

This Opinion is Not a  
Precedent of the TTAB

Mailed: February 10, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Pottle Productions Inc.*

*v.*

*Melanie Reed*

—  
Opposition No. 91208008  
—

Thomas Curley, Shaina Jones Ward, and Christopher P. Beall of Levine Sullivan Koch & Schulz LLP, for Pottle Productions Inc.

Timothy B. Moore, Law Office of Timothy B. Moore, L.C.,  
for Melanie Reed.

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Before Bucher, Mermelstein, and Hightower,  
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Melanie Reed (“Applicant”) has filed an application to register the mark AMERICA’S NEXT TOP GOSPEL STARZ, in standard characters, for “Education and entertainment services, namely, providing a website featuring non-downloadable audio clips, video clips, musical performances, musical videos, film

clips, photographs, contests, other multimedia materials featuring music and information in the field of music” in International Class 41.<sup>1</sup>

Pottle Productions Inc. (“Opposer”) opposes registration pursuant to Sections 2(d) and 43(c) of the Trademark Act on the grounds of priority and likelihood of confusion with, as well as likelihood of dilution of, its mark AMERICA’S NEXT TOP MODEL.

We sustain the opposition on Opposer’s likelihood of confusion claim.

## I. Record

The record in this case consists of the pleadings and the file of the involved application. Trademark Rule 2.122(b)(1). In addition, Opposer made the following evidence of record:

- Printouts from the PTO’s TSDR database showing the status of Opposer’s five subsisting pleaded registrations, all for AMERICA’S NEXT TOP MODEL in standard characters,<sup>2</sup> for the following goods and services:
  1. Entertainment services, namely, ongoing reality based television series; providing entertainment information concerning television program via global computer network, in International Class 41;<sup>3</sup>
  2. Plastic key chains, in International Class 20;<sup>4</sup>
  3. All purpose sport bags; athletic bags; beach bags; duffel bags; gym bags; handbags; overnight bags; purses; tote bags, in International Class 18;<sup>5</sup>

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<sup>1</sup> Application Serial No. 85540055, filed February 10, 2012, alleging first use anywhere and in commerce in August 2011; “AMERICA’S” and “GOSPEL STARS” disclaimed.

<sup>2</sup> Opposer’s Notice of Reliance, 18 TTABVUE.

<sup>3</sup> Registration No. 3154101, issued Oct. 10, 2006; “AMERICA’S” and “MODEL” disclaimed.

<sup>4</sup> Registration No. 3464134, issued July 8, 2008; “AMERICA’S” disclaimed.

<sup>5</sup> Registration No. 3735277, issued January 5, 2010; “AMERICA’S” disclaimed.

4. Fashion dolls and doll accessories, in International Class 28;<sup>6</sup> and
  5. Dvds, digital versatile discs and digital video discs featuring pre-recorded entertainment in the nature of a television reality series; video game cartridges; video game discs; video cassettes featuring pre-recorded entertainment in the nature of a television reality series, in International Class 9.<sup>7</sup>
- Copies and printouts from the printed and online versions, respectively, of publications including *Entertainment Weekly*, *In Touch Weekly*, *Parade*, *People*, and *TV Guide* from the years 2008 through 2013 discussing goods and entertainment services offered in connection with Opposer's mark.<sup>8</sup>
  - The transcript of Opposer's testimony deposition of Travis Pierson, Senior Vice President, Business Affairs, CBS Network Television Entertainment Group, with exhibits ("Pierson Tr.").<sup>9</sup>
  - The transcript of Opposer's testimony deposition of Applicant Melanie Reed, with exhibits ("Reed Tr.").<sup>10</sup>

Applicant introduced the following additional evidence:

- Printouts from the TSDR database of seven third-party applications for AMERICA'S NEXT TOP \_\_\_\_\_ marks, six indicating they were abandoned and one suspended.<sup>11</sup>
- Screen captures of Applicant's page on Facebook.com.<sup>12</sup>
- Printouts of pages from the Bible; portions of the Trademark Act; the Trademark Technical and Conforming Amendment Act of 2010; an April 2011 Department of Commerce report to Congress on "Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting"; and a June/July 2010 article from WorldTrademarkReview.com titled "When enforcement becomes bullying."<sup>13</sup>

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<sup>6</sup> Registration No. 3970863, issued May 31, 2011; "AMERICA'S" disclaimed.

<sup>7</sup> Registration No. 4146834, issued May 22, 2012; "AMERICA'S" disclaimed.

<sup>8</sup> Opposer's Second Notice of Reliance, 19 TTABVUE.

<sup>9</sup> 35 TTABVUE at 2-138.

<sup>10</sup> 35 TTABVUE at 139-312.

<sup>11</sup> Applicant's Notice of Reliance, 24 TTABVUE at 5-41.

<sup>12</sup> Applicant's Second Notice of Reliance, 26 TTABVUE.

<sup>13</sup> Applicant's Third Notice of Reliance, 25 TTABVUE.

Applicant also filed a testimonial deposition on written questions of Applicant Melanie Reed, but the Board granted Opposer's motion to strike the deposition for failure to follow procedural requirements by an Order dated December 5, 2014.<sup>14</sup> We have given the deposition no consideration.

## II. Parties

Applicant is a resident of New Orleans, Louisiana who operates a Facebook page and Facebook group titled "America's Next Top Gospel Starz" for religious purposes.<sup>15</sup> Opposer is a television production company, wholly owned by CBS, which owns and distributes a reality television series under the mark AMERICA'S NEXT TOP MODEL.<sup>16</sup> The show has been broadcast since 2003 on national television networks, including most recently The CW Television Network.<sup>17</sup>

## III. Opposer's Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Opposer's standing to oppose registration of Applicant's mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). In addition, because Opposer's

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<sup>14</sup> 39 TTABVUE.

<sup>15</sup> Reed Tr. at 19:9-10 ("The purpose of the website is to promote the gospel of Jesus Christ."), 22:20-23:3 ("America's Next Top Gospel Starz relates to anything and everything that promotes the gospel of Jesus Christ in the eyes of God as Christians in America.") (reading from interrogatory responses), 23:4-16 (stating that the purpose of the site is "to save the lost"), 35 TTABVUE at 159, 162-63.

<sup>16</sup> Pierson Tr. at 9:10-10:10, 35 TTABVUE at 10-11.

<sup>17</sup> *Id.* at 10:11-11:5, 12:14-13:20, 35 TTABVUE at 11-14.

pleaded registrations are of record, priority is not an issue with respect to the goods and services covered by Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

#### IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

##### A. Strength of Opposer's Mark

Opposer asserts that its AMERICA'S NEXT TOP MODEL mark is famous. Therefore, we begin with the fifth *du Pont* factor, the fame of the prior mark. In the likelihood of confusion context, fame "varies along a spectrum from very strong to very weak." *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (quoting *Palm Bay Imps., Inc. v.*

*Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005)). See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (stating that “[f]ame is relative . . . not absolute”), *aff’d*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007). A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. The commercial strength of a mark “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods or services traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. In addition, some context in which to place raw statistics may be necessary. *Id.* at 1309.

Opposer provides no dollar figures for revenue or advertising expenditures of the goods and services offered under its mark. It does offer evidence that its television series has been continuously broadcast on various national television networks for nearly twelve years, since May 2003, through 21 “cycles,” at times with more than five million viewers of an episode via traditional television broadcast and most

recently with more than two million viewers for original broadcasts and “in-week repeats.”<sup>18</sup> Opposer’s series has 100,000 Twitter followers and more than eight million “likes” on Facebook as of March 2014.<sup>19</sup> It has advertised through print ads, billboards, and the Internet.<sup>20</sup> Indirect evidence of fame includes numerous media references;<sup>21</sup> the 2009 Directors Guild of America Award for Outstanding Directorial Achievement in Reality Programs; the 2008 Teen Choice Award for Choice TV Reality Beauty & Makeover; and the 2007 and 2008 Teen Choice Awards for Choice TV Personality won by host Tyra Banks. The series also has been nominated for reality show awards from GLAAD, the NAACP, and Kids Choice.<sup>22</sup>

Some of the evidence offered by Opposer is impressive, particularly the longevity of its television series and the number of viewers. The shortcoming in the evidence is any context in which we could evaluate the raw statistics. For example, Opposer offers testimony that its series was the number-one rated show on the UPN network and at times is the most-watched series on The CW Television Network, but provides no information regarding viewership of the series in relation to other television programs. Nor does Opposer compare the magnitude of its Twitter followers and Facebook “likes” to those of other television series or entertainment offerings. We find that Opposer has not clearly proven that its mark is famous.

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<sup>18</sup> Pierson Tr. at 14:4-16:8, 16:20-17:23, 35 TTABVUE at 15-18.

<sup>19</sup> *Id.* at 38:14-17, 41:6-8, 35 TTABVUE at 39, 42.

<sup>20</sup> *Id.* at 20:17-23, 35 TTABVUE at 21.

<sup>21</sup> Opposer’s Second Notice of Reliance, 19 TTABVUE.

<sup>22</sup> Pierson Tr. at 11:17-21, 18:21-19:16 & Exhibit 2, 35 TTABVUE at 12, 19-20, 64-66.

The sixth *du Pont* factor is the number and nature of similar marks in use on similar goods or services. Applicant argues that Opposer's mark is weakened by third-party use of similar marks.<sup>23</sup> Evidence of third-party *use* of similar trademarks can be relevant in determining the strength of a mark. In this case, however, Applicant provided no evidence of any such use. Third-party *registrations* are not evidence that marks are in use or that consumers are familiar with them, and they cannot be given any weight in determining the strength of a registration. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973). Similarly, the seven third-party *applications* for AMERICA'S NEXT TOP \_\_\_\_\_ marks submitted by Applicant are evidence only that they were filed; they are not evidence of use. *Frito-Lay North Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.6 (TTAB 2014). Thus, although the phrase AMERICA'S NEXT TOP is laudatory and descriptive in nature, the record is devoid of any evidence of third-party use of that phrase.<sup>24</sup>

Considering the record evidence as a whole, we find AMERICA'S NEXT TOP MODEL to be a somewhat strong, but not famous, mark.

#### B. Similarity of the Marks

We turn next to the first *du Pont* factor, which is the similarity of the parties' marks. In a likelihood of confusion analysis, we compare the marks in their

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<sup>23</sup> Applicant's Brief at 8, 37 TTABVUE at 9.

<sup>24</sup> *See also* Pierson Tr. at 20:24-21:5, 35 TTABVUE at 21-22 (stating witness is unaware of use of any other AMERICA'S NEXT TOP-formative marks in association with entertainment).

entireties for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Applicant has applied to register AMERICA’S NEXT TOP GOSPEL STARZ, with the exclusive right to use “AMERICA’S” and “GOSPEL STARS” disclaimed. Opposer’s mark is AMERICA’S NEXT TOP MODEL, with “AMERICA’S” disclaimed from all pleaded registrations and “MODEL” disclaimed from Registration No. 3154101 for Opposer’s Class 41 services (Opposer’s “101 Registration”).

The first three words of each mark are identical, and “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). The marks share the same structure, featuring the phrase AMERICA’S NEXT TOP followed by the descriptive terms MODEL and GOSPEL STARZ, respectively. (Applicant does not argue, and we do not find, that her replacement of an “s” with a phonetically and visually similar “z” at the end of STARZ adds any significant degree of distinctiveness to her mark. *Cf. In re Carlson*, 91 USPQ2d 1198, 1200-01 (TTAB 2009) (finding URBANHOUSING merely descriptive for real estate services)).

Based on the record before us, we find that AMERICA'S NEXT TOP GOSPEL STARZ creates a commercial impression sufficiently similar to AMERICA'S NEXT TOP MODEL that consumers encountering Applicant's mark would be likely to assume a connection between the parties. Specifically, in view of the relative longevity and strength of Opposer's mark and the absence of evidence of any third-party use of AMERICA'S NEXT TOP-formative marks, we find that consumers likely will assume that Applicant's mark pertains to a brand extension of Opposer's entertainment services from models to gospel singers. "Although confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection." *Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1429 (TTAB 1993). *See also Fed. Bureau of Investigation v. Societe: "M. Bril & Co.,"* 172 USPQ 310, 315 (TTAB 1971) (under Section 2(d), a party must show that "the purchasing public would mistakenly assume that the applicant's goods or services originate with, are sponsored by, or are in some way associated with it"); *In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (stating that "mistaken belief that [a good] is manufactured or sponsored by the same entity . . . is precisely the mistake that § 2(d) of the Lanham Act seeks to prevent"). The first *du Pont* factor therefore weighs in Opposer's favor.

C. Similarity of the Services and Channels of Trade

The second and third *du Pont* factors assess the similarity or dissimilarity of the parties' goods and services and their established, likely-to-continue trade channels. We must focus on the wording of the application and registrations, rather than

what the record may reveal regarding the parties' particular goods and services, because "the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application." *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

In comparing the parties' goods, "[t]he issue to be determined . . . is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). The parties' goods or services need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods or services are related in some manner, or that the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that they originate from or are associated with the same source. See *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant's identified services are "Education and entertainment services, namely, providing a website featuring non-downloadable audio clips, video clips,

musical performances, musical videos, film clips, photographs, contests, other multimedia materials featuring music and information in the field of music.” Opposer’s most relevant goods or services, those identified in Opposer’s pleaded ’101 Registration, are “Entertainment services, namely, ongoing reality based television series; providing entertainment information concerning television program via global computer network.”

We find the parties’ services, as identified, to be similar. Applicant’s education and entertainment services include providing a website featuring video clips and film clips. Opposer’s services are a reality based television series and providing entertainment information concerning a television program via a global computer network. The broad wording “entertainment information concerning television program” in Opposer’s ’101 Registration encompasses the video clips and episodes of its television program that it provides via the Internet: through its page on Facebook.com<sup>25</sup> and the CW Television Network website,<sup>26</sup> and through other Internet-based platforms, including Hulu and Amazon Prime.<sup>27</sup>

Because the parties’ identified services are similar, the second *du Pont* factor favors Opposer.

Turning to *du Pont* factor three, the similarity of the parties’ channels of trade, there are no limitations as to channels of trade in the description of services in the application or pleaded registration. Therefore, we presume that both parties’

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<sup>25</sup> Pierson Tr. at 38:1-40:18 & Exhibit 10, 35 TTABVUE at 39-41, 128-34.

<sup>26</sup> *Id.* at 17:6-9, 34:21-35:16 & Exhibit 8, 35 TTABVUE at 18, 35-36, 123-25.

<sup>27</sup> *Id.* at 15:10-16:8, 35 TTABVUE at 16-17.

entertainment services move in all channels of trade normal for those services. *See Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Applicant argues that her mark is used for religious and proselytizing purposes, in contrast with the use of Opposer's mark, which is secular in nature, and thus the market interface of the two marks is distinct.<sup>28</sup> The weakness in Applicant's position is that we must consider her services as identified in the application. The applied-for services are not limited to religious and proselytizing purposes, or even to the field of gospel music; rather, they are identified more broadly as "Education and entertainment services, namely, providing a website featuring non-downloadable audio clips, video clips, musical performances, musical videos, film clips, photographs, contests, other multimedia materials featuring music and information in the field of music."

With respect to the third *du Pont* factor, Opposer provided evidence that the services of both parties are offered through Facebook.com, a channel we find to be normal for their identified services.<sup>29</sup> We therefore find that the similarity of the channels of trade favors a likelihood of confusion. In view of the pervasive use of

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<sup>28</sup> Applicant's Brief at 18-19, 37 TTABVUE at 19-20. "Market interface between applicant and the owner of a prior mark" is the tenth *du Pont* factor, but it pertains to business dealings between the parties. *See du Pont*, 177 USPQ at 567. We construe Applicant's argument under *du Pont* factors two and three.

<sup>29</sup> *See* Opposer's Brief at 25-26, 36 TTABVUE at 33-34.

social media and Facebook in particular,<sup>30</sup> however, we do not accord this factor great weight in our analysis.

D. Remaining *du Pont* Factors

Opposer contends that two additional factors, the variety of goods on which its mark is used and Applicant's conduct in adopting her mark, weigh in its favor.

1. Variety of Goods on which Opposer's Mark Is Used

The ninth *du Pont* factor is the variety of goods on which a mark is used. Opposer provided evidence that it has registered and licensed its AMERICA'S NEXT TOP MODEL mark for a variety of goods that are promotional in nature or collateral to its television series, including DVDs, clothing, caps, bags, dolls, key chains, posters, cosmetic brushes, and makeup.<sup>31</sup> This factor weighs slightly in favor of a likelihood of confusion. *See Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1663 (TTAB 2002).

2. Applicant's Intent in Adopting Her Mark

Finally, Opposer argues, the fact that Applicant was aware of Opposer's mark AMERICA'S NEXT TOP MODEL when she applied to register her mark AMERICA'S NEXT TOP GOSPEL STARZ favors a finding that confusion is likely.

Opposer's accusation falls under *du Pont* factor thirteen. *See L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012) (“[A] party which knowingly adopts a

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<sup>30</sup> Facebook is the world's leading social-networking website, with more than one billion users. “Facebook,” *Grolier Multimedia Encyclopedia*, GROLIER ONLINE (January 30, 2015), <http://gme.grolier.com/article?assetid=10021760>. The Board may take judicial notice of entries in standard reference works, including encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013).

<sup>31</sup> Pierson Tr. at 23:6-11, 29:15-33:10 & Exhibits 3-7, 35 TTABVUE at 24, 30-34, 67-122.

mark similar to one used by another for related goods should not be surprised to find scrutiny of the filer's motive."). It is well-established, however, that an applicant's prior knowledge of the senior mark is not enough to invoke bad-faith intent in our likelihood of confusion analysis. *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989) (quoting *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 829 (CCPA 1980)); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987) (noting that a search report showing opposer's mark is insufficient to establish intent); *Ava Enters. Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783, 1787 (TTAB 2006). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. See, e.g., *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.") (quotation omitted).

We find the final likelihood of confusion factor to be neutral.

## V. Other Claims

Because we have found for Opposer on the ground of likelihood of confusion, we need not address its claim for likelihood of dilution under Section 43(c) of the Trademark Act.

With respect to Opposer's allegation that Applicant's mark has not been used in commerce, made for the first time in its opening brief, Opposer neither pleaded such a claim nor argued that it was tried by express or implied consent of the parties

pursuant to FED. R. CIV. P. 15(b)(2), made applicable to this proceeding by Trademark Rule 2.116(a).

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. TBMP § 507.03(b) (June 2014). “The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter.” *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

Here, we cannot conclude Applicant was fairly apprised that Opposer would be asserting a claim under Section 1(a) until Opposer filed its brief. It would not be unreasonable for Applicant to assume that the written discovery and deposition questions relating to use of her mark in commerce pertained solely to the pleaded grounds of priority of use, likelihood of confusion, and dilution. *See, e.g., Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998). On the record before us, we find that Opposer’s Section 1(a) claim was not tried by implied consent. Therefore, we do not reach Opposer’s unpleaded claim under Section 1(a) of the Trademark Act.

Finally, we address Applicant’s argument that “the denial of Ms. Reed’s registration directly restricts her ability to practice her sincerely held religious

beliefs,” in violation of the First Amendment to the U.S. Constitution.<sup>32</sup> Because our jurisdiction is limited to Applicant’s registration of her mark, not her use of that mark, our decision does not implicate Applicant’s free exercise of her religious beliefs. *In re Heeb Media LLC*, 89 USPQ2d 1071, 1077 (TTAB 2008). The predecessor to our primary reviewing court made this distinction clear in *In re McGinley*, 660 F.2d 481, 211 USPQ 668, 672 (CCPA 1981):

With respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not reflect his right to use it. *Holiday Inn v. Holiday Inn, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976). No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.

## VI. Conclusion

Considering the record evidence as a whole, we find that the parties’ marks are likely to cause consumer confusion when used in association with their respective services.

**Decision:** The opposition is sustained under Trademark Act Section 2(d).

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<sup>32</sup> Applicant’s Brief at 20, 37 TTABVUE at 21.