THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 6, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Mattel, Inc.
v.
BarBee Inc.

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Opposition No. 91281982

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Brian D. Wassom of Warner Norcross + Judd LLP,
for Mattel, Inc.

Rexford Brabson and David Stewart of T-Rex Law PC,
for BarBee Inc.

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Before Allard, Elgin, and Stanley,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

BarBee Inc. ("Applicant") seeks registration on the Principal Register of the composite word and design mark

("INC." disclaimed) for "Online

social networking services accessible by means of downloadable mobile applications," in International Class 45.[1]

Mattel, Inc. ("Opposer") has opposed registration of Applicant's mark on the basis of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its common law rights in and ownership of forty registered BARBIE and BARBIE-formative marks for a wide variety of goods and services, including:

- BARBIE (in typeset form) for "Doll," in International Class 28;[2]
- BARBIE (in typeset form) for "doll clothes and doll accessories," in International Class 28;[3] and
- BARBIE (in typeset form) for "providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children."[4]

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[1] Application Serial No. 97081593 was filed on October 19, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce. The mark is described as "consist[ing] of a solid black square background featuring the stylized wording BarBee with Bar in white and Bee in orange centered above the stylized smaller wording INC. in white below a stylized white martini glass with a splashing orange liquid emitting an orange bee design consisting of orange antennas, an orange-outlined circular head, wings and body with 2 orange horizontal lines." The colors black, white, and orange are claimed as a feature of the mark.

[2] 1 TTABVUE 20. Reg. No. 689055, issued December 1, 1959; maintained. 22 TTABVUE 5-10.

The mark is registered in typeset form. "Standard character" marks were previously known as "typed" or "typeset" marks. *In re Viterra Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012). A typed or typeset mark is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 807.03(i) (2025).

Citations to the record and briefs reference TTABVUE, the Board's online docket system. Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of that particular docket entry.

[3] 1 TTABVUE 21. Reg. No. 768397, issued April 21, 1964; maintained. 22 TTABVUE 22-27. For an explanation of typeset form, *see* discussion *supra* note 2.

[4] 1 TTABVUE 22. Reg. No. 2495195, issued October 9, 2001; maintained. 22 TTABVUE 87-89. For an explanation of typeset form, *see* discussion *supra* note 2.

Opposer also claims that its BARBIE mark is both distinctive and famous, that it became famous within the meaning of 15 U.S.C. § 1125(c) "well before both the filing date of the opposed Application, and before any first use alleged by Applicant[,]" and that any use by Applicant of its mark is likely to cause dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).[5]

In its Answer, Applicant denied the salient allegations of the Notice of Opposition.[6]

The matter is fully briefed.[7] Opposer bears the burden of proving its claims by a preponderance of the evidence. *See Genesco Inc. v. Martz*, No. 91121296, 2003 TTAB LEXIS 123, at *22 (claims of priority and likelihood of confusion and dilution must be proven by a preponderance of the evidence). Having considered the evidentiary record, the parties' arguments and applicable authorities, we find that Opposer has not carried this burden. We dismiss the opposition.

I. Opposer's Motion to Amend its Notice of Opposition to Add Claims

On January 31, 2025, one day before the expiration of its rebuttal period,[8] Opposer filed a motion seeking to amend its Notice of Opposition under Rule 15 of the Federal

[5] 1 TTABVUE 19-20, 25-26 (paras. 4-9, 21-28).

[6] 4 TTABVUE 4-7. Applicant's purported affirmative defenses are not true affirmative defenses, but rather constitute amplifications of Applicant's denials of the allegations of likelihood of confusion and likelihood of dilution, and, as a result, are permissible. *See e.g., ProMark Brands, Inc. v. GFA Brands, Inc.*, No. 91194974, 2015 TTAB LEXIS 67, at *5 n.11.

[7] Opposer's opening brief appears at 49 TTABVUE, Applicant's brief appears at 50 TTABVUE, and Opposer's reply brief appears at 51 TTABVUE.

[8] 40 TTABVUE 1 (denoting that rebuttal periods ends February 1, 2025).

Rules of Civil Procedure to add two grounds for opposition to conform to the trial evidence, namely, that (1) "[A]pplicant Barbee Inc. lacked the **bona fide** intent to use the applied-for mark under 15 U.S.C. § 1051(b) because it has never existed, and (2) even if, in the alternative, the entity Barbee LLC ever had any cognizable rights in the Application, it has abandoned those rights by ceasing to exist."[9] The Board deferred consideration of Opposer's Motion to Amend its Notice of Opposition until final decision.[10] Inasmuch as Opposer did not pursue its claim based of abandonment in its brief, i.e., its alternative position set out in part (2),[11] we need not consider it. *See, e.g., Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, No. 91187092, 2013 TTAB LEXIS 515, at *2 n.3 (opposer's pleaded claims not argued in its brief deemed waived), *aff'd*, 787 F.3d 1368 (Fed. Cir. 2015).

Therefore, we are left to consider whether the Notice of Opposition should be amended to conform to the trial evidence to add the ground set forth in part (1) above, i.e., Opposer's claim that Applicant lacked the bona fide intent to use the involved mark because it never existed.

Specifically, Opposer seeks to amend its Notice of Opposition to add the following:

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[9] 44 TTABVUE 2 (italics in original, bold here).

[10] 44, 48 TTABVUE.

[11] Opposer's failure to pursue this claim is understandable. As mentioned in this Board's previous order (48 TTABVUE 1 n.1), an abandonment claim is not available against the involved application inasmuch as it is based on Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) and no statement of use has been filed. *See Qualcomm Inc. v. FLO Corp.*, No. 91182244, 2010 TTAB LEXIS 52, at *4 ("With respect to the ground of abandonment, this ground is not available when the opposed application is based on Section 1(b). Use of a mark that is the subject of an application alleging a bona fide intent to use is not required until the applicant files a statement of use.").

> No Bona Fide Intent to Use, 15 U.S.C. § 1051(b)
>
> 36. Opposer incorporates herein by reference each of the foregoing paragraphs.
>
> 37. The Application identifies a nonexistent entity as the owner of Applicant's Mark.
>
> 38. The Applicant, BarBee Inc., did not have a **bona fide** intention to use the mark in commerce at the time the Application was filed because it did not exist.[12]

Applicant opposes the motion, arguing that the proposed amendment comes far too late in the proceeding and is prejudicial.[13] Moreover, Applicant adds, Barbee LLC is active and has continuously maintained rights in the mark and attaches to its motion evidence of its "corporate reactivation," which consists of an invoice for services consisting of "Standard Florida Reinstatement filing."[14]

Fed. R. Civ. P. 15(b), as made applicable by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), provides in pertinent part:

> When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move—at any time, even after judgment—to amend the pleadings to conform them to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.

Id.; see also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.03(b) (2025) ("When issues not raised by the pleadings are tried by the express or implied consent of the parties, unless prohibited by 37 C.F.R. § 2.107, the Board

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[12] 44 TTABVUE 19 (italics in original, bold here).

[13] 46 TTABVUE 3-4.

[14] 46 TTABVUE 4, 9.

will treat them in all respects as if they had been raised in the pleadings. … Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the result of the trial of these issues.”).

Thus, to decide the motion to amend to conform to the evidence, we must determine whether the putative claims were tried by express or implied consent under Fed. R. Civ. P. 15(b)(2). *See Hangzhou Mengku Tech. Co. v. Shanghai Zhenglang Tech. Co.*, No. 91272143, 2024 TTAB LEXIS 575, at *16.

It is clear from Applicant’s opposition to the motion to amend that it did not expressly consent to the trial of the unpleaded claim. As for whether there was implied consent, such can be found only where the non-moving party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the unpleaded issue. *See Moke Am. LLC v. Moke USA, LLC*, No. 91233014, 2020 TTAB LEXIS 18, at *32-33; *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, No. 91173806, 2009 TTAB LEXIS 445, at *11; *Boise Cascade Corp. v. Cascade Coach Co.*, 1970 TTAB LEXIS 371, at *5-6 (“Generally speaking, there is an implied consent to contest an issue if there is no objection to the introduction of evidence on the unpleaded issue, as long as the adverse party was fairly informed that the evidence went to the unpleaded issue.”). The question of whether an issue was tried by consent is basically one of fairness. *Morgan Creek*, 2009

TTAB LEXIS 445, at *16. "The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter." *Id*.

The parties agree that the question about Applicant's corporate existence at the time the subject application was filed was first raised during Opposer's testimony cross-examination of David Wayne Muirhead, Applicant's founder.[15] However, during cross-examination, counsel for Applicant objected to a series of questions, including those regarding an interview that Mr. Muirhead gave to an entity in the United Kingdom referred to by the parties as "Channel 4,"[16] which centered on the present opposition proceeding.[17] Applicant's counsel offered two bases for the objection to questions about the UK interview: (1) this issue, raised on cross-examination, improperly extended beyond the scope of direct examination, and (2) was properly the subject of a discovery deposition, not testimony cross-examination.[18]

As part of this line of questioning about the UK program, the following exchange took place about Applicant's name:

15 Q And quite often you just call it BarBee; right?

16 A Not at all. Not at all. It's BarBee, Inc. That's

17 what I always say, BarBee, Inc.

18 Because our business -- our actual

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[15] 44 TTABVUE 3; 46 TTABVUE 3; 41 TTABVUE 6, 7.

[16] Opposer's counsel stated that the interview that Mr. Muirhead gave in the UK was conducted by "Channel 4." 41 TTABVUE 11 (Muirhead Cross-Examination Transcript ("Muirhead Cross Ex. Tr.") 9:22-23).

[17] 41 TTABVUE 11-16 (Muirhead Cross Ex. Tr. 9:22-14:3).

[18] 41 TTABVUE 11, 12-13 (Muirhead Cross Ex. Tr. 9:22-10, 10:17-11:14).

19 business license is BarBee, LLC. So BarBee, Inc.

20 is just BarBee, Incorporated.

21 Actually, I always just say BarBee,

22 Incorporated. But we couldn't be incorporated

23 because we're an LLC. That's where that confusion

24 came from.

25 Q Right. That whole interview with Channel 4, it was

1 referred to as BarBee; right? · I don't think the

2 word "Inc." was ever used.

·3 A We're going to have to go back and dissect that

4 sucker, because I'm just going to have to see if it

5 was used.[19]

We deny Opposer's motion to amend its pleading. Not only was this line of questioning objected to by Applicant, Applicant's statement that the evidence was properly the subject of a discovery deposition suggests to us that Applicant considered the information a new issue. Moreover, this line of questioning, which concluded with counsel asking if Applicant was referred to as simply as "BarBee," was likely construed as questions to determine the dominant term of Applicant's mark, not the basis of a new claim as to whether a particular entity had a bona fide intent to use the mark. No redirect examination of Mr. Muirhead was taken, further indicating that Applicant did not consider the issue as having been tried. *See Morgan Creek*,

[19] 41 TTABVUE 46-47 (Muirhead Cross Ex. Tr. 44:15-45:5). *See* 44 TTABVUE 3.

2009 TTAB LEXIS 445, at *16 ("The fact that applicant took no redirect after the testimony with respect to dress shirts was elicited on cross examination is a further indication that applicant did not regard the issue of fraud as having been tried.").

Opposer's notice of reliance does not support Opposer's position. Opposer's Fifth Notice of Reliance states that the documents submitted therewith consisting of records from the Florida Division of Corporations are offered to show that "Barbee Inc. does not exist and that 'Barbee LLC' has been dissolved."[20] This same notice of reliance states that select office actions and an examiner's amendment issued during the prosecution of the involved application demonstrate that Applicant "was given the opportunity to correctly identify itself, and chose to identify as 'Barbee Inc.'"[21] While the notice of reliance may be fairly read to indicate that Opposer contends Applicant has misidentified itself and that its corporate entity may have been administratively dissolved, this hardly puts Applicant on notice that Opposer intends to claim that Applicant lacked the requisite intent to use the mark in commerce as of the application filing date.

On this record, Opposer has not demonstrated that Applicant was fairly apprised that the evidence was being offered in support of the unpleaded issue. For these reasons, Opposer's motion to amend is **denied**.

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[20] 43 TTABVUE 2.

[21] 43 TTABVUE 2.

II. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file history of the involved application.

In addition, Opposer introduced the following evidence during its case-in-chief:

- Opposer's First Notice of Reliance on Trademark Status & Document Retrieval (TSDR) printouts of Opposer's pleaded registrations.[22]

- Opposer's Second Notice of Reliance on TSDR printouts of additional, unpleaded registrations owned by Opposer, all shown as active.[23]

- Opposer's Third Notice of Reliance on TSDR printouts of additional, unpleaded registrations owned by Opposer, all shown as cancelled.[24]

- Opposer's Fourth Notice of Reliance on Applicant's responses to select discovery requests propounded by Opposer.[25]

- Testimony Declaration of Matt Brutocao, Vice President, Global Brand Marketing, Barbie at Mattel, Inc., with related exhibits ("Test. Decl. Brutocao").[26]

Applicant, during its case-in-chief, introduced the following evidence:

- Applicant's Notice of Reliance on (1) Opposer's responses to select discovery requests propounded by Applicant; and (2) printouts of Opposer's website.[27]

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[22] 22 TTABVUE. Some registrations are shown as cancelled: Reg. Nos. 2588845, 4339722, 5112553, 5222835, 5233647 and 5233649. 22 TTABVUE 169-208. In its brief Opposer acknowledges an additional registration has since cancelled: Registration No. 5318480. 49 TTABVUE 27 n.75. These cancelled registrations have little probative value. *Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 TTAB LEXIS 251, at *31 ("A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b).").

[23] 23 TTABVUE.

[24] 24 TTABVUE. As mentioned, cancelled registrations have little probative value. *Made in Nature*, 2022 TTAB LEXIS 251, at *31.

[25] 26 TTABVUE.

[26] 27, 28, 29 TTABVUE.

[27] 32 TTABVUE.

- Testimony Declaration of David Wayne Muirhead, Applicant's founder ("Test. Decl. Muirhead").[28]

In rebuttal, Opposer offered the following evidence:

- Opposer's Fifth Notice of Reliance on (1) records from the Florida Division of Corporations website, and (2) select documents from the application file of the involved application.[29]

- Transcript of the cross examination of Mr. Muirhead and related exhibits.[30]

III. Entitlement to a Statutory Cause of Action

Although Applicant does not dispute Opposer's entitlement to a statutory cause of action or even address the issue in its brief, it is a necessary element of the plaintiff's case in every inter partes proceeding. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1302-07 (Fed. Cir. 2020). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1070 (Fed. Cir. 2022) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore,* 978 F.3d at 1303.

Opposer has properly made of record its active, pleaded registrations for marks consisting of and including the term BARBIE, showing their current status and title, which are sufficient to support a plausible claim of likelihood of confusion and

[28] 33 TTABVUE.

[29] 43 TTABVUE. Because documents from the prosecution file of the involved application are automatically of record, it was not necessary for Opposer to submit copies from it under a notice of reliance. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

[30] 41, 45 TTABVUE.

dilution.[31] This evidence establishes Opposer's entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945-46 (Fed. Cir. 2000) (registration establishes "standing"); *Spotify AB v. U.S. Software Inc.*, No. 91243297, 2022 TTAB LEXIS 2, at *21-22 ("Opposer's pleaded registration … and prior use … establish that it is entitled to oppose registration of Applicant's mark on the grounds of likelihood of confusion and dilution."); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, No. 91189692, 2015 TTAB LEXIS 96, at *8 ("Opposer's [entitlement] is established with respect to its likelihood of confusion and dilution claims by its registrations … which the record shows to be valid and subsisting, and owned by Opposer.").

IV. Priority and Likelihood of Confusion

We turn first to Opposer's Section 2(d) ground of opposition. To prevail, Opposer must prove ownership of a registration and/or priority of use, and likelihood of confusion. *Barbara's Bakery, Inc. v. Landesman*, No. 91157982, 2007 TTAB LEXIS 9, at *6. We consider each element in turn below.

A. Priority

Opposer argues it has priority based solely on its forty pleaded BARBIE and BARBIE-formative marks, all of which Opposer summarizes in a chart in its brief.[32] Because TSDR printouts of Opposer's pleaded, active registrations are of record and

[31] 22 TTABVUE. We do not include Opposer's pleaded, cancelled registrations in our analysis. *See supra* note 22 for a list of Opposer's pleaded registrations that stand cancelled.

[32] 49 TTABVUE 10-12.

there are no pending counterclaims to cancel any of them, priority is not at issue with respect to the marks shown in the registrations and the goods or services covered by them.[33] *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402 (CCPA 1974).

Applicant, for its part, does not dispute that Opposer has priority with regard to its pleaded, valid and subsisting registrations.[34] However, Applicant argues that "Opposer has not relied explicitly on other unregistered common law trademark rights for its claims of priority …."[35] In its reply brief, Opposer does not address this issue, instead offering a conclusory comment about having pleaded common law rights, which it tucks in a footnote: "Opposer also pleads 'its extensive common law rights,'" quoting its Notice of Opposition.[36] Opposer's only other mention of priority in its reply brief is a single vague statement in its conclusion: "Opposer has established prior rights in the use of the famous BARBIE mark …."[37]

[33] 22 TTABVUE 5-119, 130-68. We do not include Opposer's pleaded but now-cancelled registrations in our analysis. *See supra* note 22.

[34] 50 TTABVUE 7.

[35] 50 TTABVUE 7.

[36] 51 TTABVUE 10, n.16.

It is well-settled that "[a] plaintiff must plead (and later prove) priority of use." TBMP § 309.03(a)(2) and authorities cited therein. Factual allegations made in the pleadings are not evidence of the matters alleged except insofar as they might be deemed to be admissions against interest, which this is not. *Baseball Am. Inc. v. Powerplay Sports, Ltd.*, No. 91120166, 2004 TTAB LEXIS 443, at *5 n.6 (factual allegations made in the pleadings are not evidence of the matters alleged, except insofar as they might be deemed to be admissions against interest). While we agree that Opposer properly alleged its reliance on its common law use of BARBIE and BARBIE-formative marks in its Notice of Opposition (1 TTABVUE 20 (para. 10)), Opposer did not advance this argument in its trial briefs.

[37] 51 TTABVUE 14.

To establish common law priority based on use, Opposer must prove by a preponderance of the evidence that the claimed mark is distinctive, inherently or otherwise, and priority of use of that mark in connection with specific goods or services. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317 (CCPA 1981).[38] In support of its likelihood of confusion claim, Opposer argued that Applicant's goods are related to Opposer's "downloadable mobile applications."[39] Because Opposer failed to argue in its brief that it has priority based on prior common law use on any of its BARBIE or BARBIE-formative marks for these goods, Opposer's claim of likelihood of confusion based on its common law rights is deemed waived. *Cf., Monster Energy Co. v. Lo*, No. 91225050, 2023 TTAB LEXIS 14, at *3-4 (opposer's lack of bona fide intent to use claim and the family of marks portion of its likelihood of confusion claim were not argued in brief and were deemed waived); *Bell's Brewery, Inc. v. Innovation Brewing*, No. 91215896, 2017 TTAB LEXIS 452, at *20-21 (opposer's failure in its main brief to argue likelihood of confusion claim based on one of two marks pleaded in its notice of opposition resulted in waiver of that claim based on that mark); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, No. 92050879, 2013 TTAB LEXIS 347, at *6 (petitioner's pleaded descriptiveness and geographical

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[38] There has been no issue raised as to the distinctiveness of the mark BARBIE for any of Opposer's goods or services, and thus we find it to be inherently distinctive. To the extent Applicant addresses the issue of distinctiveness, which it does in the context of Opposer's dilution by blurring claim, Applicant acknowledges that "the degree of … distinctiveness of the famous [BARBIE] mark" "may not favor Applicant." 50 TTABVUE 32.

[39] 49 TTABVUE 28.

descriptiveness claims not argued in brief deemed waived deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

Even considering the testimony of Opposer's witness Mr. Brutocao,[40] we find that it does not support a claim of priority based on common law use inasmuch as it is too vague and nonspecific to associate use of any of the BARBIE or BARBIE-formative marks with any particular date of use and it is not supported by sufficient documentary evidence to clarify the testimony. *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580 (CCPA 1945) (testimony to establish prior use of a mark "should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.").

Accordingly, we find that Opposer has established priority only with respect to the marks and goods and services reflected in its active, pleaded registrations. We therefore base our likelihood of confusion determination on Opposer's active, pleaded registered marks for the goods and services identified therein and do not consider Opposer's arguments based on its common law marks.

B. Likelihood of Confusion

Having established Opposer's priority with respect to its pleaded, active registrations, we are left to determine whether Opposer has proven confusion is likely by evaluating the evidence bearing on the factors listed in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"). *See also In re Majestic*

[40] 27 TTABVUE 28-29 (Test. Decl. Brutocao, paras. 79-80 and related exhibits).

Distilling Co., 315 F.3d 1311, 1315 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379-80 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) ("[T]he various evidentiary factors may play more or less weighty roles in any particular determination.").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.").

Recall that we previously determined that Opposer established priority only as to its active, pleaded registrations. Because there are over thirty of them, we narrow our focus, as Opposer does, to two groups. One group consists of the registrations for BARBIE marks for dolls, doll clothes and doll houses (Reg. Nos. 689055 and 768397), which we find herein to be very commercially strong. The other group consists of those registered marks that Opposer selected to serve as the basis for its comparison of the goods and services under the second *DuPont* factor: Reg. Nos. 2495195, 5346799, 5441651, 5602186, 6267201, 6267202, and 6800290 ("Compared Marks" or

"Compared Registrations").[41] Specifically, the Compared Registrations consist of the following:

- BARBIE (in typeset form) for "providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children" (Reg. No. 2495195);[42]

- BARBIE DREAMTOPIA (in standard characters) for "entertainment, namely, animated series featuring stories for children" (Reg. No. 5346799);[43]

- BARBIE LIVE! IN THE DREAMHOUSE (in standard characters) for "entertainment services, namely, providing online webisodes and non-downloadable videos featuring children's entertainment" (Reg. No. 5441651);[44]

- BARBIE DREAMHOUSE ADVENTURES (in standard characters) for "entertainment services, namely, providing non-downloadable videos featuring children's entertainment; providing an online computer game" (Reg. No. 5602186);[45]

- BARBIE (in standard characters) for "digital media, namely, pre-recorded DVDs and downloadable audio and video recordings featuring children's entertainment" (Reg. No. 6267201);[46]

- BARBIE (in standard characters) for "entertainment services, namely, providing non-downloadable animated movies, on-going television programs and non-downloadable webisode series, all featuring children's entertainment provided via a global computer network and via streaming services; providing online computer games and providing a website featuring non-downloadable photos and non-downloadable videos, and information in the field of toys, games and children's entertainment" (Reg. No. 6267202);[47] and

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[41] 49 TTABVUE 27-28.

[42] 49 TTABVUE 27; 22 TTABVUE 87-89.

[43] 49 TTABVUE 27; 22 TTABVUE 117-19.

[44] 49 TTABVUE 27; 22 TTABVUE 133-35.

[45] 49 TTABVUE 27; 22 TTABVUE 130-32.

[46] 49 TTABVUE 27; 22 TTABVUE 136-50.

[47] 49 TTABVUE 27; 22 TTABVUE 151-53.

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("SERIES" disclaimed) for "entertainment services, namely, providing ongoing webisodes and television programs featuring children's entertainment via the internet and via streaming services" (Reg. No. 6800290).[48]

If we do not find that the marks are similar and goods and services are related using the Compared Registrations as our point of comparison, similarity will not be established for any of the other active, pleaded registrations. *See e.g.*, *N. Face Apparel Corp. v. Sanyang Indus. Co.*, No. 91187593, 2015 TTAB LEXIS 328, at *20; *In re Max Cap. Grp. Ltd.*, No. 77186166, 2010 TTAB LEXIS 1, at *5.

1. Strength or Weakness of Opposer's Mark

We begin by considering the strength, including any fame, of Opposer's BARBIE and BARBIE-formative marks as that may affect their scope of protection. *See DuPont*, 476 F.2d at 1361. Analysis of the fifth and sixth *DuPont* factors together determines the strength of a mark. *Spireon, Inc. v. Flex LTD*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) ("Two of the *DuPont* factors (the fifth and sixth) consider strength."). "[T]he strength of a mark is not a binary factor" and "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003)).

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[48] 49 TTABVUE 27; 22 TTABVUE 154-68.

In evaluating the strength of a mark, we consider both its conceptual strength, based on the nature of the mark itself, and if there is probative evidence in the record, its commercial strength, i.e., its fame, based on marketplace recognition of the mark. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."); *New Era Cap Co. v. Pro Era, LLC*, No. 91216455, 2020 TTAB LEXIS 199, at *28-29 ("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.").

Opposer argues that its "BARBIE mark is both inherently and commercially strong–indeed, famous."[49] While some of Opposer's arguments focus specifically on the BARBIE mark for "dolls,"[50] doll clothes and doll accessories,[51] and BARBIE THE MOVIE,[52] its remaining arguments are broadly based on the "BARBIE brand"[53] and "[t]he brand and its products,"[54] without specifying any particular goods or services offered under particular marks.

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[49] 49 TTABVUE 29.

[50] 49 TTABVUE 17, 18, 23, 24.

[51] 49 TTABVUE 17, 18, 23.

[52] 49 TTABVUE 20, 21.

[53] 49 TTABVUE 17, 19, 20, 21, 22, 24, 25.

[54] 49 TTABVUE 24.

Seeking to limit the impact of Opposer's fame evidence, Applicant acknowledges that "Opposer has provided evidence of fame for children's dolls," but argues that the mark's conceptual strength has been weakened by two third-party registrations.[55]

a. Conceptual Strength of the Pleaded Marks

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

We agree with Opposer that its active, pleaded registrations for BARBIE and BARBIE-formative marks, including the marks of the Compared Registrations, are registered on the Principal Register without any claim of distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and that, as a result, each mark is treated as inherently distinctive.[56] Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *see New Era Cap*, 2020 TTAB LEXIS 199, at *29 ("Opposer's 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.").

Applicant challenges the conceptual strength of the mark, arguing that two BARBEE registrations owned by a third-party show that Opposer's BARBIE mark is conceptually weak.[57] Applicant adds that "Opposer itself has admitted that there are

[55] 50 TTABVUE 30.

[56] 49 TTABVUE 16 n.24. The TSDR printouts of the active, pleaded registrations appear at 22 TTABVUE 5-119, 130-68.

[57] 50 TTABVUE 29-30.

two U.S. trademark registrations containing the phrase Barbee in Class 016[,]" and that, as a result, "Opposer's rights are not so all-encompassing as to extend to the term BARBEE as used for any goods."[58]

More accurately, the record shows that Opposer admitted it is aware of **one** third-party "user[ ] of the word 'Barbee' in Class 016" and that this one entity owns **two** such registrations.[59] Opposer argues that, regardless, Applicant has not made of record of any evidence of either of these third-party registrations or any evidence of use of any BARBIE or BARBEE marks.[60] Opposer adds that Applicant, for its part, even admitted that it is unaware of (1) "any third party using the mark BARBIE other than Opposer,"[61] (2) "any third party using a BARBEE-formative mark in commerce other than [Applicant,]"[62] or (3) any marks using the sounds "bar" and "bee" in a mark in commerce.[63]

As an initial matter, we disagree with Opposer that third-party registrations alone are irrelevant because they are not evidence of third-party use of the registered mark.[64] It is well-settled that "third-party registration evidence that does not equate

[58] 50 TTABVUE 30.

[59] 32 TTABVUE 15 (Response to Request to Admit Nos. 23-24).

[60] 49 TTABVUE 35; 51 TTABVUE 8.

[61] 49 TTABVUE 35; 26 TTABVUE 14 (Applicant's Response to Opposer's Request to Admit No. 25); 26 TTABVUE 29 (Applicant's Response to Opposer's Inter. No. 16).

[62] 49 TTABVUE 35; 26 TTABVUE 15 (Applicant's Response to Opposer's Request to Admit No. 26); 26 TTABVUE 29 (Applicant's Response to Opposer's Inter. No. 17).

[63] 49 TTABVUE 35; 26 TTABVUE 24, 30 (Applicant's Response to Opposer's Inter. Nos. 7-8, 18).

[64] 51 TTABVUE 8.

to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services." *Tao Licensing, LLC v. Bender Consulting Ltd.*, No. 92057132, 2017 TTAB LEXIS 437, at *47.

In any event, while such registration evidence would be relevant if it were of record, we nonetheless agree with Opposer that the record does not contain any evidence of these third-party registrations. Although we acknowledge that Opposer admitted that one third-party owns two registrations for the BARBEE mark, Opposer only admitted that the mark is registered in "Class 016."[65] Accordingly, Applicant has failed to provide evidence sufficient to diminish the conceptual strength of the BARBIE marks for dolls, doll clothes and doll houses or the BARBIE and BARBIE-formative marks of the Compared Registrations.

b. Commercial Strength

Commercial strength or fame of the prior mark, if found, plays a dominant role in a likelihood of confusion analysis. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1328 (Fed. Cir. 2000). "Fame for confusion purposes arises as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1722*, 396 F.3d 1369, 1375 (Fed. Cir. 2005).

While fame for dilution is an either/or proposition—it either exists or does not—fame for likelihood of confusion purposes is a matter of degree. *Coach Servs., Inc.*

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[65] 32 TTABVUE 15 (Response to Request to Admit Nos. 23-24).

v. Triumph Learning LLC, 668 F.3d 1356, 1367 (Fed. Cir. 2012). Evidence of commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the mark at issue, "the length of time those indicia of commercial awareness have been evident[,]" widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp.*, 293 F.3d at 1371-76. However, raw numbers alone may be misleading. Thus, some context in which to place raw statistics may be necessary, for example, market share. *Id.* at 1375-76.

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*, No. 91160856, 2007 TTAB LEXIS 35, at *12.

Matt Brutocao, Opposer's Vice President, Global Brand Marketing, Barbie at Mattel, Inc., testified about the history of the BARBIE mark, the variety of goods and services offered under it, and its commercial success:

- The first Barbie doll appeared at the American International Toy Fair in New York City on March 9, 1959 and the first Barbie commercial aired during *The Mickey Mouse Club* in 1959. "About 300,000 dolls were sold in Barbie's first year."[66]

- Over the 65 years since the doll's debut, Opposer "has produced several thousand different BARBIE®-branded goods and services, selling a total of more than two billion BARBIE®-branded dolls and accessories. More than

[66] 27 TTABVUE 2, 3 (Test. Decl. Brutocao, paras. 2, 6, 9).

100 BARBIE® dolls are sold every minute. In 2021, Mattel shipped 86 million BARBIE dolls."[67]

- "[A]bout 92% of American girls ages 3 to 12 have owned a Barbie doll."[68]

- "Barbie's house—the BARBIE DREAMHOUSE® playset … was first introduced in 1962. To this day, one of them is sold every two minutes."[69]

- "There are BARBIE® products in over 50 categories, including food, fitness, clothing, digital applications, video games, television shows, animated films, web media, electronics, outdoor toys, books, household products (e.g. glassware, bags/luggage, cups, mugs, furniture, rugs, candles), beauty products, jewelry, footwear, food products, and many more."[70]

- "Barbie sales have always been strong, reaching $430 million by 1987, and jumping to $700 million in 1991. Mattel revenues for 1992 were $1.8 billion, nearly $1 billion of which were generated through Barbie sales." In a 1994 SEC filing, Mattel noted "sales of Barbie products exceeding $1.0 billion in volume."[71]

- "In 2022, the most recent full fiscal year, Mattel reported the Barbie brand saw $1.49 billion in gross billings globally. That had been preceded by gross billings of $1.68 billion in 2021 and $1.35 billion in 2020."[72]

- "Barbie has starred in over 30 entertainment titles, including dozens of animated films released between 2001 and 2024."[73]

- "Barbie has also starred in several animated series, including the Netflix series Barbie: Life in the Dreamhouse (2012-2015), Barbie Dreamhouse Adventures (2018-2020), Barbie: It Takes Two (2022), and Barbie: A Touch of Magic (2023-), online webisodes such as Barbie Vlogger (2015-), and Barbie LIVE! In the Dreamhouse (2017)."[74]

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[67] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 11).

[68] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 12).

[69] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 14).

[70] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 16).

[71] 27 TTABVUE 5 (Test. Decl. Brutocao, para. 17) (internal quotation omitted).

[72] 27 TTABVUE 5 (Test. Decl. Brutocao, para. 20) (internal quotation omitted).

[73] 27 TTABVUE 6 (Test. Decl. Brutocao, para. 22).

[74] 27 TTABVUE 7 (Test. Decl. Brutocao, para. 24).

- "In July 2023, Mattel and Warner Bros. released Barbie The Movie, starring actress Margot Robbie in the title role. The film proved to be an instant, worldwide cultural sensation. As of the date of the declaration, it had grossed over $1.435 billion and broken multiple records, including:
  a. Highest-grossing film of 2023 in the U.S. and worldwide;
  b. Most successful global release in Warner Bros. history;
  ….
  t. Eight Oscar nominations (including for Best Picture) and one Oscar win, for Best Original Song."[75]

- "Mattel spent $50 million-plus on Barbie ads in 2003, and [began] expanding its marketing strategy beyond the physical doll itself to include storytelling from the fictional world in which the doll characters live."[76]

- "In 2011, Mattel's Barbie brand was awarded 'Campaign of the Year' by marketing trade publication *PR Week* at its annual awards gala."[77]

- "In February 2022, Barbie (and the Barbie Dreamhouse) starred in the USA TODAY Ad Meter's highest-ranked Super Bowl® commercial."[78]

- "In April 2022, NASA collaborated with Mattel to bring BARBIE® dolls to the International Space Station to encourage children to pursue careers in STEM."[79]

- "Barbie has a powerful social media presence with over 19 million followers across platforms, and saw more than 6 million engagements across social media in the first six months of 2023 …."[80]

- "Barbie's Facebook page has 14 million likes, and her TikTok page has 2.1 million followers."[81]

- "There are over 18 billion minutes of BARBIE®-related user-generated content created each year."[82]

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[75] 27 TTABVUE 8-9 (Test. Decl. Brutocao, para. 27).

[76] 27 TTABVUE 10 (Test. Decl. Brutocao, para. 30).

[77] 27 TTABVUE 10 (Test. Decl. Brutocao, para. 31).

[78] 27 TTABVUE 11 (Test. Decl. Brutocao, para. 35).

[79] 27 TTABVUE 11 (Test. Decl. Brutocao, para. 36).

[80] 27 TTABVUE 14 Test. Decl. Brutocao, (para. 43).

[81] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 47).

[82] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 48).

- "In October 1996, *AdWeek* ranked Barbie #87 out of 500 top brands in its 'America's Super Brands '97' List."[83]

- "In each of 2020 and 2021, Circana (formerly known as the NPD Group), a leading global information company, named BARBIE® the top global toy property. Barbie remained #2 on this list in 2022 and 2023."[84]

- "The market research firm Brand Finance has ranked Barbie in the top five most valuable toy brands in the entire world in each of 2021, 2022, and 2023."[85]

- "TIME magazine describes Barbie's 'brand recognition [as] up there with Mickey Mouse.' In short, the Barbie brand is the epitome of a household name."[86]

- "Oscar de la Renta was the first designer collaboration in 1985. Many other famous designers have since collaborated with the brand, including Versace, Tarina Tarantino, Anna Sui, Cynthis Rowley, Calvin Klein, Vera Wang, Diane Von Furstenberg, MAC Cosmetics, Dior, and more. Beginning in 1990, Bob Mackie created a long line of exquisite, still-sought-after dolls. To celebrate her 50th anniversary in 2009, Barbie had her own runway show in the New York Mercedes-Benz Fashion Week, featuring original creations by 50 notable designers. In 2014, Jeremy Scott's Moschino show was inspired by Barbie, complete with her dream wardrobe. In 2019, Barbie was given the Board of Directors' Tribute by the Council of Fashion Designers of America—an award that had previously been bestowed on Michelle Obama and Gloria Steinem."[87]

- "In 1998, the Strong Museum of Play in Rochester, New York launched the National Toy Hall of Fame, and chose the Barbie doll as part of the Hall's inaugural class."[88]

[83] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 51).

[84] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 52) (footnote omitted).

[85] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 53).

[86] 27 TTABVUE 17 (Test. Decl. Brutocao, para. 57) (footnote omitted).

[87] 27 TTABVUE 19 (Test. Decl. Brutocao, para. 65) (footnote omitted).

[88] 27 TTABVUE 20 (Test. Decl. Brutocao, para. 67).

- "In 2014, Mattel and Sports Illustrated collaborated in a promotion through which Barbie appeared on one version of the cover of the magazine's popular swimsuit edition."[89]

- "In 2015, Barbie launched her first video blog (vlog) on YouTube which propelled the channel to the #1 doll brand on YouTube. An October 2020 CNN article noted that, 'With more than 9.6 million subscribers, the official Barbie page is currently the most watched channel directed at girls on YouTube.' Today, the BARBIE® YouTube channel has over 11 million subscribers, three thousand videos, and 23 billion minutes of content watched, and is still the #1 girls' brand on YouTube."[90]

- "The Instagram channel @barbiestyle launched in 2014 and quickly reached over 3.6 million followers."[91]

- "Barbie's Facebook page has 14 million likes, and her TikTok page has 2.1 million followers."[92]

In its brief, Applicant admits that Opposer's mark is commercially strong for "children's dolls and the success of the Barbie movie[,]"[93] arguing only that Opposer has shown "no fame of its mark for social networking services, in the context of a mobile application or otherwise."[94] "Opposer's alleged fame is in an entirely different industry sector," Applicant adds, "and thus is not indicative of a likelihood of confusion."[95] Applicant did not cross-examine Opposer's witness, Mr. Brutocao,

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[89] 27 TTABVUE 20 (Test. Decl. Brutocao, para. 68).

[90] 27 TTABVUE 14 (Test. Decl. Brutocao, para. 44) (footnotes omitted).

[91] 27 TTABVUE 14 (Test. Decl. Brutocao, para. 46).

[92] 27 TTABVUE 15 (Test. Decl. Brutocao, para. 47).

[93] 50 TTABVUE 29 ("Opposer spends much of its brief complimenting itself on how famous its mark is for children's dolls and the success of the Barbie movie.").

[94] 50 TTABVUE 29.

[95] 50 TTABVUE 29.

however, nor did Applicant in its brief make any other substantive criticisms of Opposer's evidence on the issue of commercial strength.

c. Summary of Strength or Weakness of the Pleaded BARBIE and BARBIE-Formative Marks

All of Opposer's active, pleaded BARBIE and BARBIE-formative marks are registered on the Principal Register without a claim of acquired distinctiveness, including the BARBIE mark for dolls, doll clothes, and doll houses and the BARBIE and BARBIE-formative marks of the Compared Registrations, and Applicant was not successful in diminishing their conceptual strength.

As for commercial strength, we find that Opposer's BARBIE mark is commercially very strong for purposes of likelihood of confusion for "dolls" and "doll clothes," and "doll houses". The testimony and evidence regarding the "BARBIE brand" and "BARBIE products" is not specific enough to support a finding that the mark is commercially strong. Similarly testimony that "BARBIE® products [are] in over 50 categories, including food, fitness, clothing, digital applications, video games, television shows, animated films, web media, electronics, outdoor toys, books, household products (e.g. glassware, bags/luggage, cups, mugs, furniture, rugs, candles), beauty products, jewelry, footwear, food products, and many more"[96] is not specific enough to support finding that the mark is very commercially strong or famous for general types of products listed.

[96] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 16).

Moreover, while it is true that in terms of absolute numbers, the sales figures about which Mr. Brutocao testified are impressive, one problem is that the testimony evidence is not always specific to the United States. For example, Mr. Brutocao testified about "gross billings globally."[97] Sales outside the United States are not relevant to our analysis. *Cf. Hard Rock Cafe Licensing Corp. v. Elsea*, No. 93436, 1998 TTAB LEXIS 124, at *13 ("The renown of opposer's marks outside the United States or exposure of the foreign public to opposer's marks is irrelevant [to Section 2(d) claim]."); *Lever Bros. Co. v. Shaklee Corp.*, No. 61926, 1982 TTAB LEXIS 129, at *9 n.8 (because "any trademark activity outside the United States is ineffective to create rights within this country, ... evidence of such use is irrelevant to any of the issues in the Section 2(d)] proceeding before us[.]"). He also testified as to "global" media impressions.[98] Because, for example, there is no evidence as to the extent of U.S. consumers that saw this content, this evidence, without more, is generally less probative of the commercial strength of the pleaded BARBIE mark. *See e.g.*, *In re Jasmin Larian, LLC*, No. 87522459, 2022 TTAB LEXIS 99, at *39-40 ("English language material obtained from foreign websites, for example, has been accepted as competent evidence in trademark examination when it is likely that U.S. consumers have been exposed to the website or news source.").

In view of the foregoing, we find that for purposes of the likelihood of confusion analysis, the BARBIE mark is very commercially strong (indeed "famous" for

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[97] *See e.g.*, 27 TTABVUE 5 (Test. Decl. Brutocao, para. 20).

[98] 27 TTABVUE 10 (Test. Decl. Brutocao, para. 32).

purposes of likelihood of confusion) for "dolls," "clothing for dolls," and "doll houses," and otherwise a strong mark for the goods and services identified in, for example, the Compared Registrations. That is, to the extent that consumers recognize the BARBIE mark in connection with these other goods and services, it is a result of the fame of the BARBIE mark with dolls, doll clothing and doll houses.

2. Similarity or Dissimilarity and Nature of the Parties' Identified Goods and Services

We next consider the second *DuPont* factor, the similarity or dissimilarity of the parties' goods and services. *DuPont*, 476 F.2d at 1361. Because Opposer established priority only with respect to the marks and the goods and services set out in its active, pleaded registrations, our determination must be based on the identifications of services in the involved application and the goods and services in the active, pleaded registrations focusing, as we mentioned, on the Compared Registrations.[99] *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322-23 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 942 (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

[99] To the extent that Opposer argues that the parties' goods and services are related by virtue of the similarity of Opposer's prior common law use of its mark with, for example, downloadable mobile applications (49 TTABVUE 28) and "social networking accounts" (51 TTABVUE 10 and n.16), these arguments rely entirely on Opposer's common law rights in the mark. Inasmuch as Opposer waived the claim of priority based on the prior common law use of its mark for these goods or services, they are irrelevant to Opposer's likelihood of confusion claim and we do not consider them. *See* discussion *supra* Section IV(A).

goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”).

It is generally “‘not necessary that the products [and services] of the parties be similar or even competitive to support a finding of a likelihood of confusion.’” *Coach Servs.*, 668 F.3d at 1369 (quoting 7-*Eleven, Inc. v. Wechsler*, No. 91117739, 2007 TTAB LEXIS 58, at *28). Instead, they need only be ‘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.” *Id.* (quoting *7-Eleven*, 2007 TTAB LEXIS 58, at *28-29).

The relatedness of the parties’ goods and services may be established based on (1) the language of the involved identifications of goods or services, which may show, on the face of the identifications, that the goods or services are literally or legally identical, or otherwise intrinsically related, and (2) evidence of third-party uses or registrations, which may show that the identified goods or services are commonly offered by the same entity under the same mark. *In re OSF Healthcare Sys.*, No. 88706809, 2023 TTAB LEXIS 353, at *9-11. *See also, Coach Servs.*, 668 F.3d at 1369 (“[L]ikelihood 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.’”) (quoting 7-*Eleven*, 2007 TTAB LEXIS 58, at *28-29).

As an initial matter, we agree with Opposer that because Applicant seeks to register its mark for use with “online social networking services accessible by means

of downloadable mobile applications," which is unrestricted as to, for example, the nature and purpose of its use, we cannot read any limitations into the identification.[100] That is, we cannot limit the identification to use, for example, by bar owners and employees, a feature that Applicant emphasizes.[101] *See also Octocom Sys.*, 918 F.2d at 942; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1043 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of SquirtCo's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration.").

In its brief, Opposer makes two arguments that the parties' goods and services are related. Opposer argues that the parties' goods and services are (1) "materially identical,"[102] which Opposer clarifies in its reply brief to mean "legally identical,"[103] and (2) also "highly related."[104] We address each in turn.

Recall that the subject application identifies: "Online social networking services accessible by means of downloadable mobile applications." As we mentioned earlier, Opposer focuses its arguments under the second *DuPont* factor on its Compared Registrations, details of which we repeat below for convenience:[105]

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[100] 49 TTABVUE 25-26.

[101] *See e.g.*, 50 TTABVUE 7, 10.

[102] 49 TTABVUE 25.

[103] 51 TTABVUE 10-11 & n.16.

[104] 49 TTABVUE 27.

[105] Opposer acknowledges that three of the registrations it relied on in its brief to show relatedness are now cancelled (Reg. Nos. 5233647, 5233649 and 5318480). 49 TTABVUE 27 n.75. *See also* 22 TTABVUE 188-197, 206-08. Even though they are cancelled, Opposer argues that "[t]hey are nevertheless admissible and relevant as supplementary evidence of the fact that Opposer has used its marks with these services." 49 TTABVUE 27 n.75. While the

- BARBIE (in typeset form) for "providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children" (Reg. No. 2495195);[106]

- BARBIE DREAMTOPIA (in standard characters) for "entertainment, namely, animated series featuring stories for children" (Reg. No. 5346799);[107]

- BARBIE LIVE! IN THE DREAMHOUSE (in standard characters) for "entertainment services, namely, providing online webisodes and non-downloadable videos featuring children's entertainment" (Reg. No. 5441651);[108]

- BARBIE DREAMHOUSE ADVENTURES (in standard characters) for "entertainment services, namely, providing non-downloadable videos featuring children's entertainment; providing an online computer game" (Reg. No. 5602186);[109]

- BARBIE (in standard characters) for "digital media, namely, pre-recorded DVDs and downloadable audio and video recordings featuring children's entertainment" (Reg. No. 6267201);[110]

- BARBIE (in standard characters) for "entertainment services, namely, providing non-downloadable animated movies, on-going television programs and non-downloadable webisode series, all featuring children's entertainment provided via a global computer network and via streaming services; providing online computer games and providing a website featuring non-downloadable photos and non-downloadable videos, and information in the field of toys, games and children's entertainment" (Reg. No. 6267202);[111] and

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cancelled registrations are admissible, we disagree as to their probative value. A cancelled registration "is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used." *Kemi Organics, LLC v. Gupta*, No. 92065613, 2018 TTAB LEXIS 149, at *17. Consequently, we have not considered these three cancelled registrations in our relatedness analysis.

[106] 49 TTABVUE 27; 22 TTABVUE 87-89.

[107] 49 TTABVUE 27; 22 TTABVUE 117-19.

[108] 49 TTABVUE 27; 22 TTABVUE 133-35.

[109] 49 TTABVUE 27; 22 TTABVUE 130-32.

[110] 49 TTABVUE 27; 22 TTABVUE 136-50.

[111] 49 TTABVUE 27; 22 TTABVUE 151-53.

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(“SERIES” disclaimed) for “entertainment services, namely, providing ongoing webisodes and television programs featuring children’s entertainment via the internet and via streaming services” (Reg. No. 6800290).[112]

In its reply brief, Opposer argues that “Applicant’s description covers any and all social networking activities conducted through mobile applications, regardless of industry or field, and thus **encompasses**, inter alia, entertainment-oriented socializing for all ages.”[113] *See e.g.*, *In re Hughes Furniture Indus.*, No. 85627379, 2015 TTAB LEXIS 65, at *10 (Because Applicant’s broadly worded identification of “furniture” necessarily encompasses Registrant’s narrowly identified “residential and commercial furniture,” the goods are legally identical.).

There is no evidence of record that supports Opposer’s characterization of Applicant’s services as “entertainment-oriented socializing”. Even assuming Opposer’s characterization of Applicant’s services is accurate, Opposer fails to specify which of the identifications of the seven registrations making up the Compared Registrations is encompassed by Applicant’s identification or offer any other evidence or argument as to how we could arrive at a finding for the same. A quick comparison of the parties’ identifications convinces us that neither party’s identification of goods

[112] 49 TTABVUE 27; 22 TTABVUE 154-68.

[113] 51 TTABVUE 10 (emphasis added).

or services are encompassed by the other party's identification. Thus, on this record, the parties' goods and services are not legally identical.

Nor are the parties' goods and services "highly related." To this end, Opposer essentially argues that its BARBIE mark appears on both (1) social networks, and (2) mobile apps, which are "highly related" to Applicant's "Online social networking services accessible by means of downloadable mobile applications.[114] The fact that the BARBIE mark may be used on a third-party mobile application, such as Facebook, Opposer argues, "is a distinction without a difference."[115] We disagree.

Opposer does not identify any social networking mobile application in its Compared Registrations, and display of its marks on *third-party* social networking platforms does not, without more, render the parties' goods and services "highly related."[116] Put another way, the use of the BARBIE mark on, for example, Facebook or Instagram, is not equivalent to Opposer's offering "online social networking services" to others.

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[114] 51 TTABVUE 10-11. *See also* 49 TTABVUE 26-28.

[115] 51 TTABVUE 11.

[116] 50 TTABVUE 23-24.

As discussed earlier, Opposer's arguments based on its use of its marks with its common law goods, i.e., mobile apps, are irrelevant because Opposer failed to allege and establish priority as to those common law goods. However, even if we were to consider such mobile applications, Mr. Brutocao's testimony and supporting exhibits do not show that the mobile apps have a social networking feature. 27 TTABVUE 28-29, 29 TTABVUE 110-56 (Test. Decl. Brutocao, para. 79 and Exs. 80-87). That is, none of the printouts of the apps show that the app user can engage with other users to play a game, share a fashion creation, or the like, and some apps promote the fact that they are for use with a "single player," which is nearly the opposite of social networking. 29 TTABVUE 122, 132. Thus, this evidence similarly fails to show that the parties' goods and services are legally identical or highly related.

Moreover, Opposer simply does not point to (nor did we locate) any evidence in the record that might establish relatedness, such as evidence of third-party uses or registrations of Applicant's identified services and Opposer's identified goods and services under the same mark. On this record, Opposer has not met its burden of proof and has failed to establish that the parties' goods and services are related.[117]

3. Similarity or Dissimilarity of Established, Likely-to-Continue Channels of Trade

Next, we consider the third *DuPont* factor involving the similarity or dissimilarity of established and likely-to-continue channels of trade. *DuPont*, 476 F.2d at 1361. As before, we make our determination based on the goods and services as they are recited in the involved application and the Compared Registrations. *Octocom Sys.*, 918 F.2d at 942.

There are no limitations as to the channels of trade in either party's identifications. Therefore, we must presume that Applicant's and Opposer's goods and services as identified in the involved application and the Compared Registrations are marketed in all normal trade channels and to all normal classes of purchasers for such goods and services. *See Inter IKEA Sys. B.V. v. Akea, LLC*, No. 91196527, 2014 TTAB LEXIS 166, at *29-33.

Opposer argues that record shows that the parties use "materially identical trade and marketing channels"[118] because Opposer's BARBIE mobile applications are

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[117] We hasten to add that, even if we were to find the parties' goods and services to be related, it would not change the outcome of this decision because, as discussed *infra* at Section IV(B)(5), the marks are so dissimilar that confusion would not be likely.

[118] 49 TTABVUE 32, 33. We agree with Applicant that, because the parties' services were not found to be legally identical (50 TTABVUE 25), Opposer is not entitled to rely on the

"available for download in both the Apple App Store and in Google Play—the two (and only) online stores through which BarBee's app is also distributed."[119] We disagree inasmuch as these arguments, based on Opposer's common law use of its mark with mobile applications, are irrelevant because Opposer did not establish priority based on such use.[120]

Focusing as we must on the channels of trade for the goods and services identified in Opposer's Compared Registrations, Mr. Brutocao testified about the following channels of trade for the pertinent identified goods and services (i.e., online educational and entertainment services featuring stories, games, and directories for toys and games; animated series, webisodes, and online videos; online computer games; and audio and video recordings, all for children):

- "Barbie has … starred in several animated series, including the Netflix series Barbie: Life in the Dreamhouse (2012-2015), Barbie Dreamhouse Adventures (2018-2020), Barbie: It Takes Two (2022), and Barbie: A Touch of Magic (2023-), online webisodes such as Barbie Vlogger (2015-), and Barbie LIVE! In the Dreamhouse (2017)."[121] This testimony establishes that streaming services, such as Netflix, are the channels of trade for the animated series, but it does not specify a channel of trade for the online webisodes.

- "Barbie was instrumental in demolishing the notion that video games were exclusively for boys. Scores of BARBIE®-branded video games have been released for nearly all major platforms and desktop operating systems, beginning with a 1984 game for the Commodore 64."[122] The supporting

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presumption that the channels of trade and classes of consumers are the same (49 TTABVUE 32).

[119] 49 TTABVUE 33.

[120] *See* discussion *supra* Section IV(A).

[121] 27 TTABVUE 7 (Test. Decl. Brutocao, para. 24).

[122] 27 TTABVUE 7 (Test. Decl. Brutocao, para. 25).

exhibit shows that the platforms include Game Boy, Macintosh Windows, Windows, and PlayStation.[123]

- "[T]the live-action reality show Barbie Dreamhouse Challenge aired on HGTV,"[124] a television show.
- "Barbie launched her first video blog (vlog) on YouTube which propelled the channel to the #1 doll brand on YouTube."[125]
- Barbie has her own accounts on Instagram, Facebook and TikTok, but there is no testimony or evidence that goods or services offered under the Compared Registrations are offered or marketed on these platforms.[126]

Applicant, for its part, presented evidence that its mobile application is available in the Google Play store and the Apple App Store, and that it is marketed through Applicant's own website, and on its Facebook, Instagram and TikTok accounts.[127]

We find that Opposer has failed to establish that the channels of trade overlap. Here, Opposer offers no evidence that the goods or services identified in its Compared Registrations are offered in the Google Play store or the Apple App Store, or any app store for that matter. To the extent that Opposer's evidence relates to marketing on Instagram, Facebook or TikTok, we cannot tell from the conclusory testimony what identified services are actually marketed there. Plus, each party posts from its own account, that is, Applicant posts on its account, and Opposer posts on its account,

[123] 27 TTABVUE 207-13 (Exhibit 20 to the Test. Decl. Brutocao).

[124] 27 TTABVUE 8 (Test. Decl. Brutocao, para. 26).

[125] 27 TTABVUE 14 (Test. Decl. Brutocao, paras. 44, 45).

[126] 27 TTABVUE 14-15 (Test. Decl. Brutocao, paras. 46-48).

[127] 50 TTABVUE 25; 33 TTABVUE 3-6, 15-60 (Test. Decl. Muirhead, paras. 6-9 and Exhibits B-K).

again precluding overlap. Thus, Opposer has failed to establish that the parties' channels of trade overlap.[128]

Applicant acknowledges that Opposer has also marketed its goods and services (apart from its apps) through the "same social media platforms,"[129] but these arguments are not focused on the goods and services identified in the Compared Registrations. Even assuming that the parties' goods and services are both offered on, for example, Facebook and Instagram, Applicant likens these platforms to departments stores and supermarkets, arguing that advertising on these platforms alone is not enough to establish that the channels of trade overlap.[130] We agree and consider this far too general of an overlap to have any meaningful impact on the likelihood of confusion. *Cf. Parfums De Coeur, Ltd. v. Lazarus*, No. 91161331, 2007 TTAB LEXIS 36, at *30 ("the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.").

4. Conditions Under Which and Buyers to Whom Sales are Made

The fourth *DuPont* factor considers the "conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing." *DuPont*, 476 F.2d at 1361. "[W]e look to the language of the identifications to ascertain the . . . degree of care in purchasing." *Heil Co. v. Tripleye GmbH*, Opp. No. 91277359, 2024

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[128] We hasten to add that, even if the channels of trade were found to overlap, it would not change the result of our decision inasmuch as the marks are sufficiently dissimilar that confusion would not be likely, as discussed *infra* at Section IV(B)(5).

[129] 50 TTABVUE 25.

[130] 50 TTABVUE 25-26.

TTAB LEXIS 494, at *80-81. "A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion," while "[c]onversely, impulse purchases of inexpensive items may tend to have the opposite effect." *Id.* (citations omitted).

Opposer's witness testified that "[a]ll Barbie-branded … online interactive experiences are available either for free or for a nominal sum."[131] "Downloading is not only easy, but also consequence-free[,]" argues Opposer, adding, "a customer knows they can always just delete an app they no longer wish to use. Therefore, customers already conditioned to recognize the BARBIE® mark and who are interested in exploring what an app offers will have virtually no hesitation in downloading BarBee's app based only on their initial assumption that it is related to the BARBIE® brand."[132]

Applicant's app, when it is offered, is available for free on Google Play and the App Store.[133]

The identifications of goods and services in the involved application and the Compared Registrations contain no limitations as to price points, so we must presume that the identified goods and services include content that is available for free as well as for a low price. Because the goods and services in the involved application and the

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[131] 49 TTABVUE 34; 27 TTABVUE 30 (Test. Dec. Brutocao, para. 85).

[132] 49 TTABVUE 34.

[133] 33 TTABVUE 31-37.

Compared Registrations may be accessed for free or very low cost, they may be subject to impulse download or purchase.

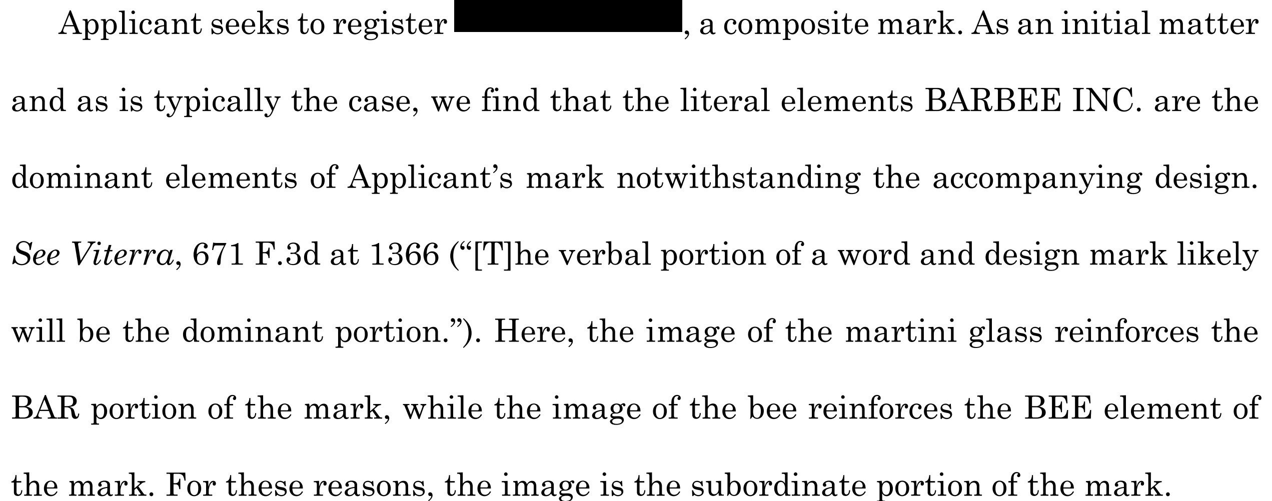
5. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor, which assesses the similarity or dissimilarity of the marks. *DuPont*, 476 F.2d at 1361. We consider "the marks in their entireties as to appearance, sound, connotation and commercial impression." *Viterra*, 671 F.3d at 1362 (quoting *DuPont*, 476 F.2d at 1361). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, No. 87075988, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, No. 85497617, 2014 TTAB LEXIS 214, at *4), *aff'd per curiam*, 777 Fed. Appx. 516 (Fed. Cir. 2019).

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." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs.*, 668 F.3d at 1368). "[S]imilarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (quoting *Coors Brewing*, 343 F.3d at 1344).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entirety of the marks, not just part of the marks. Nonetheless, 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*, 746 F.3d at 1322. The focus is on the recollection of the average purchaser, who normally "retains a general rather than a specific impression of marks." *In re i.am.symbolic, llc,* No. 85916778, 2018 TTAB LEXIS 281, at *11-12.



Applicant seeks to register

, a composite mark. As an initial matter and as is typically the case, we find that the literal elements BARBEE INC. are the dominant elements of Applicant's mark notwithstanding the accompanying design. *See Viterra*, 671 F.3d at 1366 ("[T]he verbal portion of a word and design mark likely will be the dominant portion."). Here, the image of the martini glass reinforces the BAR portion of the mark, while the image of the bee reinforces the BEE element of the mark. For these reasons, the image is the subordinate portion of the mark.

Focusing on the literal elements BARBEE INC., we find that the BARBEE portion is dominant. It is the largest literal element in the mark, appearing in a much larger font size than the INC. element, and it is also the first term in the mark. *See e.g., Palm Bay*, 396 F.3d at 1372 (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 876 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead

word); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, No. 74797, 1988 TTAB LEXIS 60, at *7-8 ("[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 …."). Moreover, Applicant's disclaimer of the generic or descriptive term INC. further supports our finding, as generic or descriptive, disclaimed terms have less source-identifying significance. *See e.g., In re Chatam Int'l, Inc.*, 380 F.3d 1340, 1342-43 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (stating "[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark").

As a reminder, the marks covered in Opposer's Compared Registrations include the BARBIE mark (in standard characters), BARBIE DREAMTOPIA (in standard characters), BARBIE LIVE! IN THE DREAMHOUSE (in standard characters), BARBIE DREAMHOUSE ADVENTURES (in standard characters), and

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Because Opposer has not proven that the goods and services recited in any of the Compared Registrations are related to the services recited in Applicant's application, we confine our analysis to the BARBIE mark (in standard characters), as Opposer does, as it has the most similarity with Applicant's mark.[134] Opposer argues that,

[134] 49 TTABVUE 29-32.

when Opposer's BARBIE mark is compared to the dominant portion of Applicant's mark, i.e., BARBEE, the parties' marks are similar "in every relevant respect"[135] and points to testimony by Applicant's founder, who admitted that the marks "sound similar,"[136] a point Applicant concedes in its brief.[137]

The marks have nothing else in common, Applicant continues, pointing out that the parties' marks are otherwise dissimilar: The mark displays the literal element "BarBee" such that the capitalization indicates that the term is a compound word made up of the individual words "Bar" and "Bee."[138] BarBee is a portmanteau of bar and bee, combining two words relevant to the app's purpose[,]" i.e., "[e]mployer bars and restaurants can connect with and immediately hire 'worker bees,' and vice versa."[139] The connotation of this compound word is a "Bee of the Bar," which is reinforced by the logo consisting of a bee inside a martini glass, giving it an entirely different commercial impression when compared to Opposer's mark.[140] Applicant acknowledges that the INC. element has been disclaimed, but argues that disclaimed

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Had Opposer shown that the goods and services recited in one or more of the Compared Registrations were related to the services recited in Applicant's application, we would have focused on a comparison of those marks.

[135] 49 TTABVUE 30.

[136] 49 TTABVUE 31; 41 TTABVUE 24 (Muirhead Cross Ex. Tr. 22:14-20).

[137] 50 TTABVUE 20.

[138] 50 TTABVUE 20.

[139] 50 TTABVUE 22.

[140] 50 TTABVUE 20-22.

matter cannot be ignored and that, when the mark is considered as a whole, it is sufficiently dissimilar that confusion is not likely.[141]

We find, after considering the marks as a whole, the marks are not sufficiently similar to weigh in favor of a likelihood of confusion. As an initial matter, consumers who encounter Applicant's mark would readily recognize its dominant element to consist of the terms, "bar" and "bee." *Cf. Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, No. 91194148, 2015 TTAB LEXIS 260, at *27 ("[W]hen a compound term comprises two ordinary English words, consumers often recognize them as such, rather than considering the combination to be a fanciful term with no meaning at all."). The dominant, compound term used in Applicant's mark is visually different from Opposer's BARBIE mark. We agree with Applicant that its mark conveys a different meaning when the compound word BARBEE is considered as a whole, i.e., in combination with the logo consisting of a bee inside a martini glass, i.e., that of a worker bee at a bar. The record shows that BARBIE, on the other hand, is a nickname for the doll, whose full name is Barbara Millicent Roberts,[142] and, as a result, it conveys the impression of a doll named BARBIE. As a result of their different meanings when applied to the goods of Applicant and Opposer, the two marks create different commercial impressions, notwithstanding the fact that they are identical in sound. *See, e.g., In re Sears, Roebuck & Co.*, No. 502919, 1987 TTAB LEXIS 84, at *8

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[141] 50 TTABVUE 20.

[142] 27 TTABVUE 35 (Exhibit 1 to Test. Decl. Brutocao). In his declaration, Mr. Brutocao expressly stated that the facts set out in the publications attached to his declaration were accurate, *id.* at 3 (para. 5), allowing us to rely on them for the truth of the matter asserted.

(despite CROSS-OVER for bras and CROSSOVER for ladies' sportswear being identical in sound, the marks are not likely to cause confusion because they generate different commercial impressions).

Opposer makes numerous arguments in an attempt to associate its BARBIE doll with Applicant's mark, including arguing that the BARBIE character has had more than 250 occupations, including one as a beekeeper;[143] that one of BARBIE's artistic collaborations resulted in BARBIE wearing a full-length bee costume;[144] Opposer sells BARBIE-branded martini glasses, which were featured in Barbie The Movie;[145] and Opposer has sold a "Barbie Loves the Ocean Beach Shack Playset" that features island-inspired beverages and a blender.[146] None of these arguments are persuasive. When comparing the marks, we consider, as we must, the marks as they appear in the drawing and the goods and services as they are identified in the involved application and Compared Registrations.

6. Nature and Extent of Any Actual Confusion and Conditions under which There Has Been Contemporaneous Use

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the parties' subject marks. *DuPont*, 476 F.2d at 1361. These factors are interrelated.

[143] 27 TTABVUE 21 (Test. Decl. Brutocao, paras. 73, 74(a)).

[144] 27 TTABVUE 22 (Test. Decl. Brutocao, para. 74(b)).

[145] 27 TTABVUE 23-24 (Test. Decl. Brutocao, para. 75(a)).

[146] 27 TTABVUE 24 (Test. Decl. Brutocao, para. 75(b)).

Applicant expressly states in its brief that it is not aware of any incidents of actual confusion.[147] Opposer, for its part, does not address this factor in its opening brief, but in its reply brief it acknowledges that it is not aware of any such incidents.[148] However, "the absence of evidence of actual confusion, under the seventh *du Pont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *du Pont* factor, that there has been a significant opportunity for actual confusion to have occurred." *In re Ass'n of the U.S. Army*, No. 76578579, 2007 TTAB LEXIS 52, at *27 (citing *Gillette Canada Inc. v. Ranir Corp.*, Opp. No. 82769, 1992 TTAB LEXIS 24, at *19-20).

Applicant argues that it has not, due to the ongoing nature of this proceeding, filed an amendment alleging use of its mark in commerce. But the record reflects that since it filed "its intent-to-use Application on October 19, 2021, Applicant has used its Mark in connection with its identified goods since at least as early as 2022."[149] Because Opposer's witness testified that Opposer has used its mark in connection with at least dolls since at least 1959,[150] Applicant maintains that the marks have coexisted in the marketplace for approximately two years without any evidence of confusion.[151]

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[147] 50 TTABVUE 11.

[148] 49 TTABVUE; 51 TTABVUE 14.

[149] 50 TTABVUE 30; 33 TTABVUE 4 (Test. Decl. Muirhead, para. 7).

[150] 27 TTABVUE 3 (Test. Decl. Brutocao, para. 6).

[151] 50 TTABVUE 30-31.

The record, however, is not clear on the length of time that Applicant has used its mark. For example, during cross-examination, Mr. Muirhead consistently testified that Applicant was not currently using its involved mark but he did not testify as to when usage stopped:

8 Q And you mentioned that you're not on iOS or
9 Google. That's interesting, because I actually
10 looked for those apps on those platforms today,
11 this morning, and wasn't able to find them.
12 Is there a place where your service is
13 still available, or is it not available?
14 A There's no place where it's available.[152]

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4 Q Okay. So you're not using the mark in commerce
5 right now?
6 A No.[153]

Under the seventh and eighth *DuPont* factors, we find that there is no evidence of actual confusion, but we also find that such absence of evidence is due to the lack of meaningful exposure of Applicant's mark to consumers. In the absence of a significant opportunity for actual confusion to have occurred, the absence of actual confusion is of little probative value in this case. *See e.g.*, *Barbara's Bakery*, 2007 TTAB LEXIS 9,

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[152] 41 TTABVUE 17 (Muirhead Cross. Depo. Tr. 15:8-14).

[153] 41 TTABVUE 18 (Muirhead Cross. Depo. Tr. 16:4-6).

at *14 (where the respective marks coexisted in the marketplace for at least nine years, absence of actual confusion nonetheless deemed "of little probative value" because of the absence of a significant opportunity for such confusion to occur, given "the minimal scope of applicant's actual use of her mark in the marketplace").

7. The Wide Variety of Goods and Services on which the BARBIE Mark is Used

The ninth *DuPont* factor considers "[t]he variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." *DuPont*, 476 F.2d at 1361. "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." *Dollar Fin. Grp. v. Brittex Fin., Inc.*, 132 F.4th 1363, 1373 (Fed. Cir. 2025); *DeVivo v. Ortiz*, No. 91242863, 2020 TTAB LEXIS 15, at *44. "This factor may favor a finding that confusion is likely if the goods or services are not obviously related, but has less impact if the parties' goods or services in issue are identical or closely related." *Monster Energy*, 2023 TTAB LEXIS 14, at *54.

"The goods and services demonstrating variety may be the subject of multiple registrations of the same mark by the same party." *Monster Energy*, 2023 TTAB LEXIS 14, at *54; *see also Nike, Inc. v. WNBA Ent., LLC*, No. 91160755, 2007 TTAB LEXIS 39, at *20 ("The fact that opposer applies its [registered] marks to a variety of sports products makes it more likely that purchasers, aware of opposer's use of the mark on a variety of sports products, when seeing a similar mark used in connection with backpacks, duffel bags and other sports bags, are likely to believe that these products are also being produced or sponsored by opposer.").

Mr. Brutocao, Opposer's witness, testified that "[t]here are BARBIE® products in over 50 categories, including food, fitness, clothing, digital applications, video games, television shows, animated films, web media, electronics, outdoor toys, books, household products (e.g. glassware, bags/luggage, cups, mugs, furniture, rugs, candles), beauty products, jewelry, footwear, food products, and many more."[154]

Although this testimony is vague as to the nature of the specific products, the record does contain TSDR printouts of Opposer's active, pleaded registrations, which show that the BARBIE mark has been registered for use with a variety of goods and services which, in addition to the registrations previously discussed, include, wristwatches;[155] toy furniture;[156] plastic tea sets for use by children;[157] vanity dresser sets for use by children;[158] Halloween costumes;[159] soaps and lotions;[160] clothing[161] and shoes[162]; purses and cosmetic cases;[163] cosmetics for children;[164] facial tissues and

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[154] 49 TTABVUE 36; 27 TTABVUE 4 (Test. Decl. Brutocao, para. 16).

[155] 22 TTABVUE 28-33.

[156] 22 TTABVUE 34-39.

[157] 22 TTABVUE 40-45.

[158] 22 TTABVUE 46-51.

[159] 22 TTABVUE 52-56.

[160] 22 TTABVUE 57-61.

[161] 22 TTABVUE 67-72, 111-13.

[162] 22 TTABVUE 90-92.

[163] 22 TTABVUE 73-75.

[164] 22 TTABVUE 76-78, 105-110.

stickers for fingernails;[165] jewelry;[166] greeting cards;[167] and doll clothes and accessories.[168] And, although unpleaded, Opposer made of record other active registrations for BARBIE and BARBIE-formative marks for a variety of goods and services: series of books;[169] vacuum bottles for drinks;[170] bandages;[171] sunglasses;[172] retail store featuring consumer products;[173] and sanitary masks made of cloth for protection against viral infection.[174] The record shows that Barbie, the character, has appeared in over thirty entertainment titles.[175] Barbie has appeared in a supporting role in multiple *Toy Story* films, and she starred in her own Netflix series *Barbie: Life in the Dreamhouse*, and in her own branded video games, one of which was inducted into the World Video Game Hall of Fame in 2023.[176]

Applicant does not counter Opposer's argument or even specifically address these arguments in its brief, nor did Applicant cross-examine Opposer's witness.

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[165] 22 TTABVUE 79-81.

[166] 22 TTABVUE 82-84.

[167] 22 TTABVUE 85-86.

[168] 22 TTABVUE 93-95, 111-13, 114-16.

[169] 23 TTABVUE 5-10.

[170] 23 TTABVUE 11-16.

[171] 23 TTABVUE 26-28.

[172] 23 TTABVUE 29-31.

[173] 23 TTABVUE 32-34.

[174] 23 TTABVUE 92-94.

[175] 49 TTABVUE 36; 27 TTABVUE 6 (Test. Decl. Brutocao, para. 22).

[176] 49 TTABVUE 36; 27 TTABVUE 6-8, 199-220 (Test. Decl. Brutocao, paras. 22-25 and Exs. 16-21).

8. Weighing of the *DuPont* Factors

Finally, we must weigh and balance the *DuPont* factors for which there has been evidence and argument in this appeal. *In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) ("[I]t is important ... that the Board ... weigh the *DuPont* factors used in its analysis *and* explain the results of that weighing.").

Under the fifth and sixth *DuPont* factors, Opposer was successful in demonstrating that the BARBIE marks are very strong for dolls, doll clothes and doll houses and the BARBIE and BARBIE-formative marks are strong for the goods and services identified in the Compared Registrations largely due to association with the dolls. Applicant, for its part, was not successful in diminishing the strength of Opposer's marks. The sixth factor thus weighs in favor of a likelihood of confusion, while the fifth is neutral.

Turning to the second and third *DuPont* factors, Opposer did not establish that the parties' goods and services are legally identical or highly related or that the channels of trade overlap, causing these two factors to weigh strongly against likelihood of confusion. The fourth *DuPont* factor, which considers the "conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing," weighs in favor of a likelihood of confusion, as does the ninth *DuPont* factor, which considers "[t]he variety of goods on which a mark is or is not used."

Considering the first *DuPont* factor, we acknowledge that the dominant portions of the marks are phonetically identical, but, when considering the marks as a whole,

the marks are highly dissimilar in sight, connotation and commercial impression, weighing strongly against likelihood of confusion.

Here, not only are the marks dissimilar but, when combined with our determination that Opposer did not establish that the parties' goods and services are legally identical or highly related or that the channels of trade overlap, we conclude confusion is not likely. This is true despite the strength of Opposer's BARBIE marks. *See e.g., DC Comics v. Cellular Nerd LLC*, No. 91246950, 2022 TTAB LEXIS 453, at *65-66 ("Despite the strength of Opposer's "S" shield design marks, we find that the differences in the respective goods and services, as well as differences in the marks, are significant countervailing factors."); *Burns Philp Food, Inc. v. Modern Prods., Inc.*, No. 77433, 1992 TTAB LEXIS 35, at *10 ("[E]ven though the parties' goods are relatively inexpensive and would presumably be purchased without much care, and even though opposer's mark is famous in the field of spices, it is our firm belief that applicant's mark, considered in its entirety, is sufficiently different from opposer's in sound, appearance and meaning that confusion is unlikely."), *aff'd mem.*, 1 F.3d 1252 (Fed. Cir. 1993).

For the reasons discussed above, Opposer has failed to prove its claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), by a preponderance of the evidence.

V. Dilution

To prevail on its dilution claim under Section 43(c) of the Trademark Act, Opposer must establish by a preponderance of the evidence that:

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

15 U.S.C. § 1125(c); *Coach Servs.*, 668 F.3d at 1371-72; *DC Comics*, 2022 TTAB LEXIS 453, at *67.

Dilution by blurring is defined as the "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). Dilution by tarnishment is defined as an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C). Dilution occurs "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." 15 U.S.C. § 1125(c)(1).

As an initial matter, we note that in the Notice of Opposition, Opposer refers to its "World-Famous BARBIE® marks,"[177] which we understand to be a reference to its forty pleaded registered BARBIE and BARBIE-formative marks set out in the chart in its pleading.[178] Similarly, Opposer's brief refers to various BARBIE and BARBIE-formative marks, including the BARBIE and BARBIE-formative marks of the Compared Registrations, the BARBIE DREAMHOUSE mark, and THE BARBIE MOVIE. We have narrowed our consideration of Opposer's dilution claims to the mark that we believe stands the best chance of serving as a basis for them.

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[177] 1 TTABVUE 19 (para. 4).

[178] 1 TTABVUE 20-23 (para. 10).

Specifically, we focus our attention on Opposer's use and registration of the BARBIE mark for dolls[179] because we find, as discussed herein, that the BARBIE mark is famous for these goods. *TiVo Brands LLC v. Tivoli, LLC*, No. 91221632, 2018 TTAB LEXIS 439, at *20-21 ("We have narrowed our consideration of the dilution claim to the mark that we believe stands the best chance of serving as a basis for its dilution claim."). If we determine that if Applicant's mark would not dilute Opposer's BARBIE mark for dolls, then neither would Applicant's mark dilute Opposer's other pleaded marks. *Id*.

A. Does Opposer Own a Distinctive, Famous Mark for Purposes of Analyzing Opposer's Dilution Claim?

There is no dispute that Opposer's BARBIE mark is inherently distinctive and commercially very strong for "dolls" as a result of widespread use and consumer recognition. Indeed, in its brief, Applicant acknowledges that this factor "may not favor Applicant."[180]

As for whether the BARBIE mark is sufficiently "famous" to be entitled to protection against dilution, we must determine whether it is "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." *N.Y. Yankees P'ship*, 2015 TTAB LEXIS 96, at *10 (quoting Section 43(c)(2)(A) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(A)).

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[179] Registration No. 689055 (22 TTABVUE 5-10).

[180] 50 TTABVUE 32, 35.

In assessing fame for dilution purposes, we consider the following four non-exclusive factors:

> (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
>
> (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
>
> (iii) The extent of actual recognition of the mark.
>
> (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A)(i)-(iv).

As mentioned earlier, fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. *Coach Servs.*, 668 F.3d at 1373. While fame for dilution "is an either/or proposition"—it either exists or does not—fame for likelihood of confusion is a matter of degree along a continuum. *Palm Bay*, 396 F.3d at 1375 (quoting *Coors Brewing*, 343 F.3d at 1344). Accordingly, a mark can acquire "sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame." *Coach Servs.*, 668 F.3d at 1373 (quoting *7-Eleven*, 2007 TTAB LEXIS 58, at *22).

Opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Coach Servs.*, 668 F.3d at 1373 (quoting *Toro Co. v. ToroHead, Inc.*, No. 91114061, 2001

TTAB LEXIS 823, at *55).[181] A famous mark is one that has become a "household name." *Coach Servs*, 668 F.3d at 1373 (internal citations omitted). In addition, "a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context." *Toro Co.*, 2001 TTAB LEXIS 823, at *40 (citing H.R. Rep. No. 104-374, at 3 (1995) ("the mark signifies something unique, singular, or particular")). We discussed the evidence of fame of Opposer's BARBIE mark for dolls above. By all measures, BARBIE is a famous trademark for dolls and is entitled to protection against dilution under 15 U.S.C. § 1125(c).

Applicant argues that Opposer's marks cannot be diluted because they are only famous within a "niche class of consumers" and argues that "Opposer has failed to offer evidence showing fame outside that of young girls and the toy industry."[182] We disagree. As an initial matter, Applicant does not cite to any portion of the record for support for this argument and attorney argument without evidence is not persuasive. *Cai*, 901 F.3d at 1371. Moreover, it is undisputed that Opposer's dolls appeal to young girls.[183] However, Opposer's dolls do not have to be purchased by the general public for the BARBIE mark to be recognized by the general public. The duration, extent, and geographic reach of the advertising and publicity of Opposer's BARBIE mark is

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[181] "Although the Board's *Toro* decision predates the TDRA, its discussion of fame for dilution purposes remains relevant." *Coach Servs*, 668 F.3d at 1373 n.8.

[182] 50 TTABVUE 35-36.

[183] 27 TTABVUE 4 (Test. Decl. Brutocao, para. 12).

exceptional, as discussed above, and has resulted in the BARBIE mark remaining in the eye of the general public for decades. *See e.g., In re Mr. Recipe, LLC*, No. 86040643, 2016 TTAB LEXIS 80, at *11-12 ("'Niche fame' is the renown of a mark in a specialized market (*e.g.*, a specific geographic area or field of endeavor) … [and] relevant to counter a showing of fame in the dilution context ….").

B. Did Applicant Use its BARBEE and Design Mark in Commerce?

Turning to the next dilution element, Opposer must establish that Applicant was using its allegedly diluting mark in commerce. To this end, an application based on intent to use a mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), satisfies the "in commerce" requirement. *N.Y. Yankees P'ship*, 2015 TTAB LEXIS 96, at *24 ("[W]e held that an application based on intent to use a mark in commerce under Trademark Act Section 1(b) satisfied the commerce requirement.").

C. Was Opposer's BARBIE Mark Famous Before Applicant's Constructive Filing Date?

Under the third dilution factor, Opposer must prove that its mark became famous before the filing date of Applicant's intent-to-use application, which is October 19, 2021. *See Coach Servs.*, 668 F.3d at 1373. The vast majority of the evidence in the record about the fame of Opposer's BARBIE trademark predates 2021, the year of Applicant's filing. Based on the record evidence previously discussed,[184] we find that Opposer's BARBIE mark for dolls became famous before the filing date of the involved application.

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[184] *See* discussion in Sections IV(B)(1)(b)-(c), *supra*.

D. Is Applicant's Mark Likely to Cause Dilution by Blurring?

The Trademark Act provides the following framework for considering whether a mark dilutes a famous mark by blurring:

> In determining whether a mark or trade name is likely to cause dilution by blurring, the [board] may consider all relevant factors, including the following:
>
> > (i) The degree of similarity between the mark or trade name and the famous mark.
> >
> > (ii) The degree of inherent or acquired distinctiveness of the famous mark.
> >
> > (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
> >
> > (iv) The degree of recognition of the famous mark.
> >
> > (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
> >
> > (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

1. The Degree of Similarity Between Opposer's and Applicant's Marks

Opposer must demonstrate that its mark and Applicant's mark are similar. Section 43(c)(2)(B)(i) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B)(i). Applicant argues that this element is of "determinative importance" inasmuch as its mark is not similar enough to Opposer's mark to cause any dilution.

In determining the similarity or dissimilarity of the marks for dilution purposes,

> [the Board] use[s] the same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity

> of the marks in their entireties as to appearance, sound, connotation and commercial impression. While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists.

TiVo Brands, 2018 TTAB LEXIS 439, at *51 (quoting *Nike, Inc. v. Maher*, No. 91188789, 2011 TTAB LEXIS 234, at *41-42). *See also DC Comics*, 2022 TTAB LEXIS 453, at *79 ("While we are not conducting a Section 2(d) likelihood of confusion analysis under this factor for dilution by blurring, we still consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, connotation, and commercial impression."). "In other words, are applicant's and opposer's marks 'sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark[?]'" *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.*, No. 91188993, 2011 TTAB LEXIS 378, at *22 (quoting *Nat'l Pork Board v. Supreme Lobster and Seafood Co.*, No. 91166701, 2010 TTAB LEXIS 225, at *62), *vacated on other grounds*, 2011 TTAB LEXIS 2013.

Where, as here, Applicant's mark has a different appearance, meaning and commercial impression from Opposer's mark, this factor favors Applicant. *Rolex Watch U.S.A.*, 2011 TTAB LEXIS 378, at *22-24 (Opposer's ROLEX for watches and applicant's ROLL-X for X-ray tables that roll were not similar enough where survey showed that ROLL-X called to mind a feature of the goods (such as rolling, portable or X-ray) to more persons than thought of opposer's ROLEX for watches. No likelihood of blurring was proven.), *vacated on other grounds*, 2011 TTAB LEXIS 2013. *See also*

DC Comics, 2022 TTAB LEXIS 453, at *80 ("Accordingly, just as we found that Applicant's mark is not similar to Opposer's 'S' shield design marks for purposes of likelihood of confusion, we find that Applicant's mark is not similar enough to Opposer's asserted marks for purposes of dilution."); *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, No. 91177415, 2010 TTAB LEXIS 40, at *78-79 (because CAPITAL CITY BANK was not similar enough to CITIBANK to be likely to cause confusion, it was also not similar enough to be likely to cause dilutive impairment), *aff'd on other grounds*, 637 F.3d 1344.

Based on our review of the parties' marks as we discussed above in connection with Opposer's priority and likelihood of confusion claim, we find that Applicant's BARBEE and Design mark is dissimilar from Opposer's BARBIE mark in appearance, meaning and commercial impression such that the former does not readily conjure up the latter. The similarities/dissimilarities of the marks factor therefore favors Applicant.

2. The Degree of Inherent or Acquired Distinctiveness of the Famous Mark.

Opposer must also establish that its mark is distinctive. "This inquiry is made even when it is undisputed that Opposer's mark is registered on the Principal Register." *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, No. 91121204, 2003 TTAB LEXIS 391, at *61-62. As discussed, *supra*, we have found Opposer's mark to be

inherently distinctive, Applicant does not dispute this, and Applicant acknowledges in its brief that this element "may not favor Applicant."[185]

3. The Extent to Which the Owner of the Famous Mark is Engaging in Substantially Exclusive Use of the Mark.

Mr. Brutocao, Opposer's witness, testified that "[Opposer] has enforced the BARBIE® mark in several lawsuits, hundreds of Opposition and Cancelation actions before the Trademark Trial and Appeal Board, hundreds of cease-and-desist letters, and tens of thousands of online notice-and-takedown requests."[186] Indeed, Applicant admitted that it is unaware of any third parties using the mark BARBIE or any similar mark such as BARBEE.[187] Even considering the two registrations in Class 16 of which Opposer is purportedly aware, which we discussed earlier,[188] there is no evidence of the registrations in the record.

Even if there were such evidence, it would not cause this factor to weigh in favor of Applicant because the law does not require that use of the famous mark be "absolutely exclusive," but merely "substantially exclusive." *McDonald's Corp. v. McSweet, LLC*, No. 91178758, 2014 TTAB LEXIS 351, at *64-65 (citing *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352 (Fed. Cir. 1999) (holding that in the trademark context, "substantially exclusive" use does not mean totally exclusive use)).

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[185] 49 TTABVUE 32.

[186] 27 TTABVUE 20-21 (Brutocao, paras. 71-72).

[187] 26 TTABVUE 14 (Applicant's Response to Opposer's Request for Admission Nos. 26-27); 26 TTABVUE 24, 29-30 (Applicant's Response to Interrogatory Nos. 7-8, 16-18).

[188] *See* discussion, *supra*, Section IV(B)(1)(a).

On the record before us, we find that Opposer's use of the BARBIE mark is at least substantially exclusive. Accordingly, this factor favors Opposer.

4. The Degree of Recognition of the Famous Mark

With respect to the degree of recognition of Opposer's BARBIE mark, we have no direct evidence, e.g., a survey, showing a level of recognition of Opposer's mark. However, Opposer's evidence of strong and consistent appearance in print and online, and in television and feature films proves that Opposer's mark has attained a significant level of recognition. *DC Comics*, 2022 TTAB LEXIS 453, at *82-83.

5. Whether Applicant Intended to Create an Association with Opposer's Famous BARBIE Mark.

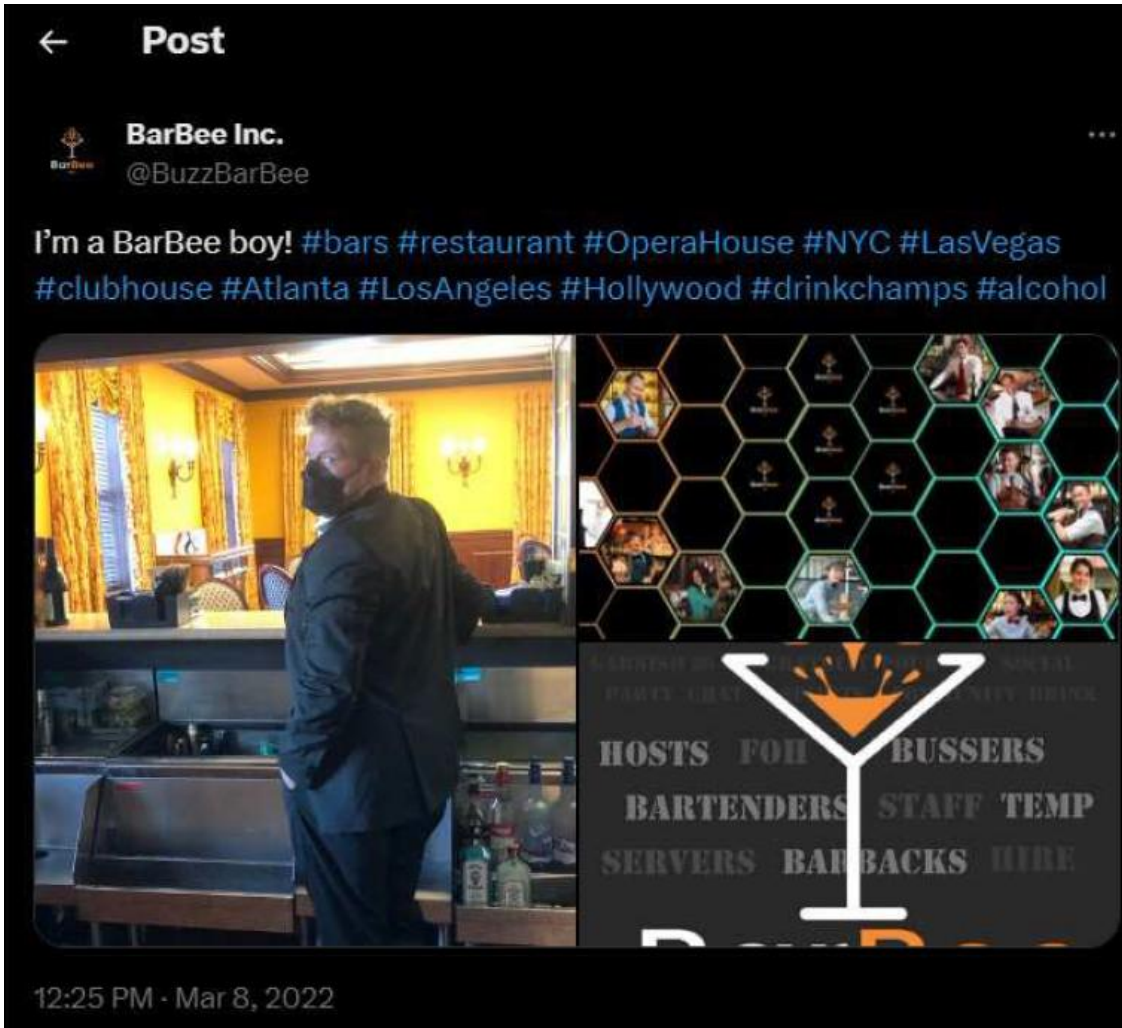
We turn now to the factor analyzing whether Applicant intended to create an association with Opposer's BARBIE mark. Opposer argues that Applicant intended to create an association with Opposer. To satisfy this factor, it is not enough that Applicant was aware of Opposer's BARBIE mark before it filed its application to register its involved mark.[189] *Nike*, 2011 TTAB LEXIS 234, at *43.

Here, Opposer relies heavily on Applicant's Twitter post dated March 8, 2022, which includes the caption: "I'm a BarBee Boy!"[190] In its main brief, Opposer argues that this post and its caption "speak[ ] for itself."[191]

[189] 49 TTABVUE 40.

[190] 49 TTABVUE 40; 51 TTABVUE 7.

[191] 49 TTABVUE 40.



[192]

Applicant counters that this is "one comedic social media post … [that] clearly falls under fair use and not an actual intention to create an actual source-confusing association between the respective brands."[193] In its reply brief, Opposer offers a more robust argument: that Applicant was "clearly invoking the well-known Aqua song, 'Barbie Girl"—specifically its signature chorus lyric, 'I'm a Barbie Girl.'"[194] Opposer adds that Applicant's characterization of the post as "comedic" and "fair use" is a

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[192] 41 TTABVUE 95 (Exhibit D to the Muirhead Cross Ex. Test.).

[193] 50 TTABVUE 33.

[194] 51 TTABVUE 7.

concession that the caption "I'm a BarBee boy!" was intended to call to mind and capitalize on consumers' familiarity with the phrase "I'm a Barbie Girl."[195]

Applicant's argument mentions "fair use" in passing but does not explain how its post meets the requirements of Section 43(c)(3)(A), which expressly provides that a "fair use" "shall not be actionable as dilution by blurring or dilution by tarnishment …." 15 U.S.C. § 43(c)(3)(A). Similarly, Opposer does not address the statutory elements but rather encourages us to draw inferences from Applicant's arguments.

During cross-examination, Mr. Muirhead, Applicant's founder, was questioned about this post:

19 Q This is a Twitter post on BuzzBarBee from

20 March 8th, 2022. Is that you in that photo?

21 A That is. But that was taken during COVID in 2020.

22 Q That's fine. And the text is, "I'm a BarBee boy."

23 You wrote that?

24 A Is this the Twitter? No, I didn't write that.

25 Q You did not write that?

1 A No. I did not write that.

2 Q Who did?

3 A The guy that we hired.

4 Q And he posted this on your behalf?

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[195] 51 TTABVUE 7-8.

5 A Apparently so. I didn't even know this existed

6 until now. And to be honest, I'm not even certain,

7 like, with the mask on.

8 Q You don't recognize yourself standing behind that

9 counter in that room?

10 A You know, I know the picture.

11 Q So that is you?

12 A It appears to be.

13 Q Okay. And you -- have you looked at this Twitter

14 account since March 8, 2022?

15 A I don't know. No. I don't have access to -- I

16 have no security passwords to it.

17 Q Again, like you said, nothing's ever lost. It's

18 there to look at. · I'm not asking if you accessed

19 it since then.

20 A I have no reason to look for it. If I don't know

21 if I'm on there, I have no reason to look for it to

22 see if we're on there because it's not a platform

23 that we use because I strictly use TikTok.[196]

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[196] 41 TTABVUE 42-43 (Cross. Ex. Muirhead 40:19-41:23).

Based on this evidence of record, we find that this one post alone, without more, is not sufficient for us to determine that Applicant intended to create as association with Opposer's BARBIE mark.

6. Any Actual Association between the Mark or Trade Name and the Famous Mark.

While the parties agree that there is no evidence of any actual association between Applicant's mark and Opposer's mark,[197] Opposer argues that such evidence is not required,[198] and indeed would be difficult to come by, inasmuch as Applicant has used its mark at most in a very limited manner.[199] Applicant, on the other hand, counters that the lack of evidence clearly points in its favor.[200]

Because the involved application was filed based on an intent-to-use, and the record shows that Applicant has had limited actual use of its mark,[201] we find that there has been a limited opportunity for the public to make any actual association between the parties' marks. Thus, we consider this factor to be neutral. *N.Y. Yankees P'ship*, 2015 TTAB LEXIS 96, at *35 (because involved application filed based on intent to use and record shows limited actual use, the Board found this factor neutral).

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[197] 49 TTABVUE 40; 50 TTABVUE

[198] 49 TTABVUE 40.

[199] 49 TTABVUE 40; 51 TTABVUE 6.

[200] 50 TTABVUE 32.

[201] *See* discussion, *supra*, Section IV(B)(6).

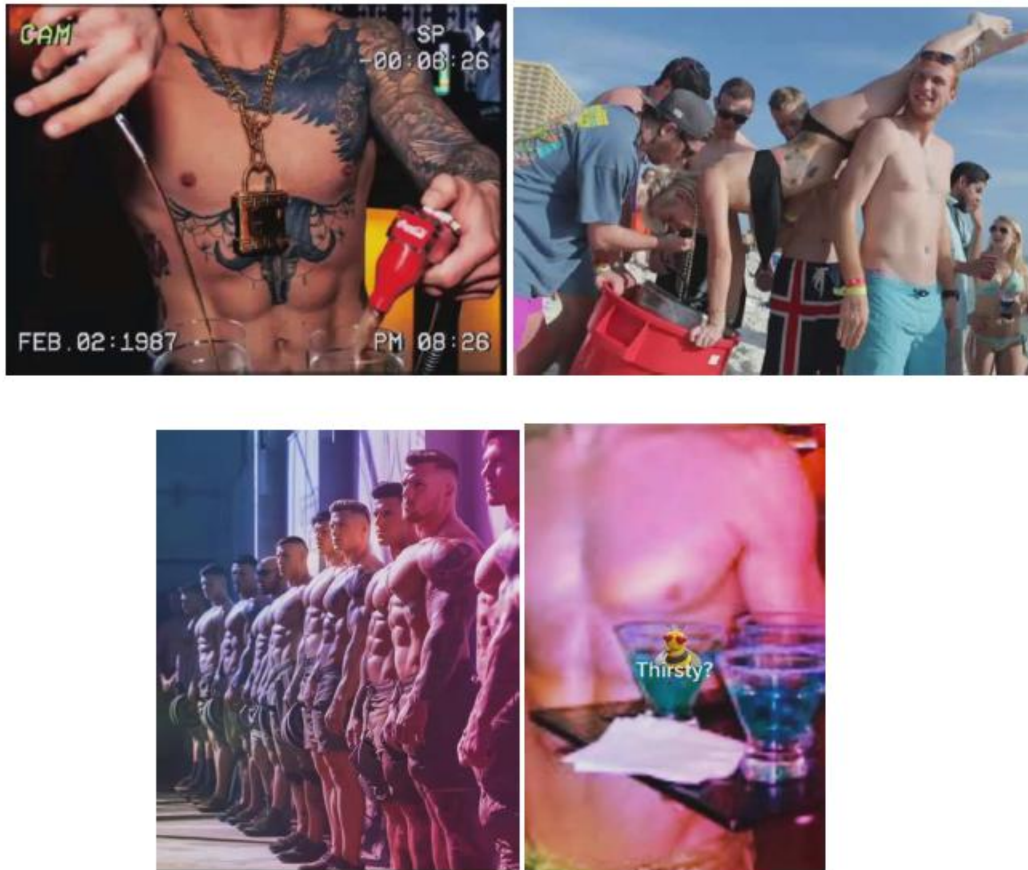
7. Conclusion as to Dilution by Blurring

Having determined that Opposer failed to establish that Applicant intended to create as association with Opposer's BARBIE mark and that the marks are dissimilar, we conclude on this record that Opposer has failed to prove dilution by blurring under Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B), by a preponderance of the evidence.

E. Whether Applicant's Mark Is Likely to Cause Dilution by Tarnishment

Dilution by tarnishment is an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C). In addition to the first three elements of a dilution claim discussed above, Opposer also must prove by a preponderance of the evidence that Applicant's use of its mark is likely to cause dilution by tarnishment.

Opposer argues that Applicant uses its mark with unwholesome and unsavory content, such as the below "bawdy images" taken from Applicant's TikTok account:



[202]

Opposer adds that during Mr. Muirhead's cross-examination, he testified that he posted to TikTok an image of a shirtless man with the caption, "thirsty?" to "play on the sex appeal of the viewers."[203]

Applicant, not surprisingly, completely disagrees. First, Applicant argues that the similarities between the marks are not sufficient to create an association, so no tarnishment can result.[204] Second, "though Applicant's Mark is not used for choir boy services, a few pictures of shirtless men and an association with bars and alcohol is

[202] 49 TTABVUE 42; 45 TTABVUE 2 (Exs. F2, F3, F4 and F6).

[203] 49 TTABVUE 43; 41 TTABVUE 56 (Muirhead Cross Ex. Test. 54:15-19).

[204] 50 TTABVUE 34.

not the type of 'sexual activity', obscenity, and illegal activity[ ] that is likely to tarnish Opposer's brand."[205] Applicant adds that "Opposer's allegations of **bawdiness** are highly hypocritical."[206] "To insinuate that Margot Robbie or Ryan Gosling were cast in the movie without any thought of sex appeal in such decisions is unconvincing."[207] In making these arguments, Applicant acknowledges that "the content of the Barbie movie has not been made of record …."[208]

We need not reach the question of whether Applicant's use of its mark is distasteful. Inasmuch as we have determined that the marks are dissimilar, Opposer has not established that its mark will suffer any negative association by Applicant's mark. In view of the foregoing, Opposer has failed to prove its claim of dilution by tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), by a preponderance of the evidence.

VI. Decision

The opposition to registration of the mark in Application Serial No. 97081593 is dismissed on the grounds of (1) priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

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[205] 50 TTABVUE 34.

[206] 50 TTABVUE 34 (italics in original, bold here).

[207] 50 TTABVUE 35.

[208] 50 TTABVUE 35.