

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: October 13, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Advance Magazine Publishers Inc.*

*v.*

*Nitashia Johnson*  
—

Opposition No. 91267229  
—

Jordan A. LaVine and Eric R. Clendening of Flaster Greenberg P.C.,  
for Advance Magazine Publishers Inc.

Laura L. Chapman of Sheppard Mullin Richter & Hampton LLP,  
for Nitashia Johnson.

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Before Lykos, Goodman, and Elgin,  
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Applicant Nitashia Johnson seeks registration on the Principal Register of the  
mark THE SELF PUBLICATION (in standard characters) for:

Education and entertainment, in particular presentation of  
works of visual art or literature to the public for cultural or  
educational purposes, in International Class 41.<sup>1</sup>

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<sup>1</sup> Application Serial No. 90094604 was filed on August 5, 2020 under Section 1(a) of the  
Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and  
use in commerce since at least as early as April 5, 2017.

Opposer Advance Magazine Publishers Inc. filed a Notice of Opposition against the registration of Applicant's proposed mark. The operative Notice of Opposition alleges claims based on likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution by blurring under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).<sup>2</sup> In support of its claims, Opposer pleads ownership of multiple registrations for SELF formative marks (standard character, typed drawing, and stylized),<sup>3</sup> including the following Principal Register registrations:

- **SELF** (typed) for “magazines for women directed to the subject of fitness in all its aspects” in International Class 16.<sup>4</sup>
- **SELF** (typed) for “providing information in the fields of nutrition, beauty and health” in International Class 44.<sup>5</sup>
- **SELF** (standard character) for “entertainment services, namely, providing a website featuring nondownloadable videos featuring fitness, fashion, exercise, health, nutrition and beauty broadcast over digital media networks” in International Class 41.<sup>6</sup>
- **SELF** (standard character) for “therapeutic apparatus, namely, chemically activated anti-cellulite wraps, ice packs, compresses, and compression bandages” in International Class 10.<sup>7</sup>

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<sup>2</sup> 11 TTABVUE; *see also* 18 TTABVUE. Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020). References to the parties' filings and evidence are to public (redacted) versions where possible; the Board refers to confidential information only in general terms.

<sup>3</sup> A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (July 2022).

<sup>4</sup> Registration No. 1120502, registered on June 19, 1979; third renewal.

<sup>5</sup> Registration No. 2785834, registered on November 25, 2003; renewed.

<sup>6</sup> Registration No. 4825914, registered on October 6, 2015; Declarations under Trademark Acts Sections 8 and 15, 15 U.S.C. §§ 1058, 1065, accepted and acknowledged.

<sup>7</sup> Registration No. 5297527, registered on September 26, 2017.

- **SELF** (standard character) for “footwear” in International Class 25.<sup>8</sup>
- **SELF** (standard character) for “training jump ropes; toning tubes; abdominal wheels; hand, wrist and ankle weights for exercise; weight lifting gloves; exercise balance balls; pumps especially adapted for use with exercise balance balls pumps; and yoga mats” in International Class 28.<sup>9</sup>
- ***SELF*** (stylized) for “pillows” in International Class 20.<sup>10</sup>
- **SELF** (standard character) for “sports bras, yoga pants, tank tops, sweatshirts” in International Class 25.<sup>11</sup>
- **SWEAT WITH SELF** (standard character) for “Providing online newsletters in the field of fitness, exercise, workout routines and health via e-mail; Education and entertainment services, namely, a continuing web-based non-downloadable video series focused on health and fitness; Entertainment in the nature of providing an informational and entertainment website in the fields of physical exercise, fitness and fitness workout routines.” in International Class 41.<sup>12</sup>
- **SELF** (standard character) for “training gloves for cross training; jump resistance training exercise bands; athletic sporting goods, namely, athletic ankle and knee supports” in International Class 28.<sup>13</sup>

Opposer also asserted ownership of pending application for:

- **SELF** (standard character) for “physical educational services, namely, organizing and promoting classes, lectures and events featuring fitness [sic], wellness, aerobics, politics and culture; organizing and hosting of events for cultural purposes; arranging and conducting educational conferences; organizing exhibitions for

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<sup>8</sup> Registration No. 5418950, registered on March 6, 2018

<sup>9</sup> Registration No. 5481616, registered on May 29, 2018.

<sup>10</sup> Registration No. 5482816, registered on May 29, 2018.

<sup>11</sup> Registration No. 5667160, registered on January 29, 2019.

<sup>12</sup> Registration No. 5697348, registered on March 12, 2019.

<sup>13</sup> Registration No. 5857765, registered on September 10, 2019.

educational purposes in the field of finances, investments, fitness, health, wellness, mind and body,” in International Class 41.<sup>14</sup>

Applicant, in her Answer, denied the salient allegations of the Notice of Opposition.<sup>15</sup> Opposer and Applicant submitted main briefs; Opposer also submitted a rebuttal brief.<sup>16</sup>

We dismiss the opposition.

## **I. Evidentiary Issues**

Before proceeding to the merits of the opposition, we address several evidentiary matters.<sup>17</sup>

First, Opposer pleaded ownership of Registration Nos. 1663404, 1721094, 2515153, 4771512, 4809091, 4752455, and 4892205, but these registrations are cancelled under Trademark Act Section 8, 15 U.S.C. § 1058.<sup>18</sup> Opposer did not rely on Registration Nos. 1663404, 2515153, 4771512, 4809091, 4752455, or 4892205 at trial. Although Opposer submitted records for Registration No. 1721094 under a notice of reliance, which was cancelled on April 14, 2023 during the parties’ testimony periods,

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<sup>14</sup> Application Serial No. 90041098, filed on July 8, 2020 on an intent-to-use basis under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), fifth extension of time to file statement of use granted.

<sup>15</sup> 19 TTABVUE.

<sup>16</sup> Opposer’s main trial brief is found at 39 TTABVUE (confidential) and 40 TTABVUE (public). Applicants’ trial brief is found at 41 TTABVUE. Opposer’s rebuttal brief is found at 42 TTABVUE.

<sup>17</sup> Applicant filed her pretrial disclosures with the Board. *See* 35 TTABVUE. “A party making a pretrial disclosure is not required to file routinely a copy of such disclosure with the Board.” TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 702.01 (June 2023).

<sup>18</sup> *See* 11 TTABVUE.

Opposer did not discuss this registration in its main or rebuttal briefs.<sup>19</sup> Accordingly, we have not considered these cancelled registrations. *See In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (expired or cancelled registrations generally are evidence only of the fact that the registrations issued); *In re Hartz Hotel Servs. Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations).

Second, Applicant interposes an objection to Opposer's eighth Notice of Reliance as "untimely."<sup>20</sup> Opposer responds that "Applicant consented to Opposer filing its rebuttal trial materials by April 3, 2023, which Opposer did."<sup>21</sup> Although the parties stipulated to extension of Opposer's rebuttal period until April 3, 2023,<sup>22</sup> the Board's order granting the motion in part revised the schedule, such that the rebuttal period closed March 6, 2023.<sup>23</sup> Accordingly, Opposer's filing was untimely, and has been given no consideration. Trademark Rule 2.123(k), 37 C.F.R. § 2.123(k); *see also* TBMP § 706.

Finally, Opposer submitted a testimony declaration that includes numerous hyperlinks to websites and YouTube videos.<sup>24</sup> Providing a hyperlink to Internet materials is insufficient to make such materials of record. *In re ADCO Indus. – Techs.*,

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<sup>19</sup> *See* Opposer's Notice of Reliance ("NOR") No. 1 (26 TTABVUE 12).

<sup>20</sup> Applicant's Trial Br. at 2 (41 TTABVUE 8); *see* Opposer's 8th NOR (filed April 3, 2023) (38 TTABVUE). Applicant also objected to "evidence" at 39 TTABVUE, but this is Opposer's main trial brief and was timely filed.

<sup>21</sup> Opposer's Rebuttal Br. at 2 (42 TTABVUE 6).

<sup>22</sup> Stipulation and Joint Motion to Extend (24 TTABVUE 2).

<sup>23</sup> 25 TTABVUE 1.

<sup>24</sup> *See* Eisinger Test. Decl. ¶¶ 11, 21, 22, 25 (33 TTABVUE 6, 8, 9, 10).

*L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided). Accordingly, we have not utilized the hyperlinks and give no consideration to arguments based on evidence purportedly found at the hyperlinks.

## **II. Dilution by Tarnishment Claim Tried by Implied Consent**

As noted above, Opposer's Amended Notice of Opposition pleads dilution by blurring under Trademark Act Section 43(c). In its brief, however, Opposer argues both dilution by blurring and dilution by tarnishment.<sup>25</sup>

"A plaintiff may not rely on an unpleaded claim in its brief, and to pursue an unpleaded claim, a plaintiff's pleading must be amended under Fed. R. Civ. P. 15(b) to assert the claim, or the claim must have been tried by express or implied consent. Fed. R. Civ. P. 15(b)." *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at \*3 (TTAB 2020) (subsequent history omitted); see Fed. R. Civ. P. 15(b)(2) ("[w]hen an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings.").<sup>26</sup>

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<sup>25</sup> Compare Amended Notice of Opposition ¶¶ 23-29 (11 TTABVUE 6-7) with Opposer's Trial Br. at 25-26, 28-29 (40 TTABVUE 31-32, 34-35).

<sup>26</sup> The Federal Rules of Civil Procedure and Federal Rules of Evidence are made applicable to Board proceedings by Trademark Rules 2.116 and 2.122(a), 37 C.F.R. §§ 2.116, 2.122(a).

Implied consent can be found only where the non-offering 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. *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 94 USPQ2d 1645, 1656 (TTAB 2010) (quoting TBMP § 507.03(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

Applicant did not object to Opposer's introduction of the dilution by tarnishment claim, and presented argument in its trial brief as to the claim.<sup>27</sup> Accordingly, we find this claim was tried by implied consent. *See Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1623 n.17 (TTAB 2013) (unpleaded claim raised at trial and argued in the briefs deemed tried by implied consent); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (unpleaded registrations tried by implied consent where "applicant has raised no objection to opposer's submission of and reliance upon these unpleaded registrations").

### **III. The Record**

The record automatically includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of Applicant's subject application.

Opposer introduced the testimony declaration of Mary Amy Eisinger, Digital Director at SELF Magazine, and attached Exhibits A-C consisting of "digital covers" of the magazine and examples of branded products.<sup>28</sup> Opposer also introduced seven notices of reliance on:

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<sup>27</sup> *See Applicant's Trial Br.* at 16-17 (41 TTABVUE 22-23).

<sup>28</sup> Testimony Declaration of Mary Amy Eisinger (33 TTABVUE (public); 34 TTABVUE (confidential)).

- TESS records of its pleaded registrations;<sup>29</sup>
- Applicant's Responses to Opposer's First Set of Interrogatories;<sup>30</sup>
- Records of eight Board proceedings from 2011 to 2022 brought by Opposer against "SELF" formative marks in connection with goods and services in International Class 41;<sup>31</sup> and
- Approximately 40 articles published in USA Today, The New York Times, The Wall Street Journal, and The Los Angeles Times in which Opposer's SELF trademarks appear.<sup>32</sup>

Applicant introduced her own testimony declaration with Exhibits A-F consisting of copies of online listings for books THE SELF PUBLICATION volumes 1-3, Applicant's website homepage, marketing materials, and invoices.<sup>33</sup> Applicant also submitted a notice of reliance on her website, Instagram page, and copies of 87 registrations owned by third parties for "self" formative marks.<sup>34</sup>

#### **IV. The Parties**

Opposer owns Condé Nast, a global mass media company that owns numerous media brands, including SELF.<sup>35</sup> Initially founded in January 1979 as a printed magazine, SELF has evolved into a website at <self.com> that covers topics such as health, fitness, food, sports, culture, and wellness. Opposer also publishes videos, podcasts, social media accounts, and email newsletters, and has sponsorships,

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<sup>29</sup> Opposer's NOR No. 1 (26 TTABVUE).

<sup>30</sup> Opposer's NOR No. 2 (27 TTABVUE).

<sup>31</sup> Opposer's NOR No. 3 (28 TTABVUE).

<sup>32</sup> Opposer's NOR Nos. 4-7 (29-32 TTABVUE).

<sup>33</sup> Testimony Declaration of Nitashia Johnson (37 TTABVUE).

<sup>34</sup> Applicant's NOR (36 TTABVUE).

<sup>35</sup> Eisinger Test. Decl. ¶ 1 (33 TTABVUE 2).



partnerships, events, and product licensing under the SELF brand.<sup>36</sup> Over the past several years, SELF has expanded coverage of product reviews, beauty, fashion, politics, travel, music, and celebrity culture.<sup>37</sup>

Opposer publishes original editorial content on its website daily, averaging over 150 new articles per month.”<sup>38</sup> “High profile and world-famous musicians, athletes, artists, and celebrities” have appeared on the “digital covers” of SELF.<sup>39</sup> The monthly readership for SELF as of 2021 included 21 million unique visitors with an average amount of 17 million minutes in time spent.<sup>40</sup> 65% of the site’s readership is located in the United States.<sup>41</sup> The “ComScore” for SELF is “20 million total views, and 30 million minutes.”<sup>42</sup>

In addition, Opposer has produced two special interest print publications for newsstand sales as recently as 2018.<sup>43</sup> SELF-branded electronic newsletters are sent out every day of the week to over 497,000 unique subscribers.<sup>44</sup> SELF has over 5.7 million followers of its social media pages across Instagram, Facebook, TikTok,

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<sup>36</sup> *Id.* at ¶ 5 (33 TTABVUE 3).

<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at ¶ 15 (33 TTABVUE 7).

<sup>39</sup> *Id.* at ¶ 7 and Exh. A (33 TTABVUE 5, 13-20). It does not appear that Opposer publishes a digital magazine designed for reading on electronic devices, although it does publish “cover stories” with photographs.

<sup>40</sup> *Id.* at ¶ 17 (33 TTABVUE 7).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* Opposer fails to provide explain what a “ComScore” is, or measures, and over what period of time.

<sup>43</sup> *Id.* at ¶ 8 and Exh. B (33 TTABVUE 5, 21-25).

<sup>44</sup> *Id.* at ¶ 18 (33 TTABVUE 8).

Snapchat, Twitter, and Pinterest, including 1.6 million on the main SELF Facebook page, an additional 26,400 on the Team SELF Facebook page, 831,000 on Instagram, 495,000 on Twitter, 608,000 on Pinterest, and over one million on TikTok.<sup>45</sup> Opposer has hosted live and virtual events in partnership with other brands or organizations.<sup>46</sup> Opposer and its employees have won several awards for SELF, including a “Webby People’s Voice Award” and “Medical, Marketing and Media (MM&M) Gold Award,” and SELF has appeared on Adweek’s Hot List and Ad Age’s Publisher’s A-List.<sup>47</sup>

Applicant is a multimedia artist.<sup>48</sup> Applicant views her services under her proposed mark THE SELF PUBLICATION as “a reflective-photographic book & video series that I created as a means to reflect internally (what I call an ‘Internal Gaze’) to celebrate the voices, resilience, and beauty of the Black community” and “dismantle stereotypes through imagery and creative writing.”<sup>49</sup> Applicant presents exhibitions in museums and plans to host a lecture series and release a documentary film.<sup>50</sup> Applicant’s services are advertised via her social media accounts and website

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<sup>45</sup> *Id.* at ¶¶ 19-20 (33 TTABVUE 8).

<sup>46</sup> *Id.* at ¶ 11 (33 TTABVUE 6).

<sup>47</sup> *Id.* at ¶ 26 (33 TTABVUE 10).

<sup>48</sup> Johnson Test. Decl. ¶ 1 (37 TTABVUE 2).

<sup>49</sup> *Id.* at ¶¶ 2, 3.

<sup>50</sup> *Id.* at ¶¶ 10, 12 (37 TTABVUE 4); Applicant’s Trial Br. at 9 (41 TTABVUE 15) (citing Johnson Test. Decl. ¶¶ 9, 10, 14, and exhibits); Johnson Test. Decl. Exhs. D (listing upcoming events and noting that “The project works as traveling exhibit and video series”) and E (images of museum exhibition, including photographs and a video, as a “project example”) (37 TTABVUE 15, 16, 46-48).

at <theselfpublication.com>; Applicant also plans to sell a “booklet” in selected museum locations.<sup>51</sup>

## V. Entitlement to a Statutory Cause of Action

“Entitlement to a statutory cause of action, formerly referred to as ‘standing’ by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case.” *Illyrian Import, Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at \*17 (TTAB 2022) (citations omitted). To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, Opposer must demonstrate (1) an interest falling within the zone of interests protected by the statute; and (2) a reasonable belief in damage proximately caused by registration of the applied-for mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2068-69 (2014)); *see also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

Evidence made of record of Opposer’s pleaded registrations for its SELF marks establishes that Opposer is entitled to oppose the registration of Applicant’s proposed mark.<sup>52</sup> *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish . . . direct commercial interest”); *New Era Cap Co.*, 2020 USPQ2d 10596, at \*6 (pleaded registrations establish

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<sup>51</sup> Opposer’s NOR No. 2, Response to Interrogatory Nos. 6, 7, and 10 (27 TTABVUE 8-9).

<sup>52</sup> Opposer’s NOR No. 1 (26 TTABVUE). Applicant did not address Opposer’s entitlement in her brief.

statutory entitlement to bring opposition). A plaintiff which shows entitlement to a statutory cause of action on one ground has the right to assert any other ground. *Hole in One Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at \*3 (TTAB 2020).

## VI. Likelihood of Confusion

To prevail on a likelihood of confusion claim, a party must prove that it owns

a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States . . . 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.

Trademark Act Section 2(d); *see also Cunningham*, 55 USPQ2d at 1848; *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at \*20 (TTAB 2022).

Accordingly, Opposer must prove by a preponderance of the evidence that (1) it has priority of a pleaded mark, and (2) use of Applicant's proposed mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Opposer's goods or services, even in the absence of contrary evidence or argument. *DC Comics*, 2022 USPQ2d 1249, at \*21 (citing *Cunningham*, 55 USPQ2d at 1848, and *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010)).

We focus our analysis on three of Opposer's pleaded marks ("SELF Marks"):

- **SELF** (Registration No. 1120502) for "magazines for women directed to the subject of fitness in all its aspects" in International Class 16.
- **SELF** (Registration No. 2785834) for "providing information in the fields of nutrition, beauty and health" in International Class 44.
- **SELF** (Registration No. 4825914) for "entertainment services, namely, providing a website featuring nondownloadable videos featuring fitness, fashion, exercise, health, nutrition and beauty broadcast over digital media networks" in International Class 41.

As Opposer appears to agree, these marks “have the most points in common with” Applicant’s THE SELF PUBLICATION mark for “Education and entertainment, in particular presentation of works of visual art or literature to the public for cultural or educational purposes,” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at \*12 (TTAB 2023), and if we find a likelihood of confusion as to Opposer’s SELF Marks based on the services noted above, “we need not find it as to Opposer’s other registered marks; conversely, if we do not find a likelihood of confusion as to Opposer’s [SELF Marks]” for the services noted above, “we would not find it as to Opposer’s other registered marks for [the] goods [or services] identified therein.” *New Era Cap Co.*, 2020 USPQ2d 10596, at \*9-10.<sup>53</sup>

#### **A. Priority**

Opposer’s Amended Notice of Opposition is limited to those goods and services recited in its pleaded registrations and application.<sup>54</sup> Opposer’s three pleaded registrations, which Applicant has not counterclaimed to cancel, establish that priority is not an issue as to the marks and the goods and services covered by the registrations. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 110 (CCPA 1974)).<sup>55</sup>

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<sup>53</sup> See Opposer’s Trial Br. at 19-20(40 TTABVUE 25-26) (discussing these three registrations).

<sup>54</sup> Amended Notice of Opposition (11 TTABVUE); see also 18 TTABVUE 5 n.1 (“Opposer’s amended Section 2(d) claim relies entirely on the marks and goods and services identified in” its pleaded registrations and application).

<sup>55</sup> Opposer appears to discuss in its brief common law rights falling outside of its pleaded registrations (such as use of SELF in connection with podcasts, sponsorships, a book club, and providing “coverage” of politics, travel, music, and “celebrity culture”). See, e.g., Opposer’s

## B. 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.” *Monster Energy*, 2023 USPQ2d 87, at \*13 (citing *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We “must consider each relevant *DuPont* factor for which there are arguments and evidence.” *Id.* at \*14.

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods].” *Id.* (citing *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.”)); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances . . . . Any single factor may control a particular

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Trial Br. at 4, 8-9 (40 TTABVUE 10, 14-15). Even if we considered Opposer’s common law rights to have been tried by implied consent of the parties, Opposer has not supplied any evidence of priority as to these rights – for example, the book club was launched in 2022, and conferences were held in 2021 and 2022. Eisinger Test. Decl. ¶¶ 11, 22 (33 TTABVUE 6, 9). Accordingly, we limit our analysis to Opposer’s pleaded registrations.

case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020).

**1. Factors 5 and 6: Strength or Weakness of Opposer’s Mark**

We first consider the strength and any weakness of Opposer’s SELF Marks, because a determination of the strength or weakness of these marks helps inform us as to their scope of protection. In doing so, we consider the fifth *DuPont* factor which enables Opposer to expand the scope of protection for its SELF Marks through evidence showing “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. We also consider the sixth *DuPont* factor, which allows Applicant to contract the scope of protection of Opposer’s mark by adducing evidence of third-party use of similar marks on similar goods. *Id.*

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself and its commercial strength in the marketplace, *Spireon Inc. v. Flex Ltd.*, 2023 USPQ2d 737, at \*4 (Fed. Cir. 2023) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010)), as well as “[t]he number and nature of similar marks in use on similar goods.” *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*17 (TTAB 2022) (quoting *DuPont*, 177 USPQ at 567). “[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003); *see also Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017).

**a. Conceptual Strength or Weakness**

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Spireon*, 2023 USPQ2d 737, at \*4 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

Because Opposer's SELF Marks registered on the Principal Register without a claim of acquired distinctiveness, they are presumed to be inherently distinctive. *See* Trademark Act Section 7(b), 15 U.S.C. 1057(b); *New Era Cap Co.*, 2020 USPQ2d 10596, at \*10 ("Opposer's mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act."); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (a "mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods."). In other words, Opposer's SELF Marks must be, at least, suggestive for Opposers' goods and services. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) ("marks that are suggestive are 'inherently distinctive' and can be registered.").

Nevertheless, SELF may be weak if it is shown to be highly suggestive. *See Spireon*, 2023 USPQ2d 737, at \*4 ("[m]arks that are . . . highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.") (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir.



2015)). On the other hand, “the fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985).

Applicant argues SELF is conceptually weak and entitled to a narrow scope of protection because it is a commonly registered term.<sup>56</sup> “[T]hird-party registrations ‘are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’” *Spireon*, 2023 USPQ2d 737, at \*4 (quoting *Juice Generation*, 115 USPQ2d at 1675); *see also Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*22 (TTAB 2021) (third-party registrations “may bear on conceptual weakness if a term is commonly registered for similar goods or services.”) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)).

In support of her argument, Applicant made of record 87 registrations containing the term SELF alone or combined with other words “in connection with substantially similar or related products and services.”<sup>57</sup> We have carefully reviewed each registration. Many are for marks that include the term SELF as part of a unitary term, such as variations of “self-made,” “self-discipline,” “self-esteem,” “selfless,” and “self-driven,” where the commercial impressions are so different that the marks are not probative. *See Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669,

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<sup>56</sup> Applicant’s Trial Br. at 5-6 (41 TTABVUE 11-12).

<sup>57</sup> *Id.* at 6 (41 TTABVUE 11); *see Applicant’s NOR Exh. C* (36 TTABVUE 29-135).

223 USPQ 1281, 1284-85 (Fed. Cir. 1984) (“None of these marks . . . conveys a commercial impression similar to that projected by the SPICE ISLANDS mark . . .”). We also do not consider those marks which, on their face, are for goods and services that are unrelated to Opposer’s SELF Marks. *Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods where the involved goods are identical, as Board must focus “on goods shown to be similar”); *cf. In re i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes . . . support a finding that registrants’ marks are weak with respect to the goods identified in their registrations”).

Accordingly, we have determined that the most relevant third-party registrations are as follows, all for marks comprised of in whole or in part of SELF for goods or services which are related, on their face, to Opposer’s goods services:

Mark	International Class (IC) / Goods and Services <sup>58</sup>
# SELFIE’S & Design <sup>59</sup>	IC 009. Downloadable electronic publications, namely newspapers, periodicals, books, magazines, journals in the field of fashion, beauty, lifestyle, shopping, e-commerce, influencer/blogger, food and beverages, travels; computer application software for providing information in the field of fashion, beauty, lifestyle, shopping, e-commerce, influencer/blogger, food and beverages, travels

<sup>58</sup> Goods and services have been truncated to show only relevant portions.

<sup>59</sup> Registration No. 5243507.

<b>Mark</b>	<b>International Class (IC) / Goods and Services<sup>58</sup></b>
	<p>IC 016. Printed matter, namely books, magazines, newspapers, periodicals in the field of fashion, beauty, lifestyle, shopping, e-commerce, influencer/blogger, food and beverages, travels</p> <p>IC 041. Services of a publishing firm, except printing, namely publishing of books, magazines, newspapers, journals and periodicals; non-downloadable electronic publications in the nature of books, newspapers, journals, magazines and periodicals, including in electronic form and on the internet, non-downloadable and other than for advertising purposes, publication of written text, images, texts, news, in particular educational and entertainment news content; news programming services, namely newspaper, book, periodical, journal and magazine publishing for transmission across the internet</p>
SELF LOVE REBEL <sup>60</sup>	IC 041. [ ] Providing on-line non-downloadable general feature magazines
SELFINTERVIEW <sup>61</sup>	IC 041. Entertainment and educational services related to interviews, namely, providing online and television programs featuring interviews of celebrities, athletes, and artists in the fields of movies, sports, news, and entertainment for entertainment purposes [ ]
SELFLESS SELFIE <sup>62</sup>	IC 041. Entertainment in the nature of providing an informational and entertainment website in the fields of celebrity gossip, entertainment, sports and fitness
SELF PRINCIPLE SLEEP EXERCISE LOVE FOOD <sup>63</sup>	IC 041. On-line journals, namely, blogs featuring information on wellness

<sup>60</sup> Registration No. 5236666.

<sup>61</sup> Registration No. 5383950.

<sup>62</sup> Registration No. 5625102; “selfie” disclaimed.

<sup>63</sup> Registration No. 5359235; “sleep exercise love food” disclaimed.

<b>Mark</b>	<b>International Class (IC) / Goods and Services<sup>58</sup></b>
SELF SOUL SPORT <sup>64</sup>	IC 041. Entertainment services, namely, providing podcasts in the field of culture and lifestyle; Organizing and hosting of events for cultural purposes
SELF HELP FOR LIFE <sup>65</sup>	IC 041. On-line journals, namely, blogs featuring personal improvement information
SELF-FULL <sup>66</sup>	<p>IC 016. Printed books in the fields of relationships, self-help, self-awareness, personal improvement, and psychology; printed training materials in the fields of relationships, self-help, self-awareness, personal improvement, and psychology; printed materials, namely, curricula in the fields of relationships, self-help, self-awareness, personal improvement, and psychology</p> <p>IC 041. [ ] publishing e-books in the fields of relationships, self-help, self-awareness, personal improvement, and psychology</p>
SELFHELPWORKS <sup>67</sup>	IC 009. Digital media, namely, pre-recorded cds, pre-recorded dvds, and digital video discs featuring information on health, physical wellness, lifestyle, nutrition, exercise, stopping smoking, quitting alcohol, managing diabetes, managing anxiety, managing depression, weight control and weight management; downloadable audio and video recordings featuring information on health, physical wellness, lifestyle, nutrition, exercise, stopping smoking, quitting alcohol, managing diabetes, managing anxiety, managing depression, weight control and weight management; downloadable electronic publications, namely, e-books, manuals, and journals in the field of health, physical wellness, lifestyle, nutrition, exercise, stopping smoking, quitting alcohol, managing diabetes, managing anxiety, managing depression, weight

<sup>64</sup> Registration No. 5600045; “sport” disclaimed.

<sup>65</sup> Registration No. 5673905; “self help” disclaimed.

<sup>66</sup> Registration No. 6019917.

<sup>67</sup> Registration No. 6179099.

<b>Mark</b>	<b>International Class (IC) / Goods and Services<sup>58</sup></b>
	<p>control and weight management; downloadable educational course materials in the field of health, physical wellness, lifestyle, nutrition, exercise, stopping smoking, quitting alcohol, managing diabetes, managing anxiety, managing depression, weight control and weight management</p> <p>IC. 041. Educational and training services, namely, conducting electronic online sessions, seminars, webinars, conferences and workshops in the field of health, physical wellness, lifestyle, nutrition, exercise, stopping smoking, quitting alcohol, managing diabetes, managing anxiety, managing depression, weight control and weight management and distribution of course material in connection therewith</p>
<p><b>SELF WORTH EXPERIENCE<sup>68</sup></b></p>	<p>IC 041. [ ] On-line journals, namely, blogs featuring self-empowerment, stress reduction, personal growth, physical and spiritual wellness; On-line video journals, namely, vlogs featuring nondownloadable videos in the field of self-empowerment, stress reduction, personal growth, physical and spiritual wellness; [ ] Providing a website featuring blogs and non-downloadable publications in the nature of articles and brochures in the field(s) of self-empowerment, stress reduction, personal growth, physical and spiritual wellness [ ]</p>
<p><b>SELF-HYPE<sup>69</sup></b></p>	<p>IC 041. [ ] Providing a web site featuring non-downloadable instructional videos in the field of self-improvement and personal development</p>
<p><b>SELF CARE LIFESTYLE<sup>70</sup></b></p>	<p>IC 041. [ ] Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment services, namely, providing podcasts in the field of personal development and empowerment; Entertainment services, namely, providing video</p>

<sup>68</sup> Registration No. 6220403.

<sup>69</sup> Registration No. 6602024.

<sup>70</sup> Registration No. 6587054; “self care” disclaimed.

<b>Mark</b>	<b>International Class (IC) / Goods and Services<sup>58</sup></b>
	<p>podcasts in the field of personal development and empowerment; [ ] On-line journals, namely, blogs featuring personal development and empowerment; On-line video journals, namely, vlogs featuring nondownloadable videos in the field of personal development and empowerment; [ ] Providing a website featuring blogs and non-downloadable publications in the nature of articles, brochures in the fields of personal development and empowerment; [ ] Entertainment services, namely, an ongoing series featuring personal development and empowerment provided through webcasts viewable on blogs, websites and social media platforms; Entertainment services, namely, providing webcasts in the field of personal development and empowerment; Entertainment services, namely, providing ongoing webisodes featuring personal development and empowerment via a global computer network; [ ] Production of podcasts; [ ] Providing on-line digital publications in the nature of blogs and online journals viewable on websites in the field of personal development and empowerment via the Internet; Providing on-line videos featuring personal development and empowerment, not downloadable; Providing on-line tutorial videos in the field of personal development and empowerment, not downloadable; Providing a website featuring non-downloadable audio recordings in the field of personal development and empowerment; Providing a website featuring non-downloadable photographs; Providing a website featuring non-downloadable photographs in the field of personal development and empowerment; Providing a website featuring non-downloadable videos in the field of personal development and empowerment; [ ] Providing on-line publications in the nature of e-books in the field of personal development and empowerment; Providing online non-downloadable journals in the field of personal development and empowerment; Providing online non-downloadable visual and audio recordings featuring personal development and empowerment; Providing online non-downloadable e-books in the field of personal development and empowerment; Providing online non-</p>

<b>Mark</b>	<b>International Class (IC) / Goods and Services<sup>58</sup></b>
	downloadable tutorial e-books in the field of personal development and empowerment
SELF-LOVE BREAKFAST CLUB & Design <sup>71</sup>	IC 041. [ ] Entertainment services, namely, providing podcasts in the field of wellness, food, health, fitness, nutrition, and personal development

Opposer does not indicate that it challenged registration of any of these registrations, all of which issued after the earliest registration of its SELF Marks. Further, Opposer submitted evidence indicating that SELF, as used in its marks, is suggestive of “be[ing] your best self”:<sup>72</sup>



In sum, we find that SELF has been weakened by third-party registrations and is conceptually weak due to its suggestive nature.

<sup>71</sup> Registration No. 6730897.

<sup>72</sup> Eisinger Test. Decl. Exh. B (33 TTABVUE 21).

**b. Fame or Commercial Strength or Weakness**

The commercial strength of Opposer's SELF Marks is "based on marketplace recognition of the marks," *Made in Nature*, 2022 USPQ2d 557, at \*21, and "may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Omaha Steaks*, 128 USPQ2d at 1689-90 (quoting *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (internal citations omitted)). Commercial strength also may be measured by "widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services." *Monster Energy*, 2023 USPQ2d 87, at \*22 (internal quotations omitted).

Applicant did not introduce any evidence of third-party uses that would establish any diminished commercial or marketplace strength of the mark under the sixth *DuPont* factor. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."); see also *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1675-76. We do not accord Applicant's evidence of third-party registrations probative weight, as registrations alone do not demonstrate "market context" or "make [ ] clear that consumers are accustomed to distinguishing between" marks because they are not evidence of the extent of use in the marketplace. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973); *In re Morinaga Nyugyo K. K.*,



120 USPQ2d 1738, 1745 (TTAB 2016) (“[T] hird-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”).<sup>73</sup>

Opposer argues that its SELF Marks fall on the higher end of the fame spectrum under the fifth *DuPont* factor.<sup>74</sup> A famous mark has extensive public recognition and renown. *Bose*, 63 USPQ2d at 1305; *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). “Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use,” *Omaha Steaks*, 128 USPQ2d at 1689-90 (citing *Bose*, 63 USPQ2d at 1305). As a result, it is incumbent on Opposer to clearly prove that its SELF Marks are famous. *Made in Nature*, 2022 USPQ2d 557, at \*31 (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012)).

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<sup>73</sup> In *Spireon* (which issued after briefing was completed in this case), the Federal Circuit held that when the defendant submits third-party registrations of marks that are “identical” to the plaintiff’s mark and cover goods that are “identical” to those for which the plaintiff’s mark is registered, the plaintiff bears the burden of showing that the marks are not in use. *Spireon*, 2023 USPQ2d 737, at \*7. None of the third party registered marks is identical to Opposer’s mark for purposes of triggering the burden of proof re-allocation established under the narrow circumstances in *Spireon*. Accordingly, “the burden rested on [Applicant] to establish that [the] prior marks were actually in use.” *Id.*, at \*6 (citing *AMF*, 177 USPQ at 269-70).

<sup>74</sup> Opposer’s Trial Br. at 9-11, 20-23 (40 TTABVUE 15-17, 26-29).

“Fame for confusion purposes arises as long as a significant portion of the relevant consuming public recognizes the mark as a source indicator.” *Id.* (citing *Palm Bay*, 73 USPQ2d at 1694). Here, the “relevant consuming public” consists of purchasers of the services identified in Opposer’s SELF Marks. Likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. It “varies along a spectrum from very strong to very weak.” *Palm Bay*, 73 USPQ2d at 1694 (quoting *In re Coors Brewing Co.*, 68 USPQ2d at 1063).

Opposer mainly relies on the following as indicators of the fame of the SELF Marks: the number of monthly unique visitors to the <self.com> website and minutes spent on the site; its “ComScore” (which Opposer does not explain); the number of followers of its social media accounts, which have grown in recent years; the appearance of celebrities on the digital covers of SELF; its accolades and awards; mentions in *The New York Times*, *USA Today*, *The Wall Street Journal*, and *The Los Angeles Times*; and confidentially-provided advertising and consumer revenues, and expenditures for “content costs, consumer marketing, and production and distribution costs” from 2019 to 2021 and projected numbers for 2022.<sup>75</sup>

Although these indicators of success are, by any measure, substantial, at least for the past few years, Opposer has only provided recent figures and has not provided any context for any of the figures, so we cannot measure them against other like

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<sup>75</sup> *Id.* at 9-10 (40 TTABVUE 15-16); Opposer’s Confidential Trial Br. at 9-10 (39 TTABVUE 15-16). Aside from “consumer marketing,” which we intuit are advertising costs, Opposer has not explained what “content costs” and “production and distribution costs” are (especially the latter, particularly as SELF is a digital publication). Thus, we cannot determine if these costs would have an impact on consumer perception.

brands – even as against Opposer’s many other publications for which it surely had ready access to such information. We also do not know the percentages of revenues and expenses are attributable to the United States. Indeed, because substantially all of Opposer’s revenue appears to come from non-consumer sources (e.g. advertising), we dare not attempt to extrapolate based on online readership numbers alone. Thus, we cannot gauge the relative level of success or the degree of exposure the general public has had to the SELF trademark based on these numbers. *Cf. Omaha Steaks*, 128 USPQ2d at 1689-92; *Bose*, 63 USPQ2d at 1309.

As to Opposer’s other evidence of fame, Ms. Eisinger testified as to awards won by SELF publications and editors, but there is no showing that consumers are aware of these accolades.<sup>76</sup> Opposer provided its remaining subsisting registrations for a variety of goods and services, the earliest of which issued in 1979. Opposer also provided the final orders dismissing eight opposition proceedings brought against SELF formative marks, but none of these orders were on the merits. Opposer made of record over 40 articles from the Lexis/Nexis database, spread over the past two decades from what it terms “the most widely read print and online publications.”<sup>77</sup>

In comparison to the type and amount of evidence found to be persuasive for purposes of demonstrating the renown or fame of a mark, Opposer’s testimony and evidence falls short, and is more in tune with cases where the Board has found marks to have achieved moderate commercial success. *Compare Omaha Steaks*,

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<sup>76</sup> Eisinger Test. Decl. ¶ 25 (33 TTABVUE 9).

<sup>77</sup> *Id.* at 17.

128 USPQ2d at 1690 (fame of OMAHA STEAKS mark supported by annual advertising expenditures of \$45-50 million and 100,000 orders per day processed during the holiday season); *Palm Bay*, 73 USPQ2d at 1691 (VEUVE CLICQUOT found famous amongst purchasers of champagne and sparkling wine based in part upon sales in 8,000 establishments; extensive promotional campaign consisting of print advertisements in general interest magazines and in wine specialty magazines, radio ads, point-of-sale displays, wine tastings; unsolicited recognition in New York Times, Boston Globe, Money Magazine); *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark for loudspeaker systems supported by \$50 million in annual sales and \$5 million in annual advertising); *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 899 F.2d 1070, 12 USPQ2d 1901, 1902 (Fed. Cir. 1989) (fame of NINA RICCI for fragrance products supported by \$350 million in retail sales and around \$37 million in advertising and sales promotion expenditures between 1981 and 1986), *with Sock It To Me v. Aiping Fan*, 2020 USPQ2d 10611, at \*8 (TTAB 2020) (moderate commercial strength found for an opposer who used the mark in commerce with socks and stockings since October 2004; experienced significant and substantial growth in gross sales between 2004 and 2017; sold more than 12 million pairs of socks in the United States; showed impressive gains in a market filled with larger competitors; has substantial marketing expenditures and advertises extensively-online, via social media, and in trade shows, and catalogs; and received favorable media coverage about its humble origins and rapid expansion on well-known publications such as Marie Claire, Elle, Seventeen, Vogue, The Wall Street Journal, and Forbes); *Brooklyn*

*Brewery*, 2020 USPQ2d 10914, at \*18 (finding plaintiff achieved a degree of commercial recognition of its BROOKLYN BREWERY mark for beer from more than 30 years use, annual revenues in the tens of millions of dollars, recognition from winning a number of awards, and extensive unsolicited media coverage).

Ultimately, and considered as a whole, Opposer's evidence establishes that the SELF trademark for magazines, online information, newsletters, and the like directed to individual's health and wellness, and collateral merchandise, has achieved moderate commercial strength, but the evidence falls short of clearly establishing that the mark falls on the high end of the fame spectrum. *See Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007) ("It is the duty of a party asserting that its mark is famous to clearly prove it.") (citation omitted).

**c. Strength Factors**

In sum, Opposer's SELF marks are conceptually weak, but commercially moderately strong.

**2. Factor 1: Similarity of the Marks**

Next, we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay*, 73 USPQ2d at 1692 (citing *DuPont*, 177 USPQ at 567). "Similarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 68 USPQ2d at 1062).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks

into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *See Stone Lion*, 110 USPQ2d at 1164.

Further, the marks “must be considered . . . in light of the fallibility of memory . . . .” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

Comparing Opposer’s SELF Marks with Applicant’s proposed mark THE SELF PUBLICATION, all are in standard or typed characters and not limited to any particular font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Obviously, the marks share the formative term “self.” Opposer argues that inclusion of the word THE is insignificant, and PUBLICATION does not eliminate the potential

for confusion because it is descriptive of Applicant's services and the word publication means "the act of bringing before the public" or an "announcement."<sup>78</sup>

Applicant argues:

The inclusion of the word "the" used before the noun "self" transforms the meaning of Applicant's Mark as denoting particular, specified persons—here, the Black community. Similarly, the term "publication" connotes the act of bringing something before the public which was before reflected only internally (Internal Gaze)—the real stories and representation of the Black community.<sup>79</sup>

Both parties' arguments are unsupported by evidence – Opposer, because it did not submit any dictionary definitions for "publication" or other evidence of descriptiveness that we may rely on, and Applicant, because her declaration does not clearly support her argument as to the connotation of her proposed mark. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (citing *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.")).

We find, therefore, that the definite article THE in Applicant's proposed mark is insignificant as a source identifier or differentiator between marks and "does not have trademark significance." *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE confusingly similar).<sup>80</sup> The term PUBLICATION in Applicant's proposed mark neither is disclaimed nor has been

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<sup>78</sup> Opposer's Trial Br. at 15, 17 (40 TTABVUE 21, 23); Opposer's Rebuttal Br. at 3-4 (42 TTABVUE 7-8).

<sup>79</sup> Applicant's Trial Br. at 7 (citing Johnson Test. Decl. ¶¶ 2, 6) (41 TTABVUE 13) .

<sup>80</sup> *See* Opposer's Trial Br. at 15-16 (40 TTABVUE 21-22).

shown by Opposer to be merely descriptive of Applicant's "presentation of works of visual art or literature to the public for cultural or educational purposes" services or otherwise weak.<sup>81</sup> Nonetheless, the term PUBLICATION plainly refers to the types of goods and services provided under Opposer's SELF Marks, bolstering the connection between the two.

Taken together, the entire mark THE SELF PUBLICATION is more similar than dissimilar in appearance and connotation to Opposer's SELF as they both suggest a publication that seeks to improve or better oneself. Thus, the first *DuPont* factor favors a finding of likelihood of confusion. *In re Embiid*, 2021 USPQ2d 577, at \*11 (TTAB 2021) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.") (quoting *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018)).

### **3. Factor 2: Similarity of the Goods and Services**

Under the second *DuPont* factor, we compare the goods and services as they are identified in the subject application and pleaded registrations for Opposer's SELF Marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). We must look to the goods and services as identified in the involved application and pleaded registrations, not to any extrinsic evidence of actual use. *Stone Lion*, 110 USPQ2d at

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<sup>81</sup> *See id.* at 16-17 (arguing "publication" is descriptive) (40 TTABVUE 22-23).



1162 (it is proper for the Board to focus on “the application and registrations rather than on real-world conditions.”).

To review, Opposer’s goods and services are: “magazines for women directed to the subject of fitness in all its aspects” in International Class 16; “providing information in the fields of nutrition, beauty and health” in International Class 44; and “entertainment services, namely, providing a website featuring nondownloadable videos featuring fitness, fashion, exercise, health, nutrition and beauty broadcast over digital media networks” in International Class 41. Applicant’s services are “education and entertainment, in particular presentation of works of visual art or literature to the public for cultural or educational purposes.”

As an initial matter, Applicant appears to be under the misapprehension that her recitation of services encompasses the sale of print books.<sup>82</sup> This is not the case; the sale of one’s own goods (here, in International Class 16) is not a registrable service for others. *In re Reichhold Chems., Inc.*, 167 USPQ 376, 377 (TTAB 1970) (“It is well settled that promoting the sale and use of one’s goods is not, per se, a service within the meaning of the statute.”).

For its part, Opposer contends that Applicant’s identification of services is “very broad and overlapping” with Opposer’s goods and services.<sup>83</sup> But, Opposer also appears to buy into Applicant’s argument that her “service” relates to printed book sales, targeted to specific persons. Opposer argues that it has expanded its goods and

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<sup>82</sup> See Applicant’s Trial Br. at 2-3, 15 (41 TTABVUE 8-9).

<sup>83</sup> Opposer’s Trial Br. at 18 (40 TTABVUE 24).

services to multiple media for purposes related to art, literature, and culture, including targeting the Black community through services “relating to literature,” such as a “book club that has promoted African-American literature” and articles relating to healthcare concerns for Black women.<sup>84</sup> Not only does Opposer appear to misconstrue the nature of Applicant’s services, it also failed to establish prior common law rights as to these so-called “overlapping” services.<sup>85</sup>

Opposer also argues that there need only be a “viable relationship between the goods or services in order to support a holding of likelihood of confusion” because “the marks are the same or almost so.”<sup>86</sup> This somewhat overstates the matter, as the Federal Circuit recently clarified that the applicable legal test for the required degree of similarity between goods or services for confusion to be likely between identical marks (i.e., “even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”) is the same, whether or not the term “viable relationship” is used. *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at \*8 n.3 (Fed. Cir. 2022) (citations omitted). Nonetheless, here the parties’ marks are more similar than dissimilar, but they are not “identical.” *Cf. DeVivo v. Ortiz*, 2020 USPQ2d 10153, at \*11 (TTAB 2020) (“[B]ecause the marks are identical, the degree of similarity

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<sup>84</sup> *Id.* at 17, 18 (40 TTABVUE 23, 24); Opposer’s Rebuttal Br. at 5, 6 (citing Eisinger Test. Decl. ¶¶ 22, 25) (42 TTABVUE 9, 10).

<sup>85</sup> *See supra* Section VI(A).

<sup>86</sup> Opposer’s Trial Br. at 18 (citing *In re Concordia Int’l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983)) (40 TTABVUE 24).

between the goods . . . required for confusion to be likely declines.”) (citing *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015)).

Contrary to Opposer’s assertions, the identifications in Applicant’s application and Opposer’s registered SELF Marks do not cover the same subject matter. Applicant has limited her identification to presentation of works of literature and art for cultural and educational purposes. We fail to see how this is related to Opposer’s magazines, information, and videos on a website limited to fitness, fashion, exercise, health, nutrition, or beauty. Opposer introduced no evidence to show that the goods and services are related, such as news articles and/or website evidence showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant’s services and Opposer’s goods and services. *Cf. In re Charger Ventures LLC*, 2023 USPQ2d 451, at \*5-6 (Fed. Cir. 2023) (“Because the record shows that companies are known to offer both . . . services under the same mark and, often, on the same website, we find that substantial evidence supports the Board’s finding on [similarity of services.]”); *Hewlett-Packard*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis.”); *In re ICoat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (evidence of third party use and registrations probative of relatedness of goods).

The second *Dupont* factor weighs against finding likelihood of confusion.

**4. Factor 3: Similarity of Established, Likely-to-Continue Channels of Trade**

This brings us to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers as delineated in the identifications. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1051. As with the second *DuPont* factor, we look to the language of the identifications of goods and services, and not “real world conditions.” *Stone Lion*, 110 USPQ2d at 1162.

Because there are no limitations as to channels of trade or classes of purchasers in the parties’ application and registrations, we must presume that the identified goods and services move in all channels of trade normal for such goods and services and are available to all potential classes of ordinary consumers of such goods and services. *See id.* at 1052 (citing *In re i.am.symbolic*, 866 F.3d at 1327); *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *see also B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 143 (2015) (explaining if an “application does not delimit any specific trade channels of distribution, no limitation will be applied”) (internal quotation and citation omitted).<sup>87</sup>

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<sup>87</sup> Applicant’s assertion that her target consumers are “individuals in the Black community who have been affected by colorism,” Applicant’s Trial Br. at 2 (41 TTABVUE 8), and Opposer’s assertion that it publishes articles on topics of interest to Black women, Opposer’s Trial Br. at 24 (40 TTABVUE 30), are irrelevant as there are no such demographic restrictions in the identifications. *See In re i.am.symbolic*, 866 F.3d at 1327 (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.”).

To reiterate, Applicant's services are identified as: "Education and entertainment, in particular presentation of works of visual art or literature to the public for cultural or educational purposes." Because what the normal channel of trade of Applicant's "presentation" services are is not apparent from the face of the application, we may look to extrinsic evidence for clarification. *Cf. In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) ("when the description of goods for a cited registration is somewhat unclear . . . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade."). Applicant's testimony informs us that she provides exhibitions at museums, and this is confirmed by the website evidence of record.<sup>88</sup> Opposer's print magazines presumably are sold through normal channels for such goods (i.e. newsstands, grocery stores, etc.), and the evidence of record shows that its services are delivered through a website, electronic newsletters, and social media accounts.<sup>89</sup> Opposer has not introduced any evidence that the typical trade channel for its goods or services are museums.

Opposer is mistaken that the parties' trade channels overlap because "both utilize a website and social [media] as primary avenues of promoting, offering, and selling their respective services."<sup>90</sup> Applicant's website and social media accounts are mere

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<sup>88</sup> *See supra* note 50 and accompanying text.

<sup>89</sup> Opposer's Trial Br. at 5-6, 24 (40 TTABVUE 11-12, 30).

<sup>90</sup> *Id.* at 24 (40 TTABVUE 30).

advertising for the sale of her books and services, not a channel of trade for delivery of her involved presentation services.<sup>91</sup> Moreover, the Board has long recognized that the “Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet,” *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (quoting *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007)), and “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1743 (TTAB 2014) (quoting *Parfums de Coeur*, 83 USPQ2d at 1021); *see also* J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:53.5 (5th ed. Sept. 2023 update) (“That the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.”). Notably, there is no evidence of record that Opposer’s goods or services and Applicant’s services are provided or advertised through the *same* websites or the *same* social media accounts.

We find that the channels of trade for the parties’ involved goods and services do not overlap. Therefore, the third *DuPont* factor is neutral. *See, e.g., Bond*,

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<sup>91</sup> *See* Johnson Test. Decl. Exhs. A-D (website excerpts) (37 TTABVUE 8-17); Applicant’s NOR Exh. B (Instagram excerpts) (36 TTABVUE 24-28).

119 USPQ2d at 1054 (third *DuPont* factor deemed neutral where insufficient evidence showing overlap of trade channels).

#### **5. Factor 4: Similarity of Conditions of Purchase**

We next turn to the fourth *DuPont* factor, the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). “Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Palm Bay*, 73 USPQ2d at 1695; *see also Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”).

Opposer contends this factor also favors likelihood of confusion, but it does not provide any evidence supporting this statement.<sup>92</sup> Even so, we note that Opposer’s services in Classes 41 and 44 appear to be provided to consumers largely on the Internet for free; Opposer’s special edition print magazines (Class 16) cost under \$15.<sup>93</sup> As noted above, Applicant’s services appear to be provided through museum

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<sup>92</sup> *See id.* at 25-26 (40 TTABVUE 30-31).

<sup>93</sup> *See* Eisinger Test. Decl. Exh. B (33 TTABVUE 25).

exhibitions, but there is no indication if these events are open for free or are ticketed sales, and if so at what cost.<sup>94</sup> Although we may presume that Opposer's goods and services are subject to impulse purchasing made with a lesser standard of purchasing care, there is no evidence as to the level of care that would be exercised by the least sophisticated consumer of Applicant's services.

Accordingly, the fourth *DuPont* factor is neutral in our analysis. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1483 (TTAB 2014) (finding the fourth *DuPont* factor neutral where there is argument in the briefs regarding the conditions of sale and purchaser sophistication but no evidentiary support).

#### **6. Factors 7 and 8: Lack of Actual Confusion**

Under the seventh and eighth *DuPont* factors, we consider the "nature and extent of any actual confusion" in light of "the length of time and conditions under which there has been concurrent use without evidence of actual confusion." *DuPont*, 177 USPQ at 567. The seventh and eighth factors are interrelated; the absence of evidence of actual confusion by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence that there has been a significant opportunity for actual confusion to have occurred. *See Citigroup Inc.*, 94 USPQ2d at 1660; *In re Cont'l Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Applicant argues, "[t]here have also been no instances of actual confusion between Applicant's Mark and Opposer's Marks notwithstanding that they have been

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<sup>94</sup> Opposer's NOR No. 2, Applicant's Response to Interrogatory No. 10 (27 TTABVUE 10).



coexisting in the marketplace for over six years since Applicant commenced use of [her] mark for the applied-for services in April 2017.”<sup>95</sup> Opposer contends the seventh and eighth factors are neutral because “contemporaneous use of marks for six years is legally inconsequential.”<sup>96</sup>

Applicant presented minimal evidence regarding the extent of use of her mark THE SELF PUBLICATION for her services since 2017. Although the number of subscribers on her Instagram page is inadmissible hearsay, that number on its face pales in comparison to Opposer’s 831,000 followers.<sup>97</sup> She made a profit of only \$877.21 in 2021, but there is no evidence of record whether this is attributed to her services or sale of books and collateral merchandise.<sup>98</sup>

There is no evidence of record to suggest that there has been significant opportunity for actual confusion to have occurred. We find the seventh and eighth *DuPont* factors to be neutral.

**7. Factor 9: Variety of Goods and Services on Which Mark is Used**

“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, at \*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

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<sup>95</sup> Applicant’s Trial Br. at 10 (41 TTABVUE 16).

<sup>96</sup> Opposer’s Rebuttal Trial Br. at 10 (42 TTABVUE 14).

<sup>97</sup> *Compare* Applicant’s NOR Exh. B (36 TTABVUE 24-28) with *Eisinger Test. Decl.* ¶ 19 (33 TTABVUE 8).

<sup>98</sup> Opposer’s NOR No. 2, Applicant’s Response to Interrogatory No. 14 (27 TTABVUE 10).

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 asserts that SELF is a "house mark" based on "substantial record evidence showing use of the mark for "magazines, newsletters, websites, video, podcasts, social media engagement, sponsorships, partnerships, event activations, awards," along with "SELF-branded merchandise" such as "workout equipment, shower and bath accessories, activewear apparel . . . and sexual wellness products. . . ."99

Several of the referenced activities are subsumed within the services that we considered under the second *DuPont* factor, and the few other activities, all concentrated in the fitness and personal care spaces, "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, at \*15.

We find the ninth *DuPont* factor to be neutral.

#### **8. Weighing the *DuPont* Factors<sup>100</sup>**

We have carefully considered and weighed all of the evidence made of record, as well as all of the arguments related thereto. *See In re Charger Ventures*, 2023 USPQ2d 451, at \*7.

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<sup>99</sup> Opposer's Trial Br. at 6, 23 (40 TTABVUE 12, 29).

<sup>100</sup> Opposer asserts that the "tenth, eleventh, and twelfth factors are neutral and favor neither party." *Id.* at 25 (40 TTABVUE 31). Applicant does not address these factors. Therefore, we find these factors to be neutral.

Any of the *DuPont* factors may play a dominant role in our analysis; and in some cases, even a single factor is dispositive. See *Stratus Networks*, 2020 USPQ2d 10341, at \*3 (“Any single factor may control a particular case”); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (“[W]e have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis . . . .”); *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (a single *DuPont* factor may be dispositive in a likelihood of confusion analysis); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (“[E]ven though opposer’s services and applicant’s product are or can be marketed to the same class of customers, namely plumbing contractors, these services and goods are so different that confusion is not likely even if they are marketed under the same mark.”); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669-70 (TTAB 1986) (opposition dismissed because the goods were “quite different,” notwithstanding that the marks were “virtually the same”). We find this to be such a case.

Notwithstanding that Applicant’s mark is similar to Opposer’s SELF Marks under the first *DuPont* factor and the more moderate scope of protection accorded to Opposer’s marks under the fifth and sixth *DuPont* factors, Opposer has not shown that Applicant’s services and Opposer’s goods and services are related. We find that confusion is not likely. Accordingly, Opposer has failed to prove likelihood of confusion by a preponderance of the evidence.

## VII. Dilution by Blurring and Tarnishment

We now turn to Opposer's claims of dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Both claims require Opposer to prove in the first instance that it has a "famous mark," that is, one that "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Trademark Act Section 43(c)(2)(A). Thus, a threshold question in a dilution claim is whether Opposer's SELF Marks are "famous." *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015).

It is well-established that dilution fame is difficult to prove. *Coach Servs.*, 101 USPQ2d at 1724 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001)). An opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Toro*, 61 USPQ2d at 1181. A famous mark is one that has become a "household name." *Coach Servs.*, 101 USPQ2d at 1725 (internal citations omitted).

In light of our finding above that Opposer has not demonstrated a high level of fame for likelihood of confusion purposes, it is axiomatic that Opposer has not reached the more stringent requirement for dilution fame. This is particularly the case because, aside from testimony that the mark has been in use since 1979 and certain news articles, Opposer has provided little evidence pointing to the renown of the mark

prior to April 2017, the date Opposer concedes Applicant commenced use.<sup>101</sup> *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1250 (TTAB 2015) (“[A]n element of the dilution claim is the acquisition of fame prior to the defendant’s first use or application filing date”). Because Opposer has not proven dilution fame, its dilution by blurring and tarnishment claims must fail.

**Decision:** Opposer’s likelihood of confusion and dilution claims under Sections 2(d) and 43(c) are dismissed.

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<sup>101</sup> *See* Opposer’s Trial Br. (40 TTABVUE 33) (“The evidence reflects that Opposer’s SELF mark was famous prior to the date when Applicant began using [her] mark in commerce (April 2017).”).