This Opinion is Not a Precedent of the TTAB

Mailed: July 30, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Njoy, LLC
v.
Shenzhen IJoy Technology Co., Ltd.

Cancellation No. 92081215

David M. Kelly, Jason M. Joyal and Kelu Sullivan of Kelly IP, LLP,
for Njoy, LLC.

Di Li of Di Li Law, P.C.,
for Shenzhen IJoy Technology Co., Ltd.

Before Lykos, Pologeorgis and Brock,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On December 14, 2022, Njoy, LLC ("Petitioner") filed a Petition to Cancel the following two registered marks IJOY and IJOY GROUP

(Registration Nos. 6763037[1] and 6763038[2]) on the Principal Register owned by Shenzhen IJoy Technology Co., Ltd. ("Respondent") located in Shenzhen, China. Both registrations are for goods identified as,[3]

> Absorbent paper for tobacco pipes; Ashtrays for smokers; Cigarette cases; Cigarette filters; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Filter tips; Herbs for smoking; Lighters for smokers; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes; Tobacco; Tobacco pipes in International Class 34.

The underlying applications filed in 2015 that matured into Respondent's registrations were originally filed and owned by Wang Xi Zhi, an individual residing in Shaodong County, Hunan China. Zhi assigned the registrations to Respondent in 2022.[4] Both registrations include a statement that the wording IJOY "has no meaning in a foreign language."

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[1] Registered on June 21, 2022 based on an application filed on March 23, 2015 under Trademark Action Section 1(a), alleging August 1, 2010 as the date of first use anywhere and March 25, 2013 as the date of first use in commerce. The description of the mark is as follows: "The mark consists of [the] word 'IJOY' in a stylized form." Color is not claimed as a feature of the mark.

[2] Registered on June 21, 2022 based on an application filed on April 9, 2015 under Trademark Action Section 1(a), alleging June 3, 2014 as the date of first use anywhere and December 16, 2014 as the date of first use in commerce. The description of the mark is as follows: "The mark consists of [the] word[s] 'IJOY GROUP' in a stylized form." The word GROUP has been disclaimed apart from the mark as shown. Color is not claimed as a feature of the mark.

[3] Citations to the record throughout the decision include references to TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The parties have designated portions of the record confidential. We will discuss only in general terms the relevant evidence submitted under seal where necessary and appropriate in our opinion.

[4] Both assignments were executed on February 28, 2022, and were recorded with the USPTO Assignment Division on June 8, 2022 at Reels/Frames 7745/0581 and 7745/0592.

Petitioner seeks to cancel both registrations on the grounds that (1) Respondent's marks are likely to cause confusion with Petitioner's previously used and registered NJOY and NJOY formative marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and (2) the doctrines of res judicata (claim preclusion) and collateral estoppel (issue preclusion) bar re-litigation of this case based on the Board's entry of final judgment in a prior opposition proceeding involving Petitioner and Respondent's predecessor-in-interest, *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) (non-precedential) (hereinafter referred to as the "Prior Opposition").

In the Petition to Cancel, Petitioner pleaded ownership of several registrations, including the following two registrations on the Principal Register, both for the standard character mark NJOY:[5]

> Registration No. 3427769 for "smoking simulators, namely, electronic cigarettes," in International Class 9;[6] and

[5] For each pleaded registration, Petitioner attached to its Petition to Cancel a printout of from the USPTO Trademark Status and Document Retrieval ("TSDR") database showing the current status and title of the registration. Accordingly, such registrations are received into evidence and are made part of the record for all purposes of this proceeding. *See* Trademark Rule 2.122(d)(1); 37 C.F.R. § 2.122(d)(1). However, the remaining evidence submitted with the Petition to Cancel, including the Testimony Declaration of Wang Xi Zhi dated August 19, 2019, is not part of the record unless Petitioner otherwise properly introduced such evidence at trial. *See* Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c) ("Exhibits to pleadings. Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.").

[6] Registered May 13, 2008; renewed on May 17, 2018. The underlying application was filed on March 8, 2007 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce. The Statement of Use was filed on March 5, 2008.

> Registration No. 4091150 for "electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes," in International Class 9.[7]

In its Answer, Respondent admitted that Petitioner owns each of its pleaded registrations and that they are valid and subsisting.[8] Respondent also admitted the following salient allegations with respect to Petitioner's res judicata, collateral estoppel and Section 2(d) claims:[9]

> 14. On September 4, 2014, NJOY, Inc. filed Notice of Opposition No. 91218230 (the "2014 Opposition") against U.S. Application No. 86150445 (the "'445 Application") for the IJOY mark shown below for "Cigarette cases; Cigarette filters; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Filter tips; Lighters for smokers; Tobacco; Tobacco pipes" in Class 34. NJOY's grounds for opposition in the 2014 Opposition were priority and likelihood of confusion based on NJOY, Inc.'s prior rights in its NJOY Mark.
>
> IJOY
>
> 15. The 2014 Opposition proceeded to a trial on the merits on a likelihood-of-confusion claim, with both NJOY, Inc. and the Applicant submitting evidence.
>
> 16. Upon information and belief, the owner of the '445 Application and Respondent are in privity with one another. The owner of the '445 Application was Wang Xi Zhi. Wang Xi Zhi assigned Respondent's IJOY Marks (defined below) to Respondent at Reel/Frame 7745/0581 and 7745/0592. In addition, in the 2014 Opposition Wang Xi Zhi submitted trial evidence of his "Company Profile," which revealed that his company is Shenzhen IJOY

[7] Registered January 24, 2012; Sections 8 and 15 declarations accepted and acknowledged on January 19, 2022. The underlying application was filed on August 10, 2011 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

[8] Answer ¶ 6; 5 TTABVUE 3.

[9] Answer ¶¶ 14-16, 24 and 25; 5 TTABVUE 5-6.

> Technology Co., LTD., the Respondent and owner of the registrations that are the subject of this Petition for Cancellation. (See Exhibit B at ¶8 (Opp. No. 91218230, 58 TTABVUE 74, 109).)
>
> …
>
> 24. NJOY has priority based on its pleaded valid and subsisting prior-issued registrations for the NJOY Mark and prior use of the NJOY Mark and NJOY trade name for the NJOY Products and Services[10] since before the filing date of the application that matured into Registration Nos. 6763037 and 6763038, the issuance date of Registration Nos. 6763037 and 6763038, Respondent's claimed dates of first use, and any dates of first use that may be proved by Respondent.
>
> 25. Respondent's Goods and the NJOY Products and Services offered and sold by NJOY in connection with its NJOY Mark are identical and/or closely related products and services.

Otherwise, Respondent denied the remaining allegations in the Petition to Cancel. Respondent also asserted the affirmative defenses of laches, acquiescence, and estoppel as well as putative defenses (i.e. amplifications of its denials).[11] Insofar as none of the affirmative defenses were pursued at trial or on brief, they are deemed waived. *See, e.g., Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *1 n.3 (TTAB 2020) (various affirmative defenses deemed waived because no evidence or argument presented at trial).

[10] Paragraph No. 6 of the Petition to Cancel broadly defines the "NJOY Products and Services" as "[t]he products and services described in Paragraphs 2-6" of the Petition to Cancel pertaining to Petitioner's registered and common law marks. 1 TTABVUE 6-9.

[11] Answer, "Affirmative Defenses" ¶¶ 34-37; 5 TTABVUE 6.

The case is now fully briefed.[12] Petitioner, as plaintiff in this proceeding, bears the burden of establishing its entitlement to a statutory cause of action and claims by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). In reaching our decision, we have not considered any statements made by either party in their briefs that are unsupported by evidence properly in the record. *See, e.g.*, *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010).

I. Board Determination on Summary Judgment

On August 16, 2023, Petitioner filed a motion for summary judgment on res judicata based on the Prior Opposition.[13] On November 15, 2023, the Board granted Petitioner's motion for summary judgment in part and denied the motion in part. The Board found no genuine dispute of material fact that the parties were the same or in privity with the parties from the Prior Opposition; and that the Prior Opposition was sustained on the merits of a Section 2(d) claim, thereby satisfying the first two elements of res judicata for both involved registrations.[14]

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[12] The publicly available, redacted versions of Petitioner's main and rebuttal briefs may be found at 37 and 48 TTABVUE.

[13] 10 TTABVUE.

[14] November 15, 2023 Board Order, p. 9; 15 TTABVUE 9.

Under the doctrine of res judicata, "a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action." *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)) (other citations omitted). For res judicata to apply, there must be: (1) identity of parties (or their privies); (2) an earlier final judgment on the merits of a claim; and (3) a second claim based on the same set of transactional facts as the first. *Id.* (citing *Parklane Hosiery*, 439 U.S. at 326 n.5) (other citation omitted).

With regard to the third res judicata element of whether the Prior Opposition involved the same transactional facts as here,[15] the Board found no genuine dispute of material fact that Respondent's registered mark  in Registration No. 6763037 is identical to the mark owned by Zhi, Respondent's predecessor-in-interest from the Prior Opposition.[16] The Board further found no genuine dispute of material fact that Petitioner relied upon Registration Nos. 3427769, 4091150, 4395179, and 4419653 for the standard character marks NJOY and NJOY KING in both the Prior Opposition and the instant cancellation proceeding as the basis for its Section 2(d) claim, and that as a result, the evidence of similarity of the marks, at least as to these registrations, would be identical in the two proceedings.[17] The Board also found that some of the goods were either identical to or "encompassed by" the identification of goods of the opposed application in the Prior Opposition.[18] *See Gen. Elec. Co. v. Raychem Corp.*, 204 USPQ 148, 150 (TTAB 1979) (claim preclusion is applicable "not only with respect to the identical description of goods as had been previously litigated,

[15] To determine if separate proceedings against two applications or registrations involve claims with the same set of transactional facts for purposes of res judicata, we consider (1) whether the mark involved in the first proceeding is the same mark, in terms of commercial impression, as the mark involved in the second proceeding; and (2) whether the evidence of likelihood of confusion between the plaintiff's mark and the defendant's first mark would be identical to the evidence of likelihood of confusion between the plaintiff's mark and the defendant's second mark. *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1767 (TTAB 2015) (citing *Institut Nat'l Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1894-95 (TTAB 1998)).

[16] 15 TTABVUE 10.

[17] *Id.*

[18] 15 TTABVUE 11.

but with respect to all goods that could be said to be encompassed by that description of goods") (citing *Toro Co. v. Hardigg Indus., Inc.*, 549 F.2d 785, 196 USPQ 149 (CCPA 1977)). The Board therefore granted Petitioner's motion for summary judgment in part as to Respondent's IJOY Registration No. 6763037 but only for the following goods:

> Cigarette cases; Cigarette filters; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Filter tips; Lighters for smokers; Tobacco; Tobacco pipes.

Registration No. 6763037 now stands as partially cancelled. The Board apprised the parties that the disposition of the remaining goods in Registration No. 6763037,

> absorbent paper for tobacco pipes; Ashtrays for smokers; Herbs for smoking; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes,

would be decided at final decision.

Petitioner's motion for summary judgment on res judicata was denied in its entirety as to Registration No. 6763038 for the mark IJOY GROUP and all the goods listed in that registration. This is because the Board found that Petitioner failed to meet its burden on summary judgment by not including "any evidence with its motion demonstrating that the IJOY and IJOY GROUP marks are the same mark in terms of commercial impression."[19] As a result, the third requirement for res judicata of the same transactional facts was not satisfied.

[19] 15 TTABVUE 14.

The Board then resumed proceedings and the case proceeded to trial.

II. The Record

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the files of the subject registrations. The parties filed the testimony and evidence summarized below.

A. Petitioner's Main Trial Period

Petitioner submitted the Testimony Declaration of Lynn E. Winch, Petitioner's Senior Director, Financial Planning & Analysis, with Exhibits 1-6 ("Winch Decl.") (22 TTABVUE – confidential version; 23 TTABVUE – public version). Petitioner also submitted notices of reliance on the following:

> Printouts from TSDR of Petitioner's pleaded NJOY and NJOY-formative trademarks registrations showing current status and title (16 TTABVUE);[20]
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> A printout from TTABVUE of the Board's final decision in the Prior Opposition, *NJOY, LLC v. Zhi*, Opp. No. 91218230, (TTAB April 16, 2020) (17 TTABVUE);
>
> Respondent's Responses to Petitioner's First Set of Interrogatory Nos. 5, 6, 7, and 10 (18 TTABVUE – confidential version; 19 TTABVUE – public version);
>
> Respondent's Responses to Petitioner's First Set of Requests for Production of Documents No. 19, Exhibits A and B (20 TTABVUE); and
>
> Printouts from TSDR of third-party registrations for the same mark covering both electronic cigarettes and various smoking accessories and smoker's articles (21 TTABVUE).

[20] This submission was superfluous because Petitioner's pleaded registrations were properly made of record with its Petition to Cancel.

B. Respondent's Trial Period

Respondent submitted the Testimony Declaration of Hongbo Lin, Respondent's Project Manager and Business Director, with Exhibits 1-4 ("Lin Decl.") (27 TTABVUE). Petitioner's objections to portions of Lin's testimony are discussed below in Section III.

Respondent also submitted under notice of reliance:

> Printouts from TSDR of Respondent's applications and registrations of trademarks containing the term "IJOY" showing current status and title, Exhibits 1-7 (24 TTABVUE);
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> Status and title copies of applications and registrations of third-party marks containing the word "JOY," Exhibits 8-32 (24 TTABVUE);
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> Printouts from Respondent's website, social media, and third-party websites and online publications, Exhibits 38-42 (26 TTABVUE); and
>
> Respondent's Responses to Petitioner's First Set of Interrogatories and Petitioner's First Set of Requests for Production of Documents and Things (26 TTABVUE – public version; 25 TTABVUE – confidential version).

Some of Respondent's evidence submitted under notice of reliance is the subject of Petitioner's motion to strike which is discussed below in Section III.

C. Petitioner's Rebuttal Trial Period

Petitioner submitted the Rebuttal Testimony Declaration of Lynn E. Winch., with Exhibits 1- 9 ("Winch Rebuttal Decl.") (33 TTABVUE). Petitioner also made of record under rebuttal notices of reliance the following:

> Printouts from TSDR of third-party applications relied upon by Respondent showing current status and title (34 TTABVUE); and

> Respondent's Responses to Petitioner's First Set of Interrogatories (35 TTABVUE – public version; 36 TTABVUE – confidential version).

III. Petitioner's Motion to Strike

After the close of Respondent's trial period, on August 29, 2024, Petitioner filed a motion to strike the following evidence submitted by Respondent under notice of reliance:[21]

> Third-party registrations comprised of the term JOY (First Notice of Reliance - Exhibits 10, 13-15, 17-18, 21-22, 27-28, 30, and 32);
>
> Respondent's Responses to Petitioner's First Set of Interrogatories Nos. 1, 3, and 8 (Second Notice of Reliance - Exhibit 43);
>
> Respondent's Responses and Documents produced in response to Petitioner's First Set of Requests for Production of Documents and Things (Second Notice of Reliance - Exhibit 44); and
>
> Paragraphs 20-21 of Lin's Testimony Declaration.

In an interlocutory order dated November 14, 2024, the Board deferred until final hearing the motion to strike with one exception.[22] The Board granted Petitioner's motion to strike Respondent's written responses and documents produced in response to Petitioner's First Set of Requests for Production of Documents and Things with the caveat that to the extent any documents were otherwise admissible via a notice of reliance under Trademark Rules 2.120(k) and 2.122(d)(2), (e)(1), and (e)(2), Respondent was allowed until December 3, 2024 to file with the Board and serve on

[21] 28 TTABVUE.

[22] 32 TTABVUE.

Petitioner a notice of reliance on those documents.[23] Respondent filed nothing. As a result, Respondent's written responses and documents submitted under notice of reliance are stricken from the record.[24]

A. Third-party registrations comprised of the term JOY

Petitioner seeks to strike the third-party use-based registrations Respondent submitted under notice of reliance on the grounds that Respondent previously stated during discovery that it had no responsive documents in its possession in response to Petitioner's First Request for Production of Documents No. 19:

> Documents sufficient to identify any third-party use in Commerce of any trademark, including the geographic scope of such use and the time period of such use, that Respondent intends to rely upon in this Petition for Cancellation.

In other words, Petitioner moves for imposition of the estoppel sanction under Fed. R. Civ. P. 37(c)(1).

Fed. R. Civ. P. 34(a) governs the scope of a request for production of documents. That Rule in turn refers to Fed. R. Civ. P. 26(b). *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") §§ 402 and 406 (2025) for a discussion. Generally, "a party does not have an obligation to locate documents that are not in its possession, custody, or control and produce them during discovery." *Adamson Sys. Eng'g, Inc. v. Peavey Elec. Corp.,* 2023 USPQ2d 1293, at *4 (TTAB 2023) (quoting TBMP § 406.02). Consistent with this principle, "a party need not investigate third-

[23] 32 TTABVUE 5.

[24] Petitioner also renews its motion to strike in its appendix to its main trial brief. 38 TTABVUE.

party use or registrations to respond to discovery requests." *See Mystery Ranch, Ltd. v. Terminal Moraine Inc.*, 2022 USPQ2d 1151, *7 (TTAB 2022) (citing *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (a party has no duty to conduct an investigation of third-party uses in response to discovery requests)). Accordingly, Petitioner's motion to strike Respondent's third-party registrations submitted under notice of reliance is denied.

B. Respondent's Responses to Petitioner's First Set of Interrogatories

Petitioner renews its motion to strike Respondent's reliance on its own Interrogatory response Nos. 1, 3, and 8 due to Respondent's failure to provide the required written statement explaining why it is entitled to rely on its own interrogatory answers. Petitioner's motion is granted. *See* Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5); *see, e.g., Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (interrogatory responses by answering party not considered because he did not include explanation as to why he needed to rely on each additional discovery response, and not obvious in what way they avoided any unfairness from what propounding party submitted).

C. Lin's Testimony Declaration

Petitioner seeks to strike Paragraph Nos. 20-21 of the Lin Declaration on the ground that Lin's testimony regarding Respondent's revenues and advertising expenses contradicts Respondent's prior, sworn interrogatory responses on the same

topics."[25] Petitioner points out that Lin verified the interrogatory responses but never provided supplemental responses under Fed. R. Civ. P. 26(e).

We decline to strike Paragraph Nos. 20-21 of Lin's testimony declaration. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (the Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing); *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (same); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (same). Rather, we have considered the probative value of his testimony in light of the prior interrogatory responses.

We sustain, however, Petitioner's objection to Lin's opinion testimony in Paragraph No. 28 regarding the ultimate disposition of Petitioner's Section 2(d) claim. *See, e.g., Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *2 (TTAB 2019) (sustaining objection to portion of testimony declaration where witness opined on the ultimate disposition of the claim); *see also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (same).

IV. Entitlement to a Statutory Cause of Action

As plaintiff, Petitioner must prove entitlement to a statutory cause of action. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058,

[25] 28 TTABVUE 8-9.

1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). According to Section 14 of the Trademark Act, 15 U.S.C. § 1064:

> A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, … by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905.

To establish entitlement to a statutory cause of action under Section 14 of the Trademark Act, Petitioner must demonstrate (1) that its Section 2(d) claim falls within the zone of interests protected by the statute (i.e., has a "real interest" in the outcome of the proceeding); and (2) damage proximately caused by the registration or continued registration of the involved mark (i.e., a reasonable basis for its belief in damage). *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)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Empresa,* 111 USPQ2d 1162; *see also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a "real interest" as a "direct and personal stake" in the outcome of the proceeding).

Respondent argues that there is "no evidence concerning how the alleged confusion has impacted or will impact Petitioner's reputation or commercial success" making Petitioner's allegation in its Petition to Cancel that it will be damaged by Respondent's registrations "conclusory and thus insufficient to demonstrate a

reasonable belief of damage."[26] Respondent is mistaken. Lynn E. Winch, Petitioner's Senior Director, Financial Planning & Analysis, through her testimony declaration, has established Petitioner's common law rights in and use of the mark NJOY in connection with various nicotine products, including electronic cigarettes, electronic vaporizers, e-liquids, and charging accessories.[27] *See Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common-law use sufficient to establish standing/statutory entitlement). She further testified that Petitioner's NJOY branded products have "achieved great commercial success;" that Petitioner has "invested a substantial amount of time, effort, and money in advertising, marketing, and promoting its products under the NJOY Mark since 2007;" and that upon review of Respondent's trademark registrations, she believes that Respondent's use and registration of its registered marks "are damaging and will continue to damage NJOY and its valuable trademark and trade name rights in its NJOY mark."[28]

In addition and as noted above, attached to Petitioner's Petition to Cancel are printouts from the TSDR database showing the current status and title of Petitioner's pleaded registrations, including Registration No. 3427769 for "smoking simulators, namely, electronic cigarettes" and Registration No. 4091150 for "electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes," each for the standard character mark NJOY. *See Cunningham v. Laser*

[26] Respondent's Brief, p. 23; 40 TTABVUE 30. Although not explicitly couched as a challenge to Petitioner's statutory entitlement, we view Respondent's arguments as such.

[27] Winch Decl. ¶¶ 9-10, 15-20; 23 TTABVUE 4, 8-9.

[28] Winch Decl. ¶¶ 17, 18, 24-27; 23 TTABVUE 8-9, 13

Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff's two prior registrations suffice to establish plaintiff's direct commercial interest and its standing); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Respondent even admitted in its Answer that Petitioner is the owner of its "valid and subsisting" pleaded registrations.[29]

Based on this evidence and Respondent's admission in its Answer, we find that Petitioner has demonstrated, by a preponderance of the evidence, that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. *See Ritchie v. Simpson*, 50 USPQ2d at 1026; *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Petitioner has proven its entitlement to bring the instant cancellation proceeding.

V. Section 2(d) Claim

We turn now to the substantive claim before us. To prevail on a likelihood of confusion claim brought under Trademark Act Section 2(d), a plaintiff must prove that it owns

> a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States … and not abandoned as to be likely, when used on or in connection with the goods of the [registrant], to cause confusion, or to cause mistake, or to deceive.

[29] Answer ¶ 6; 5 TTABVUE 3.

Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see also Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1848; *Otto Roth & Co., Inc. v. Universal Foods Corp*., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008). We consider each element of this claim, priority and likelihood of confusion, below.

A. Priority

In a cancellation proceeding in which both parties own registrations, Petitioner must prove priority. *Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281 (TTAB 1998). Respondent in its brief concedes priority as to "Petitioner's registered and common law NJOY marks" used in connection with e-cigarettes, but argues that Petitioner "is not entitled to priority with respect to Respondent's Peripheral Products in Class 34."[30]

Respondent's arguments cannot overcome its earlier judicial admission in its Answer. "[A] judicial admission ... is incapable of refutation." *Made in Nature, LLC v. Pharmavite LLC,* 2022 USPQ2d 557 at *13 (TTAB 2022); *see also Reliable Contracting Grp., LLC v. Dep't of Veterans Affs.*, 779 F.3d 1329, 1334 (Fed. Cir. 2015) ("judicial admissions, which 'have the effect of withdrawing a fact from issue and dispensing wholly with the need for proof of the fact,' are limited to formal admissions made in, for example, a complaint, answer, or pretrial order.").

As noted above, Respondent in its Answer to the Petition to Cancel admitted that Petitioner "has priority based on its pleaded valid and subsisting prior-issued

[30] Respondent's Brief, p. 17; 40 TTABVUE 24.

registrations for the NJOY Mark and prior use of the NJOY Mark and NJOY trade name for the NJOY Products and Services since before the filing date of the application that matured into Registration Nos. 6763037 and 6763038, the issuance date of Registration Nos. 6763037 and 6763038, Respondent's claimed dates of first use, and any dates of first use that may be proved by Respondent."[31] This admission is sufficiently broad to cover all of Petitioner's pleaded registered and common law NJOY marks as well as priority based on constructive or actual use.[32] Accordingly, Petitioner has satisfied the first element of its Section 2(d) claim.

B. Likelihood of Confusion

Having established priority, we are left with the issue of likelihood of confusion. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). *See also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g.*,

[31] Answer ¶ 24; 5 TTABVUE 6.

[32] Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), a party may rely upon the filing date of the application underlying its registration for purposes of priority as its constructive use date. *See Cent. Garden & Pet Co. v. Doskocil Mfg. Co*., 108 USPQ2d 1134, 1140 (TTAB 2013); *Larami Corp. v. Talk to Me Programs, Inc*., 36 USPQ2d 1840, 1844 (TTAB 1995) (parties may rely on the constructive use i.e. filing dates for purposes of priority). A party may, of course, rely on an earlier priority date based on common law rights. A party cannot rely on claimed dates of use in commerce in a registration of as proof of use in the United States. *See* Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2) ("The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.").

In re Guild Mortg. Co., 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("[T]he various evidentiary factors may play more or less weighty roles in any particular determination."). "Each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde,* 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below.

We will focus our comparison on Petitioner's two pleaded registrations for the standard character mark NJOY, Registration No. 3427769 for "smoking simulators, namely, electronic cigarettes" in International Class 9 and Registration No. 4091150 for "electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes" in International Class 9. *See, e.g., In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we find a likelihood of confusion as to that mark and goods, we need not find it as to Petitioner's other registered or common law marks. Conversely, if we do not find a likelihood of confusion as to these two registrations owned by Petitioner, we would not find it as to Petitioner's other

registered marks for the goods identified therein or common law marks.

Where appropriate, we apply the doctrine of collateral estoppel to individual *DuPont* factors. *See, e.g., Toro Co. v. Hardigg Indus., Inc.*, 187 USPQ 689, 691 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785 (CCPA 1977) ("in view of the prior decision, applicant is estopped under the doctrine of collateral estoppel from denying opposer's priority or the similarity between the marks 'TORO' and 'TORO-PAD'"). "Collateral estoppel, like the related doctrine of res judicata, has the dual purpose of protecting litigants from the burden of relitigating an identical issue with the same party or his privy and of promoting judicial economy by preventing needless litigation." *Parklane Hosiery, supra*, 439 U.S. at 326. The underlying rationale is that a party who has litigated an issue should be bound by that decision and cannot demand that the issue be decided again. *Mother's Rest. Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1569 (Fed. Cir. 1983). The doctrine of collateral estoppel requires: (1) identity of an issue in the current and prior proceeding; (2) actual litigation of that issue in the prior proceeding; (3) necessity of a determination of the issue in entering judgment in the prior proceeding; and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. *See Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232 (Fed. Cir. 2005).

1. The Similarity or Dissimilarity of the Marks

We commence with the first *DuPont* factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound,

connotation and commercial impression." *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC,* 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd*, 777 Fed. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

The proper test regarding similarity "is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). Further, the marks "must be considered … in light of the fallibility of memory …." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.,* 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). "Similarity is not a binary factor but is a matter of degree." *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors*

Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). "No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

We now compare Petitioner's registered standard character mark NJOY as set forth in Registration Nos. 3427769 and 4091150 with Respondent's registered stylized marks  and  as set forth respectively in

Registration Nos. 6763037 and 6763038.

a.  Registration No. 6763037

Petitioner asserts that Respondent is collaterally estopped from arguing that its stylized mark registered  mark is dissimilar to Petitioner's NJOY standard character mark in sound, appearance, connotation and commercial impression under the first *DuPont* factor. In support thereof, Petitioner points to the fact that Respondent's  mark at issue here is identical to its mark from the Prior Opposition; that Petitioner relied upon its NJOY standard character mark as set forth in Registration Nos. 3427769 and 4091150 in both the Prior Opposition and the instant cancellation proceeding as the basis for its Section 2(d) claim; and that the Board found that "the marks are similar in their entireties in terms of appearance, sound, connotation and commercial impression" in the Prior Opposition.[33]

Respondent counters that collateral estoppel does not apply because in the Prior Opposition, "the Board found the marks IJOY and NJOY to be confusingly similar, but only for electronic cigarettes relevant goods, which were considered legally identical goods."[34] Elaborating, Respondent asserts that the remaining goods in

[33] *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) at Final Decision, 66 TTABVUE 25.

[34] Respondent's Brief, p. 11; 40 TTABVUE 18.

Registration No. 6763037 are "fundamentally different" and "[g]iven the greater disparity between the goods in the present case, the threshold for finding similarity should be higher than in the prior proceeding."[35]

We agree with Respondent that collateral estoppel does not apply. In the Prior Opposition, the Board was guided by the principle that where the goods are in-part identical, a lesser degree of similarity between the marks is required for confusion to be likely when it made its finding that "the difference in the first letter of a mark may not be sufficient to distinguish the marks."[36] Having already entered summary judgment under the doctrine of res judicata as to the in-part identical goods for this registration, we are left with non-identical goods. As a result the issue before us is slightly different because a higher degree of similarity is required.

Turning now to our analysis, Respondent argues that the origin of its mark is not based on the U.S. English word "joy." Respondent's Project Manager and Business Director, Hongbo Lin, testified that "Respondent's 'IJOY' Marks originate from its business name in Chinese, 爱卓依, which is phonetically pronounced as Ai-Zhuo-Yi."[37] However, there is no evidence in the record that U.S. consumers will perceive IJOY as Respondent's corporate name 爱卓依 , and pronounce it with the transliteration

[35] Respondent's Brief, p. 12; 40 TTABVUE 189.

[36] *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) at Final Decision, 66 TTABVUE 25.

[37] Lin Decl. ¶ 7; 27 TTABVUE 4.

"Ai-Zhuo-Yi." We will therefore address Respondent's arguments using U.S. English as the standard.

Respondent acknowledges that both its stylized mark  and Petitioner's standard character mark NJOY share the same term "JOY," but maintains that they differ materially in appearance, sound, connotation and commercial impression. Respondent argues that NJOY evokes the word "enjoy," with a soft, continuous cadence, while "IJOY" begins with a sharp, standalone "I" sound, and connotes individuality.[38] Elaborating further on this point, Respondent asserts that because the marks contain only four letters, "the divergence between [the letters] 'I' and 'N' has a heightened impact."[39] Respondent also maintains that the marks differ materially in visual presentation because Respondent's mark is "commonly stylized in bold, italic typefaces with thick strokes, conveying a sense of weight and strength" whereas "Petitioner's mark is often depicted in a thin serif font with tight spacing, creating a more refined, restrained, and lifestyle-oriented impression."[40]

We are unpersuaded by Respondent's arguments. To state the obvious, the literal portions of each mark, IJOY and NJOY, are almost identical. Each mark is comprised of four letters, ending with the letter string J-O-Y to denote the word "joy." The only difference is that Respondent's mark commences with the letter "I" whereas Petitioner's mark begins with the letter "N." This difference is slight because both

[38] Respondent's Brief, p. 11; 40 TTABVUE 18.

[39] *Id.*

[40] *Id.*

marks sound and look similar and project highly similar meanings and commercial impressions of expressions of joy and happiness.

The stylized font depicted in Respondent's mark  is not enough to distinguish it in appearance from Petitioner's standard character mark NJOY. As a standard character mark, Petitioner has the flexibility to depict its mark NJOY in any font, style, size, or color, including the exact stylized font as Respondent's mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008).

Comparing the marks overall, *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), they are similar in their entireties in terms of appearance, sound, connotation and commercial impression. The first *DuPont* factor therefore weighs in favor of finding a likelihood of confusion for Respondent's registered stylized mark .

b.  **Registration No. 6763038**

Because Respondent's stylized  mark was not at issue in the Prior Opposition, the doctrine of collateral estoppel does not apply to the analysis

of the first *DuPont* factor for Respondent's Registration No. 6763038.

Respondent argues that its mark 

differs from Petitioner's standard character mark NJOY because its mark is comprised of a ten-letter, two-word phrase whereas NJOY is a single word with two syllables. Respondent also argues that its mark 

projects a different meaning and connotation than Petitioner's NJOY mark due to the addition of the term GROUP. Respondent contends that ordinary consumers view the word GROUP as meaning "a business organization, a brand with a broad product portfolio, or a business with diversified operations" compared "to the clean, personal, and health-oriented image projected by Petitioner's NJOY mark" targeting consumers seeking to cease smoking.[41]

Consumers do not, as Respondent urges, focus on minutia such as the number of syllables in each mark. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 315-16 (TTAB 1959) ("Purchasers … do not engage in trademark syllable counting—they are governed by general impressions made by appearance or sound, or both."). Rather, consumers are likely to focus on the dominant element in a mark. We find that the dominant element in Respondent's mark is the initial term IJOY as opposed to the disclaimed, merely descriptive (if not generic), word GROUP. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming Board's finding that DELTA, not the disclaimed generic term CAFE, is the dominant

[41] Respondent's Brief, p. 14; 40 TTABVUE 21.

portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that BINION'S, not the disclaimed descriptive wording ROADHOUSE, is the dominant portion of the mark BINION'S ROADHOUSE). And for the reasons we explained above, we find IJOY and NJOY similar in sound, meaning, connotation and commercial impression.

Considering the marks in their entireties, we find that they are similar in appearance, sound, connotation and commercial impression. Accordingly, this *DuPont* factor weighs in favor of finding a likelihood of confusion for Respondent's stylized  mark.

2. The Similarity or Dissimilarity of the Goods

Next we consider the second *DuPont* factor, a comparison of the parties' goods as identified in each respective registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). To reiterate, the goods at issue are as follows:

Petitioners Goods:

> Registration No. 3427769 for "smoking simulators, namely, electronic cigarettes" in International Class 9; and
>
> Registration No. 4091150 for "electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes" in International Class 9.

Respondent's Goods:

> Registration No. 6763037 for "absorbent paper for tobacco pipes; Ashtrays for smokers; Herbs for smoking; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes" in International Class 34; and
>
> Registration No. 6763038 for "Absorbent paper for tobacco pipes; Ashtrays for smokers; Cigarette cases; Cigarette filters; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Filter tips; Herbs for smoking; Lighters for smokers; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes; Tobacco; Tobacco pipes" in International Class 34.

a. IJOY **Registration No. 6763037**

None of the parties' goods are identical. However, Respondent admitted in its Answer that "Respondent's Goods and the NJOY Products and Services offered and sold by NJOY in connection with its NJOY Mark are identical and/**or closely related products** and services."[42] Respondent now attempts to circumvent this admission by arguing in its brief that the involved goods are unrelated because Respondent's "core business activity concerns not only e-cigarettes, but also peripheral products such as ashtrays for smokers, cigarette cases, filter tips, matches, lighters for smokers, etc."[43] Respondent cannot retreat from its prior admission in its Answer. *See Made in Nature,* at *13. The second *DuPont* factor weighs in favor of finding a likelihood of confusion for Registration No. 6763037.

[42] Answer ¶ 25; 5 TTABVUE 5 (emphasis added). See footnote 11, *supra.*

[43] Respondent's Brief, p. 16; 40 TTABVUE 23.

b. IJOY GROUP Registration No. 6763038

The second *DuPont* factor weighs strongly in favor of a likelihood of confusion for Registration No. 6763038 because the parties' goods identified as "electronic cigarettes" are identical. And aside from the fact that the goods are identical in part based on the language of each identification, Respondent is bound by the admission in its Answer that "Respondent's Goods and the NJOY Products and Services offered and sold by NJOY in connection with its NJOY Mark are identical …"[44]

3. The Similarity or Dissimilarity of Established, Likely to Continue Trade Channels

This brings us to the third *DuPont* factor, the similarity or dissimilarity of established, likely to continue trade channels and classes of consumers. Respondent argues that the parties do not share the same trade channels because each has their own business-to-consumer websites and brick and mortar stores.[45] Respondent's argument is misplaced. We look to how the trade channels are delineated, if at all, as set forth in the identification of goods for each of the involved registrations. *See Stone Lion*, 110 USPQ2d at 1161; *see also Octocom,* 16 USPQ2d at 1787.

a. IJOY Registration No. 6763037

There are no limitations as to channels of trade or classes of purchasers in the identification of any goods in Respondent's registration. The same is true for both of

[44] Answer ¶ 25; 5 TTABVUE 5 (emphasis added). See footnote 11, *supra.*

[45] Respondent's Brief, p. 18; 40 TTABVUE 25.

Petitioner's registrations. We must therefore presume that Respondent's and Petitioner's goods move in all channels of trade normal for those goods, and that they are available to all usual classes of purchasers for those goods. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340, 343 (TTA 1983). The record shows that the normal trade channels for both Petitioner's and Respondent's goods include authorized online and brick-and-mortar tobacco retailers.[46] The third *DuPont* factor for this Registration No. 6763037 favors a finding of likelihood of confusion.

b. IJOY GROUP Registration No. 6763038

As noted above, the parties' goods identified as "electronic cigarettes" are identical. This permits us to invoke the presumption set forth in *Viterra*, 101 USPQ2d at 1908 that these identical goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *Id.* (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Assoc'd Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

[46] Winch Testimony Decl. ¶¶ 21-22; 23 TTABVUE 10 and Lin Testimony Decl. ¶ 17; 27 TTABVUE 8.

Consequently, for Registration No. 6763038, the third *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

4. Strength or Weakness of Petitioner's NJOY Registered Marks

"Two of the *DuPont* factors (the fifth and sixth) consider [the] strength" of a plaintiff's mark. *Spireon, Inc. v. Flex Ltd.,* 71 F.4th 1355, 2023 USPQ2d 737, at *3-4 (Fed. Cir. 2023). "The fifth *DuPont* factor, '[t]he fame of the prior mark (sales, advertising, length of use),' *DuPont,* 177 USPQ at 567, is a measure of the mark's strength in the marketplace." *Id*. (citing *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733 (Fed. Cir. 2017)). This factor allows a plaintiff to expand the scope of protection its mark should be afforded based on evidence of marketplace strength. By contrast, "the sixth *DuPont* factor, '[t]he number and nature of similar marks in use on similar goods,' *DuPont*, 177 USPQ at 567, [ ] is a measure of the extent to which other marks weaken the assessed mark." *Spireon,* 2023 USPQ2d at *4 (citing *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed Cir. 2005)). This *DuPont* factor allows a defendant to contract the scope of protection of a plaintiff's mark by adducing evidence of conceptual and commercial weakness. *Spireon*, 2023 USPQ2d at *4. Each of these two factors have been argued, respectively, by Petitioner and Respondent.

We find that the doctrine of collateral estoppel applies to both the fifth and sixth *DuPont* factors. In the Prior Opposition, Petitioner, who was in the position of Opposer, relied on the same two registrations for the standard character mark NJOY

we are using as a basis for comparison here: Registration No. 3427769 for "smoking simulators, namely, electronic cigarettes," in International Class 9; and Registration No. 4091150 for "electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes," in International Class 9. The Board found under the fifth *DuPont* factor in the Prior Opposition "that Opposer's NJOY marks are commercially strong, and fall on the stronger side of the spectrum from very strong to very weak."[47]

Under the sixth *DuPont* factor, the Board found in the Prior Opposition that "[t]he dictionary definitions, third-party registrations, and [evidence of] third-party use show that the mark NJOY is suggestive of a quality, characteristic or function of Opposer's products because it conveys the purpose or feeling a consumer receives by using Opposer's products – enjoyment."[48]

The Board ultimately found that "[c]onsidering the record as a whole (i.e., the NJOY marks are suggestive but are commercially strong), Opposer's marks are entitled to a broader scope of protection than is normally accorded to an inherently distinctive suggestive mark because of their commercial strength" citing *Cadence Indus. Corp. v. Kerr*, 225 USPQ 331, 334 (TTAB 1985) (with sufficient sales, advertising and promotion thereof, a suggestive mark may well be categorized, despite its suggestive nature, as a strong mark).[49] When balancing the *DuPont* factors

[47] *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) at Final Decision 66 TTABVUE 26.

[48] 66 TTABVUE 15.

[49] 66 TTABVUE 21.

in the Prior Opposition, the Board concluded that "Opposer's mark is commercially strong and is on the strong side of the spectrum of strength and is thus entitled to a broader scope of protection than a mark with average strength. …"; no mention was made of the sixth factor presumably because it was deemed neutral.[50]

The issues of the strength and weakness of Petitioner's NJOY registered mark are precluded from re-litigation because they are identical to those litigated and adjudged in the Prior Opposition as was necessary and essential to reach a final decision on the merits. Respondent's privy had a full and fair opportunity to litigate these issues. Because collateral estoppel bars re-litigation of the fifth and sixth *DuPont* factors, we accord each factor the same degree of weight in this cancellation proceeding as was given in the Prior Decision. That is to say, the fifth factor weighs in favor of finding a likelihood of confusion while the sixth factor is neutral.

5. Actual Confusion and Contemporaneous Use

We now address the seventh *DuPont* factor, the nature and extent of any actual confusion, and the related eighth *DuPont* factor, the extent of the opportunity for actual confusion. *DuPont*, 177 USPQ at 567. As with the Prior Opposition, Respondent presents the same argument that the lack of evidence of any instances of actual confusion, despite coexistence in the marketplace for fifteen years, weighs against a likelihood of confusion.[51]

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[50] 66 TTABVUE 26.

[51] In the Prior Opposition, Applicant, Respondent's predecessor-in-interest, "testified that even though he has used the mark IJOY (stylized) for the products described in the description of goods since August 1, 2010, he is unaware of any reported instances of actual confusion." Similarly here, Respondent's witness Lin testified that he was unaware of "any

In the Prior Opposition, the Board explained that "the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period in the same markets as those served by Opposer under its marks," citing *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).[52] The Board deemed the seventh and eighth *DuPont* factors neutral because "Applicant's testimony and evidence regarding the extent of his sales, advertising and marketing is not sufficiently complete to allow us to determine whether there has been a reasonable opportunity for confusion to occur."[53]

These seventh and eighth *DuPont* factors were raised, litigated and fully adjudicated in the Prior Opposition by Respondent's privy, meaning that Respondent is collaterally estopped from asking us to revisit these issues. Consistent with the Prior Opposition, we deem the seventh and eighth *DuPont* factors neutral.

6. Balancing the *DuPont* Likelihood of Confusion Factors

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; "explain the results of that weighing;" and "the weight [we] assigned to the relevant factors." *In re Charger*

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customer confusion between any of Respondent's products and any of [Petitioner's] products." Lin Decl. ¶ 27; 27 TTABVUE 10. *See also id.* at ¶¶ 25-26; 27 TTABVUE 10.

[52] *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) at Final Decision, 66 TTABVUE 8.

[53] *NJOY, LLC v. Wang Xi Zhi,* Opp. No. 91218230, (TTAB April 16, 2020) at Final Decision, 66 TTABVUE 25.

Ventures LLC, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). *See also Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 2024 USPQ2d 293, at *2 (Fed. Cir. 2024). We have carefully considered all evidence of record and arguments as they pertain to the *DuPont* factors. We balance the factors below as they pertain to both Registration Nos. 6763037 and 6763038.

The first and third *DuPont* factors each weigh in favor of finding a likelihood of confusion. In light of Respondent's admissions in its Answer, the second *DuPont* factor weighs in favor of finding a likelihood of confusion. Based on the Prior Opposition, Respondent is collaterally estopped from relitigating the issues of the strength and weakness of Petitioner's NJOY registered mark and the lack of any reported instances of actual confusion, despite the parties' coexistence in the marketplace. Consistent with the Prior Opposition, the fifth factor weighs in favor of finding a likelihood of confusion, while the sixth, seventh and eighth factors are neutral.

We therefore conclude that confusion is likely for both Respondent's IJOY Registration No. 6763037 for "absorbent paper for tobacco pipes; Ashtrays for smokers; Herbs for smoking; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes" as well as Registration No.

6763038 for the mark IJOY GROUP for "Absorbent paper for tobacco pipes; Ashtrays for smokers; Cigarette cases; Cigarette filters; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Filter tips; Herbs for smoking; Lighters for smokers; Liquefied gas cylinders for cigarette lighters; Matches; Smoker's articles, namely, filter tubes; Tobacco; Tobacco pipes" in International Class 34.

Accordingly, we find that Petitioner has proved its entitlement to a cause of action under Trademark Act Section 14, as well as priority and likelihood of confusion under Trademark Act Section 2(d) by a preponderance of the evidence.

Decision: The Petition to Cancel is granted.