

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: July 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Veronica Morales d/b/a Blue Ivy*

*v.*

*BGK Trademark Holdings, LLC*  
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Opposition No. 91234467  
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Ryan E. Hatch of the Law Office of Ryan E. Hatch,  
for Veronica Morales d/b/a Blue Ivy.

Marvin S. Putnam of Latham & Watkins LLP,  
for BGK Trademark Holdings, LLC.

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Before Cataldo, Greenbaum, and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

BGK Trademark Holdings, LLC (“Applicant”), is a Delaware limited liability company that is wholly owned by singer, songwriter, and actress Beyoncé Giselle Knowles-Carter, its sole member.<sup>1</sup> Applicant seeks registration on the Principal

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<sup>1</sup> 7 TTABVUE 13 (Applicant’s Answer). Citations to the record reference TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer(s) to the page number(s) of the docket entry where the cited materials appear.

Register of the mark BLUE IVY CARTER, the namesake of Mrs. Carter's daughter, in standard characters, for a variety of goods and services in fourteen international classes including:

Fragrances, cosmetics, skin care products, namely, non-medicated skin care preparations, non-medicated skin care creams and lotions, namely, body cream, hand cream, skin lotion, body lotions, skin moisturizers, skin emollient, skin cleansing creams, skin cleansing lotions, all for adults and infants; hair care products, namely, non-medicated hair care preparations, non-medicated hair gel, shampoo, conditioner, hair mousse, hair oils, hair pomades, hair spray, in International Class 3;

Metal key chains and metal key rings, in International Class 6;

DVDs, CDs, and audio and visual sound recordings featuring musical performances; musical sound recordings; computer application software for mobile phones, portable media players, and handheld computers for use in downloading music, ring tones and video games; handheld and mobile digital electronic devices, namely, tablet PCs, cellular phones, laptops, portable media players, handheld computers; cases and covers for mobile phones and mobile digital electronic devices, namely, laptops, cell phones, radio pagers, mobile computers; downloadable web-based application software in the nature of a mobile application downloadable to handheld and mobile digital electronic devices for use in downloading music, ring tones and video games; decorative magnets, eyewear, eyeglass cases; computer bags; graduated glassware, in International Class 9;

Baby teething rings, in International Class 10;

Baby carriages, baby strollers, in International Class 12;

Books in the field of music, motion pictures, musical performers; photographs; posters; baby books; stickers; print materials, namely, art prints, color prints, concert programs, calendars, pens, post cards; gift bags; paper flags; trading cards; paper baby bibs, in International Class 16;

Bags, namely, tote bags, beach bags, handbags, diaper bags, baby carriers worn on the body, pouch baby carriers, luggage; small leather goods, namely, leather cases, leather bags and wallets, leather purses, leather billfolds, leather key chains, leather key cases, in International Class 18;

Plastic key chains and plastic key rings; small leather goods, namely, leather picture frames, leather key fobs, and leather key holders; plastic flags; vinyl banners, baby bouncers, baby changing mats, baby changing tables, high chairs for babies, playpens for babies, in International Class 20;

Mugs; beverage glassware; plastic water bottles sold empty; hair accessories, namely, hair combs; baby bathtubs; drinking cups for babies, in International Class 21;

Banners of cloth, nylon; flags, namely, cloth flags, nylon flags; towels; baby bedding, namely, bundle bags, swaddling blankets, crib bumpers, fitted crib sheets, crib skirts, crib blankets; baby blankets, in International Class 24;

Hair accessories, namely, hair ties, hair scrunchies, barrettes, hair bands, hair bows, hair clips, hair pins, hair ribbons, ponytail holders; novelty button; hair accessories, namely, electric hair-curlers, other than hand implements, in International Class 26;

Playing cards, balls, namely, basketballs, baseballs, footballs, kick balls, rubber balls, beach balls, golf balls, hand balls, tennis balls, racquet balls, soccer balls, sport balls; dolls, baby multiple activity toys, baby rattles, baby swings, in International Class 28;

Product merchandising for others; online retail store services featuring music, musical recordings, motion pictures, clothing and clothing accessories, novelty items; Entertainment marketing services, namely, marketing, promotion and advertising for recording and performing artists, in International Class 35; and

Entertainment services, namely, providing online video games, dance events by a recording artist, multimedia production services; Entertainment services in the nature of live musical performances; production of motion picture films, fan clubs, in International Class 41.<sup>2</sup>

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<sup>2</sup> Application Serial No. 86883293 was filed on January 2, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intention to use the mark in commerce. The application includes the following statement: The name “BLUE IVY CARTER” identifies a living individual whose consent is of record.

Veronica Morales (“Opposer”) is the owner and founder of a lifestyle event planning company doing business under the name “Blue Ivy.”<sup>3</sup> She has opposed registration of Applicant’s mark BLUE IVY CARTER on three grounds: (1) that Applicant did not have a bona fide intention to use the mark in commerce on or in connection with the identified goods and services as of the filing date; (2) that the use and registration of Applicant’s proposed mark will result in a likelihood of confusion with Opposer’s previously registered mark BLUE IVY, in standard characters, for

Event planning and management for marketing, branding, promoting or advertising the goods and services of others; Special event planning for business purposes; Special event planning for commercial, promotional or advertising purposes; Online retail store services and retail store services featuring paintings, wedding portraits and invitations; Personal management services for promotional, corporate and party entertainers, in International Class 35; and

Consultation in the field of special event planning for social entertainment purposes; Special event planning for social entertainment purposes; Party and wedding planning and coordination services; Party and wedding planning consultation services; Providing information in the field of wedding party planning; Rental of party decorations and wedding decorations, in International Class 41;<sup>4</sup>

and (3) that Applicant committed fraud by knowingly submitting a false declaration in support of its claimed bona fide intent to use the mark in commerce with an intent to deceive the USPTO.<sup>5</sup> Applicant denied the salient allegations of the Notice of

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<sup>3</sup> 1 TTABVUE 4 (Notice of Opposition); 43 TTABVUE 30 (Exhibit 3, Applicant’s Notice of Reliance).

<sup>4</sup> Registration No. 4224833, issued October 16, 2012, based on a claim of first use in commerce of October 4, 2009; Section 8 Statement of Use filed on January 25, 2019 and accepted.

<sup>5</sup> Opposer also pleaded ownership of common law rights in the mark BLUE IVY for “entertainment-related services,” but did not present any evidence or argument regarding the earliest common law use, or any use, of the BLUE IVY mark in her trial briefs. The common law claim is therefore waived, and the question of likelihood of confusion will be

Opposition.<sup>6</sup> The case is fully briefed.

Opposer bears the burden of establishing her claims by a preponderance of the evidence. *See Jansen Enters., Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). Having carefully considered the evidentiary record, the parties' arguments and applicable authorities, as explained below, we dismiss the Opposition.

## I. The Record

The record includes the pleadings, the file of the opposed application pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following submissions by the parties:

### A. Opposer's Notices of Reliance on

- Opposer's first set of interrogatories to Applicant, and original and supplemental responses and objections thereto;<sup>7</sup>
- Opposer's first requests for production of documents and things to Applicant, and original and supplemental responses and objections thereto;<sup>8</sup>

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decided solely on the basis of her pleaded registration. *See Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d at 1465 n.3; *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013).

<sup>6</sup> 7 TTABVUE (Applicant's Answer). Applicant also asserted various affirmative defenses including failure to state a claim, laches, estoppel, acquiescence, and unclean hands in its answer but did not discuss them in its trial brief. Accordingly, they are waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1752 n.6 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014). The other listed affirmative defenses are mere amplifications of Applicant's denials in the opposition.

<sup>7</sup> 38 TTABVUE; 34-35 TTABVUE.

<sup>8</sup> 31-33, 39 TTABVUE. When documents are not produced in response to a propounding party's requests for documents, as is the case here, the responses to those requests are admissible solely for purposes of showing that the party stated that there are no responsive documents. *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013). Since Applicant does not state that there are no responsive documents, the requests are not properly of record and we do not consider them.

- Internet materials consisting of an October 14, 2013 article, titled “Jay Z Has the Room,” from the November 2013 online issue of Vanity Fair magazine;<sup>9</sup>
- Official records consisting of a copy of the application and status of abandoned Application Serial No. 85526099 for the mark BLUE IVY CARTER in the name of Applicant;<sup>10</sup> and
- Official records consisting of a copy of the registration certificate and status of Registration No. 4224833 for the mark BLUE IVY in the name of Opposer.<sup>11</sup>

B. Applicant’s Notice of Reliance on

- Screenshots of Opposer’s website, Facebook and Twitter pages;<sup>12</sup>
- Opposer’s advertising material, and a picture of her mark;<sup>13</sup>
- Audio recording of a portion of a radio show interview of Opposer;<sup>14</sup>
- Applicant’s first set of requests for admission to Opposer, and Opposer’s responses and objections thereto;<sup>15</sup>
- Applicant’s first set of interrogatories to Opposer, and Opposer’s responses and objections thereto;<sup>16</sup>
- Applicant’s first set of requests for production of documents to Opposer, and Opposer’s responses and objections thereto;<sup>17</sup>

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<sup>9</sup> 36 TTABVUE.

<sup>10</sup> 37 TTABVUE.

<sup>11</sup> *Id.*

<sup>12</sup> 40 TTABVUE 9, 71-79, 121-125.

<sup>13</sup> *Id.* at 12-69, 178.

<sup>14</sup> *Id.* at 70.

<sup>15</sup> *Id.* at 232-261.

<sup>16</sup> *Id.* at 79-120.

<sup>17</sup> *Id.* at 236-266. Documents produced in response to requests for production of documents are generally not admissible by notice of reliance alone. 37 C.F.R. § 2.120(k)(3)(ii). However, they are admissible through a notice of reliance if they are authenticated by an admission from the producing party. 37 C.F.R. § 2.120(k)(3)(ii); See MISCELLANEOUS CHANGES TO

- April 15, 2017 article from the website Essense.com titled “Blue Ivy’s Most Precious Mini Style Moments”;<sup>18</sup>
  - Emails and letters from third parties to Opposer;<sup>19</sup>
  - Screenshots of Google searches of the terms “blue ivy” and “blue ivy events”;<sup>20</sup> and
  - Registration certificate and file history for Opposer’s Registration No. 4224833 for the mark BLUE IVY.<sup>21</sup>
- C. Public and confidential declaration and report of Applicant’s expert witness, Bruce G. Silverman.<sup>22</sup>

## II. Preliminary Issues

### A. Opposer’s Brief Exhibits and Citations to the Evidence

Opposer attached 191 pages of documents (Exhibits A – K) to her main brief comprising duplicate copies of her discovery requests to Applicant, Applicant’s responses thereto, and her registration certificate, which had already been made of record through notices of reliance filed during her testimony period. This was unnecessary and a waste of time. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.05(b) (timely filed evidence “need not and should not be

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TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016). In response to a request for admission served by Applicant, Opposer admitted that the documents it produced were authentic. 43 TTABVUE 259. The documents produced by Opposer are therefore authenticated and properly of record.

<sup>18</sup> *Id.* at 125-148.

<sup>19</sup> *Id.* at 151-173.

<sup>20</sup> *Id.* at 174-176.

<sup>21</sup> *Id.* at 179-235.

<sup>22</sup> 41-42 TTABVUE.

resubmitted with a party's brief."); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board); *Life Zone, Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008) (attaching previously-filed evidence to a brief is neither a courtesy nor a convenience to the Board). Opposer's attachment of a copy of the opposed application was also unnecessary because it was automatically of record. 37 C.F.R. § 2.122.

Exacerbating this problem, Opposer cites to her submitted evidence only by referencing the exhibits attached to her brief, generally by exhibit letter and without page reference, rather than to the trial record by referencing the TTABVUE entry and page number, as recommended by the Board's procedural rules. *Cf.* 37 C.F.R. § 2.142(b)(3); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); TBMP § 801.01 ("To allow readers to easily locate materials in the record, the parties should cite to the evidence in the trial record by referencing the TTABVUE entry and page number, and not attach previously-filed evidence to their briefs."). Opposer's failure to abide by the Board's standard trial procedures has made our review of her claims cumbersome.

#### B. Confidential Declaration of Applicant's Expert Witness

The testimonial declaration of Applicant's expert witness, Bruce G. Silverman, is marked "confidential" in its entirety and was submitted under seal.<sup>23</sup> Applicant's

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<sup>23</sup> 41 TTABVUE.

separately filed “redacted” copy is entirely blank.<sup>24</sup> Since most of his testimony relates to evidence he reviewed and his opinions related thereto; does not contain sensitive information such as sales figures, advertising expenditures, or other similar information typically designated as confidential in Board proceedings; and Applicant openly refers to his testimony throughout its briefing; it is inconceivable that the entire declaration should be marked confidential. Because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential. It is clear that not everything in Mr. Silverman’s testimony fits that description. Accordingly, Applicant is allowed until thirty (30) days after the issue date of this decision to file a redacted version of Mr. Silverman’s testimony, failing which the testimony in its entirety will become part of the public record. *Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1745 (TTAB 2012).

### C. Objections to Evidence

Contemporaneous with the filing of its trial brief, Opposer filed a motion to strike certain evidence of Applicant, including Exhibit 8 in Applicant’s notice of reliance consisting of an August 5, 2017 article from the website *Essense.com*, titled “Blue Ivy’s Most Precious Mini Style Moments,” on the basis that it was not produced in discovery.<sup>25</sup> The Board, in its Order of January 28, 2020, deferred action on this

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<sup>24</sup> 42 TTABVUE.

<sup>25</sup> 46 TTABVUE (Opposer’s Motion to Strike).

objection until final decision.<sup>26</sup> Because this evidence is not outcome-determinative, we decline to address this objection. *See, e.g., Grote Industries, Inc. v. Truck-Lite Co., LLC f/k/a Truck-Lite Co., Inc.*, 126 USPQ2d 1197 (TTAB 2018) (declining to discuss objections not material to outcome-determinative findings of fact).

Separately, Applicant objects to the October 14, 2013 article, titled “Jay Z Has the Room,” from the November 2013 online issue of Vanity Fair magazine submitted with Opposer’s notice of reliance on the basis that the article “is entirely objectionable as hearsay and cannot be cited for the truth of the matter asserted.”<sup>27</sup> We will discuss this objection within the context of Applicant’s no bona fide intent claim.

### III. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d at 1945. Two requirements must be met before an opposer can establish standing in a trademark opposition proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). First, the opposer must have a “real interest,” and not be a “mere intermeddler,” in the proceeding. *Id.* at 1026-27. Second, the opposer must have a “reasonable basis” for its belief of damage. *Id.* at 1027. A showing of actual damage is not required, nor is it necessary that an opposer provide a guarantee of success on the merits. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1100-1101, 192 USPQ 24, 27-

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<sup>26</sup> 51 TTABVUE.

<sup>27</sup> 49 TTABVUE 34 (Applicant’s Brief).

28 (CCPA 1976). Once standing is established, an opposer may rely on any ground set forth in the Trademark Act that negates the applicant’s right to registration. *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 493, 2 U.S.P.Q.2d 2021, 2024 (Fed. Cir. 1987); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385–86 (TTAB 1991) (Once the opposer shows “a personal interest in the outcome of the case ... the opposer may rely on any ground that negates applicant's right to the registration sought”).

Applicant concedes that, as owner of the registered mark BLUE IVY, Opposer has a real interest in the proceeding. However, Applicant contests that Opposer’s belief in damage is reasonable on the basis that (1) Opposer previously expressed “her belief that association of her BLUE IVY trademark with Applicant’s BLUE IVY CARTER mark would **help** her business,” and (2) because her “allegations of likelihood of confusion are baseless and entirely frivolous.”<sup>28</sup> In reply, Opposer argues that her belief in damage is reasonable because there is “ample evidence supporting her belief of damage” and her claim of likelihood of confusion is “not wholly without merit.”<sup>29</sup> We address each of these arguments in turn.

Regarding Applicant’s first contention that Opposer’s reasonable belief in damage is undercut by her “belief that an association of her BLUE IVY trademark with Applicant’s BLUE IVY CARTER mark” would help her business, Applicant points to

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<sup>28</sup> 49 TTABVUE 15 (Applicant’s Brief, emphasis in original).

<sup>29</sup> 52 TTABVUE 6, 9-10 (Opposer’s Reply Brief).

an interview given by Opposer “[s]hortly after Blue Ivy Carter was born”<sup>30</sup> in which she stated that she was “actually honestly very flattered” that Applicant’s owner, Mrs. Carter, gave her daughter the same name as Opposer’s company, and that as far as the effect on her business,

[I]t was pretty much immediate . . . I think that’s kind of when it became really apparent, when suddenly we grew up, like you know, 10% in 5 seconds and then, you know, I’d get weird emails and funny phone calls, and people asking me if we’re doing, you know, baby Blue Ivy birthdays and of course we were like, absolutely! You know first thing I thought of was, we might as well do, you know, Blue Ivy every event and on top of that I might have her be my spokes girl!

...

I’m definitely going to reach out to [Beyoncé’s] agent, I actually called yesterday but her agent wasn’t in, so we’ll definitely be speaking with them this week and I’m definitely interested in doing something with her. I mean, I don’t see why she wouldn’t appreciate at least the fact that we have a type of artistic vision. ...

I’ll be honest with you, I mean, I dig Beyoncé. She’s one of my biggest inspirations, but at the end of the day I would never call my daughter Blue Ivy but would damn well call my company Blue Ivy.<sup>31</sup>

Applicant states that Opposer “continued to flaunt” her connection with Applicant’s “Mark” by offering a “one-day discount” to her customers approximately one year later in celebration of the Blue Ivy Carter’s first birthday.<sup>32</sup> According to Applicant, such statements by Opposer preclude her from establishing a reasonable belief of damage from the registration of Applicant’s proposed mark when she filed her Notice of Opposition.<sup>33</sup>

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<sup>30</sup> 49 TTABVIE 14-15 (Applicant’s Brief).

<sup>31</sup> 43 TTABVUE 70 (Applicant’s Notice of Reliance (NOR), Exhibit 3, audio recording).

<sup>32</sup> 49 TTABVUE 16-17 (Applicant’s Brief).

<sup>33</sup> *Id.*

In reply, Opposer argues that making “some favorable comments ... around the time Blue Ivy Carter was born and the following year” does not undercut her reasonable belief in damage.<sup>34</sup> She asserts that her statements regarding her “initial feeling of being flattered many years ago,” her “initial hope that Blue Ivy Carter the individual would end up being a spokesperson for her business, which never came to any fruition,” and her offering of a one-day discount in January 2013, are “not relevant to whether [she] suffered harm many years later.”<sup>35</sup>

Applicant’s arguments regarding Opposer’s pre-filing statements are unpersuasive. As a preliminary matter, it is axiomatic that “[w]ithout use, there is no ‘trademark.’” 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:13 (5th ed. 2019); *JBLU, Inc. v. U.S.*, 813 F.3d 1377, 1381, 37 Int’l Trade Rep. (BNA) 2385 (Fed. Cir. 2016) (“[T]rademark rights stem from use, not registration.”). Therefore, while Opposer’s statements in an interview years ago may show that she perceived benefits to her business because a celebrity’s child’s given name was the namesake of her business, they have no bearing on whether she could form a reasonable belief of damage if Applicant were to use and register that name as a mark on or in connection with specific goods and services. There is no evidence suggesting that Opposer was even aware that Applicant intended to use or register the name BLUE IVY CARTER as a mark when those statements were made. Accordingly, Opposer’s statements, made some years earlier and well prior to the filing of the opposed application, have

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<sup>34</sup> 52 TTABVUE 10 (Opposer’s Reply Brief).

<sup>35</sup> *Id.*

little probative value in determining her belief in damage at the time the notice of opposition was filed.<sup>36</sup>

As to Applicant's second argument, we find that Opposer's standing to oppose registration of Applicant's mark is established by her pleaded registration, 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); *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012). While a claim that is wholly without merit would not support a reasonable basis for a belief in damage, *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982), we do not find Opposer's claim to be wholly without merit and thus find standing.

#### IV. Likelihood of Confusion

Trademark Act Section 2(d), 15 U.S.C. § 1052(d), prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

To prevail on her § 2(d) claim, Opposer must prove by a preponderance of the evidence that she has priority in the use of her mark and that Applicant's use of its mark is

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<sup>36</sup> Although the exact date of Blue Ivy's Carter's birth is not of record, it appears that Opposer's radio interview occurred before the filing of Applicant's first, now abandoned application was filed (discussed *infra*) and approximately five years before the filing of the current application was filed.

likely to cause confusion, mistake, or deception as to the source or sponsorship of the goods and services identified in the application. *Cunningham*, 55 USPQ2d at 1848. Because Opposer's pleaded registration is of record, and Applicant has not counterclaimed to cancel it, priority is not at issue with respect to the mark and services identified in the registration. *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)).

Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("[T]he various evidentiary factors may play more or less weighty roles in any particular determination").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc.*, 192 USPQ at 29 ("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.”). These factors, and the other *DuPont* factors argued by each party, are discussed below.

A. The Similarity or Dissimilarity of the Marks

The first *DuPont* factor considers the “similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John's*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.”).

We begin our analysis by considering each of the elements of the marks

individually before turning our consideration to the effect of their combination in the marks as a whole. As to appearance and sound, both marks include the words “BLUE” and “IVY,” which Applicant notes are “common English words”;<sup>37</sup> they appear in the same order; and they are pronounced the same way. The term “BLUE IVY” comprises the entirety of Opposer’s mark and the first two words of Applicant’s proposed three-word mark. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding other distinctive matter. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1051. Moreover, as Opposer observes, “it is often the first part of a mark that is likely to be impressed upon the mind of a purchaser and remembered” (quoting *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)).<sup>38</sup> The addition of “CARTER” as the third word in Applicant’s proposed mark BLUE IVY CARTER introduces a visual and aural difference between the two marks that must be considered. However, they are fairly similar in overall sound and appearance.

We next consider the connotation and commercial impression imparted by each mark. Because the words “BLUE” and “IVY” are common English words, we ascribe to them their ordinary meanings. “Blue” is a color that, in Opposer’s mark BLUE IVY, acts as an adjective to modify the noun, “ivy,” a type of climbing or creeping vine.<sup>39</sup>

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<sup>37</sup> 49 TTABVUE 21 (Applicant’s Brief).

<sup>38</sup> 45 TTABVUE 19 (Opposer’s Brief).

<sup>39</sup> The American Heritage Dictionary defines “Ivy” inter alia as 1. a. “[a] widely cultivated evergreen climbing plant”; as “[a]ny of several other woody, climbing or trailing evergreen plants”; and as “[any of various creeping or trailing plants of other genera, such as Boston ivy, ground ivy, or Virginia creeper. (<https://www.ahdictionary.com/word/search.html?q=ivy>).

Neither term is dominant in Opposer's mark because the term as a whole is a unitary expression, which appears arbitrary in relation to Opposer's services.

Applicant does not argue that any particular word or words are dominant in its proposed mark BLUE IVY CARTER. Rather, Applicant contends that the wording as a whole "denotes a particular human being, namely, the celebrity Blue Ivy Carter," and that this distinctive connotation not found in Opposer's mark, in turn, provides a distinct commercial impression.<sup>40</sup> Specifically, Applicant argues that the wording "brings to mind a famous child who is listed in the IMDb database,<sup>41</sup> reported on by popular press, and whose name generates millions of hits on a Google search. ... The commercial impression of Opposer's Mark is not a human being. Instead, its commercial impression is an event planning business."<sup>42</sup>

Applicant's argument is unavailing. Even if we were to accept Applicant's assertion that the relevant consumers would immediately associate the proposed mark BLUE IVY CARTER with the particular child, Blue Ivy Carter, due to her fame,

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The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions.

<sup>40</sup> 49 TTABVUE 21 (Applicant's Brief).

<sup>41</sup> Applicant's evidence relating to the IMDb database is simply a website link found in Exhibit 1 to Applicant's Confidential Declaration of its expert witness, Bruce G. Silverman, along with other such links. Applicant did not provide printouts of the web pages for that and other web pages referenced his declaration. Because information displayed at a website link's Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record. We therefore have not considered any evidence based on those links alone. *See, e.g., In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012).

<sup>42</sup> 49 TTABVUE 21 (Applicant's Brief).

it is common knowledge that people, including celebrities, are often known by their first names. Applicant's officer, Mrs. Carter ("Beyoncé") is but one example. Given that, it would be just as likely for consumers to presume that BLUE IVY connotes the first (or first and middle) name of "the" Blue Ivy Carter. Further, even acknowledging that Blue Ivy Carter is a well-known celebrity due to her parentage, there is no evidence to suggest that all potential consumers of Applicant's goods and services would be familiar with her; some may just like the products or services. Moreover, Applicant relies on the above-quoted opinions of its expert witness, whose testimony we find to have little probative value in this proceeding.<sup>43</sup>

Separately, Applicant points out that Opposer explained in a radio interview that the word "BLUE" in her mark "represents something blue in the wedding tradition," and the word "IVY" signifies that weddings are a "romantic experience" because ivy

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<sup>43</sup> We give little weight to the testimony of Applicant's expert witness, Mr. Silverman, on factual or legal grounds beyond general statements about marketing or branding, the subjects of his purported expertise, to the extent they are relevant to the issues herein. "[T]he Board is responsible for determining whether ... marks are similar, and we will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1401-02 (TTAB 2010). While Mr. Silverman may be an expert in marketing and branding, it is apparent from a review of his testimonial declaration that he is not an expert in trademark matters much less on the registrability of trademarks under the Lanham Act and the problems and considerations related thereto. This is apparent from his reference to "trademarked" brand names, willingness to offer opinions based on facts not in evidence and, in some cases, based on no evidence at all, such as his opinion that Applicant's mark is already famous (without evidence of use). As such, his opinions are, for the most part, akin to that of a lay witness. It is well established that the expressions of opinion by witnesses, including persons considered to be experts in a particular field on any question before the Board, is not binding upon the Board for "if such testimony were adopted without considering other aspects of the case, the effect would be to substitute the opinion of the witnesses for the ultimate decision to be reached by the Court and would therefore be improper." *The Quaker Oats Company v. St. Joe Processing Company, Inc.*, 109 USPQ 390 at 391 (CCPA, 1956); *Venetianaire Corporation of America v. A & P Import Co.*, 163 USPQ 412 (DC NY, 1969); and *Philip Morris Incorporated v. Rothmans of Pall Mall Limited*, 180 USPQ 592 (TTAB 1973).

“intertwine[s] when [it] grow[s] on buildings.”<sup>44</sup> While those concepts may have informed Opposer’s adoption of her mark, there is no evidence in the record suggesting that consumers perceive her mark in that way.

Applicant also emphasizes that “Opposer’s Mark, when used in the course of Opposer’s business, has a distinct appearance: the word “Ivy” is displayed directly below the word “Blue” with ivy appearing to grow out of the ends of some of the letters.” According to Applicant, “the Board must consider ‘illustrations of the mark as actually used’ because ‘such illustrations may assist the [Board] in visualizing other forms in which the mark might appear’” and that “such visualization is significant because ‘the likelihood of confusion inquiry is viewed through the eyes of a consumer to determine the commercial impression of the mark,’” citing *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1327 (Fed. Cir. 2017).

Applicant’s argument is misplaced. The Court’s statement in *Joseph Phelps Vineyards* was made in the context of a concurring opinion and involved a factual scenario concerning the actual use of the mark of each party, an issue that is not relevant here. The subject application is based on Applicant’s proposed intention to use its mark in commerce, so there is no comparison to be made. Additionally, because Applicant has applied to register its mark in standard characters and that mark, if registered, “may be presented in any font, style, size or color,” *In re Aquitaine Wine*

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<sup>44</sup> 49 TTABVUE 21 (Applicant’s Brief, quoting from audio recording, Exhibit 3 of Applicant’s NOR, 43 TTABVUE 70).

USA, LLC, 126 USPQ2d 1181 (TTAB 2018), including the font, style, size or color used by Opposer, we must conceive that such use may be confusingly similar. Opposer's registration of the mark BLUE IVY is also for standard characters and thus may be used any font, style, size or color. The evidence of Opposer's use of its mark submitted by Applicant shows that Opposer uses BLUE IVY in various forms not limited to the stylized form mentioned by Applicant, such as with other colors, without the ivy design, and in text without any stylization.<sup>45</sup>

Overall, we find BLUE IVY and BLUE IVY CARTER to be more similar than dissimilar as to appearance, sound, connotation and commercial impression. The first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. The Similarity or Dissimilarity of the Goods and Services and Their Trade Channels

The second *DuPont* factor considers the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *In re Detroit Athletic Co.*, 128 USPQ2d at 1047 (quoting *DuPont*, 476 F.2d at 1361), and the third *DuPont* factor considers the "similarity or dissimilarity of established, likely-to-continue trade channels." *Id.* at 1052.

It is "not necessary that the goods [and services] be identical or even competitive to support a finding of a likelihood of confusion." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). "[L]ikelihood of confusion can be found 'if the respective goods [and services] are

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<sup>45</sup> 43 TTABVUE 12-56 (Applicant's NOR, Exhibit 2).

related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* It is “well established that ‘confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other.’” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting TMEP § 1207.01(a)(ii)).

Opposer argues that “[t]here is substantial overlap between the classes of the BLUE IVY Mark and the Applicant’s identified classes. For example, Applicant’s broad designations – which include the broad category of party favors among other designations – overlap with registered goods and services.”<sup>46</sup> Opposer cites random examples from each international class, such as “Applicant’s international class 3 (e.g. fragrances, cosmetics, skin care products, or hair care products)” and class “10 (baby teething rings).”<sup>47</sup> However, “classification is wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification.” *In re Detroit Athletic Co.*, 128 USPQ2d at 1047 (quoting *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 U.S.P.Q.2d (BNA) 311355, \*11 n. 16 (TTAB 2019); it is solely for the convenience of the Patent and Trademark Office. *Id.* Additionally, as Applicant observes, the opposed application does not include or even reference party favors.<sup>48</sup>

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<sup>46</sup> 45 TTABVUE 21 (Opposer’s Brief).

<sup>47</sup> *Id.*

<sup>48</sup> 49 TTABVUE 24 (Applicant’s Brief).

Opposer contends that “Applicant’s broad designations also overlap with registered goods and services, including event planning and management for marketing, branding, promoting or advertising the goods and services of others, special event planning for business purposes, special event planning for commercial, promotional or advertising purposes, party and wedding planning and coordination services; [p]arty and wedding planning consultation services; and with providing information in the field of wedding party planning,” again listing random examples,

e.g. classes 35 (e.g., product merchandising for others; online retail store services featuring music, musical recordings, motion pictures, clothing and clothing accessories, novelty items; entertainment marketing services, namely, marketing, or promotion and advertising for recording and performing artists), and 41 (e.g., entertainment services, namely, providing online video games, dance events by a recording artist, multimedia production services; Entertainment services in the nature of live musical performances; production of motion picture films, or fan clubs).<sup>49</sup>

In response, Applicant states that “Opposer’s argument regarding overlap between the parties’ goods and services is ... absurd.”<sup>50</sup> According to Applicant,

Opposer simply lists the identified goods in classes 3, 6, 10, 12, 16, 18, 20, 21, 24, 26, and 28 of the Application without any further analysis or argument. ... It appears that Opposer is essentially suggesting that everything in the Application, from “portable media players,” to “baby strollers,” to “towels,” is sufficiently similar to either “party favors,” “retail services featuring paintings, wedding portraits, [and] invitations,” or “party decorations and wedding decorations” to cause consumer confusion. This argument is simply irrational. Suggesting that such extremely unrelated goods and services “overlap” would make futile the practice of specifically listing out specific classes, goods, and services covered by a trademark application.

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<sup>49</sup> 45 TTABVUE 22-23 (Opposer’s Brief).

<sup>50</sup> 49 TTABVUE 24 (Applicant’s Brief).

We agree that Opposer has failed to demonstrate that the goods and services are related. Although the identifications of goods and services in the subject application and claimed registration may themselves constitute evidence of the relatedness of the goods or services, *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002), it is well settled that “when an opposer as party plaintiff rests its case essentially on a previously issued registration, it must bear a risk of not meeting its burden of proof where the goods [and services] in issue are different and the relationship between them is not readily apparent.” *Pharmacia Inc. v. Asahi Medical Co., Ltd.*, 222 USPQ 84, 86 (TTAB 1984). Where, as here, there is a difference between the marks and the goods and services, or both,

it is incumbent upon the [opposer] to persuade us that there is a reasonable likelihood of confusion. ... If the goods are different, the proof is perhaps more objective because then we are looking for concrete facts about the nature of the goods, their uses, the channels through which they reach their ultimate purchasers and users, the types of persons who buy them, and the marketing environment surrounding the sale of the goods of the parties. In the many cases, some of these facts will be self-evident, a matter of common knowledge or matters to be presumed from the identifications of goods in opposer’s registration and applicant’s application. In other cases, however, the relationship between the parties’ goods, particularly as that ultimate and the underlying subsidiary facts impinge upon the question of likelihood of confusion, is not readily apparent and some evidence is needed.

*Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d at 1401-02 (quoting *Hyde Park Footwear Company, Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641-642 (TTAB 1977)). Opposer’s claim that her “registered goods and services and Applicant’s identified goods and services are identical or closely related”<sup>51</sup> is unsupported. The

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<sup>51</sup> 45 TTABVUE 23 (Opposer’s Brief).

goods and services are not identical, and there no evidence suggesting they are related in a manner that would give rise to the mistaken belief that they emanate from the same source. Opposer has, figuratively, thrown the identification of goods and services against a wall, hoping something will stick.

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; or copies of use-based registrations of the same mark for both the applicant’s services and the goods listed in the cited registration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, \*4-5 (TTAB 2019). Opposer provided no such evidence and does not explain why the goods and services should be considered related despite having asserted a likelihood of confusion between the marks as to all of goods and services in each of the fourteen classes in the opposed application. The failure of Opposer to adduce any evidence of relatedness tends to confirm our view that no viable relationship the goods and services actually exists. “Speculation and surmise is no substitute for evidence.” *Pharmacia Inc. v. Asahi Medical Co., Ltd.*, 222 at 86.

After a careful review and comparison of the services in both classes of Opposer’s registration with the goods and services in each of the fourteen classes in Applicant’s application, we are unpersuaded that they are related in a manner sufficient for likelihood of confusion purposes, at least on this record. Almost all of Applicant’s goods and services are plainly distinct from Opposer’s services. The only goods or

services that appear even marginally related are Opposer's services of "event planning and management for marketing, branding, promoting or advertising the goods and services of others" (Class 35) on the one hand, and Applicant's services of "product merchandising for others" and "entertainment marketing services, namely, marketing, promotion and advertising for recording and performing artists" (Class 35) on the other. But there is no evidence suggesting that those services are actually related in a manner that would be likely to cause confusion.

Opposer has also failed to present any evidence showing that the parties' goods and services are provided in the same trade channels or to the same classes of purchasers. Instead, Opposer notes that, "absent restrictions in an application and/or registration, the identified services are presumed to travel in the same channels of trade to the same classes of purchasers," citing to *In re Viterra, Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).<sup>52</sup> However, that presumption only applies when the goods and services are identical. Where, as here, they are not identical, we may presume only that they travel in whatever trade channels are normal for each good and service. *See Coach Servs.*, 101 USPQ2d at 1723 (absent limitation, "goods are presumed to travel in all normal channels ... for the relevant goods.").

Opposer further contends, without citation to the record, that "Applicant admits that both it and Opposer would be selling through common channels of trade,"<sup>53</sup>

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<sup>52</sup> 45 TTABVUE 20.

<sup>53</sup> 52 TTABVUE 7, 18 (Opposer's Reply Brief).

which Applicant disputes. If Opposer is referring to Applicant's assertion that "[g]iven the nature of its identified goods, they would be sold primarily by mass-market online and/or brick and mortar retailers,"<sup>54</sup> that statement does not establish common channels of trade. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087-88 (Fed. Cir. 2014) ("The PTO goes too far ... in claiming that because both [applicant's] services and the registrant's goods are promoted through websites, the channels of trade are similar. Advertising on the Internet is ubiquitous and 'proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.'") (citing *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453, 470-71 n.14 (E.D. Pa. 2012)) (quoting J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:53.50 (4th ed. Supp. 2011)).

In sum, Opposer has failed to demonstrate that the parties' respective goods and services are related in any manner, or that they travel within the same trade channels to the same class of purchasers. The second and third *DuPont* factors therefore weigh heavily against a finding of likelihood of confusion.

### C. Strength of Opposer's Mark

Referencing the fifth *DuPont* factor, which assesses the strength of Opposer's mark through, for example, evidence of sales, advertising, and length of use, *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *DuPont*, 476 F.2d at 1361), Applicant argues that

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<sup>54</sup> 49 TTABVUE 27 (Applicant's Brief).

“Opposer’s mark is very weak, and is therefore entitled to only a narrow scope of protection.”<sup>55</sup> Opposer disputes that contention.<sup>56</sup>

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). “[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

The conceptual strength of Opposer’s BLUE IVY mark is not at issue. The mark is presumed to be 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). The registration is “prima facie evidence of the validity of the registered mark ...”. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b); *see also Tea Bd. of India*, 80 USPQ2d at 1899. As discussed earlier herein, there is no evidence that BLUE IVY has a particular meaning in the industry and it appears arbitrary in relation to the services.

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<sup>55</sup> 49 TTABVUE 29 (Applicant’s Brief).

<sup>56</sup> 52 TTABVUE 18 (Opposer’s Reply Brief).

Commercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). The proper legal standard for evaluating the commercial strength of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734.

According to Applicant, Opposer's mark is commercially weak because

Opposer is a small business, with just three regional offices and a handful of employees. As would be expected of such a small business, Opposer produces a low volume of advertisements, since [she] is the only person involved in its marketing, promotions, and sales. Opposer primarily promotes and offers [her] services through [her] website, [www.blueivyevents.com](http://www.blueivyevents.com), and on its three social media accounts. However, as demonstrated by Mr. Silverman, Opposer's online presence is very weak. According to Mr. Silverman, Opposer's website is infrequently visited by consumers. Similarly, Opposer's social media accounts are poorly subscribed. For instance, as of September 2017, only 915 accounts followed Opposer's Twitter page, and as of August 2018, fewer than 3,000 accounts followed Opposer's Facebook page [citations omitted].<sup>57</sup>

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<sup>57</sup> 49 TTABVUE 30 (Applicant's Brief).

Applicant's contentions, however, rely largely on the opinions of its expert witness, Mr. Silverman, whose testimony is largely unsupported by evidence in the record. Contrary to his assertions, the evidence of record does not demonstrate that Opposer's volume of advertisements are low, or that her online presence is weak, as compared with third parties providing similar services, in comparison, which is the proper legal standard. *See Joseph Phelps Vineyards, Id.* Thus, it is unclear how Opposer's marketing, promotion and sales figures compare to her competitors in the industry, e.g., market share. Without comparative numbers or market share percentages provided by Applicant (or Opposer), we cannot place Applicant's asserted commercial weakness of Opposer's BLUE IVY mark into context. *Cf. Bose, 63 USPQ2d at 1309.*

We therefore find that Opposer's mark is conceptually strong but have insufficient information to determine its relative commercial strength. Accordingly, the fifth *DuPont* factor is neutral in our analysis.

#### D. Conclusion as to Likelihood of Confusion

Balancing the *DuPont* factors that are relevant to this opposition, we find that the first *DuPont* factor weighs in favor of a finding of likelihood of confusion; the second and third *DuPont* factors weigh strongly against a finding of likelihood of confusion; and the fifth *DuPont* factor is neutral. Based on all evidence and arguments bearing on the *DuPont* factors that the Board may consider, we find that the parties' goods and services, and their respective channels of trade, are so dissimilar that confusion is unlikely, even taking into account the reduced degree of similarity needed because the marks are similar in appearance, sound, connotation and commercial impression.

## V. Bona Fide Intent to Use

We turn now to Opposer's claim that Applicant lacked a bona fide intention to use the mark BLUE IVY CARTER as of the filing date of the application. Under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), a person who has not yet made use of a trademark may file an application for registration of the mark if such person "has a bona fide intention, under circumstances showing the good faith of such person, to use [the] trademark in commerce...". That bona fide intention must be "firm" and "must reflect an intention to use the mark ... 'in the ordinary course of trade, and not made merely to reserve a right in a mark.'" *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015), *aff'g*, *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463 (TTAB 2013) (quoting 15 U.S.C. § 1127). Accordingly, the lack of a bona fide intent is a proper statutory ground on which to challenge a trademark application. *Id.* at 1897.

As noted by Opposer, she bears "the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods [and services]."<sup>58</sup> "One way an opposer can establish a prima facie case of a lack of bona fide intent to use is to establish that applicant has no documentary evidence to support its allegation of an intent to use as of the filing date." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:14.1 (5th ed. 2020); *see also Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727

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<sup>58</sup> 45 TTABVue 14 (Opposer's Brief, citing *Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008 (TTAB 2015) (quoting *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008)).

(TTAB 2010). If Opposer satisfies her initial burden of showing the absence of documentary evidence regarding Applicant's bona fide intention to use the mark, the burden of production shifts to Applicant to come forward with evidence adequately explaining or outweighing the failure to provide such documentary evidence. *See Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1930 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 n. 11 (TTAB 1993).

A. Opposer's Argument that Applicant Has No Documentation Supporting Its Bona Fide Intent to Use BLUE IVY

Opposer's no bona fide intent claim rests primarily on her argument that Applicant acted in a recalcitrant and uncooperative manner throughout the case, disclosing no substantive information in response to interrogatories and producing no documents in response to requests for production seeking evidence of Applicant's bona fide intent. Specifically, she states that

On August 21, 2017, Applicant objected to all of [her] interrogatories and requests for production on the basis that that the requests were premature, stating that it is "unable to substantively respond" but that it would "provide supplementary responses following the execution of an agreed (or Board-ordered) protective order."

On December 26, 2017, the Board issued an order providing that its standard protective order "remains the operative protective order in this proceeding." ... On February 15, 2018, Applicant served supplemental discovery responses and objections stating that it "refuses to respond to Opposer's Requests, and will seek a protective order as necessary." Applicant never subsequently sought a protective order.

Applicant never answered any interrogatories, and never produced any documents, tangible things, or other factual evidence in response to requests for production. Applicant refused to provide any evidence of an

intent to use.<sup>59</sup> (Citations omitted)

In response, Applicant, argues that Opposer’s “finger-pointing with respect to the lack of documentary evidence obscures the reason for the lack of such evidence,” and that “the discovery process in this action broke down as a result of Opposer’s misconduct.” According to Applicant,

Opposer used [her] discovery requests as a weapon to pry into the personal life of Mrs. Carter and to threaten and intimidate her. That Applicant was unwilling to engage in such an abusive process should not somehow now be twisted in Opposer’s favor to support a finding that Opposer lacked bona fide intent.<sup>60</sup>

The parties paint an incomplete picture. On July 20, 2017, during the discovery period, Opposer served a number of interrogatories and requests for production on Applicant seeking evidence of its bona fide intent to use the mark BLUE IVY CARTER.<sup>61</sup> Between July 31 and August 10, 2017, pursuant to Applicant’s request, the parties attempted to negotiate a modification to the Board’s standard protective order but, ultimately, could not agree on a proposed modified order to submit to the Board for approval.<sup>62</sup> On August 18, 2017, prior to its deadline for providing responses to Opposer’s discovery requests, Applicant filed a motion seeking a modified protective order.<sup>63</sup> That motion was not decided by the Board until December 26,

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<sup>59</sup> 45 TTABVUE 12 (Opposer’s Brief).

<sup>60</sup> 49 TTABVUE 32-33 (Applicant’s Brief).

<sup>61</sup> 38 TTABVUE 6-11 (Opposer’s 1st Corrected NOR); 39 TTABVUE 6-12 (Opposer’s 2nd Corrected NOR).

<sup>62</sup> 9 TTABVUE 57-63 (Exhibit 2, Applicant’s Motion for Entry of a Protective Order).

<sup>63</sup> 9 TTABVUE (Applicant’s Motion for Entry of a Protective Order).

2017.<sup>64</sup> Meanwhile, on August 21, 2017, Applicant timely responded to those discovery requests but provided no substantive responses or documents with its response.<sup>65</sup> Instead, Applicant asserted various objections to the requests and declined to provide substantive responses until either the parties could agree on, or the Board ordered, a modified protective order.<sup>66</sup> Thus, while Opposer is correct in noting that the Board issued an Order on December 26, 2017 denying Applicant's motion for a modified protective order and indicating that the standard Order would remain in place, she **omits** mention of the fact that the Board in the same Order **denied** her motion to compel the same documents she now laments having not received on the basis that she had failed to make a good faith effort to resolve the parties' discovery dispute.<sup>67</sup>

Apparently, Opposer did not thereafter receive suitable responses from Applicant and it appears that Applicant's responses were likely unsatisfactory, and probably would have been unsatisfactory to most litigants. However, Opposer did not raise the issue again with the Board despite having ample opportunity to do so before her

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<sup>64</sup> 16 TTABVUE (Board's Order on Motion to Amend Board's Protective Order / Motion to Compel).

<sup>65</sup> 32 TTABVUE 6-40 (Opposer's 3rd NOR); 34 TTABVUE 6-24 (Opposer's 5th NOR).

<sup>66</sup> *Id.*

<sup>67</sup> 16 TTABVUE 7. As quoted in the Board's Order: "In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete." TBMP § 523.02." Specifically, the Board found that Opposer should have engaged in more than just one phone call to try and resolve the discovery dispute and noted that Applicant was not given a meaningful opportunity to resolve the dispute prior to Board intervention. As a result, Opposer's efforts were deemed incomplete and insufficient. *Id.*

pretrial disclosures deadline of January 25, 2019.<sup>68</sup> Thus, we do not know whether Opposer followed up on any of the Board's suggestions to try and work out her differences with Applicant, or whether she pursued Applicant relentlessly, only to be stonewalled. Had the latter scenario transpired, Opposer presumably could have offered proof on the record in a renewed motion to compel and we would then have been in a position to intervene.

Nothing prevented Opposer from returning to the Board, after making a good faith effort, to file a further motion to compel. Hence, Opposer should not now be heard to complain about a situation that could have been remedied had she followed the Board's clear procedures during discovery and prior to trial.<sup>69</sup> *Chianti Ruffino Esportazione Vinicola Toscana S.p.A. v. Colli Spolenti Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001) ("Any deficiencies in applicant's discovery responses should have been addressed by the timely filing of a properly-supported motion to compel discovery prior to the commencement of opposer's testimony period"); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (because

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<sup>68</sup> Although a motion to compel discovery does not necessarily have to be filed during the discovery period, it should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the day of the deadline for pretrial disclosures for the first testimony period. 37 C.F.R. § 2.120(e); *Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co.*, 128 USPQ2d 1470 (TTAB 2018) (reconsideration of Board order denying untimely motion to compel filed on deadline for pretrial disclosures denied).

<sup>69</sup> Strict compliance with the Trademark Rules of Practice is expected of all parties before the Board, whether or not they are represented by counsel familiar with Board practice. See *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212 n.2 (TTAB 2006), *aff'd*, 240 Fed. App'x. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008). Failure to follow the Board's well-established and widely-disseminated practice and procedure is at a party's peril.

respondent's objections "were not of a nature which would have led petitioner to believe that no such documents existed, and because petitioner failed to file a motion to compel, petitioner cannot now [during trial period] be heard to complain that the documents were not identified and produced"). The Board will not draw adverse inferences against Applicant based on alleged insufficient responses to discovery requests in the absence of a motion challenging the sufficiency of those responses which is granted by the Board. *See Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984).

B. Opposer's Argument that Applicant Lacked a Bona Fide Intent Based on Abandonment of a Prior Application for the Same Mark

Opposer argues that "Applicant previously abandoned a similar application for the same mark, and failed to file any Statement of Use despite filing five extensions of time to do so over a period of more than four years" and that "Applicant's pattern of abandonment and extended non-use further supports a finding of a lack of bona fide intent," citing to the Board's decision in *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012).<sup>70</sup> However, in *L'Oreal*, the Board found that the applicant had filed sixteen applications to register various well-known marks with the intention to trade off of some of the best known, previously registered marks in the country (e.g., HEINEKIN, JACK DANIEL'S, and CHANEL), which amounted to a history and pattern of bad faith. Here, the existence of only one abandoned application to register the mark for the same goods does not by itself support a finding that Applicant has

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<sup>70</sup> 45 TTABVUE 17 (Opposer's Brief).

engaged in a pattern of bad faith conduct. Indeed, an applicant can file more than one intent-to-use application covering the same goods or services and still have the requisite bona fide intention to use each mark. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d at 1506 n.7 (quoting S. Rep. No. 100-515, 100th Cong. 2d Sess. at 24-25 (1988)).

C. Opposer's Argument that Applicant Lacked a Bona Fide Intent Based on Prior Statements made by Shawn Corey Carter

Finally, Opposer argues that certain prior statements made by Shawn Corey Carter (Jay-Z), the husband of Mrs. Carter (Beyoncé) and father of Blue Ivy Carter, demonstrate that Applicant lacked a bona fide intent to use the mark BLUE IVY CARTER in commerce on or in connection with the goods and services identified in its application.<sup>71</sup> Specifically, Opposer points to an interview published in a 2013 article of Vanity Fair magazine, titled "Jay Z Has the Room," wherein Mr. Carter, is reported to have made the following statements when asked about the filing of Applicant's first application for the mark BLUE IVY CARTER on January 27, 2012:<sup>72</sup>

I asked about allegations in the media that he and Beyoncé trademarked their daughter's name to do a line of baby clothes. Jay said they did it merely so no one else could. "People wanted to make products based on our child's name, and you don't want anybody trying to benefit off your baby's name. It wasn't for us to do anything; as you see, we haven't done anything. First of all, it's a child, and it bothers me when there's no [boundaries]. I come from the streets, and even in the most atrocious sh\*it we were doing, we had lines: no kids, no mothers— there was respect there. But [now] there's no boundaries. For somebody to say, This person had a kid—I'm gonna make a f\*ckin' stroller with that kid's

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<sup>71</sup> *Id.* at 13, 23-24.

<sup>72</sup> 45 TTABVue 12-13 (Opposer's Brief).

name. It's, like, where's the humanity?"<sup>73</sup>

According to Opposer, these reported statements of Mr. Carter demonstrate Applicant's "true intent" in filing the current application, which Opposer contends is "an admitted pattern of abusing the trademark process."<sup>74</sup>

Applicant, in response, argues that "[the] article is entirely objectionable as hearsay and cannot be cited for the truth of the matter asserted" and therefore "cannot be relied upon to demonstrate that [Applicant] lacked the requisite intent when it filed its 2012 (or 2016) trademark applications."<sup>75</sup> According to Applicant, "even if Opposer's evidence did not constitute hearsay, it would still be irrelevant to [Applicant's] intent to use the [BLUE IVY CARTER] Mark" because "Mr. Carter ... is not a member or owner of [Applicant]."<sup>76</sup>

In reply, Opposer asserts that "Mr. Carter's statements are not hearsay on at least three grounds":<sup>77</sup>

[1] as a statement of the declarant's then existing state of mind (such as motive, intent, or plan), [2] as an admission by a party opponent that is used against it in this proceeding, and [3] as (sic) under the residual exception under Fed. R. Evid. 807.

Inter partes proceedings before the Board are, "wherever applicable and appropriate," governed by the Federal Rules of Evidence,<sup>78</sup> which defines "hearsay"

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<sup>73</sup> 36 TTABVUE 32 (Opposer's 7th NOR).

<sup>74</sup> 45 TTABVUE 13 (Opposer's Brief).

<sup>75</sup> 49 TTABVUE 34 (Applicant's Brief).

<sup>76</sup> *Id.*

<sup>77</sup> 52 TTABVUE 6 (Opposer's Reply Brief).

<sup>78</sup> 37 C.F.R. §§ 2.122(a) and 2.116.

as “a statement, other than one made by the declarant while testifying at the trial or hearing, offered in evidence to prove the truth of the matter asserted.”<sup>79</sup> “Hearsay is inadmissible unless it falls within one of the exceptions provided in the Federal Rules of Evidence.” *United States v. Williams*, 41 F.3d 192, 199 (4th Cir. 1994); Fed. R. Evid. 802.

Rule 803(3) of the Federal Rules of Evidence provides that “a statement of [a] declarant’s then-existing state of mind (such as motive, intent, or plan)” is an exception to the rule against hearsay. However, because Mr. Carter is not a party to this proceeding, his statements are irrelevant. The evidence does not show that he is legally connected to Applicant’s company in any way. Opposer cites no legal precedent that would allow us to presume a legal connection between a corporate entity and a relative of an owner of that corporate entity. Opposer’s counsel’s assertion that “Mr. Carter has a very close relationship with [Applicant], being the husband of its manager and sole member, the singer Beyoncé Giselle Knowles-Carter, and the father of their daughter Blue Ivy Carter,” is insufficient to establish such a connection. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

Rule 801(d)(2) provides that a statement offered as an admission against an opposing party that “(A) was made by the party in an individual or representative capacity; (B) is one the party manifested that it adopted or believed to be true; (C)

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<sup>79</sup> Fed. R. Evid. 801(c).

was made by a person whom the party authorized to make a statement on the subject; (D) was made by a party's agent or employee on a matter within the scope of that relationship while it existed; or (E) was made by a party's coconspirator during and in furtherance of [a] conspiracy," is not hearsay.<sup>80</sup> However, as noted above, Mr. Carter is not a party. Nor has Applicant shown that Applicant manifested that it adopted or believed Mr. Carter's statements to be true; that Mr. Carter was authorized to make the statements on Applicant's behalf; or that Mr. Carter was acting as Applicant's agent or employee when the statements were made, much less Applicant's coconspirator during furtherance of a conspiracy. His statements are therefore not an exception under this Rule.

Finally, Rule 807 (the "Residual Exception" Rule) provides that hearsay is not excluded by the rule against hearsay, even if it does not fall into one of the exceptions, if "(1) the statement is supported by sufficient guarantees of trustworthiness—after considering the totality of circumstances under which it was made and evidence, if any, corroborating the statement;" **and** "(2) it is more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts."<sup>81</sup> This evidence rule also does not aid Opposer's argument because Mr. Carter's statements are not supported by any guarantees of trustworthiness, much less "sufficient" ones, and are not shown to be more probative on the issue of Applicant's bona fide intent "than any other evidence that [Opposer]

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<sup>80</sup> Fed. R. 801(d)(2).

<sup>81</sup> Fed. R. Evid. 807.

[could have] obtain[ed] through reasonable efforts,” as required the Rule. As discussed earlier at length, Opposer’s own inaction resulted in a failure to obtain any documentary evidence relevant to her claims.

Moreover, because Mr. Carter’s statements were made to a reporter, who then wrote and published an article purportedly based on those statements, Mr. Carter’s statements are not only hearsay, they are also a classic example of hearsay within hearsay (multiple hearsay) and therefore are particularly unreliable.<sup>82</sup> “If hearsay is unreliable then it stands to reason that multiple hearsay is less reliable and would need more corroboration to make it trustworthy.” *Valdivia v. Schwarzenegger*, 548 F. Supp. 2d 852, 1100 (E.D. Cal. 2008) (finding that testimony of parole officer, who testified to statements made to him by someone else was unreliable multiple hearsay). Based on all of the foregoing, we find the statements of Mr. Carter in the Vanity Fair magazine article to be inadmissible hearsay and irrelevant to our decision.

In sum, the trial record is lacking in evidence that could persuade us that Applicant possessed no evidentiary means to demonstrate its bona fide intention to use its proposed mark at the time it filed its application. Nor does the evidence of record suggest in any other way that Applicant lacked such an intention. Opposer has failed to establish a prima facie case sufficient to shift the burden of persuasion to

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<sup>82</sup> Hearsay within hearsay is not prohibited by the rule against hearsay if all levels of statements conform to an exception of the rule. Fed. R. Evid. 805; *Stagecoach Properties, Inc. v. Wells Fargo & Company*, 199 USPQ 341, 355 (TTAB 1978). As discussed above, Mr. Carter’s statement does not conform to any exception.

Applicant. *See Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d at 1472 (“If opposer satisfies its initial burden of showing the absence of documentary evidence regarding applicant’s bona fide intention to use the mark, the burden of production shifts to applicant to come forward with evidence adequately explaining or outweighing the failure to provide such documentary evidence.”). Because the burden did not shift, at no time was it incumbent on Applicant to place evidence in the record to demonstrate its bona fide intention to use its mark in commerce. Opposer failed to prove her claim.

## VI. Fraud

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). A party opposing registration of a trademark on the ground of fraud bears a heavy burden of proof. *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004, 54 C.C.P.A. 1442, 153 USPQ 749, 750 (CCPA 1967). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981); *see also Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, (TTAB 2009).

Opposer’s fraud claim rests entirely on the premise that Applicant knowingly signed and submitted with the application a false declaration of its bona fide intent to use the mark BLUE IVY CARTER in connection with the identified goods and

services, with an intent to deceive the USPTO. Because we find Opposer failed to establish that Applicant lacked a bona fide intent to use its mark in connection with the goods and services identified in the application, her fraud claim based thereon, a fortiori, fails as well.

**Decision:** Opposer's claims of likelihood of confusion, no bona fide intent, and fraud, are dismissed.<sup>83</sup>

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<sup>83</sup> As discussed earlier, Applicant is allowed until thirty (30) days after the issue date of this decision to file a redacted version of Mr. Silverman's testimony, failing which the testimony in its entirety will become part of the public record