

FAME BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
AND THE CANADIAN TRADE-MARKS OPPOSITION BOARD

The North American subcommittee of INTA's Dilution and Well Known Marks Committee reviewed all decisions issued in 2009 by the United States Trademark Trial and Appeal Board to see if the Trademark Dilution Revision Act (TDRA), which has been law in the United States since October 6, 2006, has impacted the treatment of famous marks. In sum, although fame continues to be an important factor in the Board's likelihood of confusion analysis, none of the decisions summarized by the subcommittee were decided under the TDRA. In fact, if the Board found a likelihood of confusion where the opposer also pleaded a dilution claim, the Board would not address the dilution claim. Moreover, where fame played a role in the Board's likelihood of confusion analysis, the Board repeatedly noted that it is the duty of the party asserting fame to clearly prove it because of the extreme deference accorded to famous marks.

The subcommittee also reviewed all 2009 decisions of the Canadian Trade-Marks Opposition Board regarding the treatment of famous marks. The general trend before Canada's Trade-Marks Opposition Board in 2009 was to continue to follow recent Supreme Court of Canada case law regarding famous marks. Generally, where the Board was prepared to find that a trade-mark is famous, it limited the owner's rights to the sphere of activity in which the owner had established fame or closely related activities. Both Boards continue to set a relatively high bar for finding a mark to be famous.

UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD

Case Title: *Outback Steakhouse of Florida, Inc. and OS Asset, Inc. v. Waterworldwide Pty Ltd.*, Opposition 91161384, decided 1/07/09

Citable as Precedent: No

Opposer's Mark(s): OUTBACK and OUTBACK STEAKHOUSE and Design [beer]

Applicant's Mark(s): AUSTRALIAN OUTBACK RAIN and Design [bottled drinking water, Class32]; AUSTRALIAN and OUTBACK disclaimed.

Issues: Likelihood of Confusion

Decision: Opposition and counterclaim both dismissed and Notice of Allowance should issue to applicant.

Fame: Fame was not pleaded but opposers argued their OUTBACK marks are inherently distinctive, commercially strong and famous. On this point, opposers relied exclusively on news articles submitted via Notice of Reliance and ask TTAB to weigh the fame of their prior marks in their favor. Long held that Board cannot consider printed publications submitted for proof of facts asserted in the printed publications. The articles are hearsay.

Case Title: *Ironman Magazine v. World Triathlon Corporation*, Opposition 91167894, decided 1/12/09

Citable as Precedent: No

Opposer's Mark(s): IRON MAN and IRONMAN [used since 1936 in publishing and distributing magazine directed to the bodybuilding and weight training industry]

Applicant's Mark(s): IRONMAN and Design [nutritional, food and vitamin supplements...]. Applicant has used mark in connection with triathalon events.

Issues: Likelihood of Confusion

Decision: Opposition sustained.

Fame: TTAB found opposer's IRONMAN mark has not achieved the notoriety of a famous mark, although opposer's mark was well-known in the world of bodybuilding. Applicant submitted substantial evidence as to the fame of its various IRONMAN marks. TTAB found that the evidence of fame of the Applicant's mark was not relevant to the du Pont factor of fame, because weight of fame is given to the mark of the senior user, not that of the junior user.

Case Title: ***Ziebart International Corp. v. Z Tech Rustproofing, Care Care, & Accessories, LLC***, Opposition 91158809, decided 1/13/09

Citable as Precedent: No

Opposer's Mark(s): Z-LINER and Z-SHIELD [applying protective coatings for vehicles]

Applicant's Mark(s): Z TECH Stylized [application of protective coatings to prevent road abrasions]

Issues: Likelihood of Confusion

Decision: Opposition Sustained. Applicant's counterclaims dismissed. Applicant's mark Z TECH when used in connection with the identified services is likely to cause confusion at least with respect to Z-LINER and Z-SHIELD.

Fame: The TTAB found opposer's assertions that its marks are famous to be unsupported by the record. The duty of a plaintiff asserting that its marks are famous is to clearly prove it. Opposer alleged it had one million customers spread out over years; however, opposer did not provide a yearly breakdown nor evidence of sales or advertising expenditures. The TTAB wanted evidence to establish that the marks are famous now.

Case Title: *In re Heartland Design Associates, LLC*, Serial No. 77245616, decided 1/13/09

Citable as Precedent: No

Applicant's Mark(s): CHEF JEFF'S KITCHEN and Design [pickles, jellies and jams in Class 29: salad dressings, relishes, and catsup; herbal teas; salsas; spices; processed herbs; seasonings in Class 30] CHEF and KITCHEN disclaimed.

Cited Registration: CHEF GEOFF's [eat-in and carry-out restaurant services, and catering services]

Issues: Likelihood of Confusion

Decision: Refusal of registration is affirmed.

Fame: In its brief, Applicant listed fame of the registered mark as a du Pont factor to be considered, but did not discuss this factor. The TTAB merely stated "As would be expected in an ex parte proceeding, there is no evidence of fame of the registrant's mark. This du Pont factor is neutral."

Case Title: *Hearst Communications, Inc. v. Charles Browning Wilson*,
Opposition 91120453, decided 1/16/09

Citable as Precedent: No

Opposer's Mark(s): COSMOPOLITAN [magazines]; COSMOPOLITAN.COM [providing an interactive on-line computer database featuring, inter alia, entertainment news]; a family of marks comprising or incorporating the terms COSMOPOLITAN or COSMO [a variety of goods & services]

Applicant's Mark(s): COSMO.COM? [providing on-line information on available entertainment in various cities]

Issues: Likelihood of Confusion

Decision: Opposition Sustained

Fame: Based on record, TTAB found that under the du Pont factors, COSMOPOLITAN is famous for magazines; however, although the mark might have some renown with other goods and services, TTAB was not prepared to find COSMOPOLITAN famous for opposer's other goods and services. Evidence of fame included average circulation of COSMOPOLITAN magazines in 1998 more than 2.6 million copies in U.S. and advertising expenditures in 2005 more than \$16.2 million. Evidence also showed unsolicited references to opposer's COSMOPOLITAN mark and magazines by others in a variety of contexts. Applicant referred to third party registrations and uses of COSMOPOLITAN and COSMO marks, but record was devoid of evidence to establish this. Having found likelihood of confusion, the TTAB found it was not necessary to consider the opposer's dilution claim.

Case Title: *In re Richard Starkey aka Ringo Starr*, Serial No. 78821116, decided 1/27/09

Citable as Precedent: No

Registrant's Mark(s): RINGO [men's, women's and children's clothing, namely, shirts, blouses, pants, shorts, hosiery, jackets and underwear]

Applicant's Mark(s): RINGO [clothing, namely, sweatshirts and sweatpants, shorts, tops, t-shirts, sport shirts, shirts, wind resistant jackets, jackets, belts and socks; headgear, namely, headbands, hats, caps and beanies; and footwear, all depicting the name and image of a famous entertainer]

Issues: Likelihood of Confusion

Decision: Refusal of Registration Affirmed

Fame: TTAB granted applicant's request that it take judicial notice that he is a famous entertainer who performs under stage name of "Ringo Starr." With respect to fame of the mark, TTAB reiterated that the issue with fame involves "fame of the prior mark", and the registrant was deemed to be the owner of the "prior mark" as used on goods for which Ringo Starr was seeking a registration. Starr's fame as an entertainer does not entitle him to register RINGO for goods that are similar to or the same as those in registrant's earlier registration for RINGO. Starr's fame was not a factor in decision. However, in a footnote TTAB stated that even if it considered Applicant's fame and were to agree that due to that fame purchaser's would understand prior to purchasing his goods that RINGO referred to applicant and that he was the source of those goods, the result would be the same because the converse would not be true. That is, applicant's fame might lead purchasers to mistakenly assume that Registrant's clothing originated with Applicant or that Registrant's use is pursuant to a license or other authorization by Applicant – also a source of confusion that would preclude registration by Starr.

Case Title: *Alpharma Inc. v. Advanced Animal Nutrition, Inc.*, Opposition 9164763, decided 1/27/09

Citable as Precedent: No

Opposer's Mark(s): 3-NITRO [growth stimulant for chickens, turkeys, and swine]

Applicant's Mark(s): NITRO [animal feeds and animal feed products, namely, pet foods]

Issues: Likelihood of Confusion

Decision: Opposition Dismissed

Fame: 3-NITRO is suggestive - an abbreviation for chemical name of active ingredient in Opposer's products (3-Nitro-4-hydroxy-phenylaronic acid). Information on sales and advertising filed under seal. Sales substantial when compared to advertising, which appears to be minimal. TTAB unable to draw any conclusions on strength of mark because Opposer did not provide any context, e.g. sales or advertising figures for comparable types of products. Opposer's Global Leader of Sales and Marketing for the animal health division testified that he had not heard of the 3-NITRO product before he joined Opposer in 1999.

Case Title: ***Ferrotec (USA) Corporation and Ferrotec Corporation v. Ferro Labs, Inc***, Opposition 91174110, decided 1/29/09

Citable as Precedent: No

Opposer's Mark(s): FERRO TEC (in stylized form) [ferrofluid compositions for use in the voice coil gap of loudspeakers; ferrofluid for domain detectors; ferrofluid for stepping-motor applications; magnetic fluid for use in a variety of industrial applications in the semiconductor & electronic industries; & other goods]; FERROSOUND, FERRODRIVE, & FERROFLUIDIC [all for goods related to those listed above]; & a family of marks, all incorporating the term FERRO, for various goods

Applicant's Mark(s): FERRO LABS (and design) [colloid suspensions of magnetic particles combining magnetic characteristics & fluidity, ferrofluids & magnetic fluids, ferrofluidic seals & suspensions used in manufacture of industrial devices requiring minimized resistance & friction, namely, dumpers, shock absorbers, seals, suspensions, cooling devices, rotating shafts, gyroscopes, bearings, image stabilizing devices for optical systems & related devices]

Issues: Likelihood of Confusion

Decision: Opposition Dismissed

Fame: TTAB did not find on the record that the FERROFLUIDIC and FERRO TEC were famous for purposes of likelihood of confusion. Information re sales and advertising submitted under seal. TTAB made clear that "although raw numbers of sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw numbers may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products)." It is the duty of party asserting fame to prove it because of extreme deference accorded to famous mark with respect to wide latitude of legal protection it receives, and the dominant role fame plays in likelihood of confusion analysis. Evidence showed use of FERROFLUIDIC since at least 1979 and the FERRO TEC mark since at least 1995, and high degree of success in marketing and selling products under the marks, but failed to prove marks famous. Opposer did not put the sales figures and marketing expenses in context. The sales and marketing numbers were combined for both marks and TTAB could not determine what amount was attributable to each mark and could not determine if either mark was famous. Opposer's evidence did not demonstrate that successful marketing of FERROFLUIDIC and FERRO TEC products translated into widespread recognition of each of the marks among relevant purchasers.

Case Title: *Musidor B.V. v. Peter Kaveh*, Opposition 91168841, decided 1/29/09

Citable as Precedent: No

Opposer's Mark(s): MICK JAGGER and JAGGER [both marks for: various clothing items, including t-shirts, shirts, sweatshirts, dresses and lingerie]

Applicant's Mark(s): JAGGER [clothing, namely, suits, shirts, t-shirts, pants, shorts, sweatshirts, jackets, skirts, dresses, tops, sweaters, headwear, raincoats, underwear, pajamas, robes, infant wear, swim wear, beach wear; accessories, namely, gloves, mittens, scarves, belts; socks and footwear]

Issues: Likelihood of Confusion

Decision: Opposition Sustained

Fame: Opposer contended that MICK JAGGER is a famous mark and a famous individual, and Rolling Stones is a famous musical group. The record contained deposition with deponent's opinion about fame. TTAB noted that this is not the type of fact of which the TTAB can take judicial notice. Therefore, TTAB concluded that it had no basis to find fame.

Case Title: *Mrs. United States National Pageant, Inc. v. Melvin A. Richardson and Mary C. Richardson*, Opposition 91165290, decided 3/05/09

Citable as Precedent: No

Opposer's Mark(s): "MRS. UNITED STATES NATIONAL PAGEANT" and "MRS. UNITED STATES" (in stylized form)[both marks for: entertainment services in the nature of beauty and talent pageants]

Applicant's Mark(s): "MRS. U.S. INTERNATIONAL" [promoting the goods and services of others through the medium of pageants and contests conducted on a national and regional basis]

Issues: Likelihood of Confusion

Decision: Opposition Sustained based on Likelihood of Confusion; however, Board found evidence of fame insufficient.

Fame: The evidence shows that opposer has used its MRS. UNITED STATES NATIONAL PAGEANT and MRS. UNITED STATES marks for over 18 years. Since 1997, Opposer has maintained a website where interested women can obtain information about its beauty pageant and has advertised its beauty pageant in Pageantry Magazine. The Las Vegas Sun newspaper, in an article dated August 1, 1997, described opposer's pageant as "the premier event of its kind." The executive director of the Mrs. New York State Pageant for the MRS. UNITED STATES NATIONAL PAGEANT testified that "MRS. UNITED STATES is a very well-respected pageant ... it's considered among the top two for married women in the U.S." Opposer offered no evidence regarding its profits and advertising expenditures. The Board found the testimony of opposer's witnesses Mrs. Ilacqua and Mrs. Strassburg with respect to the reputation of opposer's beauty pageant self-serving, and a single news article describing opposer's pageant as "the premier event of its kind" is insufficient evidence of widespread critical assessments.

Case Title: *Under Armour, Inc. v. Hot Gear LLC*, Opposition 91173897, decided 3/09/09

Citable as Precedent: No

Opposer's Mark(s): "HEATGEAR"[clothing, namely, t-shirts, shorts, shirts, leggings, underwear, tank tops and women's bras]

Applicant's Mark(s): "HOTGEAR" [athletic uniforms; and a wide variety of other clothing items]

Issues: Likelihood of Confusion

Decision: Opposition Sustained based on Likelihood of Confusion; Board found that the *du Pont* factor of fame clearly favored the opposer.

Fame: Opposer's advertising and revenue figures showed substantial advertising, promotion and sales for its goods identified by the mark HEATGEAR, including the fact that 60% of opposer's sales are in its HEATGEAR line and opposer's overall sales comprise a 70% share of the performance wear market. The Board inferred from the nature and wide extent of opposer's promotional activity that the consuming public has had significant exposure to opposer's HEATGEAR brand and goods. Thus, although the opposer may also use its house mark, UNDERARMOUR with HEATGEAR, the Board found that the evidence clearly establishes that HEATGEAR is a famous mark for likelihood of confusion purposes in connection with performance wear, which is a subset of the broadly identified clothing in opposer's registration. The Board found that consumers familiar with opposer's performance wear clothing sold under the famous mark HEATGEAR would be likely to believe, upon encountering applicant's athletic uniforms sold under the mark HOTGEAR, that the goods originate from or are associated with or sponsored by the same entity.

Case Title: ***Gecko Trading Co., Inc. v. Gecko's Toes, Inc.***, Oppositions 91174136 and 91173878, decided 3/10/09

Citable as Precedent: No

Opposer's Mark(s): "GECKO" [a variety of goods, including clothing, sporting goods, jewelry, beach products, skin and hair care products, smoking articles, eyewear, and glassware; and retail and wholesale store services featuring apparel, beach products, stuffed dolls and novelty items]

Applicant's Mark(s): "AIRGECKO" and "GECKO'S TOES" [both marks for: hose hangers not of metal]

Issues: Likelihood of Confusion

Decision: Oppositions Dismissed. Board found no Likelihood of Confusion. Board found the limited evidence of use of GECKO mark and availability of opposer's goods to consumers through opposer's retail store and in department stores was not sufficient to establish extensive public recognition and renown of the opposer's GECKO mark.

Fame: Opposer alleged use of GECKO mark since 1984 and annual sales of approximately \$7 - \$10 million annually for the last 12 years; advertising expenditures of over \$150,000 from 2001 – 2002 for its clothing products and sale of its products nationwide in its own two stores, major department stores and the Internet. Opposer also claimed it had an extensive licensing program for goods under its GECKO mark. Board found that opposer's evidence of the asserted notoriety of its GECKO mark, while sufficient to show that it has enjoyed success in marketing goods under the mark, is insufficient to show that such mark is famous. Primarily in view of the lack of an established relationship between applicant's goods and opposer's goods and services, Board found that opposer has failed to demonstrate a likelihood that the consumers would be confused by applicant's AIRGECKO and GECKO'S TOES marks for its hose hangers.

Case Title: *Overstock. Com, Inc. v. Web-Notions, Inc.*, Opposition 91175307, decided 3/10/09

Citable as Precedent: No

Opposer's Mark(s): "OVERSTOCK.COM" [online wholesale and retail store services]

Applicant's Mark(s): "A1OVERSTOCK" [online wholesale bookstore services, featuring books, magazines, and posters]

Issues: Likelihood of Confusion and Dilution

Decision: Opposition Sustained on Likelihood of Confusion.

Fame: Although the applicant admitted in response to a request for admission that the opposer's "mark is distinctive and famous" and that registration of applicant's mark "will likely cause dilution of the distinctive quality of Opposer's famous and distinctive name and mark," the Board stated that the dilution claim failed because such admissions do not excuse opposer from having to prove that its mark was distinctive and famous prior to the filing date of the application at issue.

Case Title: *Google Inc. v. Nikolaus Gubernator*, Opposition 91171014, decided 3/13/09

Citable as Precedent: No

Opposer's Mark(s): "GOOGLE" and "GOOGLE"(and design) [both marks for: creating indexes of information, indexes of websites and indexes of other information sources in connection with global computer networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, by means of global computer information networks; and other goods and services]

Applicant's Mark(s): "CHMOOGLE"[consultation services in the field of scientific research]

Issues: Likelihood of Confusion and Dilution.

Decision: Opposition Sustained on Likelihood of Confusion, therefore Board did not reach the dilution claim. Board concluded that opposer showed significant market exposure, revenue, and overall fame amongst the relevant public. The evidence clearly established that for likelihood of confusion purposes, GOOGLE is a famous mark in connection with search engine services.

Fame: Google provided evidence that The Google search engine is so widely used, that Google has generated billions of dollars in revenue over the past few years. In 2005, Google had a net income of \$1,465,397,000, which has increased every year since, with net income for the first quarter of 2008, of \$1.37 billion, up from \$1.21 billion in the fourth quarter of 2007. Opposer submitted dozens of news articles discussing the reputation and fame of Google. In a 2003 telephonic survey of respondents who indicated "they used the Internet," 53.47% identified Google as a search engine without prompting, more than double the next most recognized brand. Survey expert concluded Google brand was famous as early as 2003 in connection with search engine services.

Case Title: *Novartis AGv. Cera Products, Inc.*, Opposition 91173560, decided 3/20/09

Citable as Precedent: No

Opposer’s Mark(s): “THERAFLU” [cough and cold preparation]

Applicant’s Mark(s): “CERAFLU” [oral hydration powdered nutritional supplement drink mix]

Issues: Likelihood of Confusion and Dilution

Decision: Opposition Sustained on Likelihood of Confusion; therefore, Board found no need to reach the dilution claim.

Fame: Opposer's THERAFLU product was first sold in 1987 and over the last 20 years a number of THERAFLU products have increased. In 2007, sales of THERAFLU products approached one hundred-million dollars. THERAFLU has maintained the number one ranking measured by gross sales among all the products currently on the market for treating flu symptoms. Opposer's latest market research to evaluate the popularity and recognition of its THERAFLU mark shows that the mark has an aided brand awareness of 93% among relevant consumers. Opposer’s level of promotional expenditures is set as a percentage of sales. Details of opposer’s nationwide promotional campaigns for THERAFLU products on TV, radio, and print ads remain confidential, but Board said that the documentation was substantial, and included detailed flow charts listing day-by-day television ad placement information over a period of more than five years, often on popular, primetime shows on national cable and over-the-air networks.

Case Title: *Under Armour, Inc. v. Renee Bode*, Opposition 91178653, decided 5/21/09

Citable as Precedent: No

Opposer's Mark(s): "UNDER ARMOUR" [numerous items of clothing listed in eleven pleaded registrations]

Applicant's Mark(s): "UNDERARMIES" [underarm clothing shields]

Issues: Likelihood of Confusion

Decision: Opposition Sustained. The TTAB found that opposer had shown that its mark UNDER ARMOUR is a famous mark in the field of sporting goods and clothing for purposes of likelihood of confusion.

Fame: The record showed that opposer owned eleven registrations that include the words UNDER ARMOUR for a variety of clothing and sporting goods, and had been using the mark UNDER ARMOUR in connection with clothing since the mid-1990s. Opposer advertised in a variety of newspapers, in nationally distributed magazines, at sporting events such as the Boston Marathon, on television, including the Super Bowl, in sport stadiums, on billboards, and on the Internet via banner and search engine advertisements. In 2008, Nielsen rated Under Armour as the number one viewed brand in product placement for the first quarter. Several athletes have endorsed UNDER ARMOUR clothing and opposer outfits several teams, including U.S. Olympic teams. Opposer has had product placements of the mark UNDER ARMOUR in movies and video games. Opposer created and sponsors the "All-American Games" and the "Under Armour Senior Bowl" featuring top high school athletes. Since 2004, opposer's revenues and advertising expenditures have more than doubled. In 2007, opposer's net revenues were \$606.6 million, and its advertising and marketing expenses were \$218.8 million.

Case Title: *American Girl, LLC v. Barry Epstein*, Opposition 91169029, decided 5/28/09

Citable as Precedent: No

Opposer's Mark(s): "AMERICAN GIRL" [clothing, namely, shirts, pants, tank tops, blouses, sweaters, sweatshirts, and a number of other items of clothing; dolls and doll accessories; and other goods and services]

Applicant's Mark(s): "AMERICAN BOY" [clothing, namely, shirts, pants, tops, sweaters, sweatshirts and suits]

Issues: Likelihood of Confusion

Decision: Opposition Sustained. In view of deficiencies in opposer's evidence, the TTAB was not persuaded the AMERICAN GIRL mark was famous for dolls and doll accessories, but found that it was a strong mark for those goods. The TTAB also found that Opposer had established that the public is aware of AMERICAN GIRL as a trademark for clothing and that the trademark function of AMERICAN GIRL for dolls and doll accessories had transferred to girl's clothing.

Fame: Opposer claimed that its AMERICAN GIRL mark for various goods and services had achieved "tremendous fame," and that applicant's intended use of the AMERICAN BOY mark is likely to dilute opposer's AMERICAN GIRL marks. Opposer's evidence showed that it had sold 123 million books since 1986, 14 million dolls, had 23 million visitors to its American Girl retail stores in Chicago, New York and Los Angeles, and had about 50 million visits to its AmericanGirl.com web site each year. Opposer had released three made for TV movies, one in 2005, 2006 and 2007, based on historical characters which are the subject of opposer's dolls and books, and launched a feature film in July 2008.

TTAB remarked that much of opposer's evidence in support of its contention that its mark was famous was designated confidential in depositions. TTAB deferred to opposer and did not identify any such information although some of the evidence, including sales figures, was available to the public in annual reports and introduced as attachments to declarations and were not marked as confidential.

With regard to opposer's articles of clothing, TTAB found that the strength of the AMERICAN GIRL mark extends to clothing for girls. Opposer marketed its clothing items in the same stores and in the same catalogs in which it markets its dolls and doll accessories. TTAB found opposer's gross annual sales for clothing items impressive and noted that opposer owned numerous registrations for clothing items.

Case Title: *Paddington & Company, Ltd. v. Lead Co., Ltd.*, Opposition 91150248, decided 5/29/09

Citable as Precedent: No

Opposer’s Mark(s): “Paddington Bear” character mark in duffel coat and floppy hat [Christmas ornaments, children’s growth charts, children’s hats, children’s jackets, children’s hairbrushes, children’s activity kits, children’s games, children’s dinnerware, children’s calendars]

Applicant’s Mark(s): “TEENIE WEENIE BEAR” (and bear design in duffel coat, backward baseball cap and pants) [Class 16: paper handkerchiefs, tissue paper, notebooks, memo paper, name card paper, envelopes, scrapbooks, ballpoint pens, pencils, crayons, pencil cases, letter holders, boxes of paper, paper sacks for packaging, picture postcards, comic books, catalogues in the field of general merchandise and clothing, and magazines dealing with topics of sports, cultural events and general interest; Class 25: clothing and footwear, namely, flat shoes, basketball shoes, sandals, slippers, raincoats, mantillas, shorts, half coats, shirts, dresses, baby bunting, jackets, jumpers, jeans, parkas, Hawaiian print shirts, pajamas, night gowns and night shirts, bathrobes, sweaters, sport shirts, athletic uniforms, t-shirts, pullovers, mufflers, mittens, scarves, socks, hats and caps, belts]

Issues: Likelihood of Confusion; *Bona Fide* intention to use mark

Decision: Opposition Dismissed on both grounds in a 2 to 1 decision. The panel was unanimous that, in view of the evidence, although the panel was unable to conclude that opposer’s Paddington Bear character mark was famous for purposes of likelihood of confusion, the evidence showed that the Paddington Bear character mark was strong. The majority’s decision to dismiss the opposition was based on its conclusion that the dissimilarity of the marks and third party use of the marks, which favored the applicant, were dispositive. The dissent indicated that it would have sustained the opposition based on its belief that the marks were similar and the evidence of third party use was not dispositive.

Fame: The evidence presented by opposer included ten novels and three collections of short stories about Paddington Bear, DVDs and television programs, including broadcasts in 1981 by 215 PBS stations. A Nielsen survey revealed that the 1981 programs were viewed by a cumulative audience of 1,710,000 television households which represented a total audience of 2.9 percent of all

television households in the U.S. In 1975 opposer formed Paddington & Co. in response to the demand for Paddington Bear-branded merchandise and since that time had licensed the use of the Paddington Bear character on a wide variety of merchandise. The Paddington Bear character had been featured in contests and promotions with Good Housekeeping magazine, the American Library Association, and UNICEF. During the 1990 Christmas season. Macy's had tie-ins with the Paddington Bear character, including offering a variety of merchandise, having sales associates wear pins with the image of the Paddington Bear, and conducting a musical review at its flagship store in New York City, which featured the Paddington Bear character. In 1990, the first Paddington Bear balloon appeared in the Macy's Thanksgiving Day Parade. In 1994, Sears entered into a license to sell merchandise with the Paddington Bear character. In 2002, Dayton Hudson constructed a Christmas grotto in the Minneapolis airport featuring animated scenes from the story *Paddington Bear and the Christmas Surprise*; and Marshall Fields created a series of Christmas windows featuring the Paddington Bear character at its downtown Chicago store.

Opposer presented no specific evidence of the dollar amounts expended on advertising or sales of merchandise under the Paddington Bear character mark because opposer's licensees did not provide opposer with this information. The evidence alleged that using a formula provided by opposer an approximation for "Paddington-branded merchandise," including the character mark, the word mark and/or PB was more than \$92 million during the 1991-early 2004 time frame. The TTAB found that it could not determine what amount of the purported \$92 million was attributable to the Paddington Bear character mark. The TTAB found that opposer failed to put in context its retail sales figures for the Paddington-brand merchandise vis-à-vis other brands that featured marks consisting of children's storybook or television characters and, as well as the number of books it had sold featuring the Paddington Bear character.

Majority concluded that TEENIE WEENIE BEAR was the dominant part of the applicant's mark and found that the inclusion of the words and the differences in the respective bear designs sufficient to distinguish the marks.

The dissenting opinion pointed out that, as set forth in the majority opinion, the Paddington Bear character is a strong mark and both applicant's and registrant's marks comprised anthropomorphic bears wearing "duffle" coats and hats, without more, photographs

of six third-party teddy bears wearing duffle coats and hats or hoods did not weaken opposer's mark. Furthermore, the nature of the products, prospective consumers would not exercise a high degree of care in considering their purchases, their attention would focus more on the similarities in the marks than the differences. The dissent also points out that the majority has articulated the test as not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather, whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result and that the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Finally, the dissent disagreed with the majority's finding that the name "Teenie Weenie Bear" is the dominant element of applicant's mark and found that the bear design is the dominant element because of the size and placement of name vis-à-vis the design and that, therefore, the name identifies the design. In view of the foregoing, the dissent would have sustained the opposition under likelihood of confusion.

Case Title: ***Otto International, Inc. v. Otto Studio, LLC***, Opposition
91175103, decided 6/01/09

Citable as Precedent: No

Opposer's Mark(s): "OTTO" (and design) [clothing, namely, caps, hats and sun visors]

Applicant's Mark(s): "OTTO STUDIO" (in design format) [footwear]

Issues: Likelihood of Confusion

Decision: Opposition Sustained. Opposer contended its mark is strong, but stopped short of claiming mark was famous. TTAB agreed that record established mark has significant strength with respect to headwear.

Fame: Opposer claimed it is the leading supplier of hats and caps in the U.S. The Opposer's mark appears on a label inside its hats and caps. Registered mark has been used for over twenty-four years. Sales figures are confidential, but annual sales under the marks are in the tens of millions, and total sales this decade number in the hundreds of millions of dollars. Opposer has made substantial expenditures in advertising and promoting its marks. Record is devoid of any third-party use or registrations of the same or similar marks in the clothing and footwear fields.

Case Title: *HSN LP v. Young H. Chan*, Oppositions 91173579 and 91177186, decided 6/10/09

Citable as Precedent: No

Opposer's Mark(s): "HSN," "HOME SHOPPING NETWORK," and "HSN" (and design) [all marks for: television shopping services, retail store services, online sales services, all related to consumer products] ("the HSN Marks")

Applicant's Mark(s): 3 applications to register the mark "HSK HOME SHOPPING KOREA" (and design): [retail store providing preserved fruits, vegetables, poultry, meats, edible oils, dried and cooked fruits and vegetables]; Providing home shopping services in the field of health foods, oriental foods, electronics, kitchen utensils, kitchen wears (sic), appliances, sporting goods, jewelry, furniture and clothing by means of television; and, Retail store providing household or kitchen utensils, containers, appliances, dishes.

Issues: Likelihood of Confusion.

Decision: Oppositions Sustained.

Fame: HSN opposed registration of HSK HOME SHOPPING KOREA on grounds of priority of use, likelihood of confusion and dilution. HSN was able to show that it had continuously used the HSN Marks since as early as 1985. The TTAB expressed that fame of a mark plays a dominant role in a likelihood of confusion analysis. HSN television programs are available in 90 million homes, resulting in 30 million orders per year and opposer has 4.5 million active customers. As of 2007, HSN was the country's fourth largest cable network. The TTAB found that based on the facts, the HSN Marks are famous for purposes of analyzing likelihood of confusion. The TTAB further stated that where, as here, opposer's trademarks are famous, it can never be of "little consequence". The TTAB also noted that all doubt as to whether confusion is likely is to be resolved against the newcomer, especially where the established mark is famous. Because the TTAB found likelihood of confusion, it did not decide the issue of dilution.

Case Title: ***Gibson Guitar Corp. v. Concordia Investment Partners, Inc.***,
Opposition 91170847, decided 6/10/09

Citable as Precedent: No

Opposer's Mark(s): A headstock design [guitars], known in industry as the Dove Wing Peg Head ("Dove Wing Headstock") design

Applicant's Mark(s): A headstock design [guitars]

Issues: Likelihood of Confusion. The TTAB found the Dove Wing Headstock design famous in connection with guitars

Decision: Opposition Sustained.

Fame: Opposer has used Dove Wing Peg Head design since at least 1922. Between 1997 and 2005 Opposer sold between 45,000 and 90,000 guitars having the Dove Wing Headstock. Opposer prominently used the silhouette shape of the Dove Wing Headstock design over the years. All of the Les Paul guitars used the Dove Wing Headstock design.

Case Title: *Morgan Creek Productions, Inc. v. Foria International, Inc.*,
Opposition 91173806, decided 6/11/09

Citable as Precedent: Yes

Opposer's Mark(s): "MORGAN CREEK" (and design) [pre-recorded motion picture films and videos (video cassettes and DVDs); pre-recorded phonograph records, audio tapes, audio cassettes and CDs featuring musical entertainment]; "MORGAN CREEK" [caps, t-shirts, baseball shirts]

Applicant's Mark(s): "MORGAN CREEK OUTFITTERS" [camp shirts, dress shirts, golf shirts, knit shirts and shirts]

Issues: Likelihood of Confusion; whether the issue of fraud was tried by consent of the parties

Decision: Opposition Dismissed. Opposer did not meet its burden of showing likelihood of confusion. The TTAB found that opposer had not shown that its "MORGAN CREEK" (and design) mark is a famous mark for purposes of likelihood of confusion. TTAB found that Opposer's use of the "MORGAN CREEK" mark on clothing was mainly limited to sporadic use on promotional items given to employees and friends of the company and the clothing was not given or sold to the public at large.

Fame: Opposer has been in business of film production and distribution for more than twenty years and has produced 34 films. Opposer's logo appears onscreen in its films. Opposer's logo also appeared on video-cassettes, record albums, audio-cassettes and now on its DVDs and CDs. Opposer has sold more than \$200 million worth of videos and more than 5 million soundtracks of its movies in the U.S. Opposer advertises its movies using its logo with its trailers, network and cable television spots, buses and billboards, the Internet, newspapers and magazines. The logo was used on screen in the 43 episodes of Ace Ventura and on the boxes of its two computer games. The logo is also used on promotional items. Opposer spends millions of dollars advertising and promoting its films and about 200 million people have seen the films. Opposer's evidence provided no context for comparing the number of films Opposer produced with total number of films produced, did not show Opposer's market share, did not show how attendance at its films compared to attendance at films of other companies, and did not show how its advertising expenditures compared to those of other studios. Raw numbers can be misleading and context is needed. Logos on posters, packaging for CDs and DVDs were of small size and not likely to be noticed. Evidence insufficient to prove fame, but is a strong mark for motion pictures.

Case Title: *Eveready Battery Company, Inc. v. Green Planet, Inc.*,
Opposition 91180015, decided 7/21/09

Citable as Precedent: Yes

Opposer's Mark(s): "SCHICK" [razors and razor blades]; and other marks for related goods

Applicant's Mark(s): "SLICK ULTRA PLUS" [disposable razors]

Issues: Dilution under 43(c); Likelihood of Confusion

Decision: Opposition Sustained. TTAB was persuaded that opposer's SCHICK mark is famous for likelihood of confusion purposes.

Fame: In its notice of opposition, Opposer argued that its SCHICK marks are famous, had become famous prior to the filing date of the opposed application, and that registration of applicant's mark would dilute the distinctive quality of its SCHICK marks. The parties agreed to Accelerated Case Resolution and stipulated to withdrawal of the Section 43(c) dilution claim.

Opposer and its predecessors (collectively, opposer) have used the SCHICK mark continuously since 1926 in connection with razors. Opposer's SCHICK brand has the second largest market share for razors and shaving-related products in the U.S. Opposer's razors and blades are sold throughout the U.S. in retail stores, grocery stores, drugstores, convenience stores and warehouse club stores. From 2000 to 2008, opposer sold over \$2 billion of its razors and blades, including over \$100 million of disposable razors annually. From 2001 to 2007, opposer spent over \$300 million advertising its goods under its SCHICK mark, including over \$75 million for advertising its disposable razors. Opposer's ads have appeared in a wide range of national magazines as well as on radio and television. Opposer sponsors numerous sporting events and professional athletes. Such events prominently display the SCHICK mark, and often feature promotional booths and giveaways featuring SCHICK razor products.

Case Title: *Genesco Brands Inc. v. Wendy M. Rathjen and Jane M. Burke*, Opposition 91177209, decided 8/11/09

Citable as Precedent: No

Opposer's Mark(s): 'JOURNEYS' [shoes; retail shoe store services]; 'JOURNEYS' (and design) and 'JOURNEYS KIDZ' [shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants and skirts]; and other marks incorporating the word 'JOURNEYS' for the same and/or related goods and services

Applicant's Mark(s): 'LOVE THE JOURNEY' (and design) [baseball caps; boxer shorts; children's headwear; fleece pullovers; hats; infant wear; jogging suits; shirts; shorts; sweat shirts; t-shirts; and a variety of other clothing items]

Issues: Likelihood of Confusion.

Decision: Oppositions Sustained.

Fame: Opposer did not argue that the "JOURNEYS" mark is famous. The TTAB noted that the record was not sufficient to demonstrate the "extensive public recognition and renown" required for fame. Nevertheless, the TTAB found that the evidence was sufficient to establish that the mark had achieved some degree of recognition and strength in the market. In addition, the TTAB found that the mark by its nature is strong and distinctive, and appeared to be essentially arbitrary for the retail sale of footwear and apparel, as well as for the goods themselves. TTAB found opposer's marks are strong and entitled to a broad scope of protection.

The evidence submitted by the opposer included proof of use of the mark JOURNEYS for over 20 years in connection with retail stores, primarily featuring shoes, but also selling other items of apparel; current use in all 50 states in more than 800 stores; and promotion of the stores on radio, television, and through print catalogs and nationally distributed consumer magazines. There was also evidence that the JOURNEYS mark had received attention in trade publications and in local newspapers, and sales and advertising figures (confidential) were quite substantial.

TTAB considered third party use of "Journey" and found the existence of two third-party uses is clearly not sufficient to prove that the term "Journey" is so widely and extensively used in connection with clothing that purchasers have become conditioned to look to other elements of the marks to distinguish the source of such goods. Thus, to the extent the evidence of third party use had any probative value, the TTAB found it insufficient to outweigh the evidence of strength of the term JOURNEY as a mark.

Case Title: *Kraft Foods Global Brands LLC v. Anthony Brown*, Opposition 91186494, decided 8/20/09

Citable as Precedent: No

Opposer's Mark(s): Several marks incorporating the term 'KOOL-AID' [prepared powder containing flavor, fruit acid, and color put up in a number of flavors for making nonalcoholic beverage in the home; carbonated beverages; soft drinks; soft drink mixes; and other goods]

Applicant's Mark(s): 'KOOL' [non-alcoholic beverages, namely, carbonated beverages]

Issues: Likelihood of Confusion

Decision: Opposition Sustained (Opposer's motion for summary judgment granted). TTAB found there was no genuine issue of material fact that opposer's KOOL-AID marks are strong marks entitled to a broad scope of protection.

Fame: Opposer provided evidence of fame through a declaration and related exhibits which applicant did not specifically dispute. Evidence showed that Opposer used its KOOL-AID marks throughout the U.S. for over 75 years and extensively promoted the KOOL-AID marks by advertising in television, print, radio, billboard, newspapers, the internet and at point of sale. Evidence showed Opposer launched 80 television campaigns involving the KOOL-AID marks. Opposer's advertising figures for the last 10 years, which it designated as confidential, supported its claim of substantial advertising expenditures. In the last five years, opposer sold in excess of \$165 million worth of beverage products under the KOOL-AID marks and consumers drank over 450,000,000 gallons of KOOL-AID beverage products each year. Based on opposer's evidence and applicant's failure to show that any of the evidence should be discounted or given little weight, and the absence of any reasonable argument that such evidence is not of the type that would normally be used to establish fame, the TTAB found no genuine issue of material fact that opposer's KOOL-AID marks are famous in connection with opposer's goods.

Applicant argued that opposer's mark was entitled to a limited scope of protection due to "extensive third party use" of the term Kool, relying on third party registrations referenced in a declaration unaccompanied by copies of the registrations. The TTAB found the declaration, by itself, was insufficient to make the third party registrations of record. The TTAB also noted that even if properly made of record, the referenced third party registrations would have been of little probative value even if submitted correctly because none of the goods set forth in the third party registrations were related to applicant's and opposer's goods as set forth in the application and pleaded registrations.

Case Title: *Hasbro, Inc. v. Braintrust Games, Inc.*, Opposition 91169603, decided 8/24/09

Citable as Precedent: No

Opposer's Mark(s): 'CLUE' [equipment for use in playing board game; computer game software and video game software; interactive mystery storybooks]; 'CLUE THE CLASSIC DETECTIVE GAME' (and design) [board games]

Applicant's Mark(s): 'NO FRIGGIN CLUE' [in Class 9: video game software; video game cassettes, video game discs, video game machines for use with TVs; computer software featuring trivia and knowledge-based games, and other goods; in Class 41: entertainment services, namely, providing online computer games; providing games that may be downloaded from a global computer network; online betting services]

Issues: Likelihood of Confusion

Decision: Opposition Sustained as to both classes based on likelihood of confusion, therefore, TTAB found it unnecessary to reach the issues of dilution and fraud. Based on the record presented, TTAB concluded that the CLUE mark is a well-known and strong mark, and enjoys considerable renown, a factor which significantly supports a finding of likelihood of confusion, and entitles the mark to an enhanced scope of protection. However, based on evidence presented, the TTAB did not find opposer's mark to be famous.

Fame: Opposer provided evidence showing substantial sales of its classic CLUE game over a sixty year period., as well as for its licensed versions of the game, including Harry Potter, Scooby-Doo!, The Simpsons, and Clue Jr.. Since 1982, CLUE games have been published in electronic formats; opposer licensed a series of 18 mystery books based on the game concept, as well as a motion picture and a Broadway musical. The CLUE mark has been licensed for use on goods such as greeting cards, lottery tickets, key chains, clothing, casino games and card games. Evidence showed opposer had expended considerable resources promoting the CLUE brand, some of which resulted in recognition in national media, particularly during the fiftieth anniversary of the CLUE game in 1999.

Applicant challenged opposer's evidence as failing to show the significance of opposer's sales and advertising figures and failure to show how opposer's sales and advertising figures measure up to

its competitor's figures. TTAB found that in view of the extreme deference that is accorded to a famous mark, it is the burden of the party offering evidence of fame to provide a meaningful context for its figures, such as evidence of the market share for the goods sold under the mark.

Opposer pointed to two previous, non-precedential decisions, in which the TTAB found opposer's CLUE mark to be famous. The TTAB sustained applicant's objection to significant evidence proffered by opposer on this issue and noted that fame is a factual matter that must be established on the record in each proceeding. Therefore, whether the record in opposer's previous proceedings was sufficient to establish its fame in 1999 or 2002 was not relevant to whether the record in the present proceeding is sufficient to establish fame now.

Case Title: *UMG Recordings, Inc. v. Charles O'Rourke*, Opposition 91178937, decided 8/27/09

Citable as Precedent: Yes

Opposer's Mark(s): 'MOTOWN' [musical and theatrical sound and video recordings; entertainment services]; various marks incorporating the capital letter 'M' and the word 'MOTOWN' [clothing and merchandise, including, short-sleeved and long-sleeved t-shirts, sweatshirts, and baseball-style caps]

Applicant's Mark(s): 'MTOWN CLOTHING' (and design) [beanies; caps; footwear; hats; headbands; headwear; jackets; jogging suits; pajamas; polo shirts; pullovers; short-sleeved or long-sleeved t-shirts; shorts; suits; sweat pants; sweat shirts; swimsuits; t-shirts; tank tops; trunks; underwear; wristbands]

Issues: Likelihood of Confusion

Decision: Opposition Sustained. When confronted with clothing using applicant's mark, consumers familiar with opposer's famous music industry marks, including the MOTOWN and M MOTOWN marks, would likely conclude applicant's mark was another variation on the marks used by or authorized by opposer for such goods.

Fame: Opposer argued only the likelihood of confusion issue and was deemed to have waived its dilution claim. Applicant conceded that the MOTOWN mark was famous in the music industry, but not with clothing. TTAB found that Opposer's mark is famous for musical recordings and performances, and opposer had demonstrated that such fame has been exploited by use of the mark on collateral products, including clothing. *See Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1944 (TTAB 1996) for a discussion of cases involving use of a famous or well-known mark on collateral products. Evidence of use on clothing included: substantial sales of MOTOWN branded merchandise, including clothing in a Detroit airport store since 2002; sale of MOTOWN branded clothing since 1988 in the Motown Museum gift shop and on the museum's website, www.motownmuseum.com; and sale of MOTOWN branded clothing at the Motown Café Orlando in Orlando, Florida since March 1999.

Case Title: *GTFM, Inc. v. Stephanie Seems*, Opposition 91179611, decided 9/11/09

Citable as Precedent: No

Opposer's Mark(s): 'FUBU' [clothing, namely shirts, vests, sweaters, shoes, caps, bandannas, shorts, sweat shirts, pants, belts for clothing, socks, swimwear, jackets, rainwear, blouses, dresses, footwear, hosiery, scarves, hats, head bands, pajamas, sleepwear]

Applicant's Mark(s): 'JUBU' [athletic shoes, beanies, belts, caps, hoods, jackets, jerseys, pajamas, pants, shirts, socks, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, ties, tops, undergarments]

Issues: Likelihood of Confusion; Dilution.

Decision: Opposition Sustained as to Likelihood of Confusion only. Despite a recent trajectory in promotional expenditures and gross retail sales that revealed significant decline over the past decade, the TTAB found that opposer's mark remained a strong mark with a substantial degree of renown in the U.S., thereby entitling it to a broad scope of protection for purposes of likelihood of confusion. Given its determination that opposer has priority of use and that there is a likelihood of confusion, the TTAB found it unnecessary to reach a determination on the question of dilution.

Fame: Opposer's evidence showed use of its mark continuously since 1992 in conjunction with the design, manufacture, sale and distribution of clothing and other consumer merchandise, such as backpacks and handbags, generating hundreds of millions of dollars in sales. Opposer's evidence showed that it had expended substantial sums in promotion and advertisement of its mark; clothing and accessories bearing prominently the opposer's mark has been worn by celebrity entertainers. Evidence showed worldwide sales of its branded products had dropped from highest point of \$315 million (2000) to \$131 million (2004). There was no evidence about the annual sales volume of opposer's products since 2006. Evidence showed promotional expenditures had dropped from \$8 million (2002) to \$1.6 million (2005-2006). The TTAB agreed with the opposer's argument that despite a decline from \$315 million to \$131 million, this latter figure for annual sales in the U.S. compares favorably with the reported annual retail sales of goods in past trademark decisions where marks such as ARTHUR THE AARDVARK, INTERMATIC, JEWS FOR JESUS, LEXINGTON, NAILTIQUES and PANAVISION were found to be well-known.

Case Title: ***Cott Beverages Inc. v. Travis Ryan Barbieri***, Opposition
91181911, decided 9/17/09

Citable as Precedent: No

Opposer's Mark(s): 'COTT' [teas]; 'COTT' [maltless beverages sold as soft drinks; syrups and concentrates for use in the manufacture of soft drinks]; 'IT'S COTT TO BE GOOD!' [soft drinks, syrups and concentrates for use in the manufacture of soft drinks]; 'COTT' (stylized) [nonalcoholic maltless beverages sold as soft drinks]; 'COTT' (stylized) [concentrates used in the manufacture of soft drinks]; 'C HOUSE OF COTT' (and design) [non-alcoholic beverages, namely, soft drinks]

Applicant's Mark(s): 'CO TEA' (and design) [soft drinks flavored with tea]

Issues: Likelihood of Confusion

Decision: Opposition Dismissed. Opposer's marks were not found to be famous. Applicant's mark found to be substantially different in appearance, sound, connotation and commercial impression from opposer's marks. Factor of dissimilarities of the marks outweighed the other relevant *du Pont* factors.

Fame: Opposer argued that its "COTT mark is a well-known, famous mark, entitled to broad protection." In support of this assertion, opposer submitted the testimony of its director of marketing who testified that the COTT mark has been in use for many years by opposer's predecessors in interest and by opposer. Opposer began marketing COTT cola in 2003. Over one million cases of beverages with the COTT brand have been sold yearly over the last three years. Cott Beverages Inc. is the fourth largest supplier of non-alcoholic beverages in the U.S. and sells goods to many large retail outlets in the U.S. such as Wal-Mart, Target, Safeway, and Publix. Based on the record, it was not clear whether opposer had a large share of the non-alcoholic beverage market. Opposer did not submit evidence to show how its sales figures compare to the three largest shareholders of the non-alcoholic beverage market, or the brands of beverages sold by those companies. Opposer also did not provide evidence of advertising expenditures. Additionally, the record showed that although the opposer sold COTT branded beverages in the U.S. for some time, the opposer did not enter the U.S. market in any substantial way until 2003. TTAB found that raw numbers of sales alone may be misleading and must be placed in some context in determining the fame of a mark. Although opposer's marks appear to be strong based on opposer's evidence of use and the lack of evidence that would indicate the mark is not strong, such as any use of similar marks by third parties, the TTAB found that opposer has not met its burden to show fame. In view thereof, the TTAB ruled that the strength of opposer's marks does not reach the level of playing "a 'dominant' role in the process of balancing the *du Pont* factors."

Case Title: ***Johnson & Johnson v. Matthew M. Kumar and Larry D. Johnson***, Opposition No. 91152039, decided 11/2/09

Citable as Precedent: No

Opposer's Mark: DURAGESIC (in standard character form) in connection with analgesic preparations administered transdermally in the form of a bandage or patch

Applicant's Mark: DERMOGESIC (in standard character form) for "transdermal patches for use in the treatment of post-surgical pain and presurgical analgesic

Issues: Likelihood of confusion Decision

Decision: Opposition sustained on likelihood of confusion.

Fame: Opposer submitted a claim of fame of its mark under Section 2 (d). Opposer did not submit a dilution claim. The TTAB rejected applicant's arguments on the fame issue because those arguments were erroneously based on the premise that opposer had alleged dilution as a ground of opposition.

Opposer established that its DURAGESIC product had been marketed for eighteen years, and submitted evidence of sales and advertising and promotional expenditures for the mark from 2003-2007. However, Opposer provided no evidence of market share or other evidence which would enable the TTAB to place the numbers in context. Opposer provided testimony that although the DURAGESIC product came off patent in 2005 and generic versions were available, ninety percent of prescriptions for the drug are written by physicians for Opposer's DURAGESIC branded product on a do not substitute basis. Testimony was also given regarding Opposer's market research indicating that patients prefer and purchase Opposer's DURAGESIC branded product instead of generics even though it requires a higher co-pay from the patient.

The TTAB considered Opposer's claim of fame under Section 2(d) and ruled considered that Opposer's evidence established that mark was well-known in the marketplace, but that the Opposer's evidence failed to establish that Opposer's mark was famous for purposes of the fifth DuPont likelihood of confusion factor. Therefore, Opposer's mark was not entitled to the wide and expansive scope of protection to which a famous mark would be entitled in the likelihood of confusion analysis.

Notwithstanding the ruling on the issue of fame, the TTAB found that the marks were sufficiently similar that confusion was likely to result from their use on the parties' legally identical goods.

Case Title: *Plaid Inc. (a New York corporation) v. Plaid, Inc. (a Connecticut Corporation)*, Cancellation No. 92049221, decided 11/23/09

Citable as Precedent: No

Respondent's mark: PLAID, in standard characters, for various advertising, marketing and design services (registration)

Petitioner's mark: PLAID, in standard characters, for branding, design, communications, advertising and marketing services (pending application)

Decision: Petitioner's motion for summary judgment is granted and the petition to cancel is granted.

Issues: Priority and Likelihood of confusion

Fame: Petitioner alleges that its mark is "famous" under Section 2(d) and that there has been actual confusion between the parties and their respective marks. The parties introduced evidence concerning, and the TTAB addressed, the similarity between the parties' marks, services and channels of trade, fame of the parties' marks, actual confusion and third party use of similar marks for similar services. The TTAB opined that while there may be genuine issues of material fact regarding the fame of petitioner's mark, in view of the fact that the marks and services are identical, they found it unnecessary to consider fame in reaching a decision.

Case Title: *Sunkist Growers, Inc. v. Smile Factory, LLC*, Opposition 91176970, decided 12/02/2009

Citable as Precedent: No

Opposer's Mark(s): "SMILE PACK" and "SMILE FACTORY" [processed fresh sliced apples]

Applicant's Mark(s): "SUNKIST SMILES" and various other "SMILE" marks [fresh fruit]

Issues: Likelihood of Confusion

Decision: Opposition Sustained on Likelihood of Confusion. Mark was not famous for purposes of likelihood of confusion.

Fame: The Board concluded that Opposer's mark was not famous, as Opposer failed to sufficiently demonstrate the fame of the asserted marks. Opposer submitted much of its evidence through confidential testimony. Accordingly, the exact figures or statistics associated with this testimony are largely unknown. The Board did acknowledge that Opposer has expended a significant sum of money and effort in marketing the goods under the pleaded marks and has enjoyed considerable success and at least moderate recognition for its efforts. However, Opposer failed to provide individual expenditure amounts for each different mark asserted in the opposition. Accordingly, it was impossible for the Board to determine which goods under which marks have enjoyed the greatest success and recognition. Opposer also submitted the opinion of an expert. Unfortunately, the expert's opinion is not discussed in great detail. The Board found that the record fell "far short" of demonstrating widespread recognition among consumers. Rather, the Board declared that the amount spent by Opposer on advertising its marks was "rather low compared to annual advertising figures for other marks we have found to be famous." The Board gave the example of \$4-billion as sufficient advertising expenditures to support a finding of fame.

Case Title: *Volvo Trademark Holding AB v. Giovanni D. Volo*, Opposition 91168187, decided 12/09/2009

Citable as Precedent: No

Opposer's Mark(s): "VOLVO" for automobiles and other related goods and services

Applicant's Mark(s): "VOLO AIR" [air filters for mechanical purposes and air filtering apparatus, namely, air purifiers and air filters for electric fans]

Issues: Likelihood of Confusion and Dilution

Decision: Opposition Sustained on Likelihood of Confusion. Mark is famous for purposes of likelihood of confusion. Board declined to decide issue of dilution.

Fame: Fame is indirectly measured by the volume of sales and advertising expenditures for the goods and services, "by the length of time those indicia of commercial awareness have been evident," and through the general reputation of the products and services. While raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading and some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). Further, it is always the duty of the party asserting fame to clearly prove that the asserted mark is famous. Opposer produced evidence that it had used the VOLVO mark "on cars and other products" since the 1950s. From 2000 to 2007, total sales of Volvo products in the U.S., excluding cars, exceeded \$28-billion with yearly sales ranging from \$2 to \$5-billion. Specifically, Opposer's air filter sales exceeded \$20-million alone during this time. However, there was no testimony as to what share of the market the sale of these air filters represented. Opposer presented evidence that it advertised in the U.S. via television, direct mail, internet, trade shows, brochures, print publications, billboards, radio, and sponsorships. However, instead of providing expenditures within the U.S., Opposer only presented its total global expenditures. Nevertheless, given the sales figures for the Volvo products, the Board inferred that Volvo had substantial worldwide advertising and marketing expenditures under the VOLVO mark. Therefore, the Board found the mark VOLVO famous when used in connection with automobiles and automobile parts.

Case Title: *Calvin Broadus v. Kristyn Kelley Allen dba Passive Devices*,
Opposition 91176834, decided 12/16/2009

Citable as Precedent: No

Opposer's Mark(s): "SNOOPTUNES" [wireless transceivers for distributing audio, visual, and textual computer files over computer networks including music, books, plays, pamphlets, brochures, newsletters, journals, magazines on the subjects of sporting and cultural activities and a wide variety of topics of general interests]

Applicant's Mark(s): "SNOOP DOGGY DOGG" and "SNOOP DOGG" [series of musical sound recordings; musical sound and video recordings; t-shirts and caps; entertainment services in the nature of live musical performances and music-based entertainment]; and other marks for the same or similarly related goods and services

Issues: Likelihood of Confusion

Decision: Opposition Sustained on Likelihood of Confusion. Mark is famous for purposes of likelihood of confusion.

Fame: Opposer's evidence showed that SNOOP DOGG is a famous mark and extends to the shorthand name for SNOOP DOGG name "Snoop," the well recognized Opposer had performed under the name SNOOP DOGG for over 10-years, often being referred to simply as "Snoop." Evidence showed that Opposer had released several different albums under the mark SNOOP DOGGY DOGG or variations thereof. From 1993 to 2008, Opposer released a total of nine different albums, at least six of which were under the SNOOP DOGG mark. All but two of those albums earned platinum status, with sales of approximately 18-million records. Opposer presented further evidence that there were approximately 744 songs written or featuring SNOOP DOGG on various websites. Further, Opposer expended approximately \$3-million per year on advertising and promotion of his records. Opposer's advertising appeared in national television and radio advertising and all forms of print advertising, as well as mobile and roadside billboards and online advertisements. Opposer has spent approximately \$1-billion in advertising and promoting the SNOOP DOGG brand and image over the past 16-years. Opposer presented a Google internet search that showed that the term "Snoop Dogg" returned approximately 22.2-million results. The evidence presented by Opposer also demonstrated "considerable" mainstream exposure, including the appearance of "Snoop Dogg" on major industry films and television shows including *Training Day* (2001), *Starsky and Hutch* (2004), 4

appearances on *Saturday Night Live*, 14 appearances on *The Tonight Show with Jay Leno*, and 5 appearances on *Late Night With Conan O'Brien*. Opposer also produces and stars in his own reality TV show, *Snoop Dogg's Father Hood*, a show on the E! Entertainment Network. Opposer has also been associated with a diverse range of goods and services. Opposer has endorsement deals with Chrysler automobiles (where he appeared in a commercial with Lee Iacocca), T-Mobile, Nokia, XM Satellite Radio, and Orbitz chewing gum. Opposer also has a clothing line, "Rich N Infamous by Snoop Dogg." Opposer's work in the community is also well publicized with the "Snoop Bowl," a widely recognized event (mentioned in publications such as *Rolling Stone* and *USA Today*), which is held the day of the Super Bowl. The "Snoop Bowl" is a community outreach program for inner-city youth. Opposer also has been the subject of a number of cover stories, articles, and interviews in national print publications such as *Rolling Stone*, *Maxim*, *Vibe* and *Entertainment Weekly*, as well as online publications such as usatoday.com and money.cnn.com. Evidence demonstrated that Opposer's endorsement value was exceptionally high through "crossover" appeal for various consumer groups. Therefore, the Board found "[i]t is clear that SNOOP DOGG is a strong and famous mark and name in the music entertainment field, and that in view of the wide exposure of Snoop to the public as a nickname for SNOOP DOGG, that name is famous as well."

Case Title: ***Bells Brewery, Inc. v. Bell Hill Vinyards***, Opposition 91177980, decided 12/18/2009

Citable as Precedent: No

Opposer's Mark(s): "BELL'S" Mark and Design [beer, including porter and ale, stout and malt liquor]

Applicant's Mark(s): BELL HILL [packaged wine]

Issues: Likelihood of Confusion

Decision: Opposition Dismissed. TTAB found that Opposer's BELL'S mark was not famous for purposes of likelihood of confusion analysis.

Fame: Opposer's evidence showed that it had used the mark since 1985 and that it had steadily gained revenue in that time period. Opposer and third-parties promoted the brand in stores, print advertisements, on Opposer's website, in press releases to beer publications, and at local events. Associations related to the beer industry ranked Opposer's beer as among the highest rated beers in the U.S. The beer was also referenced in several articles published in various print media, including the "Denver Rocky Mountain News," the "Chicago Tribune" and "The New York Times." Opposer's beer was not available nation-wide at the time of the opposition. The Board acknowledged the devoted following for BELL'S beer products and the fact that Opposer has received high reviews from organizations that review beer products. However, the Board did not find that the evidence showed the extensive public exposure necessary to rise to the level of strength to play a dominant role in the determination of likelihood of confusion.

CANADIAN TRADE-MARKS OPPOSITION BOARD

- Case: *Empressa Cubana del Tabaco v. Tequila Cuervo, S.A. de C.V.*
[2008] T.M.O.B. No. 158
- Background: Tequila Cuervo applied to register the trade-mark LAZARO COHIBA in association with alcoholic beverages, namely rum, based on proposed use. The term LAZARO was disclaimed. Empressa opposed based on several grounds, including confusion with its mark COHIBA, which it had registered for use in association with tobacco and related products.
- Opponent's Evidence of Fame: Empressa submitted evidence that:
- its exclusive distributor in Canada, Havana House, has sold over 730,000 cigars in Canada since 1994 under the COHIBA brand; and
 - COHIBA cigars are sold in Canada by Havana House at an average price of \$14 to \$15 per cigar.
- Outcome: The opposition was rejected. The Board found no reasonable likelihood of consumer confusion.
- Fame Disposition: Empressa had significant deficiencies in its evidence regarding the alleged fame of its mark. No advertising of the mark could be proven, since advertising of tobacco products is prohibited by law in Canada. Also, Empressa's affiant admitted on cross-examination that only a few thousand people in Canada would have purchased COHIBA cigars from Havana House.
- The fame of Empressa's COHIBA mark was only analyzed in the context of section 6(5)(a) of the *Trade-marks Act* (inherent distinctiveness of the marks at issue), rather than the "surrounding circumstance" of fame. The Board found that Empressa's mark COHIBA had become known to some extent in Canada, but that it was not very well known and was not famous in Canada. The Board noted that Empressa's evidence in the case fell "far short" of meeting the requirements for fame established in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).

Case:	<i>McDonald's Corp. v. Chung-Kee Noodle Shop Ltd.</i> [2008] T.M.O.B. No. 215
Background:	Chung-Kee applied to register the trade-mark MCNOODLE based on proposed use in association with noodles, dumplings, stewed meats and various other food items. Chung-Kee also applied to use this mark in association with restaurant services and wholesale or retail packages of the food items mentioned above. McDonald's opposed on several grounds, including confusion with over 50 registered trade-marks.
Opponent's Evidence of Fame:	<p>McDonald's submitted evidence that:</p> <ul style="list-style-type: none"> - it operates and/or allows licensees to operate over 1,300 restaurants in Canada, and over 30,000 worldwide, bearing the mark MCDONALD'S; - its revenue from Canadian sales at its MCDONALD'S restaurants is over \$2 billion per year for the years 2000 to 2005; - it owns numerous marks consisting of the prefix "MC" and followed by a word that is descriptive of a type of food product; and - it spends tens of millions of dollars annually on marketing campaigns that run at least six times per year and are designed to reach between 75% and 90% of Canadian households.
Outcome:	The opposition was successful. The Board found a reasonable likelihood of confusion between the applicant's mark and the opponent's registered marks. The Board also found that Chung-Kee failed to meet its burden to show that its mark actually distinguished or was adapted to distinguish its wares and services from those of others.
Fame Disposition:	The Board stated that the mark MCDONALD'S was famous <i>in association with restaurant wares and services</i> , due to the level of sales, the number of outlets and the penetration of McDonald's advertising. The Board also made this finding with respect to the MC-prefixed family of marks registered by McDonald's for use in association with food items. The Board stated that this finding is of "great importance in assessing the issue of confusion". The Board found that a reasonable likelihood of confusion existed, "... particularly in view of the fame associated with the registered trade-mark MCDONALD'S and a number of other MC-prefixed marks of the Opponent, the similarities between the marks and the similarities between the wares, services and trades of the parties ...".

Case:	<i>Wrangler Apparel Corp. V. Big Rock Brewery Partnership</i> [2009] T.M.O.B. No. 18
Background:	Big Rock applied to register the trade-mark WRANGLER based on proposed use. The application was originally for registration of the mark in association with a wide range of goods, but was subsequently amended to include only “brewed alcoholic beverages”. Wrangler opposed the application on several grounds, including confusion with several of Wrangler’s registered marks. All of these marks consisted of or incorporated the word WRANGLER and were registered in association with various clothing items, watches, and outdoor equipment.
Opponent’s Evidence of Fame:	<p>Wrangler submitted evidence that:</p> <ul style="list-style-type: none"> - the mark WRANGLER had been used in association with clothing in Canada, by Wrangler or licensees or predecessors in title, since 1929; - the mark WRANGLER had been used by licensees of Wrangler in association with such things as cowboy hats, belts and equestrian products like ropes and halters, for various periods of time ranging from 7 to 20 years; - WRANGLER products of general appeal were sold through stores like Zellers, Walmart, Loblaws, The Bay and Moores, with over 3.2 million units sold in 2005; - WRANGLER products of particular western styling were sold through “Western Specialty stores”, mostly in Alberta and Saskatchewan, with over 800,000 units sold in 2005; - advertising expenditures, spent on print advertising, point of sale displays, gift with purchase promotions, and hat stickers bearing the WRANGLER mark, averaged between \$1.2 million and \$3.2 million/year from 1995 to 2006; and - Wrangler or its licensee spent approximately \$5.5 million annually on sponsorship of rodeo and other equestrian events in the U.S. and Canada, for the last 20 years.
Outcome:	The opposition was rejected. The Board found little likelihood of confusion of the average consumer regarding the source of wares. Grounds of opposition based on confusion, lack of entitlement and non-distinctiveness were rejected based on the lack of confusion.
Fame Disposition:	The Board referred to the WRANGLER marks as “well known”. The Board also seemed to imply that the marks were famous, but restricted the fame of the marks to the “western and country life-style market”. Wrangler argued that its advertising at rodeo events, appearing alongside advertising of alcoholic beverages, would lead to an association between the “western and country life-style” and alcoholic beverages. However, the Board noted that Wrangler filed no evidence in support of its contention that such a mental association would actually be made by the consumer of brewed alcoholic beverages. Wrangler’s fame as recognized by the Board was insufficient to give rise to a reasonable likelihood of confusion in this case.

Case:	<i>Allergan Inc. v. Toutounghi</i> [2009] T.M.O.B. No. 26
Background:	Toutounghi applied to register the trade-mark BELLATOX in association with topical wrinkle cream and retailing and wholesaling services. The application was based on proposed use in Canada. Allergan opposed based on several grounds, including an allegation of confusion with its registered marks BOTOX and BOTOX COSMETIC.
Opponent's Evidence of Fame:	<p>Allergan submitted evidence that:</p> <ul style="list-style-type: none"> - it had earned more than \$44 million in Canadian sales of BOTOX and BOTOX COSMETIC products between 2001 and May 2005; - it had spent more than \$13 million on advertising and marketing in Canada for said products; - its advertising for said products was carried on radio, television, consumer magazines, billboards and bus shelters in Canada, and that it sponsored various events for women to promote said products; - one particular doctor, who swore an affidavit, stated that he had provided more than 4000 BOTOX treatments since June 2001, that he typically conducts 20 to 40 treatments per week, and that he had purchased 2900 vials of BOTOX products since 2001; - Allergan held the largest market share in Canada for botulinum toxin therapy; and - a survey was conducted to show the Canadian public's growing awareness of the BOTOX mark.
Outcome:	The opposition was successful, and the application was rejected. The Board found a reasonable likelihood of confusion that made the applicant's mark unregistrable.
Fame Disposition:	<p>Toutounghi attempted to argue that there was a low likelihood of confusion due to the "widespread consumer awareness" of Allergan's marks BOTOX and BOTOX COSMETIC and the fact that Toutounghi's mark was different. The Board held that Toutounghi admitted that Allergan's marks were well known, swinging the balance regarding the inherent distinctiveness issue in favour of Allergan.</p> <p>While Allergan tried to argue that it owned a family of marks consisting of the suffix "-OTOX" or "-TOX", the Board rejected this argument. The Board accepted that Allergan owns a family of marks consisting of BOTOX and BOTOX COSMETIC, and that both of these marks by themselves, and the family, were very well known in Canada.</p>

Case:	<i>Doris Hosiery Mills Ltd. v. Suzy's Inc.</i> [2009] T.M.O.B. No. 117
Background:	Suzy's applied to register the trade-mark SUZY'S SECRET based on proposed use in association with women's apparel and retail clothing store services. Doris opposed on several grounds including non-registrability and non-entitlement due to confusion with its mark SECRET, registered in association with hosiery, and various other clothing products.
Opponent's Evidence of Fame:	<p>Doris submitted evidence that:</p> <ul style="list-style-type: none"> - it had used the mark SECRET for ladies' hosiery since 1967; - its licensee had used the mark SECRET in association with various other wares and services such as lingerie and underwear items since 1999; - its SECRET-branded products were sold through thousands of retail outlets in Canada, including The Bay, Sears, Zellers and Wal-Mart, as well as specialty hosiery stores, lingerie boutiques, drug stores, and grocery chains; - its SECRET-branded products were also sold through catalogue or mail order services provided by Sears, Avon and Amway, among others; - its sales in Canada of SECRET-branded intimate apparel since 1999 were in excess of 3,388,000 units, representing over \$21 million in value; and - it had advertised SECRET-branded products since at least 1972 via radio, television, magazines, newspapers, billboards, mall posters and transit ads, and spent over \$30 million on this advertising.
Outcome:	The Board concluded that the trade-mark SUZY'S SECRET was confusing with Doris' mark with respect to the lingerie, bras and panties for which Suzy's had applied for registration. The Board allowed Suzy's application for all other wares and services.
Fame Disposition:	Suzy's acknowledged that, while Doris' mark was not famous, it may be well known for hosiery and undergarments. The Board simply stated that it found this to be the case, based on Doris' evidence. However, the Board also found that there was no real connection in the minds of consumers between Doris' mark SECRET and retail clothing stores.

Case: *Anheuser-Busch, Incorporated v. Kevin G. Di Cicco d/b/a Air Bud Productions* [2009] T.M.O.B. No. 193, decided 11/13/09

Background: Anheuser-Busch company argued that its BUD and BUD LIGHT trademarks are famous; should “benefit from a wider ambit of protection,” and hence should be able to stop registration of the trade-mark AIR BUD advertised for the wares: “clothing, namely t-shirts, sweat shirts, hats; games namely a board game, toys namely plush toys and squeaky toys; sports equipment namely baseballs, basketballs, footballs, soccer balls, volleyballs, hockey pucks, hockey sticks; dog food; pre-recorded video games on DVD’s; paper articles namely children’s books, comic books, how to books,” and “entertainment services namely producing motion pictures and television shows,” based upon use in Canada since February 29, 1992.

Outcome: The Board was able to refuse the application on a technical ground, namely that the Applicant’s evidence did not support its claimed date of first use. It however also reviewed other grounds in the Statement of Opposition which turned on the issue of confusion. The Board found on a balance of probabilities that there exists a likelihood of confusion between the marks BUD and BUD LIGHT with respect to t-shirts, sweat shirts, hats, baseballs, basketballs, footballs, soccer balls, volleyballs, hockey pucks and hockey sticks on the basis of a “connection in the mind of the average Canadian consumer” given the Opponent’s sponsorship of many sporting events and given that its marks were well-known.

It is clear that the Opposition Board is following the lead of the Supreme Court of Canada. Fame is only one factor in determining confusion in Canada.

Fame Disposition: The Board indicated that even if it could conclude that the trademarks BUD and BUD LIGHT are famous trade-marks in Canada, it would have done so only with respect to beer and not all the collateral merchandising items the Opponent put forth such as board games, plush toys, squeaky toys; dog food, paper articles, prerecorded video games on DVD, nor with respect to the services specified by the Applicant.

Case: *Manufacturier de bas de nylon Doris Lt6e/Doris Hosiew Mills Ltd. v. Suzy's Inc.* [2009] T.M.O.B. No. 117, decided 7/20/09

Background: Suzy's Inc. filed an application to register the trade-mark SUZY'S SECRET, based upon proposed use for: women's wearing apparel, namely, blouses, skirts, vests, pants, shorts, t-shirts, hats, dresses, sweaters, coats, lingerie, bras, panties and swimwear as well as retail clothing store services.

The application was opposed on the grounds of confusion, reliance being laid on the trade-mark SECRET alone or in combination with other indicia, forming an alleged family of trade-marks used in association with "ladies' hosiery".

Outcome: The Opposition was successful only with respect to the wares "lingerie, bras and panties."

Fame Disposition: In argument, the applicant prevailed upon the Hearing officer to take judicial notice that VICTORIA'S SECRET is a famous trade-mark. Consistent with another Hearing Officer's refusal to take notice that TRIVIAL PURSUIT was a famous trade-mark, the Officer was not willing to do so.

Case:	<i>Apple Computer Inc. vs. Richardson</i> [2009] T.M.O.B. No. 172
Background:	Richardson filed two applications to register the trade-marks for  blackapple and  blackapple based on use since October, 1996. The applications were filed for use in association with scanning, imaging, laser printing in colour and monochrome and general reprographic services. Apple opposed the applications on several grounds, including confusion with numerous registered and unregistered marks consisting of the word APPLE or the APPLE design.
Opponent's Evidence of Fame:	<p>Apple submitted evidence that:</p> <ul style="list-style-type: none"> - the APPLE trade-marks have been in use for over 25 years (since the 1970's) in association with computers, computer peripherals and computer programs and has expanded to Internet, on-line and other wire-based and wireless goods and services; - the APPLE trade-marks are recognized as one of the leaders in the computer industry posting revenues of US\$3.68 billion in 2005; - the on-line APPLE store operates in 20 countries, including Canada, and in the first 30 days of operation it generated US\$12 million in orders and there are 112 APPLE stores located in Canada; - the APPLE trade-marks are used on all new APPLE products introduced into the marketplace since 1984 such as the Macintosh personal computers, iPod music players, and the on-line iTunes music store; and - marketing and advertising expenditures for the APPLE trade-marks from 1994 to 2004 are over US\$2 billion worldwide and since 1996, in Canada alone, the cost was US\$40 million spent on print advertising and point of sale displays.
Outcome:	The opposition was successful. The Board noted that the Applicant failed to prove no likelihood of confusion. The Opponent's trade-marks were inherently distinctive, famous and used longer, there was a relationship between the Applicant's services and wares of the Opponent and some resemblance between the trade-marks since the Applicant used the Opponent's mark in its entirety.
Fame Disposition:	The Board referred to the APPLE trade-marks as "famous" in association with computers and peripheral equipment due to the exhaustive evidence submitted that showed the APPLE trade-marks were well known. The Board noted that the APPLE trade-marks should be granted a wider scope of protection and on this basis there existed a relationship between the Applicant's services and the Opponent's wares and deemed a likelihood of confusion.