

App. 1

NOT RECOMMENDED FOR
FULL-TEXT PUBLICATION

File Name: 17a0692n.06

No. 17-1225

**UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT**

DEBBIE ROHN;	)	
DEAN ROHN,	)	ON APPEAL FROM
	)	THE UNITED
Plaintiffs-Appellants,	)	STATES DISTRICT
	)	COURT FOR THE
v.	)	WESTERN DISTRICT
VIACOM INTERNATIONAL	)	OF MICHIGAN
INC., et al.,	)	
Defendants-Appellees.	)	(Filed Dec. 18, 2017)

Before: SILER, KETHLEDGE, and THAPAR, Circuit Judges.

KETHLEDGE, Circuit Judge. Debbie and Dean Rohn argue that Viacom’s trademarked television characters (the Bubble Guppies) have pushed their trademarked clothing line (Guppie Kid) out of the market, and that Viacom has therefore infringed on their trademarks. But Guppie Kid’s sales had largely dried up well before the Bubble Guppies came along. For this reason and more, the district court granted summary judgment to Viacom. We affirm.

The Rohns own two trademarks. One is for the word GUPPIE, an acronym for “Growing Up Playing Pursuing Individual Excellence.” The other is for a

App. 2

logo: the word GUPPIE, in which a fish in a necktie forms the letter G. These marks give the Rohns the exclusive right to put the word and logo on hats, shirts, and the like. They started doing so in 1990, and have since sold (at most) \$12,000 in “Guppie Kid” apparel. But most of those sales came in the first fifteen years, and the Rohns have sold only about \$2,000 of their apparel since 2005.

In 2011, a show called Bubble Guppies premiered on Nickelodeon, a television network owned by Viacom. The show is pitched toward a young audience; it features cartoon children with fish tails (the Bubble Guppies) learning how to count and read. In its logo, the end of the letter G is shaped like a fish tail. Viacom licenses the characters and logo to large retailers like Target and Sears, who make and sell Bubble Guppies apparel.

The Rohns sued Viacom and various retailers for trademark infringement, alleging that potential customers were likely to confuse Guppie Kid and Bubble Guppies apparel. The district court granted Viacom’s motion for summary judgment and entered judgment for all defendants. This appeal followed.

We review the district court’s decision *de novo*. See *Richmond v. Huq*, 872 F.3d 355, 363 (6th Cir. 2017). To avoid summary judgment, the Rohns need evidence that would enable a reasonable jury to find that Bubble Guppies apparel infringes on their Guppie Kid trademarks. See Fed. R. Civ. P. 56(a).

App. 3

Trademarks protect a business's association with its own goods. To show infringement, therefore, the Rohns must show confusion – *i.e.*, that a consumer looking at a Guppie Kid shirt likely would not be able to tell whether the Rohns or Viacom made it. *See Progressive Distrib. Servs., Inc. v. United Parcel Servs., Inc.*, 856 F.3d 416, 424 (6th Cir. 2017); *see also* 15 U.S.C. §§ 1114, 1125. We determine whether confusion is likely based on many things, the first being the “strength of the plaintiff’s mark.” *Progressive*, 856 F.3d at 424. The stronger the trademark, the more likely consumers are to associate it with the trademark holder, and thus the more likely they are to be confused if someone else uses a similar mark. This strength has two components: conceptual strength (whether the mark is just a generic word or something more distinctive) and commercial strength (whether the mark is recognized in the market). *See id.* at 427-31.

Here, no one disputes that the GUPPIE word and logo are distinctive. As to commercial strength, however, the Rohns have little evidence. They cite only Debbie Rohn’s own deposition testimony that business was “very, very good” in the 1990s and then got “good” again in 2006 when the Rohns launched a website. Yet even she was careful to say that “I shouldn’t use the word great.” Indeed, most Guppie Kid sales (\$10,000 out of \$12,000) occurred in western Michigan before 2005. Those sales were confined to local shops and the Rohns’ home, since larger stores declined the Rohns’ invitations to carry Guppie Kid. And the website has added only about 50 sales – mostly to family

App. 4

and friends – in over 10 years. Even before the Bubble Guppies arrived, then, Guppie Kid sightings were few. And they were already becoming fewer: a number of stores that once carried Guppie Kid apparel had closed long ago, and the few stores that still carried it rarely sold it. Thus, few consumers were likely to know about Guppie Kid in the first place. Few if any consumers were therefore likely to confuse the Rohns' brand with Viacom's. That would explain why the Rohns offer no evidence that any consumer has actually confused the two brands, which is the best evidence that consumers are likely to confuse them. *See Progressive*, 856 F.3d at 433. And without some proof that any consumers actually confused or had a reason to confuse the brands, a reasonable jury could not find that Viacom infringed on the Rohns' trademarks.

The Rohns argue, however, that they have “conclusive” proof of Guppie Kid's strength – namely that the GUPPIE trademarks are “incontestable,” a status that trademarks achieve if they are not successfully challenged within five years of being registered. *See* 15 U.S.C. § 1065. But that status entitles trademarks only to a “presumption of strength.” *Progressive*, 856 F.3d at 429. And a defendant can defeat that presumption with, among other things, proof that a trademark is commercially weak. *See id.* Viacom has done that, so this argument fails.

The Rohns alternatively argue that the weakness of their trademarks actually helps them, because their claim is one of reverse confusion. In such cases, rather than exploit the reputation of a trademark holder, the

infringer “saturates the market” with a similar trademark; consumers then start to think that the two brands are related. *Ameritech, Inc. v. Am. Info. Tech. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987). According to the Rohns, a plaintiff with a weak trademark is unlikely to prevent this saturation and thus more likely to show reverse confusion. But whatever the merits of that argument in theory, it makes no practical difference here – since the value of the Rohns’ trademarks is not only weak but practically nonexistent. Consumers are unaware of brands like these to begin with, and thus the Rohns lack evidence of any kind of confusion.

Finally, the Rohns argue that a jury could find trademark infringement based on things beyond the strength of their marks, *e.g.*, the similarly piscine letter Gs in the Bubble Guppies and Guppie Kid logos. But the “ultimate question” remains whether consumers are likely to think that the two brands are related. *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991). And nowhere do the Rohns show that consumers knew about their brand to begin with – let alone confused Viacom’s brand with theirs. Thus, a jury could not find that Bubble Guppies apparel infringes on their Guppie Kid trademarks.

The district court’s judgment is affirmed.

App. 6

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

DEBBIE ROHN
and DEAN ROHN,

Plaintiffs,

v.

VIACOM INTERNATIONAL,
INC. *et al.*,

Defendants.

Case No. 1:14-cv-83

HON. JANET T. NEFF

/

JUDGMENT

In accordance with the Court's January 27, 2017 Opinion and Order (Dkt 213) and the parties' February 10, 2017 Joint Notice Regarding Impact of Opinion and Order on Retailer Defendants (Dkt 214):

IT IS HEREBY ORDERED that Judgment is entered in favor of Defendants and against Plaintiffs.

DATED: February 10, 2017 /s/ Janet T. Neff

JANET T. NEFF

United States District Judge

App. 7

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

DEBBIE ROHN and
DEAN ROHN,

Plaintiffs,

Case No. 1:14-cv-83

v.

HON. JANET T. NEFF

VIACOM INTERNATIONAL,
INC. *et al.*,

Defendants.

/

OPINION AND ORDER

(Filed Jan. 27 2017)

Pending before the Court are the cross-motions of Plaintiffs Debbie and Dean Rohn and Defendant Viacom International, Inc. for summary judgment on the issue of liability in this trademark case. For the reasons discussed herein, the Court denies Plaintiffs' Motion for Summary Judgment (Dkt 205) and grants Defendant's Motion for Summary Judgment (Dkt 197).

I. BACKGROUND

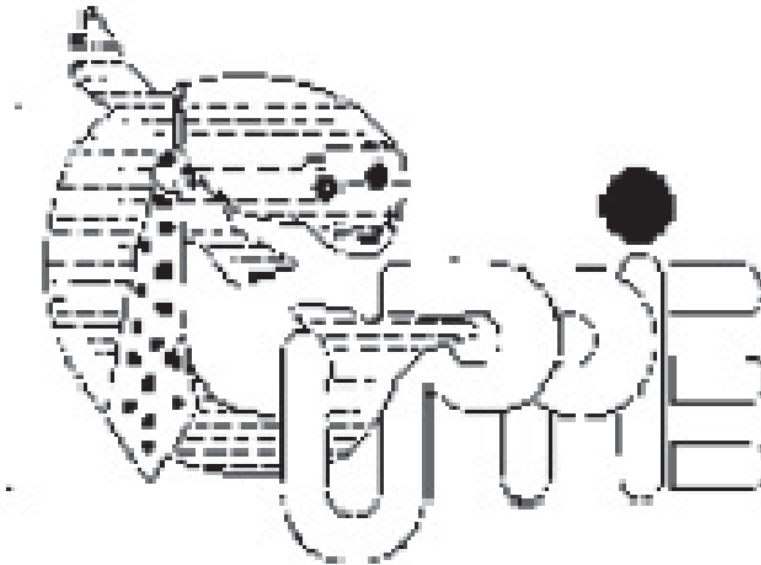
A. Factual Background

1. Plaintiffs' Trademarks

In 1990, Plaintiffs incorporated Guppie Kids, Inc., a Florida corporation, in connection with their Guppie

Kid apparel concept (JSF¹ ¶ 1). Guppie Kids, Inc. was administratively dissolved on October 11, 1991 for failing to file an annual report (*id.*).

On February 4, 1992, Plaintiffs obtained design plus words U.S. Trademark Reg. No. 1,674,309 (“the ’309 Mark”) for the following mark:



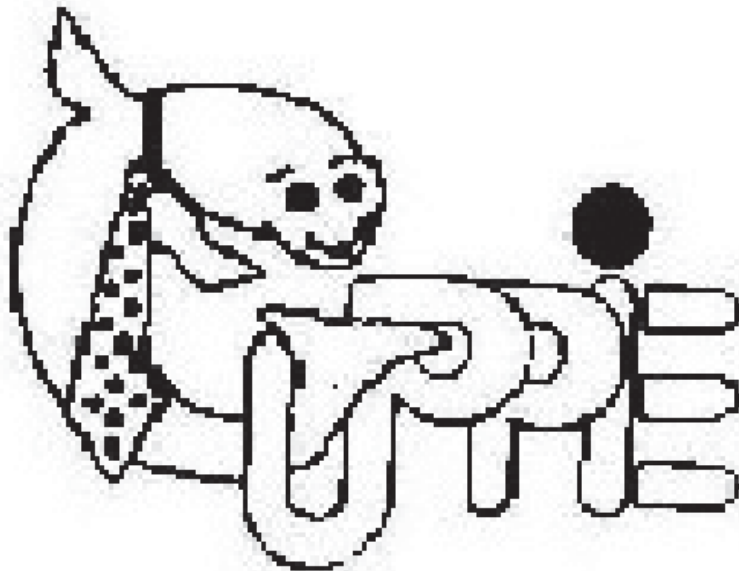
(JSF ¶ 2). The ’309 Mark was registered in connection with the following goods: “Baby bunting, bloomers, boxer briefs, boxer shorts, coats, dresses, hats, jackets, leggings, mittens, pants, shirts, shoes, shorts, skirts, slippers, slips, socks, suits, sweatpants, sweatshirts,

¹ Defendant filed a “Joint Statement of Facts” (JSF) (Dkt 200), to which Plaintiffs posed no objection; therefore, the Court has relied on the Joint Statement of Facts for resolution of this motion unless otherwise indicated. *See generally* Judge Neff’s Information and Guidelines for Civil Practice § IV.A.2(a).

App. 9

sweaters, ties, and underwear” (*id.* ¶ 3). The ’309 Mark was cancelled on August 10, 1998 because Plaintiffs were unable to pursue the manufacture of GUPPIE-branded toys (*id.* ¶ 4).

On September 11, 2007, Plaintiffs obtained design plus words U.S. Trademark Reg. No. Reg. No. 3,290,738 (“the ’738 Mark”) for the following mark:



(JSF ¶ 5). The ’738 Mark was originally registered in connection with the following goods: “Baby bunting; Bloomers; Boxer briefs; Boxer shorts; Coats; Dresses; Hats; Jackets; Leggings; Mittens; Pants; Shirts; Shoes; Shorts; Skirts; Slippers; Slips; Socks; Suits; Sweat pants; Sweat shirts; Sweaters; Ties; Underwear” (*id.* ¶ 6). In or around 2009, Plaintiffs deleted shoes and

slippers from the '738 Mark because of a lawsuit settlement (*id.* ¶ 7).

On November 17, 2009, Plaintiffs obtained word trademark Reg. No. 3,711,588 (“the ’588 Mark”) for GUPPIE for use in connection with “Hats, jackets, boxer briefs and/or boxer shorts, pants, shirts, shorts, t-shirts, ties, sweatshirts, hooded shirts, gloves, and infant’s underwear” (JSF ¶ 8 Plaintiffs had previously filed for the GUPPIE word mark on April 24, 2008 but abandoned that mark for unknown reasons as of July 8, 2009 (*id.*)).

In the early 1990s, Plaintiffs advertised their GUPPIE brand in a children’s magazine (JSF ¶ 9 Plaintiffs entered into a License Agreement dated January 17, 1996 with a company called CHAB, Inc. (“the CHAB Agreement”) (*id.* ¶ 10). CHAB was owned by Terri Raffaele (*id.* ¶ 11). Pursuant to the CHAB Agreement, CHAB obtained the exclusive right to use the ’309 Mark in the United States in connection with t-shirts, shorts, sweatshirts, and sundresses (*id.* ¶ 12). In exchange, CHAB agreed to pay an escalating minimum annual royalty to Plaintiffs in addition to 5 percent of all GUPPIE sales (*id.* ¶ 13). The CHAB Agreement had a 10-year term with minimum annual royalties of \$1,000 for years 1-3; \$5,000 for years 4 and 5; and \$10,000 for years 6-10 (*id.* ¶ 14). Pursuant to the CHAB Agreement, Raffaele intended to attend trade shows and perform various other tasks to grow a brand (*id.* ¶ 15). CHAB never made any sales of GUPPIE products, and, in or about 1998, approximately two

App. 11

years after entering the agreement, Raffaele terminated the license (*id.* ¶ 16).

After termination of the CHAB Agreement, Plaintiffs took over management of brand marketing and ran the business from their home (JSF ¶ 17). Plaintiffs met with two or three marketing companies in the 2000s to explore further marketing their Guppie Kid products (*id.* ¶ 18). Specifically, in 2006, Plaintiffs met with representatives from marketing agencies Knorr Marketing and Greenlight Marketing (*id.*). Plaintiffs did not reach an agreement with these companies and did not retain any documents from Knorr Marketing's pitch other than a non-disclosure agreement (*id.* ¶ 19). In 2006 or 2007, Plaintiffs met with a volunteer business counselor from SCORE Association, a small business mentorship program, to generate marketing ideas and a business plan (*id.* ¶ 20). Plaintiffs did not keep a copy of the business plan that the volunteer SCORE counselor developed (*id.* ¶ 21). Plaintiffs never retained or paid a marketing company to market or promote the GUPPIE marks (*id.* ¶ 22).

Each piece of Guppie Kid clothing came with a card with a pledge reflecting the “yuppie guppie” concept: “we pledge to work very hard to do our best because some day we would like to be a success. But most important to be a Guppie, we pledge to be kind, loving, and help others. That would make us truly happy” (JSF ¶ 23). Plaintiffs also developed “licenses” to be given away with the purchase of GUPPIE-branded clothing, which were “little cards” intended to be “another thing for the kids to be reminded to work hard

App. 12

and to be kind” (*id.* ¶ 24). Plaintiffs also gave away bookmarks and magnets with each purchase to remind kids and parents of the brand, as well as a behavior chart that can be accessed on the Guppie Kid website (*id.* ¶ 25). Plaintiffs also worked with Debbie Rohn’s sister-in-law to develop a Guppie theme song, a copy of which would be given to purchasers of GUPPIE-branded clothes (*id.* ¶ 26). When a few child suicides occurred in Cadillac, Michigan, Plaintiffs used the Guppie Kid brand to promote an anti-bullying message (*id.* ¶ 27).

From approximately 2005 to the present, Plaintiffs expended approximately \$50,000 in connection with the ’309 Mark, the ’738 Mark, and the ’588 Mark (collectively, “the GUPPIE Marks”), including expenses for computer equipment, travel expenses and product purchases from their manufacturer (JSF ¶ 28). Dean Rohn estimates that Plaintiffs spent an additional \$50,000 in connection with the GUPPIE Marks in the period from 1990 to 2005 (*id.* ¶ 29). Of the approximately \$100,000 spent by Plaintiffs in connection with the GUPPIE Marks between 1990 and 2015, approximately \$25,000 were legal fees (*id.* ¶ 30).

Plaintiffs’ GUPPIE apparel has been available for sale on Plaintiffs’ website – www.guppiekids.com – since 2005 (JSF ¶ 31). Plaintiffs do not have documentation demonstrating any sales of Guppie Kid products outside of Michigan through their website prior to 2012 (*id.* ¶ 32). Plaintiffs made three sales from the www.guppiekids.com website in 2012 and two sales in 2013 (*id.* ¶ 33). Plaintiffs have no documentation to

establish any website sales since 2014 and are unaware of any such sales (*id.*). Dean Rohn estimates that from 1990 to 2005, Plaintiffs sold between \$5,000 and \$10,000 of GUPPIE branded product (*id.* ¶ 34). Plaintiffs' Guppie Kid brand has produced \$2,000 in income from 2005 to 2015 (*id.* ¶ 35). Plaintiffs have produced all existing documentation regarding sales of Guppie Kid clothing (*id.* ¶ 36). Documentation of Guppie Kid sales prior to 2005 does not exist because Plaintiffs' computer containing those records crashed, and there is no way to recreate the lost records (*id.* ¶ 37).

2. Defendant's Trademark

Robert Scull is one of the creators of Defendant's Bubble Guppies show and is its executive producer (JSF ¶ 38). Jonny Belt is Scull's business partner, a co-creator of Viacom's Bubble Guppies show, and the show's executive producer (*id.* ¶ 39). Scull and Belt originated the idea for the Bubble Guppies show when working on a show called "Little Bill" (*id.* ¶ 40). They continued to develop the Bubble Guppies concept, and, in spring of 2005, Scull gave Nickelodeon – a division of Defendant Viacom – a pitch package for the Bubble Guppies concept (*id.*). The Bubble Guppies pilot aired in the summer of 2005 (*id.* ¶ 41). A series deal for the show was executed at the end of 2005 or beginning of 2006 (*id.* ¶ 42). Thereafter, the production team worked on producing the show (*id.*). The Bubble Guppies show premiered on Nick Jr. in January 2011 (*id.* ¶ 43).

On July 19, 2011, Defendant obtained a trademark for BUBBLE GUPPIES, U.S. Trademark Reg. No. 3,998,384 (“the ’384 Mark”) for use in connection with “entertainment services in the nature of television series, featuring animation, comedy and drama; providing online information in the field of entertainment concerning television programs” (JSF ¶ 44). Although all 80 episodes of Bubble Guppies have not yet aired, the show is out of production, and Viacom does not intend to produce any additional episodes (*id.* ¶ 45).

Merchandise containing the Bubble Guppies branding is created by manufacturers that specialize in a given type of merchandise (JSF ¶ 46). Defendant licenses its intellectual property to such manufacturers to incorporate in their creation of apparel (*id.* ¶ 47). The manufacturers then sell the merchandise through retail merchants with whom they have agreements (*id.* ¶ 48). Defendant ultimately receives a royalty percentage of shipments from the manufacturer to the retailer (*id.* ¶ 49).

B. Procedural Posture

Plaintiffs initiated this trademark dispute in January 2014 against Defendant Viacom and numerous third parties, including retailers and non-retailers, alleging that Defendant infringed on their trademarks through its sale of merchandise relating to its “Bubble Guppies” animated musical television show, such as the following:



(Dkt 1, Compl. ¶ 22). In their Second Amended Complaint, filed in July 2014, Plaintiffs assert the following claims against all named Defendants: Trademark Infringement (Count I), False Designation of Origin (Count II) and Unfair Competition (Count III) (Dkt 83).

In the fall of 2014, Plaintiffs stipulated to dismissing the following four Defendants from this case: Cafe Press, Inc. (Dkt 117); NexTag, Inc. (Dkt 121); Etsy, Inc. (Dkt 134); and Shopzilla, Inc. (Dkt 137). Further, in July 2015, this Court granted Defendant Goodies for

Kiddies' Motion to Dismiss (Op. & Order, Dkt 140).² In addition to Defendant Viacom, the following seven Defendants remain in this case: Zazzle, Inc.; Gilt Groupe, Inc.; Genesco, Inc.; Kmart Holding Corporation; Kohl's Department Stores, Inc.; Sears, Roebuck and Co.; and Target Corporation.

Following the close of discovery, Defendant Viacom filed a pre-motion conference request, proposing a dispositive motion to resolve the question of its liability on Plaintiffs' three claims (Dkt 182). Plaintiffs responded and filed their own pre-motion conference request, asserting that the case at bar is a "reverse confusion case" on which they are entitled to summary judgment (Dkt 183 at PageID.1134-1135). The Court conducted the pre-motion conference on March 7, 2016 (Minutes, Dkt 189). Counsel agreed that the liability of Defendant Viacom, if any, was the threshold issue for dispositive motion briefing and decision before motions from the third-party retailers and non-retailers would be entertained. The Court issued a briefing schedule (Dkt 190), and the parties filed their motion papers in June 2016. Specifically, Defendant filed its motion (Dkt 197), to which Plaintiff filed a response in opposition (Dkt 208). Plaintiff filed its own motion (Dkt 205), with a supporting brief seemingly identical to its brief in opposition to Defendant's motion (Dkt 207). Defendant filed a consolidated response in opposition to Plaintiffs' motion and reply brief in further support of its motion

² Plaintiffs filed an appeal from this Court's Opinion and Order (Dkt 153), which the Sixth Circuit Court of Appeals dismissed on October 21, 2015 for lack of jurisdiction (Dkt 165).

for summary judgment on liability (Dkt 203). Plaintiffs filed a sur-reply (Dkt 206). Defendant also filed an objection (Dkt 204) to the “Affidavit of Plaintiff Debbie Rohn Regarding Summary Judgment (on Liability) Issues” (Dkt 210). Plaintiffs filed a response to the objection (Dkt 209).

Having conducted pre-motion conferences in this matter and having fully considered the parties’ written briefs, stipulated statements of fact and accompanying exhibits, the Court finds that the relevant facts and arguments are adequately presented in these materials and that oral argument would not aid the decisional process. *See* W.D. Mich. LCivR 7.2(d).

II. CROSS-MOTIONS FOR SUMMARY JUDGMENT

A. Motion Standard

A court properly grants summary judgment “if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” FED. R. CIV. P. 56(a). The party moving for summary judgment has the initial burden of showing that no genuine issue of material fact exists. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Street v. J. C. Bradford & Co.*, 886 F.2d 1472, 1479 (6th Cir. 1989). Once the moving party has made such a showing, the burden is on the nonmoving party to demonstrate the existence of an issue to be litigated at trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986). The Court must view the factual evidence

and draw all reasonable inferences in favor of the non-moving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986); *Slusher v. Carson*, 540 F.3d 449, 453 (6th Cir. 2008).

As Defendant points out, “likelihood of confusion” is an essential element that Plaintiffs must prove to prevail on each of their three claims (Dkt 198 at PageID.1181). See *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 609 (6th Cir. 2009) (setting forth elements of a trademark infringement claim); *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 178 (6th Cir. 1985) (setting forth elements of a false designation of origin claim); *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 323 (6th Cir. 2001) (setting forth elements of an unfair competition claim). The Sixth Circuit uses the multi-factor “likelihood of confusion” test to determine whether there has been trademark infringement, false designation of origin or unfair competition under the Lanham Act, 15 U.S.C. § 1051 *et seq.* *Audi AG v. D’Amato*, 469 F.3d 534, 542 (6th Cir. 2006) (citing *Two Pesos v. Taco Cabana*, 505 U.S. 763, 780 (1992)).

The Sixth Circuit has recognized four theories of liability for trademark infringement: palming off, confusion of sponsorship (also known as “association”), reverse confusion of sponsorship, and dilution. *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 419 (6th Cir. 2012). In their motion papers, Plaintiffs focus on reverse confusion, opining that “everyone thinks that Viacom owns the mark” (Dkt 208 at PageID.1577). See generally *Ameritech, Inc. v. Am. Info.*

Techs. Corp., 811 F.2d 960, 964 (6th Cir. 1987) (explaining that in a reverse confusion claim, the second or “junior” user seeks to capitalize on the first or “senior” user’s goodwill or reputation and “saturates the market with a similar trademark and overwhelms the senior user”). In the Sixth Circuit, trademark infringement analysis requires examination of the same multi-factor test, regardless of the theory of liability. *Therma-Scan*, 295 F.3d at 630, 640 (“[D]espite TSI’s arguments to the contrary, the presence of a reverse-confusion claim does not alter this analysis.”). See, e.g., *Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 186 F. Supp. 3d 741 (W.D. Mich. 2016). “The ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.” *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991).

“Whether a likelihood of confusion exists is a mixed question of law and fact subject to de novo review.” *Grubbs v. Sheakley Group, Inc.*, 807 F.3d 785, 794 (6th Cir. 2015) (quoting *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 515 (6th Cir. 2007)); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998). Any disputes about the evidence that pertains to the eight factors set forth, *infra*, presents a factual issue. *Data Concepts*, 150 F.3d at 624. “[T]he further determination of whether a given set of foundational facts establishes a likelihood of confusion is a legal conclusion.” *Homeowners*, 931 F.2d at 1107; *Data Concepts*, 150 F.3d at 624

(explaining that “the balancing of [the factual] findings to determine the ultimate issue of likelihood of confusion is a question of law”). “The legal conclusion that confusion is likely must rest on the particular facts of the case, but when all of the material facts have been determined, the ultimate determination of likelihood of confusion lies within the exclusive jurisdiction of the court.” *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084, 1086 (6th Cir. 1983).

B. Analysis

“[I]n determining whether there is a likelihood of confusion, the following eight factors should be considered: (1) strength of plaintiff’s mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing [] channels used; (6) degree of purchaser care; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion in selecting the mark.” *Audi*, 469 F.3d at 542-43. Again, in the course of applying these factors, “the ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.” *Homeowners*, 931 F.2d at 1107.

The parties do not disagree on the relevant factors, nor the case law and principles applicable to each factor, only their application to the facts at bar. Defendant argues that application of each of these factors illustrates that Plaintiffs’ three claims lack merit. Defendant argues that it is also entitled to summary

judgment on Plaintiffs' reverse confusion theory for the same reasons and because there is no record evidence to support Plaintiffs' theory (Dkt 198 at PageID.1193-1194). In response, Plaintiffs opine that the legal standard of "likely to cause confusion," especially in a reverse confusion case, is simpler than Defendants urge, and Plaintiffs request that this Court grant summary judgment in their favor (Dkt 208 at PageID.1569-1576). The Court will consider each factor, in turn.

1. *Strength of Plaintiffs' Marks*

This first factor focuses on "the distinctiveness of a mark *and* its recognition among the public." *Therma-Scan*, 295 F.3d at 631 (emphasis added). "Strength is a combination of the mark's place on the distinctiveness scale and its degree of acquired distinctiveness, how well it is recognized in the marketplace and how clearly it is actually associated with a particular source." *Citizens Banking Corp. v. Citizens Fin. Group, Inc.*, 320 F.App'x 341, 346 (6th Cir. 2009) (citation omitted). In other words, "[a] mark is strong if it is highly distinctive, i.e., if the public readily accepts it as the hallmark of a particular source." *Homeowners*, 931 F.2d at 1107.

In this regard, Defendant argues that Plaintiffs' marks are weak because they have little consumer recognition (Dkt 198 at PageID.1182-1183). Like the plaintiff in *Therma-Scan*, Plaintiffs do not respond by attempting to establish that their marks are widely

recognized among the general population. Instead, Plaintiffs respond that this factor weighs in favor of a finding of likelihood of confusion because both their logo mark and their word mark are “incontestable,” inasmuch as the marks have been in continuous use for five consecutive years after the date of registration and are still in use in commerce (Dkt 208 at PageID.1577-1578).

Like the plaintiff’s argument in *Therma-Scan*, Plaintiff’s argument here is misplaced. “Even where a trademark is incontestable and ‘worthy of full protection,’ the significance of its presumed strength will depend upon its recognition among members of the public.” *Therma-Scan*, 295 F.3d at 632. “Treating a valid, incontestable trademark as an exceptionally strong mark for the purpose of determining whether confusion is likely to occur, without examining whether the mark is distinctive and well-known in the general population, would shift the focus away from the key question of ‘whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.’” *Id.* (quoting *Homeowners*, 931 F.2d at 1107).

Moreover, “even if a mark is on the strong side of the distinctiveness scale, it can still be a weak mark if it has low recognition among the public.” *Citizens*, 320 F. App’x at 346 (citing *Therma-Scan*, 295 F.3d at 631, and *Homeowners*, 931 F.2d at 1107). Defendant points out that there is extensive third-party use of similar marks in commerce (Dkt 203 at PageID.1416), a point that Plaintiffs not only failed to refute in their

response but also acknowledged in their Second Amended Complaint in describing their efforts to protect their marks in the face of “Guppies Popping Up All Over” (2d Amend. Compl., Dkt 83 at PageID.533).

In short, this factor weighs against a finding that confusion with Defendant’s Bubble Guppies mark is likely. The Court’s analysis also reveals the weakness of Plaintiffs’ reverse-confusion theory, which requires that Plaintiffs’ mark was of a strength upon which Defendant, the purported junior user, could even capitalize.

2. *Relatedness of the Goods*

In examining the relatedness-of-the-goods factor, “[t]he question is, are the [goods or services] related so that they are likely to be connected in the mind of a prospective purchaser?” *Homeowners*, 931 F.2d at 1109 (citation omitted). In that analysis, “courts must examine whether the products of the parties perform the same function . . .” *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275, 283 (6th Cir. 1997).

Defendant argues that the goods at issue are not related because they do not perform the same function and are targeted to different demographics (Dkt 198 at PageID.1185). Specifically, Plaintiffs’ GUPPIE apparel is intended to embody a “yuppie kid” concept, reflected by the GUPPIE acronym: “Growing Up, Playing, Pursuing Individual Excellence” (*id.*). According to Defendants, Plaintiffs are attempting to promote their

concept to school-age children, as evidenced by Plaintiffs' development of various "licenses," behavior charts, bookmarks, magnets and bracelets (*id.*). Defendant points out that its mark, in contrast, reinforces specific connections formed between preschoolers and cartoon characters on the Bubble Guppies musical show (*id.* at PageID.1186).

In response, Plaintiffs merely posit that "obviously this factor weighs in favor or [sic] finding confusion" because "[t]he goods sold by Plaintiffs are children's clothing. The goods sold by Defendant are children's clothing" (Dkt 208 at PageID.1578).

The Court is more persuaded by the nuances of Defendant's argument than Plaintiffs' two-sentence declaration that the goods are related simply because they are clothes. "Goods or services are not necessarily related . . . simply because they 'coexist in the same broad industry.'" *ThermaScan*, 295 F.3d at 633. Moreover, Plaintiffs have produced no evidence that children have, or would, confuse BUBBLE GUPPIES apparel and GUPPIE clothing. The Court determines that the record does not support a likelihood of confusion of sponsorship, affiliation or connection with Defendant's Bubble Guppies mark based on the alleged relatedness of the goods.

3. *Similarity of the Marks*

"In assessing similarity, 'courts must determine whether a given mark would confuse the public when viewed alone, in order to account for the possibility

that sufficiently similar marks may confuse consumers who do not have both marks before them but who may have a general, vague, or even hazy, impression or recollection of the other party's mark.'” *Maker’s Mark*, 679 F.3d at 421 (quoting *Daddy’s Junky Music*, 109 F.3d at 283). Further, “courts should examine the pronunciation, appearance, and verbal translation of conflicting marks.” *Id.* “It is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important.” *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (quoting J. Thomas McCarthy, *TRADEMARKS AND UNFAIR COMPETITION* § 23:15 (2d ed. 1984)).

Defendant argues that beyond the words “Guppie” and “Guppies,” the purportedly conflicting marks have no similarity (Dkt 198 at PageID.1187). According to Defendant, Plaintiffs’ GUPPIE marks are not actionably similar to Defendant’s BUBBLE GUPPIES mark because “the public would not mistake Plaintiffs’ tie-wearing fish with Viacom’s rounded and bubbly BUBBLE GUPPIES logo or the show’s bright-eyed and bubble-headed half-human half-fish cartoon characters that are the core of the brand” (*id.* at PageID.1186). Defendant also points out that “the marks are not similar in pronunciation, cadence, and appearance” inasmuch as Defendant visually reinforces the distinctive term “bubble” in Bubble Guppies by the use of “a water bubble as the dot on the letter ‘i,’ bubble-style lettering, and blue and green colors and shading that

reference the show's underwater location" (*id.* at PageID.1187-1188).

According to Plaintiffs, the marks in this case are "exactly the same" (Dkt 208 at PageID.1578). Plaintiffs assert that "the only difference is that Viacom added the word 'Bubble' to Plaintiffs['] mark, making the infringement and likelihood of confusion significantly greater" (*id.*).

Again, the Court is more persuaded by the nuances of Defendant's argument. The record simply does not demonstrate a likelihood of confusion with Defendant's Bubble Guppies mark based on the alleged similarity of the marks, which concomitantly weakens Plaintiffs' theory that customers are likely to be confused into thinking that their goods are those of Defendant, the purported junior user.

4. *Evidence of Actual Confusion*

Evidence of actual confusion is "undoubtedly the best evidence of likelihood of confusion." *Therma-Scan*, 295 F.3d at 634 (quoting *Daddy's Junky Music*, 109 F.3d at 284). In this regard, Defendant argues that Plaintiffs have presented *no* evidence of actual confusion and that Plaintiffs instead rely on inadequate, as well as unreliable and inadmissible hearsay (Dkt 198 at PageID.1189).

In response to Defendant's argument, Plaintiffs do not point the Court to evidence of actual confusion but merely assert, without further elaboration, that "there

is evidence of actual confusion throughout Debbie Rohn's Affidavit" (Dkt 208 at PageID.1579).

Even assuming *arguendo* that Debbie Rohn's affidavit contains properly admissible evidence of consumers' beliefs or mindset, Plaintiffs' failure to identify the portions of the affidavit upon which they rely, or otherwise elucidate how these portions support their argument, is fatal to analysis of this factor. Neither Defendant nor this Court is required to study Debbie Rohn's 91-paragraph affidavit with its 130-page attachment of unmarked documents to discern the relevant portions and proper bases for Plaintiffs' argument. *See* FED. R. CIV. P. 56(c)(1) (Supporting Factual Positions); W.D. Mich. LCivR 7.1(a). *See also Magnum Towing & Recovery v. City of Toledo*, 287 F. App'x 442, 449 (6th Cir. 2008) ("It is not the district court's . . . duty to search through the record to develop a party's claims; the litigant must direct the court to evidence in support of its arguments before the court."); *Wardle v. Lexington-Fayette Urban County Gov't*, 45 F. App'x 505, 509 (6th Cir. 2002) (*per curiam*) ("[A] district court is not required to search the record to determine whether genuine issues of material fact exist when the non-moving party has failed to point them out."); *InterRoyal Corp. v. Sponseller*, 889 F.2d 108, 111 (6th Cir. 1989) ("A district court is not required to speculate on which portion of the record the nonmoving party relies, nor is it obligated to wade through and search the entire record for some specific facts that might support the nonmoving party's claim.").

In short, the record before the Court does not demonstrate a likelihood of confusion with Defendant's Bubble Guppies mark based on any evidence of actual confusion. This factor therefore also tips in Defendant's favor.

5. *Marketing Channels Used*

The fifth factor requires an analysis of the parties' predominant customers and their marketing approaches. *Therma-Scan*, 295 F.3d at 636. "[I]f the services of one party are sold through different marketing media in a different marketing context than those of another seller, the likelihood that either group of buyers will be confused by similar service marks is much lower than if both parties sell their services through the same channels of trade." *Homeowners*, 931 F.2d at 1110.

Here, Defendant argues that the parties' marketing channels do not overlap inasmuch as Defendant has promoted the Bubble Guppies television show through its national media network and Plaintiffs' marketing of GUPPIE products was limited to their website, a print advertisement in the early 1990s, and Plaintiffs' display and/or donation of GUPPIE products at various trade shows, charities, and other local events in or around Cadillac, Michigan (Dkt 198 at PageID.1190-1191).

According to Plaintiffs, the overlap between the parties' marketing and advertising is "palpable" (Dkt 208 at PageID.1579), although Plaintiffs conversely

concede that “the marketing channels were not exact duplicates, given that Plaintiffs are a [sic] proprietors of a small business in Western Michigan and Defendants are all worldwide behemoths” (*id.* at PageID. 1579-15 80).

Some use of the internet for marketing does not alone, and as a matter of law, constitute overlapping marketing channels. *Therma-Scan*, 295 F.3d at 637 (observing that “a non-specific reference to Internet use is no more proof of a company’s marketing channels than the fact that it is listed in the Yellow Pages of the telephone directory”). The facts at bar indicate that Plaintiffs’ marketing was very limited in variety, scope and geography. The record facts weigh against concluding that confusion with Defendant’s Bubble Guppies mark is likely based on marketing channels.

6. *Degree of Purchaser Care*

The standard for determining whether an ordinary purchaser would differentiate between products or services with similar marks is the exercise of ordinary caution. *Therma-Scan*, 295 F.3d at 638. Defendant argues this factor weighs in its favor because “children form a connection with the Bubble Guppies *characters* – not word marks that they cannot read” (Dkt 198 at PageID.1191 [emphasis in original]). In response, although Plaintiffs posit that this factor also supports a finding of a likelihood of confusion, Plaintiffs seemingly concede Defendant’s point in acknowledging that “the purchasing decisions are largely

child-driven or motivated, in particular by child identification with the Viacom show” (Dkt 208 at PageID.1580). In light of the different demographics and motivations for purchase, the record similarly does not support the conclusion that Defendant misappropriated any goodwill associated with Plaintiff’s GUPPIE marks and used it to its benefit with consumers of its “Bubble Guppies” merchandise. The Court determines that this factor does not weigh in favor of finding a likelihood of confusion.

7. *Defendant’s Intent in Selecting the Mark*

If a party chooses a mark with the intention of creating confusion between its products and those of another company, “that fact alone may be sufficient to justify an inference of confusing similarity.” *Therma-Scan*, 295 F.3d at 638 (quoting *Daddy’s Junky Music*, 109 F.3d at 286). Circumstantial evidence of copying, particularly “the use of a contested mark with knowledge of the protected mark at issue,” is sufficient to support an inference of intentional infringement where direct evidence is not available. *Therma-Scan*, 295 F.3d at 638-639 (citation omitted). “Where there is no evidence that the defendant actually knew that a protected trademark existed, such knowledge can be presumed if evidence exists of the plaintiff’s ‘extensive advertising and long-term use of a protected mark.’” *Id.* at 639 (quoting *Daddy’s Junky Music Stores*, 109 F.3d at 286). The mere pre-existence of a mark “does not support an inference that intentional copying

occurred.” *Therma-Scan*, 295 F.3d at 639; *Daddy’s Junky Music*, 109 F.3d at 286-87.

Defendant argues that there is no evidence that Defendant intended to cause any purported consumer confusion and that no such inference can be drawn where Plaintiffs’ operation is small and local, with extremely limited marketing and sales (Dkt 198 at PageID.1192, citing *Therma-Scan*, 295 F.3d at 639 (plaintiff’s “small scale of operations in a limited geographical area and the fact that it has not conducted extensive advertising” can preclude a presumption of actual knowledge of a pre-existing mark)).

Plaintiffs baldly assert in response that Defendant “knowingly used Plaintiffs’ word mark and plainly infringed on Plaintiffs’ logo mark” (Dkt 208 at PageID. 15 8 1).

Again, mere assertions are not effective. As Defendant points out in reply, the chronology of events in this case does not permit such an inference because any communications Plaintiffs may have sent to Defendant after they learned of the Bubble Guppies television show cannot *retroactively* create intent by the show’s co-creators to pattern the show after Plaintiffs’ products, or *retroactively* create intent to cause confusion with Plaintiffs’ products (Dkt 203 at PageID. 142 1). It is incorrect to “suggest[] that the mere prior existence of a registered mark demonstrates that the alleged infringer intentionally copied that mark.” *Daddy’s Junky Music*, 109 F.3d at 286-87. Therefore, the Court determines that this factor, whether

analyzed as intent or merely indifference, also weighs against a finding of likelihood of confusion, given the factual record in this case.

8. *Likelihood of Expansion in Selecting the Mark*

The last factor to consider is the likelihood of expansion in selecting the mark. A “strong possibility that either party will expand his business to compete with the other . . . will weigh in favor of finding that the present use is infringing.” *Daddy’s Junky Music*, 109 F.3d at 287 (internal quotation marks omitted).

The parties agree that the Bubble Guppies show is out of production and that Defendant does not intend to produce any additional episodes (JSF ¶ 45). Defendant further points out that the “peak” of the Bubble Guppies apparel royalties bell curve “has already passed” (Dkt 198 at PageID.1193).

Plaintiffs respond, again with no elaboration, that “[t]here is evidence in Debbie Rohn’s Affidavit herewith that supports an expansion by Plaintiffs and by Defendants” (Dkt 208 at PageID.1581). Plaintiffs also contend that Defendant’s plan to not make any new shows “has no bearing on reverse confusions effects [sic] on Plaintiffs’ ability to expand” (Sur-Reply, Dkt 206 at PageID.1446).

The Court disagrees. “[A] finding of little evidence of expansion plans is accorded little to no weight” in the likelihood of confusion analysis. *Maker’s Mark*, 679

F.3d at 424. Moreover, this factor is relevant only where a party “expand[s] his business to compete with the others or to be marketed to the same consumers,” *Homeowners*, 931 F.2d at 1112 (quotation omitted), and, as determined *supra*, the record does not support a finding that these parties, either forward or reverse, target the same audiences with their products. Hence, this factor is accorded little to no weight.

In summary, the parties do not disagree on the case law and principles applicable to each factor, only their application to the facts at bar. Even viewing the factual evidence and drawing all reasonable inferences in favor of Plaintiffs, the Court determines that no genuine issue of material fact has been identified regarding the likelihood of consumer confusion between Plaintiffs’ GUPPIE Mark and Defendant’s Bubble Guppies Merchandise. The balance of factors leads to the conclusion that the relevant consumers are not likely to believe that the products or services offered by the parties are affiliated in some way. Plaintiffs’ thinly argued and weakly supported position to the contrary is simply insufficient to defeat Defendant’s motion or support a judgment in their favor. Rather, Defendant is entitled to summary judgment on the issue of its liability arising from Plaintiffs’ claims, including Plaintiffs’ reverse-confusion theory of liability to establish trademark infringement.

III. DEFENDANT'S OBJECTION TO DEBBIE ROHN'S AFFIDAVIT

Defendant filed an objection (Dkt 204) to the “Affidavit of Plaintiff Debbie Rohn Regarding Summary Judgment (on Liability) Issues” (Dkt 210), arguing that the affidavit is (1) largely not made on personal knowledge or based upon facts that would be admissible in evidence and to which Debbie Rohn is competent to testify, and (2) attempts to introduce inadmissible evidence that was never produced to Defendant in discovery (Dkt 204 at PageID.1425). Specifically, Defendant requests that the Court (1) disregard or strike from the Rohn affidavit, at a minimum, paragraphs 30, 39, 43, 45, 49, 54, 55, 67, 68, 69, 70, 75, 78, 82 and subsections A-N, 84, 86, 88, 89 and 90; (2) disregard or strike from the Rohn affidavit, at a minimum, pages 20-133 of the documentary evidence that Plaintiffs offer through the Rohn affidavit; and (3) grant any further relief that the court deems just and necessary (*id.* at PageID. 143 1).

In response, Plaintiffs concede that Debbie Rohn's affidavit “includes material generated contemporaneously with her reading and reviewing of Defendants' Motion and Brief in Support” (Dkt 209 at PageID.15 89). Plaintiffs contend that some of the material “Defendants obviously know to be true because much of it simply recites and reacts to what is in Viacom's television show or its show-related licensed merchandise or is already in the Joint Statement [of Facts (JSF)]” (*id.*). Last, Plaintiffs assert that “to the limited extent that her Affidavit contains material testimony from Mrs.

Rohn which *might* have been offered by her during discovery in this case, the Court should note defense counsel extensively deposed her, that no restrictions were placed on the scope or depth of her questioning in that deposition, and that any undiscovered material in her affidavit is explained by the fact that defense counsel did not ask the questions which would have revealed what Defendants now claim they did not know before” (*id.* [emphasis in original]).

For the reasons set forth *supra*, this Court is unwilling to parse Debbie Rohn’s affidavit either to find support for Plaintiffs’ position or to determine which portions would be inadmissible. Rather, because this Court has not relied upon the affidavit to reach its conclusion on the issue of Defendant’s liability, the Court will deny Defendant’s objection as moot.

IV. CONCLUSION

For the foregoing reasons, the Court denies Defendant’s Objection as moot, grants Defendant’s Motion for Summary Judgment (Dkt 197), and denies Plaintiffs’ Motion for Summary Judgment (Dkt 205). Accordingly:

IT IS HEREBY ORDERED that Defendant’s Motion for Summary Judgment (Dkt 197) is GRANTED.

IT IS FURTHER ORDERED that Plaintiffs’ Motion for Summary Judgment (Dkt 205) is DENIED.

IT IS FURTHER ORDERED that Defendant's Objection to Debbie Rohn's Affidavit (Dkt 204) is DENIED as moot.

IT IS FURTHER ORDERED that counsel shall confer and, *not later than February 10, 2017*, file a Joint Notice advising the Court whether Judgment is properly entered in favor of all Defendants, and if not, why not, including a recommended course for resolution of this case.

DATED: January 27, 2017

/s/ Janet T. Neff
JANET T. NEFF
United States District Judge

App. 37

No. 17-1225

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

DEBBIE ROHN;	)	
DEAN ROHN,	)	
Plaintiffs-Appellants,	)	
v.	)	ORDER
VIACOM INTERNATIONAL	)	(Filed Jan. 19, 2018)
INC., ET AL.,	)	
Defendants-Appellees.	)	

BEFORE: SILER, KETHLEDGE, and THAPAR,
Circuit Judges.

The court received a petition for rehearing en banc. The original panel has reviewed the petition for rehearing and concludes that the issues raised in the petition were fully considered upon the original submission and decision of the case. The petition then was circulated to the full court.* No judge has requested a vote on the suggestion for rehearing en banc.

* Judge White recused herself from participation in this ruling.

App. 38

Therefore, the petition is denied.

**ENTERED BY ORDER
OF THE COURT**

/s/ Deb S. Hunt
Deborah S. Hunt, Clerk
