

This Opinion Is Not a
Precedent of the TTAB

Hearing: July 24, 2019

Mailed: July 25, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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P.C. Richard & Son Long Island Corporation
v.
Jon Bargains Inc.
—

Opposition No. 91223383
—

Celeste M. Butera of Hoffmann & Baron, LLP
for P.C. Richard & Son Long Island Corporation.

Anthony F. Lo Cicero, Tuvia Rotberg, and Jessica Capasso of Amster Rothstein &
Ebenstein LLP for Jon Bargains Inc.
—

Before Bergsman, Ritchie and Shaw, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Jon Bargains Inc. (Applicant) seeks registration on the Principal Register of the mark WIZGEAR (in standard character form) for “electronic accessories, namely, cell phone cases, computer tablet cases, protective cases for smartphones and computer

tablets, smartphone mounts, computer tablet mounts; small electronics, namely, headphones and earphones,” in Class 9.¹

P.C. Richard & Son Long Island Corporation (Opposer) filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark WIZGEAR for the identified goods so resembles Opposer’s registered marks for THE WIZ and NOBODY BEATS THE WIZ for retail store services in the field of consumer electronics and accessories as to be likely to cause confusion. Opposer pleaded ownership of the registrations listed below:

1. Registration No. 1204051 for the mark THE WIZ (in typed drawing format) for “retail stores services for audio and visual equipment,” in Class 42;²

2. Registration No. 1893461 for the mark THE WIZ (in typed drawing format) for “retail store services in fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances,” in Class 42;³

3. Registration No. 1395362 for the mark NOBODY BEATS THE WIZ (in typed drawing format) for “retail store services for audio and visual equipment and accessories, electrical appliances, and records and tapes,” in Class 42;⁴ and

¹ Application Serial No. 86428877, filed October 20, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and in commerce as of September 2014.

² Registered August 3, 1982; second renewal.

³ Registered May 9, 1995; second renewal.

⁴ Registered May 27, 1986; second renewal.

4. Registration No. 1905190 for the mark NOBODY BEATS THE WIZ (in typed drawing format) for “retail store services in the fields of audio and video equipment and accessories, computers and computer equipment and accessories, office equipment and accessories, computer software, photographic equipment, and household appliances,” in Class 42.⁵

Opposer also alleged common law rights in the marks THE WIZ and NOBODY BEATS THE WIZ for “retail services in connection with [Opposer’s] consumer electronics and appliances business”⁶ which “have been continually and extensively used in commerce by Opposer prior to the application date of Applicant and prior to any date of first use by Applicant of its applied for mark WIZGEAR.”⁷

Finally, Opposer alleged claims under Section 2(a) of Trademark Act, 15 U.S.C. § 1052(a), a false suggestion of a connection, and Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), dilution. However, because Opposer did not pursue these claims at trial, we deem them to be waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.⁸ Applicant, in its Second Amended Answer and Counterclaim, which is

⁵ Registered July 11, 1995; second renewal.

⁶ Notice of Opposition ¶3 (1 TTABVUE 5).

⁷ Notice of Opposition ¶5 (1 TTABVUE 5); *see also* Notice of Opposition ¶¶9 and 10 (1 TTABVUE 6).

⁸ 9 TTABVUE.

the operative pleading, counterclaimed to cancel Opposer's pleaded registrations on the ground of abandonment.⁹ Also, Applicant counterclaimed to cancel Registration No. 1395362 for the mark NOBODY BEATS THE WIZ for "retail store services for audio and visual equipment and accessories, electrical appliances, and records and tapes," on the ground of fraud. Applicant alleges that when Opposer filed the Sections 8 and 9 Combined Declaration of Use and Renewal Application, it knowingly made a false statement that it was rendering retail store services in the field of records and tapes with the intent to deceive the USPTO.¹⁰

Opposer, in its reply, denied the allegations in the counterclaim.¹¹

Applicant filed a motion to amend its application, without the consent of Opposer, to delete "small electronics, namely, headphones and earphones" from the description of goods.¹² Opposer opposed the motion to amend the description of goods.¹³ In our March 19, 2018 order, the Board deferred consideration of the motion until final decision.¹⁴ If we find that Applicant is not entitled to registration in the absence of the deletion of "small electronics, namely, headphones and earphones" from the description of goods, the proposed amendment will be approved and entered.

⁹ 28 TTABVUE 9-11.

¹⁰ 28 TTABVUE 12-13.

¹¹ 31 TTABVUE.

¹² 36 TTABVUE.

¹³ 37 TTABVUE.

¹⁴ 39 TTABVUE.

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 514.03 (2019).

I. The record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file and the registration files of Opposer's pleaded registrations which Applicant counterclaimed to cancel.¹⁵ The parties introduced the testimony and evidence listed below.

A. Opposer's testimony and evidence

1. Testimony declaration of Thomas Pohmer, Opposer's Vice President and Chief Financial Officer;¹⁶
2. Discovery deposition of Thomas Pohmer, attached to his testimony declaration as Exhibit 1;¹⁷
3. Testimony declaration of John Pflug, Opposer's Director of Marketing;¹⁸

¹⁵ Therefore, it was unnecessary for Opposer to introduce its registration files into the record (53 and 58 TTABVUE), and it was unnecessary for Opposer to introduce a copy of the application file at issue (62 TTABVUE 159-203).

Likewise, it was unnecessary for Applicant to introduce portions of Opposer's pleaded registration files. 67 TTABVUE 9-389.

¹⁶ 48 TTABVUE (public version). The version of the Pohmer testimony declaration with confidential information is posted at 45 TTABVUE.

The publicly available exhibits to the Pohmer testimony declaration are posted at 49, 51 and 52 TTABVUE. The versions of the exhibits to the Pohmer testimony declaration with confidential information are posted at 46 TTABVUE.

¹⁷ 50 TTABVUE (public version). The version of the Pohmer discovery deposition designated confidential is posted at 47 TTABVUE.

¹⁸ 55 TTABVUE 3-11 (public version). The version of the Pflug declaration with confidential information is posted at 54 TTABVUE.

4. Discovery deposition of John Pflug, attached to his testimony declaration as Exhibit 1;¹⁹
5. Notice of reliance on copies of Opposer's pleaded registrations printed from the USPTO electronic databases showing the current status of and title to the registrations;²⁰
6. Notice of reliance on the discovery deposition of Yona Lebovitz, Applicant's President and owner;²¹
7. Notice of reliance on copies of Opposer's website at pcrichard.com;²²
8. Notice of reliance on copies of thewiz.com website derived from the WaybackMachine website at web.archive.org;²³
9. Notice of reliance on Applicant's responses to Opposer's first set of interrogatories;²⁴
10. Notice of reliance on Applicant's supplemental responses to Opposer's first set of interrogatories;²⁵
11. Notice of reliance on Applicant's second supplemental responses to Opposer's first set of interrogatories;²⁶

¹⁹ 55 TTABVUE 14-136. The version of the Pflug deposition with confidential information is posted at 61 TTABVUE.

²⁰ 53 TTABVUE 12-26, 182-196, 306-323 and 58 TTABVUE 3-20 and 145-157.

²¹ 57 TTABVUE (public version). The version of the Lebovitz deposition designated confidential is posted at 56 TTABVUE.

The exhibits to the Lebovitz deposition are posted at 62 TTABVUE 205-413 and 63 TTABVUE 3-64.

²² 59 TTABVUE, 60 TTABVUE 3-71 and 62 TTABVUE 3-157.

²³ 60 TTABVUE 73-110

²⁴ 63 TTABVUE 66-78.

²⁵ 65 TTABVUE 3-17. Confidential information in Applicant's supplemental responses is posted at 64 TTABVUE 3-17.

²⁶ 65 TTABVUE 19-34. Confidential information in Applicant's second supplemental responses is posted at 64 TTABVUE 19-35.

12. Notice of reliance on Applicant's response to Opposer's first request for production of documents;²⁷
13. Notice of reliance on Applicant's website at wizgear.com;²⁸ and
14. Rebuttal notice of reliance on documents printed from the USPTO TTABVUE database purportedly relating to five oppositions filed by Opposer against various "Wiz" marks.²⁹

B. Applicant's testimony and evidence.³⁰

²⁷ 63 TTABVUE 80-90. Documents obtained in response to a request for production of documents may not be made of record through a notice of reliance alone, except to the extent that they are admissible by notice of reliance under Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). See Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii). However, if no documents exist which are responsive to a document request, a party's response that no documents exist may be made of record. See *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance).

²⁸ 63 TTABVUE 92-133.

²⁹ 74 TTABVUE 7-91.

³⁰ Applicant sought to introduce through a notice of reliance what appears to be webpages featuring the mark NOBODY BEATS THE WIZ posted at 66 TTABVUE 11-19 and 31-33. We give these purported webpages no consideration because they do not display a URL and the date that they were accessed. Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2) ("Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided."); see also *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d at 1759 (objection to Internet printouts from petitioner's website showing the dates accessed and printed and URL information on the grounds that petitioner failed to authenticate the documents by testimony overruled), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (web pages inadmissible for lack of URL and date accessed).

Also, Applicant sought to introduce through a notice of reliance what appears to be a transcription of an audio file. 67 TTABVUE 4. A transcription of an audio file is not the type of evidence that may be introduced into the record through a notice of reliance and, therefore, we give it no consideration.

Finally, Applicant sought to introduce documents identified as Applicant's Exhibits A-I, L, AA, and Z, all designated confidential through a notice of reliance. 69 TTABVUE. The documents include the bill of sale from the bankruptcy sale where Opposer acquired the

1. Notice of reliance on Opposer's responses to Applicant's first set of interrogatories;³¹
2. Notice of reliance on a webpage from thewiz.com displaying the mark NOBODY BEATS THE WIZ derived from the WaybackMachine;³²
3. Notice of reliance on Opposer's website at pcrichard.com;³³
4. Notice of reliance on third-party registrations consisting of variations of "Wiz";³⁴
5. Notice of reliance on copies of third-party websites displaying marks consisting of variations of "Wiz";³⁵
6. Notice of reliance on a dictionary definition (merriam-webster.com) for the term "Wiz";³⁶
7. Notice of reliance on Opposer's responses to Applicant's first set of interrogatories;³⁷ and
8. Testimony declaration of Yona Lebovitz, Applicant's President and owner.³⁸

marks in the pleaded registrations, documentation for the number of viewers visiting THEWIZ.com, Opposer's vendor history payment, etc. These exhibits are not the types of documents that may be introduced into the record through a notice of reliance and, therefore, we give them no consideration.

³¹ 66 TTABVUE 21-27. Applicant introduced Opposer's responses a second time at 68 TTABVUE 53-59.

³² 66 TTABVUE 29.

³³ 66 TTABVUE 35-74.

³⁴ 67 TTABVUE 391-569.

³⁵ 68 TTABVUE 3-44.

³⁶ 68 TTABVUE 46-50.

³⁷ 68 TTABVUE 53-59.

³⁸ 70 TTABVUE. The exhibits designated confidential attached to the Lebovitz declaration are posted at 71 TTABVUE.

II. Applicant's counterclaim to cancel Opposer's pleaded registrations on the ground of abandonment.

A. Standing

Applicant, by virtue of its position of defendant in the opposition, has standing to seek cancellation of the pleaded registrations. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999).

B. Findings of fact.

As noted above, Opposer pleaded ownership of registrations for the marks THE WIZ and NOBODY BEATS THE WIZ, as well as common law use of those marks, for retail store services in the field of consumer electronics and accessories. First, we determine the meaning of the term "retail store services."

"Retail" is defined as a "the sale of goods to the ultimate customers, usually in small quantities (opposed to wholesale)."³⁹ "Store" is defined as "an establishment where merchandise is sold, usually on a retail basis."⁴⁰ A "retail store" is defined as "a place of business usually owned and operated by a retailer but sometimes owned and operated by a manufacturer or by someone other than a retailer in which merchandise is sold primarily to ultimate consumers."⁴¹

³⁹ Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed July 24, 2019). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

⁴⁰ Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed July 24, 2019).

⁴¹ Merriam-Webster.com accessed July 24, 2019.

The TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1402.11(a)(vi) (2018) provides that

Retail store, catalog, and ordering services are classified in Class 35 no matter how the services are conducted. Any of the following identifications is acceptable:

“Computerized on-line retail store services in the field of {indicate field of goods}, in Class 35.”

“Web-based catalog services featuring {specify goods}, in Class 35.”

“Computerized on-line ordering services in the field of {indicate field of goods}, in Class 35.”

See also TMPEP § 904.03(i) (instructing that “the website on which [a] web page appears is, in effect, an electronic retail store.”).

A few cases have referred to retail stores services as including online sales. *See In re Meridian Rack & Pinion*, 114 USPQ2d 1462 (TTAB 2015) (holding BUYAUTOPARTS.COM generic for on-line retail store services featuring auto parts); *In re Lens.com, Inc.*, 83 USPQ2d 1444 (TTAB 2007) (LENS generic for “retail store services featuring contact eyewear products rendered via a global computer network”); *In re Eddie Z’s Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, conducted via the Internet).

Finally, Applicant, in its brief, acknowledges that “retail store services” include more than retail services rendered through brick and mortar facilities. *See* Applicant’s Brief, p. 28 (“[A]t the time of the 2016 Renewal, Opposer was not using the NOBODY BEATS THE WIZ mark for retail store services since its websites were

under construction and not accessible to consumers.”) and Applicant’s Brief, p. 4 (“Opposer never operated brick and mortar stores” but “Opposer operated an online store.”).⁴²

We find that the term “retail store services” is not limited to sales through brick and mortar stores; rather it includes any business that brings together merchandise in a single location for sale to the ultimate consumer. Accordingly, the term “retail stores services” in a description of services encompasses sales through brick and mortar facilities, as well as through online sales (e.g., an online retail store). *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Opposer acquired the trademarks and the registrations for the trademarks THE WIZ and NOBODY BEATS THE WIZ through a bankruptcy sale in September 2003.⁴³ When Opposer purchased THE WIZ and NOBODY BEATS THE WIZ trademarks, there were no THE WIZ or NOBODY BEATS THE WIZ retail stores operating⁴⁴ and Opposer never opened or operated any THE WIZ or NOBODY BEATS THE WIZ brick and mortar retail stores.⁴⁵

⁴² 82 TTABVUE 11 and 35.

⁴³ Pohmer Testimony Decl. ¶15 (48 TTABVUE 6); Pflug Discovery Dep., p. 10 (55 TTABVUE 23).

⁴⁴ Pohmer Discovery Dep., p. 16 (50 TTABVUE 18); Pflug Discovery Dep., p. 16 (55 TTABVUE 29).

⁴⁵ Pohmer Discovery Dep., pp. 16-17 (50 TTABVUE 18-19); Pflug Discovery Dep., p. 25 (55 TTABVUE 38).

By November 2004, Opposer was operating www.thewiz.com and www.nobodybeatstheviz.com websites wherein consumers could purchase a wide array of consumer electronics, and consumer electronics accessories and services.⁴⁶ From November 2004 through “October/November 2015,” www.thewiz.com and www.nobodybeatstheviz.com were fully operational.⁴⁷ However, from July 2013 through November 2015, consumers could only place telephone orders.⁴⁸ “[T]he cart button forwarded the user to a customer services telephone number in order to place their order.”⁴⁹ Pohmer Exhibits 6-18 corroborate the testimony.⁵⁰

From “October/November 2015” through February 2017, access to the websites at www.thewiz.com and www.nobodybeatstheviz.com was suspended and a user would reach an “under construction” notice at those websites.⁵¹ Opposer was deciding whether and how to integrate THE WIZ and NOBODY BEATS THE WIZ websites

⁴⁶ Pohmer Testimony ¶24 (48 TTABVUE 7); Pflug Testimony Decl. ¶7 (55 TTABVUE 4).

⁴⁷ Pohmer Testimony Decl. ¶42 (48 TTABVUE 10-11); Pflug Discovery Dep., pp. 21-22 and 24 (55 TTABVUE 34-35 and 37); Pflug Testimony Decl. ¶11 (55 TTABVUE 5).

⁴⁸ Pohmer Testimony Decl. ¶42 (48 TTABVUE 11); Pflug Discovery Dep., pp. 40-41 (55 TTABVUE 53-54); Pflug Testimony Decl. ¶11 (55 TTABVUE 5).

⁴⁹ Pohmer Testimony Decl. ¶43 (48 TTABVUE 11); Pflug Discovery Dep., pp. 41-42 and 44-45 (55 TTABVUE 54-55 and 57-58).

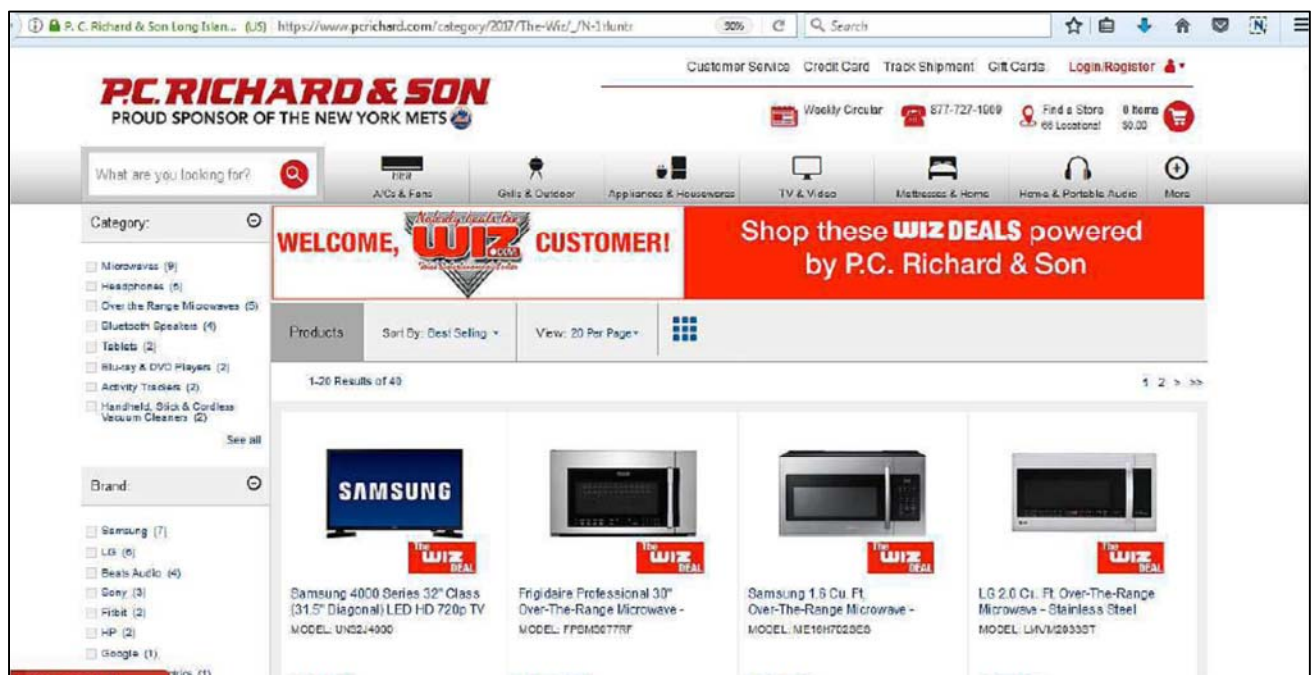
“This was due to new security measures implemented by the e-commerce industry for online order placement and the information transmitted via online orders, and the time needed to assess and determine implementation of these necessary measures and enhancements to our Wiz websites.” Pohmer Testimony Decl. ¶43 (48 TTABVUE 11); *see also* Pflug Discovery Dep., p. 42 (55 TTABVUE 55); Pflug Testimony Decl. ¶12 (55 TTABVUE 6).

⁵⁰ Pohmer Testimony Decl. ¶¶24, 27-40 (48 TTABVUE 7-10 and 51 TTABVUE 159-289 and 52 TTABVUE 3-37).

⁵¹ Pohmer Testimony Decl. ¶44 (48 TTABVUE 11); Pohmer Discovery Dep., pp. 33-34 (50 TTABVUE 35-36); Pflug Discovery Dep., p. 82 (55 TTABVUE 95); Pflug Testimony Decl. ¶16 (55 TTABVUE 6).

into Opposer's overall marketing.⁵² However, during this time, Opposer did not conduct any market research or studies concerning THE WIZ and NOBODY BEATS THE WIZ trademarks.⁵³

Prior to February 2017, Opposer decided to integrate the THE WIZ and NOBODY BEATS THE WIZ URLs into Opposer's overall marketing by having those URLs direct consumers to Opposer's PCRICHARD.com website.⁵⁴ Opposer's homepage featuring THE WIZ and NOBODY BEATS THE WIZ trademarks is reproduced below.⁵⁵



⁵² Pohmer Testimony Decl. ¶¶44 (48 TTABVUE 11); Pohmer Discovery Dep., pp. 32 and 47 (50 TTABVUE 34 and 49); Pflug Discovery Dep., pp. 23 and 81 (55 TTABVUE 36 and 94); Pflug Testimony Decl. ¶¶15-17 (55 TTABVUE 6-7).

⁵³ Pohmer Discovery Dep., p. 51 (50 TTABVUE 53).

⁵⁴ Pohmer Testimony Decl. ¶¶45 and 47 (48 TTABVUE 11-12); Pflug Discovery Dep., pp. 20 and 59-60 (55 TTABVUE 33 and 72-73); Pflug Testimony Decl. ¶19 (55 TTABVUE 7).

⁵⁵ Pohmer Testimony Decl. ¶47 and Exhibit 20 (48 TTABVUE 12 and 52 TTABVUE 59).



Further, when a consumer uses the GOOGLE search engine, or any other search engine, to search terms THE WIZ, WIZ, or NOBODY BEATS THE WIZ, they are directed to Opposer’s homepage featuring those marks as shown above.⁵⁶ According to the Pohmer testimony,

[Opposer’s] marketing, buying and sales departments select those products that appear as THE WIZ deals on our website pages and randomly select the retail products and services we are promoting that month based on a myriad of considerations, including pricing, inventory and profit points. Any of our products could be branded as THE WIZ deals at any time, and those products selected change periodically, including but not limited to cell phone car mounts, headphones, tablet covers and cases, and cell phone covers and cases.⁵⁷

⁵⁶ Pohmer Testimony Decl. ¶¶49 and 53 and Exhibits 22 and 24 (48 TTABVUE 12 and 52 TTABVUE 167-190 and 229-262); Pflug Testimony Decl. ¶¶21-25 (55 TTABVUE 8-9).

⁵⁷ Pohmer Testimony Decl. ¶54 (48 TTABVUE 14); *see also* Pflug Discovery Dep., p. 65 (55 TTABVUE 78) (the product selection was one in collaboration with the buying team).

In other words, Opposer “wanted the page to welcome The Wiz customer and present an array of product within our catalog.”⁵⁸

C. Statement of the law for abandonment.

The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. *See* Section 14 of the Trademark Act, 15 U.S.C. § 1064(3). Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a mark is considered abandoned when “its use has been discontinued with intent not to resume such use.” The definition of abandonment is found in this provision, as follows:

A mark shall be deemed to be “abandoned” if either of the following occurs:

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

Because registrations are presumed valid under the law, the party seeking their cancellation bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence. *See On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). If

⁵⁸ Pflug Discovery Dep., p. 65 (55 TTABVUE 78).

the petitioner presents a prima facie case of abandonment, the burden of production (i.e., going forward), then shifts to the trademark holder to rebut the prima facie showing with evidence. *Cerveceria Centroamericana*, 13 USPQ2d at 1311.

Abandonment is a question of fact. *See Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 667 (Fed. Cir. 1984). Thus, any inference of abandonment must be based on proven fact. Section 45 of the Trademark Act. *See also Cerveceria Centroamericana*, 13 USPQ2d at 1310 (“The protection due the registrant is provided by requiring that the inference have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and ‘there is no basis ... to infer nonuse,’ a prima facie case of abandonment must fail.”) (quoting *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 332-33, 196 USPQ 801, 804-05 (CCPA 1978)); *Stetson v. Howard D. Wolf & Assoc’s*, 955 F.2d 847, 21 USPQ2d 1783, 1785 (2d Cir. 1992) (A party claiming that a mark has been abandoned must show “non-use of the mark by the legal owner and no intent by that person or entity to resume use.”).

Proof of non-use for three consecutive years, however, constitutes prima facie evidence of abandonment, because it supports an inference of a lack of intent to resume use. Section 45 of the Trademark Act. *See also Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1533 (TTAB 2018); *On-line Careline Inc. v. Am. Online Inc.*, 56 USPQ2d at 1476 (“The party seeking cancellation establishes a prima facie case of abandonment by showing proof of nonuse for three consecutive years.”); *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531,

56 USPQ2d 1343 (4th Cir. 2000). As noted above, if the plaintiff establishes non-use for three consecutive years, the burden shifts to defendant to rebut the prima facie case by either disproving the three years of nonuse or showing an intent to resume use. *Cerveceria Centroamericana*, 13 USPQ2d at 1312.

D. Analysis

As noted above, Opposer was using the marks THE WIZ and NOBODY BEATS THE WIZ for online retail store services from November 2004 through October 2015. From October 2015 through February 2017 (17 months), Opposer suspended use of the marks while it was figuring out how to integrate THE WIZ and NOBODY BEATS THE WIZ in its overall marketing strategy. Opposer resumed using THE WIZ and NOBODY BEATS THE WIZ by redirecting online searches to Opposer's PCRICHARD.com website which displays THE WIZ and NOBODY BEATS THE WIZ as displayed above.

Applicant argues that Opposer abandoned use of the marks THE WIZ and NOBODY BEATS THE WIZ because Opposer never operated brick and mortar stores under the marks THE WIZ or NOBODY BEATS THE WIZ inasmuch as the use of those marks were limited to the operation of websites at www.thewiz and www.nobodybeatsthewiz.⁵⁹ As discussed above, the term "retail store services" is not limited to brick and mortar stores. "Retail store services" is broad enough to encompass online stores and the evidence shows that Opposer rendered online retail stores services using the marks THE WIZ and NOBODY BEATS THE WIZ.

⁵⁹ Applicant's Brief, pp. 23-24 (82 TTABVue 30-31).

Applicant points out that for tracking sales, Opposer designated www.thewiz.com as store No. 20 and that the last sale for store No. 20 occurred on June 28, 2013.⁶⁰ However, that is not evidence that Opposer abandoned use of the marks; rather, it is evidence that Opposer stopped tracking sales for store No. 20. Likewise, Opposer's failure to track phone sales generated from THE WIZ and NOBODY BEATS THE WIZ websites from June 2013 through October 2015 does not prove that Opposer stopped using the marks THE WIZ and NOBODY BEATS THE WIZ, especially when Thomas Pohmer and John Pflug testified as to how Opposer processed those sales through Opposer's customer service department and corroborated the use of those marks by presenting copies of representative webpages.⁶¹

Applicant contends that the evidence shows that in June 2013, Opposer decided that it would no longer invest in the www.thewiz.com and www.nobodybeatstheviz.com websites and, thus, abandoned the use of THE WIZ and NOBODY BEATS THE WIZ for at least three years with no intent to resume use.⁶² Applicant failed to identify the evidence that shows Opposer decided not to invest in its THEWIZ.com and NOBODYBEATSTHEWIZ.com websites, presumably because there is no such evidence. Rather, Applicant asks us to infer that Opposer's failure to immediately update THEWIZ.com and NOBODYBEATSTHEWIZ.com online

⁶⁰ Applicant's Brief, p. 24 (82 TTABVUE 31).

⁶¹ Applicant's reliance on *Ziebarth v. Del Taco, LLC*, Cancellation No. 92053501, 2015 TTAB LEXIS 324, *40-41 (TTAB March 31, 2015) is misplaced. In *Ziebarth*, the Board rejected defendant's counsel's statements about defendant's advertising because the statements were not supported by evidence in the record. Here, we have the uncontroverted testimony about Opposer's use by Messrs. Pohmer and Pflug corroborated by copies of webpages.

⁶² Applicant's Brief, p. 32 (82 TTABVUE 32).

platforms in 2013 is evidence that Opposer intended to abandon THE WIZ and NOBODY BEATS THE WIZ trademarks. However, we cannot infer that Opposer intended to abandon its marks based on speculation and in the face of the testimony and evidence that Opposer was using the marks. Moreover, both Messrs. Pohmer and Pflug testified that the suspension of the THEWIZ.com and NOBODYBEATSTHEWIZ.com websites was due to Opposer's deliberations as to whether and how to incorporate those marks into Opposer's overall marketing. That is not evidence of no intent to resume use.

Finally, Applicant asserts that the landing page that Opposer uses to redirect THEWIZ.com and NOBODYBEATSTHEWIZ.com URLs does not show use of the marks THE WIZ or NOBODY BEATS THE WIZ.⁶³ We reproduce below excerpts from Opposer's PCRICHARD.com website displaying the marks.⁶⁴



⁶³ Applicant's Brief, pp. 25-27 (82 TTABVUE 32-34).

⁶⁴ 52 TTABVUE 59-62.



The first and second images show use of the mark NOBODY BEATS THE WIZ. The addition of the gTLD “.com” in the first image does not constitute a material alteration of NOBODY BEATS THE WIZ and does not change the mark. *See* TMEP § 1215.08(a) (“Generally, an applicant may add or delete a non-source-identifying gTLD to/from the drawing of a domain name mark (e.g., COOPER amended to COOPER.COM, or COOPER.COM amended to COOPER) without materially altering the mark.”). In the second image, NOBODY BEATS THE WIZ engenders a commercial impression separate and distinct from the word “Direct” because of the way the terms are structured and because “Direct” describe the quick or immediate delivery offered by Opposer (e.g., a variation of NOBODY BEATS THE WIZ).⁶⁵

Likewise, THE WIZ as used in THE WIZ DEAL forms a separate and distinct commercial impression because the word “Deal” is defined, *inter alia*, as “a business transaction” and THE WIZ DEAL means and engenders the commercial impression of a THE WIZ bargain.⁶⁶ Moreover, the term “Wiz” engenders a separate commercial impression in the above-noted displays because of the way it is featured as the dominant part of the mark. In this regard, the definite article “the” has little, if any, trademark significance and, thus, WIZ and THE WIZ are essentially the same. *See*

⁶⁵ The word “Direct” is defined, *inter alia*, as “proceeding in a straight line or by the shortest course; undeviating; not oblique: *a direct route*.” Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed July 24, 2019.

⁶⁶ Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019).

In re Narwood Prods., Inc., 223 USPQ 1034 (TTAB 1984) (noting “the insignificance of the word ‘the’” in comparison of THE MUSIC MAKERS and MUSICMAKERS); *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 USPQ 269 (TTAB 1980) (“Since the psychological and marketing impact of petitioner’s mark in its earlier version clearly was derived from the word ‘IMAGE,’ the omission of the word ‘THE’ (the definite article serving merely to emphasize ‘IMAGE’) from the later version did not interrupt the continuity of use”); and *U.S. Nat’l Bank of Oregon v. Midwest Savings and Loan Ass’n*, 194 USPQ 232, 236 (TTAB 1977) (“The definite article ‘THE’ likewise adds little distinguishing matter because the definite article most generally serves as a means to refer to a particular business entity or activity or division thereof, and it would be a natural tendency of customers in referring to opposer’s services under the mark in question to utilize the article ‘THE’ in front of ‘U-BANK’ in view of their uncertain memory or recollection of the many marks that they encounter in their everyday excursion into the marketplace”).

Applicant failed to show that Opposer stopped using the marks THE WIZ or NOBODY BEATS THE WIZ for three consecutive years or that Opposer stopped using those marks with no intent to resume use. Accordingly, the counterclaim to cancel Opposer’s pleaded registrations on the ground of abandonment is denied.

III. The counterclaim to cancel Registration No. 1395362 for the mark NOBODY BEATS THE WIZ for “retail store services for audio and visual equipment and accessories, electrical appliances, and records and tapes” on the ground of fraud.

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration, or a registrant in a post registration setting, knowingly

makes a false, material representation of fact in connection with an application to register, or a post registration document, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *In re Bose Corp.*, 580 F.3d 1240, 1245, 91 USPQ2d 1938, 1939-40 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518 (TTAB 2016). A party alleging fraud in the procurement or maintenance of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *In re Bose*, 91 USPQ2d at 1243 (*quoting Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). For example, the Board will not find fraud if the evidence shows that a false statement was made with a reasonable and honest belief that it was true, rather than an intent to mislead the USPTO into issuing a registration to which the applicant was not otherwise entitled. *See id.*; *see also Woodstock's Enters. Inc. (Cal.) v. Woodstock's Enters. Inc. (Or.)*, 43 USPQ2d 1440, 1443 (TTAB 1997), *aff'd*, 152 F.3d 942 (Fed. Cir. Mar. 5, 1998). Intent to deceive is an indispensable element of the analysis in a fraud case. *See In re Bose*, 91 USPQ2d at 1941.

Applicant, in its Second Amended Answer and Counterclaim, the operative pleading, alleged that Opposer falsely stated that the mark in Registration No. 1395362 was in use in commerce for retail store services for records and tapes with the intent to deceive the USPTO.⁶⁷ However, Applicant, in its brief, did not argue that Opposer falsely stated that the mark was not in use for retail store services for records

⁶⁷ 28 TTABVUE 12.

and tapes. Rather, Applicant argued instead that when Opposer filed its Combined Declaration of Use and Renewal Application, Opposer was not using the mark for any retail store service since its websites were under construction and not accessible to customers.⁶⁸ Fraud must be pleaded with specificity and the basis for Applicant's fraud claim as argued in its brief was not pleaded. *See* Fed. R. Civ. P. 9(b); *see also Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d at 1293 (the allegations of fraud must include an explicit expression of the factual circumstances constituting the fraud) (citing *King Auto Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 802-803 (CCPA 1981)). Further, there is no reason to believe that during trial Opposer was aware that Applicant had changed the basis for its fraud claim and, thus, the argued fraud claim was not tried by implied consent.

Even assuming Applicant properly pleaded the factual circumstances amounting to the fraud claim it argued in its brief, Applicant failed to introduce any evidence regarding Opposer's intent to deceive the USPTO. Accordingly, Applicant failed to prove an essential element of a fraud claim. *See In re Bose*, 91 USPQ2d at 1941.

Applicant's counterclaim to cancel Registration No. 1395362 on the ground of fraud is denied.

IV. Likelihood of confusion

A. 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);

⁶⁸ Applicant's Brief, pp. 28-29 (82 TTABVue 35-36).

John W. Carson Found. v. Toilets.com Inc., 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a “real interest” in the proceeding and a “reasonable” basis for its belief of damage. See *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposer has established its standing for its likelihood of confusion claim by properly introducing into evidence its pleaded registrations.⁶⁹ See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff’s two prior registrations suffice to establish plaintiff’s direct commercial interest and its standing); *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its Answer, did not contest Opposer’s standing.

B. Priority

Because Opposer’s pleaded registrations are of record, priority in the opposition proceeding is not at issue with respect to the services identified therein. *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)). Moreover, the evidence discussed in the abandonment section establishes that Opposer made common law use of its marks prior to the filing date of Applicant’s application or Applicant’s actual first use date. Applicant, in its Answer did not contest Opposer’s priority.

⁶⁹ 53 TTABVUE 12-26, 182-196, 306-323 and 58 TTABVUE 3-20 and 145-157.

C. Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973) (internal citations removed). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for

which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

1. The similarity or dissimilarity and nature of the goods and services.

Opposer’s pleaded registrations are registered for retail store services in the field of consumer electronics and accessories. Applicant is seeking to register its mark for “electronic accessories, namely, cell phone cases, computer tablet cases, protective cases for smartphones and computer tablets, smartphone mounts, computer tablet mounts; small electronics, namely, headphones and earphones.” The products that Opposer sells through its retail store services include cell phone cases, computer tablet cases, protective cases for smartphones and computer tablets, smartphone mounts, computer tablet mounts, headphones and earphones.⁷⁰ Logic dictates that retail store services are related to products commonly sold in that particular retail store. *See In re Detroit Athletic Club Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (sports apparel retail services are related to clothing); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (furniture is related to general merchandise store services); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (jewelry store services and jewelry are competitive and inherently related); *In re United Serv. Distribs., Inc.*, 229 USPQ 237, 238-239 (TTAB 1986) (distributorship services in the field of health and beauty aids are related to skin

⁷⁰ Pohmer Testimony Decl. ¶¶26, 51 and 54 (48 TTABVUE 7, 13 and 14); Pflug Testimony Decl. ¶¶20, 23, 30 (55 TTABVUE 7-9)

cream); *In re U.S. Shoe Corp.*, 229 USPQ 707, 708 (TTAB 1985) (retail women's clothing store services and clothing are related to uniforms); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 866 (TTAB 1985) (“[T]here is little question that jewelry store services and jewelry are highly related goods and services”); *In re Jewelmasters, Inc.*, 221 USPQ 90, 91 (TTAB 1983) (retail jewelry store services and jewelry are highly related); *see also Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1639-40 (TTAB 2006) (“It is settled that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other.”).

We find that Applicant's “electronic accessories, namely, cell phone cases, computer tablet cases, protective cases for smartphones and computer tablets, smartphone mounts, computer tablet mounts; small electronics, namely, headphones and earphones” are closely related to Opposer's retail stores services in the field of consumer electronics and accessories.

2. Established, likely-to-continue channels of trade and classes of consumers.

Where, as here, the identifications of goods and services describe goods and services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the services in Opposer's pleaded registrations and the products in Applicant's application encompass all goods and services of the type described, that they are offered in all channels of trade normal for these goods and services, and that they are available to all classes of purchasers

for the described goods and services. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139, 140 (CCPA 1958); *In re Integrated Embedded*, 120 USPQ2d 1504, 1515 (TTAB 2016); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Under these circumstances, Applicant's products are the types of products that would be sold in Opposer's retail stores to Opposer's customers.

We find that the channels of trade and classes of consumers are the same.

3. The nature and extent of any reported instances of actual confusion.

Neither Opposer nor Applicant is aware of any reported instances of actual confusion.⁷¹ However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d at 1660; *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual

⁷¹ Pohmer Discovery Dep., p. 64 (50 TTABVUE 66); Pflug Discovery Dep., p. 96 (55 TTABVUE 109); Opposer's response to Applicant's interrogatory No. 2 (66 TTABVUE 24); Lebovitz Testimony Decl. ¶16 (70 TTABVUE 3).

confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

The parties have been simultaneously using their marks since September 2014.⁷² Applicant sells its WIZGEAR products through its own website at WIZGEAR.com and through third-party websites such as AMAZON.com, eBAY.com, WALMART.com, BHPHOTOVIDEO.com and THEPAPERSTORE.com.⁷³ Applicant does not sell its WIZGEAR products through Opposer’s PCRICHARD.com website.⁷⁴ Applicant “advertises its WIZGEAR products through keyword and sponsored advertisements on Amazon and through social media such as Facebook, Twitter, and Instagram.”⁷⁵ Such keyword advertising use the term WIZGEAR, not WIZ alone.⁷⁶

Opposer renders its THE WIZ and NOBODY BEATS THE WIZ retail store services in the field of consumer electronics and accessories through an online store identified by the URLs THEWIZ.com and NOBODYBEATSTHEWIZ.com.⁷⁷ In addition to directly accessing THEWIZ.com and NOBODYBEATSTHEWIZ.com,

⁷² Lebovitz Testimony Decl. ¶4 (70 TTABVUE 2) (“Since September Of 2014, [Applicant] has used the WIZGEAR mark for cell phone and tablet accessories such as protective cases and car mounts.”).

⁷³ Lebovitz Testimony Decl. ¶8 (70 TTABVUE 3).

⁷⁴ Lebovitz Testimony Decl. ¶10 (70 TTABVUE 3).

⁷⁵ Lebovitz Testimony Decl. ¶13 (70 TTABVUE 3).

⁷⁶ Lebovitz Testimony Decl. ¶14 (70 TTABVUE 3).

⁷⁷ Pohmer Testimony Decl. ¶¶24, 26-43, and 47 (48 TTABVUE 7-12).

consumers can search for Opposer's online retail stores by entering "THE WIZ," "WIZ," or "NOBODY BEATS THE WIZ" keywords in a search engine.⁷⁸

Inasmuch as both parties are heavily invested in online selling and using keywords including the term "Wiz," we find that there has been an opportunity for actual confusion to have occurred (approximately four years) and that under the particular circumstances described above, we find that this *DuPont* factor weighs against finding that there is a likelihood of confusion.

4. The conditions under which sales are made.

Applicant argues, without any supporting testimony or evidence, that both Opposer's customers and its customer exercise a high degree of purchasing care.⁷⁹ However, because Opposer is rendering retail store services in the field of consumer electronics and accessories without any restrictions as to channels of trade, classes of consumers, price points or quality, and Applicant's description of goods do not include any restrictions as to channels of trade, classes of consumers, price points or quality, we must presume that purchasers for the parties' goods and services include ordinary consumers who may not exercise a high degree of purchasing care. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class"); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that all purchasers of wine may not be

⁷⁸ Pohmer Testimony Decl. ¶49, 52, 53 (48 TTABVUE 12-13).

⁷⁹ Applicant's Brief, p. 22 (82 TTABVUE 29).

discriminating because while some may have preferred brands, “there are just as likely to be purchasers who delight in trying new taste treats.”). Accordingly, this *DuPont* factor weighs in favor of finding that there is a likelihood of confusion.

5. The strength of Opposer’s marks THE WIZ and NOBODY BEATS THE WIZ, including the number and nature of similar marks in connection with similar services.

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 (secondary meaning.”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. 2019) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness. For purposes of analysis of likelihood of confusion, a mark’s renown may “var[y] along a spectrum from very strong to very weak.” *Joseph*

Phelps Vineyards, LLC v. Fairmont Holdings, LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted).

THE WIZ and NOBODY BEATS THE WIZ when used in connection with retail store services appear to be arbitrary terms because they do not describe, nor suggest, any quality, characteristic or function of the services. *See Alberto-Culver Co. v. Helene Curtis Indus., Inc.*, 167 USPQ 365, 370 (TTAB 1970).

The fact that a word or term may be found in a dictionary does not indicate that the word is lacking in trademark significance unless the dictionary meaning of the word is descriptive of the goods in connection with which it is used. That is, the capability of a dictionary word to function as a trademark must be determined by the simple expedient of exploring what meaning, if any, does it possess as applied to a particular product. In this regard, it must be recognized that while a word may have a meaning or descriptive significance as applied to one product, it may not have such a significance as applied to a different product. Insofar as “COMMAND” is concerned, although it may in a round about manner possess some suggestive characteristics of hair care products, it is, in essence, an arbitrary mark as applied to such goods.

Id.

To rebut Opposer’s evidence that THE WIZ and NOBODY BEATS THE WIZ are inherently strong marks, Applicant introduced a dictionary definition of the term “Wiz” which is an abbreviation of “Wizard.”⁸⁰ The word “Wizard” is defined, inter alia, as “a person or amazing skill or accomplishment” and, in the field of computers, as “a

⁸⁰ Merriam-Webster.com (68 TTABVUE 46-47).

software feature that guides users through complex procedures with step-by-step instructions, often presented in dialog boxes.”⁸¹

Applicant also introduced copies of third-party registrations incorporating the term “Wiz” for goods or services related to retail store services in the field of consumer electronics and accessories.⁸² The “evidentiary value of third party [sic] registrations per se is to show the sense in which ... a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2015)). In other words, third-party registrations may be used in the manner of a dictionary to show that mark or a portion of a mark is descriptive or suggestive of goods or services. *See Institut National Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations show the sense in which a word is used in ordinary parlance and that a particular term has descriptive significance as applied to certain goods or services); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (“[W]e find no error in the citation of nine third-party registrations ‘primarily to show the meaning of * * * [zing]’ in the same way that dictionaries are used.”); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a

⁸¹ Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed July 24, 2019.

⁸² 67 TTTABVUE 391-569.

term is perceived in the trade or industry”).⁸³ Applicant introduced the third-party registrations, with relevant portions of the description of goods or services, listed below:⁸⁴

MARK	REG. NO.	GOODS/SERVICES
TOUCHWIZ	3673234	Mobile telephones; smartphones; battery chargers for mobile telephones
WIZTOPIC°	5070634	Smartphones
WIZ KHALIFA	4818131	Cases for portable phones
WIZPAK	5065211	Bags specifically adapted to carry audio and related electronic equipment
FLOWIZ	5089227	Smart phones; mobile phones; leather cases for mobile phones and smart phones
WIZWARE	5378517	Cellphone covers; mobile phones; accessories for consumer electronic products

Finally, Applicant introduced excerpts from third-party websites using the term “Wiz” as part of the trademark displayed on the third-party website.⁸⁵ These documents are probative for what they show on their face, not the truth of what has been printed. *See WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 and 1040-41 (TTAB 2018) (printouts from websites downloaded from the Internet are admissible under notice of reliance for what they show on their face, but absent testimony from a competent witness, the matters asserted therein are hearsay and thus not probative of the truth of what has been

⁸³ Accordingly, Opposer’s contention that the third-party registrations are not probative and are entitled to no weight is incorrect. (Opposer’s Brief, pp. 28-29 (78 TTABVUE 40-41).

⁸⁴ Applicant introduced many more third-party registrations. The registrations noted above are the most relevant.

⁸⁵ 68 TTABVUE 3-44. Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), provides that “Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.”

printed); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1467 n.30 (TTAB 2014) (Internet webpage evidence admissible only to show what has been printed and not for the truth of what has been printed).⁸⁶ Applicant introduced the third-party websites listed below:

1. Wiz PC & Cell Phone Repair (wizpc.net);
2. G WIZ Computer Consulting (gwizconsulting.com);
3. Mobile Wiz Smartphone Holder & Travel Mate (mobilewizusa.com);
4. My Computer Wizz virus and malware removal (mycomputerwizz.com);
5. WizCompute internet technology consulting (wizcompute.com);
6. TheWizCells purchasing used cell phone online (thewizcells.com);
7. Wiz Electronics Inc., Netgear authorized dealer (wizelectronicinc.com);
8. Cellular Wiz cellphone repair (cellularwizatlanta.com); and
9. Wiz Tech internet service provider (mywiztech.com).

The third-party registrations and websites are probative to show that the terms “Wiz” or “Wizard” suggest that something is very good. This corresponds with the dictionary definition noted above that the word “Wizard” is defined as “a person of amazing skill or accomplishment.”⁸⁷ Accordingly, we find that while the term “Wiz” is inherently distinctive, it is a suggestive term connoting good quality or skill.

⁸⁶ Accordingly, we deny Opposer’s motion to strike Applicant’s third-party websites as inadmissible hearsay. Opposer’s Appendix of Evidentiary Objections and Motion to Strike (78 TTABVUE 44-46). We consider the third-party websites only for what they show on their face noting that there is no testimony or other evidence regarding the third party sales, market share, or promotional efforts.

⁸⁷ See also Merriam-Webster.com (accessed July 24, 2019) defining “Wiz” as “a person who is very good at something.”

With respect to the commercial strength of THE WIZ and NOBODY BEATS THE WIZ, Opposer introduced the evidence listed below arguing that such evidence establishes the “fame” of THE WIZ and NOBODY BEATS THE WIZ:⁸⁸

1. Since November 2004 through October 2015, Opposer has operated www.thewiz.com and www.nobodybeatsthewiz.com websites wherein consumers could purchase a wide array of consumer electronics, and consumer electronics accessories and services.⁸⁹ After a brief hiatus, Opposer, in February 2017, redirected the above-noted URLs and key word searches to the PCRICHARD.com website which displays the trademarks THE WIZ and NOBODY BEATS THE WIZ; and
2. Opposer “has maintained a strong internet retail presence utilizing the Wiz Trademarks.”⁹⁰

Opposer’s testimony and evidence falls short of proving that THE WIZ and NOBODY BEATS THE WIZ have obtained, maintained, or retained any renown in the market. First, the length of time that Opposer has used THE WIZ and NOBODY BEATS THE WIZ trademarks, in itself, is not sufficient to bestow commercial renown on those marks. *Cf. In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (length of use insufficient, in itself, to prove acquired distinctiveness). We note that Opposer acquired THE WIZ and NOBODY BEATS THE WIZ at a bankruptcy

⁸⁸ Opposer’s Brief, p. 28 (78 TTABVUE 40).

⁸⁹ Pohmer Testimony ¶24 (48 TTABVUE 7); Pflug Testimony Decl. ¶7 (55 TTABVUE 4).

⁹⁰ Opposer’s Brief, p. 28 (78 TTABVUE 40).

sale where it paid a minimal amount for the goodwill associated with the marks and its predecessor's customer list indicating that the marks had little residual value.⁹¹ Further, Opposer's subsequent sales generated through THEWIZ.com and NOBODYBEATSTHEWIZ.com websites from 2003 through 2013 were minimal.⁹² After 2013, Opposer did not separately track sales generated through those websites but incorporated those sales in Opposer's overall online sales figures from which we infer that the sales were so insignificant that there was no reason to separately track those sales.⁹³ Corroborating our inference is that in 2017, Opposer did not launch a separate website for THE WIZ or NOBODY BEATS THE WIZ but had the URLs and keyword searches involving those marks redirected to Opposer's PCRICHARD.com website. Finally, there is no evidence regarding the recognition of Opposer's THE WIZ and NOBODY BEATS THE WIZ marks by third parties (e.g., magazines referring to those marks), nor is there any evidence regarding social media following regarding the services identified by those marks.

Considering the record as a whole, including the evidence to both inherent strength, commercial strength and the number and nature of third-party marks in use in connection with similar goods and services, we find that a mark comprising, in whole or in part, the term "Wiz" in connection with retail store services in the field of

⁹¹ Pohmer Testimony Decl. ¶17 (45 TTABVUE 6) (confidential). The purchase price for THE WIZ and NOBODY BEATS THE WIZ trademarks, goodwill and associated customer list was designated confidential so we may refer to them only in general terms.

⁹² Pohmer Testimony Decl. ¶¶55-56 (45 TTABVUE 14) (confidential). Opposer's sales figures were designated confidential so we may refer to them only in general terms.

⁹³ Pohmer Testimony Decl. ¶56 (45 TTABVUE 14).

consumer electronics and accessories should be given a restricted scope of protection. *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. App'x. 222 (Fed. Cir. 2010); *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983). In other words, Opposer's marks THE WIZ and NOBODY BEATS THE WIZ are not entitled to such a broad scope of protection that they will bar the registration of every mark comprising, in whole or in part, the term "Wiz"; they are, nevertheless, sufficient to bar the registration of marks "as to which the resemblance to [Opposer's marks] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two." *Id. Compare In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996) (wide-spread third-party use supported the finding that the marks were not likely to cause confusion because "at least half, if not more, of the third-party telephone directory listings of enterprises whose trade name names/marks contain the term BROADWAY have listed addresses on a street, road, avenue, etc., named 'BROADWAY.' To purchasers familiar with these enterprises, the term BROADWAY will have geographic significance").

6. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110

USPQ2d 1810, 1812 (TTAB 2014); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods and services are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods and services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *see also Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific

impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because Opposer is rendering retail store services in the field of consumer electronics and accessories and Applicant's description of goods include electronic accessories and headphones and ear phones, the average customer is an ordinary consumer.

Applicant's mark WIZGEAR resembles Opposer's mark THE WIZ and NOBODY BEATS THE WIZ because they share the term "Wiz." The term "Wiz" in Applicant's mark WIZGEAR is the dominant portion of Applicant's mark because the term "Gear" is descriptive of Applicant's goods. The word "Gear" is defined, inter alia, as "implements, tools, or apparatus, especially as used for a particular occupation or activity; paraphernalia: *fishing gear*."⁹⁴ It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d

⁹⁴ Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2019) accessed July 24, 2019.

1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data Corp.*, 224 USPQ at 751; *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Further reinforcing the significance of the term “Wiz” as the dominant element of Applicant’s mark WIZGEAR is its location as the first part of the mark. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1049 (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (noting that the dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)

("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

Likewise, the dominant portion of Opposer's marks THE WIZ and NOBODY BEATS THE WIZ is the term "Wiz." As discussed previously, the definite article "the" has little, if any, trademark significance. *See In re Narwood Prods., Inc.*, 223 USPQ 1034; *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 USPQ 269; *U.S. Nat'l Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ at 236.

With respect to the mark NOBODY BEATS THE WIZ, the commercial impression engendered by the entire mark emphasizes that THE WIZ provides the best deal. "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985). While some consumers may perceive Applicant's mark WIZGEAR to mean and engender the commercial impression of high quality consumer electronics and accessories, others are likely to perceive WIZGEAR as referring to products related Opposer's THE WIZ and NOBODY BEATS THE WIZ retail stores in the field of consumer electronics and accessories. The peripheral differences in this case fail to distinguish the marks.

Given the dominance of the term "Wiz" in the marks at issue, we find that Applicant's mark WIZGEAR is similar to Opposer's marks THE WIZ and NOBODY BEATS THE WIZ in terms of appearance, sound, connotation and commercial impression.

7. Summary

Because the marks are similar, the goods and services are closely related, the goods and services are offered similar trade channels to the same consumers and the goods and services of the parties are offered to ordinary consumers who may not exercise a high degree of purchasing care, we find that Applicant's mark WIZGEAR for "electronic accessories, namely, cell phone cases, computer tablet cases, protective cases for smartphones and computer tablets, smartphone mounts, computer tablet mounts; small electronics, namely, headphones and earphones" is likely to cause confusion with Opposer's marks THE WIZ and NOBODY BEATS THE WIZ for retail store services in the field of consumer electronics and accessories.

In finding that there is a likelihood of confusion, we acknowledge that the term "Wiz" is entitled to a somewhat narrow scope of protection. Nonetheless, especially in a case as here where ordinary consumers encounter similar marks and closely related goods and services, we find that there is a likelihood of confusion.

Finally, even if we delete "small electronics, namely, headphones and earphones" from Applicant's description of goods, there is still a likelihood of confusion.

Decision: Applicant's Counterclaim to Cancel Opposer's pleaded registrations on the ground of abandonment is denied.

Applicant's Counterclaim to Cancel Opposer's pleaded Registration No. 1395362 on the ground of fraud is denied.

The opposition is sustained and registration to Applicant is refused.