

**Fame Before the Trade-mark Trial and Appeal Board and the Canadian Trade-marks
Opposition Board – Summary of 2010 Cases**

The North American Subcommittee of *INTA's* Dilution and Well Known Marks Committee reviewed all decisions issued in 2010 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 2010, the Board issued its first decision since enactment of the TDRA in which the opposition was sustained solely on the basis of a likelihood of dilution – the Board chose not to make a determination as to Opposers' claim of likelihood of confusion. In another precedential decision, the Board also ruled that a foreign trademark owner who has filed an ITU application may rely on the fame of its mark in the United States to support a dilution claim in an opposition. Overall, fame continued to be an important factor in the Board's likelihood of confusion analysis in 2010, and, for the most part, the Board did not address a likelihood of dilution claim where the opposition was sustained based on a finding of likelihood of confusion.

The Subcommittee also reviewed all 2010 decisions of the Canadian Trade-marks Opposition Board regarding the treatment of famous marks. The Opposition Board continues to follow Supreme Court of Canada case law from 2006 regarding famous marks. Another trend that emerged in 2010 is the Board addressing numerous applications by an individual who attempted to register well known trade-marks for wares other than those for which the trade-marks have become well known. All such applications were refused. Finally, the Canadian summary also includes one case relating to the cancellation of a well known mark for lack use in Canada, in which case the Hearing Officer cancelled the registration on the basis that the owner of the trade-mark made a deliberate business decision not to use the trade-mark for certain wares in Canada.

Canadian Trade-marks Opposition Board

L'Oreal v. Marcon

[2010] T.M.O.B. No. 67

Background

Robert V. Marcon filed an application to register the trade-mark L'OREAL PARIS in association with:

- Vitamin, mineral and herbal supplements and combinations thereof.
- Aloe vera drinks

based on proposed use.

L'Oreal opposed based on several grounds, among which, that the applied for trade-mark was confusing with a number of its trade-marks, including most notably, the trade-mark L'OREAL PARIS (TMA655,217) and the trade-mark L'OREAL (TMDA29020) previously used or made known in Canada in association with wares, services, and companies in the field of cosmetics, perfumes, products for care or treatment.

Opponent's Evidence of Fame

L'Oreal submitted evidence that:

- it first introduced L'Oreal products in Canada under the trade-mark L'OREAL or one of its variations in 1959
- the trade-mark L'OREAL PARIS was introduced in Canada as early as 1993.
- net sales of products in Canada in association with the trade-mark L'OREAL PARIS from 1997 to 2007 have increased from more than \$117 million to 228 million CAD annually.
- advertising and promotional expenses have increased from more than \$12 million to 30 million CAD annually.
- there was long and extensive use of its L'OREAL trade-marks in Canada, including use of the trade-mark L'OREAL PARIS, in association with the registered wares.

Outcome

The opposition was successful. The Board found that the Applicant has not discharged his burden of showing, on a balance of probabilities, that there is not a reasonable likelihood of confusion. The Board was not satisfied that the Applicant's statement required by s. 30(i) was made in good faith in light of the fact that the Applicant has also filed 19 other applications for arguably well known marks.

Disposition regarding fame

The Board found that L'Oreal's L'OREAL PARIS trade-mark had become "very well known" in

Canada, based on the evidence provided by L'Oreal -- skirting away from use of the word fame. However, it did reference the Supreme Court of Canada *Mattel* decision to state that fame is not the trump card in cases of alleged confusion.

Using the factors set out in Section 6(5) of the *Canadian Trade-marks Act* the Court concluded that the marks being identical; the channels of trade potentially overlapping (in the absence of evidence by the applicant to be contrary), and the extensive reputation of the opponent's mark, there could be a reasonable likelihood of confusion.

Societe Anonyme des Eaux Minerales d'Evian, S.A. vs. Marcon
[2010] T.M.O.B. No. 83

Background

Marcon applied to register the trade-mark EVIAN based on proposed use for the wares distilled spirits, namely, vodka, gin and tequila and ice cream. Societe Anonyme opposed the application on several grounds, including confusion with the registered trade-marks EVIAN and EVIAN & DESIGN for mineral water; EVIAN & DESIGN for beer, still or sparkling water and non-alcoholic beverages and EVIAN & DESIGN for cosmetics.

Opponent's Evidence of Fame

Societe Anonyme submitted evidence that:

- the trade-mark EVIAN is used in 125 countries including Canada and 1.5 billion bottles of EVIAN water are sold annually;
- the trade-mark EVIAN was first used in Canada in 1978 in relation to water;
- between 2002 and 2006, including projected sales for 2007, sales in Canada for EVIAN water would be approximately \$98,400,000 CDN;
- marketing and advertising expenditures between 1990 and 1997 were in the area of \$12,665,000 USD;
- since January, 1996 the trade-mark EVIAN has been used with other products in Canada, namely, skin and body care products, cosmetics and clothing items.

Outcome

The opposition was successful. The Board noted that although the trade-mark EVIAN had some geographic significance the Opponent provided evidence that its trade-marks had become well-known in Canada through use and promotion and had acquired a high degree of distinctiveness. The Board also noted that the Applicant had failed to satisfy the onus on him to establish that there was no likelihood of confusion as to the source of the respective wares and there was no overlap in the channels of trade.

Disposition Regarding Fame

The Board noted that the Opponent's evidence did establish that its trade-marks were well known in Canada. Based on the extensive use and pervasiveness of the Opponent's trade-marks, they were distinctive and well known in Canada and transcended the beverage market.

Daive Campari-Milano S.p.A. v. Mastronardi Produce Ltd.
2010 T.M.O.B. No. 97 (CanLII)

Background

Mastronardi Produce Ltd. filed an application to register the trade-mark for CAMPARI for tomatoes based on use in Canada since November, 1995.

Daive Campari-Milano S.p.A. opposed. Aside from a technical ground, the opposition is based upon confusion in relation to four trade-mark registrations on the mark CAMPARI or CAMPARI in combination with other indicia in connection with alcohols.

Opponent's Evidence of Fame

The Opponent submitted evidence that:

- The Opponent is the parent company of the Campari Group, Italy's largest producer and distributor of branded spirits;
- The Campari Group's products include four of the top 100 international spirit brands, including CAMPARI;
- Canadian sales for 1998 to 2004 inclusive amounted to about 3 million U.S. dollars;
- Advertising and promotional expenses for CAMPARI products in Canada were about 1 million U.S. for the period 1996 to 2004 inclusive

Outcome

The opposition was rejected.

While the length of use and degree of resemblance factors favour the Opponent, the nature of the wares and channels of trade were very different.

- The lack of actual confusion despite concurrent use was used to draw a negative influence;
- The evidence on record was not sufficient for the Hearing Officer to "transcend product line differences".

Chanel S. de R.L. v. Marcon
2010 TMOB 98

Background

Robert Marcon applied to register the trade-mark CHANEL based on proposed use in association with candles, vitamins and minerals, and various medicinal herbal supplements. Chanel opposed on several grounds including non-registrability and non-entitlement due to confusion with its trade-mark CHANEL registered in association with cosmetics, fragrances, jewellery, and various articles of clothing.

Opponent's Evidence of Fame

- Chanel had registered the trade-mark CHANEL in the 1920s
- Chanel had used the trade-mark in Canada since at least 1998
- In Canada, from 1998 to 2006, Chanel:
 - o sold \$227.6 million of CHANEL cosmetic and fragrance products;
 - o spent \$86.7 million on advertisement, promotions, and demonstrations of CHANEL cosmetic and fragrance products in Canadian newspapers, magazines, radio, television, and point of sale displays; and
 - o sold more than \$154 million worth of CHANEL clothing, jewellery, leather goods, accessories, watches and eyeglasses.
- The notoriety of the CHANEL mark had been mentioned in articles in various Canadian magazines, copies of which were provided.

Outcome

The Board found a reasonable likelihood of confusion between the applied-for trade-mark and Chanel's registered trade-marks. The application was refused for non-registrability and lack of distinctiveness. No further grounds were considered.

Disposition Regarding Fame

The Board integrated Chanel's fame into the factors enumerated in the Trade-marks Act for assessing confusion and found each to be in Chanel's favour. The Board concluded that: (i) the two trade-marks are identical; (ii) Chanel's trade-mark had become well known in Canada since at least 1998; (iii) the sale of candles is a natural extension of the wares offered by famous haute couture / fragrance brand owners; (iv) the cosmetic industry has used and advertised the use of vitamins, minerals, plants, and herbs as components of its products for sale in Canada for many years; and (v) cosmetics, fragrances, candles, vitamins, and herbal supplements share a channel of trade as both are commonly sold in drug stores. The Board also commented at paragraph 37 on *Mattel* and *Veuve Clicquot* noting that with regard to fame “[t]he key factor in considering the extent to which a famous mark transcends the wares or services with which it is normally associated is whether an ordinary consumer is likely to be mistakenly infer that the wares or services come from a common source or are in some way associated with each other.” The Board concluded that the reputation of Chanel's mark would transcend the market into wares that are not necessarily of the same general class.

Background

Aird & Berlis commenced proceedings to cancel registrations for the trade-marks VIRGIN, VIRGIN & Design and VIRGIN & Bottle Design (herein the “VIRGIN Trade-marks”) which were registered for fruit juices and non-alcoholic beverages. In such proceedings, a trade-mark registrant must file evidence showing (i) use in Canada of a trade-mark within the three years preceding the cancellation notice or (ii) the date when the trade-mark was last used in Canada and the reasons for the absence of use during the preceding three years. The failure to file such evidence could result in amendment to or cancellation of the registration.

Registrant’s Evidence

Virgin Enterprises Ltd. (“Registrant”) submitted evidence demonstrating that:

- prior to the three years preceding the cancellation notice, a franchisee of the Registrant had sold drinks branded with the VIRGIN Trade-marks in Canada;
- the Registrant operated a Virgin Café in Canada during the three years preceding the notice;
- the VIRGIN Trade-marks were used in Canada in association with wine (however, there was no direct evidence that the VIRGIN Trade-marks had been used for fruit juices or non-alcoholic beverages).

The Registrant also claimed special circumstances to justify non-use of the VIRGIN Trademarks by relying on the following:

- that licensees in Canada that had been using the VIRGIN Trademarks for over thirty years for various wares and services;
- that the Registrant had entered into a franchise arrangement to market and sell various non-alcoholic and alcoholic beverages in Canada between 1999 and 2002;
- that since 2002 the Registrant had not been able to find another distributor in Canada for its beverages; and
- the fame of the VIRGIN brand and the diverse range of products and services for which it was known.

Outcome

The registrations for the VIRGIN Trade-marks were cancelled for failure to use the trade-marks in Canada during the three years preceding the notice. The Registrant failed to demonstrate special circumstances that would excuse non-use. Based on the evidence submitted, the Registrant made a deliberate business decision not to use the VIRGIN Trademarks in Canada for the wares listed in the registrations.

Disposition Regarding Fame

That a trade-mark might be a famous mark with global reach does not exempt the Registrant from the *Trade-marks Act* requirement to demonstrate use of a trade-mark or legitimate circumstances justifying non-use in order to maintain a trade-mark registration.

Anheuser-Busch Inc. vs. Daum
[2010] T.M.O.B. No. - 163

Background

Daum applied to register the trade-mark BC-BUD based on proposed use in association with the wares and services “clothing, namely coats, shirts, pants, dresses, sweaters, overalls, shorts, socks and scarves; printed publications of photographic wares, namely, magazines, papers, books, newsletters, and webpages; stickers; flags; novelties/knick-knacks, namely, ashtrays, glasses, mugs, plates, pens, pencils, business cards, cards, toothpick holders, scissors, awards, plastic bags, boxes, paper bags, plastic containers, lunch boxes, bottles and flasks, flying saucers, umbrellas, balls, flags, stickers, posters, plant food and conditioner, picture frames, towels, face clothes, blankets, neon signs, sunglasses, rings, necklace, pendants, lighters, rolling papers, cigarette packages, matches, antenna balls, clocks, murals, paintings, coffees, teas, juices and carbonated beverages excluding non-alcoholic beers and the operation of a retail store namely, in the field of clothing, printed publications of photographic wares, novelties and knickknacks and non-alcoholic beverages; online and retail sale of clothing, photographic services, books; operation of on-line chat clubs, on-line news sources, on-line sports trivia contests and on-line photography contests; providing online access in order to contract with government bodies to others”. Anheuser-Busch opposed the application on several grounds, including confusion with its registered trade-mark BUD and a number of trade-mark registrations incorporating the word BUD.

Opponent’s Evidence of Fame

Anheuser Bush submitted the following evidence:

- BUDWEISER beer, commonly referred to by and marketed under the trade-mark BUD, has been sold in Canada since as early as 1903;
- catalogues from 1996, 2000, 2001 and 2003 showing a wide range of merchandizing items displaying the trade-marks BUD and BUD LIGHT, which items are available and licensed to numerous entities in Canada;
- sales of BUDWEISER beer between 1996 and 2004 were \$3,430 million;
- sales of BUD LIGHT beer between 1995 and 2004 were over \$257 million;
- Canadian sales of merchandizing items featuring the trade-mark BUD exceeded \$5.2 million US between 1997 and 2004;
- advertising expenditures for BUDWEISER and BUD LIGHT beer from 1996 to 2004 exceeded \$250 million.

Outcome

The opposition was successful. The Board noted that the Opponent’s trade-marks BUD and BUD-LIGHT have become well known in Canada based on the evidence that was provided. The Applicant relied on Internet evidence to show that “BC Bud” is known in Canada as a type of

marijuana and that there were other uses of “bud” by others for clothing. However, this evidence failed to show that there was a common adoption of the word BUD for clothing. The Board noted that as a matter of first impression consumers would likely believe the Applicant’s wares and/or services would be associated with the Opponent.

Disposition Regarding Fame

The Board referred to the BUD and BUD-LIGHT trade-marks as "famous" in association with beer but the Opponent’s notoriety did not extend to merchandising items.

Bayer Aktiengesellschaft v. Marcon
[2011 TMOB 9; 2010 CarswellNat 5704]

Background

Robert Victor Marcon applied to register the trade-mark BAYER based upon proposed use for “dental products namely: toothbrushes; toothpaste; dental floss and floss wands; mouthwash; dental whitening strips and pastes; dental desensitizing strips and pastes; aerosol breath fresheners; Topical skin balms namely: sunscreens; tanning balms; lotions; creams; and combinations thereof”.

The applicant is an individual who previously tried to register marks such as ABSOLUT; BEEFEATER; BUDWEISER; CANADIAN CLUB; CHANEL; CORONA; EVIAN; JACK DANIEL’S; Nescafé; SENSODYNE; SOUTHERN COMFORT and TIM HORTONS. Such individual currently has applications pending for, inter alia, the marks HEINEKEN; FINLANDIA; DOM PERIGNON and COORS.

Bayer Aktiengesellschaft opposed the application on several grounds including confusion with Bayer’s use and registration of a number of Bayer registered trade-marks and the Bayer trade name. In that connection the Hearing Office found two Bayer registrations to be the most relevant to the issue of confusion -- one dating back to 1919 for “pharmaceutical preparation used for the relief of pain and to reduce fever, composed of and/or containing acetylsalicylic acid”, and one from 1997 for pharmaceutical preparations namely anti-fungals, anti-infectives and anti-hypertensives; vitamin and mineral supplements; and diagnostic reagents for medical use”.

Opponent’s Evidence of Fame

Bayer Aktiengesellschaft submitted evidence that:

- Bayer as a name and as a trade-mark has been used in Canada since at least as early as 1896.
- Bayer is one of the world’s leading innovative companies in the healthcare and medical products industry.
- Bayer’s over-the-counter business on a world-wide level is one of the top three in the world.
- Surveys in 2006 and 2007 indicate that “Bayer is the most recognized health care brand in Canada. Canadians have also voted Bayer as the top respected healthcare company in Canada”.
- Bayer has expended significant monies on advertising and promotion of its branded healthcare products in Canada.

Outcome

The Opposition ruled in Bayer's favour.

Weight was given to the Opponent's extensive reputation and use of its Bayer mark; a connection between the respective wares; the potential overlap between the parties channels of trade, and the fact the marks are identical.

Disposition regarding Fame

This case does not depart from the Supreme Court of Canada's decision in *Mattel* which held it is important to consider all surrounding circumstances, and that fame of a mark does not trump all remaining circumstances. Confusion in this case was not automatically presumed. The Hearing Officer assumed, in the absence of evidence to the contrary from the applicant, that the parties could operate in the same general field or industry and thus there could be confusion.

United States Trademark Trial and Appeal Board

Case Title: *Citigroup Inc. v. Capital City Bank Group, Inc.*

Opposition No. 91177415, February 17, 2010

Citable as Precedent: Yes

Opposer's Mark(s): CITIBANK (and related family of marks) [goods and services related to banking under Classes 16, 35, 36 and 42]

Applicant's Mark(s): CAPITAL CITY BANK (and related family of marks) [services related to banking under Class 36]

Issues: Priority, Likelihood of Confusion, and **Dilution**

Decision/Fame: (i) Opposer's allegation of fame sufficient to state dilution claim against Applicant's ITU applications, but NOT sufficient to state dilution claim against use-based applications as Opposer did not allege that the CITIBANK Marks became famous before Applicant's use of the CAPITAL CITY BANK mark; NEVERTHELESS, TTAB deemed the allegation as properly plead (Applicant's date of first use of the CAPITAL CITY BANK mark is the operative date for determining fame of Opposer's marks); (ii) CITIBANK is a famous mark for purposes of likelihood of confusion AND dilution; (iii) No likelihood of confusion; (iv) No dilution (Opposer did not prove that CITIBANK Marks became famous before Applicant's first use of CAPITAL CITY BANK mark; no blurring) (v) **Opposition dismissed.**

Case Title: ***Bridgestone Firestone North American Tire, LLC and Bridgestone Corporation v. Federal Corporation***

Opposition No. 91168556, February 24, 2010

Citable as Precedent: Yes

Opposer's Mark(s): POTENZA, TURANZA, (ALENZA) [tires in Class 12]

Applicant's Mark(s): MILANZA [tires in Class 12]

Issues: Priority and Likelihood of Confusion

Decision: (i) No Likelihood of Confusion; (ii) **Opposition dismissed.**

Fame: Opposers did not establish that POTENZA and TURANZA marks achieved any significant recognition independent of BRIDGESTONE mark.

Case Title: *Safer, Inc. v. OMS Investments, Inc.*

Opposition No. 91176445, February 23, 2010

Citable as Precedent: Yes

Opposer's Mark(s): DEER AWAY and DEER AWAY PROFESSIONAL [repellant for repelling deer, other big game and rabbits in Class 5]

Applicant's Mark(s): DEER-B-GON [animal repellant used to repel deer and other ruminant animals and rabbits in Class 5]

Issues: Priority and Likelihood of Confusion

Decision: (i) No Likelihood of Confusion; (ii) **Opposition dismissed.**

Fame: Consumers have not been widely exposed to DEER AWAY and DEER AWAY PROFESSIONAL marks and the marks have not otherwise become widely known, therefore marks are not famous.

Case Title: *Temper-Pedic International, Inc., et al
v. Denver Mattress Co., LLC*

Opposition No. 91169165, February 4, 2010

Citable as Precedent: No

Opposer's Mark(s): SWEDISH SLEEP SYSTEM [mattresses and related goods in Class 20]

Applicant's Mark(s): SWEDISH LUXURY [mattresses and related goods and services in Classes 20 and 35]

Issues: Priority, Likelihood of Confusion, and Geographic Deceptive Misdescription

Decision: (i) Priority and Likelihood of Confusion favors Opponent, **Opposition sustained**; (ii) Geographically deceptively misdescriptive claim **dismissed**.

Fame: Opposer did not establish that SWEDISH SLEEP SYSTEM mark achieved any significant recognition independent of famous TEMPURPEDIC mark; evidence not sufficient to support a finding that the mark is famous, but mark is distinctive, strong and entitled to a broad scope of protection.

Case Title: ***Bose Corporation v. PWC Industries, Inc.***

Opposition No. 91182396 Decided March 1, 2010

Citable as Precedent: No

Opposer's Mark: WAVE (stylized and in standard characters) for radios, clock radios, compact stereo systems, and portable compact disc players; music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and digital music player; compact disc changer; digital music playing docking station (Int. Cl. 9)

ACOUSTIC WAVE (both typed) for loudspeaker systems; loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player (Int. Cl. 9).

Applicant's mark: FULL WAVE AUDIO ("AUDIO" disclaimed) for "marine waterproof audio amplifier, and waterproof stereo speakers" (Int. Cl. 9)

Issues: Likelihood of confusion

Decision: **Opposition sustained.**

Fame: The Federal Circuit already has determined that opposer's ACOUSTIC WAVE and WAVE marks are famous. The Court determined that "[w]hen the full record is considered, only one conclusion can be reached regarding the fame of the Bose product marks; they are famous and thus entitled to broad protection." *Bose Corp. v. QSC Audio Products, Inc.*, 63 USPQ2d at 1309.

In the present case, opposer has updated its evidence bearing on fame, thus presenting us with even more evidence of fame than what the Federal Circuit considered in making its earlier determination.

Opposer's ACOUSTIC WAVE mark has been used for approximately twenty-five years, with annual sales of 45,000 units generating around \$50 million in annual sales revenue. Promotional and advertising expenditures average \$10 million on an annual basis. Opposer has advertised its goods in national publications such as USA Today, Parade Magazine and New York Times Magazine, as well as through direct mailings and on opposer's website. Opposer has benefited from significant press coverage in major media outlets such as Wall Street Journal, Boston Herald and CNN.com.

Opposer's WAVE mark has been used for approximately sixteen years, with annual sales of 600,000 units, representing annual sales revenue in

excess of \$250 million. Opposer has spent around \$40 million annually on its promotional and advertising efforts.. Opposer has promoted its WAVE brand goods through direct mail, catalogs, the Internet, and in publications such as New York Times Magazine and Parade Magazine. Opposer also has enjoyed press coverage of its WAVE brand products in national publications.

Accordingly, we find that opposer's ACOUSTIC WAVE and WAVE marks are famous for opposer's electronic products.

Case Title: *New York State Department of Economic Development v. Ramapo Valley Brewery, Inc.*

Opposition No. 91171992 Decided March 10, 2010

Citable as Precedent: Yes

Opposer's Mark: I [heart] NY for various goods in Int. Cl. 16; 25 and 35 as evidenced in cited registrations.

Applicant's mark: I LOVE NY BEER, in standard character form and I [heart] NY BEER, for numerous goods in Int. Cl. 16; 21; and 25

Issues: Likelihood of confusion; Dilution

Decision: **Opposition sustained as to likelihood of confusion.**

Fame: Between 2003-2008, opposer spent over \$40 million promoting travel and business in the state of New York featuring the I LOVE NEW YORK mark. As a result of opposer's promotions featuring the I LOVE NY mark, the logo has been identified as one of the best known logos in the United States, if not the world. In a story published on May 14, 2002, CNN.com recognized opposer's logo as a "world-recognized symbol". The story also referred to the logo as an "iconic symbol" and noted that "'I Love New York' has seeped into public consciousness like few other ad campaigns." Richard Kirshenbaum, co-chairman and chief creative officer of Kirshenbaum Bond & Partners is quoted saying "I think it's become part of the vernacular. And when that happens, it's a good thing."

The renown of the I LOVE NEW YORK logo has been recognized in publications outside of the United States. While foreign publications do not have much probative value regarding consumer perception in the United States, we find that these articles corroborate the perception described in the CNN.com article. An article in an issue of the Toronto Star in 2005 proclaimed opposer's logo as "probably the world's most recognized place-brand." In 2000, R.O.B. Magazine, a Canadian business publication, in partnership with the London Financial Times commissioned an international panel of judges to rank the "greatest logos." In article entitled "The World's Top 50" appearing in the November 2000 issue of R.O.B. Magazine, opposer's logo was ranked as the world's 24th top logo based on whether the logo had a positive effect on perceptions of the company among employees and the public.

TTAB found that opposer's I LOVE NY logo was famous. **Because the TTAB found that applicant's marks are likely to cause confusion, they did not have to consider the dilution claim.**

Case Title: *Fiat Group Automobiles S.p.A.v.ISM, Inc.*

Opposition No. 91190607, Decided March 15, 2010

Citable as Precedent: Yes

Opposer's Mark: FIAT PANDA and PANDA on automobiles – no registration or use in the US. Alleges continuous use since 1980 of the trademarks FIAT PANDA and PANDA on automobiles in Europe and most major industrial countries of the world, indicating its intent to “rely on 6bis of the Paris Convention and Article 16(2) of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) as further support for this Notice of Opposition.”

Applicant's mark: PANDA for Class 12 “automobiles”

Issues: Dilution

Decision: This is a Motion to Dismiss. **Motion to dismiss granted with respect to the dilution claim.**

Fame: Opposer's dilution claim relies on the alleged fame of a “well known mark” but opposer has not alleged any particular type of use or specific facts which could be proved at trial as demonstrating widespread recognition of its mark in the United States, opposer's dilution claim is insufficient. We note, in this regard, the pleading of such a claim cannot merely allege recognition and fame outside the US and presume that such follows as a matter of course. Opposer must assert facts that it expects to prove at trial that would demonstrate the recognition and fame of its PANDA and FIAT PANDA marks in the US. As the notice of opposition does not plead such facts, opposer's dilution claim must fail as a matter of law.

The Board held that a foreign trademark owner who has filed an ITU application may rely on the fame of its mark in the United States to support a dilution claim in an opposition – as the the TDRA does not define the term “mark,” the Board looked to Section 45 of the Act, concluding that it must “at least recognize the possibility that, in an unusual case, activity outside the United States related to a mark could potentially result in the mark becoming well-known within the United States, even without any form of activity in the United States.

Case Title: ***Kenneth Cole Productions (LIC), Inc. v. Andrew Craig***

Opposition No. 91161781 Decided March 23, 2010

Citable as Precedent: No

Opposer's Mark: LeTIGRÉ (stylized) for "men's, women's and children's apparel-namely, sweaters, shirts, jackets, sport coats, all-weather coats, raincoats, slacks, jeans, shirts, swim trunks, gym trunks, headwear and robes" in Int. Cl. 25

Applicant's mark: LE TIGRE (in standard character form) for "writing instruments namely fountain pens, ball point pens, felt and fiber tip pens and markers" in In. Cl. 16; small leather goods, namely, cases for diaries and daily planners; and brief case type portfolios Int. Cl. 18

Issues: Likelihood of confusion; Dilution

Decision: **Opposition sustained on likelihood of confusion;** however, the mark is not famous

Fame: Opposer argued that its LeTIGRÉ (stylized) mark is "clearly well-known, and likely famous, entitling it to a broad scope of protection"and that the mark is "arbitrary and thus a strong mark."

Opposer argued that its registration is now over 28 years old and that the mark has received "enormous unsolicited publicity and media attention," including evidence that mark has been featured in news articles and persons wearing clothing bearing opposer's mark has been featured on magazine covers. The evidence does not suffice for purposes of proving that the mark is famous under the du Pont factor. Absent from the record are any actual dollar figures for opposer's sales and advertising of clothing bearing opposer's LeTIGRÉ mark. It is impossible to ascertain from this record the extent to which consumers have been exposed to opposer's goods under its mark vis-à-vis their competitors, and, thus, whether opposer's evidence of media exposure translates into fame of its pleaded mark. Ultimately, opposer's evidence falls short of establishing that the LeTIGRÉ mark is famous.

Case Title: *Edwards Lifesciences Corporation v. VigiLanz Corporation*
Opposition No. 91154210 decided April 14, 2010

Citable as Precedent: Yes

Opposer's Mark: VIGILANCE for "heart monitors" in Cl. 10

Applicant's mark: VIGILANZ for "near real-time computer monitoring system comprised of a software application and database that anticipates and detects possible adverse drug events, and alerts healthcare providers to adverse drug events in Cl. 9

Issues: Likelihood of confusion; Fame

Decision: **Opposition sustained on likelihood of confusion;** Opposer has shown at least niche fame of its mark VIGILANCE for heart monitors and should be afforded a fairly wide berth of protection.

Fame: Opposer has been using the mark VIGILANCE to identify heart monitors since 1990 and made of record the sales figures and advertising expenditures for its heart monitors. The sales and advertising figures were designated confidential so we may only refer to them in general terms. On their face, the sales figures appear to be relatively large. In that regard, opposer claims to have captured 75% of the heart monitor market.

Opposer has submitted references from medical journals to show that its VIGILANCE mark has achieved fame. An article in an unidentified periodical, referred to "Vigilance ... as the gold standard in this trial." Opposer also submitted abstracts from seven medical journals referencing the use of VIGILANCE heart monitors in clinical tests. The abstracts were from Anaesthesia, Journal of Clinical Monitoring, Clinical Intensive Care, Journal of Trauma, a Japanese publication and a German publication. The articles have limited value in proving the fame of opposer's mark because they noted only opposer's heart monitors as an instrument used in a particular study. They did not demonstrate recognition of the mark by the relevant purchasing public.

Although the medical journal articles are not sufficient to establish fame for the mark, as evidenced by opposer's long use of its mark and market success, we find that opposer has acquired niche market fame. That is, within critical care settings such as operating rooms, intensive care units, recovery rooms, hospital emergency rooms and burn units, the VIGILANCE mark has achieved a high level of renown.

Case Title: ***National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Company, 2010 WL 2513872 (T.T.A.B. 2010)***

Opposition No. 91166701 against Serial No. 76574162, Decided June 11, 2010

Citable as Precedent: YES

Opposer's Mark(s): **THE OTHER WHITE MEAT** (*in standard character format*)

[Association services namely, promoting the interests of members of the pork industry in Class 42.]

THE OTHER WHITE MEAT (*in standard character format*)

[Cookbooks, brochures about pork, pens, pencils, crayons, bumper stickers, and stickers in Class 16; shirts, t-shirts, sweatshirts, aprons, jackets, and hats in Class 25; and providing an Internet website featuring food preparation/cooking information regarding pork and accompanying recipes in Class 43]



[Promoting the interests of the members of the pork industry” in Class 35; and “providing an Internet website featuring information about cooking and accompanying recipes” in Class 43]

Applicant's Mark(s): **THE OTHER RED MEAT** (*in standard character format*)

[Fresh and frozen salmon in Class 29]

Issues: Likelihood of Confusion and Dilution

Decision: **The opposition was sustained on the basis of a likelihood of dilution, and the Board chose not to make a determination as to Opposers' claim of likelihood of confusion.**

Fame: The Board began its reasoning by stating the three elements relevant to a finding of dilution by blurring under Section 43(c) of the Act: (1) whether Opposers' mark is famous; (2) whether Opposers' mark became famous prior to the date of the application to register Applicant's mark; and (3) whether Applicant's mark is likely to blur the distinctiveness of Opposers' famous mark.

The Board found Opposers' THE OTHER WHITE MEAT mark to be famous. The Board supported its conclusion with evidence that

Opposers spent \$25 million every year for almost twenty years on demand enhancement advertising and marketing prior to the filing of the involved application. The Board also supported its conclusion that Opposers' THE OTHER WHITE MEAT mark was famous with evidence of extensive third-party advertising (through cross-promotional and co-branded activities), in-store retail promotions and unsolicited, national news media coverage, including "extensive references to the mark in the popular culture." The Board held that the preponderance of the evidence supported the conclusion that Opposers' mark THE OTHER WHITE MEAT was famous among a broad spectrum of the general consuming public.

Next, the Board found that Opposers' THE OTHER WHITE MEAT mark was famous before Applicant's filing date. The Board noted that the majority of the evidence in the record about the renown of Opposers' slogan predated Applicant's February 4, 2004 application filing date of THE OTHER RED MEAT mark.

Finally, the Board found that Applicant's mark THE OTHER RED MEAT was likely to blur the distinctiveness of Opposers' mark, THE OTHER WHITE MEAT. The Board considered the factors for determining the likelihood of blurring in a dilution case set out by the Trademark Dilution Revision Act: (1) The degree of similarity between the mark or trade name and the famous mark, (2) the degree of distinctiveness of the famous mark, (3) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark, (4) the degree of recognition of the famous mark, (5) whether the user of the mark or trade name intended to create an association with the famous mark, and (6) any actual association between the mark or trade name and the famous mark.

In conducting its analysis under the TDRA, the Board found:

1) The marks THE OTHER WHITE MEAT and THE OTHER RED MEAT were "highly similar" because they have "the same structure and cadence and three of the same words." The Board also noted that the fourth word is "an adjective referring to a color of meat, of which there are precious few from which to choose." The Board reasoned that both marks "elicit the same mental processing" because they compare the promoted meat with other kinds of meat on the market. The Board also relied on a dilution survey conducted by the Opposers that showed that "more than thirty-five percent of the survey respondents associate applicant's slogan with Opposers' slogan (or with the pork being promoted by the mark) in an unaided survey response."

2) Opposers' mark was inherently distinctive. The Board observed that the incontestable registration issued without a Section 2(f) showing of acquired distinctiveness, and thus was entitled to a presumption of inherent distinctiveness. The Board reasoned the mark was suggestive because it "only suggests a healthy attribute of the commodity being promoted by the pork industry, namely, the color of some cuts of pork after being cooked."

3) Opposers' use of the mark THE OTHER WHITE MEAT to be "virtually exclusive." The Board observed that there was no evidence in the record of any third party use of the same or similar marks on any goods or services. The Board reasoned that Opposers' exclusive use of the mark supports the conclusion that dilution by blurring is likely.

4) Opposers' mark was "extremely well recognized by a broad spectrum of consumers." The Board reasoned by a preponderance of the evidence that THE OTHER WHITE MEAT "has become part of the fabric of popular culture in the United States." The Board based its reasoning on a "Northwestern Study of 2000," which showed that only four other consumer slogans in the United States had a greater degree of recognition than THE OTHER WHITE MEAT. The Board observed that this degree of recognition supports the conclusion that dilution by blurring is likely.

5) Applicant intended to create an association between its mark and Opposers' mark. The Board did not believe Applicant's CEO's claims that he came up with THE OTHER RED MEAT "out of the blue." Instead, the Board reasoned that, because Applicant's CEO had reviewed a trademark search report showing Opposers' mark and had customer relationships with well-publicized restaurants that prominently participated in Opposers' THE OTHER WHITE MEAT campaign, the CEO's argument that he came up with THE OTHER RED MEAT mark independently "stretches credulity." While the Board did not conclude bad faith on the part of Applicant because Applicant "may have believed it was permissible" to create an association with Opposers' mark, the Board decided the factor weighed in favor of Opposers.

6) The Board did not consider evidence of actual association between the marks because Applicant filed THE OTHER RED MEAT on an intent to use basis.

The Board found for Opposers in connection with their likelihood of dilution claim. Therefore, the Board did not consider Opposers' likelihood of confusion claim.

Case Title: ***Valentino U.S.A., Inc. v. Florence Fashions (Jersey) Limited, 2010 WL 2783891 (T.T.A.B. 2010)***

Opposition No. 91094961 to Application Serial No. 74188334;
Opposition No. 91095203 to Application Serial No. 74188331;
Cancellation No. 92029390 to Registration No. 2130804;
Cancellation No. 92029476 to Registration No. 2103658, Decided
June 25, 2010

Citable as Precedent: No

Opposer's Mark(s): VALENTINO

[Common law – clothing and accessory items, including coats, dresses, sweaters, hosiery, gloves, handbags, belts and footwear]

VALENTINO GARAVANI

[Common law – clothing and accessory items, including coats, dresses, sweaters, hosiery, gloves, handbags, belts and footwear]

Applicant's Mark(s): GIANNI VALENTINO

[Bath robes; boots; ski boots; boots for sports; coats; dressing gowns; gloves; hosiery; jackets; jerseys; jumpers; knitted pullovers; knitted cardigans; mittens; leggings, overcoats; pants; pullovers; pajamas; sandals; scarves; mufflers; knitted caps; knitted vests; shawls; shirts; shoes; skirts; slippers; socks; sweaters; swimsuits; trousers; underwear; waistcoats; ties; neckties; bow ties; cravaths [sic]; night gowns; bed jackets; negligees; and headwear in International Class 25;]

GIOVANNI VALENTINO

[Attache cases; bandoliers; brief cases; garment bags for travel; handbags; straps for luggage; thongs; pocket wallets; drawstring pouches; purses; rucksacks; satchels; cosmetic cases sold empty; cases for men's toiletries sold empty; valises; animal hides; trunks for travelling; umbrellas; parasols; walking sticks; whips; harnesses; and saddlery; all made of leather or imitation of leather in International Class 18 and shoulder belts; namely, belts which run across the body from front to back and which are attached to belts about the waist in International Class 25]

GIANNI VALENTINO

[Attache cases; bandoliers, brief cases; garment bags for travel; handbags; straps for luggage; thongs; music cases, namely, a type of brief case designed to carry musical scores; pocket wallets;

drawstring pouches; purses; rucksacks; satchels; school bags; travelling bags; individual pieces of luggage and luggage sets; cosmetic cases sold empty; cases for men's toiletries sold empty; valises; animal hides; trunks for travelling; umbrellas; parasols; walking sticks; whips; harnesses; and saddlery; all made of leather or imitation of leather in International Class 18]

GIOVANNI VALENTINO

[Bath robes; boots; boots for sports; coats; overcoats; dressing gowns; bed jackets; gloves; hosiery; jackets; knitted pullovers; pullovers, jerseys, sweaters, jumpers, knitted cardigans; leggings, mittens; trousers; pants; pajamas; shoes; sandals; scarves; mufflers; shawls; knitted caps; knitted vests; shirts; skirts; slippers; socks; swimsuits; underwear; waistcoats; ties; neckties; cravats; bowties, night gowns, negligees; and headwear in International Class 25]

Issues: Likelihood of Confusion

Decision: **Sustained as to likelihood of confusion.** The Board held VALENTENO had not acquired fame. However, the Board concluded that because Defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO were similar to Plaintiff's marks VALENTINO and VALENTINO GARAVANI, Plaintiff had established priority of use, the goods were identical, in part, and otherwise closely related, and there was an overlap in the channels of trade and the classes of purchasers, resulting in a likelihood of confusion.

Fame: The Board began its likelihood of confusion analysis with the fifth *du Pont* factor, which required it to consider evidence of the fame of Plaintiff's mark. The Board explained that fame "plays a 'dominant' role in the process of balancing the du Pont factors," and may be measured indirectly by "the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident."

As proof of fame, Plaintiff submitted several printed publications showing use of the VALENTINO marks in magazine advertising, in the press and in books about the designer Valentino Garavani, along with testimony about various fashion awards Mr. Garavani has won. However, Plaintiff failed to provide any evidence of fame after 1991, the Defendant's priority date, because Plaintiff mistakenly believed its "burden [was] to show that its marks were strong as of [Defendant's] priority date." The Board clarified that it "generally accepts and considers evidence related to likelihood

of confusion for the period up to the time of trial, and this includes evidence of the fame of a plaintiff's mark." The Board noted that "[f]ame comes and goes," and that the Board "must make a determination as to whether likelihood of confusion exists today, not only sometime in the distant past." In any event, the Board held that the "record [did] not support a finding of fame even prior to 1991."

Plaintiff also failed to provide any evidence of volume of sales and advertising expenditures over time. Plaintiff only provided "testimony and documentary evidence of an advertising plan for one year," which the Board found to be "woefully inadequate" to prove fame.

The Board did, however, find that Plaintiff's marks had "some strength in connection with clothing, bags, footwear and accessories," based on decades of magazine advertisements and press references. The Board also found that the designer of Plaintiff, Valentino Garavani, "has received substantial recognition over the years as evidenced by the numerous awards given to him by organizations in the fashion industry and by being the subject of numerous books about his career in and impact on the fashion industry."

Regardless, the Board found "[P]laintiff has not met its burden to show that it owns a famous mark," and that Plaintiff's marks do not "reach the level of playing a 'dominant' role in the process of balancing the du Pont factors." The Board reasoned that, "[b]ecause 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."

Despite the Board's finding that Plaintiff's marks were not famous for likelihood of confusion purposes, the Board ultimately held that "because defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO are similar to plaintiff's marks VALENTINO and VALENTINO GARAVANI, the goods are identical, in part, and otherwise closely related, and there is an overlap in the channels of trade and the classes of purchasers, there is a likelihood of confusion." The Board also held that Plaintiff had established priority of use, and ultimately resolved the case in favor of the prior user.

The Board did not consider likelihood of dilution.

Case Title: ***Apple, Inc. v. Echospin, LLC, 2010 WL 2783894 (T.T.A.B. 2010)***

Opposition No. 91171592 to Application Serial No. 76613376,
Decided June 29, 2010

Citable as Precedent: No

Opposer's Mark(s): APPLE (word mark)

[computers and computer programs recorded on paper and tape]

[communication filed by computer, namely, electronic transmission of data and documents via computer, delivery of messages by electronic transmission]

[computer consultation, design, testing, research and advisory services; research and development of computer hardware and software; maintenance and repair of computer software applications; updating of computer software; computer programming services; providing information concerning computers and computer software over computer networks and global communication networks; computer services, namely, hosting web sites and providing web site operation and management services to others; computer services, namely, providing search engines for obtaining data on computer networks and global communication networks; leasing of computers, computer peripherals and computer software]



[computers and computer programs recorded on paper and tape]

[computers hardware; computer hardware, namely, server, desktop, laptop, notebook and subnotebook computers; hand held and mobile computers; computer monitors; personal digital assistants; portable digital audio players; electronic organizers; computer keyboards, cables, modems; audio speakers; computer video control devices, namely, computer mice, a full line of computer software for business, home, education, and developer use; computer programs for personal information management; database management software; electronic mail and messaging software; database synchronization software; computer programs for accessing, browsing and searching online databases; operating

system software; application development tool programs; blank computer storage media; fonts, typefaces, type designs and symbols recorded on magnetic media; computer software for use in providing multiple user access to a global computer information network for searching, retrieving, transferring, manipulating and disseminating a wide range of information; computer software for use as a programming interface; computer software for use in network server sharing; local and wide area networking software; computer software for matching, correction, and reproduction of color; computer software for use in digital video and audio editing; computer software for use in enhancing text and graphics; computer software for use in font justification and font quality; computer software for use to navigate and search a global computer information network, as well as to organize and summarize the information retrieved; computer software for use in word processing and database management; word processing software incorporating text, spreadsheets, still and moving images, sounds and clip art; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing audio, video, still images and other digital data; computer software for analyzing and troubleshooting other computer software; children's educational software; computer game software; computer graphics software; Web site development software; computer program which provides remote viewing, remote control, communications and software distribution within personal computer systems and across computer network; computer programs for file maintenance and data recovery; computer peripherals; instructional manuals packaged in association with the above]

[Application service provider (ASP), namely, hosting computer software applications of others; computer services, namely, displaying the web sites and images of others on a computer server; computer diagnostic services; installation of computer software; updating of computer software; maintenance of computer software; computer hardware development; integration of computer systems and networks; monitoring the computer systems of others for technical purposes and providing back-up computer programs and facilities; computer consultation, design, and testing services; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; computer data recovery; computer programming for others; research and development of computer hardware and software; website design, creation and hosting services; computer services, namely, designing and implementing web sites for others; computer services, namely, providing search engines for obtaining data on a global computer network;

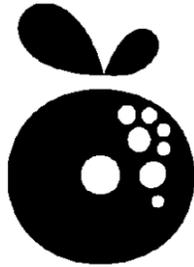
providing use of on-line nondownloadable software for communications via local or global communications networks, including the Internet, intranets, and extranets; computer consultation, namely, analyzing data to detect, eradicate, and prevent the occurrence of computer viruses; computer consultation, namely, services relating to the protection of computer hardware, computer software, computer networks and computer systems against computer viruses, attacks, or failures; computer consultation, namely, services for optimizing the performance and functionality of computer software and communications networks; technical support services, namely, troubleshooting of computers, computer software, telecommunications, and the Internet systems; leasing of computers, computer peripherals and computer software; leasing computer facilities. providing information in a wide variety of fields over computer networks and global communication networks; computer services, namely, creating indexes of information, web sites and other information sources available on computer networks; providing information concerning a wide range of text, electronic documents, databases, graphics and audiovisual information]

[telecommunication services, namely, electronic transmission of data and images via computer networks; electronic mail services; providing on-line electronic bulletin boards for transmission of messages among computer users in the fields of business, creative design, education, computers, information technology, word processing, database management, entertainment, electronic commerce and telecommunications; telecommunications consultation; delivery of messages by electronic transmission; electronic transmission of data and information by computer, radio, mail, providing Internet access]

[analysis and consultation in the field of business information management, namely, the selection, adoption and operation of computers and computer information management systems; providing information in the fields of business and commerce over computer networks and global communication networks; business services, namely, providing computer databases regarding the purchase and sale of a wide variety of products and services of others; business services, namely, dissemination of advertising for others via computer networks and global communication networks; retail store services featuring computers, computer software, computer peripherals and consumer electronics, and demonstration of products relating thereto; online retail store services provided via computer networks and global communication networks featuring computers, computer software, computer peripherals and

consumer electronics, and demonstration of products relating thereto]

Applicant's Mark(s):



[software for the collection, storage, processing, modification, organization, transmission, and sharing of data and information, including digital media]

[computer service, namely, acting as an application service provider in the field of information processing to host computer application software for the collection, storage, processing, modification, organization, transmission, and sharing of data and information, including digital media]

Issues:

Priority, Likelihood of Confusion, and Likelihood of Dilution

Decision:

The opposition was sustained on the ground of likelihood of confusion.

Fame:

The Board Board addressed the fame factor in its LOC analysis, finding the Apple logo to be a famous mark based on Opposer's evidence of significant revenue, advertising figures, extensive media coverage, and favorable survey results, concluding that Apple established "overall fame amongst the relevant public." Opposer's 2008 10K report showed net sales for the United States to be over \$18 billion in 2008, and advertising expenses were listed as "\$486 million, \$467 million, and \$338 million for 2008, 2007, and 2006 respectively." Opposer submitted news articles discussing the reputation and fame of its brand. Opposer also submitted evidence of high consumer recognition, showing Apple ranked among the "100 Top Brands" in Interbrand's survey every year from 2001 through 2008.

The Board sustained the opposition on the ground of likelihood of confusion, concluding that Opposer established that its mark is famous, the parties' goods and services are legally identical, and the marks are similar. **Having found a likelihood of confusion, the Board did not consider likelihood of dilution.**

Case Title: *Telefonos de Mexico, S.A.B. de C.V. v. Andres Gutierrez Estrada, 2010 WL 2783897 (T.T.A.B. 2010)*

Opposition Nos. 91183487 to Application Serial Nos. 77270292 filed on 9/2/2007; 91183509 to Application Serial No. 77270301, Decided June 30, 2010

Citable as Precedent: No

Opposer's Mark(s): TELMEX

[telephone calling car services]

Applicant's Mark(s): AUDITORIO TELMEX

[arena services, namely, providing facilities for sports, concerts, conventions and exhibitions]

[entertainment in the nature of ballet performances; entertainment in the nature of visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; entertainment, namely, live performances by a musical band; entertainment, namely, live performances by musical bands; entertainment, namely, live performances by rock groups; live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; performance hall rental services; planning arrangement of showing movies, shows, plays or musical performances; presentation of live show performances; presentation of musical performance; booking of seats for shows and booking of theatre tickets; rental of portable theatre seating; entertainment in the nature of visual and audio performances, and musical, variety, news and comedy shows; providing facilities for movies, shows, plays, music or educational training; entertainment in the nature of dance performances]

Issues: Likelihood of Confusion (Opposer abandoned Dilution claim)

Decision: **The opposition was sustained as to both applications.**

Fame: The Board noted that Opposer attempted to assert dilution in its Notice of Opposition, but did not maintain that ground in its brief. **Therefore, the Board regarded the dilution ground as abandoned and did not consider it.**

The Board also noted that Opposer appeared in its brief to assert "the international fame and renown of its mark as a distinct ground

for the oppositions. However, opposer asserted no such ground in either of its notices of opposition. Accordingly, we have given no consideration to this ground which opposer did not plead.”

However, the Board did address the fame factor in its LOC analysis, noting that Opposer’s evidence regarding sales of its calling cards in the U.S. is insufficient to establish fame – “[W]e have no information regarding its U.S. competitors in the calling card business in the United States to place that evidence in context. Even without that information, the numbers alone suggest that opposer does not have significant market share.” The Board also found that the articles submitted under notice of reliance, which, for the most part, mention TELMEX “in the context of business or financial reporting, the exploits of Carlos Slim Helu, the former chairman of Telmex, and reports of results of the Copa Telmex tennis tournament in Argentina,” were insufficient to establish that the TELMEX mark is famous in the United States.

Case Title: *Coach Services, Inc. v. Triumph Learning LLC,*

Opposition 91170112, decided 9/17/10 (Opposer's Notice of Appeal to CAFC filed 11/10/10, the U.S. Court of Appeals for the Federal Circuit heard oral argument on 8/5/2011)

Citable as Precedent: Yes

Opposer's Mark(s): COACH (in typed drawing format) for:

"leather goods, namely, utility kits, portfolios, key cases, comb cases, pass cases, money clips, billfolds, wallets, pocket secretaries, stud cases, jewel cases, and leather book covers," in International Class 14;

"women's handbags and carry-on luggage," in International Class 18;

"men's and women's belts," in International Class 25;

"eyeglass cases, cellular phone cases, computer cases and computer accessory cases," in International Class 9; and

"desk pads, desk file trays, memo boxes, pencil cups, business card holders, paperweights, planning diaries, daily business planners, checkbook covers," in International Class 16.

Applicant's Mark(s): COACH,
Coach, and



for:

Computer software for use in child and adult education, namely, software to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams; prerecorded audio and video tapes in the field of child and adult

education, featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 9; and,

Printed materials in the field of child and adult education, namely, textbooks, workbooks, teacher guides and manuals, posters and flashcards, all featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 16.

Issues: Priority and Likelihood of Confusion,
Dilution, and
Descriptiveness.

Decision: **Opposition dismissed.**

Fame: Opposer introduced evidence of the following to establish fame:

1. Opposer began using the COACH mark at least as early as December 28, 1961;
2. There are approximately 400 COACH retail stores throughout all 50 states;
3. Opposer's COACH products are also sold by approximately 1,000 third-party retailers throughout the United States;
4. In 2008, opposer's annual sales were approximately three-and-a-half billion dollars;
5. In 2008, opposer spent "about 30 to \$60 million a year" on advertising;
6. Opposer has advertised in fashion magazines and regional magazines such as Elle, Vogue, Mademoiselle, New Yorker, New York Magazine, Cosmopolitan, and Vanity Fair;
7. Opposer has advertised in newspapers in major metropolitan areas, such as the New York Times, New York Post, Chicago Tribune, and Boston Globe, as well as in smaller cities;
8. Opposer's COACH products have received unsolicited publicity in numerous newspapers and magazines discussing fashion trends;
9. Opposer has been the subject of newspaper and magazine articles which refer to the renown of opposer and its products.
10. Opposer's March 2008 internal brand awareness study.
11. Opposer's products are the subject of counterfeiting.

The Board found Opposer's COACH mark to be famous for purposes of likelihood of confusion. However, the Board went on to find that the goods are not related and that the channels of trade are distinct:

There are clear and significant differences between applicant's goods, educational materials for preparing for standardized tests, and the various products identified in opposer's registrations... While opposer uses its mark on a myriad of consumer products, it does not use COACH to identify educational products, notwithstanding its production of an instructional video to help U.S. Customs identify counterfeit products.

The Board also found that although the marks are identical in sound and appearance, they are quite different in commercial impression:

Opposer's COACH mark, when applied to fashion accessories is clearly either arbitrary or suggestive of carriage or travel accommodations (e.g., stagecoach, train, motor coach, etc.) thereby engendering the commercial impression of a traveling bag (e.g., a coach or carriage bag). On the other hand, applicant's COACH marks call to mind a tutor who prepares a student for an examination.

Therefore, the Board held that that applicant's use of its COACH marks for "educational materials for preparing for standardized tests" is not likely to cause confusion with opposer's COACH marks for handbags and consumer fashion products and accessories.

Regarding Opposer's dilution claim, the Board did not find Opposer's evidence of fame sufficient to show that Opposer's mark is famous for purposes of dilution. "[O]pposer's evidence of fame falls far short of the quantum and quality of evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003), that was found sufficient to prove that opposer's mark was famous for dilution purposes." The Board noted the following regarding Opposer's evidence of fame:

– Opposer's brand awareness study is "of dubious probative value because Opposer did not proffer a witness with first-hand knowledge of the study to explain how the study was conducted and the significance of the study. Moreover, to the extent that were able to extrapolate any significance from the findings in the study, the study showed a high level of brand awareness in women ages 13-24 but provided no evidence of about the brand awareness among women in general or men."

– Media evidence introduced fails to show a widespread recognition of Opposer's mark to the general population.

– News articles noting Opposer’s renown are too few to support a finding that Opposer’s mark has been transformed into a household name.

– Sales and advertising expenditures are for only one year, in 2008, and these figures represent its activities worldwide, without breaking down the figures to sales and advertising in the United States.

Furthermore, the Board noted that Opposer did not provide evidence to prove that Opposer’s mark became famous for the relevant goods prior to the application date.

(The Board went through the factors for determining dilution by blurring and dilution by tarnishment, finding that Opposer did not prove either form of dilution.)

Finally, the Board found that that Applicant’s use of the word “Coach” in connection with educational materials for preparing for standardized tests is merely descriptive. However, the Board also determined that Applicant established its affirmative defense that its COACH marks have acquired distinctiveness.

Case Title: ***Humana Inc. v. Aetna Inc.***,
Opposition 91192704, decided 10/13/10

Citable as Precedent: No

Opposer's Mark(s): HUMANAONE (in standard character form), and
 (“HUMANAONE and design”)

for “underwriting insurance for pre-paid health care; insurance underwriting in the field of health administration of pre-paid health care plans; organizing pre-paid health care,” in International Class 36.

Applicant's Mark(s): AETNA ONE (in standard character form), and
 (“AETNA ONE and design”)

for “managed health care services, namely, health and wellness counseling; medical, behavioral health, and disability care management services; disease care management services; providing health care information in the field of health and wellness, behavioral health, disability, management, and disease management” in International Class 44.

Issues: Likelihood of Confusion

Decision: **Opposition dismissed.**

In analyzing the relevant *duPont* factors, the Board found:

- 1) the services were related (in favor of LOC),
- 2) the respective services must be treated as traveling in the same channels of trade to the same classes of purchasers (in favor of LOC),
- 3) purchasers would exercise some sophistication when purchasing healthcare insurance (against LOC),
- 4) Opposer's marks were not famous (neutral),
- 5) the word “One” was relatively diluted as used in the health insurance field, and marks using the word “One” often co-exist and are distinguished because of other terms used in conjunction with “One” (against LOC), and

6) the parties' marks (giving appropriate weight to the dominant portions thereof, namely, AETNA and HUMANA) differed in appearance, sound, connotation and commercial impression, and the parties' stylized marks were further distinguished by their respective stylization and design elements (against LOC).

The Board concluded that "the dissimilarity of the marks, under the first *du Pont* factor, simply outweighs the evidence as to the other factors which favor opposer's case."

Fame:

Opposer introduced evidence of the following to establish fame:
sales revenue and marketing expenditures for the years 2002-2009;
use of the HUMANAONE marks for eight years,
Opposer's promotion of the marks in a variety of media, including in printed publications, on television, radio and the Internet, and by way of direct mail, and
Opposer's use of the marks on several collateral products.

The Board noted that Opposer failed to put sales and marketing figures in any context in terms of "where its HUMANAONE services rank among health insurance underwriters," and found that Opposer's evidence fell far short of establishing fame. Therefore, the *duPont* fame factor was neutral. The Board also noted that "[e]ven if fame had been shown, the factor of fame is not sufficient to establish likelihood of confusion in the present proceeding."

Case Title: *HyLoft, Inc. and KE Investments, Inc. v. Rapid Rack Industries, Inc.*,
Opposition 91187636, decided 10/7/10

Citable as Precedent: No

Opposer's Mark(s): HYLOFT (three registrations) for "shelves, namely, suspended shelves for storage purposes," "shelving and storage racks," and "retail store services featuring shelving and storage racks."

Applicant's Mark(s): GORILLA LOFT for "storage racks and shelving."

Issues: Likelihood of Confusion and Dilution

Opposers asserted that Applicant's mark GORILLA LOFT for storage racks and shelving would likely cause confusion with, and would likely dilute, their registered mark HYLOFT for shelving and storage racks and related retail store services. (Opposers did not plead a dilution claim or seek leave to amend their notice of opposition to include a dilution claim. However, Opposers argued dilution in their brief and Applicant did not object. Rather, Applicant addressed the merits of the dilution claim in its brief. Therefore, the board construed the dilution claim "as having been tried by implied consent" and deemed the notice of opposition to be amended.)

Decision: **Opposition dismissed with prejudice.** In analyzing the relevant *duPont* factors, the Board found that the only similarity between the marks was the term "loft," and use of that suggestive term "alone is not sufficient to support a finding that the marks GORILLA LOFT and HYLOFT are similar." Therefore, despite the identity of the goods, the Board ruled that the dissimilarity of the marks outweighed all other *duPont* factors and it dismissed the Section 2(d) claim.

Fame: Opposers claimed that their mark is famous for Section 2(d) purposes, but they failed to provide sufficient proof. Opposers' only admissible evidence of fame consisted of media references, but no evidence as to the circulation of that media and no sales or advertising figures. "On this record, we have no basis to find that consumers have been widely exposed to the HYLOFT mark, or that the mark has otherwise become widely known."

Furthermore, Opposers could not prevail on their dilution claim as they failed to prove fame for purposes of Section 2(d). Therefore, Opposers could not meet the higher fame standard for dilution.