

This Opinion is Not a  
Precedent of the TTAB

Hearing: February 6, 2020

Mailed: April 10, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*The Christian Broadcasting Network, Inc.*

*v.*

*Delicious Ltd.*  
—

Opposition No. 91240654  
—

Patrick J. Arnold Jr. and Bryce R. Persichetti of McAndrews, Held & Malloy, Ltd.,  
for The Christian Broadcasting Network, Inc.

Lynn E. Rzonca and Jessica H. Watkins of Ballard Spahr LLP,  
for Delicious Ltd.

—  
Before Zervas, Wolfson, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Delicious Ltd. (“Applicant”) seeks registration on the Principal Register, through the extension of the protection of International Registration No. 1322001, of the standard character mark BCBN for the following goods (the “Goods Application”):

- Cosmetics, perfume, hair lotions, soaps, essential oils, in International Class 3;

- Computer software for use in organizing and viewing digital images, photographs, videos, podcasts, for image processing, for creating, organising,<sup>1</sup> editing and listening to music, for creating, sending and receiving messages, for database management, for games, for digital animation and special effects of images; application software for smartphones and tablets for use in organizing and viewing digital images, photographs, videos, podcasts, for image processing, for creating, organising, editing and listening to music, for creating, sending and receiving messages, for database management, for games, for digital animation and special effects of images; prerecorded CD's and DVD's featuring music and recorded information and podcast in the field of bullying prevention; apparatus for the transmission of sound or images; computer and smartphone hardware and accessories, namely, covers, keyboards, stands and screen savers software, in International Class 9;
- Jewellery, costume jewellery, precious stones; key rings of precious metal; badges of precious metal; clocks and watches, in International Class 14;
- Paperdolls in book form, namely, book in the field of bullying prevention, education and entertainment; printed publications namely, brochures, booklets, books, magazines in the field of bullying prevention, education or entertainment; newsletters in the field of bullying prevention, education or entertainment; posters; cards, namely, business cards, greeting cards, postcards, collectible cards, trading cards; stickers; badges made of paper; calendars; stationery; paper labels; printed certificates; printed teaching materials in the field of bullying prevention, education or entertainment; promotional material namely paper and cardboard, in International Class 16;
- Clothing, namely, pants, trousers, t-shirts, shirts, stockings, tights, jackets, coats, jeans, skirts, dresses, pyjamas, jumpers, shorts, sweatshirts, socks, lingerie, underwear, gloves, scarves, belts, head wraps, caps, hats, hoodies, jerseys, knitwear in the nature of sweaters, shirts, scarves, caps and hats, sweatpants, neck warmers; sports clothing, namely, bras, hats, singlets, pants, t-shirts, shirts with short sleeves, jackets, skirts, jumpers, shorts, vests, sweatshirts, boots, coats, tops, leggings; baby clothing, namely, pants, t-shirts, shirts, jackets, jeans, skirts, dresses, pyjamas, jumpers, shorts, sweatshirts, socks, gloves, scarves, bodysuit, one-piece garments, swaddling clothes; business clothing, namely, pants, trousers, suits, t-shirts, shirts, jackets, skirts, dresses, blouses, blazers, jumpers, sweatshirts, gloves, scarves, ties, footwear, belts, swimwear, stockings, t-shirts, tops, jeans, pyjamas, shorts, socks, lingerie, headgear, namely, hats, caps, toques, bandanas, headbands, in International Class 25; and

---

<sup>1</sup> International Registration No. 1322001 uses British English.

- Games and playthings, namely, games in the nature of board games, video game machines, card games, educational board games and card games for children; soft toys, namely, soft sculpture toys; balloons; playing cards; dress up dolls; sporting articles, namely, sport balls, sport gloves for baseball, softball, and cricket, sports bats, golf clubs, lift weights, personal exercise mats, rackets, sport guards, namely, knee guards, leg guards, body protectors, and elbow protectors,” in International Class 28;<sup>2</sup>

and the following services (the “Services Application”):

- Charitable fund raising namely, charitable collections, management and monitoring of charitable funds; trustee services, in International Class 36;
- Chatroom services, namely, providing Internet chatrooms, providing online chatrooms for social networking; communication by electronic communications networks on social media platforms for social networking, in International Class 38; and
- Education relating to children, namely, conducting classes, seminars and instructions in the field of bullying prevention or promoting friendliness; gaming services, namely, providing online computer games and lottery services; entertainment, namely, in the nature of variety television shows, live musical concerts, theatre, talent shows, reality shows; organizing sporting and cultural activities, in International Class 41.<sup>3</sup>

The Christian Broadcasting Network, Inc. (“Opposer”) opposes both applications, but on different grounds. With respect to the Services Application, Opposer claims, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), that Applicant’s BCBN mark so resembles Opposer’s registered and common law CBN mark as to be likely, when used in connection with the identified services, to cause confusion, to cause mistake, or to deceive prospective consumers. With respect to the Goods Application, Opposer claims, under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), that

---

<sup>2</sup> Application Serial No. 79197514 was filed on March 3, 2016 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f), on the basis of International Registration No. 1322001.

<sup>3</sup> Application Serial No. 79975367 was filed on March 3, 2016 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f), on the basis of International Registration No. 1322001.

its CBN mark is famous and that Applicant's use of its BCBN mark in connection with the identified goods is likely to dilute the famous CBN mark by blurring.<sup>4</sup>

The case is fully briefed,<sup>5</sup> and counsel for the parties appeared at an oral hearing before the panel on February 6, 2020. We sustain the opposition to the Services Application, and dismiss the opposition to the Goods Application.

## I. The Record

The record includes the pleadings,<sup>6</sup> the application file histories of the Services Application and the Goods Application, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following materials submitted by the parties:

### Opposer:

- The testimony declaration of Gordon Robertson, Opposer's Chief Executive Officer, and Exhibits 1-15 thereto, 9 TTABVUE;<sup>7</sup>

---

<sup>4</sup> Opposer originally asserted a Section 2(d) claim against both applications in its Consolidated Notice of Opposition, but did not pursue that claim against the Goods Application in its main brief. Opposer's counsel confirmed at the oral hearing that it is relying solely on dilution against the Goods Application. Opposer has waived its claim of likelihood of confusion in the Goods Application and this claim is given no further consideration. *See, e.g., Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013); *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer was deemed to have waived the claim).

<sup>5</sup> Citations in this opinion to the briefs and the record refer to TTABVUE, the Board's online docketing system. *Turbin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

<sup>6</sup> Applicant denied the salient allegations of Opposer's Consolidated Notice of Opposition, and interposed various purported affirmative defenses that are essentially amplifications of its denials.

<sup>7</sup> We will cite all testimony declarations by paragraph and exhibit number (e.g., "Robertson Decl. ¶ 10; Ex. 8").

- The testimony declaration of Mihai Bocarnea, Ph.D., Opposer's Vice President of Research, and Exhibits 16-24 thereto, 8 TTABVUE;<sup>8</sup>
- Opposer's First Notice of Reliance and Request to Take Judicial Notice, and Exhibits 1-3 thereto, 6 and 13 TTABVUE;<sup>9</sup>
- Opposer's Second Notice of Reliance and Request to Take Judicial Notice, and Exhibit 1 thereto, 10 TTABVUE; and
- Opposer's Rebuttal Declaration of Dr. Bocarnea, and Exhibits 25-27 thereto, 23-24 TTABVUE.<sup>10</sup>

**Applicant:**

- Applicant's Notice of Reliance, and Exhibits 1-2 thereto, 21 TTABVUE;
- The testimony declaration of Gerry DeVeaux, Applicant's Director, and Exhibits A-M thereto, 22 TTABVUE;
- The cross-examination deposition of Mr. Robertson, and Exhibits 1-11 thereto, 25 TTABVUE;<sup>11</sup> and

---

<sup>8</sup> Dr. Bocarnea's testimony declaration was submitted in both redacted and unredacted versions. The publicly available version is at 8 TTABVUE, and the confidential version is at 7 TTABVUE.

<sup>9</sup> The body of Opposer's First Notice of Reliance was omitted from the filing at 6 TTABVUE, which contains only the exhibits thereto. The body of the First Notice of Reliance appears at 13 TTABVUE.

<sup>10</sup> This declaration was also submitted in both redacted and unredacted versions. The publicly available version is at 23 TTABVUE, and the confidential version is at 24 TTABVUE.

<sup>11</sup> We will cite all deposition transcripts by page, line, and exhibit number (e.g., "Robertson Tr. 14:22-15:5; Ex. 1").

- The cross-examination deposition of Dr. Bocarnea, and Exhibit 12 thereto, 26-27 TTABVUE.<sup>12</sup>

## II. Evidentiary Issue

Before turning to the merits of the opposition, we address Opposer's request in its First Notice of Reliance "that the Board take judicial notice of the fact that it is common for television broadcasting companies to combine new letters with its [sic] main trademark in connection with affiliated television broadcasts," 13 TTABVUE 7, and its request in its Second Notice of Reliance "that the Board take judicial notice of the fact that it is common for companies, including television broadcasting companies, to have a social media presence on social media such as Facebook, Twitter, and Instagram." 10 TTABVUE 2.<sup>13</sup> The parties briefed the propriety of Opposer's requests, 18-19 TTABVUE, but the Board deferred decision on them until final hearing. 20 TTABVUE 1-2.

Rule 201 of the Federal Rules of Evidence, which applies in Board inter partes proceedings under Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a), governs the taking of judicial notice. Rule 201(b) provides that a tribunal "may judicially notice a fact that is not subject to reasonable dispute because it: (1) is generally known within the [tribunal's] territorial jurisdiction; or (2) can be accurately and readily determined

---

<sup>12</sup> Dr. Bocarnea's deposition transcript was submitted in both redacted and unredacted versions. The publicly available version is at 26 TTABVUE, and the confidential version is at 27 TTABVUE.

<sup>13</sup> Opposer attached what it described as "examples" of the alleged facts to each Notice of Reliance, 6 TTABVUE 82-225; 10 TTABVUE 5-144, and stated that it intended to rely on those examples under its Notices of Reliance. 13 TTABVUE 7; 10 TTABVUE 2-3.

from sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b). *See generally Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1692-93 (Fed. Cir. 2018) (discussing the taking of judicial notice in Board proceedings); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 704.12(a) & nn.1-2 (June 2019) (discussing the kinds of facts that may be judicially noticed, and collecting cases in which the Board has taken, or declined to take, judicial notice of facts).

Applicant argues that the facts of which Opposer requests we take judicial notice “are not judicially noticeable for several reasons.” 18 TTABVUE 3. With respect to the alleged fact that it is common for television broadcasting companies to combine letters with their “main” trademarks, Applicant argues that the “Board must first find that the companies referenced in Opposer’s exhibits have trademark rights in a ‘main trademark’ and that the public is aware of such,” and that the “classification [of] trademarks as ‘main trademarks’ is outside the purview of the Board’s authority under F.R.E. 201.” *Id.* at 4. Applicant claims that “[i]n trademark cases, judicial notice is limited to obvious facts about consumer perception.” *Id.* Applicant also argues that “the Board must find that the public is aware of the connection between each television broadcasting company and its affiliated network,” *id.*, and that there is “no evidence that the relationships among the referenced third-party entities is commonly known by the public.” *Id.* at 4-5. Applicant concludes that the Board “itself cannot determine, by looking at how three companies use their trademarks, what is or is not ‘common’ in the entire industry.” *Id.* at 5.

With respect to the alleged fact that it is common for companies, including television broadcasting companies, to have a social media presence, Applicant argues that the Board cannot “make an assumption about what is common not just in the television broadcasting industry, but for ‘companies’ in general, based on exhibits demonstrating the social media habits of three entities and their alleged affiliates.”

*Id.* at 6.

Finally, Applicant argues that “Opposer’s requests for judicial notice would still be improper because Opposer has not submitted appropriate evidence on which the Board may rely” because “the Board does not take judicial notice of website content.”

*Id.* Applicant concludes that “[t]here is no reason the Board should depart from its longstanding practice of finding websites and website content not judicially noticeable because of the inability of this material to support actual, indisputable facts.” *Id.* at 7.

Opposer responds that “[w]hether a practice is common in an industry is precisely the kind of fact that has been and may be judicially noticed.” 19 TTABVUE 4. Opposer cites cases in which the Board has judicially noticed “that it is a common practice for manufacturers to apply both a house mark and a product mark to their various items of merchandise,” *France Denney, Inc. v. ViVe Parfums Ltd.*, 190 USPQ 302, 304 (TTAB 1976) (quoting *Textron Inc. v. Cardinal Eng’g Corp.*, 164 USPQ 397, 399 (TTAB 1969)), “that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life,” *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1886 (TTAB 2008), and that because “famous marks are frequently used on certain



types of items, such as clothing, glassware, trash cans, pillows, etc., which are unrelated in nature to those goods on which the marks are normally used, such use has become part of everyday life which we cannot ignore.” *Gen. Mills Fun Grp., Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396, 400 & n.5 (TTAB 1979),<sup>14</sup> *aff’d*, 648 F.2d 1335, 209 USPQ 986 (Fed. Cir. 1981).

Opposer argues specifically that the “primary trademarks” of broadcasters such as CBS, NBC, and ESPN are familiar to almost every person in the United States, 19 TTABVUE 5, and that “the consuming public would have little difficulty understanding that a relationship exists in affiliated television broadcasts under slightly amended marks, i.e., CBS with CBSSN; MSNBC, CNBC and NBCSN with NBC, and ESPNU with ESPN.” *Id.* at 6. Opposer also argues that it is unreasonable to “suggest that the public is unaware of social media, such as Facebook, Instagram, and Twitter, or that the public is unaware of the fact that broadcasting companies, such as CBS, NBC, and ESPN—and just about every other company in business these days—have social media presences.” *Id.* Opposer dismisses Applicant’s argument that the Board does not judicially notice websites because the cases on which Applicant relies “relate to instances where the website content was not properly submitted into evidence, and the party then requested that the Board take judicial notice of the website content,” *id.* at 7, and because Opposer “is not requesting that

---

<sup>14</sup> A dissenting panelist argued that the display of famous trademarks on collateral merchandise was not a proper subject for judicial notice because “[i]f the practice exists on the scale which the majority assumes, it should have been a relatively simple matter for a well-financed and expertly counseled opposer to prove,” and because “[j]udicial notice is not taken of business operations or the manner in which goods are promoted or advertised . . . .” *Gen. Mills Fun Grp.*, 204 USPQ at 402 (Kera, Member, dissenting).

the Board take judicial notice of the website content, but rather of the facts” regarding the alleged industry practices. *Id.* at 8.

The Federal Circuit has held that “[u]nder Federal Rule of Evidence 201(b)(2), a tribunal ‘may judicially notice a fact that is not subject to reasonable dispute because it . . . can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.’” *Omaha Steaks*, 128 USPQ2d at 1692. Unlike the industry practices regarding mark usage judicially noticed by the Board in the *France Denney*, *L.C. Licensing*, and *Gen. Mills Fun Grp.* cases cited by Opposer, we find that the existence of the alleged industry practice that it is “common for television broadcasting companies to combine new letters with its [sic] main trademark in connection with affiliated television broadcasts,” 13 TTABVUE 7, is subject to reasonable dispute, and must be left to proof.<sup>15</sup> Similarly, although social media have “become a part of everyday life,” *L.C. Licensing*, 86 USPQ2d at 1886, for many companies, we cannot say that there is no reasonable dispute that it is “common for companies, including television broadcasting companies, to have a social media presence on social media such as Facebook, Twitter, and Instagram.” 10 TTABVUE 2. *Cf. In re Medline Indus., Inc.*, 2020 USPQ2d 10237, \*2-3 (TTAB 2020) (even if the existence of various shades of green were an “elemental fact,” Board declined to take judicial notice of the “nature and number of those shades” because the existence of such shades was not a fact that was not subject to reasonable dispute). We decline to

---

<sup>15</sup> Opposer properly made of record evidence of the existence of this alleged practice under its notices of reliance, and we will consider that evidence for whatever probative value it may have.

take judicial notice that it is “common for companies, including television broadcasting companies, to have a social media presence on social media such as Facebook, Twitter, and Instagram.” 10 TTABVUE 2, and again leave Opposer to its proof.<sup>16</sup>

### **III. Factual Background<sup>17</sup>**

#### **A. Opposer’s Business and Marks**

Opposer began operations in 1961 as the Christian Broadcasting Network. Robertson Decl. ¶ 2. Mr. Robertson testified that Opposer “is, at its core, a television production company that produces a variety of television and internet programs for distribution in the United States and all over the world as well.” Robertson Decl. ¶ 2. He described Opposer’s mission as “providing television and internet programs which provide hope and peace and give education and instruction - all with a view that is informed by Christian values and morals.” Robertson Decl. ¶ 2. Opposer’s mission statement on its website reads as follow:

The mission of CBN and its affiliated organizations is to prepare the United States of American and the nations of the world for the coming of Jesus Christ and establishment of the Kingdom of God on earth. Our ultimate goal is to achieve a time in history when “the knowledge of the Lord will cover the earth as the waters cover the sea.”

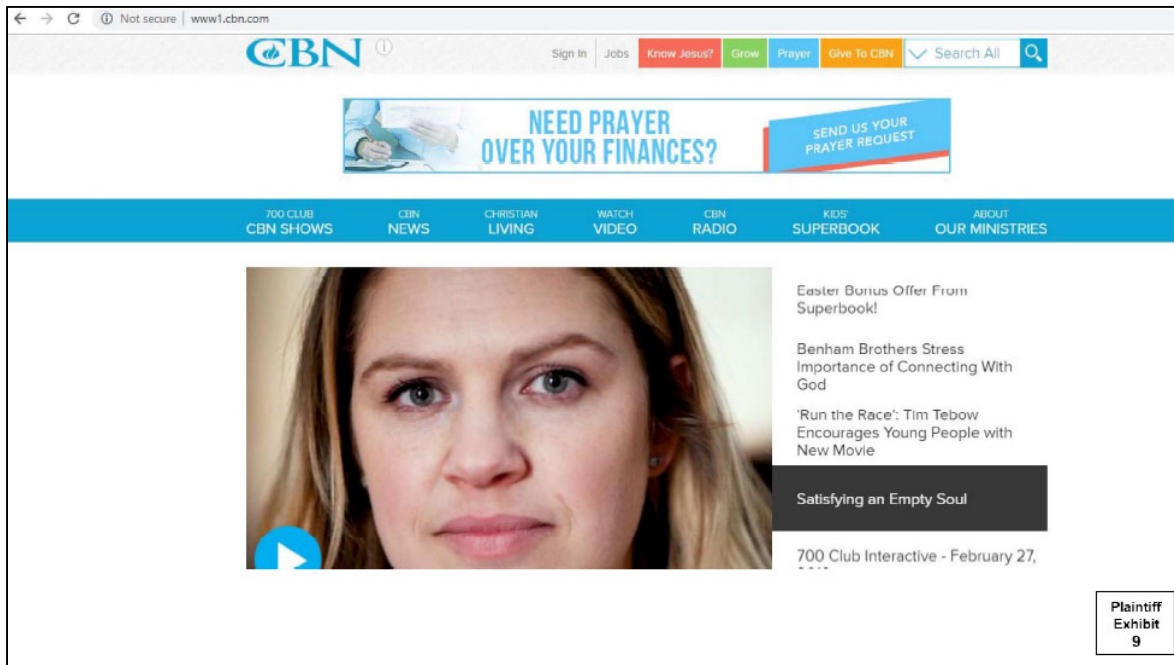
Robertson Tr. 14:22-15:23; Ex. 1.

---

<sup>16</sup> Opposer again properly made of record evidence of the existence of the alleged fact under its notices of reliance, and we will consider that evidence for whatever probative value it may have.

<sup>17</sup> This section contains a general discussion of the parties and their respective businesses and marks. We make additional factual findings below in connection with specific issues.

Mr. Robertson testified that Opposer’s website at cbn.com displays “the various pieces by which CBN carries out its mission.” Robertson Decl. ¶ 11; Ex. 9. We reproduce below the referenced page from the website:



The category links on Opposer’s masthead permit visitors to access Opposer’s flagship television program, The 700 Club, and other television shows and videos, news programs, articles regarding Christian living, Christian music stations, an animated series for children entitled “Superbook,” and ministries for prayer, counseling, and humanitarian aid. Robertson Decl. ¶ 11. Opposer also has a social media presence on Facebook, Instagram, Twitter, YouTube, and Pinterest, Robertson Decl. ¶ 11, and communicates with the public through mailers and emails. Robertson Decl. ¶ 14.

Opposer’s flagship television show is “The 700 Club,” Robertson Decl. ¶ 15, which has aired Monday through Friday for nearly 60 years. Robertson Decl. ¶ 15. Each show begins with a visual and oral statement that “the following programming is

presented to you by CBN.” Robertson Decl. ¶ 15. Opposer receives revenues from contributions, Bocarnea Decl. ¶¶ 5-6; Exs. 16-17,<sup>18</sup> the bulk of which go for production of television shows. Robertson Tr. 80:21-81:2.

Opposer owns various registrations of the mark CBN in standard characters, including Registration No. 1108225 for “television broadcasting services and entertainment services in the nature of televised religious, educational, news, and variety programs,” Robertson Decl. ¶ 3; Ex. 1, and Registration No. 5286207 for “charitable fundraising.” Robertson Decl. ¶ 7; Ex. 5.<sup>19</sup> Mr. Robertson testified that the CBN mark has been in use with the television broadcasting and entertainment services continuously since 1969, Robertson Decl. ¶ 3, and with the charitable fundraising services continuously since 1961. Robertson Decl. ¶ 7.

### **B. Applicant’s Business and Mark**

Applicant’s Director Gerry DeVeaux testified that Applicant operates what he identified as the “BE COOL BE NICE” campaign, which he explained “is a secular, international, anti-bullying cyber movement that encourages kindness, civility, and good manners among children and young people.” DeVeaux Decl. ¶ 2. He testified that the applied-for mark BCBN “is an abbreviation for ‘Be Cool Be Nice’” and has been used in connection with the campaign since at least as early as 2016. DeVeaux

---

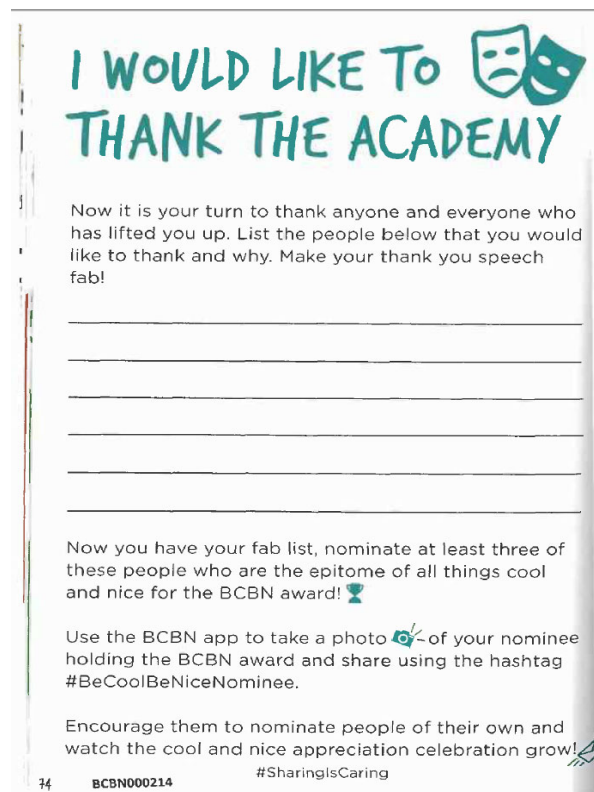
<sup>18</sup> The specific amounts were designated as confidential, but we have reviewed them and they appear to be substantial.

<sup>19</sup> Status and title copies of these and the other registrations attached as exhibits to Mr. Robertson’s declaration were made of record under Opposer’s First Notice of Reliance. 6 TTABVUE 3-29. We discuss them below.

Decl. ¶ 3. He testified that “the mark BCBN™ is used in conjunction with the phrase BE COOL BE NICE™” and “in proximity to the BE COOL BE NICE™ mark in many of the Campaign’s materials.” DeVeaux Decl. ¶ 13. We reproduce below a few examples of use of the applied-for mark, alone or in connection with BE COOL BE NICE, which are attached to Mr. DeVeaux’s declaration:



DeVeaux Decl. ¶ 4; Ex. A.



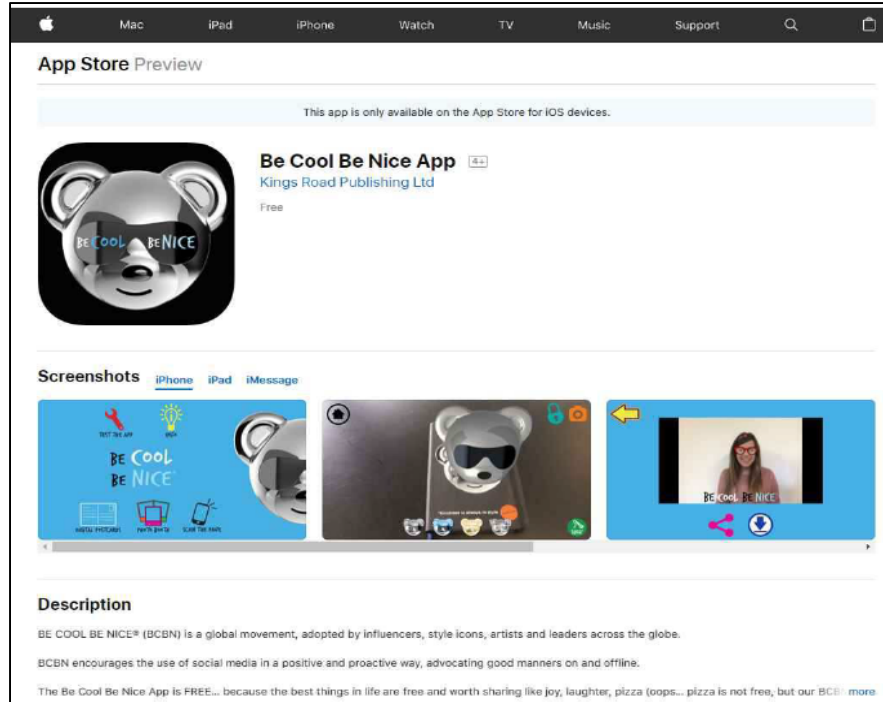
DeVeaux Decl. ¶ 4; Ex. A.



DeVeaux Decl. ¶ 4; Ex. A.



DeVeaux Decl. ¶ 4; Ex. A.



DeVeaux Decl. ¶ 11; Ex. H.

Mr. DeVeaux testified that the Be Cool Be Nice campaign “does not have, and never has had, any religious focus and specifically does not wish to have a religious focus,” and that it “is a secular movement that aims to instill in children the means to be kind and considerate in a world where social media can render even the most basic interactions impersonal.” DeVeaux Decl. ¶ 6. He made of record a copy of the campaign book entitled *Be Cool Be Nice*, and various materials from social media regarding the campaign, DeVeaux Decl. ¶¶ 8-9; Exs. D-G, and he testified that a number of celebrities, including Kendall Jenner, Willow Smith, Marc Jacobs, and Lenny Kravitz, have associated themselves with the campaign. DeVeaux Decl. ¶ 15.

#### IV. Standing

A threshold issue in every inter partes case is the plaintiff’s standing to challenge registration. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.2d 1270, 111



USPQ2d 1058, 1062 (Fed. Cir. 2014). “To have standing, a plaintiff must have a real interest, i.e., a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged” by registration of the involved mark. *TiVo Brands, LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1102-03 (TTAB 2018) (citing *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 and *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999)).

Neither party discusses standing, but Opposer made of record multiple registrations of its CBN marks from the USPTO’s Trademark Status & Document Retrieval (“TSDR”) database showing active status and title in Opposer, and those registrations give Opposer a real interest in this proceeding and a reasonable belief of damage from registration of Applicant’s mark, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000), based on a likelihood of confusion claim that is not wholly without merit. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Because Opposer has established its standing to assert its Section 2(d) claim, it has standing to pursue its dilution claim as well. *See, e.g., Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011).

#### **V. Likelihood of Confusion Claim Regarding the Services Application**

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with

the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its § 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its marks and that Applicant’s use of its mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of the services identified in the Services Application. *Cunningham*, 55 USPQ2d at 1848.

### **A. Priority**

Neither party addresses priority, but because Opposer’s pleaded registrations are of record, and Applicant did not counterclaim to cancel them, priority is not at issue with respect to the services identified in the registrations. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

### **B. Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (*DuPont* “articulated thirteen factors to consider when determining likelihood of confusion”). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered,” *id.* (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)), but all factors “‘must be considered’ when [they] are of record.” *In re Guild Mortg. Co.*, 912 F.3d

1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (internal quotation omitted)).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). Opposer discusses these two key factors, 28 TTABVUE 9-15, together with all but two of the other eleven factors, *id.* at 12-13, including the alleged fame of its CBN marks, under the fifth *DuPont* factor, *id.* at 6-9; the established, likely-to-continue trade channels, under the third *DuPont* factor, *id.* at 15-17; the sophistication of the relevant purchasers, under the fourth *DuPont* factor, *id.* at 17-18, the absence of similar marks in use, under the sixth *DuPont* factor, *id.* at 18-19; the absence of instances of actual confusion, under the seventh and eighth *DuPont* factors, *id.* at 19-20; Opposer’s use of its marks in connection with a variety of goods and services, under the ninth *DuPont* factor, *id.* at 20-21; Opposer’s enforcement of its marks, under the eleventh *DuPont* factor, *id.* at 21-22; and the extent of potential confusion, under the twelfth *DuPont* factor. *Id.* at 22-23.

Applicant argues that “the factors most germane to the analysis of likelihood of confusion are the dissimilarity of the parties’ offerings under their respective marks and their commercial context (particularly considering Applicant’s consumer base of children),” and “the dissimilarity of the marks in their entirety,” as well as “the

narrow scope of Opposer's alleged fame of its CBN mark and its narrow right to exclude others; and the absolute lack of evidence of actual consumer confusion, despite concurrent use and the fame Opposer alleges." 29 TTABVUE 8.

### 1. The Fifth *DuPont* Factor

We begin with the fifth *DuPont* factor, which involves the "fame of the prior mark (sales, advertising, length of use)." *DuPont*, 177 USPQ at 567. The fifth factor considers the commercial strength of a mark, that is, "the extent to which 'a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.'" *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (quoting *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017)). As the Federal Circuit has explained, "[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards*, 122 USPQ2d at 1734 (quoting *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)). Opposer argues that its CBN mark is famous for purposes of both its likelihood of confusion claim and its dilution claim, 28 TTABVUE 14-16, 30-33, but we must analyze the claims of fame separately.

"Fame of an opposer's mark, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors.'" *Palm Bay Imps.* 73 USPQ2d at 1694 (quoting *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). "A mark 'with extensive public recognition and renown deserves and receives more legal

protection than an obscure or weak mark.” *Omaha Steaks*, 128 USPQ2d at 1689 (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)).

In *Christian Broad. Network, Inc. v. ABS-CBN Int’l*, 84 USPQ2d 1560, 1567 (TTAB 2007) (“*ABS-CBN*”), a cancellation proceeding under Section 2(d) against a registration of the mark “ABS-CBN” for television broadcasting services and telephone calling card services, the Board found that “the CBN mark is famous for television broadcasting services and evangelical services, and therefore is entitled to a wide scope of protection.” The Board made its fame finding

[b]ased on the facts that petitioner’s programming is regularly viewed in 16% of the homes in the United States, that its viewership is nearly twice that of MSNBC and CNN (except for LARRY KING LIVE and the show following LARRY KING LIVE), that petitioner has had substantial revenues and advertising expenses, and that the CBN mark is prominently displayed in all of petitioner’s activities . . . .

*Id.*

Opposer argues that the mark remains famous for television broadcasting services,<sup>20</sup> pointing to “the exemplary evidence made of record again, and

---

<sup>20</sup> The Board found in *ABS-CBN* that the mark was also famous for what the Board described as “evangelical services.” *ABS-CBN*, 84 USPQ2d at 1567. Here, as discussed below, Opposer made of record six registrations of its mark, including Registration No. 2987580 for “Christian evangelical ministerial services including outreach, counseling, and discipleship,” Robertson Decl. ¶ 4; Ex. 2, but relies on only three of the registrations (not including Registration No. 2987580), which Opposer argues “are sufficient to demonstrate the likelihood of confusion and dilution present in this case.” 28 TTABVUE 10. The record does not contain sufficient evidence regarding the use of Opposer’s mark for the services identified in Registration No. 2987580 to enable us to determine whether the mark is famous today for those services.

supplemented for the passage of time, in the present case.” 28 TTABVUE 14. Opposer relies on more than 50 years of use of the mark; sales, advertising, and revenue figures relating to the mark; the extent of the mark’s exposure through the viewing of Opposer’s television programs, including its flagship program, The 700 Club; the number of visitors to Opposer’s website at [cbn.com](http://cbn.com); and its communications to the public under the mark in the form of mailers and emails. *Id.* at 14-15.

Applicant neither expressly concedes the fame of Opposer’s CBN mark for likelihood of confusion purposes, nor expressly disputes it. Under the argument heading “***Opposer’s exclusivity is, at best, limited to the field of evangelical services,***” 29 TTABVUE 12 (emphasis in original), Applicant argues that the Board’s finding of fame in the *ABS-CBN* case “was limited to fame in the context of ‘television broadcasting services and evangelical services,’ and there is no record evidence showing that Opposer’s alleged fame has expanded beyond that segment.” *Id.* Applicant proceeds to argue that Opposer’s alleged fame is limited to its Christian-centric audience and mission. *Id.* at 12-13. These arguments, which conclude with a citation of the definition of dilution fame in Section 43(c)(2)(A) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(A), *id.* at 13, essentially address dilution fame, and Applicant refers back to them in its argument against dilution fame later in its brief. *Id.* at 18. But even if Applicant does not clearly dispute the fame of Opposer’s CBN mark for likelihood of confusion purposes, Opposer, as the party asserting fame, “must clearly prove it,” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353

(TTAB 2014), in order for us to weigh the fifth *DuPont* factor in Opposer's favor, and we will examine the record to determine whether Opposer has carried that burden.

“Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion,” *Omaha Steaks*, 128 USPQ2d at 1689 (quoting *Bose Corp. v. QSC Audio Prods, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)), and Opposer offers no such evidence here. But “the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods [and services] traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Id.* at 1689-90 (quoting *Bose*, 63 USPQ2d at 1305). Opposer offers such evidence in the form of the testimony of Mr. Robertson and Dr. Bocarnea.

Opposer has operated under the CBN mark since 1961, Robertson Decl. ¶ 3, and the mark has been in use with television broadcasting continuously since 1969, a period of some 50 years. Robertson Decl. ¶ 3. The 700 Club show, which begins with visual and spoken uses of the CBN mark and includes other exposure of the mark, has aired every weekday during that period, Robertson Decl. ¶ 15, which includes more than a dozen additional years since the *ABS-CBN* decision.

Dr. Bocarnea, who has been employed by Opposer in various research capacities since 1994, Bocarnea Decl. ¶ 1, testified based on his review of testimony given in the *ABS-CBN* case by Opposer's then-acting Vice President of Marketing, John Turver,<sup>21</sup>

---

<sup>21</sup> Dr. Bocarnea testified that he worked for Mr. Turver at the time, Bocarnea Tr. 9:15-22, and that he checked the information to which Mr. Turver testified. Bocarnea Tr. 8:10-9:3, 15-22.

and his review of Opposer's historic and current business records. Bocarnea Decl. ¶¶ 1-2. He confirmed Mr. Turver's testimony that as of 2006, The 700 Club could be seen in 96% of U. S. households, and the daily average audience for the show was over one million viewers, which represented approximately 17 million unique households monthly and approximately 16% of the homes in the United States. Bocarnea Decl. ¶ 3b. *ABS-CBN*, 84 USPQ2d at 1567. He further confirmed that in 2006, Opposer's website at *cbn.com* received approximately 1.5 million unique user sessions per month, and that Opposer sent out about 20 million pieces of mail per year displaying the CBN mark. Bocarnea Decl. ¶ 3d-e.

Dr. Bocarnea testified that the "activities and viewer information about which Mr. Turver testified in 2006 have not only continued unabated but have grown considerably." Bocarnea Decl. ¶ 4. He testified that as of 2018, Opposer's programming could be seen in 97% of U.S. households, Bocarnea Decl. ¶ 4a, and that its most popular shows, *The 700 Club* and *The 700 Club Interactive*,<sup>22</sup> were seen by a daily average audience of about 650,000 U.S. households. Bocarnea Decl. ¶ 4b. We note that this is not an apples-to-apples comparison to the 2006 figure of daily viewership of "over one million viewers," Bocarnea Decl. ¶ 3b, but in our view it likely represents an increase in total daily viewers because, as discussed below in our analysis of Opposer's claim of dilution fame, the 2010 U.S. Census identified an average of 2.58 persons per U.S. household.

---

<sup>22</sup> The exact nature of *The 700 Club Interactive* is unclear from the record. Robertson Tr. 82:12-20. The Board discussed only *The 700 Club* in *ABS-CBN*. *ABS-CBN*, 84 USPQ2d at 1563.



Dr. Bocarnea also testified that in 2018 Opposer's programming was syndicated on more than 90 U.S. TV stations, and could also be seen on smartphones, tablets, and smart TVs, Bocarnea Decl. ¶ 4c, and that Opposer's multiple websites received about 4.7 million unique visitors per month, also an increase from the comparable 2006 figure pertaining to the *cbn.com* website alone. Bocarnea Decl. ¶ 4d. Finally, he testified that in 2018 Opposer sent out about 14.5 million pieces of mail bearing the CBN mark, a decrease from the comparable 2006 figure, but one that was more than offset by the fact that Opposer sent out more than 220 million emails. Bocarnea Decl. ¶ 4e. Mr. Robertson testified similarly and provided numerous examples of Opposer's written communications. Robertson Decl. ¶ 14; Ex. 14.

Dr. Bocarnea also testified about Opposer's revenue and advertising figures. He authenticated a chart that was introduced in the *ABS-CBN* case, which he described as showing Opposer's "different sources of revenues for the fiscal years 2000 through 2005." Bocarnea Decl. ¶ 5; Ex. 16. The chart contains sections captioned (1) "Internet Media Revenue," which displays entries entitled "Sales Revenues," "Advertising Revenues," and "Other;" (2) "Operations Group Revenues," which displays entries entitled "Production/Studio Revenue," "Sales and Services," and "Rental Income;" (3) "Non-cash Airtime Revenues;" and (4) "Contribution Revenues," which displays entries entitled "Cash Contributions," "Trust and Gift Annuity Income," and "Non-cash Contributions including Donated Securities." Bocarnea Decl. ¶ 5; Ex. 16. By far the largest source of Opposer's revenues during this period were contributions, with the undefined "Non-cash Airtime Revenues" about half as large as contributions and

the other categories quite modest in comparison to contributions. Bocarnea Decl. ¶ 5; Ex. 16. Dr. Bocarnea also authenticated a chart showing Opposer’s total revenues for the period 1980-2018. The specific figures were redacted as confidential, but they are substantial, and reflect relatively steady growth and nearly a four-fold increase over that period. Bocarnea Decl. ¶ 6; Ex. 17.

With respect to advertising expenditures, Dr. Bocarnea authenticated charts showing figures from 1997-2005 (introduced in the *ABS-CBN* case) and from 2015 through January 31, 2019.<sup>23</sup> Bocarnea Decl. ¶¶ 7-8; Exs. 18-19. The earlier chart contains sections captioned (1) “Advertising Expenses, which displays entries entitled “Outdoor Transit Ads,” Radio/TV Ads,” Trade Show,” “Graphics for Ads,” “Advertising – Miscellaneous,” “Marketing Expenses,” and “Promotional Expenses;” (2) “Direct Marketing - Direct Mail Expenses,” which displays various mailing-related entries; (3) “Leased Lines and Satellite Fees,” which displays those entries; and (4) “Airtime Expenses,” which displays entitled “Affiliate Airtime” and “Non-cash Airtime – IFE and others.” Bocarnea Decl. ¶ 7; Ex. 18. Dr. Bocarnea explained that Opposer’s “advertising expenses for the years considered are separated as Advertising, Direct Mail, Leased Lines and Airtime costs.” Bocarnea Decl. ¶ 8. The specific figures in the categories were redacted as confidential, but they have remained substantial during the subject periods. Bocarnea Decl. ¶¶ 7-8; Exs. 18-19.

The Board found in 2007 that Opposer’s CBN mark was famous under the fifth *DuPont* factor, and on the basis of the record in this case, which shows increases in

---

<sup>23</sup> He did not provide figures for the period between 2005 and 2015.

many, but not all, of the metrics on which the Board relied in *ABS-CBN*,<sup>24</sup> we find that Opposer's CBN mark remains famous on the "spectrum from very strong to very weak," *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, for television broadcasting services. Opposer's CBN mark is entitled to a broad scope of protection, and the fifth *DuPont* factor supports a finding of a likelihood of confusion.

## 2. The Second and Third *DuPont* Factors

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,'" while the third *DuPont* factor considers "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of services in the Services Application and in Opposer's registrations. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

It is "not necessary that the [services] be identical or even competitive to support a finding of a likelihood of confusion." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). "[L]ikelihood of confusion can be found 'if the respective [services] are related in some manner and/or if the

---

<sup>24</sup> We note that there is no current comparison between the sizes of the audiences for The 700 Club program and for MSNBC and CNN programming that the Board cited in *ABS-CBN*, 84 USPQ2d at 1567, and, as discussed below in our dilution analysis, the record does not show that The 700 Club program is seen today by the same percentage of American households as in 2007.

circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* (quoting *7-Eleven*, 83 USPQ2d at 1724).

The Services Application covers the following services: (1) “Charitable fund raising namely, charitable collections; management and monitoring of charitable funds; trustee services,” in Class 36; (2) “Chatroom services, namely, providing Internet chatrooms, providing online chatrooms for social networking; communication by electronic communications networks on social media platforms for social networking,” in Class 38; and (3) “Education relating to children, namely, conducting classes, seminars and instructions in the field of bullying prevention or promoting friendliness; gaming services, namely, providing online computer games and lottery services; entertainment, namely, in the nature of variety television shows, live musical concerts, theatre, talent shows, reality shows; organizing sporting and cultural activities,” in Class 41.

As noted above, Opposer relies on three of its six pleaded registrations, which cover the following services: “television broadcasting services” and “entertainment services in the nature of televised religious, educational, news and variety programs,” 6 TTABVUE 3-10 (Registration No. 1108225); “educational services, namely, seminars, workshops and conferences in the fields of Christian living, finances, [and]

marriages,” *id.* at 11-15 (Registration No. 2087580);<sup>25</sup> and “charitable fundraising.” *Id.* at 23-26 (Registration No. 5286207).

Opposer argues that “[w]ith respect to the parties’ services in international classes 36 and 41, the services are legally identical,” 28 TTABVUE 16, and that the parties’ Class 38 services are closely related. *Id.* at 18-20. Applicant does not address the identifications of services in the application and Opposer’s registrations per se, and instead focuses exclusively on the parties’ actual uses of their marks. 29 TTABVUE 8-10. Applicant argues that “[p]erhaps the most striking thing distinguishing the source of the parties’ goods and services is the nearly antithetical contexts in which they are offered in the marketplace, and their resulting disparate consumers,” *id.* at 8; that “Opposer simply relies on an alleged overlap of goods [sic] in Classes 36, 38 and 41 – which does not decidedly tip the balance in Opposer’s favor, given the stark commercial differences between the parties’ uses of their marks,” *id.* at 10; that “Opposer’s mission and commercial activities under the CBN mark are defined by everything that Applicant and its BCBN™ mark are not,” *id.*; and that “[s]uch antithetical commercial endeavors strongly support the conclusion that, when encountering the parties’ marks in the marketplace, consumer confusion is highly unlikely.” *Id.*

In its reply brief, Opposer argues that Applicant’s “analysis is irrelevant in a case before the Board,” 30 TTABVUE 5, and that Applicant “has conceded, as it must, that

---

<sup>25</sup> Certain services have been deleted from the Class 41 identification in this registration, and there are additional services in the registration that are not relevant under the second *DuPont* factor.

the parties' services are legally identical with respect to international classes 35 [sic] and 41, and closely related with respect to international class 38." *Id.* at 5-6.

Applicant cannot resort to extrinsic evidence of its and Opposer's actual uses of their marks to restrict or limit the scope of its and Opposer's broad and unrestricted identifications of services. We must "focus on the application and registrations rather than on real-world conditions, because 'the question of registrability of an applicant's mark must be decided on the basis of the identification of [services] forth in the application.'" *Stone Lion*, 110 USPQ2d at 1162 (citing *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). "This is so 'regardless of what the record may reveal as to the particular nature of an applicant's [services], the particular channels of trade or the class of purchasers to which sales of the [services] are directed.'" *Id.* (quoting *Octocom*, 16 USPQ2d at 1787).

The broad "charitable fundraising" services identified in Opposer's Registration No. 5286207 encompass the narrower "charitable fundraising namely, charitable collections" services identified in the Services Application, and those services are thus legally identical. *See, e.g., In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006; *ABS-CBN*, 84 USPQ2d at 1567 ("television broadcasting services" encompass "television broadcasting services via satellite and cable"). The second *DuPont* factor strongly supports a finding of a likelihood of confusion as to the Class 36 portion of the Services Application.<sup>26</sup> Because there are no restrictions on channels of trade or

---

<sup>26</sup> We need not consider the similarity of each of the services identified in Opposer's registrations to each of the services identified in the three classes in the Services Application because registration may be refused as to an entire class in the application if likelihood of confusion exists as to any service in that class. *See, e.g., Double Coin Holdings Ltd. v. Tru*

classes of consumers in the parties' respective identifications of these legally identical services, we must also presume that the channels of trade and classes of consumers for the services are identical. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). The third *DuPont* factor also strongly supports a finding of a likelihood of confusion as to the Class 36 portion of the Services Application.

The services identified in Registration No. 1108225 as "entertainment services in the nature of televised religious, educational, news and variety programs" encompass the Class 41 services identified in the Services Application as "entertainment, namely, in the nature of variety television shows," and are legally identical. *See ABS-CBN*, 84 USPQ2d at 1567. The second *DuPont* factor strongly supports a finding of a likelihood of confusion as to the Class 41 portion of the Services Application. Because there are no restrictions on channels of trade or classes of consumers in the parties' respective identifications of these legally identical services, we must again presume that the channels of trade and classes of consumers for the services are identical, and the third *DuPont* factor also strongly supports a finding of a likelihood of confusion as to the Class 41 portion of the Services Application.

Applicant's Class 38 services cover "Chatroom services, namely, providing Internet chatrooms, providing online chatrooms for social networking; communication by electronic communications networks on social media platforms for social networking." Contrary to the gist of Applicant's arguments, the services of

---

*Dev.*, 2019 USPQ2d 377409, \*6 (TTAB 2019) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA (1981))).

“communication by electronic communications networks on social media platforms for social networking” are not limited to those involving, or directed to, children. Opposer argues that the “television broadcasting services” identified in Registration No. No. 1108225 are “closely related to the ‘communication by electronic communications networks on social media platforms for social networking’ because the public expects television broadcasters to have social media presences.” 28 TTABVUE 19. Opposer contends that “the general public would likely assume that the sources of the identified services are the same, as many (if not all) television broadcasting companies, including [Opposer], have social media presences.” *Id.* Opposer points to Mr. Robertson’s testimony, and Opposer’s Second Notice of Reliance, both of which reflect Opposer’s social media presence on Facebook, Instagram, YouTube, Twitter, and Pinterest, Robertson Decl. ¶ 11; 10 TTABVUE 6-11, as well as evidence that third-party television broadcasters are also active in social media. 10 TTABVUE 12-144.

As noted above, Applicant does not dispute the relatedness of the services as identified, only as actually rendered, and the record shows that many companies, including television broadcasters, have a presence on social media. The relatedness of television broadcasting services and social media communication is confirmed by the Services Application itself, because Applicant seeks registration of its mark for both “variety television shows” and various social media services, including “communication by electronic communications networks on social media platforms for social networking.” *See Octocom*, 16 USPQ2d at 1786 (that modems and computer



programs “might come from a single source is shown by [Octocom’s] original application, which indicates [Octocom] itself used the mark OCTOCOM for both modems and computer program”). The record also shows that Opposer and other television broadcasting companies engage in social media communications under their house marks. 10 TTABVUE 12-144. We find that Applicant’s Class 38 social media communication services are related to Opposer’s television broadcasting services, and the second *DuPont* factor thus supports a finding of a likelihood of confusion as to the Class 38 portion of the Services Application.

Because there are no restrictions on channels of trade or classes of consumers in Applicant’s Class 38 identification, we presume that the services travel through all usual channels of trade for such services to all usual consumers of them. *Tao Licensing*, 125 USPQ2d at 1062 (citing *Viterra*, 101 USPQ2d at 1908 and *Cunningham*, 55 USPQ2d at 1846). The record shows that the services identified as “communication by electronic communications networks on social media platforms for social networking” are consumed by the general public, who also consume television broadcasting services (sometimes simultaneously when television programming is streamed on social media platforms). The channels of trade and the classes of consumers for Applicant’s Class 38 services overlap with those for Opposer’s television broadcasting services, and the third *DuPont* factor supports a finding of a likelihood of confusion as to the Class 38 portion of the Services Application.

### **3. The First *DuPont* Factor**

“The first *DuPont* factor requires examination of ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial

impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, (No. 18-2236) (Fed. Cir. Sept. 13, 2019). The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

Our findings above on the second and fifth *DuPont* factors reduce the degree of similarity between the marks that is necessary for confusion to be likely. Because the Class 36 and 41 services are legally identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines” as to those services, *Cai*, 127 USPQ2d at 1801 (quoting *Viterra*, 101 USPQ2d at 1908 (internal quotation omitted)), and because we have found that Opposer’s CBN mark remains famous under the fifth *DuPont* factor, it “receives more legal protection than an obscure or weak mark.” *Omaha Steaks*, 128 USPQ2d at 1689 (quoting *Kenner Parker Toys*, 22 USPQ2d at 1456).

The nature of the marks here also affects our analysis under the first *DuPont* factor. “Several cases state that marks involving letter combinations are likely to be inherently difficult to remember and, therefore, consumers are more susceptible to confusion or mistake than with word marks.” *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1509 (TTAB 2007) (citing *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) and *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990)). See also *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 25 USPQ 5, 6-7 (CCPA 1935) (Z.B.T. held to be confusingly similar to T.Z.L.B.).

Opposer argues that the parties’ standard character marks CBN and BCBN “are quite similar as to sound and appearance” because “the only difference between the marks is the addition of the single letter ‘B’ before CBN.” 28 TTABVUE 20. With respect to the connotation and commercial impression of the marks, Opposer argues that “CBN,” the term common to the marks, is distinctive and incontestable, and that this increases the likelihood of confusion. *Id.* at 20-21. Opposer also invokes the principle that likelihood of confusion is often found where one mark incorporates the entirety of another mark, *id.* at 21, and argues that this principle applies with particular force here because “many television broadcasters combine new letters with their main trademarks for affiliated broadcasts,” including “CBS with CBSSN; NBC with MSNBC; CNBC with NBCSN; and ESPN with ESPNU.” *Id.* at 22. Opposer concludes that “the public is likely to assume that CBN has similarly added a letter

to the beginning of its main trademark, and therefore associate BCBN with the services already associated with the CBN mark.” *Id.*

Applicant argues that the marks “are facially dissimilar and have different pronunciations, further distinguishing them,” 29 TTABVUE 10, that “the ‘B’ in Applicant’s mark BCBN™ provides a sufficiently distinct dominant syllable that also alludes to the directive at the heart of Applicant’s campaign – ‘**BE** COOL BE NICE,’” *id.* at 10-11, and that the “‘B’ at the beginning of BCBN™ also provides an alliterative quality (**BCBN**) absent from Opposer’s mark.” *Id.* at 11.

Applicant also argues that “[i]n the same way that Applicant’s Mark is used in proximity to BE COOL BE NICE™ and understood to be an abbreviation thereof,” the mark “BCBN™ is inseparable from Applicant’s BE COOL BE NICE™ campaign and its vibrant, secular distinctiveness.” *Id.* According to Applicant, “[c]onsumers encountering Applicant’s mark BCBN™ in its commercial context will understand it to be part and parcel of the BE COOL BE NICE™ kids’ anti-bullying campaign.” *Id.*

Applicant further contends that even if the marks are similar in appearance and sound, they differ in connotation because of the “parties’ distinct offerings – Applicant’s social-media based campaign for kindness in which BCBN™ is intimately associated with BE COOL BE NICE™, versus Opposer’s Christian-focused broadcasting and related services . . . .” *Id.*

The parties’ standard character marks CBN and BCBN differ only by the addition of a second letter “B” in Applicant’s mark, and as the Board noted in *ABS-CBN*, “[l]ikelihood of confusion has frequently been found where one mark incorporates the

entirety of another mark.” *ABS-CBN*, 84 USPQ2d at 1568 (citing cases). This principle applies here for the reasons discussed below.

With respect to appearance, Applicant’s argument that the letter “B” at the beginning of its mark is a “sufficiently distinct dominant syllable,” 29 TTABVUE 11, is similar in nature to the argument made by the respondent in *ABS-CBN*, who claimed that the prefix “ABS [was] the dominant portion of its mark [ABS-CBN].” *ABS-CBN*, 84 USPQ2d at 1569. The Board rejected that argument because the hyphen between the letters ABS and CBN caused the CBN component of the ABS-CBN mark to stand “apart from ABS and [to make] a separate visual impact.” *Id.* No single letter dominates the marks here and Applicant’s mark is a four-letter string (BCBN) concluding with the same three letters that comprise Opposer’s CBN mark. Taking into account “the recollection of the average customer, who retains a general rather than specific impression of marks,” *i.am.symbolic*, 127 USPQ2d at 1630, we find that the presence of the single letter “B” at the start of the four-letter string BCBN in Applicant’s mark fails to distinguish the BCBN mark from the CBN mark in appearance. We find that BCBN is similar in appearance to CBN.

As to sound, the Board found in *ABS-CBN* that “consumers who would pronounce the marks [ABS-CBN and CBN] would do so by saying each individual letter, that is, all the letters will be spoken.” *ABS-CBN*, 84 USPQ2d at 1569. Because the marks here consists of letter strings without vowels, we similarly find that when the marks are verbalized, consumers would pronounce each letter in each mark (i.e., B-C-B-N and C-B-N). See *B.V.D. Licensing*, 83 USPQ2d at 1508 (agreeing with the opposer

that because the subject marks BVD and BHD lacked vowels, each letter in the marks must be spoken). The presence of the letter B at the start of the BCBN mark “and the need for those speaking the marks to speak each letter results in some difference in pronunciation, but that difference is not sufficient to outweigh the overall similarity in the structure of the letters,” *id.*, and the overall sound of the marks when verbalized. We find that the letter string “B-C-B-N” sounds similar to the letter string “C-B-N.”

Finally, with respect to the connotation and commercial impression of the marks, Applicant argues that “[e]ven where the marks are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity.” 29 TTABVUE 11 (quoting *Coach Servs.*, 101 USPQ2d at 1721). Applicant claims that the “parties’ distinct offerings – Applicant’s social-media based campaign for kindness in which BCBN™ is intimately associated with BE COOL BE NICE™, versus Opposer’s Christian-focused broadcasting and related services – necessitate a finding that their associated marks are unlikely to engender consumer confusion.” *Id.* Applicant also contends that its mark is “consistently used in proximity to BE COOL BE NICE™ and the vibrant, stylized illustrations that make up so much of Applicant’s campaign,” *id.* at 12, and that “[c]onsumers encountering Applicant’s Mark BCBN™ in its commercial context will understand it to be part and parcel of the BE COOL BE NICE™ kids’ anti-bullying campaign.” *Id.*

Opposer responds that “these arguments are irrelevant . . . based on the controlling law of this Board.” 30 TTABVUE 9. Opposer cites *Hercules Inc. v. Nat’l*

*Starch & Chem. Corp.*, 223 USPQ 1244 (TTAB 1984), in which the Board rejected the applicant's claims that the marks were dissimilar because the opposer used a generic term and its trade name with its registered mark, and the applicant used its trade name with its mark, holding that such elements were "relevant in a proceeding concerning registrability only if they are included as part of the mark as it is registered and as it is presented for registration." *Id.* (quoting *Hercules*, 223 USPQ at 1248). Opposer argues that "the application for BCBN does not include BE COOL BE NICE, and thus [Applicant's] arguments regarding BE COOL BE NICE are similarly irrelevant." *Id.*

Applicant's argument regarding the meaning of its mark is akin to the argument of the respondent in *ABS-CBN* that the ABS-CBN and CBN marks were dissimilar "because the marks are acronyms or initialisms which mean different things: Christian Broadcasting Network in the case of petitioner's CBN mark; and Alto Broadcasting Network and Chronicle Broadcasting Networking in the case of respondent's ABS-CBN mark." *ABS-CBN*, 84 USPQ2d at 1569. The Board rejected that argument "because the corporate names are not part of either party's registrations, and moreover there is no evidence that respondent uses its ABS-CBN mark in proximity to the underlying corporate name." *Id.* The Board found that "there is nothing of record to establish that the public is even aware of the underlying derivation of respondent's mark." *Id.* (citing *Hercules*, 223 USPQ at 1248).

To the extent that Applicant's argument for dissimilarity in meaning relies on "[c]onsumers encountering Applicant's Mark BCBN™ in its commercial context," 29

TTABVUE 11, where Applicant claims that BCBN is “consistently used in proximity to BE COOL BE NICE,” *id.* at 12, we reject it because we cannot consider the use of extrinsic elements such as the BE COOL BE NICE mark together with BCBN where those elements are not part of the mark shown in Applicant’s application. *ABS-CBN*, 84 USPQ2d at 1569; *Hercules*, 223 USPQ at 1248. To paraphrase the Board in *B.V.D.*

*Licensing:*

While [A]pplicant sometimes utilizes the words [BE COOL BE NICE] in combination with the [BCBN] mark in the involved application, any registration that would issue from the application would not include those words and [A]pplicant would not be required to use them. Thus, we assess the connotation of [A]pplicant’s mark from the perspective that consumers will see only that which [A]pplicant seeks to register.

*B.V.D. Licensing*, 83 USPQ2d at 1508.

To the extent that Applicant’s argument asserts that consumers would recognize BCBN standing alone as an abbreviation of BE COOL BE NICE, we reject it for failure of proof. There is no standard reference work in the record that identifies BCBN as an abbreviation for BE COOL BE NICE. Moreover, consumers of the services broadly identified in the Services Application as “charitable collections,” “communication by electronic communications networks on social media platforms for social networking,” and “variety television shows” include members of the general public. There is some evidence that the BCBN mark is “consistently used in proximity to BE COOL BE NICE™,” 29 TTABVUE 12, and “in many of the Campaign’s materials.” DeVeaux Decl. ¶ 13. Mr. DeVeaux testified, however, that Applicant’s “[c]ampaign is directed at young people and aims to instill in children lessons for



dealing with bullying, as well as inspiration to be kind and considerate,” DeVeaux Decl. ¶ 2, and that the “intended readership for the BE COOL BE NICE™ book is children in the second through sixth grades.” DeVeaux Decl. ¶ 14.<sup>27</sup> Consistent with his testimony, Applicant argues under the second *DuPont* factor that its materials are “directed specifically toward children,” 29 TTABVUE 9, which Applicant calls its “consumer base.” *Id.* at 8. Even assuming some exposure of these materials to parents as well, the record does not show that these materials have been exposed to a significant degree to the general public.

There has been some exposure of the BE COOL BE NICE campaign per se to the general public in coverage of the campaign in *Garage*, featuring Kendall Jenner and Willow Smith, and *GQ* magazines, and in other materials and publications,<sup>28</sup>

---

<sup>27</sup> Mr. DeVeaux testified that sales of the book in the United States “have amounted to about \$250,000 since the Campaign’s launch” in 2016. DeVeaux Decl. ¶ 12. His testimony suggests that the exposure of the materials in which the BCBN mark is used in proximity to the BE COOL BE NICE mark has been relatively modest.

<sup>28</sup> We note, however, that the *GQ* materials appear to have been taken from a portion of the website of the magazine relating to the United Kingdom ([gq-magazine.co.uk/gallery/be-cool-be-nice-anti-bullying](http://gq-magazine.co.uk/gallery/be-cool-be-nice-anti-bullying)). Even assuming that the *GQ* edition was exposed to consumers in the United States, we give these materials limited weight. Some of the other materials also appear to be directed to persons in the United Kingdom. These include the “Channel 5” website listing links to various websites in the .uk ccTLD and various United Kingdom telephone numbers, and the [bbonline.com](http://bbonline.com) and [royalcentral.co.uk](http://royalcentral.co.uk) websites, the latter of which describes itself as “the web’s most popular source for the latest news and information on the British Royal Family and the Monarchies of Europe.” DeVeaux Decl. Ex. M. In addition, some of the “individuals and entities that have promoted the [BE COOL BE NICE] campaign and the services rendered under the BCBN™ mark,” DeVeaux Decl. ¶ 15, are associated with the United Kingdom, including The House of Lords, Commonwealth Secretariat, Buckingham Palace, and Princess Beatrice of York. Applicant does not establish the extent, if any, of the exposure of these materials, and the promotion of the campaign by these entities, to consumers in the United States. In the absence of such a showing, we give them no further consideration. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1491 n.92 (TTAB 2017).

including online versions. DeVeaux Decl. ¶¶ 5, 15-16; Exs. B-C, L-M. There is also some use of the initialism BCBN in these materials, mostly in text or hashtags, but such uses are fewer and less prominent than in Applicant's materials directed specifically to children and their parents. DeVeaux Decl. Exs. C, L-M. Applicant's evidence is insufficient to show that consumers of "charitable collections," "communication by electronic communications networks on social media platforms for social networking," and "variety television shows" in the United States would recognize BCBN to be an abbreviation of BE COOL BE NICE.

In *ABS-CBN*, the Board found that "the presence of the prefix letter string 'ABS' in respondent's mark would, for many television viewers, serve to suggest that ABS-CBN may be a specific television channel within petitioner's broadcasting network." *ABS-CBN*, 84 USPQ2d at 1568-69. We have found above that Opposer's CBN mark remains famous for television broadcasting services, and the record shows that some broadcasters have added letters to their main marks to identify particular affiliated channels. Examples include CBS and CSBSN; NBC and CNBC and MSNBC; and ESPN and ESPNU. 6 TTABVUE 83-225. We find that the perception that BCBN, which contains four letters just as the secondary mark CNBC identified in the above examples, "may be a specific television channel within [Opposer's] network," *ABS-CBN*, 84 USPQ2d at 1569, is also likely here. "[C]onsumers familiar with [Opposer's] CBN mark and television broadcasting services would likely associate [Applicant's BCBN] mark in some way with CBN, and may mistakenly believe that [BCBN] is a division of CBN." *Id.*

Opposer's charitable fundraising and social media communications services are closely associated with its television broadcasting services. A significant portion of Opposer's revenues have taken the form of viewer contributions, Bocarnea Decl. ¶ 5; Ex. 16, and Mr. Robertson testified that the "bulk of our fundraising goes for our production and television shows." Robertson Tr. 80:21-22. As discussed above, Opposer's social media communications are a direct offshoot of its television broadcasting services. Under the circumstances, we similarly find that consumers familiar with Opposer's charitable fundraising activities and social media communications under and in connection with the CBN mark "would likely associate [Applicant's BCBN] mark in some way with CBN" when the mark is used in connection with the Class 36 and Class 38 services identified in the Services Application, as well as with the Class 41 services. *ABS-CBN*, 84 USPQ2d at 1569. We find that the marks are similar in connotation and commercial impression when used in connection with the involved services.

"While the marks are not identical, we find that they are similar in sound, appearance, meaning, and commercial impression, and that the similarities in the marks outweigh their differences." *Id.* The first *DuPont* factor supports a finding of a likelihood of confusion.

#### **4. The Fourth *DuPont* Factor**

"The fourth *DuPont* factor considers '[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing.'" *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). In *Stone Lion*, the Federal Circuit held that "Board precedent requires the decision to be based 'on the

least sophisticated potential purchasers.” *Id.* at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)).

Opposer argues that “[t]his factor favors Plaintiff, or is at least a neutral factor in the balance.” 28 TTABVUE 24. Opposer cites the finding in the Board’s decision in *ABS-CBN* that “[i]n view of the nature of [Plaintiff’s] services, and [Plaintiff’s] testimony that its services are rendered to the general television viewing public, the relevant viewers would be expected to exercise nothing more than ordinary care in purchasing or viewing decisions.” *Id.* (quoting *ABS-CBN*, 84 USPQ2d at 1568). Opposer also argues “any viewer who comes upon [Opposer’s] broadcasts while ‘channel surfing,’ or information about the broadcasts while browsing the internet or social media, would indeed fall into the impulse buyer category.” 28 TTABVUE 25. Opposer does not address the degree of care exercised by purchasers of the other services identified in the Services Application.

The record does not support Opposer’s claim that some consumers of television broadcasting services are in “the impulse buyer category.” *Id.* We find that the least sophisticated purchasers of the several services identified in the Services Application are likely to exercise ordinary care, such that the fourth *DuPont* factor is neutral in our likelihood of confusion analysis.

#### **5. The Sixth *DuPont* Factor**

The sixth *DuPont* factor “considers ‘[t]he number and nature of similar marks in use on similar goods [or services].’” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *DuPont*, 177 USPQ at 567). We agree with Opposer that “there is no evidence of any

third-party use of the mark CBN in connection with any of the registered services or any similar services.” 28 TTABVUE 26. Thus, the sixth factor is neutral in our analysis of the likelihood of confusion. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, \*15 (TTAB 2020).

#### **6. The Seventh and Eighth *DuPont* Factors**

The seventh *DuPont* factor is the “nature and extent of any actual confusion,” while the eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. Opposer argues that it “need not present any evidence of actual confusion in order to find that a likelihood of confusion exists,” 28 TTABVUE 26, that “there has been minimal time for any actual confusion to occur,” *id.*, and that “evidence of actual confusion is difficult to obtain.” *Id.* at 27 (quoting *Lebanon Seaboard Corp. v. R&R Turf Supply, Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012)). Applicant responds that “Opposer puts forth absolutely no evidence establishing actual consumer confusion between the parties’ marks.” 29 TTABVUE 13. Applicant argues that “Opposer admits that Applicant’s Mark has garnered significant attention, yet cannot point to a single instance of consumers writing, calling, posting on social media, etc. regarding confusion between the marks.” *Id.* at 14. In its reply brief, Opposer argues that while it admitted that Applicant’s potential audience is very large, 30 TTABVUE 11, there has been little use of the applied-for mark BCBN, in comparison to use of the campaign title BE COOL BE NICE, *id.*, and that

Applicant's statement that "Opposer admits that Applicant's Mark has garnered significant attention' (29 TTABVUE at 13) is false." *Id.*

In its decision on remand from the Federal Circuit's decision in *Guild Mortg.*, 129 USPQ2d 1160, the Board recently held that the eighth *DuPont* factor "requires us to look at **actual market conditions**, to the extent there is evidence of such conditions of record." *In re Guild Mortg.*, 2020 USPQ2d 10279, \*15 (TTAB 2020). The Board contrasted the analysis under the eighth *DuPont* factor based on actual marketplace conditions with the "analysis as to the second, third, and fourth *du Pont* factors, discussing the similarity of the services, channels of trade, and relevant consumers," which "is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the application and cited registration." *Id.* Accordingly, although we cannot consider the parties' actual uses of their marks in our analyses under the second, third, and fourth *DuPont* factors, we must consider their actual uses of the CBN and BCBN marks under the seventh and eighth factors.

Mr. DeVeaux testified that the BCBN mark has been in use since at least as early as 2016, DeVeaux Decl. ¶ 3, but that the BE COOL BE NICE campaign "began to take off in full force in the United States with the publication of the Fall/Winter 2016 issue of *Garage* magazine, featuring Kendall Jenner and Willow Smith alongside information about the Campaign (including references to the BCBN™ mark) and its exclusive Snapchat collaboration." DeVeaux Decl. ¶ 5. Accordingly, as of the time of trial in 2019, the period of simultaneous use of the CBN and BCBN marks in the United States was about three years.

Applicant argues that the “most striking thing distinguishing the sources of the parties’ goods and services is the nearly antithetical contexts in which they are offered in the marketplace, and their resulting disparate consumers.” 29 TTABVUE 8. Mr. DeVeaux testified that the BE COOL BE NICE campaign “is directed at young people,” DeVeaux Decl. ¶ 2, and that the “intended readership for the BE COOL BE NICE™ book is children in the second through sixth grades.” DeVeaux Decl. ¶ 14. Applicant argues that its “secular campaign is directed specifically towards children,” while “[b]y contrast, the largest swath of Opposer’s viewer is ‘age 50 to 64.’” 29 TTABVUE 9 (citation omitted), and concludes that “Opposer’s mission and commercial activities under the CBN mark are defined by everything that Applicant and its BCBN™ mark are not.” *Id.* at 10.

As Applicant acknowledges, the “probative value of the absence of actual confusion depends on there being a significant opportunity for actual confusion to occur.” *Id.* at 14 (citing *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007)). The marks have been used concurrently for a relatively short period of time, and in connection with actual goods and services that Applicant argues are “vastly different.” *Id.* at 8. We find that there has not been a significant opportunity for actual confusion to have occurred. *Cf. Guild Mortg.*, 2020 BL 120829, \*18 n.29 (where the applicant argued repeatedly on appeal of ex parte refusal to register “that, without regard to the identifications as stated, the consumers of Registrant’s and Applicant’s [mortgage banking and investment advisory] services are quite different,” evidence that applicant and the cited registrant had both been doing business in southern

California under their respective marks for nearly 40 years was insufficient to cause the eighth *DuPont* factor to be other than neutral); *ABS-CBN*, 84 USPQ2d at 1570 (where the petitioner’s affiliate CBN Asia broadcasted for one hour every Sunday on the respondent’s The Filipino Channel, such that “the marks of the parties have appeared on successive screen shots,” and there had been “considerable activity by the parties under their respective marks over a long period of time [13 years] without any reported instances of confusion,” Board could “infer that simultaneous use of the marks is not likely to cause confusion.”). Accordingly, the seventh and eighth *DuPont* factors are neutral in our analysis of likelihood of confusion.

#### **7. The Ninth *DuPont* Factor**

“The ninth *DuPont* factor takes into account the variety of goods [or services] on which a mark is or is not used.” *DeVivo*, 2020 USPQ2d 10153, \*14 (citing *DuPont*, 177 USPQ at 567). “If a party in the position of plaintiff uses its mark on a wide variety of goods [or services], then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *Id.* (citing *In re Hitachi High-Techs. Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014)).

Opposer argues that in “addition to [its] decades-old use of its mark CBN for television broadcasting services, [Opposer] has used its CBN marks in a variety of other ways,” 28 TTABVUE 27, including social media, online services related to Christian living, including prayer, counseling and humanitarian ministries, and Christian radio stations, animation, and communications to its viewers. *Id.* at 27-28. Several of the referenced social media activities are subsumed within the services that we considered under the second *DuPont* factor, and the other activities “are



insufficient to persuade us that Opposer has used [its] mark on a variety of goods [and services] and that this *DuPont* factor favors a finding of likelihood of confusion.” *DeVivo*, 2020 USPQ2d 10153, \*15. “We therefore find the ninth *DuPont* factor to be neutral with respect to a finding of likelihood of confusion.” *Id.*

### 8. The Eleventh *DuPont* Factor

“The extent to which applicant has a right to exclude others from use of its mark on its goods’ is listed as the eleventh factor in the *du Pont* analysis.” *McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014) (quoting *DuPont*, 177 USPQ at 567). This factor is normally invoked by applicants, who “[i]n the few precedential cases discussing the eleventh *DuPont* factor . . . have failed to show sufficient use of their marks to establish a right to exclude others from use of their marks on their goods.” *DeVivo*, 2020 USPQ2d 10153, \*15.

Opposer argues that “[t]his *DuPont* factor has been interpreted to consider the extent to which the prior user has policed its mark.” 28 TTABVUE 28. Opposer cites *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 13 USPQ2d 1257, 1278 (S.D.N.Y. 1989), a civil infringement action in which the district court applied the Second Circuit’s eight-factor test for likelihood of confusion set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 128 USPQ 411 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961). *Cullman Ventures*, 13 USPQ2d at 1275. The *Polaroid* factors do not include the eleventh *DuPont* factor, and the district court in *Cullman Ventures* did not discuss or apply the eleventh factor or the *DuPont* case in the portion of the decision in which it discussed the plaintiff’s efforts to police its mark. The district court discussed a *DuPont* case, *E.I. Dupont de Nemours & Co. v. Yoshida Int’l*,

*Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975),<sup>29</sup> *Cullman Ventures*, 13 USPQ2d at 1278, but not **the** *DuPont* case that sets forth the likelihood of confusion factors that we must apply. The *Cullman Ventures* case is irrelevant to our analysis under the eleventh *DuPont* factor.

The eleventh *DuPont* factor does not concern Opposer's policing efforts, and Opposer offers nothing else directed to that factor. There is no evidence that Applicant has "attempted to assert its rights so as to 'exclude' anyone else from using [the same mark] or any similar mark." *McSweet*, 112 USPQ2d at 1284-85. The eleventh factor is neutral in our analysis of the likelihood of confusion. *DeVivo*, 2020 USPQ2d 10153, \*15.

### **9. The Twelfth *DuPont* Factor**

The twelfth *DuPont* factor concerns the extent of potential confusion, "i.e. whether de minimis or substantial." *DuPont*, 177 USPQ at 567. Opposer argues that the extent of potential confusion is "substantial, and can in no way be characterized as 'de minimis.'" 28 TTABVUE 29. Opposer claims that the "parties' programming reaches a wide audience," and that Applicant's "potential audience is also very large." *Id.* The record shows that Opposer's television programming "reaches a wide audience," *id.*, and while Applicant does not address this factor in its brief, it essentially agrees with Opposer that its potential audience is also very large. 29 TTABVUE 14. We find that this factor slightly supports a finding of a likelihood of confusion.

---

<sup>29</sup> The district court cited the case for the proposition that a "trademark owner's efforts at policing its trademarks is further proof of the strength of those marks." *Cullman Ventures*, 13 USPQ2d at 1278.

## **10. Balancing the *DuPont* Factors**

All of the relevant *DuPont* factors either support a finding of a likelihood of confusion or are neutral. Opposer's CBN mark for television broadcast services is famous and entitled to a broad scope of protection. The parties' Class 36 and 41 services, and the channels of trade and classes of consumers for those services, are legally identical, and Applicant's Class 38 services are related to Opposer's television broadcasting services, and the channels of trade and classes of consumers for those services overlap with those for Opposer's television broadcasting services. The second, third, and fifth *DuPont* factors thus support a finding of a likelihood of confusion.

The marks are sufficiently similar in appearance, sound, and connotation and commercial impression for confusion to be likely, particularly given the legal identity of the services in Classes 36 and 41, the strength of Opposer's mark, and the absence of evidence of the use of similar marks for the involved services. The extent of potential confusion is significant. The fourth, sixth, seventh, eighth, and ninth *DuPont* factors, which potentially could militate against a finding of a likelihood of confusion based on the other factors, are neutral.

We find that Opposer showed, by a preponderance of the evidence, that confusion is likely, and we sustain Opposer's opposition to the Services Application.

## **VI. Dilution Claim Regarding the Goods Application**

### **A. Applicable Law**

"The Trademark Act provides for a cause of action for the dilution of famous and distinctive marks:

[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”

*TiVo Brands*, 129 USPQ2d at 1103 (quoting 15 U.S.C. § 1125(c)(1)). “Section 13(a) [of the Trademark Act], 15 U.S.C. § 1063(a), makes dilution by blurring or tarnishment under Section 43(c) a basis for opposing registration.” *Id.*

“A successful claim for federal trademark dilution by blurring under Section 43(c) of the Trademark Act requires that a plaintiff plead and prove the following in a Board proceeding:

1. Plaintiff owns a famous mark that is distinctive;
2. Defendant is using a mark in commerce that allegedly dilutes plaintiff's famous mark;
3. Defendant's use of its mark began after plaintiff's mark became famous; and
4. Defendant's use of its mark is likely to cause dilution by blurring.”

*Id.*

The “threshold question in a federal dilution claim is whether the plaintiff's mark is ‘famous,’ *New York Yankees P'ship v. IET Prods. and Servs., Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015), and “[i]t is well-established that dilution fame is difficult to prove.” *Coach Servs.*, 101 USPQ2d at 1724. We have found above that Opposer's CBN mark is famous for broadcasting services for purposes of its likelihood of confusion claim, but “[t]he fame that must attach to a mark for it to be eligible for protection under the dilution provisions of the Trademark Act is greater than that which

qualifies a mark as famous for the *du Pont* analysis of likelihood of confusion.” *TiVo Brands*, 129 USPQ2d at 1103 (citing *Coach Servs.*, 101 USPQ2d at 1724 (“Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.”)). Opposer thus “has the burden of a ‘higher and more rigorous standard for dilution fame.” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1887 (TTAB 2005) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). “[A] mark can acquire ‘sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” *New York Yankees P’ship*, 114 USPQ2d at 1502 (quoting *Coach Servs.*, 101 USPQ2d at 1724). “[F]ame for dilution requires widespread recognition by the general public.” *Coach Servs.*, 101 USPQ2d at 1725.

Dilution fame must have attached to the subject mark before the challenged use began. *TiVo Brands*, 129 USPQ2d at 1112. Opposer acknowledges this requirement, 28 TTABVUE 30, and states that Applicant has “admitted a date of first use of the BCBN mark of 2016.” *Id.* at 33. Accordingly, we will use the year 2016 as the date by which Opposer must establish dilution fame.

“There are four non-exclusive factors to consider when determining whether a mark is famous:

- i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- iii. The extent of actual recognition of the mark.

- iv. Whether the mark is registered . . . on the principal register.”

*New York Yankees P’ship*, 114 USPQ2d at 1502 (quoting 15 U.S.C. § 1125(c)(2)(A)).

## **B. The Alleged Fame of the CBN Mark**

### **1. Registrations**

Opposer’s CBN mark is the subject of multiple registrations on the Principal Register, including Registration No. 1108225 for the “television broadcasting services” for which we have found the mark to be famous under the fifth *DuPont* factor. All of the registrations issued without the requirement of a showing of acquired distinctiveness, and Registration No. 1108225, which issued in 1978, has become incontestable and is “not subject to challenge under Trademark Act 2(e).” *TiVo Brands*, 129 USPQ2d at 1112. This factor supports a finding of dilution fame. *Id.*

### **2. Actual Recognition, Advertising and Publicity, and Sales**

We will address the other three non-exclusive dilution fame factors together because Opposer relies on the first two factors to establish fame under the third.

“Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used.” *Id.* at 1104 (quoting *Nike*, 100 USPQ2d at 1024). Actual recognition may be shown by evidence such as consumer surveys and “third-party references to and discussion about” the subject mark, *Nike*, 100 USPQ2d at 1024, or it may be inferred from sufficiently powerful evidence regarding advertising, publicity, and sales. *See New York Yankees P’ship*,

114 USPQ2d at 1503 (the opposer “offered no direct evidence regarding the extent of actual recognition” of its mark, but did offer “substantial evidence relating to the first two fame factors”); *UMG Recordings*, 100 USPQ2d at 1887 (noting absence from record of “surveys or other evidence specifically measuring the general public’s ‘actual recognition’ of opposer’s MOTOWN marks,” but inferring actual recognition from evidence of extensive public exposure of the opposer’s marks).

Opposer offers no direct evidence of actual recognition in the form of a consumer survey or third-party references to its CBN mark.<sup>30</sup> Instead, Opposer argues that “[s]ignificant actual recognition of Plaintiff’s mark may . . . be inferred from the strong record of public exposure to Plaintiff’s CBN mark.” 28 TTABVUE 32. Opposer cites the longstanding use of the CBN mark and the information summarized above in our analysis of the fifth *DuPont* factor regarding Opposer’s exposure of the CBN mark through the reach of its television broadcasting and other communications to the public, and its sales, revenues, and advertising figures. *Id.* at 31-32. Accordingly, we will review that evidence again to determine whether, in the absence of direct evidence of actual recognition, it is “so strong that we [can] infer from [it] significant actual recognition among the general public as well,” *UMG Recordings*, 100 USPQ2d at 1887, or whether it is sufficient, in its own right, to prove dilution fame under the first two fame factors in § 43(c)(2)(A).

---

<sup>30</sup> Dr. Bocarnea testified that he was unaware of any brand awareness studies conducted by Opposer for the CBN mark. Bocarnea Tr. 35:7-18; 36:8-18. Applicant made of record two articles regarding Opposer, Robertson Tr. 18:22-19:8; 20:7-16; Exs. 2-3, but Opposer does not cite them as evidence of actual recognition of its mark.

As discussed above, the primary vehicle through which the CBN mark is exposed to the public is Opposer's flagship program *The 700 Club*. 28 TTABVUE 31-32.<sup>31</sup> The show had aired continuously under the mark for 47 years as of 2016, which weighs in favor of a finding of dilution fame. Dr. Bocarnea also testified that as of 2018, *The 700 Club* and *The 700 Club Interactive* could be seen in 97% of United States households, one percentage point higher than the comparable figure in 2006, and that the shows had a daily average audience of 650,000 households. Bocarnea Decl. ¶ 4b. The fact that the shows can be seen today in 97% of U.S. households begs the question of what percentage actually sees them. To paraphrase the Board's comment on the comparable figure in *ABS-CBN*, "[w]e understand that [97%] does not mean that [Opposer's] programming is, in fact, seen in [97%] of the households." *ABS-CBN*, 84 USPQ2d at 1567 n.53. Dr. Bocarnea did not testify as to the percentage of households that actually regularly view the shows, and we have not found that figure in the record.

The U.S. Census, however, contains information regarding the number of households in the United States, and "[b]ecause the U.S. Census is a standard reference, we may take judicial notice of information disclosed in the census reports, and regularly have done so." *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1103 n.5 (TTAB 2018) (citations omitted). *See also Guild Mortg.*, 2020 USPQ2d 10279, \*17 n.27; *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, \*7 (TTAB

---

<sup>31</sup> Mr. Robertson notably testified, however, that "700 Club is a more dominant brand in terms of brand awareness than CBN." Robertson Tr. 90:5-9.



2019). We take judicial notice that the 2010 Census “enumerated 308.7 million people in the United States,” and that “[o]f the total population in 2010, 300.8 million lived in 116.7 million households for an average of 2.58 people per household.” Households and Families: 2010 (2010 Census Briefs) ([census.gov/prod/cen2010/briefs/c2010br-14.pdf](https://www.census.gov/prod/cen2010/briefs/c2010br-14.pdf), last accessed on April 10, 2020).<sup>32</sup>

As discussed above, Dr. Bocarnea purported to confirm and adopt Mr. Turver’s testimony in 2006, and to provide “some comparable numbers and activities for the year 2018.” Bocarnea Decl. ¶ 4. He testified that Mr. Turver testified in 2006 that the daily average audience for the shows “was over 1 million viewers, which represented approximately 17 million unique households monthly, representing approximately 16% of the homes in the United States.” Bocarnea Decl. ¶ 3b. Dr. Bocarnea did not explain what Mr. Turver meant by “17 million unique households monthly,” how Mr. Turver derived that figure from the daily average audience of 1 million viewers, or how Mr. Turver derived the percentage of U.S. homes that watched the shows.<sup>33</sup> Dr. Bocarnea also did not provide 2018 figures for the daily average number of viewers or the number and nature of any such “unique households monthly,” and as noted above, his declaration is notably silent on the approximate percentage of U.S. homes that view the program.

---

<sup>32</sup> The U.S. Census website estimates that as of July 1, 2019, the U.S. population was more than 328 million people in 119.7 million households. [Census.gov/quickfacts/fact/table/US#](https://www.census.gov/quickfacts/fact/table/US#) (last accessed on April 10, 2020).

<sup>33</sup> Citing Mr. Turver’s testimony deposition, which is not of record here, the Board found without elaboration in *ABS-CBN* that The 700 Club’s “monthly cumulative or unique viewers comprise approximately seventeen (17) million households [that] represent approximately 16% of the homes in the United States.” *ABS-CBN*, 84 USPQ2d at 1563.

On the basis of the 2010 Census findings that each U.S. household had about 2.5 members, we can safely assume, from Dr. Bocarnea's testimony that the daily average audience for The 700 Club in 2018 consisted of 650,000 households, that approximately 1.6 million persons had at least the opportunity to view the show daily.<sup>34</sup> It is likely that this represents an increase in the number of individual viewers over the 2006 figure of one million daily viewers. By the same token, however, the daily average audience of 650,000 households is a miniscule percentage of the more than 116 million households that the Census Bureau counted in the 2010 Census and the more than 119 million households that the Bureau estimates to have existed as of July 2019.

Dr. Bocarnea's rebuttal declaration, in which he testified about a "bi-annual national survey for CBN's flagship show, The 700 Club," conducted by a company called GfK/MRI, Bocarnea Rebuttal Decl. ¶ 4; Ex. 27,<sup>35</sup> also raises questions regarding the extent of the show's viewership. Dr. Bocarnea provided neither the survey nor an explanation of its methodology, but he described it as showing that "of the total 48,098 completed surveys, 655 indicated that they watched The 700 Club (unweighted number)," which "according to GfK/MRI, represents a total estimate for the U.S. population of 3,354,000 viewers (weighted value)." Bocarnea Rebuttal Decl.

---

<sup>34</sup> Obviously we cannot similarly assume that each member of each household watched it.

<sup>35</sup> The spreadsheet that Dr. Bocarnea created from the survey data was redacted as confidential, but he disclosed several figures from it in the unredacted version of his rebuttal declaration.

¶ 4. This estimated audience of 3.3 million viewers represents a miniscule percentage of the estimated United States population of 328 million people as of July 1, 2019.<sup>36</sup>

In the absence of the details that Mr. Turver appears to have provided in his 2006 testimony, we cannot find, on the basis of Dr. Bocarnea's two declarations, that the show was viewed in 2018 by a significant percentage of U.S. households, much less that it was viewed by the 16% percent of U.S. households to which Mr. Turver testified as in 2006.<sup>37</sup>

In addition, the record does not establish that the viewership of The 700 Club is particularly representative of the entire U.S. public. Dr. Bocarnea testified that "[b]roadly speaking, CBN's audience consists of people of all ages – children, teens, and adults," Bocarnea Decl. ¶ 9, but he admitted on cross-examination that the average audience for The 700 Club is mostly adults between the ages of 35 and 64, Bocarnea Tr. 29:11-14, and he testified elsewhere in his declaration that more than two-thirds are age 35 and older. Bocarnea Decl. ¶ 10; Ex. 20.<sup>38</sup> Mr. Robertson agreed that most of Opposer's donor viewers are older, Robertson Tr. 20:7-25; Ex. 3, and he testified that on the "Bell curve" of Opposer's demographics, "the biggest bell [is] age

---

<sup>36</sup> The spreadsheet contains an estimate of what appears to be the number of persons in the undefined survey universe from which the sample of completed surveys was taken. Bocarnea Rebuttal Decl. Ex. 26. That estimated figure is smaller than the estimated U.S. population, but the estimated number of viewers remains a miniscule percentage of even the lower figure.

<sup>37</sup> Even if the record showed that the 16% figure still held, however, exposure of the CBN mark to about one-sixth of the U.S. public through regular viewing of The 700 Club would not establish that the mark "had become a 'household term [with] which almost everyone is familiar.'" *TiVo Brands*, 129 USPQ2d at 1113 (quoting *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1181 (TTAB 2001)).

<sup>38</sup> Exhibit 20 covers only two years, 2017 and 2018, which are after the year 2016, the date by which Opposer must show that the CBN mark had become famous.

50 to 64, predominantly female,” and that the “ratio varies year over year, but the range is roughly 55 to 60 percent female.” Robertson Tr. 85:15-20.

Mr. Robertson also testified that The 700 Club has “very loyal repeat viewers,” Robertson Tr. 84:18, who are interested in watching the show because of its Christian-centric content. Robertson Tr. 86:4-8.<sup>39</sup> Dr. Bocarnea agreed on the audience’s loyalty. Bocarnea Tr. 40:15-17. Mr. Robertson explained that the number one reason that viewers watch The 700 Club is Opposer’s “take on the news,” Robertson Tr. 88:4-7, which involves a self-styled “Christian Perspective,” 6 TTABVue 47-54,<sup>40</sup> and “[n]umber two would be prayer.” Robertson Tr. 88:9.

Dr. Bocarnea testified in his rebuttal declaration that he “evaluated the extent to which I am able to show, statistically, the percentage of non-Christians who regularly watch CBN’s flagship television show” based on a spreadsheet analyzing data regarding the religious views of respondents to GfK/MRI’s survey discussed above. Bocarnea Rebuttal Decl. ¶¶ 4-5; Ex. 27. He cited the percentages of respondents who expressed disagreement with the following statements: (1) “Prayer is part of my daily life” (17%); (2) “Attending religious services regularly” (30%); (3) “Religion is the most important way to know what’s morally correct” (11%); and (4) “Religion should be the

---

<sup>39</sup> He testified that in his interactions with viewers he has heard various reasons why viewers began watching the show, “everything from I’ve been watching since the early ‘70s to, you know, my grandmother made me watch,” Robertson Tr. 89:8-14, and that viewers talk to him about their Christian faith and “are very interested in expressing what the show means to them.” Robertson Tr. 89:15-20.

<sup>40</sup> Mr. Robertson authenticated a *Time* magazine article announcing Opposer’s launch of a 24-Hour News Feed and quoting him that the news feed “will provide a religious perspective that other channels lack.” Robertson Tr. 20:7-16; Ex. 3.

pillar of society” (24%). He concluded from the responses regarding daily prayer that “[m]ost likely, non-religious viewers of The 700 Club are among these” respondents, Bocarnea Rebuttal Decl. ¶ 4, and from the responses regarding regular attendance at religious services that about 30% of The 700 Club’s viewers “do not attend religious services regularly.” Bocarnea Rebuttal Decl. ¶ 4.

There are undoubtedly non-religious or casually religious viewers of The 700 Club, although the cited responses suggest that they are a small minority of what both of Opposer’s witnesses described as the show’s loyal viewership,<sup>41</sup> assuming that we can infer viewers’ religiosity from those responses. We find, however, that Dr. Bocarnea’s analysis of these responses does not negate his and Mr. Robertson’s testimony that the viewership of The 700 Club consists predominantly of older viewers who are motivated to watch primarily by the religious content of the shows. The CBN mark may be well known to Opposer’s loyal audience, but Opposer has not shown that the audience is representative of the U.S. public at large in either size or composition.

We turn now to the extent and scope of Opposer’s sales and advertising, which are factors that may establish dilution fame, either directly or as the basis for an inference of actual recognition of the subject mark. 15 U.S.C. § 1125(c)(2)(A)); *New York Yankees P’ship*, 114 USPQ2d at 1503; *UMG Recordings*, 100 USPQ2d at 1887. Sales (measured in revenues) and advertising of goods and services are vehicles by which the associated marks are exposed to the public. Opposer argues that “over the

---

<sup>41</sup> Mr. Robertson testified that Opposer’s “donor audience” is mostly Christian viewers. Robertson Tr. 85:21-25.

last 20 years, Plaintiff’s revenue has approached or exceeded \$100 million per year.” 28 TTABVUE 32. This claim is based on a confidential chart, authenticated by Dr. Bocarnea, entitled “FY89-FY08 CBN Total Contributions (CBN Total Revenue – 39 years).” Bocarnea Decl. ¶ 6; Ex. 17.<sup>42</sup> As explained above, for the period 2000-2005 at issue in the *ABS-CBN* case, the lion’s share of Opposer’s revenues took the form of viewer contributions. Bocarnea Decl. ¶ 5; Ex. 16. There is no evidence that the same is not true for the other years in the 29-year period covered in the chart.

Dr. Bocarnea testified that he considered Opposer’s direct competitors to be other Christian fundraising entities, Bocarnea Tr. 12:19-13:14; 14:3-6, and Mr. Robertson testified that while Opposer receives advertising revenues from its television programs and websites, Robertson Tr. 79:21-23,<sup>43</sup> “[e]verything is funded by donations,” Robertson Tr. 79:20, and that the “bulk of our fundraising goes for our production and television shows.” Robertson Tr. 80:21-22. Mr. Robertson also testified that the “number of viewers that donate is a small fraction of the total viewership,” Robert Tr. 88:2-3, indicating that a small group of donors accounts for a disproportionately large portion of Opposer’s revenues. Although Opposer’s pre-2016

---

<sup>42</sup> The “FY08” figure is a typographical error, as the chart runs through Opposer’s fiscal year 2018.

<sup>43</sup> Dr. Bocarnea was shown the chart at his deposition and was asked about the revenues attributable to social media and Internet advertising. Bocarnea Tr. 30:2-31:5; Ex. 12. He did not know the revenues attributable to social media, Bocarnea Tr. 30:7-10, and testified, with respect to the percentage of the revenues attributable to Internet advertising, that “when you go back ten years ago or so there was [sic] pretty much negligible,” Bocarnea Tr. 30:15-16, but that in 2018, the last fiscal year in the chart, those revenues accounted for a higher percentage of total revenues. Bocarnea Tr. 30:17-18.

revenues have been substantial, in the low nine figures, their nature and origin do not reflect widespread exposure of the CBN mark to the general public.

With respect to Opposer's advertising, as discussed above, Dr. Bocarnea testified about Opposer's advertising expenses between 1997 and 2005 and between 2015 and January 31, 2019. Bocarnea Decl. ¶¶ 7-8; Exs. 18-19. He did not provide figures for the period between 2005 and 2015, simply averring that "CBN's advertising expenditures have remained substantial to date," Bocarnea Decl. ¶ 8, and the vast majority of the period between 2015 and January 31, 2019 is after the 2016 date by which Opposer's mark had to have become famous.

The chart covering the earlier period contains the multiple expenditure categories described above, the most pertinent of which for purposes of possible exposure of the CBN mark is the "Advertising Expenses" category, which displays sub-categories entitled "Outdoor Transit Ads," "Radio/TV Ads," "Trade Show," "Graphics for Ads," "Advertising – Miscellaneous," "Marketing Expenses," and "Promotional Expenses." Bocarnea Decl. ¶ 7; Ex. 18. The largest sub-category for the fiscal years 1997-2001 is "Radio/TV ads,"<sup>44</sup> but neither the chart nor Dr. Bocarnea provides any information about the programs on which such ads appeared, and the extent of their exposure to the general public. The next largest sub-category is "Marketing Expenses," but Opposer provides no information about the nature of these expenses, or the extent to which they reflect exposure of the CBN mark to the general public. Dr. Bocarnea's

---

<sup>44</sup> That sub-category does not appear for fiscal years 2002-2003, and it is much smaller in absolute terms for the fiscal years 2004-2005, and for the fiscal years 2015-2016.

testimony regarding Opposer's advertising establishes that for the referenced periods, Opposer's total expenditures were substantial, but the vagueness and incompleteness of his testimony severely undercuts its probative value in establishing that Opposer's advertising contributed to making the CBN mark famous by 2016. *Cf. UMG Recordings*, 100 USPQ2d at 1887 ("Opposer has demonstrated extensive nationwide promotion of its [MOTOWN] mark for musical recordings and entertainment through traditional advertising media and through sales of its collateral goods and services . . . ."); *New York Yankees P'ship*, 114 USPQ2d at 1503 (fame of New York Yankees' "top hat" logo shown in part through exposure of the mark on national television networks such as ESPN, Fox, CBS, NBC, ABC, and TBS). Like Opposer's sales figures, its advertising figures do not support a finding that the CBN mark had achieved dilution fame by 2016.

Finally, we consider Opposer's exposure of the CBN through direct communications with the public. Opposer argues that it "extensively uses the CBN marks in connection with both regular mail and email communications to its viewers." 28 TTABVue 28. Opposer notes that in 2006, it sent out approximately 20 million pieces of mail under the CBN mark, *id.*, and that in 2018 it sent out approximately 14.5 million pieces of mail displaying the CBN service mark and approximately 221.9 million emails which use the CBN mark prominently. *Id.* These are impressive numbers, but Mr. Robertson testified that these mailings have been sent "to people who contact CBN." Robertson Decl. ¶ 14; Ex. 14. The recipients of these communications appear to viewers of The 700 Club or others who have



communicated with Opposer, perhaps repeatedly. Indeed, many of the examples of such communications provided by Mr. Robertson characterize the recipients as “partners” with Opposer in Christian ministry. *See, e.g.*, Robertson Decl. Ex. 14 (9 TTABVUE 144, 157, 176, 186, 194, 225 (“Because you are a vital part of the ministry, I am asking you to continue to stand with CBN”), 231 (“As a CBN partner you have been a great blessing to the people of Israel”). There is no evidence that Opposer engages in such communications or other communications to a broad swath of the general public.<sup>45</sup>

Although Opposer’s registrations of its CBN mark and its use of the mark for over 50 years support a finding of dilution fame, these factors are insufficient to establish such fame where there has been insufficient exposure of the mark to the general public through the broadcasting of The 700 Club, the activities generating Opposer’s revenues, Opposer’s advertising, and Opposer’s direct communications with viewers, from which to infer actual recognition of the CBN mark by the general public or otherwise to establish fame. We find, on the basis of the record as a whole, that Opposer did not show, by a preponderance of the evidence, that by 2016 its CBN mark had become “a household term [with] which almost everyone is familiar.” *TiVo Brands*, 129 USPQ2d at 1113 (quotation omitted). Because Opposer failed to prove

---

<sup>45</sup> Mr. Robertson also testified that Opposer’s website at [cbn.com](http://cbn.com) receives 3,400,000 visitors per month. Robertson Decl. ¶ 11. This too is an impressive figure, but Mr. Robertson testified that the website enables Opposer to “carr[y] out its mission,” Robertson Decl. ¶ 11, and that visitors can use the website to access Opposer’s news, television, and video programming, Christian music radio stations, articles regarding Christian living, and various aspects of Opposer’s “ministries of prayer, counseling, and humanitarian aid.” Robertson Decl. ¶ 11. The most reasonable inference to be drawn from these facts is that the vast majority of visitors to the website are already familiar with Opposer and its CBN mark.

Opposition No. 91240654

the threshold element of its dilution claim, we need not consider the other elements of its claim to dismiss its opposition to the Goods Application.

**Decision:** The opposition to Application Serial No. 79975367 is sustained. The opposition to Application Serial No. 79197514 is dismissed.