

This Opinion is Not a
Precedent of the TTAB

Mailed: January 12, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Chanel, Inc.
v.
Camacho & Camacho, LLP
—

Opposition No. 91229126
—

Barbara A. Solomon and Emily Weiss, of Fross Zelnick Lehrman & Zissu PC, for
Chanel, Inc.

Camacho & Camacho, LLP, pro se.
—

Before Kuhlke, Adlin, and Larkin,
Administrative Trademark Judges.

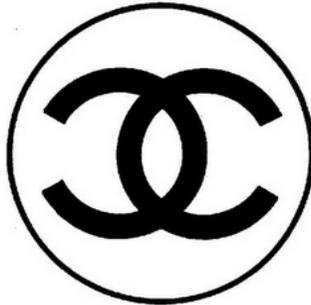
Opinion by Larkin, Administrative Trademark Judge:

Camacho & Camacho, LLP (“Applicant”), appearing pro se, seeks registration of
the mark shown below on the Principal Register for accounting services, in
International Class 35.¹

¹ Application Serial No. 86674771 was filed on June 25, 2015 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claim of first use and first use of the mark in commerce on January 1, 1999.



Chanel, Inc. (“Opposer”) has opposed registration on the basis of a single claim, under Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063, 1125(c), that Applicant’s use of the mark in connection with the services identified in the application is likely to dilute the distinctiveness of the “CC Monogram Mark,” depicted below in three forms, which is the subject of the 14 pleaded registrations described below:



(1)

shown in

- Registration No. 4505440 for cellular phone accessory charms, in International Class 9;³

² The mark is described in the application as consisting of “intertwined capital letter ‘C’s’, one normal appearance the other reverse, enclosed by quasi square border.”

³ Issued on April 1, 2014. The mark is described in the registration as consisting of “of back-to-back, interlocking “C’s”, surrounded by a circle.”

- Registration No. 1654350 for make-up brushes, in International Class 21;⁴
- Registration No. 1347094 for a full line of perfumery, cosmetics, and toiletries, in International Class 3;⁵
- Registration No. 1271876 for clothing-namely, coats, dresses, blouses, raincoats, suits, skirts, cardigans, sweaters, pants, jackets, blazers, and shoes, in International Class 25;⁶
- Registration No. 1241264 for suits, jackets, skirts, dresses, pants, blouses, tunics, sweaters, cardigans, tee-shirts, coats, raincoats, scarves, shoes and boots, in International Class 25;⁷
- Registration No. 799642 for bath powder, bath oil, after shave lotion and after bath oil spray, in International Class 3;⁸
- Registration No. 399751 for toilet soap, in International Class 3;⁹ and
- Registration No. 195359 for face powder, perfume, eau de cologne, toilet water, lipstick, and rouge, in International Class 3;¹⁰

⁴ Issued on August 20, 1991 and last renewed on September 21, 2011.

⁵ Issued on July 9, 1985 and last renewed on June 25, 2015.

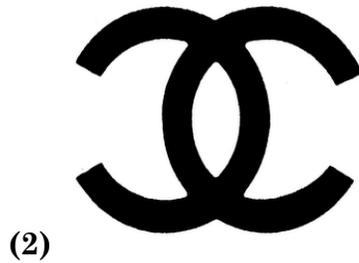
⁶ Issued on March 27, 1984 and last renewed on February 4, 2014.

⁷ Issued on June 7, 1983 and last renewed on March 22, 2013.

⁸ Issued on November 30, 1965 and last renewed on February 6, 2016.

⁹ Issued on January 26, 1943 and last renewed on January 24, 2013.

¹⁰ Issued on February 24, 1925 and last renewed on March 7, 2015.



shown in

- Registration No. 4074269 for protective covers for portable electronic devices, handheld digital devices, personal computers and cell phones, in International Class 9; temporary tattoos, in International Class 16; and key cases, in International Class 18;¹¹
- Registration No. 1734822 for leather goods, namely, handbags, wallets, travel bags, luggage, business card cases, change purses, tote bags, and cosmetic bags sold empty, in International Class 18;¹²
- Registration No. 1654252 for sunglasses, in International Class 9;¹³
- Registration No. 1314511 for leather goods-namely handbags, in International Class 18;¹⁴ and
- Registration No. 1293398 for retail store services in the field of ready-to-wear clothing, in International Class 42;¹⁵ and

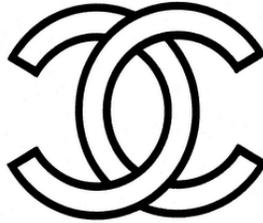
¹¹ Issued on December 20, 2011. The mark is described in the registration as consisting “of back-to-back interlocking Cs.”

¹² Issued on November 24, 1992 and last renewed on November 13, 2012.

¹³ Issued on August 20, 1991 and last renewed on February 16, 2011.

¹⁴ Issued on January 15, 1985 and renewed on January 26, 2015.

¹⁵ Issued on September 4, 1984 and renewed on September 16, 2014.



(3)

shown in Registration No. 1501898 for keychains, in International Class 6; costume jewelry, in International Class 14; gift wrapping paper, in International Class 16; blouses, shoes, belts, scarves, jackets, and men's ties, in International Class 25; and brooches and buttons for clothing, in International Class 26.¹⁶

The parties stipulated to resolution of this case under a modified version of the Board's Accelerated Case Resolution ("ACR") procedure. 7 TTABVUE; 9 TTABVUE. Only Opposer submitted evidence and filed a brief. We sustain the opposition.

I. Evidentiary Record

In their ACR stipulation, the parties agreed to submit evidence in the form of declarations, affidavits, or notices of reliance, subject to cross-examination. 7 TTABVUE 3-5. Applicant did not cross-examine any of Opposer's declarants, or object to any of Opposer's evidence, and we have considered all of it for whatever probative value it may have. The facts established by the record are effectively undisputed.¹⁷

¹⁶ Issued on August 30, 1988 and renewed on July 14, 2008.

¹⁷ As discussed below, Opposer made of record several of Applicant's discovery responses, treating them as if they were evidence on behalf of Applicant, and responding to statements made therein by Applicant as if they were Applicant's legal arguments. We will treat these discovery responses in the same manner. *See* Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) ("When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.")

The record consists of:

- (1) the pleadings;¹⁸
- (2) the file of Applicant's application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1);
- (3) the declaration of Joyce Green, Opposer's Executive Vice President of Fashion, and Exhibits 1-75 attached thereto, 16-27 TTABVUE,¹⁹ the declaration of Taryn C. Looney, Opposer's Director-Counsel, and Exhibits 76-83 thereto, 29 TTABVUE, and the declaration of Emily Weiss, Opposer's counsel of record, and Exhibits 84-86 thereto, 30 TTABVUE;²⁰
- (4) Opposer's Notices of Reliance on certain of Applicant's written discovery responses (Exhibits 87-88 thereto), 30 TTABVUE, and on printed publications and Internet materials (Exhibits 89-92 thereto), 31 TTABVUE;

¹⁸ In a November 15, 2016 order following the parties' discovery conference, the Board found that Applicant's Answer, 4 TTABVUE, admitted Opposer's ownership of its pleaded registrations and their validity and registered status, and otherwise denied the salient allegations of the Notice of Opposition. 1 TTABVUE. The Board also found that the affirmative defenses set forth in the Answer were merely amplifications of Applicant's denials. 8 TTABVUE 7-8.

¹⁹ Portions of Ms. Green's declaration and various exhibits thereto were designated "Confidential-Attorneys Eyes Only" under the Board's Standard Protective Order. This evidence was redacted in the publicly accessible version of Ms. Green's declaration, and was filed under seal at 16-21 TTABVUE. Citations in this opinion to Ms. Green's testimony are to paragraphs in the public (redacted) version of her declaration at 22 TTABVUE. Citations to exhibits are to exhibit numbers and TTABVUE pages in the public versions of the exhibits at 22-27 TTABVUE. We will summarize in general terms the evidence that was designated confidential.

²⁰ Citations in this opinion to testimony in the Looney and Weiss declarations are to paragraphs in those declarations at 28 TTABVUE and 29 TTABVUE, respectively. Citations to exhibits are to exhibit numbers and TTABVUE pages.

- (5) Opposer's pleaded registrations, by virtue of attachment as Exhibit A to its Notice of Opposition of printouts from the Patent and Trademark Office's Trademark Status & Document Retrieval database showing their current status and title, pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), 1 TTABVUE 19-71; and
- (6) The following stipulated facts (reproduced verbatim from the ACR stipulation):²¹
- (a) The existence of and Opposer's ownership of the pleaded registrations attached to the Notice of Opposition.
 - (b) Opposer has standing to bring the Opposition.
 - (c) Opposer's pleaded registrations are valid and subsisting.
 - (d) Opposer's use of the CC Monogram mark precedes the application filing date of the opposed CC mark by Applicant and the use of said mark by Applicant.
 - (e) Applicant was aware of Opposer's CC Monogram prior to its adoption of the mark opposed and prior to the filing date of the opposed application.
 - (f) Applicant is not associated, affiliated or connected in any way with Opposer or its business.
 - (g) Applicant is a New Jersey limited liability partnership doing business at 4105 US Highway 1, Suite 12I, Monmouth Junction, NJ 08852.

²¹ 7 TTABVUE 2-3.

(h) On June 25, 2015, Applicant filed an application based on use to register the opposed CC mark for “accounting services” in Class 35. The application was assigned Serial No.86/674,771.

II. Opposer’s Dilution Claim

In view of the parties’ stipulation that Opposer has standing, we proceed to consider the claim of dilution by blurring.

A. The Law of Dilution

The Trademark Act provides a cause of action in an opposition for the dilution of a famous mark under Sections 13 and 43(c), 15 U.S.C. §§ 1063 and 1125(c). Section 13(a) of the Act provides as follows:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office.

Section 43(c) of the Act provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to [relief] against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Opposer specifically asserts a claim of dilution by “blurring.” 15 TTABVUE 15. Section 43(c)(2)(B) of the Trademark Act defines dilution by blurring as an “association arising from the similarity between a mark or trade name and a famous

mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). “Dilution diminishes the ‘selling power that a distinctive mark or name with favorable associations has engendered in the mind of the consuming public.” *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2018 (TTAB 2014) (quoting *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1182 (TTAB 2001) (internal citation omitted)).

The Federal Circuit has set forth the following elements that an opposer must prove to prevail on a dilution by blurring claim:

- (1) the opposer owns a famous mark that is distinctive;
- (2) the applicant is using a mark in commerce that allegedly dilutes the opposer’s famous mark;
- (3) the applicant’s use of its mark began after the opposer’s mark became famous; and
- (4) the applicant’s use of its mark is likely to cause dilution by blurring.

Coach Servs. Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012). Opposer bears the burden of proving its dilution claim by a preponderance of the evidence. *Makarczyk*, 110 USPQ2d at 2017.

B. Was the CC Monogram Famous When Applicant’s Use of Its Mark Began?

1. The Standards for Proof of Fame

“A threshold question in a federal dilution claim is whether the mark at issue is ‘famous.’ [A] mark is famous if it 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.” *Coach*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(A)). “It is well established that dilution fame is difficult to prove.” *Makarczyk*, 110 USPQ2d

at 2019 (quoting *Coach*, 101 USPQ2d at 1724 (internal quotation omitted)). To prove it, “[a]n 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.’” *Id.* (quoting *Coach*, 101 USPQ2d at 1724). “In addition, ‘a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of its trademark context.’” *Id.* (quoting *Toro*, 61 USPQ2d at 1177).

The Trademark Act lists four non-exclusive factors to consider when determining whether a mark is famous:

- i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- iii. The extent of actual recognition of the mark.
- iv. Whether the mark was registered under the Act of March 3, 1881, or the act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A).

2. The Date by Which Opposer Must Prove That Its CC Monogram Mark Had Become Famous

“The third prong [of the test for dilution] requires the owner of a famous mark to demonstrate that its mark became famous prior to applicant’s established use or filing date.” *Makarczyk*, 110 USPQ2d at 2024. Like this case, *Makarczyk* involved a dilution claim against a use-based application in which the applicant submitted no

evidence in an ACR proceeding. The Board held that in the absence of evidence of the applicant's date of actual first use,²² the date by which Opposer had to prove that its mark had become famous was the filing date of the opposed application, which is the applicant's date of constructive use under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c). *Id.* (citing *Coach*, 101 USPQ2d at 1725).

Here, however, Applicant's June 25, 2015 filing date is not the date by which Opposer must prove that its mark had become famous because Opposer itself fixed an earlier date by arguing in its brief that the "earliest date that Applicant has been able to establish is January 8, 2002." 15 TTABVUE 17.²³ Opposer thus must show that its mark became famous by January 8, 2002. *See Citigroup*, 94 USPQ2d at 1665 (requiring opposer to prove that its mark became famous prior to established date of applicant's first use of its mark, not its filing date).

3. Opposer's Evidence of Fame

a. Discussion of the Fame of the CC Monogram Mark in Prior Proceedings

Opposer made of record numerous "judgments and decisions rendered in cases brought by [Opposer] for trademark infringement and dilution [in which] courts have acknowledged the fame and/or strength of the CC Monogram Mark," as well as a non-precedential Board decision, *Chanel, Inc. v. Mauriello*, Opp. No. 91172654 (TTAB

²² Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), provides that the "allegation in an application for registration . . . of a date of use is not evidence on behalf of the applicant . . . ; a date of use of a mark must be established by competent evidence."

²³ Opposer made of record an invoice bearing that date. Weiss Decl. ¶ 4; Ex. 86 (29 TTABVUE 3, 13-14).

Sept. 20, 2010) (10 TTABVUE in Opp. No. 91172654), in which the Board found that Opposer's CHANEL word mark and "all of the variations of the [CC Monogram Mark] are extremely famous and have been a fashion fixture for nearly a century." *Id.* at 10 TTABVUE 15. Looney Decl. ¶¶ 14-16; Exs. 80-82 (28 TTABVUE 6-10, 218-473).²⁴

The findings of fame in the civil cases do not establish the fame of the CC Monogram Mark for purposes of Opposer's dilution claim here. As the Board explained in *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 94 USPQ2d 1645, 1665-66 (TTAB 2010), *aff'd on other grounds*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011):

The decision by another court based upon a different record is not evidence in this proceeding. Section 17(a) of the Trademark Act of 1946, 15 U.S.C. § 1067(a), gives the Board the authority and duty to decide the right to registration in an opposition. That duty may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an opposition must be decided on the evidence of record.... [The] applicant cannot be bound by the findings of fact of another court that were not duplicated in this proceeding.

Our decisions in *Makarczyk* and *Mauriello* also do not establish the fame of the CC Monogram Mark for dilution purposes for the same reasons. We may not be bound by findings of fact made on a different record involving another party and presenting different facts. Fame is a factual matter that must be established on the record in each proceeding. Whether the record in Opposer's previous proceedings was sufficient

²⁴ Ms. Looney, Opposer's witness regarding the registration and enforcement of the CC Monogram Mark, has been employed by Opposer as an in-house attorney since 2011. Looney Decl. ¶ 1 (28 TTABVUE 2). She testified that her knowledge of the history of Opposer's registration and enforcement of the CC Monogram Mark is based upon her job duties, and her research in, and review of, Opposer's records and documents kept in the ordinary course of Opposer's business. Looney Decl. ¶¶ 1-3 (28 TTABVUE 2-3). We find that she has personal knowledge of these matters and is competent to testify about them. Fed. R. Evid. 602.

to establish its fame in other timeframes is not relevant to whether the record in this proceeding is sufficient to establish fame now. “[I]t is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto.” *Chicken Delight, Inc. v. Delight Wholesale Co.*, 193 USPQ 175, 177 (TTAB 1976) (citing *Aloe Creme Labs., Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970)); cf. *Hyde Park Footwear Co. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641 (TTAB 1977) (findings of fact in an opposition between and opposer and a third party cannot be used against a different applicant). In the non-precedential decision in *Mauriello*, the Board found that the CC Monogram Mark was famous for purposes of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), not for dilution purposes, an important distinction.²⁵ In the precedential *Makarczyk* decision, the Board found Opposer’s CHANEL word mark, not the CC Monogram Mark, to be famous for dilution purposes.²⁶

Applicant admitted that it had no evidence to dispute Opposer’s claim that the CC Monogram Mark was famous for dilution purposes, but left Opposer to prove that its mark was famous at the time Applicant started using its mark. 30 TTABVUE 14-15

²⁵ “Fame for likelihood of confusion purposes and fame for dilution purposes... are different concepts.... While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.2d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

²⁶ Citing *Makarczyk*, Opposer argues that the CC Monogram Mark is “the visual symbol of Chanel” and “equally famous” to the word mark, 15 TTABVUE 8, but Opposer must separately show the fame of the CC Monogram Mark to prevail here.

(Response to Request for Admission No. 1). We turn now to a review of the evidence offered by Opposer to establish such fame.

b. General Background Regarding Opposer's Business

Opposer's CC Monogram Mark is derived from the initials of Opposer's founder, Gabrielle "Coco" Chanel. Green Decl. ¶¶ 4, 11 (22 TTABVUE 3, 5).²⁷ Ms. Chanel entered the fashion business in France in 1910, and subsequently expanded her business to beauty products. Green Decl. ¶¶ 4-5 (22 TTABVUE 3-4). In 1921, she introduced her first perfume, Chanel No. 5, which was branded with the CC Monogram Mark, and in 1924, she introduced additional beauty products branded with the mark. Green Decl. ¶ 5 (22 TTABVUE 4). By 1934, Ms. Chanel's company was selling fashion and beauty products worldwide, including in the United States. Green Decl. ¶ 6 (22 TTABVUE 4).

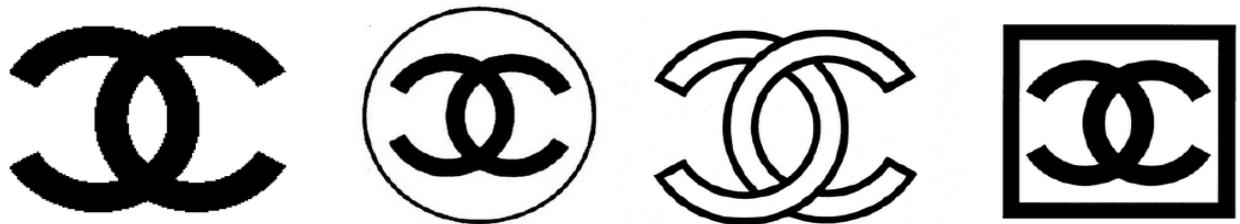
Following World War II, Ms. Chanel and her company expanded their product line into handbags, wallets, and other leather accessories, Green Decl. ¶ 17 (22 TTABVUE 7-8), which bore hardware bearing the CC Monogram Mark beginning in the 1970s. Green Decl. ¶¶ 7, 17 (22 TTABVUE 4, 7-8). Use of the CC Monogram Mark on men's fragrance products and personal care products in the United States began in the 1950s, Green Decl. ¶ 22 (22 TTABVUE 9-10), use on clothing and related products in

²⁷ Ms. Green, Opposer's witness regarding the history of Opposer and the CC Monogram Mark, and multiple other matters, has been employed by Opposer in various positions since 2007. Green Decl. ¶ 1 (22 TTABVUE 2). She testified that her knowledge of matters that preceded the period of her employment with Opposer is based upon her various job duties and her research in, and review of, Opposer's records and documents kept in the ordinary course of Opposer's business. Green Decl. ¶¶ 1-3 (22 TTABVUE 2-3). We find that she has personal knowledge of the matters that are the subject of her declaration and is competent to testify about them. Fed. R. Evid. 602.

the United States began no later than the early 1960s, Green Decl. ¶ 17 (22 TTABVUE 7-8), and use on fashion accessories such as scarves, shoes, and costume jewelry in the United States began in the 1980s. Green Decl. ¶ 16 (22 TTABVUE 7).

After Ms. Chanel died in 1971, Opposer launched a full line of skin care and cosmetics products, and a few years later launched a retail collection of ready-to-wear fashion and accessories. Green Decl. ¶ 9 (22 TTABVUE 5). In the 1980s, Opposer began opening boutiques in various locations in the United States. Green Decl. ¶ 9 (22 TTABVUE 5). The CC Monogram Mark figured prominently in these expansions of Opposer's business. Green Decl. ¶ 9 (22 TTABVUE 5). In 1983, designer Karl Lagerfeld was appointed Opposer's "Artistic Director," and Opposer expanded its business into cutting-edge luxury fashion design. Green Decl. ¶ 10 (22 TTABVUE 5).

Opposer has used the variations of the CC Monogram Mark shown below, as well as more fanciful ones.



Green Decl. ¶ 12 (22 TTABVUE 6). The consistent element in these displays has been the interlocking back-to-back letters C. Green Decl. ¶ 13 (22 TTABVUE 6).

c. Non-Exclusive Fame Factors

(i) Advertising and Publicity of the CC Monogram Mark in the United States

Opposer has used a wide range of media to advertise and promote its products in the United States. Green Decl. ¶ 44 (22 TTABVUE 19). The CC Monogram Mark has appeared in the vast majority of the advertisements for Opposer's fashion and cosmetics products, either as a standalone element in the advertisement, or on the advertised product or its packaging (or both). Green Decl. ¶ 44; Ex. 21 (22 TTABVUE 19; 23 TTABVUE 774-863). Portions of a few of the advertisements from the period between 1925 and 1998 are reproduced below:



Vogue, June 1, 1934 (23 TTABVUE 780-781)



New Yorker, June 19, 1948 (23 TTABVUE 786).



Harper's Bazaar, November 1969 (23 TTABVUE 797).



Harper's Bazaar, November 1979 (23 TTABVUE 801).

The pre-2002 advertisements in the record frequently featured celebrities and models such as Marilyn Monroe, Catherine Deneuve, Carole Bouquet, and Ali McGraw. Green Decl. ¶ 54; Ex. 30 (22 TTABVUE 27; 24 TTABVUE 96-146). A 1966 advertisement featuring Ms. McGraw is reproduced below.



Ali McGraw, 1966. Photo: Chanel

Opposer focuses on print advertising in national and regional magazines and newspapers, including fashion periodicals such as *Vogue*, men's magazines such as *GQ*, specialty publications such as *Architectural Digest*, and general interest publications such as *People* and *The New York Times*. Green Decl. ¶ 47 (22 TTABVUE 20-24). Between 1988 and 1998, Opposer's advertisements displaying the CC Monogram Mark appeared in over 100 national publications and over 150 regional publications, as well as in selected trade publications, and such advertising has continued to the present. Green Decl. ¶ 47 (22 TTABVUE 20-24). Ms. Green testified that more than 1 billion copies of print advertisements displaying the CC Monogram Mark appeared in print publications between 1988 and 1998, and more than 5 billion copies appeared between 1999 and the present. Green Decl. ¶ 48 (22 TTABVUE 24). She estimated, on the basis of circulation figures for publications such as *The New York Times*, *Vogue*, *Cosmopolitan*, *Glamour*, and *Rolling Stone*, that print advertising displaying the CC Monogram Mark had reached tens of millions of people in the United States as of 1998. Green Decl. ¶ 49 (22 TTABVUE 24-25).

Opposer has also advertised products bearing the CC Monogram Mark on both network and cable television for more than 40 years. Green Decl. ¶ 50 (22 TTABVUE 25). Opposer's television advertising has often featured well-known celebrities and models. Green Decl. ¶ 50; Ex. 23 (22 TTABVUE 25; 24 TTABVUE 41-44). A screenshot from a 1977 commercial featuring Ms. Deneuve is depicted below.

“Mystery” – Commercial for Chanel No. 5 featuring Catherine Deneuve – 1977



24 TTABVUE 43.

Opposer’s specific advertising and promotional expenditures, and Opposer’s rank in such expenditures vis-à-vis its competitors in the cosmetics and fashion industries, were designated Confidential-Attorneys Eyes Only. Green Decl. ¶¶ 44-45 (22 TTABVUE 18-19). We have reviewed the uncontradicted designated testimony and it reliably establishes that Opposer’s advertising and promotional expenditures, including those incurred before 2002, have been very substantial and have grown steadily after 1988, and that Opposer has been among the most prolific advertisers in the beauty and fashion businesses.

In addition to Opposer’s own advertising, third-party retailers such as Bergdorf Goodman, Saks Fifth Avenue, I. Magnin, and Bloomingdales have advertised and promoted Opposer’s products bearing the CC Monogram Mark through print advertising, catalogs, and other means. Green Decl. ¶ 54; Ex. 31 (22 TTABVUE 27; 24 TTABVUE 147-210).

The CC Monogram Mark has also been exposed to the United States public through published and widely disseminated photographs of numerous well-known people such as the late Princess Diana wearing products bearing the CC Monogram Mark. Green Decl. ¶¶ 55-57; Exs. 33-35 (22 TTABVUE 27-29; 24 TTABVUE 242-345). Photographs of celebrities wearing products bearing the CC Monogram Mark typically appear in unsolicited articles in publications in which Opposer does not advertise, which increases the exposure of the mark beyond Opposer's own advertising. Green Decl. ¶ 57 (22 TTABVUE 29).

The CC Monogram Mark has also been displayed and/or discussed in media articles in general circulation publications. Green Decl. ¶¶ 58-60; Exs. 36-37 (22 TTABVUE 29-34; 24 TTABVUE 346-488; 25 TTABVUE 3-290). Ms. Green testified that "third-party publications commonly acknowledge the fame and prominence of the CC Monogram Mark," Green Decl. ¶ 60 (22 TTABVUE 31), and she quoted from multiple articles that expressly describe the CC Monogram Mark as famous or iconic, Green Decl. ¶ 60f, i-j, n-s, u, w-x, including articles from the Associated Press (September 6, 1991) ("The House of Chanel likes camellias, in addition to its famous gild double-c logo.") (24 TTABVUE 369), *The Atlanta Constitution* (October 24, 1993) (Chanel black-and-white hightop shoes "boast leather insides and the famous CC logo on the side.") (24 TTABVUE 399), the *Chicago Tribune* (July 1, 1992) ("She says the collections add to the Chanel cachet, which purchasers of ready-to-wear, perfume and accessories feel they're sharing when they buy anything bearing the famous double-C logo.") (24 TTABVUE 378), *The Dallas Morning News* (November 3, 1999) (at a

fashion show, “the famous double C appeared on colorful printed silks, and some models wore glitter double C stick-on skin jewelry.”) (25 TTABVUE 11), and *The Houston Chronicle* (March 30, 2000) (“Chanel cocktail dresses for spring have tiered chiffon skirts printed with the famous double-C logo among the flowers.”) (25 TTABVUE 21). These articles are probative of the exposure of the CC Monogram Mark to the public, and the extent to which the public has been conditioned to regard the CC Monogram Mark as famous, iconic, or recognizable. *Makarczyk*, 110 USPQ2d at 2021.

The CC Monogram mark has also been exposed to the public through media coverage of fashion shows at which the CC Monogram Mark has been worn by models and otherwise displayed, Green Decl. ¶¶ 25-26, 63; Exs. 6-7, 47 (22 TTABVUE 11-12, 36; 26 TTABVUE 346-381, 655-755), references to the CC Monogram Mark in a variety of fiction and non-fiction books, including *The End of Fashion: The Mass Marketing of The Clothing Business* (1999) (referring to the CC Monogram Mark as an “enduring marketing symbol” (26 TTABVUE 434) and *Skeleton Key: A Gregor Demarkian Novel* (2001) (character notes how he “recognized the double-C bit on the handle” as Chanel (26 TTABVUE 442), Green Decl. ¶ 65a-u; Exs. 50-70 (22 TTABVUE 37-40; 26 TTABVUE 426-517), and placement of products displaying the mark in episodes of the television series *Sex and the City*, *Will & Grace*, and *The Nanny* that aired prior to 2002. Green Decl. ¶ 71; Ex. 75 (22 TTABVUE 41; 27 TTABVUE 3-33).²⁸

²⁸ Opposer also cites the *Women’s Wear Daily 100* brand recognition survey, Green Decl. ¶ 61; Ex. 38 (22 TTABVUE 34; 26 TTABVUE 3-137), and other general or industry-specific brand

Opposer's and retailers' extensive advertising of goods bearing the CC Monogram Mark in the print and electronic media over many decades, and the United States public's extensive exposure to the mark through its association with celebrities, its appearance and discussion in various media, and in the other manners shown by the record, support a finding that the mark is famous.

(ii) Sales of Goods Bearing the CC Monogram Mark

The CC Monogram Mark has been used prominently on clothing, footwear, leather goods, and a full range of beauty and fragrance products in the United States. Green Decl. ¶ 20 (22 TTABVUE 8-9). Ms. Green estimated that the CC Monogram Mark appears on 80-85% of Opposer's ready-to-wear fashion products, 90-95% of Opposer's leather accessories, 85-90% of Opposer's footwear, 95-100% of Opposer's costume jewelry, 80% of Opposer's eyewear, and 95% of Opposer's fragrance and beauty products. Green Decl. ¶ 30 (22 TTABVUE 13-14).

Goods bearing the CC Monogram Mark have long been sold to both women and men and to various demographic segments of the American public. Green Decl. ¶¶ 34-36 (22 TTABVUE 15-16). They have been distributed throughout the United States

recognition surveys or brand rankings, Green Decl. ¶ 62; Exs. 39-46 (22 TTABVUE 34-36; 26 TTABVUE 138-344), as evidence of fame. The Board relied on this evidence in *Makarczyk* to find the CHANEL word mark to be famous, 110 USPQ2d at 2021, and Ms. Green claimed that “[b]ecause the CC Monogram appears on the vast majority of Chanel products, the fame of the CC Monogram Mark is implicit in these brand recognition surveys.” Green Decl. ¶ 61 (22 TTABVUE 34). We disagree. The entries for Chanel in the *Women's Wear Daily 100* brand recognition surveys do not depict or discuss the CC Monogram Mark. The survey reports characterize their results as identifying “the winners of the name game,” 26 TTABVUE 88, and the “most recognizable names in fashion.” 26 TTABVUE 96, 99, and they showed brand names, not accompanying logos, to respondents, e.g., 26 TTABVUE 96. The other brand recognition surveys and rankings similarly do not reflect recognition of the CC Monogram Mark, as they do not focus on the mark per se. 26 TTABVUE 186.

through Opposer's own boutiques, through national and local retailers, and, since 2000, through Opposer's website. Green Decl. ¶ 37 (22 TTABVUE 16).

Prior to 2002, Opposer opened at least 10 boutiques in major cities in the United States. Green Decl. ¶ 38 (22 TTABVUE 16). All of them prominently displayed the CC Monogram Mark. Green Decl. ¶¶ 38-39; Ex. 17 (22 TTABVUE 16-17; 23 TTABVUE 34-38). A photograph of the interior of a pre-2002 boutique is reproduced below.



23 TTABVUE 35.

Fragrances and beauty products bearing the CC Monogram Mark have been sold through retailers since the late 1920s, and fashion products bearing the mark have been sold through retailers since the late 1970s. Green Decl. ¶ 40 (22 TTABVUE 17). By the end of 1998, the fashion products were sold through nearly 50 retailers and the fragrance and beauty products, as well as eyewear bearing the mark, were sold through over 1,000 retailers. Green Decl. ¶ 40 (22 TTABVUE 17). Retailers have historically prominently displayed the CC Monogram Mark, including in dedicated Chanel areas of the stores. Green Decl. ¶ 40 (22 TTABVUE 17).

Opposer has also displayed the CC Monogram Mark on its website since 2000. Green Decl. ¶ 41; Ex. 19 (22 TTABVUE 17-18; 23 TTABVUE 78-104). An archived screenshot from 2001 is reproduced below.



May 16, 2001
<https://web.archive.org/web/20010428065143/http://chanel.com:80/fb/index.cfm/>

23 TTABVUE 81.

The CC Monogram Mark has been used in the United States on nearly every compact, bottle, tube, or other container for Opposer's cosmetics for over 90 years, Green Decl. ¶¶ 14-15, 22-23; Exs. 1, 5 (22 TTABVUE 6-7, 9-10, 45-46, 606-654), on bags, wallets, and other leather accessories for over 60 years, Green Decl. ¶ 17 (22 TTABVUE 7-8), and on clothing for over 50 years. Green Decl. ¶ 16 (22 TTABVUE 7). The CC Monogram Mark has been used on or in connection with these goods in a variety of ways, including on hangtags and labels for clothing, scarves, headwear, gloves, and hosiery, through embossment on products such as bags and wallets, as a closure device or a zipper pull on bags and luggage, as a design element for products such as costume jewelry, sunglasses, handbags, belts, shoes, and gloves, and on external and internal packaging for beauty products. Green Decl. ¶¶ 21-23; Ex. 4 (22 TTABVUE 9-10, 52-605).

The record shows that the CC Monogram Mark is often the focal point of Opposer's clothing, leather goods, and accessories. One example is depicted below.



22 TTABVUE 269.

The record further shows that the CC Monogram Mark is prominently displayed on virtually all of Opposer's beauty and fragrance products. A few examples are depicted below.





22 TTABVUE 607, 611, 642, 646.

The CC Monogram Mark has appeared on Opposer's flagship Chanel No. 5 products since 1921, Green Decl. ¶ 14; Ex. 1 (22 TTABVUE 6-7, 45-46), and on other beauty products since 1924, Green Decl. ¶ 15; Ex. 2 (22 TTABVUE 7, 47-48), and the Patent and Trademark Office issued Opposer's Registration No. 195359 of the CC Monogram Mark for face powder, perfume, eau de cologne, toilet water, lipstick, and rouge in February 1925. Looney Dec. ¶ 5; Ex. 76 (28 TTABVUE 3-4, 17-26). Opposer

has used the CC Monogram Mark on women's beauty products such as foundation, concealer, blush, bronzers, eyeshadow, mascara, eyeliner, brow pencils, lipstick, lip gloss, lip liner, nail polish, moisturizer, cleaner, serum, and masks, as well as fragrances such as Chanel No. 5, Coco Mademoiselle, and Chance, which have consistently been among the best-selling fragrances in the United States. Green Decl. ¶ 22 (22 TTABVUE 9-10). Opposer has also used the CC Monogram Mark on men's fragrance and personal care products, such as shower gel, shave gel, after shave lotion, and deodorants. Green Decl. ¶ 22 (22 TTABVUE 9-10). Opposer was among the leading sellers of beauty and fragrance products in the United States during the 1990s, Green Decl. ¶ 32; Exs. 8-9 (22 TTABVUE 14; 23 TTABVUE 3-8), and by 2002, Opposer's fragrances bearing the CC Monogram Mark enjoyed a 7% share of the women's fragrance market in the United States, and a 2% share of the men's fragrance market in the United States. Green Decl. ¶ 22 (22 TTABVUE 10).

Since the 1920s, many millions of units of various Chanel No. 5 products and other beauty products bearing the CC Monogram Mark have been sold in the United States, and those sales have generated many billions of dollars in revenues. Green Decl. ¶¶ 14-15 (22 TTABVUE 6-7). In addition, millions of units of apparel and accessories bearing the CC Monogram Mark have been sold in the United States, and those sales have also generated many billions of dollars in revenues. Green Decl. ¶ 17 (22 TTABVUE 7-8). Ms. Green estimated that Opposer had sold many millions of product units bearing the CC Monogram Mark in the United States since the 1920s, yielding

revenues in the billions of dollars. Green Decl. ¶¶ 28-29 (22 TTABVUE 12-13).²⁹ The total unit and revenue figures for sales of products bearing the CC Monogram Mark through 2002 are confidential but very impressive. Green Decl. ¶¶ 29-30 (22 TTABVUE 13-14).

The extensive sales of a wide variety of goods bearing the CC Monogram Mark to various segments of the American public through multiple channels of distribution over many decades support a finding that the mark is famous. *See, e.g., N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1503-04 (TTAB 2015).

(iii) Extent of Actual Recognition of the CC Monogram Mark

Opposer offered no probative evidence regarding the extent of actual recognition of the CC Monogram Mark,³⁰ and this factor is neutral in our analysis of fame.

(iv) Registration of the Mark

Opposer owns 12 registrations of the CC Monogram Mark on the Principal Register that issued prior to 2002. As discussed above, they cover a wide variety of goods, including clothing, leather goods, fragrance and beauty products, and accessories, as well as retail store services in the field of ready-to-wear clothing. The

²⁹ Ms. Green explained that she was required to estimate unit sales because Opposer rotated goods offered in its collections each year. Green Decl. ¶ 28 (22 TTABVUE 12).

³⁰ Ms. Green testified that “consumers view the CC Monogram Mark as a visual representation of the Chanel brand,” citing a “recent survey” that purportedly showed that a very high percentage of women associate the CC Monogram Mark only with Opposer. Green Decl. ¶ 27 (22 TTABVUE 12). The survey was not made of record and appears in any event to have been conducted long after 2002, and we have given no weight to Ms. Green’s testimony about it. *Cf. Coach*, 101 USPQ2d at 1726 (brand awareness study not supported by a witness with first-hand knowledge and conducted several years after filing date of opposed application appropriately given limited weight).

oldest of these registrations issued in 1925, and eight of them have been on the Principal Register for more than 30 years.

“[W]hile proof of registration is not *conclusive* evidence of fame,” *Coach*, 101 USPQ2d at 1725, the number and scope of Opposer’s registrations support a finding that the CC Monogram Mark had become famous by 2002. *Cf. N.Y. Yankees*, 114 USPQ2d at 1504 (five registrations of New York Yankees’ “Top Hat” design mark for baseball-related services and collateral goods that issued between 1976 and 2007 supported fame of mark as of 2008); *McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1287-89 (TTAB 2014) (eight registrations of “Mc-” formative marks for restaurant services and food products that issued between 1977 and 2007 supported fame of “Mc-” family of marks prior to 1990).

4. Summary

We find, on the basis of the record as a whole, that Opposer has carried its burden of showing that the CC Monogram Mark had become famous in the United States within the meaning of Section 43(c)(2)(A) of the Trademark Act prior to Applicant’s established first use of its mark in 2002. The extensive advertising, promotion, and exposure of the mark to the general public, the extensive sales and widespread distribution of a variety of goods bearing the mark over many decades, and the longtime registration of the mark for a variety of goods and services, persuade us that the CC Monogram Mark “enjoys widespread recognition among the general public and is a ‘household name’ synonymous with high fashion and style for the products and services identified in its pleaded registrations, and is therefore famous for dilution purposes.” *Makarczyk*, 110 USPQ2d at 2022. We further find that the CC

Monogram Mark is also distinctive, either inherently or through the acquisition of distinctiveness, *id.*, for the reasons discussed in detail below in connection with our analysis of the degree of distinctiveness of the mark.

C. Applicant’s Use of Its Mark in Commerce

“The second dilution element Opposer must establish is that Applicant is using its allegedly diluting mark in commerce.” *N.Y. Yankees*, 114 USPQ2d at 1505. Opposer may prove Applicant’s use in commerce “by direct evidence or may rely on the application filing date as the date of constructive use.” *Makarczyk*, 110 USPQ2d at 2023. Opposer made of record Applicant’s admissions of its use of its mark in commerce, 30 TTABVUE 9-10, and thus has established this element of Opposer’s claim.

D. Likelihood of Dilution by Blurring

The Trademark Act sets forth a non-exclusive list of factors to be considered in making the determination of likelihood of dilution by blurring:

- i. the degree of similarity between the mark or trade name and the famous mark;
- ii. the degree of inherent or acquired distinctiveness of the famous mark;
- iii. the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- iv. the degree of recognition of the famous mark;
- v. whether the user of the mark or trade name intended to create an association with the famous mark; and

- vi. any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 43(c)(2)(B)(i-vi).

1. The Degree of Similarity Between the Marks

Under the Trademark Dilution Revision Act of 2006, we must determine “whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *N.Y. Yankees*, 114 USPQ2d at 1506 (quoting *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010)). “[F]or purposes of this element, it is sufficient that the [marks] be highly similar.” *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012).

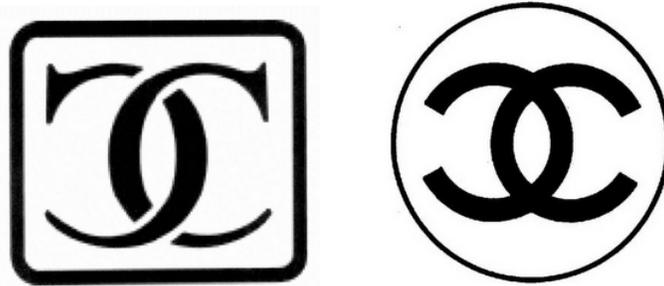
In determining similarity for purposes of dilution by blurring, we are guided by the analysis that we apply to the issue of the similarity of marks for purposes of likelihood of confusion under Section 2(d) of the Trademark Act:

While we are not conducting a Section 2(d) likelihood of confusion analysis under this factor for dilution by blurring, we still consider the degree of similarity or dissimilarity of the marks in their entirety as to appearance, connotation, and commercial impression.... We consider the marks in terms of whether they are sufficiently similar in their overall commercial impressions that the required association exists.

N.Y. Yankees, 114 USPQ2d at 1506 (citations omitted).

We do not base our determination of similarity on a side-by-side comparison of the marks, *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1030 (TTAB 2011), but for ease of

reference in following our analysis, we reproduce below Applicant's mark on the left, and one of the several variations of the CC Monogram Mark on the right:



The overall visual similarities between the marks are immediately apparent, and striking. Both marks consist of interlocking, back-to-back letters "C," both display the letters in roughly the same proportion to one another, both have a central space between the letters C, and in both, the back-to-back letters appear to be linked to, or intertwined with, one another. We acknowledge differences between the marks resulting from different font styles, the existence of breaks in Applicant's mark in the letters where they intersect, different manners of display of the top end of the letter C, and the presence of a square border in Applicant's mark,³¹ but they are insignificant because the relevant inquiry is not whether the differences could be discerned in a side-by-side comparison, *Nike*, 100 USPQ2d at 1030, but rather whether someone "encountering Applicant's mark will immediately be reminded of Opposer's famous ... design mark and associate the two." *N.Y. Yankees*, 114 USPQ2d at 1507.

³¹ The border serves only to frame the back-to-back letters "C," which are what create the commercial impression of Applicant's mark. In any event, the CC Monogram Mark is also bordered by a square in one of its unregistered variations.

The marks are highly similar in appearance and commercial impression, and “when considered in their entireties, we find that the appearance of the marks overall is sufficiently similar that Applicant’s mark ‘will trigger consumers to conjure up’ Opposer’s famous mark” and to associate the two marks. *Id.* (finding that the parties’ “top hat” marks were sufficiently similar for dilution by blurring to be likely notwithstanding “significant differences between the marks” as shown below)



Applicant’s Mark

Opposer’s Marks

Cf. Nike, 100 USPQ2d at 1030 (JUST JESU IT sufficiently similar to JUST DO IT to support finding of dilution by blurring). This factor supports a finding of dilution by blurring.

2. The Degree of Inherent or Acquired Distinctiveness of the CC Monogram Mark

“This factor requires us to analyze how distinctive or ‘unique’ the mark is to the public. The inquiry is made even when it is undisputed that opposer’s mark is registered on the Principal Register.” *Makarczyk*, 110 USPQ2d at 2025 (quoting *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 2003)). “The more inherently distinctive and memorable the mark, the more likely it is to be blurred by the use of other identical or similar marks. The more descriptive the mark, the less likely it is to be blurred by the use of identical or similar marks.” *Id.* (quotation omitted).

Opposer's CC Monogram Mark is shown in multiple registrations on the Principal Register, all of which issued without a requirement that Opposer show acquired distinctiveness under Section 2(f) of the Trademark Act. "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." *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *see also Nat'l Pork Bd.*, 96 USPQ2d at 1497.

As a factual matter, the CC Monogram Mark is a fanciful depiction of two back-to-back interlocking letters "C." The letters themselves do not describe or suggest any characteristics of the goods and services with which they are used, and we agree with Opposer that the fact that the letters are derived from the initials of Opposer's founder Coco Chanel "also does not diminish the inherent distinctiveness of the mark," 15 TTABVue 24, because in their fanciful depiction in Opposer's mark, the letters are inherently distinctive. The evidence of fame of the CC Monogram Mark discussed above also "more than sufficiently establishes that [O]pposer's [CC Monogram Mark] has acquired a high degree of distinctiveness among consumers." *Makarczyk*, 110 USPQ2d at 2025. This factor supports a finding of dilution by blurring.

3. The Extent to Which Opposer is Engaging in Substantially Exclusive Use of the CC Monogram Mark

There is no requirement that the use of a famous mark be absolutely exclusive for its owner to prevail on a dilution by blurring claim. Evidence of the substantially

exclusive use of a famous mark is probative of a likelihood that the mark will be diluted by blurring through use of the same or a similar mark. *See, e.g., McDonald's*, 112 USPQ2d at 1289-90.

Opposer made of record evidence that it has aggressively and successfully enforced its rights in the CC Monogram Mark in the United States. As discussed above in our analysis of fame, Opposer has filed numerous lawsuits against misuses of the CC Monogram Mark, and has obtained preliminary and permanent injunctive relief against many of them. Looney Decl. ¶ 8; Ex. 80 (28 TTABVUE 4, 221-228, 241-320, 326-345, 359-377, 414-438). Opposer has filed numerous oppositions and cancellation proceedings “against marks that were confusingly similar to or dilutive of the CC Monogram Mark,” Looney Decl. ¶ 9; Ex. 78 (28 TTABVUE 4-5, 205-211), and Ms. Looney testified that in “nearly all of the proceedings, [Opposer] prevailed and registration was refused or canceled, or the defendant agreed to amend its application to distinguish it from [Opposer’s] CC Monogram Mark.” Looney Decl. ¶ 11 (28 TTABVUE 5). Ms. Looney testified that “during the period from 2002 to the present, at least 28 applications for marks that were confusingly similar to or dilutive of the CC Monogram Mark were abandoned after [Opposer] filed” requests to extend its time to oppose. Looney Decl. ¶ 11; Ex. 79 (28 TTABVUE 5, 214-217). Finally, Ms. Looney testified that since 1977, Opposer has sent more than 10,000 cease-and-desist letters regarding alleged misuses of the CC Monogram Mark. Looney Decl. ¶ 10 (28 TTABVUE 5). Her uncontroverted testimony regarding Opposer’s enforcement efforts

is credible. *See Makarczyk*, 110 USPQ2d at 2025-26 (discussing Opposer’s policing of its CHANEL word mark).

Ms. Looney testified that as a result of Opposer’s enforcement efforts, “the federal registry is essentially free of marks that copy [Opposer’s] CC Monogram Mark,” and that she was not “aware of any other national brand that uses two back-to-back, interlocking letter Cs in its logo.” Looney Decl. ¶ 13 (28 TTABVUE 6). Her claim is supported by the record, which is devoid of evidence of any unconsented third-party uses or registrations of monogram marks comprising interlocking “C” letters.³² We find that Opposer has made substantially exclusive use of the CC Monogram Mark in the United States. This factor supports a finding of dilution by blurring. *See Makarczyk*, 110 USPQ2d at 2025-26 (discussing Opposer’s policing of its CHANEL word mark and finding substantially exclusive use of the CHANEL word mark on the basis of Opposer’s enforcement efforts and the lack of evidence of unconsented third-party uses).

³² Opposer made of record one of Applicant’s interrogatory answers in which Applicant referred to “the use of the CC letters in an interlocking manner similar to the Chanel CC monogram registered under Serial No. 86680027 filed on July 1, 2015 in class 042 and 050.” 30 TTABVUE 8. Opposer states that Applicant was referring to “an existing federal registration for a CC design mark owned by J&J Brothers Holdings, LLC for duvet covers, household items, mattress pads, sheet sets, and towels.” 15 TTABVUE 25. The referenced registration is not in the record, but the existence of only one allegedly similar registration would not undercut Opposer’s showing of substantially exclusive use of the CC Monogram Mark. “Third-party registrations have little probative value by themselves because they tell us nothing about whether or not the marks are actually being used or the manner of any such use,” and “[w]ithout evidence as to how, or whether, the third-party marks have been used, we cannot assess whether any such use has been so widespread as to have had an impact on consumer perceptions.” *Nike*, 100 USPQ2d at 1028.

4. The Degree of Recognition of the CC Monogram Mark

Under this factor, we must “determine the level of fame acquired by the famous mark” by applying a “sliding scale to determine the extent of that protection (i.e., the more famous the mark, the more likely there will be an association between the famous mark and defendant’s mark).” *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1729-30 (TTAB 2007) (finding that this factor was neutral because while BIG GULP was “a famous mark for dilution purposes, there is insufficient evidence to demonstrate that BIG GULP has acquired an extraordinary degree of recognition relative to other famous marks.”).

Opposer argues that its evidence of fame “also establishes that the CC Monogram enjoys a high degree of recognition,” citing *Makarczyk, N.Y. Yankees*, and *Nike*, 15 TTABVUE 26, but “we do not view the record to contain sufficient evidence from which we could infer the degree of recognition of” the CC Monogram Mark. *N.Y. Yankees*, 114 USPQ2d at 1507. On the threshold issue of the fame of the CHANEL word mark in *Makarczyk*, the Board found “particularly persuasive” Opposer’s internal consumer recognition surveys showing that the CHANEL word mark is “extremely well known and enjoys an unusually high degree of unaided and aided recognition.” 110 USPQ2d at 2022. The Board relied in part upon these surveys to support its finding on the degree of recognition factor. *Id.* at 2026. The Board similarly relied upon third-party unaided awareness surveys in finding a high degree of recognition of the JUST DO IT mark in *Nike*. 100 USPQ2d at 1028. Finally, the Board noted the absence of any direct evidence “regarding the degree of consumer recognition of Opposer’s top hat design mark” in finding this factor to be neutral in

N.Y. Yankees. 114 USPQ2d at 1507. In the absence of survey or other recognition evidence here, we cannot find that the CC Monogram Mark “has acquired an extraordinary degree of recognition relative to other famous marks,” *7-Eleven*, 83 USPQ2d at 1730, and we find that this factor is neutral.

5. Applicant’s Intent to Create an Association with the CC Monogram Mark

Applicant stipulated that it “was aware of Opposer’s CC Monogram prior to its adoption of the mark opposed,” 7 TTABVUE 3, and admitted familiarity with Opposer and the CC Monogram Mark through friends, relatives, clients, and publications. 30 TTABVUE 7 (Response to Interrogatory No. 4). It is self-evident, as Opposer concedes, that Applicant’s “mark was chosen to reflect the initials of Applicant’s business,” Looney Decl. ¶ 18 (28 TTABVUE 10), but the record is devoid of any explanation of why Applicant depicted those initials in a manner that we have found to be highly similar in appearance to the CC Monogram Mark.³³ In the absence of direct evidence of copying, on this record we cannot infer an intent to associate Applicant’s mark with the CC Monogram Mark, and we find that this factor is neutral.

³³ In Applicant’s response to one of Opposer’s interrogatories, Applicant stated that the “use of a reversed capital letter C in an interlocking position with the regular letter C is one of the next natural alternate way of two letter C’s in a logo or trade/service mark other than that of showing them in the regular typesetting position.” 30 TTABVUE 5-6 (Response to Interrogatory No. 2). Applicant’s claim that this depiction of the letters in its mark is a “natural alternate way” of combining two Cs is belied by the record, which shows no such depiction of the letters by anyone else other than Opposer.

6. Actual Association

Opposer argues that the visual similarity of the marks “was enough to cause one of Applicant’s former colleagues to remark that the Camacho mark is similar to the CC Monogram,” 15 TTABVUE 21, and that this “supports a finding of actual association between the parties’ marks.” 15 TTABVUE 21 n.6 (citing *Gucci Am. Inc. v. Guess? Inc.*, 858 F. Supp. 2d 207 (S.D.N.Y. 2012) (unattributed comments on website comparing subject marks, while weak evidence of actual association, caused this factor to favor the plaintiff slightly)). It is not clear from the cited discovery response whether the unidentified individual who commented on the similarity of the marks lives in the United States, 30 TTABVUE 8, and we do not find the response probative of an actual association between the marks. We find this factor to be neutral.

7. Summary

“Dilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party’s mark on its [services], are immediately reminded of the famous mark and associate the junior party’s mark with the owner of the famous mark, even if they do not believe that the [services] emanate from the famous mark’s owner.” *N.Y. Yankees*, 114 USPQ2d at 509. On balance, the evidence weighs in favor of a finding of a likelihood of dilution. Opposer’s mark is famous and highly distinctive, the marks are highly similar, and the record shows that Opposer has enjoyed substantially exclusive use of, and extensive media and other exposure of, its CC Monogram Mark in the United States for decades. The other factors are neutral. A substantial percentage of consumers of Applicant’s services who are exposed to

Applicant's mark are likely to be immediately reminded of Opposer's famous mark and to associate Applicant's mark with Opposer. We find, on the basis of the record as a whole, that Opposer has shown that Applicant's mark is likely to cause Opposer to suffer an impairment of the distinctiveness of its famous CC Monogram Mark, and that dilution by blurring is thus likely. *See Nike*, 100 USPQ2d at 1031 (balancing factors similarly in concluding that dilution by blurring was likely).

Decision: The opposition is sustained.