMA”) for “Accessory Product of the Year,” Smith Decl. ¶ 24; Ex. A20 (13 TTABVUE 12; 14 TTABVUE 188-89), and Mr. Smith testified that Opposer “was again nominated for a SIMA award in 2012,” Smith Decl. ¶ 24 (13 TTABVUE 12), but there is no evidence that Opposer received either award and no evidence as to the extent of distribution of the 2011 press release. Opposer did receive two awards in 2020, the Silver Award in the National Association of Container Distributors (“NACD”) Packaging Awards Competition for the bottles for Opposer’s BABY BUM product line, Smith Decl. ¶ 24; Ex. A21 (13 TTABVUE 12; 14 TTABVUE 190-92), and the Bronze Award in the 2020 Outstanding Merchandising Achievement (“OMA”) “Shop Awards” for a Trust the Bum endcap display in the CVS chain that caused the product line to become number one in its category at CVS. Smith Decl. ¶ 24; Ex. A22 (13 TTABVUE 12-3; 14 TTABVUE 193-94).

Mr. Smith did not testify as to whether Opposer did anything to publicize its 2011 and 2012 nominations and its 2020 awards beyond the issuance of its 2011 press release, or as to the extent, if any, of the purchasing public’s awareness that Opposer received the nominations and awards. Without such context, his testimony about the nominations and awards establishes only that Opposer was viewed as a promising newcomer in 2011 and 2012 and as a successful marketer and packager by trade associations in 2020. This “only tend[s] to show that [Opposer’s] products are perceived to be of high quality or are recognized only by industry groups,” *Spier Wines*

(*Pty*) *Ltd. v. Shepherd*, 105 USPQ2d 1239, 1245 (TTAB 2012), not that its marks are famous.

**v. Opposer's Enforcement Efforts**

Opposer argues that it “zealously protects its SUN BUM mark against confusingly similar marks, including successfully opposing another SKI BUM mark abroad.” 34 TTABVUE 23 (citing Smith Decl. ¶ 35; Ex. A32 (15 TTABVUE 61-73)). The fame inquiry under the fifth *DuPont* factor, however, “is focused on whether the mark has achieved ‘extensive public recognition and renown,’ not on enforcement efforts.” *Omaha Steaks*, 128 USPQ2d at 1693 (finding that the Board’s error in refusing to take judicial notice of 20 lawsuits filed by the opposer was “thus harmless”) (quoting *Coach Servs.*, 101 USPQ2d at 1720)). Moreover, Opposer states that its enforcement efforts are “a result of the widespread consumer recognition of the SUN BUM marks,” 34 TTABVUE 23, not a cause.

**vi. Opposer's Tracking Study**

In most inter partes cases, the Board must assess the degree of fame of a plaintiff’s mark by synthesizing the sort of indirect evidence discussed above because “[d]irect evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion.” *New Era*, 2020 USPQ2d 10596, at \*12 (quoting *Bose*, 63 USPQ2d at 1308). Here, however, Opposer introduced pages from the Tracking Study, which was conducted online in August 2020 by an independent brand research firm for purposes other than this litigation. Smith Decl. ¶ 33; Ex. A29 (16 TTABVUE 15, 199-207). The Board has previously considered such brand awareness studies as potentially probative evidence of fame, noting that the fact that such

studies are not conducted for purposes of litigation, but rather are “used in the ordinary course of business increases [their] probative value.” *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2022 (TTAB 2014) (characterizing multiple consumer recognition surveys commissioned by the opposer over a six-year period as “particularly persuasive” evidence of dilution fame of the CHANEL mark); *see also Nasdaq Stock Mkt., Inc. v. Antartica, S.r.l.*, 69 USPQ2d 1718, 1729 (TTAB 2003) (discussing annual surveys commissioned by the opposer to measure awareness of its stock market among the investing and general public); *Coach Servs.*, 101 USPQ2d at 1720 (substantial evidence supporting Board’s finding that the COACH mark was famous for purposes of likelihood of confusion included internal brand awareness study that “showed a high level of awareness of the COACH brand for women between the ages of 13-24”). The Board has characterized such brand awareness studies as direct evidence of consumer awareness of marks. *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1505 (TTAB 2005), *aff’d*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

The Tracking Study’s key objective was to determine “the awareness and brand health of the Sun Bum and Baby Bum brands to establish a baseline for the business moving forward” to assist Opposer in assessing “the impact of marketing activity on the health of the Sun Bum and Baby Bum brands and determine what actions should be taken in the future.” 16 TTABVUE 201.<sup>25</sup> The Tracking Study measured the

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<sup>25</sup> The Tracking Study indicates that similar studies were conducted semi-annually in 2018 and 2019. 16 TTABVUE 203.

“unaided and aided awareness,” on the part of purchasers of sun care, hair care, lip care, and baby products within the previous six months, of what the Tracking Study called the “Sun Bum brand.” The terms “unaided awareness” and “aided awareness” are not defined in the pages from the Tracking Study in the record, but the Board has previously explained that “[u]naided’ awareness indicates that the survey participant spontaneously mentions the [relevant] brand name without prompting,” while “aided’ awareness means that the survey participant responds ‘yes’ when asked whether he or she is aware of the [relevant] brand name.” *Chanel*, 110 USPQ2d at 2022 n.10. *See also Carefirst*, 77 USPQ2d at 1507 (aided awareness is “awareness after the brand has been prompted.”); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1247 (TTAB 2015) (survey measured aided awareness by giving respondents a list of marks for frozen meals and asking them which products they had heard of previously); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1723 n.53 (TTAB 2007) (market research report “did not explain what was meant by ‘unaided awareness,’” but the Board’s review of the report itself indicated that “‘unaided awareness’ means awareness of the brand without prompting from the interviewer.”). Our review of the pages from the Tracking Study in the record indicates that the terms “aided awareness” and “unaided awareness” have the meanings discussed in these cases.<sup>26</sup>

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<sup>26</sup> The pages from the Tracking Study in the record frequently display the composite mark shown in the ’379 Registration, but by definition that mark would not have been exposed to respondents in the unaided awareness portion of the Tracking Study, where respondents were asked to name brands of which they are aware, and the Tracking Study does not suggest that the composite mark was the “prompt” for the respondents’ aided awareness. Accordingly, it appears that the Tracking Study measured awareness of the SUN BUM word mark rather



The Tracking Study reported that “[u]naided and aided brand awareness and the share of consumers who have ever tried the Sun Bum brand have risen significantly and are currently at an all time high among Core Sun Care Buyers,” 16 TTABVUE 203,<sup>27</sup> who were defined as “women aged 18-44 who purchased Sun Care products” in the previous six months. *Id.* at 202. The Tracking Study reported that as of the fall of 2020, the unaided awareness of the SUN BUM brand among “Core Sun Care Buyers” was slightly above single digits, while its aided awareness among that cohort was about five times that number. *Id.* at 203.

The Tracking Study compared the level of aided awareness of the SUN BUM brand to the level of aided awareness of two categories of competitive sun care brands: (1) a set of four “lesser-known brands,” and (2) the five “largest sun care players in the space.” *Id.* at 205.<sup>28</sup> The Tracking Study stated that “[a]lthough Sun Bum’s awareness has seen significant momentum and continues to rise, brand awareness is an opportunity area especially compared to the largest sun care players in the space.” *Id.*

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than the composite mark per se. Because we find below in our analysis of the first *DuPont* factor that the words SUN BUM are the dominant portion of the composite mark, the focus of the Tracking Study on the SUN BUM word mark does not materially reduce its probative value on the question of the fame of the mark shown in the ’379 Registration.

<sup>27</sup> The levels of unaided awareness of the Sun Bum brand among sun care products buyers in 2018 and 2019 were all in the single digits, and the levels of aided awareness in 2018 and 2019 were all in the mid double digits.

<sup>28</sup> Unaided awareness figures for competitive brands were not reported. 16 TTABVUE 205.

The Tracking Study also compared the level of aided awareness of the Sun Bum brand among hair care product and lip care product buyers.<sup>29</sup> In the hair care category, the Sun Bum brand had an aided awareness in the mid double digits, which was “second lowest among hair care buyers.” *Id.* at 207. The five best-known hair care brands had much higher aided awareness. *Id.* In the lip care category, aided awareness of the Sun Bum brand was reported to be in the mid double digits, “slightly higher than that of hair care buyers, yet awareness still falls behind the other key lip care brands.” *Id.* at 208.

“In general, the Board has discouraged heavy reliance on aided awareness to prove fame.” *ProMark Brands*, 114 USPQ2d at 1247 (finding that 82% aided awareness of the opposer’s mark “lack[ed] significant evidentiary value on the question of fame” under the fifth *DuPont* factor). “[I]t is unaided awareness that is the most significant,” and “[o]ne should not be permitted to so heavily rely on aided awareness, that is, awareness after the brand has been prompted, to show fame.” *Carefirst*, 77 USPQ2d at 1507. The level of aided awareness of the Sun Bum brand among Opposer’s “Core Sun Care Buyers” reported in the Tracking Study is entitled to little weight in our analysis of fame under the fifth *DuPont* factor, particularly because it is considerably lower than the aided awareness levels of the brands of what the Tracking Study described as the five “largest sun care players in the space.” 16 TTABVue 205. Opposer’s aided awareness levels among hair care product and lip

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<sup>29</sup> The Tracking Study did not report the level of unaided awareness of the Sun Bum brand among these cohorts.

care product buyers are similarly considerably lower than those of competitive brands in the same categories. Opposer's aided awareness level in all three categories "runs in the middle of the pack, significantly trailing several brands." *Carefirst*, 77 USPQ2d at 1506.

The level of unaided awareness of the Sun Bum brand among Opposer's "Core Sun Care Buyers" reported in the Tracking Study is quite modest. In *7-Eleven*, the opposer's market research study reported 73% unaided awareness of the opposer's BIG GULP mark for fountain soft drinks among all respondents and 78% unaided awareness among 7-Eleven customers. The Board found that the opposer's evidence of fame, "particularly the market research study," supported the conclusion that the BIG GULP mark "has a very high degree of public recognition and renown" under the fifth *DuPont* factor. *7-Eleven*, 83 USPQ2d at 1723. The study also reported unaided awareness figures of 16% for the opposer's SUPER BIG GULP mark among all respondents and 18% among 7-Eleven customers, and 2% overall for the opposer's DOUBLE GULP mark. *Id.* The Board concluded that "the evidence does not show any significant public recognition and renown for opposer's GULP trademark or for any other variance of the 'Gulp' trademarks."). *Id.* The level of unaided awareness of the Sun Bum brand is far below the 70%+ levels of unaided awareness found to support a showing of fame of the BIG GULP mark in *7-Eleven*, and is comparable to the levels of unaided awareness that were found not to support a finding of fame of the SUPER BIG GULP mark.

In *Carefirst*, the opposer's brand awareness studies, like the Tracking Study, reported significant gaps between the levels of unaided and aided awareness, with the unaided awareness levels in the single digits. The Board held that if "a mark were 'famous,' as contemplated under the law, among the class of relevant customers and potential customers, it would, in all likelihood, garner much higher numbers on unaided brand awareness than did opposer's mark that scored only in the single digits, even behind some of opposer's other brands." *Carefirst*, 77 USPQ2d at 1507. The unaided awareness level of the Sun Bum brand first emerged from the single digits in 2020, and the extremely-low double-digit level reported in the Tracking Study is not the sort of "much higher number" that the Board indicated in *Carefirst* was necessary to support a showing of fame.

The levels of unaided and aided awareness of the Sun Bum brand reflected in the Tracking Study do not support Opposer's claim that there is "no doubt that a significant portion of consumers across the United States are acutely aware and immediately recognize SUN BUM personal care products." 34 TTABVue 21-22.

**vii. Conclusion Regarding Fame of Opposer's Mark**

On the basis of the direct and indirect evidence of fame in the record, "[t]here is no question but that [O]pposer's mark has achieved a degree of recognition in the [sun care products] field. Fame is relative, however, not absolute, and the evidence, when considered as a whole, falls short of a convincing showing of fame." *Carefirst*, 77 USPQ2d at 1507. In view of the "underwhelming results of [Opposer's] brand awareness stud[y]," which is "the primary evidence of confirmatory context," *id.* at 1505, for Opposer's sales and advertising figures and other indirect evidence of fame,

we find “that the strength of the mark [SUN BUM] favors [O]pposer, but not to the extent that it would if the mark were famous, as fame has been contemplated in prior decisions of this Board and of the Federal Circuit.” *Carefirst*, 77 USPQ2d at 1507. Along the “spectrum from very strong to very weak,” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, we place the mark shown in the ’379 Registration on the “strong” side of the spectrum, but not “on the much higher end of the commercial strength spectrum.” *New Era*, 2020 USPQ2d 10596, at \*12. The mark is entitled to something more than “the normal scope of protection to which inherently distinctive marks are entitled,” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017), and the fifth *DuPont* factor thus slightly supports a finding of a likelihood of confusion.

### **3. Similarity or Dissimilarity of the Marks**

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani*, 2021 USPQ2d 1241, at \*25 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1691). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (internal quotation omitted)).

“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.’” *Id.* (quoting *Cai*, 127 USPQ2d at 1801)

(internal quotation 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.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customers here are purchasers of cosmetics, including face creams, non-medicated face serums, and facial moisturizers. “Because the identifications of goods in the [379 Registration and application] do not include any restrictions or limitations regarding channels of trade, classes of consumers, or prices, these purchasers . . . are ordinary consumers. *Id.*, at \*27.

“Because the identified goods are identical in part, a lesser degree of similarity between the marks is required for confusion to be likely.” *Id.* (citing *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *New Era*, 2020 USPQ2d 10596, at \*14).

Opposer focuses its argument in its main brief on “the two-word marks SUN BUM and SKI BUM,” which Opposer argues “have one identical term, and one highly similar term.” 34 TTABVUE 24. Opposer claims that these marks “are *identical* with respect to: (i) the suffix ‘BUM’; (ii) the number of words; (iii) the number of letters; (iv) the number of syllables; and (v) beginning and ending letters (‘S’ and ‘M’),” and that “both SUN BUM and SKI BUM evoke an outdoor connotation and meaning directed toward an individual engaged in an outdoor activity.” *Id.* (emphasis supplied by Opposer).

Applicant’s arguments against similarity begin with its claim that Opposer’s marks are weak marks that should be given narrow protection. 36 TTABVUE 13.

Applicant bases this argument on the claimed conceptual weakness of the word BUM in Opposer's marks, *id.* at 13-15, the fact that Opposer "allowed its products to be sold by an online retailer called 'The Ski Bum,' suggesting that Opposer was not concerned with customers confusing its products as originating from this online retailer" and that "[i]f Opposer believed that there was no likelihood of confusion with an online retailer selling Sun Bum's identical products under the name 'The Ski Bum,' then there certainly should be no likelihood of confusion with Applicant's mark for different, not identical goods," *id.* at 15-16, and the claim that Opposer's "marks as a whole are merely descriptive, or at best highly suggestive, of the listed goods, and are therefore weak on the spectrum of distinctiveness." *Id.* at 16. Applicant concludes this portion of its argument as follows:

Due to the large number of third-party BUM-based marks for identical or similar goods as Opposer's Marks, the descriptive nature of the other elements of Opposer's Marks, and the descriptive or highly suggestive nature of Opposer's Marks as a whole when applied to the same goods as Applicant's Mark, Opposer's Marks should be afforded narrow protection, and are therefore less likely to generate confusion over source.

*Id.* at 17.

Applicant then argues that the marks are dissimilar in appearance, sound, and meaning, *id.* at 17-29, and that "minute distinctions between the marks weighs [sic] against a likelihood of confusion." *Id.* at 18. With respect to appearance, Applicant argues that the "only similarity between the marks is the common element BUM, but this portion of the mark is weak and does not serve a source-identifying function due to common third-party use of this element, as discussed *supra.*" *Id.* According to

Applicant, “consumers would distinguish between SKI BUM and SUN BUM, which are for different goods, based on both the goods and the different first words of each mark – SKI and SUN.” *Id.* at 19. Applicant argues that “consumers are generally more inclined to focus on the first word of a trademark, such that consumers would be more likely to focus on the first words of Applicant’s Mark, SKI, and Opposer’s Marks, SUN, BABY, and TRUST.” *Id.* Applicant argues that “[b]ecause consumers are more likely to focus on the first words of the marks, and not the weak common element BUM, the first words of the marks are the dominant portions of the marks,” and “should be given greater weight, and due to their difference in appearance, sound, and connotation, weigh against a finding of a likelihood of confusion.” *Id.* at 20.

With respect to the mark shown in the ’379 Registration, Applicant argues that its mark is also distinguishable in appearance “based on the additional design features of the mark,” in which “the words SUN BUM appear in a stylized font above a cartoon figure of a gorilla wearing sunglasses.” 36 TTABVue 21. Applicant further argues that “[c]onsumers would be unlikely to confuse Applicant’s Mark SKI BUM with the stylized SUN BUM design, as the matching design elements (e.g., the matching U and U and the matching n and first arch of the m) link the words together in a manner that is not found in the combination of the elements SKI and BUM.” *Id.* Applicant argues that “the gorilla design is the dominant portion of the mark, which detracts from any similarity between the literal elements.” *Id.* Applicant cites several cases in which composite word-and-design marks such as the one shown in the ’379 Registration were found to be dominated by their design features. *Id.* at 21-22 (citing



*In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987); and *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966)). Applicant concludes that under these cases, the gorilla caricature in the mark shown in the '379 Registration "is a dominant/prominent design that is eye catching and engages the viewer before the viewer looks at the literal elements 'SUN BUM,' which are relatively smaller, rendering the gorilla design element the dominant portion of the mark and eliminating any likelihood of confusion with Applicant's Mark." *Id.* at 22-23.

With respect to sound, Applicant argues that "the first words of Applicant's Mark and Opposer's Marks are the dominant portions of the marks that consumers would focus on." *Id.* at 23. Applicant cites third-party registrations of SNOW BUMS and LAKE BUMS for clothing and concludes that "[i]f SNOW BUMS and SUN BUM for identical goods were all allowed to register and co-exist, then SKI BUM should also be allowed to register, as SKI sounds much more different from SUN than SNOW, and the mark is for different, not identical, goods." *Id.* at 24.

As to connotation and commercial impression, Applicant argues that the marks "also have markedly different, if not contrasting, meanings or connotations." *Id.* According to Applicant, "[n]ot only are the dominant portions of the marks, SKI and SUN, completely different, but they also connote opposing imagery," namely, "cold versus hot, snow versus sand, mountains versus beach, and winter versus summer."

*Id.* at 25. Applicant further argues that “SKI BUM is a well-known word phrase, that as a whole, has a distinctive meaning, rendering the Mark a unitary mark,” *id.* at 26, which “conveys images of a person who lives paycheck to paycheck at or near a ski resort in the mountains and spends most of their time skiing,” *id.*, while SUN BUM “merely describes an intended user of the identified goods, and as such, is merely descriptive of the goods.” *Id.* at 28. Applicant concludes that “[c]onsumers would be unlikely to confuse SKI BUM, a strong mark with an arbitrary meaning in connection with the goods (highend face cream), with SUN BUM, a weak mark that immediately describes a user of the goods (a person in the sun) and feature of the products (e.g., sun protection).” *Id.*

With respect to the mark shown in the '379 Registration, Applicant also argues that

[m]onkeys and gorillas are often found in tropical places, where beachgoers often travel and sunscreen is important to protect from the sun. Further, the connotation of someone out in the sun is further apparent with this mark due to the additional design element of a gorilla wearing sunglasses. Sunglasses, like sunscreen, are helpful to protect from the sun. Thus, the additional design elements of a monkey wearing sunglasses further distinguishes the mark from SKI BUM.

*Id.*

Applicant also claims that “there are numerous marks that coexist that incorporate the element BUM and evoke an outdoor connotation, including, for example, MIAMI BEACH BUM, AUSSIE BEACH BUM, BEACH BUM GANG, BEACH TOWN BUMS, BOAT BUMS, LAKE BUM, and SNOW BUMS,” *id.* at 29, and that “[d]espite these marks all having an outdoor connotation, these marks are

distinguishable based on the different non-BUM portions of the marks and the differences in the specific outdoor connotations invoked by each mark.” *Id.*

Applicant’s final argument for dissimilarity is that “[a]ny similarity between the marks is mitigated by the vast differences in the respective packaging of the goods.” *Id.* at 30. Applicant argues that the parties “use additional elements on their packaging to set them apart, including their respective brand labels,” and “[a]ny likelihood of confusion is therefore mitigated by these vast differences in the packaging and branding of the products bearing these marks.” *Id.* at 31. We have given this argument no further consideration because “we cannot consider the use of the parties’ marks on their actual packaging in assessing the similarity of the marks.” *Sabhnani*, 2021 USPQ2d 1241, at \*30 n.23.<sup>30</sup>

We begin by addressing Applicant’s arguments and evidence regarding third-party marks because they form the basis for many of Applicant’s arguments regarding the dissimilarity of the involved marks, including its argument that “[w]hen comparing a mark to a weak mark, minute distinctions between the marks weighs [sic] against a likelihood of confusion.” 36 TTABVue 18. “Evidence of the

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<sup>30</sup> Applicant primarily relies on *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 75 USPQ2d 1098 (2d Cir. 2005), as support for this argument. That case, and the others cited by Applicant, were civil infringement suits in which courts necessarily “look[ed] to the overall impression created by the logos and the context in which they are found and consider[ed] the totality of factors that could cause confusion among prospective purchasers.” *Star Indus.*, 75 USPQ2d at 1105 (quoting *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 26 USPQ2d 1583, 1587 (2d Cir. 1993)). Under the first *DuPont* factor, by contrast, “we do not consider how Applicant and [Opposer] actually use their marks in the marketplace, but rather how they appear in the registration and application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1185 (TTAB 2018).

extensive registration and use of a term by others can be powerful evidence of the term's weakness.” *Sabhnani*, 2021 USPQ2d 1241, at \*21 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd*, 125 USPQ2d 1043, 1057 (TTAB 2017)). “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.” *Id.*, at \*22 (quoting *Omaha Steaks*, 128 USPQ2d at 1693 (internal quotations omitted)). “Third-party use may bear on the commercial weakness of a mark,” *id.* (citing *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.’” *Id.* (quoting *Omaha Steaks*, 128 USPQ2d at 1693 (internal quotations omitted)). “Third-party registrations ‘may bear on conceptual weakness if a term is commonly registered for similar goods or services.’” *Id.* (quoting *Tao Licensing*, 125 USPQ2d at 1057).<sup>31</sup>

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<sup>31</sup> Evidence of use “is the only evidence relevant to the commercial weakness of [Opposer’s] mark,” *Sabhnani*, 2021 USPQ2d 1241, at \*23 (citing *Tao Licensing*, 125 USPQ2d at 1059 (“[a]s to *commercial* weakness, ‘[t]he probative value of third-party trademarks depends entirely on their usage’”) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693)), and where, as here, the involved goods are identical, third-party uses on other goods or services have “no real probative value for the analysis at hand.” *Omaha Steaks*, 128 USPQ2d at 1695. Mr. Smith was cross-examined about his knowledge of the use of various third-party BUM-formative marks, Smith Tr. 59:12-63:8 (26 TTABVUE 61-65), but he was aware only of the mark LUCKY BUM for toys and sleds, Smith Tr. 59:12-14 (26 TTABVUE 61), which is irrelevant to our analysis. The only other third-party use of a BUM-formative mark in the record is the use of the mark and trade name “The Ski Bum” by the Delaware retailer mentioned by Applicant that sells goods through its website at theskibum.com. Smith Decl. ¶ 13; Ex. A11 (13 TTABVUE 7, 425-27). According to the retailer’s website, it has been in business since 1974, and sells a variety of goods in addition to Opposer’s sun care products, including “ski and snowboard equipment footwear, outdoor clothing and outdoor accessories . . . and more.” Smith Decl. ¶ 13; Ex. A11 (13 TTABVUE 426). There is no evidence that the retailer sells any goods under its house mark “The Ski Bum,” and no evidence that any third party uses a

Applicant's main argument is that "there are numerous other trademark registrations and allowed trademark applications for similar goods as Opposer's Marks which contain the element BUM . . . rendering this portion of the mark weak as a source-identifier for similar goods," 36 TTABVUE 13, and that "evidence of numerous third-party registrations that incorporate BUM for similar or identical goods establishes the BUM portion of Opposer's Marks 'has a normally understood and well-recognized descriptive or suggestive meaning' in connection with the goods and is a weak portion of the marks." *Id.* at 14-15.

Opposer acknowledges that "Applicant has submitted copies of 41 various trademark registrations and applications with marks containing the term 'bum,'" 34 TTABVUE 31 (citing 20 TTABVUE 4-13),<sup>32</sup> but argues that "[t]his evidence provides no support for the sixth *DuPont* factor favoring Applicant" because "although third-party use of a similar mark is a relevant consideration, third-party registrations are not evidence of use or consumer awareness of such marks." *Id.* (emphasis supplied by Applicant) (citations omitted). Opposer also notes that "[o]f the 44 registrations and applications Applicant has submitted as evidence, 14 have been cancelled or abandoned for failure to file a statement of use or acceptable declaration under

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BUM-formative mark in connection with the "body and beauty care cosmetics" and "facial moisturizer" identified in the '379 Registration, or the "face creams" and "non-medicated face serum" identified in the application.

<sup>32</sup> The cited pages at 20 TTABVUE contain a table summarizing Applicant's two registrations of MIAMI BEACH BUM and the opposed application to register SKI BUM, which do not involve third-party marks for purposes of showing the conceptual weakness of the word BUM in Opposer's marks, as well as third-party registrations and applications. The third-party registrations and applications themselves appear at 20 TTABVUE 80-250.

Section 8, and thus, have no probative value.” *Id.* at 32. Opposer further argues that 24 of the marks “do not list goods in Class 003, much less goods even tenuously related to personal care products of the sort at issue here,” leaving “five marks, two of which are MIAMI BEACH BUM marks owned by Applicant,” *id.*, and that these marks have little or no probative value because of their nature. *Id.* at 33.

We agree with Opposer that Applicant’s evidence of third-party BUM-formative marks does not establish the conceptual weakness of the word BUM in the mark shown in the ’379 Registration. Applicant submitted USPTO electronic records regarding 11 third-party applications, 20 TTABVUE 80-87, 92-95, 104-07, 112-18, 158-72, 177-83, 194-201, seven of which had been abandoned by the time Applicant submitted them. *Id.* at 80-87, 112-19, 158-72. Applications “are evidence only that they were filed,” *Bond v. Taylor*, 119 USPQ2d 1049, 1054 n.11 (TTAB 2016) (citing *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007)), and “are not evidence of use of the marks.” *Inn at St. John’s*, 126 USPQ2d at 1745. Applicant’s application evidence has no probative value in showing the conceptual weakness of the word BUM in Opposer’s mark.

Applicant also submitted 30 third-party registrations. 20 TTABVUE 88-92, 96-103, 108-11, 119-57, 173-76, 183-93, 202-50. They cover a wide variety of goods, but only four, for the marks BONDI BUM, BRAZILIAN BUM BUM, CHEEKY BUM, and HONEY BUM, cover goods in Class 3. *Id.* at 108-11, 120-24, 128-31, 140-42.<sup>33</sup> The 26

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<sup>33</sup> Opposer argues in its reply brief that the registrations of CHEEKY BUM and HONEY BUM have been cancelled, 39 TTABVUE 7 n.1, but cites no supporting record evidence. “The Board does not take judicial notice of registrations in Office records,” *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at \*1 n.5 (TTAB 2020) (citation omitted), and in the

registrations covering other goods and services “have little or no probative value in showing the conceptual weakness of the word [BUM] in [Opposer’s] mark.” *Sabhnani*, 2021 USPQ2d 1241, at \*24 (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration)).

While the four marks covering goods in Class 3 “all contain the word [BUM], they contain additional elements that cause [each] of them to be less similar” to the words SUN BUM in Opposer’s mark shown in the ’379 Registration than Applicant’s SKI BUM mark is to those words. *Id.*, at \*25. Applicant’s evidence of four third-party registrations “of varying probative value,” *id.* (quoting *Inn at St. John’s*, 126 USPQ2d at 1745-46), “is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in both *Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015). *Id.*, at \*25-26 (quoting *Inn at St. John’s*, 126 USPQ2d 1745-46).<sup>34</sup> We find that Applicant did not show that the

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absence of contrary record evidence, we will treat those registrations as subsisting at the time of trial.

<sup>34</sup> “[I]n *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record . . . and in *Jack Wolfskin*, there were at least fourteen . . .” *Sabhnani*, 2021 USPQ2d 1241, at \*26 n.20 (quoting *In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1746 n.8 (TTAB 2016)).

word BUM in Opposer's mark in the '379 Registration is conceptually weak, or that the mark, in its entirety, is entitled to a narrow scope of protection.<sup>35</sup>

We turn next to Applicant's argument that the design element of the mark shown in the '379 Registration is its dominant portion. "While marks must be considered in their entireties, 'in 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.'" *Id.*, at \*30-31 (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

"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.'" *Id.*, at \*31 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). "The verbal portion of a word and design mark

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<sup>35</sup> As noted above, Applicant argues that "the other elements of Opposer's Marks are weak as they are also merely descriptive of the goods," 36 TTABVue 16, noting that "the other element, SUN, of the SUN BUM marks in Class 003, the same class as Applicant's mark, is disclaimed as it is merely descriptive of the associated goods." *Id.* Applicant concludes that Opposer's "marks as a whole are merely descriptive, or at best highly suggestive, of the listed goods, and are therefore weak on the spectrum of distinctiveness." *Id.* The '379 Registration issued without a showing of acquired distinctiveness, and we must thus presume that the registered mark is, at worst, suggestive of the goods for which it is registered. Applicant's several arguments that the mark shown in the '379 Registration is "merely descriptive" or "descriptive," 36 TTABVue 13, 16-17, 25, 28, "are inappropriate in the absence of a counterclaim to cancel" the '379 Registration. *Anheuser-Busch*, 115 USPQ2d at 1824 n.10.



‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184).

Consistent with the general principle discussed in these cases, the words Sun Bum appear alone in text in media coverage of Opposer and its products. Smith Decl. ¶ 20; Exs. A15-A16 (13 TTABVUE 10; 14 TTABVUE 113-32). Examples are shown below:



14 TTABVUE 114.

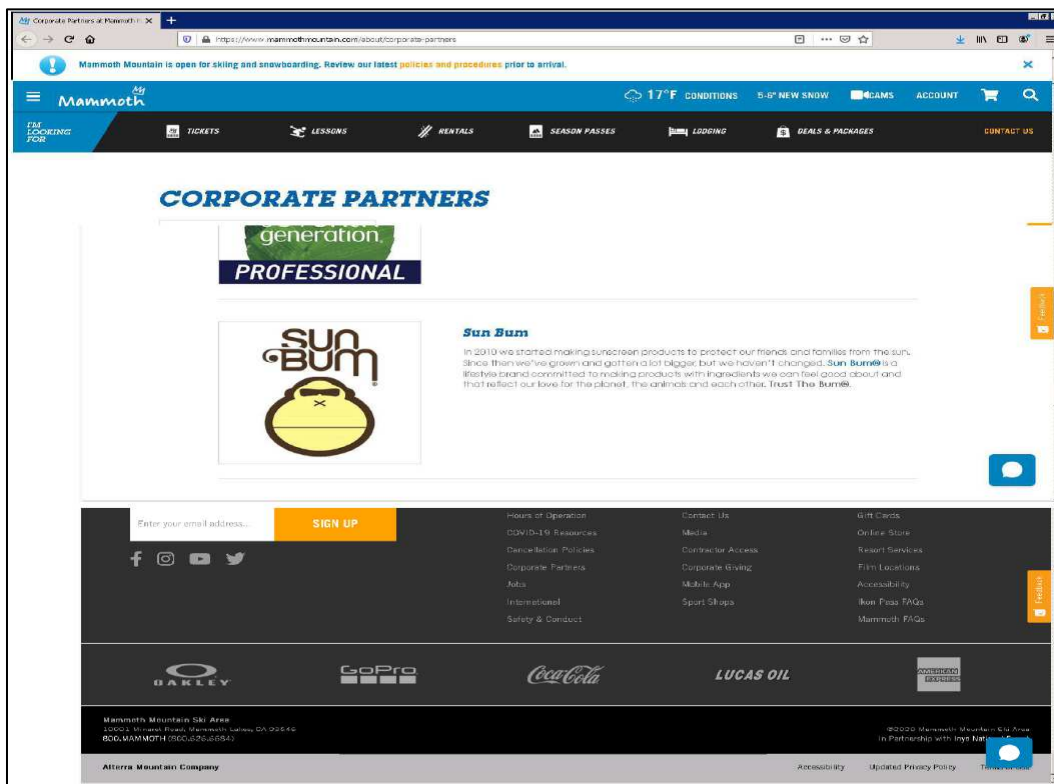


*Id.* at 122.



*Id.* at 129.

The same is true in references to Opposer's sponsorships, as exemplified below:

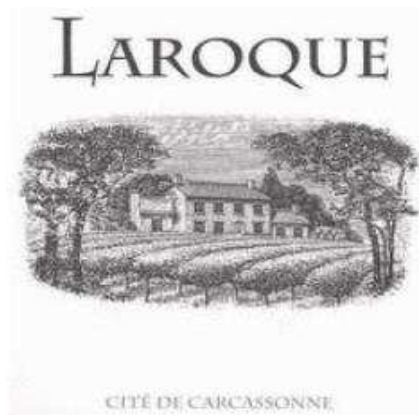


Smith Decl. ¶ 29; Ex. A27 (13 TTABVUE 14; 15 TTABVUE 8).

The mark shown in the '379 Registration, reproduced again below for ease of reference in following our discussion,



shares some of the key characteristics of the applicant's mark in *Aquitaine Wine USA*, shown below



which the Board found to be dominated by the word LAROQUE. *Aquitaine Wine USA*, 126 USPQ2d at 1185. The words SUN BUM appear above the gorilla caricature “in large, bold typeface,” *id.* at 1184, and they are “also the first [element] in the mark, further establishing [their] prominence.” *Id.* at 1184-85 (citing *Palm Bay Imps.*, 73 USPQ2d at 1692; *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)). “[B]ecause of the positioning, size and bolding” of the words SUN BUM, *Aquitaine Wine USA*, 126 USPQ2d at 1185, they are the part of the mark that is most

“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 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184).

As discussed above, Applicant cites the *Covalinski*, *White Rock Distilleries*, *Parfums de Coeur*, *Steve’s Ice Cream*, and *Ferro* cases in support of its claims that the gorilla caricature is the dominant portion of the mark shown in the ’379 Registration, and that the marks are distinguishable in appearance because of the presence of that design element in Opposer’s mark. It is axiomatic that “[e]ach case must be decided on its own facts, and the differences are often subtle ones.” *Chutter*, 2021 USPQ2d 1001, at \*29 (quoting *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973)). The cases cited by Applicant are distinguishable in any event based on differences between the records and the composite marks in those cases and the record and the composite mark here.

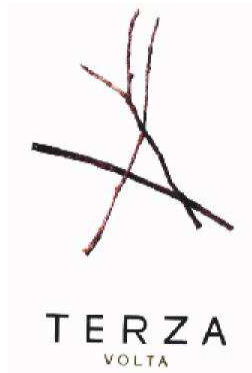
The applicant’s composite mark in the *Steve’s Ice Cream* case shown below is the one that is closest in nature to the mark shown in the ’379 Registration:



In *Steve's Ice Cream*, the Board did not expressly identify the dominant portion of the applicant's mark, but instead found no likelihood of confusion between the applicant's composite mark for "restaurant services" and the opposer's standard-character mark STEVE'S for "ice cream for consumption on and off the premises." In making that determination, the Board noted that the record showed that more than 200 restaurants and food stores operated in the United States under a STEVE'S-formative mark, *id.*, which the Board found "demonstrate[d] that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term, or something closely related to it, and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks." *Steve's Ice Cream*, 3 USPQ2d at 1479.

Here, as noted above, there is no evidence that Opposer's mark is commercially or conceptually weak in the manner of the first name "Steve's" in *Steve's Ice Cream*, and the record shows that Opposer's Sun Bum brand has achieved some commercial strength. Moreover, while we agree with Applicant that the gorilla caricature is "eye catching," 36 TTABVUE 22, it is not so prominent in size or nature vis-à-vis the word SUN BUM, unlike the "highly stylized depiction of humanized frankfurters, prancing arm in arm to musical notes" at issue in *Steve's Ice Cream*, 3 USPQ2d at 1479, to make the gorilla design the part of the mark shown in the '379 Registration that is more likely to be recalled and used to identify and refer to the goods sold under that mark.

In *White Rock Distilleries*, the Board considered the likelihood of confusion between the registered composite mark shown below for “sparkling fruit wine; sparkling grape wine; sparkling wine; wines”



and the applicant’s standard-character mark VOLTA for “energy vodka infused with caffeine.” The Board found that “the prominent design feature and the term TERZA in the registered mark serve to distinguish the registered mark visually from applicant’s mark” because “the term TERZA clearly dominates over the term VOLTA in the registered mark as TERZA appears in large bold letters above VOLTA.” *White Rock Distilleries*, 92 USPQ2d at 1284. The Board also noted that the words in the registered mark “appear[ed] in a plain block style of lettering under the more prominent design.” *Id.*

Here, as discussed above, the words SUN BUM appear in bold stylized lettering above the gorilla caricature as the first portion of the mark, and they are far more prominent vis-à-vis the gorilla design than was the word Volta vis-à-vis the design in the composite mark in *White Rock Distilleries*.

In *Covalinski*, the Board considered the likelihood of confusion between the applicant’s composite mark shown below for various types of clothing



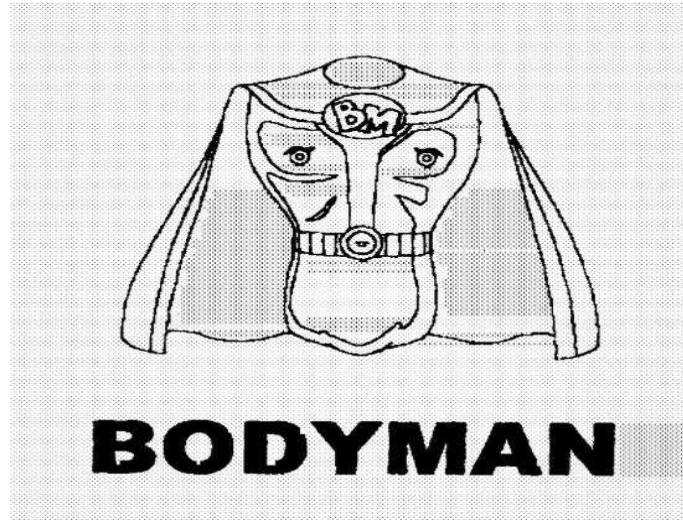
and the cited standard-character mark RACEGIRL for the same goods. The Board found that “the overall commercial impression of Applicant’s mark is dominated by its design features, particularly the large double-letter RR configuration, and that this weighs heavily against a conclusion that confusion is likely.” *Covalinski*, 113 USPQ2d at 1169. The Board based its finding on the following characteristics of the applicant’s mark:

Applicant’s design mark includes the very large, prominently displayed letters RR. The bodies of the Rs are filled with a checkerboard pattern resembling a racing flag. To each R an elongated horizontal ‘leg’ of gradually increasing thickness is appended, each of which ends in a heart design. Inside the legs appear the rest of the letters (i.e., the letter strings ‘edneck’ and ‘acegirl’), in a form in which the initial letters of each string are displayed in relatively tiny typeface and subsequent letters are displayed in increasing thickness. Together, these graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice.

*Id.* at 1168.

The mark shown in Opposer’s ’379 Registration shares none of the key characteristics of the applicant’s mark in *Covalinski*. To the contrary, the words SUN BUM are set apart from the gorilla caricature design and are plainly visible, and they are not subordinate to, much less obscured by, that design.

In *Parfums de Coeur*, the Board found that the composite mark shown below



for “entertainment services in the nature of an animated television series” was not confusingly similar to the mark BOD MAN for fragrances, in part because of its finding that the word BODYMAN was not the dominant portion of the applicant’s mark. *Parfums de Coeur*, 83 USPQ2d at 1016. The Board found, as it did with respect to the mark in *White Rock Distilleries*, that “the design is prominently displayed, being the largest element of the mark, and at the top of the mark.” *Id.* The Board also noted that the design was “reminiscent of a super hero costume,” and that the mark was “intended to be used for an animated television series,” a “visual medium.” Finally, the Board noted the significant differences between men’s fragrances and an animated television series. *Id.* at 1017.

The goods here are identical and, as noted above, the words SUN BUM appear above the gorilla caricature as the first portion of the mark, and the gorilla design is not nearly as large relative to the words SUN BUM as the super hero costume was relative to the word BODYMAN in *Parfums de Coeur*.



Finally, in *Ferro*, the Court of Customs and Patent Appeals affirmed the Board's dismissal of an opposition to registration of the composite mark shown below for rust preventative oils



based on various registered FERRO-formative word and composite marks for similar goods.<sup>36</sup> The court agreed with the applicant's argument that "the term 'gard' and the design dominate the mark sought to be registered and thus the likelihood of confusion is not present" because of "the presence of the animated bolt carrying a flag on which are the letters 'VCI'" and the fact that "the word 'gard' is in larger and bolder lower case letters than the term 'Ferro' which is in smaller letters and above the term 'gard.'" *Ferro*, 148 USPQ at 915.

Here, as discussed above, the two words SUN and BUM are of roughly equal size to one another and appear together above the gorilla caricature, which in turn is of roughly equal size to the words. *Ferro* does not support Applicant's claim that the gorilla design alone dominates the mark shown in the '379 Registration.

Having found that the words SUN BUM are the dominant portion of the mark shown in the '379 Registration, we turn to the required comparison of the marks in

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<sup>36</sup> The opposer's two registered composite marks are not shown in the reported decision from 1966.

their entireties, giving greater weight in that comparison to the words SUN BUM in the mark shown in the '379 Registration than to gorilla design element.

With respect to appearance, Applicant's SKI BUM mark is a standard character mark that "could be used in any typeface, color, or size, including the same stylization actually used . . . by [Opposer], or one that minimizes the differences or emphasizes the similarities between the marks." *Anheuser-Busch*, 115 USPQ2d at 1823. "[W]e must consider that the literal elements of the [SKI BUM] mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color of the literal portions of" the mark shown in the '379 Registration. *Aquitaine Wine USA*, 126 USPQ2d at 1186. "This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color." *Id.* (citing *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)). Accordingly, in assessing the visual similarity of the marks, we must assume that the words SKI and BUM in Applicant's mark could appear in the same font and stacked presentation as the words SUN and BUM in the mark shown in the '379 Registration, "such that the words [SKI] and BUM look very similar to one another, linking the words together in the design." 36 TTABVUE 21.

Applicant's mark SKI BUM, and the dominant portion of the mark shown in the '379 Registration, the words SUN BUM, both consist of two three-letter words, the first of which begins with S- and the second of which is the identical word BUM.<sup>37</sup>

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<sup>37</sup> We reject Applicant's argument that "[b]ecause consumers are more likely to focus on the first words of the marks, and not the weak common element BUM, the first words of the

“[M]arks ‘must be considered . . . in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *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, 3 (CCPA 1977)). Applicant’s SKI BUM mark, depicted in the stacked presentation and font of the words SUN BUM in Opposer’s mark shown in the ’379 Registration, would appear to be similar to Opposer’s mark when encountered separately by a consumer who has a general rather than specific impression and recollection of Opposer’s mark. We find that the marks are more similar than dissimilar in appearance when considered in their entirety.

With respect to sound, the mark shown in the ’379 Registration is likely to be verbalized as “SUN BUM” because the gorilla caricature is “likely to be ‘viewed, not spoken.’” *Sabhnani*, 2021 USPQ2d 1241, at \*36 (quoting *In re Electrolyte Labs., Inc.*,

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marks are the dominant portions of the marks.” 36 TTABVUE 20. We have found above that the word BUM is not a weak element of the mark shown in the ’379 Registration, and we find below that both Opposer and Applicant have built their product line extensions on the word BUM. To the extent that there is a dominant word in the SUN BUM portion of the mark shown in the ’379 Registration, it is BUM because SUN modifies, and reinforces and directs emphasis to, BUM, and has been disclaimed as descriptive of the goods identified in the ’379 Registration. *See Sabhnani*, 2021 USPQ2d 1241, at \*37 (holding that the “structure of the verbal portion of Petitioner’s mark (‘ROYAL MIRAGE’) counsels against a reflexive application of the principle cited by Respondent that ‘consumers are generally more inclined to focus on the first word, prefix o[r] syllable in any trademark or service mark’,” because ROYAL “modifies and is subordinate to the noun MIRAGE” and has been found to be highly suggestive) (internal citations omitted). *See also United Trademark Holdings, Inc. v. Disney Enters., Inc.*, \_\_\_ F.4th \_\_\_, 2022 BL 61721, at \*6 (Fed. Cir. Feb. 24, 2022) (finding that the “lead-word TEEN” in the applicant’s standard-character mark TEEN TINKER BELL for dolls was a “descriptive or suggestive adjective that merely qualifies and characterizes the rest of” the applicant’s mark, and “reinforces and directs emphasis to the rest of the mark.”). In Applicant’s mark SKI BUM, the word SKI similarly modifies and “reinforces and directs emphasis to” BUM.

913 F.2d 930, 16 USPQ2d 1238, 1240 (Fed. Cir. 1990)). Just as marks are not compared in appearance by viewing them side by side, they are not compared in sound by pronouncing them sequentially. We must consider the general impression of the sound of the words “Sun Bum” when the mark shown in the ’379 Registration is verbalized that is likely to be recalled by a consumer who subsequently hears the “Ski Bum” mark verbalized. Such a consumer may notice the differences between “Sun” and “Ski,” but is more likely to notice the identical sound of the second word “Bum.” The marks are more similar than dissimilar in sound because, when verbalized, they are both short phrases that end with the identical word BUM.

With respect to meaning, Applicant argues that “SKI BUM is a well-known word phrase, that as a whole, has a distinctive meaning” that “conveys images of a person who lives paycheck to paycheck at or near a ski resort in the mountains and spends most of their time skiing,” 36 TTABVue 26, while SUN BUM “merely describes an intended user of the identified goods, and as such, is merely descriptive of the goods.” *Id.* at 28. We agree with Applicant that the words SUN and SKI in the marks suggest warmth and cold, respectively (to the extent that SKI refers to snow skiing rather than water skiing), but as explained above, we may give greater weight to certain portions of the marks when considering the similarity or dissimilarity of the meaning of the marks as a whole. At the core of both marks is the “bum” who indulges himself or herself, in one case in the sun, and in the other with skiing.

Opposer has used the word BUM as the fulcrum of the extensions of its branding from SUN BUM into BABY BUM and TRUST THE BUM. Smith Decl. ¶¶ 7, 25

(discussing the “Bum Rush Tour” that promotes the goods at surprise surfing contests), 34. Applicant has similarly used the word BUM to extend its branding from its first product sold under the MIAM BEACH BUM mark, “our signature Bum + Body Cream in Mint and Orange,” DiPietro Decl. ¶ 16 (22 TTABVUE 6), into its SKI BUM product. DiPietro Decl. ¶¶ 8-10, 15-16, 30, 32 (22 TTABVUE 4-7). According to Applicant, MIAMI BEACH BUM and SKI BUM “are a family of related marks covering similar goods and services owned by [Applicant],” DiPietro Decl. ¶ 32 (22 TTABVUE 7). Mr. Smith similarly testified on cross-examination that he considers the SUN BUM and TRUST THE BUM marks to be part of a group or family of marks. Smith Tr. 57:11-21 (26 TTABVUE 59). The parties’ self-styled families of marks have the identical “surname,” “Bum.”

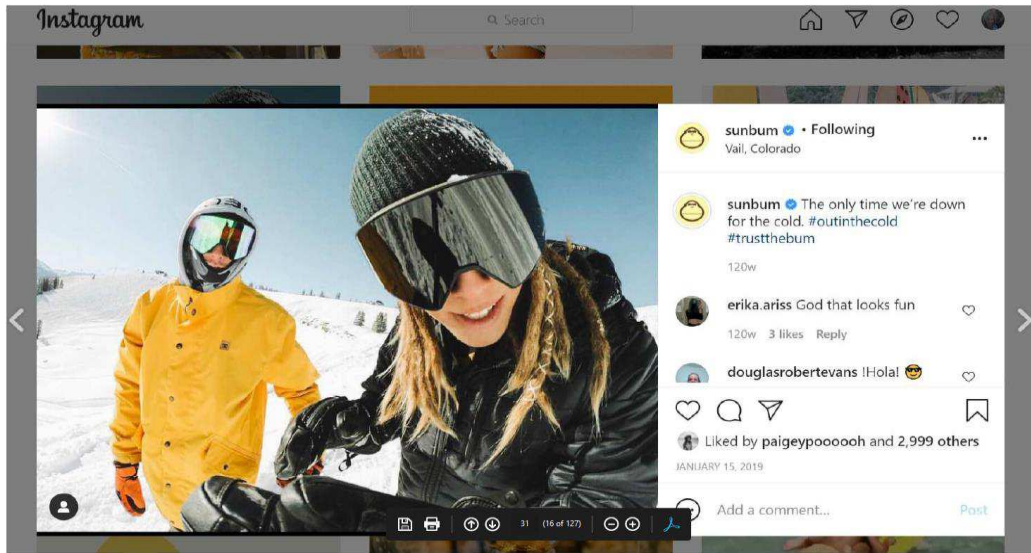
“Under the circumstances, and in the absence of any evidence to the contrary, we find that it is appropriate to give relatively less weight to the adjective[s] [SUN and SKI] than to the noun [BUM] in determining the connotation and commercial impression of [the] mark[s].” *Sabhnani*, 2021 USPQ2d 1241, at \*38 (citing *Stone Lion*, 110 USPQ2d at 1161) (holding that the Board did not err in “according little weight to the adjective ‘STONE’ in applicant’s STONE LION CAPITAL mark” in the course of “finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning and overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”).

We disagree with Applicant that the marks “are distinguishable based on the different non-BUM portions of the mark and the differences in the specific outdoor connotations invoked by each mark.” 36 TTABVUE 29 (emphasis supplied by

Applicant). Applicant admits that part of Opposer's "targeted consumers" for the goods identified in the '379 Registration are skiers, 36 TTABVUE 27-28, and Opposer has promoted those goods through promotional events related to snow skiing, sponsorships of skiing venues, and participation in trade shows directed to skiers. Smith Decl. ¶¶ 28-32, 38, 41; Exs. A26-A28, A36, A40 (13 TTABVUE 13-15, 17-18, 15 TTABVUE 4- 18, 82-87, 125-27). An example of one such promotion is depicted below:

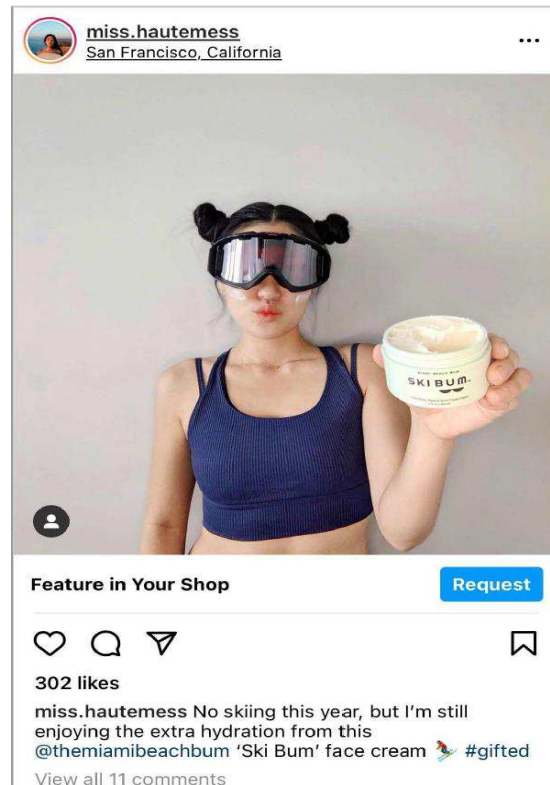


Smith Decl. ¶ 30; Ex. A40 (13 TTABVUE 14; 15 TTABVUE 127). Opposer has also promoted its goods through social media posts directed to winter sports enthusiasts:



Smith Decl. ¶ 31; Ex. A28 (13 TTABVUE 15; 15 TTABVUE 16).

The record shows that the classes of consumers for the goods identified in the '379 Registration and in the application include skiers and that the channels of trade for the identified goods include retail outlets catering to skiers. Opposer's goods have been distributed through retailers such as Alpin Haus, Confluence Kayak & Ski, Donor Ski Haus, Homewood Mountain Resort, Johnny's Ski and Board House, Mt. Hood Ski Bowl, Pyramid Ski and Snowboard Rentals, Ski Haus, Ski Hoodoo, and Skiology Ski and Sports. Smith Decl. ¶ 42; Ex. A39 (13 TTABVUE 18; 15 TTABVUE 94-97, 102-04, 107-09, 111-12, 117, 121-24). Applicant has also promoted its SKI BUM products to skiers through what Ms. DiPietro described as "influencers":



DiPietro Decl. ¶ 36; Ex. 6 (22 TTABVUE 8, 43).





DiPietro Decl. ¶ 36; Ex. 6 (22 TTABVUE 8, 46). Ms. DiPietro also stated in a video accessible on Applicant's website at [miamibeachbum.com/products/ski-bum](http://miamibeachbum.com/products/ski-bum) that "Ski Bum was inspired by my active lifestyle and minimalist routine. Whether I'm coming out of the ocean from kayaking or off the slopes from skiing this is my go to face cream for replenishing my skin." 17 TTABVUE 158 (Applicant's Response to Opposer's Request for Admission No. 3).

Against this backdrop, we find that the differences in meaning between the mark SKI BUM and the words SUN BUM, the dominant portion of the mark shown in the '379 Registration, resulting from the references to skiing and sunning oneself, are outweighed by the similarities arising from their common connotation of an outdoor enthusiast who focuses on recreation. Consumers familiar with the SUN BUM mark shown in the '379 Registration, and Opposer's BABY BUM and TRUST THE BUM line extensions, who separately encounter Applicant's SKI BUM mark for legally identical goods, could readily understand SKI BUM to be the next variant of Opposer's SUN BUM mark reflecting the extension of Opposer's line into products directed to consumers who ski in the winter and engage in other outdoor activities, including those, like Ms. DiPietro herself, who "spend a lot of time at the beach" and "also ski a lot." DiPietro Decl. ¶ 63 (22 TTABVUE 12).<sup>38</sup>

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<sup>38</sup> Mr. Smith testified on cross-examination that Opposer considered a line extension at some point under the SNOW BUM mark, which he explained "show[ed] the versatility and the ability of Sun Bum to chameleon into other categories." Smith Tr. 41:2-3 (26 TTABVUE 43). He authenticated a Snow Bum logo, mockups of Snow Bum products, and a mockup Instagram screen shot from a Snow Bum account, all of which exhibits were produced by Opposer in discovery. Smith Tr. 40:6-43:18; Exs. 4.1-4.5 (26 TTABVUE 42-45, 110-14).

We find that the SUN BUM composite mark shown in the '379 Registration and Applicant's standard character SKI BUM mark are much more similar than dissimilar in all means of comparison when they are considered in their entireties. The first *DuPont* factor thus supports a finding of a likelihood of confusion.

#### **4. Purchase Conditions and Consumer Sophistication**

“As noted above, the fourth *DuPont* factor examines both ‘the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *Sabhnani*, 2021 USPQ2d 1241, at \* 39 (quoting *DuPont*, 177 USPQ at 567). “Purchaser sophistication may tend to minimize the likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Id.*, at \*39-40 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1695 (citing *Recot*, 54 USPQ2d at 1899)). “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Id.*, at \*40 (quoting *Recot*, 54 USPQ2d at 1889).

Applicant argues that “[t]he use of the marks in the marketplace is relevant in the likelihood of confusion analysis,” 36 TTABVUE 31, and that “Applicant’s goods are high-end products that retail for \$48 for a 3oz. jar, . . . are sustainably manufactured, environmentally friendly, and use non-harmful ingredients, . . . and are targeted to women ages 25-45 who shop at boutique stores.” *Id.* According to Applicant, “[s]uch consumers are selective, taking time to review labels and verify ingredients, and are less likely to make an impulse purchase due to the high price.” *Id.* at 31-32.

Applicant contrasts its actual goods with those of Opposer, which Applicant argues “are inexpensive (e.g., sunscreen retails from \$9.99 for an 8 oz. bottle) . . . and are sold in nationwide big-box chain stores, such as Target and Walmart.” *Id.* at 32. Applicant also claims that “[i]t does not appear that Opposer has the same values as Applicant, and many of its products contain various chemicals and harmful ingredients.” *Id.* According to Applicant, “Opposer’s goods are targeted towards people of all ages, including families and children, with the goods commonly sold in family-sized packaging (e.g., 8oz. containers vs. Applicant’s 3oz. jars)” and “[s]uch consumers are often budget-conscious and would likely pay attention to product cost and/or packaging (e.g., for family-sized products). By paying close attention with purchasing decisions, consumers would be unlikely to confuse the marks.” *Id.*<sup>39</sup>

Applicant concludes that its actual goods “are akin to luxury goods, while Opposer’s goods are akin to necessity goods,” and that “Applicant’s prospective sophisticated consumers are unlikely to confuse Opposer’s necessity goods that include harmful ingredients with Applicant’s environmentally-friendly, luxury

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<sup>39</sup> Applicant cites no authority or evidence supporting its novel argument that consumers of what Applicant calls “luxury” goods and consumers of what it calls “necessity” goods will **both** exercise significant care in purchasing the goods due to their respective high and low prices, and “[a]ttorney argument is no substitute for evidence.” *Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). Applicant’s argument that purchasers of low-priced goods who “pay attention to product cost and/or packaging (e.g., for family-sized products),” 36 TTABVue 32, are unlikely to be confused as to source is both illogical and contrary to longstanding Federal Circuit precedent. By definition, such consumers care only about price (value), not source, and “[w]hen products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *FabFitFun*, 127 USPQ2d at 1673 (finding that the unrestricted “cosmetics at issue include lower cost make-up items that may be purchased without a high degree of care.”) (quoting *Recot*, 54 USPQ2d at 1899)).

goods,” while “Opposer’s prospective budget-conscious consumers are unlikely to mistake Applicant’s expensive face cream for Opposer’s cheaper family-friendly products.” *Id.*<sup>40</sup>

“Our decision under the fourth *DuPont* factor ‘must be based on the identification of goods in the [’379] Registration and [the application], as that determines the scope of the benefit of registration.’” *Sabhnani*, 2021 USPQ2d 1241, at \*41-42 (quoting *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at \*7 (TTAB 2020) (citing *Stone Lion*, 110 USPQ2d at 1162)). The goods broadly identified in the application as “face creams” and “non-medicated face serum” are not restricted to “facial moisturizer [that] is priced for sophisticated, discerning, high-end consumers,” DiPietro Decl. ¶ 57 (22 TTABVue 11), and we must deem them to “include all goods of the type identified, without limitation as to their nature and price.” *Sabhnani*, 2021 USPQ2d 1241, at \*42 (quoting *Sock It to Me*, 2020 USPQ2d 10611, at \*7). Accordingly, we must assume that the “face creams” and “non-medicated face serum” identified in the application cover both expensive and inexpensive goods. *See id.* (goods identified broadly as “perfumes” must be treated “as including inexpensive as well as high-end perfumes,” and the Board must “presume that purchasers for these goods include ordinary consumers who may buy inexpensive perfume on impulse.”) (quoting *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123

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<sup>40</sup> The relevant issue, of course, is “not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods.” *In re Embiid*, 2021 USPQ2d 577, at \*28 n.39 (TTAB 2021) (quoting *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at \*5 (TTAB 2020)).

USPQ2d 1744 (Fed. Cir. 2017)). *See also Stone Lion*, 110 USPQ2d at 1163 (“Board precedent requires the decision to be based on ‘the least sophisticated potential purchasers.’”) (quoting *Gen. Mills., Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)).

The least sophisticated consumers of the identified goods would exercise no more than ordinary care, and we find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

### **5. Absence of Evidence of Actual Confusion**

The eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Guild Mortg.*, 2020 USPQ2d 10279, at \*6 (quoting *DuPont*, 177 USPQ at 567). “The absence of any reported instances of confusion is meaningful only if the record indicates 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] mark[ ].” *Sabhnani*, 2021 USPQ2d 1241, at \*47 (quoting *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.* (quoting *Citigroup*, 94 USPQ2d at 1660).

“As noted above, our analysis of the second, third, and fourth *du Pont* factors, discussing the similarity or dissimilarity of the [goods], channels of trade, and

relevant consumers, is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the [application and '379 Registration].” *Id.* (quoting *Guild Mortg.*, 2020 USPQ2d 10279, at \*6 (emphasis in *Guild Mortg.*)). The eighth *DuPont* “factor, by contrast . . . requires us to look at **actual market conditions**, to the extent there is evidence of such conditions in the record.” *Id.*, at \*48 (quoting *Guild Mortg.*, 2020 USPQ2d 10279, at \*6 (emphasis in *Guild Mortg.*)). “Accordingly, we must look to the parties’ actual activities in the marketplace to determine whether there has been a reasonable opportunity for confusion to have occurred.” *Id.* (quoting *Citigroup*, 94 USPQ2d at 1660).

Ms. DiPietro testified that “[t]o the best of [her] knowledge and belief, there has been no consumer confusion to date relating to the origin of SKI BUM products,” that she has “never had any potential or current consumer or retailer raise any concerns about the origin of SKI BUM products, or any concerns that SKI BUM belongs to the Sun Bum company,” and that “[i]t has been almost one year since products were first sold under SKI BUM and there has been no evidence of any confusion.” DiPietro Decl. ¶ 68 (22 TTABVUE 13). Opposer does not dispute that there has been no actual confusion, but argues that the “SKI BUM product has only been for sale for a short period of time and has had only limited sales such that the absence of actual confusion does not play a roll [sic].” 34 TTABVUE 34. We agree with Opposer.

As of the time of Ms. DiPietro’s testimony, the parties’ SUN BUM and SKI BUM marks had been used concurrently for less than a year, DiPietro Decl. ¶ 68 (22 TTABVUE 13), and fewer than 200 units of products under the SKI BUM mark had

been sold, generating revenues of slightly more than \$7,000. 25 TTABVUE 293 (Applicant's Answer to Opposer's Interrogatory No. 9).<sup>41</sup> As noted above, Applicant also argues under the second and third *DuPont* factors that its sales have been made through entirely different channels of trade than those used by Opposer to entirely different customers. "Given the different channels of trade actually used by the parties and the very low level of [Applicant's] sales, there has not 'been a reasonable opportunity for confusion to have occurred'" during the brief period of concurrent use of the parties' marks. *Sabhnani*, 2021 USPQ2d 1241, at \*49 (quoting *Citigroup*, 94 USPQ2d at 1660). "We find that the eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion." *Id.*

#### **6. The Variety of Goods on Which the Sun Bum Mark is Used**

"The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used." *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at \*14 (TTAB 2020). "If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant's related good under a similar mark as an extension of the plaintiff's line." *Id.* The '379 Registration covers 16 goods in Class 3, and more than 40 other goods in Classes 16, 18, 20, 21, 24, 25, and 28, a considerable number. 25 TTABVUE 215-24. *Cf. DeVivo*, 2020 USPQ2d 10153, at \*15 (claimed common-law use of the opposer's mark on "children's books, T-shirts, tank

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<sup>41</sup> In Ms. DiPietro's Declaration, Applicant designated revenue figures for products sold under the SKI BUM mark in 2020 and 2021 as confidential, DiPietro Decl. ¶ 28 (22 TTABVUE 7), but Applicant did not similarly designate the pertinent interrogatory answer as confidential, and Opposer filed them in the publicly accessible TTABVUE files without objection from Applicant.

tops, sweatshirts, hoodies, coffee mugs, stickers, postcards, greeting cards, tote bags and informational and educational services in the STEM fields” were “insufficient to persuade us that Opposer has used her mark on a variety of goods and that this *DuPont* factor favors a finding of likelihood of confusion.”). Given our finding above that the goods are legally identical, however, we find that this factor is neutral in our analysis of the likelihood of confusion.

### **7. The Extent of Potential Confusion**

The twelfth *DuPont* factor considers the “extent of potential confusion, i.e., whether *de minimis* or substantial.” *DuPont*, 177 USPQ at 567. Opposer argues that the extent of potential confusion is substantial because of its widespread distribution of goods bearing the mark shown in the ’379 Registration. 34 TTABVUE 36. Although Applicant’s use of its mark has been quite limited to date, DiPietro Decl. ¶¶ 28-29 (21 TTABVUE 7), we have found above that the marks are similar and the goods, channels of trade, and classes of consumers are identical, so the extent of potential confusion cannot be characterized as *de minimis*. At the same time, the record does support a finding that it is substantial. We find that the twelfth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

### **8. The Thirteenth *DuPont* Factor**

“The thirteenth and final *duPont* factor pertains to ‘any other established fact probative of the effect of use.’” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*15 (TTAB 2019) (quoting *DuPont*, 177 USPQ at 567). “This includes a variety of circumstances,” *id.*, including ones in which plaintiffs claim that defendants adopted their marks in bad faith. *See, e.g., Tao Licensing*, 125 USPQ2d at 1063. Here,



however, it is Applicant, not Opposer, who invokes the thirteenth factor in claiming that Opposer has acted in bad faith because its “use of its SUN BUM marks changed after Opposer became aware of the SKI BUM product and filed the Notice of Opposition, which further supports the position that Opposer is now attempting to unfairly expand its scope of rights.” 36 TTABVUE 38.<sup>42</sup>

Applicant neither cited any cases in which the thirteenth *DuPont* factor has been used to establish a plaintiff’s bad faith (and we are aware of none), nor asserted any affirmative defense, such as unclean hands, to which its claim of bad faith might pertain. Opposer nevertheless addressed Applicant’s arguments on the merits in Opposer’s reply brief, 39 TTABVUE 14-15, so we will consider the parties’ evidence and argument under the thirteenth *DuPont* factor.<sup>43</sup>

The gist of Applicant’s argument is that Opposer adopted elements of the trade dress of Applicant’s products after Opposer became aware of them. 36 TTABVUE 38-39. Applicant argues that “[i]t appears the packaging design, which is a clear knockoff of Applicant’s product, is an attempt to create after-the-fact evidence to support its position that there is a likelihood of confusion between the marks,” *id.* at 39, and that Opposer “has likely recognized the value in this mark and is trying to unfairly expand its rights to prevent this small business from achieving success” and “does not own a

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<sup>42</sup> Applicant redacted portions of its brief discussing the thirteenth *DuPont* factor. 36 TTABVUE 38-93. We have discussed them to the extent necessary to explain our analysis of Applicant’s claim.

<sup>43</sup> Opposer redacted portions of its reply brief discussing the thirteenth *DuPont* factor. 39 TTABVUE 14-15. We have discussed them to the extent necessary to explain our analysis of Applicant’s claim.

monopoly over BUM-based marks, as evidenced by the vast number of third-party marks, and it should not be allowed to wrongly use this forum to prevent Applicant from achieving registration for its distinct and very different mark.” *Id.*

Opposer responds that the expansion of its product line “had been launched prior to the August 6, 2021 date of the [Smith] declaration,” 39 TTABVUE 14, that “Applicant did not file its application for registration of SKI BUM until February 19, 2020, well after [Opposer] had already begun working on expanding its skin care product line,” *id.* at 15, and that “the first time anyone at [Opposer] ever saw Applicant’s SKI BUM product was not until October 19, 2020, by which time [Opposer] had already selected it’s [sic] the packaging colors for its expanded skin care products.” *Id.* Mr. Smith testified regarding the process of the expansion of Opposer’s skin care line, Smith Decl. ¶ 36 (13 TTABVUE 16; 16 TTABVUE 16), and Applicant cross-examined him at some length on that subject. Smith Tr. 18:16-24; 32:16-40:5 (26 TTABVUE 20, 34-42). Mr. Smith’s testimony in his declaration, including redacted portions, and his testimony on cross-examination, support the chronology of events discussed in Opposer’s reply brief. We find that the thirteenth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

### **9. Summary of the *DuPont* Factors**

The first, second, third, fourth, and fifth *DuPont* factors support a finding of a likelihood of confusion to one degree or another, while the sixth, eighth, ninth, twelfth, and thirteenth *DuPont* factors are neutral. The goods, channels of trade, and classes of consumers are identical, the marks are similar, and Opposer’s composite SUN BUM mark shown in the ’379 Registration is conceptually strong and we have

placed it on the “strong” end of the commercial strength spectrum from very strong to very weak and have found that it is entitled to more than the normal scope of protection. Applicant did not show that the mark shown in the ’379 Registration has been weakened conceptually or commercially by third-party uses and registrations of BUM-formative marks, the absence of evidence of actual confusion is immaterial under the circumstances, and Opposer did not act in bad faith in extending the use of its SUN BUM mark to additional goods.

On the basis of the record as a whole, we find that Opposer proved, by a preponderance of the evidence, that Applicant’s use of its SKI BUM mark for legally identical goods is likely to cause confusion as to the source or sponsorship of those goods.

**Decision:** The opposition is sustained.

2019 WL 4034463 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

VOLVO TRADEMARK HOLDING AB

v.

WOLVOL INC.

Opposition No. 91207836

July 29, 2019

\*[1 Leigh Ann Lindquist](#) of Sughrue Mion PLLC for Volvo Trademark Holding AB  
[Michael Smaila](#) and [Michael Steinmetz](#) of Garson, Segal, Steinmetz, Fladgate LLP for Wolvol Inc.

Before [Zervas](#), Lynch and English  
Administrative Trademark Judges  
Opinion by Lynch  
Administrative Trademark Judge:

Wolvol Inc. (“Applicant”) seeks registration on the Principal Register of WOLVOL in standard characters,<sup>1</sup> for “Computer screens; Computer touchscreens; Electronic writing tablets; Laptop computers; Laptops; Notebook and laptop computers; Notebook computers; Overlays specially adapted for touchscreen displays; PC tablet; Tablet computer” in Int. Class 9.

Volvo Trademark Holding AB (“Opposer”) opposes registration of Applicant’s mark based on alleged dilution under Section 43(c) of the Trademark Act, [15 U.S.C. § 1125\(c\)](#), and likelihood of confusion under Section 2(d) of the Trademark Act, [15 U.S.C. § 1052\(d\)](#), with 22 of Opposer’s registered VOLVO and VOLVO-formative marks for vehicles and a variety of other goods and services. Opposer submitted a TSDR printout for each registration.<sup>2</sup>

In its amended Answer, Applicant denies the salient allegations in the Notice of Opposition. The opposition is fully briefed.

## I. Evidentiary Record

The record includes the pleadings and pursuant to [Trademark Rule 2.122\(b\)](#), [37 C.F.R. § 2.122\(b\)](#), the file of the opposed application. Opposer introduced the testimony deposition on written questions of Monica Dempe, its managing director and trademark manager, with 77 accompanying exhibits.<sup>3</sup> Opposer also submitted a First Notice of Reliance<sup>4</sup> on Internet materials consisting of magazine and newspaper articles referring to VOLVO, a Second Notice of Reliance consisting of Internet materials about books, movies, and songs referring to VOLVO,<sup>5</sup> and a Third Notice of Reliance on third-party registrations of marks for computer goods in International Class 9 and vehicles in International Class 12.<sup>6</sup> Applicant did not submit any evidence.

## II. Standing

Opposer must prove standing by showing a real interest in the outcome of the proceeding and a reasonable basis for believing that it would suffer damage if the mark is registered. *See* [15 U.S.C. § 1063](#); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, [753 F.3d 1270](#), [111 USPQ2d 1058](#), [1062 \(Fed. Cir. 2014\)](#). Opposer’s pleaded registrations, for which Opposer has proven status and title, establish its standing. *See* *Coach Servs. v. Triumph Learning LLC*, [668 F.3d 1356](#), [101 USPQ2d 1713](#), [1727-28 \(Fed. Cir. 2012\)](#); *Cunningham v. Laser Golf Corp.*, [222 F.3d 943](#), [55 USPQ2d 1842](#), [1844 \(Fed. Cir. 2000\)](#).

## III. Priority

\*2 Because Opposer has made its registrations of record, which Applicant has not counterclaimed to cancel, priority is not an issue as to the marks and goods or services covered by the registrations. See *Top Tobacco LP v. N. Atl. Op. Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy, Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)). See also *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation.”); *Intel Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) (“because of the existence of opposer’s valid and subsisting registration, it need not prove prior use as to the services recited therein”).

#### IV. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “DuPont factors”); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods. See *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.”). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. A finding of likely confusion must be made with respect to at least one item in the application to establish likely confusion as to that single class of goods. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

##### A. The Goods, Trade Channels and Classes of Consumers

In comparing the marks, goods, trade channels and classes of consumers, we focus on Opposer’s Registration Number 3803216 (‘216 Registration) for the mark VOLVO in standard characters for goods and services that include computers and video screens in International Class 9. We consider the mark and goods in this registration most relevant to the likelihood of confusion analysis. See *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

\*3 “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). Our comparison of the goods is based on the identifications in the application and Opposer’s ‘216 Registration. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Because the computers and video screens identified in the ‘216 Registration do not contain any purchaser, type or trade channel restrictions, and thus are unrestricted, Opposer’s identification of goods encompass all types of those goods. See, e.g., *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Linkvest S.A.*, 24 USPQ2d at 1716 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s goods encompass all such computer programs including those which are for data integration and transfer.”). Therefore, Opposer’s goods are legally identical in part to the various types of computers and computer screens Applicant has identified.

Because the goods in the application and Opposer’s ‘216 Registration are legally identical in part, we presume that they travel through the same channels of trade to the same classes of purchasers, considerations under the third DuPont factor. See *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”); see also *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion). While Applicant attempts to narrow the goods in the ‘216 Registration so as to distinguish their trade channels from Applicant’s, we cannot accept this argument. *Stone Lion Capital Partners*, 110 USPQ2d at 1162 (“It was proper, however, for the Board to focus on the application and registrations rather than on real world conditions, because ‘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.” (quoting *Octocom Sys.*, 16 USPQ2d at 1787)). The identification of “computers” and “video screens” in the ‘216 Registration is unrestricted, see *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000), and therefore we cannot consider asserted actual marketplace conditions based on the alleged types of computers and video screens that Opposer actually sells. See *Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (“As described above, the registration does not set forth any restrictions on use and therefore ‘cannot be narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers.’”).

**\*4** These factors weigh strongly in favor of a finding of likely confusion.

#### B. The Fame of Opposer’s Marks

The fame of a mark under the fifth *DuPont* factor 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 Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). This factor involves assessing the mark “‘along a spectrum from very strong to very weak.’” *Id.* (internal citations omitted). A famous mark receives broader legal protection in the likelihood of confusion analysis. See *Palm Bay Imps.*, 73 USPQ2d at 1694 (strong marks “enjoy wide latitude of legal protection” and are “more attractive as targets for would-be copyists”). The protection accorded a famous mark does not extend only to products that are identical or closely related to those for which the mark is famous. *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897-98 (Fed. Cir. 2000) (holding that the Board erred in limiting fame of FRITO LAY only to human food products, as fame extends beyond the particular field and “must always be accorded full weight”). Where a mark is famous, that fame plays a dominant role in the likelihood of confusion analysis. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353 (TTAB 2014).

The fame of a mark may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods and services sold under the mark, and other factors such as length of use of the mark; widespread critical assessments of the goods or services sold under the mark; notice by independent sources of the goods and services identified by the marks; and the general reputation of the goods and services. *Id.* at 1354; see also *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength).

Opposer has submitted evidence bearing on each of these factors, and each weighs in favor of finding that Opposer’s VOLVO marks have significant commercial strength. In addition to its large number of registrations, and long use of its marks in the United States since the 1950s,<sup>7</sup> Opposer submitted a wide variety of evidence of significant consumer exposure to its marks.<sup>8</sup> For example, Opposer advertises and promotes its VOLVO marks in most types of media. According to Ms. Dempe, VOLVO goods and services are advertised and promoted:

**\*5** [i]n virtually every way possible, including but not limited to national and international magazines and newspapers, local and regional television and radio commercial, direct mail, on the Internet, in product and sales brochures, signage, trade shows, dealer meetings and sponsorships such as the Volvo Ocean Race and other events. Volvo dealers also advertise Volvo branded products through local and regional print publications, especially magazines and newspapers, on outdoor billboards, in radio commercials, television commercials and through direct mail. In addition, Volvo dealers have their own website where Volvo branded goods are promoted.<sup>9</sup>

The record includes corroborating examples. Opposer’s confidential advertising and promotional expenses are included in the record, and reflect a very substantial expenditure in the five-year period prior to trial.<sup>10</sup> Opposer also provided confidential evidence of considerable sales figures under the marks from 2004 to 2015, with specific information pertaining to VOLVO cars, other VOLVO products excluding cars, VOLVO trucks, VOLVO car parts and accessories, VOLVO Penta engines, and VOLVO truck parts.<sup>11</sup> See, e.g., *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2020 (TTAB 2014). These figures suggest widespread consumer exposure to the marks.

The record also contains evidence of unsolicited media attention for goods and some services under the VOLVO marks through national publications such as *Forbes*, *Car and Driver*, *USA Today*, *The Wall Street Journal*, *The New York Times* and *The Washington Post*, among others.<sup>12</sup> The evidence includes profiles of VOLVO vehicles, articles and reviews about them, and articles on major sporting events sponsored under the VOLVO mark.<sup>13</sup> The record reflects that Opposer has

arranged for use of the VOLVO mark in connection with sponsorship of sailing, golf and cultural events.<sup>14</sup> There are numerous books about VOLVO vehicles, and books and songs that include VOLVO in their titles.<sup>15</sup> The evidence establishes the fame of the VOLVO marks, even to the point of having pop culture significance. *See, e.g., UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1887 (TTAB 2011) (inferring public recognition of MOTOWN mark based on use of mark for almost 50 years, extensive nationwide sales of opposer's recordings as well as numerous concerts and television appearances featuring its music and artists and extensive nationwide promotion of mark through traditional advertising and sale of collateral goods); *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1024-27 (TTAB 2011) (finding opposer's JUST DO IT mark famous based on pervasive third-party press and media references, substantial advertising, publicity and nationwide sales and ownership of registrations).

**\*6** Most of the fame evidence centers on VOLVO vehicles, and some relates to technology aspects in particular, like an NBC News article about VOLVO's safety technologies such as an infrared laser attached to a car windshield to monitor traffic,<sup>16</sup> a Huffington Post article on advanced steering and sensory technology featured in some VOLVO vehicles,<sup>17</sup> and a Fox News article captioned "Volvo Unveils New Hybrid Technology."<sup>18</sup> Considering the volume and nature of the fame evidence, we find that the fame of VOLVO extends beyond just vehicles and transfers to computer and video screen goods that we find most relevant to this proceeding. *Cf. Recot*, 54 USPQ2d at 1897 (erroneous to find that fame "extends no further than the products with which the marks are currently used" because fame "is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods").

VOLVO is fanciful and conceptually strong as a mark to those unfamiliar with the dead language Latin. *Cf. Palm Bay Imports*, 73 USPQ2d at 1692 (only marks containing words from common, modern languages are translated); *In re Vacuumschmelze GMBH*, 201 USPQ 878 (TTAB 1979) ("foreign words may be meaningless to the public generally"). Opposer has stated that VOLVO means "I am rolling" in Latin.<sup>19</sup> As Latin is not a living language, most relevant customers likely would be unaware of this meaning. Thus, the wording VOLVO probably would be perceived either as a fanciful term or, for those familiar with Latin, as a slightly suggestive word, at least in the context of vehicles and related goods and services.

Finally, as discussed in more detail below, the record includes no current thirdparty use or registration evidence of VOLVO or other similar marks in connection with similar goods and services that could detract from the strength of VOLVO.

The fame of Opposer's marks weighs in favor of a finding of likelihood of confusion.

### C. Similarity of the Marks

With respect to the marks, we must compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Similarity in any one of the elements of sound, appearance, meaning, or commercial impression suffices to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion"); *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.").

**\*7** We compare the standard-character mark VOLVO in the '216 Registration to the applied-for standard-character mark WOLVOL, bearing in mind that given the legally identical goods, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Also, based on our earlier finding that VOLVO is a famous mark, we must consider that a famous mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Ind., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Of the five letters in the registered VOLVO mark, WOLVOL shares four of them, and presents them in the same order. The V and the W at the respective beginnings of the marks and the common OLVO portion of the marks contribute to a similar overall sound. While the letters V and W do not make the identical sound, their sounds are somewhat similar. Opposer



contends that the “L” at the end of WOLVOL “is almost silent.”<sup>20</sup> In assessing how the marks sound, we are mindful that “there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.” *Viterra*, 101 USPQ2d at 1912. Some consumers may pronounce WOLVOL as characterized by Opposer, while others may pronounce the “L” more distinctly. Regardless of any potential phonetic variation in this regard, we find the overall sound of the marks to be similar.

As to the appearance of the marks, the placement of the same letters, OLVO, after the first letter in each mark creates a resemblance. While there are some differences in how the marks look, overall, the shared string of OLVO letters especially, in connection with the other lettering, forms a general visual similarity that is not overcome by the differences between the marks.

Finally, as previously mentioned, Ms. Dempe testified that VOLVO means “I am rolling” in Latin,<sup>21</sup> the ‘216 Registration contains a translation to this effect, and the parties point to no other evidence about the connotations and commercial impressions of VOLVO or WOLVOL. While Applicant argues that consumers then would recognize the meaning of VOLVO, but perceive WOLVOL as a fanciful word, as we noted earlier, most relevant customers likely would perceive VOLVO as a fanciful word as well. Thus, we find that the connotations and commercial impressions of the marks are not a significant point of distinction.

Applicant has criticized Opposer’s omission of expert testimony, survey evidence, or consumer testimony regarding the similarity of the marks; such evidence is not required for us to find that marks are similar. In addition, Applicant cites numerous cases where no likelihood of confusion was found because the marks were considered dissimilar, and argues the cases are analogous to this case. However, the comparison of specific marks at issue in a case is highly fact-specific and unique to the marks involved and the interplay with other *DuPont* factors such as fame and relatedness of the goods, so we do not consider the cited cases persuasive on this point.

**\*8** In light of the renown of the VOLVO mark and the identical goods at issue, given the similarity in appearance and sound of the marks, this *DuPont* factor weighs in favor of a finding of likely confusion.

#### D. Degree of Care in Purchasing

Applicant contends, without pointing to supporting evidence, that Opposer’s goods “are special purchases costing significant sums of money,” such that consumers would purchase with care and deliberation.<sup>22</sup> We rely on the relevant identified goods in the ‘216 Registration and in the application, which encompass computers and screens that could range from fairly inexpensive ordinary consumer goods to the more expensive variety. See *Stone Lion Capital Partners*, 110 USPQ2d at 1163 (“Accordingly, the Board properly considered all potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement. Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”). Given the ubiquity of computers and related equipment in everyday life, consumers of these products would exercise nothing more than ordinary care when purchasing them. See *In re Linkvest*, 24 USPQ2d at 1716 (“the growing tendency is for computers and computer programs to be purchased and operated by the general public. Business, home and educational use of computers has expanded the computer market to encompass many poorly informed and unsophisticated purchasers”). While we do not have price information for computers and video screens specifically, the confidential information regarding the pricing of vehicle parts under the mark confirms that some prices are quite low.<sup>23</sup> See *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009) (“purchasers of casual, low cost ordinary consumer items exercise less care in their purchasing”). Considering the identified goods and the relevant evidence, we find that ordinary consumers purchasing these goods would exercise an ordinary degree of care.

#### E. Other *DuPont* Factors

The parties briefly argue a couple of other *DuPont* factors. First, Opposer contends that it is entitled to a broader scope of protection under the sixth factor because “[t]here is no evidence of record showing any third party use of VOLVO in any field.”<sup>24</sup> Applicant asserts, without pointing to any evidence in the record, that seven registered marks exist, VOLT, VOLETERRA, VOLANTE, VOLITO, VOLLERT, VOLAGE, and LOVOL, supposedly for products “more closely associated with Opposer’s core business.”<sup>25</sup> According to Applicant, its mark therefore can coexist with Opposer’s marks.



Applicant's argument carries no weight given that it did not introduce any evidence to support its argument. As noted above, we have found Opposer's VOLVO mark both commercially and conceptually strong.

\*9 Second, Opposer acknowledges the lack of actual confusion evidence in the record, but correctly notes that given Applicant's failure to introduce any evidence, "there is nothing of record to determine if Applicant has had sufficient use of the WOLVOL Mark for any opportunity for instances of actual confusion to occur."<sup>26</sup> See *Cunningham*, 55 USPQ2d at 1847 (approving TTAB finding that "it could not conclude there had even been an opportunity for actual confusion"). Accordingly, we consider this factor neutral.

## V. Conclusion

Based on the similarity between Opposer's famous mark and Applicant's mark for legally identical goods that travel in the same channels of trade to the same classes of purchasers who will use ordinary care in their purchases, we conclude that a likelihood of confusion exists.

Given this determination, we need not reach Opposer's dilution claim.

**Decision:** The opposition is sustained based on Opposer's claim of likelihood of confusion.

## Footnotes

<sup>1</sup> Application Serial No. 85453974 was filed on October 23, 2011 based on use of the mark in commerce as of October 1, 2011 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

<sup>2</sup> 1 TTABVUE (Notice of Opposition). Citations refer to TTABVUE, the Board's online docketing system. The parties also should have cited to TTABVUE when referring to the evidence and other parts of the record. See *Turbin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

<sup>3</sup> 30-58 & 60 TTABVUE.

<sup>4</sup> 61-64 TTABVUE.

<sup>5</sup> 65 TTABVUE.

<sup>6</sup> 66 TTABVUE.

<sup>7</sup> 30 TTABVUE 22-23 (Dempe testimony).

<sup>8</sup> Our analysis of the strength of Opposer's marks includes all of the marks.

<sup>9</sup> 30 TTABVUE 63-64 (Dempe testimony).

<sup>10</sup> 30 TTABVUE 64-65; 29 TTABVUE 7-13 (Dempe testimony) (confidential).

<sup>11</sup> 30 TTABVUE 62-65, 71-72; 29 TTABVUE 7-13 (Dempe testimony) (confidential).

<sup>12</sup> 61-64 TTABVUE.

<sup>13</sup> *Id.*

<sup>14</sup> 30 TTABVUE 67-68 (Dempe testimony).

<sup>15</sup> 65 TTABVUE.

<sup>16</sup> 62 TTABVUE 178.

<sup>17</sup> 62 TTABVUE 166-67.

<sup>18</sup> 62 TTABVUE 206.

<sup>19</sup> 30 TTABVUE 79 (Dempe testimony).

<sup>20</sup> 81 TTABVUE 21 (Opposer's Brief).

<sup>21</sup> 30 TTABVUE 79 (Dempe testimony).

<sup>22</sup> 88 TTABVUE 25 (Applicant's Brief).

<sup>23</sup> 29 TTABVUE 11 (Dempe testimony) (confidential).

<sup>24</sup> 81 TTABVUE 29 (Opposer's Brief).

<sup>25</sup> 88 TTABVUE 26 (Applicant's Brief). We note that one of these marks was the subject of a prior Board proceeding, and Applicant appended the non-precedential case to its Brief. However, this does not suffice to introduce evidence of a third-party registration into the record.

<sup>26</sup> 81 TTABVUE 29 (Opposer's Brief).

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2019 WL 4034463 (Trademark Tr. & App. Bd.)

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