

This Opinion is Not a  
Precedent of the TTAB

Mailed: October 28, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Sony Group Corporation*

*v.*

*Neil A. Campbell*  
—————

Opposition No. 91245851  
—————

Mark Sommers, Naresh Kilaru, and Rosie Norwood-Kelly of Finnegan, Henderson,  
Farabow, Garrett & Dunner, L.L.P. for Sony Group Corporation.

Neil A. Campbell, pro se.  
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Before Zervas, Lykos, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Neil A. Campbell (“Applicant”), appearing pro se, seeks registration on the  
Principal Register of the standard-character mark SoniStream<sup>1</sup> for goods identified

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<sup>1</sup> As discussed below, this is how Applicant’s standard-character mark is shown in the drawing in his application and discussed in his brief, and we will display the mark in this manner in our opinion. We note, however, that the appearance of the mark in this manner in the drawing “does not change the nature of the mark from standard character to special form.” *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020) (citing *In re Calphalon Corp.*, 122 USPQ2d 1153, 1554 n.1 (TTAB 2017)). As discussed below, a standard-character mark is not limited to any particular font style, size, or color.

as “Downloadable computer software for Internet and broadcast radio scheduling and audio playout” in International Class 9.<sup>2</sup>

Sony Group Corporation (“Opposer”)<sup>3</sup> opposes registration of Applicant’s mark on two grounds: (1) likelihood of confusion with Opposer’s previously used and registered SONY and SONY-formative marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) likelihood of dilution by blurring of Opposer’s SONY and SONY-formative marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).<sup>4</sup> The case is fully briefed.<sup>5</sup> We sustain the opposition on the basis of Opposer’s dilution claim and do not reach its likelihood of confusion claim.

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<sup>2</sup> Application Serial No. 87882260 was filed on April 18, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

<sup>3</sup> Opposer’s corporate name was Sony Corporation when this proceeding was commenced, 1 TTABVUE 18, but Opposer changed its name to Sony Group Corporation during trial, 72 TTABVUE 2, and the Board granted Opposer’s motion to substitute its updated name, and updated the case caption to identify Sony Group Corporation as the opposer. 73 TTABVUE 2.

<sup>4</sup> In its Notice of Opposition, Opposer pleaded ownership of numerous SONY and SONY-formative marks. Not. of Opp. ¶¶ 10-11; Ex. A (1 TTABVUE 21-29, 33-153). We focus below on Opposer’s SONY word mark, registered in standard characters and in a stylized font, for a variety of goods and services.

Applicant’s Answer to Notice of Opposition, 4 TTABVUE 1-10, denied the salient allegations of Opposer’s Notice of Opposition, *id.* at 1-4, and interposed various self-styled “Affirmative Defenses, Avoidances, and Arguments.” *Id.* at 5-7. Opposer moved to strike all 12 of the paragraphs in this portion of Applicant’s Answer. 5 TTABVUE 2-6. The Board struck paragraphs 1, 7, and 9-12, but allowed paragraphs 2-6 and 8 to stand, not as affirmative defenses per se, but rather as amplifications of Applicant’s denials of Opposer’s allegations. 8 TTABVUE 4-5.

<sup>5</sup> Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s public online docketing system. *See New Era*, 2020 USPQ2d 10596, at \*2 n.1. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer’s main brief appears at 91 TTABVUE and its reply brief appears at 94 TTABVUE. Applicant’s brief appears at 93 TTABVUE.

### **I. Opposer's Motion to Strike Applicant's Brief**

In its reply brief, Opposer objects to Applicant's brief, and moves to strike it, on the grounds that it (1) was untimely filed, and (2) does not comply with the requirements of Trademark Rule 2.126, 37 C.F.R. § 2.126, because it is single-spaced, and does not include an index of cases or page numbers. 94 TTABVUE 24-26.

With respect to untimeliness, Applicant's brief was due on April 19, 2022, 80 TTABVUE 18, and it was filed the next day, April 20, 2022. 91 TTABVUE 1. Given the de minimis delay in filing, and the fact that Opposer did not demonstrate any prejudice to itself in timely filing its reply brief addressing all of Applicant's arguments, we decline to strike Applicant's brief because it was filed a day late. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") (June 2022) § 539 and cases cited therein.

Applicant's failure to comply with Trademark Rule 2.126(a)(1) is more troubling. "Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure and the Federal Rules of Evidence, is required of all parties, whether or not they are represented by counsel," *Hole in 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at \*1 (TTAB 2020), and, as Opposer notes, Applicant was repeatedly advised during this proceeding that his submissions must comply with the applicable rules. 8 TTABVUE 8 ("Submissions in Board proceedings . . . must be in compliance with Trademark Rules 2.126(a) and (b)."); 12 TTABVUE 2 ("Trial Briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b)."); 19 TTABVUE 2 ("submissions must be compliant with Trademark Rules 2.119 and

2.126.”); 21 TTABVUE 1-2 (“Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b).”); 29 TTABVUE 4 (“submissions must be compliant with Trademark Rules 2.119 and 2.126.”); 35 TTABVUE 6 (same); 73 TTABVUE 9 (“Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b).”).

Despite these admonitions, Applicant’s “brief is single-spaced and, thus, the brief is not in technical compliance with Trademark Rule 2.126(a)(1).” *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.4 (TTAB 2012). Applicant’s single-spaced brief is 26 pages in length and contains several pages with large blank portions, so it appears that “the brief, if double-spaced, would be within the [55-]page limitation as set forth in Trademark Rule 2.128(b),” and that Applicant’s non-compliance was not “meant to be a subterfuge to circumvent the rule regarding the length of the brief.” *Id.*; see also *Hole in 1 Drinks*, 2020 USPQ2d 10020, at \*1-2 (declining to strike the defendant’s brief on the ground that it was single-spaced). Accordingly, notwithstanding Applicant’s seemingly cavalier attitude toward the rules, we will exercise our discretion to “consider [his] arguments in his brief, for whatever persuasive value they may have despite his failure to properly format the brief.” *Id.*, at \*2.

## **II. The Record**

The record is immense, amounting to more than 6,000 pages of testimony and documents. It consists of the pleadings, the file history of the opposed application, by

operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following materials submitted by the parties:

**A. Opposer's Evidence**

- Testimony Declaration of Takako Suzuki, Opposer's General Manager, Trademark Department, Intellectual Property Division, and Exhibits 1-50 thereto, 55 TTABVUE 2-1992; 56 TTABVUE 2-283; 57 TTABVUE 3-430; 58 TTABVUE 2-210;
- Testimony Declaration of Mingshu W. Zhang, offered as an expert witness, and Exhibit A thereto, 39 TTABVUE 2-13;
- Testimony Declaration of Jasmine A. Prezeau, offered as an expert witness, and Exhibits A-Z thereto, 40 TTABVUE 2-85;
- Testimony Declaration of Dr. Melissa Pittaoulis, offered as an expert witness, and Exhibits A-H thereto, 41 TTABVUE 2-214; and
- Notices of Reliance Nos. 1-18 (15 filed during Opposer's trial period and three filed during its rebuttal period), covering various materials including Opposer's multiple registrations,<sup>6</sup> printed publications, Internet materials, Applicant's responses to Opposer's requests for admission, and excerpts from Applicant's discovery deposition. 36 TTABVUE 2-151 (No. 1); 37

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<sup>6</sup> Pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), Opposer previously made its pleaded registrations of record by attaching USPTO electronic records showing their current title and status to its Notice of Opposition. 1 TTABVUE 33-153. Making registrations or other evidence of record once is enough. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*12-13 (TTAB 2022) (the Board views with disfavor the filing of duplicative evidence by different methods of introduction . . .”).

TTABVUE 2-88 (No. 2); 38 TTABVUE 2-55 (No. 3); 42 TTABVUE 2-309 (No. 4); 43 TTABVUE 2-218 (No. 5); 44 TTABVUE 2-355 (No. 7); 45 TTABVUE 2-82 (No. 8); 46 TTABVUE 2-101 (No. 6); 47 TTABVUE 2-16 (No. 9); 48 TTABVUE 2-220 (No. 10); 49 TTABVUE 2-89 (No. 11); 50 TTABVUE 2-468 (No. 12); 51 TTABVUE 2-87 (No. 12); 52 TTABVUE 2-13 (No. 13); 53 TTABVUE 2-37 (No. 14); 54 TTABVUE 2-20 (No. 15); 87 TTABVUE 2-114 (No. 16); 88 TTABVUE 2-206 (No. 17); and 89 TTABVUE 2-106 (No. 18).

### **B. Applicant's Evidence**

- Testimony Declaration of Neil A. Campbell, 68 TTABVUE 2;
- Testimony Declaration of Jonathan E. Hochman, offered as an expert witness, and Exhibits A-C thereto, 76 TTABVUE 43-128;<sup>7</sup>
- Testimony Declaration of Dr. Jacqueline A. Chorn, offered as an expert witness, and Appendix A thereto, 76 TTABVUE 11-42;<sup>8</sup> and

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<sup>7</sup> Prior to trial, Opposer moved to strike the original Hochman expert report, 67 TTABVUE 2-87, on the ground that it had not been executed during Applicant's trial period. 80 TTABVUE 10. The Board granted that motion, *id.* at 12, but construed Applicant's response as a request to reopen its trial period to allow the submission of an updated but identical Hochman report. The Board granted that construed request, and accepted the updated Hochman report. *Id.* at 15.

<sup>8</sup> As with the original Hochman expert report, the Board struck the original Chorn declarations, 66 TTABVUE 2-32, because they had not been executed during Applicant's trial period, 80 TTABVUE 12, but accepted updated and identical Chorn declarations. *Id.* at 15. Dr. Chorn's declarations critique Opposer's likelihood of confusion survey, and are cited by Applicant only in support of his defense to Opposer's likelihood of confusion claim, 93 TTABVUE 18-19, which we do not reach.

- Notices of Reliance Nos. 1-7 and 9,<sup>9</sup> covering Internet materials and Applicant's entire discovery deposition.<sup>10</sup> 60 TTABVUE 2-15 (No. 1); 61 TTABVUE 2-37 (No. 2); 62 TTABVUE 2-69 (No. 3); 81 TTABVUE 1-4; 82 TTABVUE 1-4, 83 TTABVUE 2-5, 85 TTABVUE 2-5, and 86 TTABVUE 2-

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<sup>9</sup> The Board has not received a Notice of Reliance No. 8.

<sup>10</sup> Opposer submitted under its Notice of Reliance No. 14 numbered pages 5, 10, 20, 23-26, 35-36, 42-43, 58-60, 66-69, 71-72, 77, 92-93, and 95-98 from the transcript of Applicant's 113-page discovery deposition, with heavy redaction. 53 TTABVUE 10-36. Applicant submitted his entire unredacted transcript and Exhibit 5 thereto under his Notice of Reliance No. 7. 69 TTABVUE 8-116. Trademark Rule 2.120(k)(4), 37 C.F.R. § 2.120(k)(4), provides that when one party has introduced "only part of a discovery deposition . . . an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party." Such a "notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts." *Id.* Applicant's Notice of Reliance No. 7 covering the entire transcript of his discovery deposition stated that he "will likely rely on this full transcript to show the Board my complete answers to Opposer's questions in that deposition of which Opposer disclosed only in a highly redacted form to the Board from pages 5-7 and 97." 69 TTABVUE 2. As discussed below, Opposer moved to strike an email submitted with Applicant's Notice of Reliance No. 7 that was not identified as an exhibit at Applicant's discovery deposition, but did not object to the submission of the entire deposition transcript itself. 74 TTABVUE 4-5. Opposer also referred to the entire deposition in its description of the record in its main brief, 91 TTABVUE 16, noting only that the Board had struck the objected-to email. *Id.* at n.2. Accordingly, Opposer has waived any objection to Applicant's submission of the entire transcript of his discovery deposition on the ground that it exceeded the permissible scope of Applicant's use of the deposition under Trademark Rule 2.120(k)(4). We find that the entire transcript of Applicant's discovery deposition has been stipulated into the record by Opposer, and we have considered it in full as substantive evidence for whatever probative value it may have.

6 (No. 4);<sup>11</sup> 64 TTABVUE 2-41 (No. 5); 84 TTABVUE 2-16 (No. 6);<sup>12</sup> 69  
TTABVUE 2-141 (No. 7);<sup>13</sup> and 70 TTABVUE 2-20 (No. 9).

### III. The Parties and Their Marks and Businesses

#### A. Opposer

Opposer was founded in Japan in 1946. Suzuki Decl. ¶ 3 (55 TTABVUE 2).<sup>14</sup> In 1958, its company name changed from Tokyo Tsushin Kogyo K.K. to Sony

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<sup>11</sup> Prior to trial, Opposer moved to strike Applicant's Notice of Reliance No. 4, which contained links to YouTube videos, 63 TTABVUE 2-4, on the ground that providing links to Internet materials is insufficient to make those materials of record. 80 TTABVUE 4. The Board granted that motion, *id.* at 6, but allowed Applicant 20 days from the date of the order to properly submit the referenced YouTube videos under notice of reliance. *Id.* at 6. Applicant subsequently submitted the videos, 81 TTABVUE 1-4; 82 TTABVUE 1-4, 83 TTABVUE 2-5, 85 TTABVUE 2-5; 86 TTABVUE 2-6, and we have considered them for whatever probative value they may have.

<sup>12</sup> Prior to trial, Opposer moved to strike Applicant's Notice of Reliance No. 6, 65 TTABVUE 2-7, on the ground that providing links to Internet materials is insufficient to make those materials of record. 80 TTABVUE 7. The Board granted that motion, *id.* at 8, but allowed Applicant 20 days from the date of the order to resubmit Notice of Reliance No. 6. *Id.* at 8-9. Applicant subsequently did so. 84 TTABVUE 2-16.

<sup>13</sup> Prior to trial, Opposer moved to strike an email attached to Applicant's Notice of Reliance No. 7, 69 TTABVUE 142-43, that was not an exhibit to Applicant's discovery deposition, on the ground that emails cannot be properly submitted under notice of reliance. 74 TTABVUE 4-5. The Board granted that motion. 80 TTABVUE 10.

<sup>14</sup> "Rule 602 of the Federal Rules of Evidence provides that a 'witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter,' and that '[e]vidence to prove personal knowledge may consist of the witness's own testimony.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*11 (TTAB 2021) (quoting Fed. R. Evid. 602). Mr. Suzuki testified that he is the General Manager, Trademark Department, Intellectual Property Division for Opposer, and has been employed by Opposer for more than 30 years, Suzuki Decl. ¶ 1 (55 TTABVUE 2), that "[t]he facts in this declaration are based on my personal knowledge and/or my review of records and archival materials that Sony maintains in the ordinary course of business," Suzuki Decl. ¶ 1 (55 TTABVUE 2), and that "[m]y time at Sony has exposed me to the history of the SONY brand and its continued promotion and recognition among consumers and industry professionals in the United States across numerous sectors, including consumer electronics, broadcast, and entertainment." Suzuki Decl. ¶ 2 (55 TTABVUE 2). We find that this foundational testimony is sufficient to establish that Mr. Suzuki has personal knowledge of

Corporation,<sup>15</sup> and in the more than 60 years since, “Sony” has been the company’s public-facing name. Suzuki Decl. ¶ 5 (55 TTABVUE 3). In 1970, Opposer became the first Japanese company to have its shares listed on the New York Stock Exchange. Suzuki Decl. ¶ 6 (55 TTABVUE 3). Opposer has used the SONY mark continuously in the United States since at least as early as 1960. Suzuki Decl. ¶ 6 (55 TTABVUE 3).<sup>16</sup>

Opposer is one of the world’s largest diversified businesses with a long history in the consumer and professional electronics field, including audio, video, computer game, and mobile phone products, electronic components, and medical-related equipment and professional solutions. Suzuki Decl. ¶ 3 (55 TTABVUE 2). Opposer is also a widely known and leading entertainment company in the motion picture, television, music, gaming and online entertainment spaces. Suzuki Decl. ¶ 3 (55 TTABVUE 2).

Opposer’s principal business operations include Sony Group Corporation, Sony Pictures Entertainment, Sony Interactive Entertainment (formerly Sony Computer Entertainment), Sony Music Entertainment, Sony Mobile Communications, and Sony Financial Holdings. Suzuki Decl. ¶ 7 (55 TTABVUE 3). Opposer’s approximate United States revenues from SONY-branded products and services across all of its

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the history of Opposer’s use of its marks and the other matters in his declaration. *Sabhnani*, 2021 USPQ2d 1241, at \*12.

<sup>15</sup> As noted above, Opposer changed its corporate name to “Sony Group Corporation” after Mr. Suzuki executed his declaration in February 2021.

<sup>16</sup> Mr. Suzuki attached to his declaration a page from Opposer’s website at [sony.net](http://sony.net) discussing Opposer’s history. Suzuki Decl. ¶ 6; Ex. 1 (55 TTABVUE 3, 33-52).

business segments were \$12 billion in fiscal year 2013, \$14 billion in fiscal year 2014, \$16 billion in fiscal year 2015, \$16 billion in fiscal year 2016, \$17 billion in fiscal year 2017, \$19 billion in fiscal year 2018, and \$18 billion in fiscal year 2019. Suzuki Decl. ¶ 7; Ex. 2 (55 TTABVUE 3-4, 53-1631).<sup>17</sup>

Opposer has used its SONY mark in connection with a number of pioneering products, including the Betamax home video cassette recorder, which was the subject of a 1984 United States Supreme Court decision regarding copyright fair use, *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 220 USPQ 665 (1984); the Walkman, the world's first stereo cassette player, launched in 1979; the world's first compact disc player, launched in 1982; the world's first portable compact disc player, launched in 1984; the Handycam camcorder, launched in 1989; and the Playstation video game console, launched in 1995. Suzuki Decl. ¶¶ 8-9 (55 TTABVUE 4, 1676-1762; 56 TTABVUE 56-67).

Opposer's SONY mark has also long been a prominent brand in connection with entertainment. Suzuki Decl. ¶ 10 (55 TTABVUE 4). It has been used by Opposer's affiliates Sony Pictures Entertainment in connection with movies and television programs, Sony Pictures Television in connection with television programming, Sony Music Entertainment in connection with the Sony music label, and Sony Interactive Entertainment in connection with the PlayStation hardware, software, content, and network services. Suzuki Decl. ¶ 16 (55 TTABVUE 7-8).

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<sup>17</sup> Exhibit 2 to Mr. Suzuki's declaration contains a series of Opposer's Annual Reports filed with the United States Securities and Exchange Commission for the relevant periods.

The public has been exposed to Opposer's SONY mark through television and film production and distribution since 1989, Suzuki Decl. ¶ 10 (55 TTABVUE 4), and the production or distribution of numerous hit feature motion pictures in the United States, including A FEW GOOD MEN (1992), JERRY MAGUIRE (1996), GODZILLA (1998), GLADIATOR (2000), THE DA VINCI CODE (2006), THE SOCIAL NETWORK (2010), THE SMURFS (2011), ONCE UPON A TIME IN HOLLYWOOD (2019), two Jumanji films, JUMANJI (1995) and JUMANJI: WELCOME TO THE JUNGLE (2017), four James Bond films, 007 CASINO ROYALE (2006), 007 QUANTUM OF SOLACE (2008), 007 SKYFALL (2012), and SPECTRE (2015), and seven Spider-man films, SPIDER-MAN (2002), SPIDER-MAN 2 (2004), SPIDER-MAN 3 (2007), THE AMAZING SPIDER-MAN (2012), THE AMAZING SPIDER-MAN 2 (2014), SPIDER-MAN: HOMECOMING (2017), and SPIDER-MAN: FAR FROM HOME (2019). These films have collectively grossed many billions of dollars in the United States. Suzuki Decl. ¶ 11 (55 TTABVUE 5-6).

Opposer's SONY mark has also been used in connection with the production, distribution, and sale of musical recordings by artists such as Mariah Carey, Pearl Jam, Bruce Springsteen, Celine Dion, Pink Floyd, Luther Vandross, Gloria Estefan, Michael Jackson, Sade, Beyonce, Adele, David Bowie, and Elvis Presley. Suzuki Decl. ¶¶ 12-14; Exs. 6-9 (55 TTABVUE 6-7; 56 TTABVUE 58-146).

The SONY mark has been extensively advertised and promoted in connection with various goods and services in the United States for over half a century, including through retail stores, national television commercials, advertisements in magazines, newspapers, billboards (including one in New York City's Times Square spanning

decades), the Sony.com website, digital media, social media, and global sporting events. Opposer has spent tens of millions of dollars annually advertising and promoting the SONY mark in the United States for decades. Suzuki Decl. ¶ 40; Ex. 30 (55 TTABVUE 15; 56 TTABVUE 246-57). Mr. Suzuki's declaration displays or attaches a number of historical advertisements displaying the SONY mark, several of which we reproduce below:

**IF YOU CAN AFFORD  
A TELEVISION, NOW  
YOU CAN AFFORD  
A BETAMAX™**

POWER ON/OFF  
Betamax  
EJECT  
VIDEO CASSETTE RECORDER SL-2300 B&B  
TRACING  
RECORD MODE  
0000  
RECORD

For years, ever since you first heard about home videocassette recorders, you've known which one you've wanted. The one VCR that set the standard since the beginning—the Sony Betamax. With Sony reliability, Sony engineering, Sony picture quality. You've heard all the wonders of the Sony Betamax... and you've been wondering when you could afford one.

Well, now you can. For less than the cost of a color television, you can own a Sony Betamax SL-2300 video-cassette recorder—the lowest-priced Sony Betamax ever.

Not only is it an affordable VCR, it's an affordable Sony. So you get Sony quality and superb Sony features like BetaScan™ high speed picture search, a low-profile, front-loading design, with convenient remote control and three-day programmability.

Like all Betamax VCR's, your SL-2300 lets you record one program while watching another. Or record your favorite shows when you're not at home. Or watch your favorite movies and concerts by buying or renting any of the thousands of pre-recorded tapes available in the Beta format. Or take advantage of our special toll-free number 1-800-221-9982 (1-800-521-9029 in New York) for up-to-the-second information about new releases and availabilities.

Most important, your SL-2300 will let you use the miraculous new Betamovie™—the world's first one-piece home video camera/recorder. Betamovie lets you tape up to 3 hours and 20 minutes on a standard L-830 Beta cassette without having to carry your SL-2300 along. So you can create your own movies...capture family memories...practice

your business presentation...open up a world of possibilities no other format can give you.

All that's available to you if you say "I want the Sony Betamax SL-2300." And it's available in your choice of Mandarin Red, Sapphire Blue or High Tech Silver finishes. Chances are, if you can afford a television, you can afford a Sony Betamax. And the only question is, why wait any longer?

Sony Betamax, Betamovie and SonyScan are trademarks of Sony Corporation. © 1982 Sony Corporation of America.

**SONY**  
THE ONE AND ONLY

Suzuki Decl. ¶ 40; Ex. 30 (56 TTABVUE 248).



Suzuki Decl. ¶ 40 (55 TTABVUE 16).



Suzuki Decl. ¶ 40 (55 TTABVUE 17).



Suzuki Decl. ¶ 40 (55 TTABVUE 18).

Opposer's SONY mark also appears prominently on Opposer's social media pages, including on Facebook (over 8.5 million followers), Twitter (4.7 million followers), YouTube (over 390,000 subscribers), Instagram (8.7 million followers), and LinkedIn (over 770,000 followers). The social media pages for Sony Pictures display the SONY mark at the top of the pages, including on Facebook (over 29 million followers), Twitter (2.7 million followers), YouTube (4.52 million subscribers), Instagram (2 million followers), and LinkedIn (over 970,000 followers). The social media pages for Sony Music Entertainment display the SONY mark at the top of the pages, including on Facebook (1.8 million followers), Twitter (over 709,000 followers), YouTube (over 39,000 subscribers), Instagram (707,000 followers), and LinkedIn (over 639,000 followers). Suzuki Decl. ¶ 41; Ex. 31 (55 TTABVUE 18; 56 TTABVUE 258-63).

Opposer has also promoted the SONY mark through multimedia marketing campaigns involving well-known athletes, entertainers, and other celebrities, Suzuki

Decl. ¶ 43; Ex. 33 (55 TTABVUE 19-20; 56 TTABVUE 269-79), as well as through product placement in numerous motion pictures and television programs. Suzuki Decl. ¶ 46; Ex. 36 (55 TTABVUE 22-25; 58 TTABVUE 2-96).

Opposer has also extensively licensed the SONY mark for a variety of consumer products and in 2018 the SONY mark was ranked as the 85th most licensed brand in the world, generating \$350 million worldwide from the retail sale of SONY-licensed consumer products. Suzuki Decl. ¶ 47; Ex. 37 (55 TTABVUE 25; 58 TTABVUE 97-104). Millions of consumers in the United States have been exposed to Opposer's SONY mark through athletic sponsorships, including the FIFA World Cup competitions in 2010 and 2014, in which the mark appeared on field signage that was visible to millions of viewers of the World Cup games and game highlights in the United States. Suzuki Decl. ¶¶ 40, 49-52; Exs. 37-40 (55 TTABVUE 25-27; 58 TTABVUE 103-29).

Opposer and its SONY mark have received extensive unsolicited media coverage, and the SONY mark has been consistently ranked and recognized as among the world's leading brands. Opposer has been the subject of at least 15 books. Suzuki Decl. ¶ 55; Ex. 43 (55 TTABVUE 28; 58 TTABVUE 137-43). Nearly 30 years ago, the SONY mark was recognized in a 1994 article in THE PHILADELPHIA INQUIRER about the resignation of Opposer's founder and chairman Akio Morita as "one of the world's most famous brands," and 10 years later the mark was called "an iconic blue-chip brand across the world, a name that has come to stand for perpetual innovation in

the hyper-competitive consumer electronics business” in a 2004 article in MEDIA. Suzuki Decl. ¶ 58; Ex. 44 (55 TTABVUE 28; 58 TTABVUE 144-49).

In 1988, the LOS ANGELES TIMES reported that the SONY mark was the third most powerful brand name in the world after Coca-Cola and IBM, and ahead of Porsche, McDonald's, Disney, Honda, Toyota, Seiko, BMW, Volkswagen, Mercedes, Pepsi Cola, Kleenex, Nestle, Rolex, Jaguar, Xerox, Lipton, Hilton, Polaroid, Canon, Levi's, Yamaha and Nissan, in a survey conducted by Landor Imagepower. BUSINESS WIRE reported in 2006 that in a 2005 survey of more than 17,500 consumers, the SONY mark was ranked as the most popular consumer electronic brand in the world, ahead of Apple, Canon, Casio, Dell, Hitachi, Hewlett-Packard, Microsoft, Nokia, Panasonic, Philips, Pioneer, Sanyo, Sharp, and Toshiba. Suzuki Decl. ¶ 59; Ex. 45 (55 TTABVUE 28; 58 TTABVUE 150-53).

The SONY mark has been ranked consistently in the annual Interbrand list of Best Global Brands as one of the world's leading brands. The mark was ranked 58th in 2016, 61st in 2017, 59th in 2018, 56th in 2019, and 51st in 2020. Suzuki Decl. ¶ 60; Ex. 46 (55 TTABVUE 28-29; 58 TTABVUE 154-59). FORBES magazine has similarly consistently ranked the SONY mark as among the world's most valuable brands. The mark was ranked 38th in 2013, 80th in 2014, 79th in 2015, 76th in 2016, 73rd in 2017, 63rd in 2018, 60th in 2019, and 47th in 2020. Suzuki Decl. ¶ 61; Ex. 47 (55 TTABVUE 29; 58 TTABVUE 160-81). The SONY mark has also received recognition as the “house mark” for iconic consumer products such as the Sony Walkman and the

Sony Playstation in media coverage of those products. Suzuki Decl. ¶¶ 63-65; Ex. 49 (55 TTABVUE 30; 58 TTABVUE 188-207).

Opposer owns more than 20 registrations of its SONY mark, alone or with other elements, for various goods and services. 36 TTABVUE 15-151. These include registrations of the SONY word mark in standard characters for television cameras, *id.* at 15 (Registration No. 770275); data recorders, *id.* at 19 (Registration No. 785967); computers, word processors, floppy discs and typewriters for use with data recording apparatus, *id.* at 22 (Registration No. 1207979); video tape recorders, video disc players, video cameras, and recorded video tapes in addition to unrecorded video tapes, *id.* at 26 (Registration No. 1258436); radios, televisions, tape recorders, and numerous other electronics goods, *id.* at 30 (Registration No. 1622127); cellular telephones and related goods, and smart watches, *id.* at 38 (Registration No. 3243454); numerous entertainment services, including providing downloadable streaming, and wireless entertainment content in the nature of audiovisual works, motion pictures, trailers, television programming, music, and games by means of an interactive global computer and communications networks; providing online entertainment, namely, production of sound and audiovisual recordings in the field of music and musical based entertainment and production of sound and music video recordings, *id.* at 43 (Registration No. 4938522); various broadcasting, podcasting, and webcasting services, *id.* at 48 (Registration No. 4313348); and electrical sound recording apparatus, including electric record players, electrically driven record

changers, and automatic phonograph record changers. *Id.* at 108 (Registration No. 801885).

**B. Applicant**

Applicant has been involved with MusicONE, a music scheduler for radio stations, for 25 years. Campbell Tr. 12:4-13 (69 TTABVUE 15). Music scheduling involves the scheduling of the sequence of songs to be played in each hour throughout the broadcast day of a radio station. Campbell Tr. 12:14-17 (69 TTABVUE 15).

Applicant testified that he has “no experience in trademarks really.” Campbell Tr. 26:22-23 (69 TTABVUE 29). He testified that he came up with the SoniStream mark in 2010, Campbell Tr. 26:6-11 (69 TTABVUE 29), and that “I didn’t do any research about it. I just was . . . sitting in a room and thought of it and was searching the internet for domain names that were not taken.” Campbell Tr. 56:8-11 (69 TTABVUE 59). He testified that the mark “really came from ‘SonicStream’ and I took out the c because SonicStream is -- is abrupt, it stops, and it’s also descriptive. So SoniStream flows.” Campbell Tr. 28:5-8 (69 TTABVUE 31).

Applicant testified that there were three purposes of the software that he intends to sell under the SoniStream mark, the “music and program scheduler, the traffic scheduler and billing system, which is the second piece, and the playout system, I wanted to build a product that would do three things and I wanted to come up with a name that would describe that.” Campbell Tr. 28:15-20 69 TTABVUE 31). The “name would not be ‘playout,’ would not be ‘scheduler.’ It would have to be something more vague but suggestive of what it’s about. It’s about sound. That’s the ‘Soni’ part, and

'Stream,' that's about broadcasting." Campbell Tr. 28:20-24 (69 TTABVUE 31). He testified that the "Soni" part of the mark "suggests sound, sonic," Campbell Tr. 29:2-4 (69 TTABVUE 32), and that while he did no research to confirm that "Soni" would be perceived as "sonic," "it seemed patently obvious" to him. Campbell Tr. 30:9-14 (69 TTABVUE 33).

Applicant testified that the SoniStream mark fit the product that he intended to develop because

it suggests sound and it suggests broadcasting, but it suggests it in a way that could include both internet and terrestrial broadcasting. That's the stream part. And part of the product is also content distribution, which I had mentioned also in -- in the description of use to you. And in that sense I'm using "stream" in a more abstract sense of not, you know, point-to-point -- well, it is point-to-point, but not -- you know, none of this is on demand streaming. But there, I'm using stream in the sense of simply communication or transferring information. So it suggests both the -- the final program stream, be it through the air or through the internet, and also the -- excuse me, the content distribution between content providers and the broadcaster.

Campbell Tr. 31:16-32:6 (69 TTABVUE 34-35).

Applicant testified that he did not choose the mark "SonicStream"

[b]ecause it's clunky. It's not sexy. It . . . doesn't flow verbally, "Sonic -- SonicStream." It's broken up and it's also descriptive. . . . I didn't know back then, but intuitively I knew it then. Let me say that. I didn't know at all about descriptive versus suggestive at all until recently. But intuitively, I -- I knew -- it just didn't seem like -- it didn't have a trademark kind of quality to it because it was just two words that exist already. So I . . . knew that intuitively. "SonicStream" didn't seem like anything. So when I took the c out, then it seemed like -- seemed more unique. So that's all. That's why it sounds better and it - - and it seemed more like a unique mark.

Campbell Tr. 111:13-112:2 (69 TTABVUE 114-15). He testified that he instead “simply removed the c from word sonic to produce this – this mark.” Campbell Tr. 34:18-19 (69 TTABVUE 37).

He testified that SoniStream was “sexy” because

“SonicStream” sounds very -- sounds -- sounds like some -- sounds like something that’s used -- you know, it sounds like something that is used to – to remove the siding in -- some industrial product to remove the siding of buildings for -- for demolition or something. It just -- it just sounds very hard. So SoniStream, sexy only in the sense that it’s smoother. SoniStream just flows better.

Campbell Tr. 112:7-14 (69 TTABVUE 115).

Applicant first applied to register the trademark SoniStream in 2010 through MusicONE. Campbell Tr. 29:10-13; 97:5-12 (69 TTABVUE 32, 100). He testified that the mark was refused registration on the basis of the mark “SonicStream.” Campbell Tr. 29:12-23 (69 TTABVUE 32). He applied again in 2018. Campbell Tr. 29:24-25 (69 TTABVUE 32).

The drawing of Applicant’s mark in his current application displays the mark as “SoniStream.” Applicant testified that he “entered it that way” on the drawing page, Campbell Tr. 38:15-19 (69 TTABVUE 41), but that “I don’t want this font and I don’t want it to look like this. I applied this way, as I explained, to give me freedom to choose different styling. But I did not -- I don’t want it to look the way that is shown in this exhibit [2] here” because “it’s rather dated looking.” Campbell Tr. 33:17-21, 23 (69 TTABVUE 36). He testified that he was “going to file a motion to amend” the drawing because he did not “like the way it looks,” and that he was “going to make

the second ‘S’ a small s, lower case,” Campbell Tr. 25:17-26:5 (69 TTABVUE 28-29), but he never amended the drawing.

#### **IV. Opposer’s Entitlement to a Statutory Cause of Action**

“Entitlement to a statutory cause of action, formerly referred to as ‘standing’ by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case.” *Illyrian Import, Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at \*17 (TTAB 2022) (citations omitted); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, an opposer must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)).

On the issue of entitlement to a statutory cause of action, Opposer argues as follows, using the outmoded “standing” nomenclature:

Sony’s registered and common law rights in the SONY mark for overlapping and related/complementary goods establishes the required commercial interest. And because Sony has properly made its pleaded registrations for the SONY mark of record . . . Sony has proven its standing to oppose Applicant’s application. . . . Sony has presented evidence sufficient to prevail on its likelihood-of-confusion claim. Sony has thus proven a real commercial interest in the outcome of this proceeding and a reasonable basis for its belief that it will be damaged by the registration of Applicant’s “SoniStream” mark.

91 TTABVUE 40 (citations omitted). Applicant does not address the issue of Opposer's entitlement to oppose.

As noted above, Opposer made of record USPTO electronic records regarding multiple registrations of its SONY mark for a variety of goods and services showing their current status and title. Opposer's "direct commercial interest and reasonable belief in damage proximately caused by the registration of [SoniStream] are established by Opposer's registrations for [SONY]." *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at \*7 (TTAB 2021) (citing *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (standing may be established where the plaintiff asserts a likelihood of confusion claim "which is not wholly without merit")). Because Opposer has asserted such a claim, it "has proven its statutory entitlement to oppose, which extends to [both] its grounds for opposition." *Id.* See also *N.Y. Yankees P'ship v. IET Prods. and Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (once the opposer established its standing based on its registrations, it had the right to assert its dilution by blurring claim in addition to its likelihood of confusion claim).

#### **V. Opposer's Dilution by Blurring Claim**

Opposer asserts a claim of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), which 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 an injunction 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.

Thus, in order to prevail, Opposer must demonstrate that “(1) it owns a famous mark that is distinctive; (2) Applicant is using a mark in commerce that allegedly dilutes Opposer’s famous mark; (3) Applicant’s use of [his] mark began after Opposer’s became famous; and (4) Applicant’s use of [his] mark is likely to cause dilution by blurring . . . .” *Spotify AB v. U.S. Software Inc.*, 2022 USPQ2d 37, at \*20-21 (TTAB 2022) (citing *N.Y. Yankees P’ship*, 114 USPQ2d at 1502; *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012)).

**A. Does Opposer Own a Famous Mark That is Distinctive?**<sup>18</sup>

“There is no dispute that Opposer’s [SONY] mark is distinctive, both inherently, and by acquisition as a result of widespread use and consumer recognition. Conceptually, it is a coined, fanciful term. It is registered on the Principal Register without a claim of acquired distinctiveness, and is therefore presumed distinctive.” *Id.*, at \*21 (citing *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at \*10 (TTAB 2020)). Here, as in *Spotify*, Applicant “does not dispute that the mark is inherently distinctive.” *Id.* To the contrary, he asserts that “SONY is a 4 letter distinctive fanciful mark that can be instantly recognized and recalled by the general public,” 93 TTABVUE 20, and that SONY “is a very well known distinctive brand that connotes the brand SONY.” *Id.* at 21.

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<sup>18</sup> As discussed above, we focus here on Opposer’s SONY word mark alone.

“As for whether the mark is sufficiently ‘famous’ to be entitled to protection against dilution, we must determine whether 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.’” *Id.*, at \*21 (quoting *N.Y. Yankees P’ship*, 114 USPQ2d at 1502) (quoting 15 U.S.C. § 1125(c)(2)(A)). “In doing so, we consider

- (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.”

*Id.*, at \*22-23 (quoting 15 U.S.C. § 1125(c)(2)(A)). Opposer has the burden of establishing that its SONY mark has become famous. *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2017 (TTAB 2014).

In his Response to Opposer’s Request for Admission No. 13, Applicant admitted that “the SONY mark is famous among the general U.S. public.” 52 TTABVUE 8. Rule 36(b) of the Federal Rules of Civil Procedure provides that “[a] matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended.” Fed. R. Civ. P. 36(b). Applicant never moved to withdraw or amend this admission, and the fact that “the SONY mark is famous among the general U.S. public” is thereby conclusively established.

But we need not rely only on Applicant's admission because the "record evidence bearing on fame [more than amply] supports Applicant's admission that [SONY] is famous and is sufficient to overcome [any] limitations in that admission . . . ." *N.Y. Yankees P'ship*, 114 USPQ2d at 1503. Indeed, Opposer's evidence bearing on the fame of its SONY mark discussed in detail above and summarized below checks all of the boxes for fame under Section 43(c)(2)(A) of the Trademark Act.

### **1. Advertising and Publicity of the SONY Mark**

"Opposer's mark [SONY] has enjoyed extensive publicity since it was introduced to the United States" more than 60 years ago. *Spotify*, 2022 USPQ2d 37, at \*22. Suzuki Decl. ¶ 6 (55 TTABVUE 3). Opposer has advertised and promoted its goods and services to the general public in the United States in multiple business sectors. Suzuki Decl. ¶¶ 3, 7, 10 (55 TTABVUE 2-4). Opposer has extensively advertised and promoted the SONY mark in the United States for over half a century in all varieties of media, and has spent tens of millions of dollars annually for decades. Suzuki Decl. ¶ 40; Ex. 30 (55 TTABVUE 15-17; 56 TTABVUE 246-57). Opposer has also promoted the SONY mark through multimedia marketing campaigns involving well-known athletes, entertainers, and other celebrities, Suzuki Decl. ¶ 43; Ex. 33 (55 TTABVUE 19-20; 56 TTABVUE 269-79), and product placement in numerous motion pictures and television programs. Suzuki Decl. ¶ 46; Ex. 36 (55 TTABVUE 22-25; 58 TTABVUE 2-96). Opposer and its affiliates operating under the SONY mark also have a robust presence on social media. Suzuki Decl. ¶ 41; Ex. 31 (55 TTABVUE 18; 56 TTABVUE 258-63). In short, "[t]he advertising and publicity-related evidence of record is overwhelming." *Spotify*, 2022 USPQ2d 37, at \*22.

## 2. Sales of Goods and Services Under the SONY Mark

Opposer has sold consumer goods under the SONY mark in the United States since at least as early as 1960, Suzuki Decl. ¶ 6 (55 TTABVUE 3), and has offered entertainment-related goods and services since 1989. Suzuki Decl. ¶ 10 (55 TTABVUE 4). Applicant himself first learned of Sony a “[l]ong time ago when I was - - you know, probably in the 1970s,” Campbell Tr. 67: 1-2 (69 TTABVUE 70), and he testified that “stores have been selling Sony products my whole lifetime.” Campbell Tr. 77:10-11 (69 TTABVUE 80).

The SONY mark has been the house mark for iconic products such as the Sony Betamax, the Sony Walkman, and the Sony Playstation sold in the United States for decades. Suzuki Decl. ¶¶ 8-9, 63-65; Ex. 49 (55 TTABVUE 4, 30, 1676-1762; 56 TTABVUE 56-67; 58 TTABVUE 188-207). The SONY mark has also been associated with numerous successful and well-known motion pictures that have collectively grossed many billions of dollars in the United States, Suzuki Decl. ¶ 11 (55 TTABVUE 5-6), as well as with the production, distribution, and sale of musical recordings by a number of prominent artists. Suzuki Decl. ¶¶ 12-14; Exs. 6-9 (55 TTABVUE 6-7; 56 TTABVUE 58-146). In the period between 2013 and 2019 alone, Opposer estimates that it sold more than \$100 billion in goods and services under and in connection with the SONY mark in the United States. Suzuki Decl. ¶ 7; Ex. 2 (55 TTABVUE 3-4, 53-1631).

There is no doubt that many millions of members of the general public in the United States have purchased goods and services sold under and in connection with the SONY mark on one or more occasions. Applicant is one of them, having purchased

a SONY tape recorder, which he used to record his own music. Campbell Tr. 20:9-15 (69 TTABVUE 23).<sup>19</sup>

### 3. Actual Recognition of the SONY Mark

“Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used.” *Spotify*, 2020 USPQ2d 37, at \*24 (quoting *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1104 (TTAB 2018) (quoting *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011)). Based on the record here, “[i]t would be difficult to overstate the extent of public recognition of the [SONY] mark.” *Id.*

As discussed above, Opposer and its SONY mark have received extensive unsolicited media coverage for many years, and the SONY mark has been consistently ranked and recognized as among the world’s leading brands. Beginning in 1988, the SONY mark has been recognized as being in the upper echelon of famous brands in major newspapers such as LOS ANGELES TIMES and THE PHILADELPHIA INQUIRER, and in other leading publications. Suzuki Decl. ¶¶ 58-59, 61; Exs. 44, 47 (55 TTABVUE 28-29; 58 TTABVUE 144-53, 160-81).

The SONY mark has also been ranked consistently in the annual Interbrand list of Best Global Brands as among the top 100 of the world’s leading brands. Suzuki Decl. ¶ 60; Ex. 46 (55 TTABVUE 224-25; 58 TTABVUE 154-59). The Board has held

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<sup>19</sup> Applicant also “worked with Sony consumer products,” Campbell Tr. 20:2-6 (69 TTABVUE 23), and in the 1990s used a Sony stereo microphone. Campbell Tr. 68:14-69:1 (69 TTABVUE 71-72).

on more than one occasion that a mark's appearance on Interbrand's list and in similar listings of top global brands is potent evidence of fame. *Spotify*, 2022 USPQ2d 37, at \*25 (ranking of SPOTIFY mark as No. 92 on the Interbrand list, and other evidence of recognition, supported a finding that the mark "is among the most widely recognized brands in the United States."); *Chanel*, 110 USPQ2d at 2021 (appearance of CHANEL mark on the Interbrand list each year between 2001 and 2009 supported a finding of dilution fame).

The evidence under this factor "leaves no doubt that [SONY] is among the most widely recognized brands in the United States." *Spotify*, 2022 USPQ2d 37, at \*25.

#### **4. Registration on the Principal Register**

As discussed above, Opposer owns multiple valid and subsisting registrations of the SONY word mark on the Principal Register for a variety of goods and services, 36 TTABVUE 15-51, 108-11, the oldest of which issued in 1964, and none of which is based on acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). "[T]his factor also favors a finding of dilution fame." *TiVo Brands*, 129 USPQ2d at 1112.

#### **5. Conclusion Regarding Fame**

All of the relevant fame factors strongly support a finding that "[b]y any and all measures, [SONY] is exceedingly famous, and entitled to protection against dilution under 15 U.S.C. § 1125(c)." *Spotify*, 2022 USPQ2d 37, at \*25.<sup>20</sup>

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<sup>20</sup> Applicant argues that his goods are "targeted toward radio broadcasters," 93 TTABVUE 23, and Dr. Chorn, Applicant's survey expert, noted in connection with her critique of Opposer's likelihood of confusion survey that data from the U.S. Bureau of Labor Statistics reported that "there were only 82,460 people employed in radio broadcasting throughout the

**B. Is Applicant Using a Mark in Commerce That Allegedly Dilutes Opposer's Famous SONY Mark?**

The involved application was filed on April 18, 2018 under Trademark Act Section 1(b) on the basis of Applicant's alleged intention to use the mark in commerce. Applicant testified in his discovery deposition in February 2020 that software bearing the SoniStream mark did not yet exist, Campbell Tr. 43:16-22 (69 TTABVUE 46), that he and his business partner "really kept - - kept the name secret . . . as best we could," Campbell Tr. 16-19 (69 TTABVUE 47), and that the SoniStream product was "not ready yet and it's not being promoted." Campbell Tr. 66:2-3 (69 TTABVUE 69). There is no evidence in the record that the SoniStream mark has ever been used.

The fact that Applicant has not used his mark in commerce is of no moment under this factor. "[A]n application based on intent to use a mark in commerce under Trademark Act Section 1(b) satisfie[s] the commerce requirement." *N.Y. Yankees P'ship*, 114 USPQ2d at 1505-06 (citing *Toro*, 61 USPQ2d at 1174 and *Chanel*, 110 USPQ2d at 2023). Opposer has therefore satisfied the second dilution element. *Id.* at 1506.

**C. Was Opposer's SONY Mark Famous Before Applicant's First Use of SoniStream?**

Because Applicant's application was filed under Trademark Act Section 1(b) based on his intention to use the SoniStream mark in commerce, and because Applicant has

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United States and in the District of Columbia." Chorn Supp. Decl. ¶ 3 (76 TTABVUE 40). Even assuming that the consumers of Applicant's goods are correctly defined as "radio broadcasters," and that their number is tiny relative to the entire U.S. population, they are still members of the general public for purposes of the fame of Opposer's SONY mark.

not sought to prove his actual use of his mark, the mark's date of constructive first use is deemed to be the April 18, 2018 filing date. *Id.* at 1506. On the basis of the record evidence discussed above, there is no question that the required fame attached to Opposer's SONY mark long before April 18, 2018.

**D. Is Applicant's SoniStream Mark Likely to Cause Dilution By Blurring of Opposer's Famous SONY Mark?**

"Dilution by blurring is 'an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.'" *Spotify*, 2022 USPQ2d 37, at \*27-28 (quoting *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B)). "It 'occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, 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 goods emanate from the famous mark's owner.'" *Id.*, at \*28 (quoting *N.Y. Yankees P'ship*, 114 USPQ2d at 1509). The concern addressed by Section 43(c) is "that 'the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Id.* (quoting *Nat'l Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted)). Opposer must prove the likelihood of dilution by blurring by a preponderance of the evidence. *Rsch. in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012).

In the portion of his brief addressed to Opposer's dilution claim, Applicant cites Mr. Hochman's expert testimony that for Applicant's "critical path enterprise software," the "buyer will conduct extensive research and have many conversations

with the seller (as well as shopping competitive products before deciding whether to purchase,” 93 TTABVUE 25 (quoting Hochman Decl. ¶ 4 (76 TTABVUE 47)), and argues that “it’s simply not possible that anyone could confuse us with Sony or that our use of the name SoniStream in direct sales of a product our customers know we produce could impair the distinctiveness of the global brand SONY.” *Id.* This argument is misplaced, however, because “[b]lurring may occur ‘regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.’” *Spotify*, 2022 USPQ2d 37, at \*28 (quoting *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)).

The Trademark Act sets forth the following factors to consider in determining whether Applicant’s SoniStream mark is likely to dilute Opposer’s famous SONY mark by blurring:

- (i) The degree of similarity between the mark . . . 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 its mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark . . . intended to create an association with the famous mark.
- (vi) Any actual association between the mark . . . and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

### **1. The Degree of Similarity Between the Marks**

Under this factor, “[w]e ‘consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression,’” *Spotify*, 2022 USPQ2d 37, at \*29 (quoting *N.Y. Yankees P’ship*, 114 USPQ2d at 1506) (citing *Rsch. in Motion*, 102 USPQ2d at 1198)), to “determine whether Applicant’s mark is sufficiently similar to Opposer’s as to ‘trigger consumers to conjure up’ Opposer’s mark.” *Id.* (quoting *Nike*, 100 USPQ2d at 1030 (quoting *Nat’l Pork Bd.*, 96 USPQ2d at 1497)). “While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists.” *TiVo Brands*, 129 USPQ2d at 1115 (quoting *Nike*, 100 USPQ2d at 1030).

“In the dilution context, ‘the similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.’” *Id.* (quoting *Nike*, 100 USPQ2d at 1029). “Under the 2006 [Trademark Dilution Revision Act (“TDRA”)] amending Section 43(c) of the Trademark Act, the previously enunciated standard requiring ‘substantial similarity’ between the famous mark and the mark at issue is no longer the standard for dilution by blurring; rather, the amended statutory language refers only to ‘degree of similarity.’” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011). Under the TDRA, “Congress did not require an association arising from the ‘substantial’

similarity, ‘identity’ or ‘near identity’ of the two marks.” *Nike*, 100 USPQ2d at 1029 (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 97 USPQ2d 1947, 1958 (9th Cir. 2011) and citing *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769 (2d Cir. 2009) and *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 94 USPQ2d 1188, 1201 n.18 (2d Cir. 2010)).

The parties vigorously disagree about the similarity of the SONY and SoniStream marks, primarily in the context of Opposer’s likelihood of confusion claim. 91 TTABVUE 46-50; 93 TTABVUE 3, 5-10, 20-22, 24; 94 TTABVUE 13-17.<sup>21</sup> In the portion of its brief devoted to its dilution claim, Opposer argues simply that “the SONY and ‘SoniStream’ marks are substantially similar for dilution purposes, as the descriptive word ‘Stream’ is simply not sufficient to distinguish the parties’ marks especially given Sony’s music streaming services.” 91 TTABVUE 56. Applicant does not directly address the similarity of the marks factor in his discussion of Opposer’s dilution claim, 93 TTABVUE 25, but concludes in his discussion of Opposer’s likelihood of confusion claim that Opposer’s “arguments that the marks ‘SoniStream’ [and] ‘SONY’ have the same appearance depend upon their unproven pronunciation and product relatedness claims above,” that Opposer’s “argument that the SoniStream and SONY marks have the same commercial impression also depends upon their unproven pronunciation claim above,” and that “that the available

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<sup>21</sup> We reiterate that in addressing the parties’ arguments, we are not analyzing whether Applicant’s mark is sufficiently similar to Opposer’s mark to cause consumers of the goods identified in the involved application to believe mistakenly that those goods originate with, or are sponsored or authorized by, Opposer, but rather whether the marks are sufficiently similar that a consumer exposed to Applicant’s mark will conjure up Opposer’s famous mark. *Spotify*, 2022 USPQ2d 37, at \*29.

evidence shows the mark ‘SoniStream’ differs significantly with ‘SONY’ in its appearance, sound, connotation and commercial impression, so it is not similar to SONY.” *Id.* at 24.

“While we must consider Applicant’s mark[] [SoniStream] as the public views [it], that is, in [its] entirety, one feature of a mark may make a greater impression on the public’s awareness than another portion, and thus for rational reasons, we may consider that dominant portion to be more significant than another.” *TiVo Brands*, 129 USPQ2d at 1116. “It is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark.” *Id.* (citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Applicant’s mark consists of what he called “the ‘Soni’ part, and ‘Stream’ . . . .” Campbell Tr. 28:23 (69 TTABVUE 31). He testified that he “wanted a name that would be suggestive enough of what the product did, but not so specific that we couldn’t expand on the product.” Campbell Tr. 27:20-22 (69 TTABVUE 30). He selected the “Soni” part of the mark “[b]ecause it suggests sound, sonic.” Campbell Tr. 29:2-4 (69 TTABVUE 32). He testified that “Soni” “really came from ‘SonicStream,’” which was “abrupt” and “also descriptive,” Campbell Tr. 28:5-7 (69 TTABVUE 33), something which he claimed he knew “intuitively” when he selected his mark. Campbell Tr. 111:11-17 (69 TTABVUE 114).

With respect to “stream,” Applicant testified that he wanted to “describ[e] something that would schedule music, schedule commercials, and play the audio,” Campbell Tr. 95:9-11 (69 TTABVUE 98), and that he thought that “‘stream’ would

accomplish all of that and - - well, it sounds streaming.” Campbell Tr. 95:11-13 (69 TTABVUE 98). “Stream” was “the closest thing [he] could find that was related to sound and radio.” Campbell Tr. 28:1-3 (69 TTABVUE 31).

Applicant testified that he “didn’t know at all about descriptive versus suggestive at all until recently,” Campbell Tr. 111:17-19 (69 TTABVUE 114), but his self-styled intuitive conclusion that “Soni” is suggestive of the goods identified in his application, while “Stream” is descriptive of them, supports a finding that “[a]s the first portion of Applicant’s mark[ ], the term [Soni] is more likely to be recognized and impressed upon a consumer than the [descriptive] suffix[] [Stream].” *TiVo Brands*, 129 USPQ2d at 1115 (finding that the words TAPE and BAR in the applicant’s marks TIVOTAPE and TIVOBAR “describe[d] the shape of the lighting products identified by the respective marks,” *id.*, and that “consumers are less likely to focus on the descriptive portions of Applicant’s marks and instead would regard the first distinctive term TIVO as dominating the commercial impression conveyed by Applicant’s marks.”) (citations omitted). For the reasons discussed immediately above, we find that “Soni” is the dominant portion of Applicant’s mark and have given greater weight to “Soni” than to “Stream” in comparing Applicant’s SoniStream mark in its entirety to Opposer’s SONY mark.

We begin with the degree of similarity of the marks in appearance. Opposer argues that “[w]hen comparing the SONY mark with Applicant’s ‘SoniStream’ mark, the marks are strikingly similar in both appearance and sound” because Opposer’s mark

SONY and the Soni-element of Applicant’s mark differ only by the presence of an “I” rather than a “Y” in Applicant’s mark. 91 TTABVUE 48.

Applicant responds that

“SoniStream” and “Sony” in fact share only the combining form “SON-” which is used at the start of the names at least 28 other products and/or brands—usually for products related to sound. . . . These brands include consumer brands such as Sonus, Sonist and Sonicare which is used by over 30 million consumers in the US alone . . . . The prefix “SON-” therefore couldn’t be argued to be associated with any particular brand. In addition, SoniStream is [a] 10 letter suggestive mark and SONY is a 4 letter distinctive fanciful mark that can be instantly recognized and recalled by the general public.

93 TTABVUE 20. He cites Mr. Hochman’s testimony that “[t]he prefixes Soni-, Sona- and Sono- are widely used in online marketing by numerous brands with products related to sound,” including the ones shown below



that “[m]any of these brands are orders of magnitude more prominent than [Applicant’s company] Music1,” and that “[t]hese prefixes are used to form suggestive brand names because these prefixes help to define what the product is or does (i.e. something related to sound).” Hochman Decl. ¶¶ 7-8; Ex. C (76 TTABVUE 48, 12-84).

Applicant further argues that

Sony wants to be considered very famous by the Board to urge the Board to tolerate even a small amount of

similarity between “SoniStream” and “Sony” [and] Sony is in effect arguing that a person seeing the “SoniStream” mark will forget the spelling of their four-letter famous mark seen on consumer products over the last forty years.

*Id.* at 21.

Opposer has registered its SONY word mark in a “typed drawing,”<sup>22</sup> in standard characters, and in the stylized form shown below:

**SONY**

36 TTABVUE 15-51, 108-11.

Applicant seeks registration of SoniStream in standard characters and a standard-character mark “may be presented in any font style, size or color,” *Sabhnani*, 2021 USPQ2d 1241, at \*34 (quoting *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018)),<sup>23</sup> including any such display “that minimizes the differences or emphasizes the similarities between the marks.” *Id.* (quoting *Anheuser-Busch, Inc. v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015)).

Despite Applicant’s standard character claim, the drawing of his mark displays it as follows:

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<sup>22</sup> “Prior to November 2, 2003, ‘standard character’ drawings were known as ‘typed drawings’ . . . . A typed drawing is the legal equivalent of a standard character mark.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*2 n.2 (TTAB 2019) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1258 n.2 (Fed. Cir. 2010)).

<sup>23</sup> Consistent with these principles, Applicant testified that he thought that by applying for registration in standard characters, he “would be free to stylize - - like different colors, like give italics to ‘Stream’ or something by - - doing this,” Campbell Tr. 26:24-27:2 (69 TTABVUE 29-30), and that he “applied this way . . . to give [him] freedom to choose different styling.” Campbell Tr. 33:18-20 (69 TTABVUE 36).

## SoniStream

As noted above, the appearance of the mark in this manner in the drawing “does not change the nature of the mark from standard character to special form,” *New Era*, 2020 USPQ2d 10596, at \*2 n.1, but it does illustrate that Applicant’s mark may be displayed in a manner that separates the dominant word “Soni” from the word “Stream” through the use of the uppercase letters “S” with the remaining letters in lowercase. We must also assume that Applicant may display the word “Soni,” or both portions of his mark, in the same font in which Opposer’s stylized SONY word mark appears above.<sup>24</sup> Each of these displays “minimizes the differences [and] emphasizes the similarities between the marks” in appearance. *Sabhnani*, 2021 USPQ2d 1241, at \*34. While there are some visual differences between the marks, “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. That is, consumers encountering Applicant’s mark will immediately be reminded of Opposer’s famous [SONY] mark and associate the two.” *N.Y. Yankees P’ship*, 114 USPQ2d at 1507.<sup>25</sup>

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<sup>24</sup> As discussed above, Applicant claimed that the display of his mark as “SoniStream” in the drawing was in error and that he intended to amend the drawing to display the mark as SONISTREAM and to use it that way when the product is introduced. Campbell Tr. 26:13-27:5; 33:16-34:1; 37:18-38:19 (69 TTABVue 29-30, 36-37, 40-41). Applicant’s intentions in this regard are irrelevant to our analysis of the degree of similarity of the marks. We must assume that his standard-character mark could be displayed in the manners discussed above regardless of how it might appear in any amended drawing or how he might intend to use it.

<sup>25</sup> Applicant’s argument that the fame of the SONY mark will make it more, not less, likely that consumers will be able to distinguish the Soni- prefix in Applicant’s mark is contrary to Federal Circuit precedent. *Cf. Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992) (stating that “this court has consistently afforded strong marks a wider latitude of legal protection than weak marks,” and noting that its earlier decision in *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6

The similarity or dissimilarity of the sound of “Sony” and the dominant word “Soni” in Applicant’s mark gets most of the parties’ attention. They dispute whether “Soni” is likely to be pronounced “sew-knee,” like Opposer’s mark, with a long “e” sound (ē) as in the name “Tony” and the word “pony,” making Applicant’s mark as a whole sound like “Sonystream,” or “saw-ně,” “exactly as it is pronounced in the word sonic.” Campbell Tr. 34:17-18 (69 TTABVUE 37).

Opposer characterizes “Soni” as the phonetic equivalent of “Sony,” 91 TTABVUE 48, and argues that

[t]he identical pronunciation of SONY and the “Soni” portion of Applicant’s mark is further borne out by the expert testimony from Prezeau and Zhang. As they both testified, a significant portion of the U.S. public is likely to pronounce the “SoniStream” mark as “SONYstream.” Specifically, Prezeau testified regarding U.S. speakers of Spanish, French, Italian, and Portuguese, while Zhang testified regarding U.S. speakers of Chinese, Korean, and South Asian languages. . . . Together, such groups amount to over 50 million people in the United States, or approximately 15% of the U.S. population. . . .

*Id.* at 49 (citations omitted). Opposer does not directly address how the other 85% of the U.S. public that does not belong to one of these linguistic cohorts will pronounce Applicant’s mark beyond arguing that “Soni” is equivalent to “SONY” because “I” and “Y” are functionally the same. *Id.* at 48-49.

Applicant testified that he “simply removed the c from the word sonic to produce this - - this mark,” Campbell Tr. 34:18-19 (69 TTABVUE 37), such that “SoniStream”

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USPQ2d 1719, 1721 (Fed. Cir. 1988), which stated that the “better known [a mark] is, the more readily the public becomes aware of even a small difference,” “was confined to the facts of that case” to “the extent that it treats fame as a liability . . .”).

will be pronounced in the same manner as “Sonicstream” but without the “c,” and that he “will show that Sony’s evidence (the pronunciation survey by Mingshu Ziang [sic], and the pronunciation predictions of Jasmine Prezeau) could at most imply that 2.5% of the U.S. population would be likely to pronounce ‘SoniStream’ similarly to or nearly the same as ‘SONY-stream.’” 93 TTABVUE 3. He takes a deep dive into the testimony of Opposer’s linguists and the U.S. Census Bureau data regarding the percentages of the U.S. population that speak languages other than English at home. *Id.* at 5-9.

Applicant also argues that as to members of the United States public who speak only English, “Sony has provided no survey evidence or even examples of the pronunciation of SoniStream by consumers,” *id.* at 9, while he has provided

15 YouTube videos in which you can hear the pronunciation by Americans of other marks beginning [sic] with the SONI- prefix . . . . In all of these the “o” and “i” in the SONI- prefix are both pronounced short as they are in “sonic”—not l[ong] “o” and a long “e” as in SONY. The most significant of these similar marks which all share the SONI- prefix SoniStream uses are: Sonicare and Sonifresh—products which are used by 30 million consumers in the US. . . . Since I have produced evidence showing consumers consistently *do not* pronounce the SONI- prefix like SONY, and Sony has presented no survey or even example evidence that consumers in the US *do* pronounce the SONI- prefix like SONY (e.g., showing americans [sic] pronouncing Sonicare “Sony Care”), the available evidence does not support Sony’s phonetically-based pronunciation predictions for SoniStream so they should be rejected as well . . . .

*Id.*<sup>26</sup>

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<sup>26</sup> As noted above, we have reviewed the videos, and we discuss their probative value below.

Drawing an analogy to likelihood of confusion case law, Applicant relies on *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649 (Fed. Cir. 2014), for the propositions that “[t]here is no correct pronunciation of a trademark that is not a recognized word” and that “[w]here a trademark is not a recognized word and the weight of the evidence suggests that potential consumers would pronounce the mark in a particular way, it is error for the Board to ignore this evidence entirely and supply its own pronunciation.” 93 TTABVUE 9 (quoting *StonCor*, 111 USPQ2d at 1651). He concludes that “the evidence Sony has provided could at most imply that 2.4% of the US public would be expected to pronounce ‘SoniStream’ similarly or nearly the same as ‘SonyStream’,” *id.* at 21, but that “other words or marks that contain the prefix ‘Soni’ followed by two consonants or one ending consonant is [sic] consistently pronounced as in ‘sonic’, ‘supersonic’, ‘ultrasonic’, ‘sonics’, ‘sonically’, ‘Sonist’, ‘Sonicare’, ‘SoniGuard’, ‘Sonifex’ and others.” *Id.*

In its reply brief, Opposer argues that more than 50,000,000 people in the United States who speak the Romance or Asian languages discussed by Opposer’s experts are “likely to pronounce ‘SoniStream’ as ‘SONY-stream,’” 94 TTABVUE 13, and that

the various YouTube videos submitted by Campbell have [no] relevance to the likely pronunciation of “SoniStream”, as such videos involve the pronunciation of different marks which are governed by different phonological and orthographic rules (i.e., SONICARE, SONIFRESH, SONISOFT, SONISHARE, SONIBLE, SONIFEX, and SONISPHERE). For instance, with respect to SONICARE, the pronunciation of this mark is likely driven by the presence of the word “sonic,” especially since the underlying product (an electric toothbrush) contains

“sonic” technology. Various other videos concern replacement heads for SONICARE toothbrushes, which may also contribute to the pronunciation of those marks (i.e., SONIFRESH, SONISOFT, and SONISHARE). That said, the two videos concerning SONISOFT actually pronounce the mark as “SONY-soft” and accordingly do not support [Applicant’s] argument. The video concerning SONIST also pronounces this mark as “SO-nist”.

*Id.* at 14-15.

We agree with Applicant that there is no “correct” pronunciation of a mark, such as SoniStream, that is not a recognized word in United States English, and we thus must consider “all the reasonable possibilities” for the pronunciation of SoniStream. *Cf. Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.19 (TTAB 2014) (finding that the marks IKEA and AKEA had “similarities in the way they sound (ī key ā vs. ā key ā).”). In that regard, as explained above, we must assume that Applicant’s mark could be displayed as “SoniStream,” as it appears in his drawing, which would highlight the dominant “Soni-” prefix and separate it from the “-Stream” suffix.

Based on common pronunciations of the letters “i” and “y” in United States English, it is plausible that the letter “i” in Applicant’s SoniStream mark may be pronounced as a long “e” (ē), making Applicant’s mark as a whole sound like “SonyStream.” *Cf. Citigroup Inc. v. Capital City Bank Grp.*, 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (noting that the words CITI and CITY in the opposer’s CITIBANK-formative family of marks and in the applicant’s CAPITAL CITY BANK marks were aurally identical, but affirming the Board’s finding under Section 2(d) that the identity of the words in sound was outweighed by the “distinctive

spellings of the marks at issue, third-party usage of the phrase ‘City Bank’ in the financial services industry, and the role of the word ‘Capital’ in distinguishing [the applicant’s] marks from Citigroup’s marks”) (citing *Citigroup Inc. v. City Holding Co.*, 171 F. Supp. 2d 333, 345 (S.D.N.Y. 2001)); *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1646 (TTAB 2009) (marks CYNERGY and SYNERGIE found to be “highly similar, if not identical, phonetic equivalents.”).

Applicant acknowledged that “there might be a few people who pronounce” “Soni” as “Sony,” Campbell Tr. 35:2-4 (69 TTABVUE 38), and there is nothing in the record to suggest that the pronunciation of his mark as “SonyStream” is not at least a reasonable possibility. In the *StonCor* case that Applicant cites, the opposer provided testimony regarding the pronunciation of its mark STONSHIELD as the phonetic equivalent of STONESHIELD by its sales force, which marketed its products directly to prospective consumers. *StonCor*, 111 USPQ2d at 1661. Here, Applicant has offered no evidence of how his mark has actually been pronounced by consumers, or that he or others have pronounced it to prospective consumers as “saw-ně-stream” to condition them to pronounce it in that manner, as he testified that “I did not mention the name to anyone who’s in the business especially, in any business, any kind of business, especially technology business.” Campbell Tr. 44:13-16 (69 TTABVUE 47).

Instead, he cites 15 videos in which persons pronounce other marks, including “Sonicare,” a brand of electric toothbrush, and “Sonifresh” and “Sonisoft,” brands of

replacement brush heads for the Sonicare toothbrush.<sup>27</sup> For the reasons discussed below, even if the videos have some probative value in identifying all the reasonable possibilities for the pronunciation of the marks verbalized in the videos, they have no probative value in excluding “SonyStream” from the list of all the reasonable possibilities for the pronunciation of Applicant’s SoniStream mark.

The videos involve the pronunciation of the mark Sonicare by a handful of people, the pronunciation of the mark Sonisoft by two people (one of whom sounds like she is pronouncing it as “Sonysoft”), and the pronunciation of the mark Sonifresh by one person. The pronunciation of another mark for a replacement brush head for the Sonicare toothbrush is indecipherable. With respect to marks for other goods, the Sonibel mark is pronounced by two people, and the Sonifex, Sonisphere, Sonist, Soniguard, and Sonitrol marks are pronounced by one person each. Viewed as the functional equivalent of surveys of how the respective marks might be pronounced by United States consumers, in the nature of the survey offered by Opposer’s expert Mingsu Zhang discussed below, Applicant’s single-digit “samples” are so miniscule as to make it impossible to draw any conclusions about all the reasonable possibilities for the pronunciation of the respective marks. *Cf. Anheuser-Busch*, 115 USPQ2d at 1830-32 (concluding that the results of a sample of 201 respondents in a likelihood of confusion survey were “probative, although not strong, evidence that confusion is likely,” but noting that “at some point, a small sample may provide results potentially

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<sup>27</sup> Video Nos. 2-4 are the same “unboxing” video for Sonifresh replacement brush heads for the Sonicare toothbrush, so there are actually only 13 different videos.

so low or so imprecise as to be of little or no value in inferring the rate of confusion among all relevant consumers.”).<sup>28</sup>

There are additional reasons why the videos are not probative of all the reasonable possibilities for the pronunciation of the other marks, much less of all the reasonable possibilities for the pronunciation of SoniStream. None of the other marks display the “Soni-” prefix in the manner in which it appears in Applicant’s SoniStream mark.<sup>29</sup> Almost half of the videos involve the Sonicare toothbrush,<sup>30</sup> and the word “sonic” is actually present in the telescoped mark **Sonicare**, which combines “sonic” and “care,” and which is promoted as involving “sonic technology.” A telescoped mark like Sonicare is presumed to be read by consumers as the combination of the telescoped terms, and it is thus unlikely that a consumer would pronounce the Sonicare mark other than as “Sonic Care.” See *In re Greenliant Sys., Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010) (finding that “[w]hen the terms NAND and drive are

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<sup>28</sup> Ms. Zhang conducted a “survey of 77 Asian Americans in my professional and personal networks in the United States to gather empirical data on how the term ‘SoniStream’ is likely to be pronounced by Asian Americans” and reported that “[o]f the 77 participants, 36 (or approximately 47%) responded that they would pronounce the trademark as /səunistri:m/ (similar to ‘SonyStream)’.” Zhang Decl. ¶¶ 6, 12 (39 TTABVUE 3). Ms. Zhang did not show that she has any expertise in conducting surveys, her sample was obviously not randomly selected, and it consisted of 77 persons, a size much greater than Applicant’s “samples,” but still too small to yield any meaningful results even if her survey otherwise followed accepted protocols. *Anheuser-Busch*, 115 USPQ2d at 1830-32. We have given her testimony no consideration in our analysis of all the reasonable possibilities for the pronunciation of SoniStream.

<sup>29</sup> The same is true for the multiple “Soni-” formative marks listed in Exhibit C to Mr. Hochman’s Declaration. Hochman Decl. ¶ 7; Ex. C (67 TTABVUE 6, 86-87).

<sup>30</sup> Video No. 1 is a commercial for the Sonicare toothbrush, and five other videos are unboxing or product demonstration videos for replacement brush heads for the toothbrush (Nos. 2, 5-7, and 10).

combined into the compressed term NANDRIVE, the mark is equivalent in sound and meaning to the individual terms.”). We agree with Opposer that it is not surprising that consumers would also pronounce the prefix Soni- in the marks Sonifresh and Sonisoft in the same manner as in the mark Sonicare because the replacement heads sold under the latter marks are used with Sonicare electric toothbrushes.

We cannot find, on the basis of the pronunciation of marks other than SoniStream by a handful of people, that consumers would invariably pronounce Applicant’s SoniStream mark as “Saw-ně-stream” and not as “SonyStream,” and that the latter pronunciation is not one of the reasonable possibilities for the pronunciation of Applicant’s mark.

Our conclusion is buttressed by the testimony of Opposer’s linguist Jasmine Prezeau. “Generally we find it unnecessary to rely upon linguistics experts to tell us how marks are pronounced,” *Rsch. in Motion*, 102 USPQ2d at 1193 n.19 (citations omitted), but Applicant did not object to Ms. Prezeau’s testimony and addressed it on the merits. She opined, based on her fluency in English, French, Italian, Spanish, and Portuguese, that “there is no discernable difference in pronunciation between ‘SoniStream’ and ‘SonyStream’” among native speakers of French, Italian, Spanish, and Portuguese, including U.S.-based speakers of Spanish, French, Italian and Portuguese who are also proficient in English. Prezeau Decl. ¶¶ 1, 8, 12 (40 TTABVUE 4, 6).<sup>31</sup> She further opined that “the short ‘o’ that is represented by the

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<sup>31</sup> We find that Ms. Prezeau is qualified by virtue of her knowledge, experience, training, and education as an interpreter, translator, and editor to offer expert opinions regarding the way in which the word “Soni” would be pronounced by U.S.-based speakers of French, Italian, Spanish, and Portuguese, including those who are also proficient in English. Prezeau Decl.

letter ‘o’ in the American English words ‘mop,’ ‘pot,’ ‘sock,’ ‘**sonic**,’ ‘dolphin,’ or ‘box’ is not a letter-sound relationship that exists within the phonemic orthography of French, Italian, Portuguese, and Spanish,” and that “[i]n order for the ‘o’ in ‘Soni’ to be pronounced similar to the ‘o’ in sonic, it would have to be written out as an ‘a’ (or, depending on the surrounding letters, another vowel or combination of vowels) for speakers of French, Italian, Portuguese, and/or Spanish—never as an ‘o.’” Prezeau Decl. ¶ 15 (40 TTABVUE 7) (emphasis added). She testified that “[i]n the case of variant capitalizations utilized in ‘SoniStream’ (e.g., Sonistream, sonistream, SONISTREAM, etc.), my opinions with respect to pronunciation as indicated above would not change.” Prezeau Decl. ¶ 16 (40 TTABVUE 8). She “conclude[d] that the vast majority of these individuals, when exposed to the word ‘SoniStream,’ will hear it as synonymous with ‘SonyStream.’ In other words, the two will be taken to have the same sound and, thus, imply the brand ‘Sony.’” Prezeau Decl. ¶ 18 (40 TTABVUE 8).

Applicant attacks Ms. Prezeau’s testimony only “about the pronunciation of SoniStream and SonyStream among U.S. Spanish and English speakers.” 93 TTABVUE 8. He argues that

the use here of only phonetics to construct a predicted pronunciation has produced a Spanish pronunciation for Sony where the o sound is very close to the American English pronunciation of “ah” which is very different than the long “oh” sound always used in Sony’s own pronunciation of “Sony” in their advertising in the U.S. over the last fifty years, and which contradicts Sony’s own

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¶¶ 2-7; Ex. A (40 TTABVUE 2-3, 11-13). See Fed. R. Evid. 702; *Kohler Co. v. Honda Giken K.K.*, 125 USPQ2d 1468, 1483-85 (TTAB 2017).

statement about the pronunciation of their name on page 18 of the Notice of Opposition: “Sony selected the SONY mark for its simple pronunciation that is the same in any language.” In short, Ms. Prezeau’s claim that the Spanish pronunciation of SoniStream is indistinguishable from SonyStream (or “corriente de Sony”) is supported primarily by comparing the phonetically correct Spanish pronunciation of SoniStream with the phonetically correct Spanish pronunciation of Sony which: 1. Is not consistent with Sony’s pronunciation of their name in their advertising. 2. Contradicts Sony’s own statement that the pronunciation of their name is “the same in any language.”—which would include Spanish and English. 3. Is not supported by survey evidence demonstrating that any Spanish speakers in the U.S. actually pronounce “Sony” in the manner predicted by the Spanish phonetics.

*Id.*

Applicant further argues that

In describing the third basis for her predictions Ms. Prezeau states that “Such prevalence” [of the Sony brand] “can in many cases contribute to the verbal pronunciation of “SoniStream” and “SonyStream” being the same or phonetically indistinguishable among U.S. speakers of French, Italian, Portuguese, and/or Spanish.

In this statement Ms. Prezeau appears confident that the pronunciation of SONY will affect the pronunciation Soni- but not the pronunciation of SONY itself among Spanish speakers in the US because her phonetically and orthographically-based Spanish pronunciation of Sony doesn’t sound like the English pronunciation of Sony used in Sony’s own advertising in the US, or the Spanish pronunciation which Sony states is the same.

She also states her conclusion applies to English-bilingual Spanish speakers [sic] but since her conclusion is absolutely definitive (the pronunciation of “SoniStream” and “SonyStream” are “indiscernible”), she provides no quantitative evidence that she has taken into account the fact that 56.8% of Spanish speaklers [sic] report being *proficient* in English in the 2017 American Community

Survey (footnote 8 of the “Languages of the United States” Wikipedia article referenced above).

In regard to the statistic that [sic] 56.8% of Spanish speakers [sic] report being proficient in English, it is surprising that Ms. Prezeau has given no weight to the influence that English pronunciation patterns would have on the pronunciation of SoniStream by US-based Spanish speakers.

The most pertinent English pronunciation pattern in this case is how an I at the end of a word that is pronounced long (like Eye or Be) is usually pronounced short (like It) when followed by two or more consonants. Examples of this are Mini / Minimal, Multi / Multiple, and Omni / Omnipotent.

If Ms. Prezeau’s phonological arguments correctly predicted actual pronunciation of SoniStream by U.S. Spanish speakers then Sony would easily have been able to produce a survey of Americans [sic] which would have yielded 14% of the respondents pronouncing “SoniStream” exactly the same as “SonyStream”. Why they didn’t do that is inexplicable.

*Id.* at 9-10.

We agree with Opposer that Applicant’s arguments here are “both incoherent and ignore[] the phonological and orthographic rules set forth in Prezeau’s report.” 94 TTABVUE 14. Applicant did not offer expert linguists of his own, and he testified that he has “no formal education in linguistics,” Campbell Tr. 9:18-19 (69 TTABVUE 12), and speaks no foreign languages. Campbell Tr. 9:22-23 (69 TTABVUE 12). As discussed above, Ms. Prezeau testified without contradiction that the short “o” sound (as in “sonic”) on which Applicant’s argument relies “is not a letter-sound relationship that exists within the phonemic orthography of” Spanish, and that “o” would never

be pronounced “as to resemble the wide-mouthed short ‘o’ of ‘sonic’ that is phonetically transcribed as [‘sanik].” Prezeau Decl. ¶ 15 (40 TTABVUE 7).

We find that Ms. Prezeau’s testimony is sufficient to establish that most speakers of Spanish and the other referenced Romance languages in the United States, including speakers of these languages who are also proficient in English, are likely to pronounce the word “Soni” in the mark “SoniStream” in the same manner as Opposer’s mark. The ways in which members of these linguistic groups are likely to pronounce “Soni” have relevance, as the Board has “consistently found that Spanish is a ‘common language’ in the United States,” *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at \*7 (TTAB 2019), and Applicant acknowledges that the members of U.S. population who speak Spanish or the other referenced Romance languages amount to about 45,000,000 people, or around 15% of the U.S. population. 93 TTABVUE 7.

The record as a whole establishes that while “SonyStream” is certainly not the only possible pronunciation of “SoniStream,” and may not even be the most likely one, it is at least among “all the reasonable possibilities” for its pronunciation, and we must consider it in our analysis of the similarity of the marks in sound. *Inter IKEA Sys.*, 110 USPQ2d at 1740 n.19. The pronunciation of Applicant’s “SoniStream” mark as “SonyStream” would instantly “trigger consumers to conjure up” Opposer’s famous SONY mark. *Spotify*, 2022 USPQ2d 37, at \*29 (citation omitted).

Applicant’s arguments against the similarity of the marks in connotation and commercial impression are all based on their claimed dissimilarity in appearance and

sound. 93 TTABVUE 22. As discussed above, the marks are sufficiently similar in both appearance and sound to cause consumers to conjure up Opposer's famous SONY mark, and the meaning of the word "stream" in Applicant's mark SoniStream does not make that any less likely. To the contrary, Applicant testified that the word "sounds streaming," Campbell Tr. 95:12-13 (69 TTABVUE 98), and Opposer has offered a variety of streaming services under and in connection with the famous SONY mark, Suzuki Decl. ¶¶ 34-39 (55 TTABVUE 13-15), and has registered the mark for "providing downloadable streaming and wireless entertainment content in the nature of audiovisual works, motion pictures, trailers, television programming, music and games by means of an interactive global computer and communications networks." 36 TTABVUE 43 (Registration No. 4938522). The presence of the suffix "-Stream" in Applicant's SoniStream mark may actually increase the likelihood that the mark as a whole will conjure up the famous SONY mark because Applicant's mark may evoke the music and entertainment streaming services offered under the mark. *Cf. Spotify*, 2022 USPQ2d 37, at \*32 ("Because the marks SPOTIFY and POTIFY are used for software products that perform analogous functions, and are so similar in appearance and sound, their commercial impressions are similar even if consumers take different meanings from SPOT and POT.").

We have found above that "the appearance of the marks overall is sufficiently similar that Applicant's mark will 'trigger consumers to conjure up' Opposer's famous mark. That is, consumers encountering Applicant's mark will immediately be reminded of Opposer's famous [SONY] mark and associate the two." *N.Y. Yankees*

*P'ship*, 114 USPQ2d at 1507. We also find that the marks are sufficiently similar in their entireties in sound, meaning and commercial impression “that Applicant’s mark will ‘trigger consumers to conjure up’ Opposer’s famous [SONY] mark. This weighs in favor of finding dilution by blurring.” *Id.*

## **2. The Degree of Distinctiveness of the SONY 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.” *NASDAQ Stock Mkt. Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 2003). “The more inherently distinctive and memorable the mark, the more it is likely 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 uses of identical or similar marks.” *Chanel*, 110 USPQ2d at 2025 (internal citation omitted).

“As explained throughout this decision, Opposer’s [SONY] mark is nothing if not distinctive. It is coined, fanciful, registered on the Principal Register without a disclaimer or resort to Section 2(f) of the Act, and is among the most highly recognized marks in the United States.” *Spotify*, 2022 USPQ2d 37, at \*22. “This factor also weighs in favor of finding dilution by blurring.” *Id.*

## **3. The Extent to Which Opposer is Engaging in Substantially Exclusive Use of Its SONY Mark<sup>32</sup>**

As discussed above, Opposer provided unchallenged evidence that it has used its SONY mark in the United States for more than 60 years, and that it has controlled

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<sup>32</sup> Applicant’s arguments pertaining to third-party uses of “Soni-” formative marks are misplaced in the dilution context. The statutory text requires to us to determine the exclusivity of Opposer’s use of **its** mark. By contrast, in assessing the impact of third-party

use of that mark through extensive licensing. *See Chanel*, 110 USPQ2d at 2025 (discussing the opposer’s licensing of its famous CHANEL mark). “On this record, [Opposer] has shown that it engages in substantially exclusive use of the mark [SONY] with respect to competitive, as well as non-competitive goods and services. The evidence does not show the term [SONY] alone used as a mark by others.” *TiVo Brands*, 129 USPQ2d at 1116. “[T]his dilution factor favors Opposer.” *Id.*

#### **4. The Degree of Recognition of Opposer’s SONY Mark**

The evidence discussed above establishes that Opposer’s SONY mark is among the most widely recognized marks in the United States. “This factor weighs heavily in favor of finding dilution by blurring.” *Spotify*, 2022 USPQ2d 37, at \*34.

#### **5. Whether Applicant Intended to Create an Association With Opposer’s SONY mark**

Applicant argues that

I created the name SoniStream from “sonic” and “stream” with the intention to suggest the functionality of a completely integrated radio broadcast system including music scheduling, commercial scheduling/billing, and audio playout. . . . I had no intention of constructing a name that sounded like any other company; quite the opposite: I wanted to create a unique mark to build a brand. I believe I achieved that and was surprised and dismayed when I received a letter in July 2018 from the Trademark Office that Sony was opposing my registration. Coming off as another company wuld [sic] be against my ethics and business interests so I hope, when deciding the claim of dilution by blurring, the Board will consider the fact that I have no intention to create an association with SONY. . . . Coming off as another company would be against my ethics and business interests so I hope, when deciding the claim

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marks on the strength or weakness of a plaintiff’s mark on a Section 2(d) claim, the relevant inquiry is the “number and nature of **similar** marks in use on similar goods.” *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (emphasis added).

of dilution by blurring, the Board will consider the fact that I have no intention to create an association with SONY.

93 TTABVUE 25. He asks the Board to “read my sworn testimony on this on p. 29 of my Feb 2020 deposition (69 TTABVUE):

The music and program scheduler, the traffic scheduler and billing system, which is the second piece, and the playout system, I wanted to build a product that would do three things and I wanted to come up with a name that would describe that. And that name would not be “playout,” would not be “scheduler.” It would have to be something more vague but suggestive of what it’s about. It’s about sound. That’s the “Soni” part, and “Stream,” that’s about broadcasting.

*Id.* (citing Campbell Tr. 28:15-24 (69 TTABVUE 31)).

We have reviewed this testimony and Applicant’s other testimony regarding the origin of his mark. Campbell Tr. 27:8-28:8; 28:15-32:10; 34:2-35:6; 36:16-25; 55:23-24; 56:7-11; 65:3-4; 72:8-9; 76:20-77:4; 80:10-11, 20:21; 84:6-7; 95:4-14; 102:9-12; 111:11-112:2, 5-19 (69 TTABVUE 30-35, 37-39, 58-59, 68, 75, 79-80, 83, 87, 98, 105, 114-15). Applicant’s explanation of the selection and adoption of his SONISTREAM mark is entirely credible, and we find that he did not intend to associate his mark with Opposer’s SONY mark. As a result, “this dilution factor is neutral.” *TiVo Brands*, 129 USPQ2d at 1117.

**6. Any Actual Association between Applicant’s SoniStream Mark and Opposer’s SONY Mark**

As discussed above, there has been no use of Applicant’s mark, or public exposure of it. The Board has “found that where an application challenged on the ground of dilution is based on an intent to use and the applicant has not engaged in any actual use of the junior mark, it is impossible to present any evidence of actual association

between the marks in the marketplace,” but that this “does not preclude a finding of dilution when the balance of dilution factors weighs in favor of such a finding.” *Spotify*, 2022 USPQ2d 37, at \*36 n.17 (quoting *Nat’l Pork Bd.*, 96 USPQ2d at 1498). “Indeed, we have found dilution in several cases despite there being no evidence of actual association, when the balance of the dilution by blurring factors in 15 U.S.C. § 1125(c)(2)(B)(i-vi) weighed in favor of finding dilution.” *Id.* (citing *TiVo Brands*, 129 USPQ2d at 1117-18; *N.Y. Yankees P’ship*, 114 USPQ2d at 1509-10, 1512; *Nike*, 100 USPQ2d at 1030-32). We find that this factor is neutral in our analysis of the likelihood of dilution by blurring. *Id.*, at \*36.

#### **E. Summary and Conclusion**

Four of the factors used to determine whether Applicant’s mark SoniStream is likely to dilute Opposer’s famous SONY mark by blurring support a finding of likely dilution, while the other two are neutral. Applicant’s SoniStream mark is sufficiently similar to the SONY mark to trigger consumers of Applicant’s goods to conjure up Opposer’s famous mark; Opposer’s mark is a coined term and is thus inherently (and highly) distinctive; and Opposer’s use of its famous SONY mark has been at least substantially, if not entirely, exclusive in the United States. Applicant’s innocent adoption of his mark, and the absence of any actual association between the marks owing to the fact that Applicant’s mark has not been used, do “not change the result, given our determinations regarding the other dilution factors.” *Spotify*, 2022 USPQ2d 37, at \*35.

“The statute requires [O]pposer to prove impairment of the distinctiveness of [O]pposer’s famous mark.” *Chanel*, 110 USPQ2d at 2026. As discussed above, Opposer and its affiliates operating under the famous SONY mark offer a variety of goods and services involving the streaming of music or entertainment properties. We find that Applicant’s use of the SoniStream mark, which he admits evokes “streaming,” is likely to impair the distinctiveness of the famous SONY mark, particularly if Opposer were to elect to use the mark “SONY STREAM” or “SONY STREAMING” with its current goods, or to use its SONY mark with the type of goods identified in the application. *Id.* (finding the possibility of the expansion of the opposer’s use of its famous CHANEL mark from cosmetics and other goods into the real estate and hotel industries “sufficient to show that opposer is likely to suffer an impairment of the distinctiveness of its CHANEL mark.”). Impairment of distinctiveness through blurring may be found, of course, even if Applicant’s goods “are neither competitive nor necessarily related” to Opposer’s streaming goods and services. *TiVo Brands*, 129 USPQ2d at 1118.

On the basis of the record as a whole, we find that Opposer proved, by a preponderance of the evidence, its entitlement to a statutory cause of action and that Applicant’s SoniStream mark is likely to dilute Opposer’s famous SONY mark by blurring. We thus need not and do not reach Opposer’s Section 2(d) claim. *Spotify*, 2022 USPQ2d 37, at \*37 n.19.

**Decision:** The opposition is sustained.