

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: November 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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*In re Positivevolution Pty Ltd*

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Serial No. 79348303  
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Julie A. Katz of Katz Group LLC,  
for Positivevolution Pty Ltd.

Max Faucette, Trademark Examining Attorney, Law Office 107,  
Leslie Bishop, Managing Attorney.

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Before Kuhlke, Pologeorgis, and Lavache,  
Administrative Trademark Judges.

Opinion by Lavache, Administrative Trademark Judge:<sup>1</sup>

Positivevolution Pty Ltd (“Applicant”) filed a request for extension of protection of an international registration under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), seeking registration on the Principal Register of the standard character mark **ENSOMBL** for services ultimately identified as follows:

Netcasting, namely, broadcasting programs via global computer network in the field of finance and investing for financial professionals and investment advisors; transmission of podcasts in the fields of finance and investing; web portal services, namely providing financial

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<sup>1</sup> The TTABVue and Trademark Status and Document Retrieval (“TSDR”) citations in this opinion refer to the docket and electronic file database for the involved application.

professionals with access to the internet; providing internet chat rooms for financial professionals and investment advisors in the fields of finance, investing, and law; providing access to online computer databases concerning financial and investment topics; electronic transmission of pictures, images, audio and/or video via online forums for financial professionals and investment advisors; providing online forums for financial professionals and investment advisors concerning financial investment and legal topics; electronic bulletin board services for financial professionals on financial and investment topics; transmission of financial, investment and legal news; communication services for video conferencing purposes, namely video conferencing services for financial professionals and investment advisors; none of the foregoing being data transfer telecommunication services; none of the foregoing being food or grocery delivery services, in International Class 38.<sup>2</sup>

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground of likelihood of confusion, citing the standard character mark **ENSEMBLE**, registered on the Principal Register, for, inter alia, "Telecommunication services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators and food and grocery delivery agents in the vicinity of the caller using mobile phones; Telecommunication services, namely, routing calls, SMS messages

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<sup>2</sup> Application Serial No. 79348303, based on International Registration No. 1679880 and filed on July 31, 2022, has been accorded a priority date of June 10, 2022. *See* 15 U.S.C. §§ 1141f(b) (filing date), 1141g (claim of priority).

Applicant last updated the identification of services in its December 25, 2023 Request for Reconsideration at TSDR 1. The Examining Attorney acknowledged the amendment to the identification in the January 30, 2024 Denial of the Request for Reconsideration and relied on this last-amended version of the identification in the Examining Attorney's Brief, 8 TTABVUE 1-2. However, it appears that the public database record was not updated to reflect the amended version of the identification when the request for reconsideration was filed. Therefore, the Board, *sua sponte*, has updated the identification field of the public database record accordingly.

and push-notifications to retail and delivery services; Telecommunications, namely, transfer of data by telecommunications,” in International Class 38.<sup>3</sup>

After the Examining Attorney issued a final refusal, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and the appeal resumed. The case is fully briefed. We affirm the refusal to register for the reasons explained below.

## **I. Evidentiary Objection**

Before turning to our analysis, we must address the Examining Attorney’s objection to evidence consisting of copies of 23 third-party registrations, which Applicant submitted for the first time with its Appeal Brief. The Examining Attorney asserts that we should disregard this evidence as untimely. We agree.

The record in an appeal must be complete prior to the filing of the appeal. 37 C.F.R. § 2.142(d); *In re HSB Solomon Assocs., LLC*, Ser. No. 77136242, 2012 TTAB LEXIS 79, at \*9 (TTAB 2012);<sup>4</sup> TBMP § 1208.02. Thus, the third-party registrations attached to Applicant’s Appeal Brief, submitted after the filing of the appeal, are

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<sup>3</sup> Registration No. 6975188 issued on February 7, 2023. The registration also includes goods in International Class 9 and services in International Classes 35, 39, and 42. However, the Examining Attorney’s refusal focuses on the services in International Class 38.

<sup>4</sup> As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, case citations in this opinion are in the form recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Practitioners should also adhere to the practice set forth in TBMP § 101.03.

untimely. Accordingly, we sustain the Examining Attorney's objection and have not considered these registrations.<sup>5</sup>

## II. Likelihood of Confusion

Trademark Act Section 2(d), in relevant part, prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion.” 15 U.S.C. § 1052(d). To determine whether confusion is likely, we analyze all probative evidence relevant to the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003).

In every Section 2(d) case, two key *DuPont* factors are the similarity or dissimilarity of the marks and the relatedness of the respective goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976). Here, we have considered each *DuPont* factor that is relevant and for which there is evidence and argument of record. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

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<sup>5</sup> We note that Applicant also attached evidence to its Appeal Brief that was already of record in the application file. “[P]apers that are already in the application should not, as a matter of course, be resubmitted as exhibits to the brief.” TBMP § 1203.01; see also *In re Thor Tech Inc.*, Ser. No. 78487208, 2007 TTAB LEXIS 88, at \*3 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and unnecessary).

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, 1356 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1205 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). Ultimately, however, “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, 1199 (CCPA 1973).

#### **A. Relatedness of the Services**

We begin our analysis with the second *DuPont* factor, which concerns the similarity or dissimilarity and nature of the respective services. *DuPont*, 476 F.2d at 1361. In determining the relatedness of the services, we must look to the services as identified in Applicant’s application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990)).

It is sufficient that the services are related in some manner, or that the conditions and activities surrounding their marketing are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1396 (Fed. Cir. 2012); *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at \*18 (TTAB 2007). The issue is not whether consumers would confuse Applicant’s services with Registrant’s services, but rather whether there is a likelihood of confusion as to the source of these services. *L’Oreal S.A. v. Marcon*, Opp.

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No. 91184456, 2012 TTAB LEXIS 77, at \*16 (TTAB 2012); *In re Rexel Inc.*, Ser. No. 73241423, 1984 TTAB LEXIS 57, at \*2 (TTAB 1984).

Registration may be refused as to a particular class of services if Applicant's mark for any of its identified services in that class is likely to cause confusion with Registrant's mark for any of the services listed in the cited registration. *See SquirrCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981) (indicating that likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Here, Applicant's services are:

Netcasting, namely, broadcasting programs via global computer network in the field of finance and investing for financial professionals and investment advisors; transmission of podcasts in the fields of finance and investing; web portal services, namely providing financial professionals with access to the internet; providing internet chat rooms for financial professionals and investment advisors in the fields of finance, investing, and law; providing access to online computer databases concerning financial and investment topics; electronic transmission of pictures, images, audio and/or video via online forums for financial professionals and investment advisors; providing online forums for financial professionals and investment advisors concerning financial investment and legal topics; electronic bulletin board services for financial professionals on financial and investment topics; transmission of financial, investment and legal news; communication services for video conferencing purposes, namely video conferencing services for financial professionals and investment advisors; none of the foregoing being data transfer telecommunication services; none of the foregoing being food or grocery delivery services, in International Class 38.

Registrant's services include, in relevant part, "Telecommunication services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators and food and grocery delivery agents in the vicinity of the caller using mobile phones; Telecommunication services, namely, routing calls, SMS messages and push-notifications to retail and delivery services; Telecommunications, namely, transfer of data by telecommunications," in International Class 38.

As the Examining Attorney notes, the wording "Telecommunications, namely, transfer of data by telecommunications," in the registration's identification of services is broad enough to encompass some of Applicant's more specifically identified services, including "Netcasting, namely, broadcasting programs via global computer network in the field of finance and investing for financial professionals and investment advisors;" "electronic transmission of pictures, images, audio and/or video via online forums for financial professionals and investment advisors;" and "transmission of financial, investment and legal news." Thus, Applicant's and Registrant's services are legally identical in part. *In re Solid State Design Inc.*, Ser. No. 87269041, 2018 TTAB LEXIS 1, at \*16 (TTAB 2018) (noting that, where the goods [or services] in an application or registration are broadly described, they are deemed to encompass all the goods [or services] of the nature and type described therein); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, Proc. No. 94002242, 2015 TTAB LEXIS 176, at \*60-61 (TTAB 2015) (same).

Applicant asserts that it is "not a telecommunications company, and does not provide what would typically be understood to be telecommunication services," nor

does it “transfer data.”<sup>6</sup> Accordingly, Applicant included the following limitation in its identification of services: “none of the foregoing being data transfer telecommunication services.”<sup>7</sup> Again, however, the question of registrability of an applicant’s mark must be decided on the basis of the identification of services set forth in the application and cited registration. *Stone Lion*, 746 F.3d at 1323. And, as the Examining Attorney points out, “‘telecommunications’ describes ‘the transmission of information, as words, sounds, or images, usually over great distances, in the form of electromagnetic signals.’”<sup>8</sup> Therefore, despite Applicant’s apparently incongruous limitation, “the ordinary dictionary definition of the term ‘telecommunications’ makes clear that several of applicant’s . . . services . . . fall under the umbrella of transfer of data by telecommunications.”<sup>9</sup> These include Applicant’s services identified as “transmission of pictures, images, audio and/or video via online forums for financial professionals and investment advisors” and “transmission of financial, investment

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<sup>6</sup> Appeal Brief, 6 TTABVUE 15.

<sup>7</sup> See December 25, 2023 Request for Reconsideration at TSDR 1. In its application, Applicant’s identification of services clearly identifies the transmission of data as the service, limiting the subject matter of the data to the fields of finance, investing, and law. If Applicant’s service is providing content, i.e., information in the fields of finance, investing, and law, via the Internet, then Applicant should have identified the services in that manner, so as to be clear it is not a transmission service in International Class 38.

<sup>8</sup> Examining Attorney’s Brief, 8 TTABVUE 6 (quoting Dictionary.com, <https://www.dictionary.com/browse/telecommunications> (accessed on May 29, 2024)). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, Opp. No. 91061847, 1982 TTAB LEXIS 146, at \*7 (TTAB 1982), *aff’d*, 703 F.2d 1372 (Fed. Cir. 1983); *In re Red Bull GmbH*, Ser. No. 75788830, 2006 TTAB LEXIS 136, at \*7 (TTAB 2006); TBMP § 1208.04.

<sup>9</sup> Examining Attorney’s Brief, 8 TTABVUE 6.



and legal news,” both of which would necessarily involve some form of transferring data.

Accordingly, we presume, as we must, that Registrant’s broadly identified telecommunications services could include at least some of Applicant’s services. Because we find that the parties’ respective services are, in part, legally identical, the second *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

### **B. Similarity of Trade Channels**

Next, we consider established, likely-to-continue channels of trade, the third *DuPont* factor. *DuPont*, 476 F.2d at 1361. Applicant argues that its “customers are financial and investment professionals, such as wealth management advisers and financial advisors,”<sup>10</sup> and reiterates that it does not provide “telecommunication services in any broad sense of the meaning.”<sup>11</sup> However, because Applicant’s and Registrant’s services are legally identical in part, we must presume that the legally identical in part services travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (finding the Board is entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968) (noting that where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

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<sup>10</sup> Appeal Brief, 6 TTABVUE 14.

<sup>11</sup> *Id.*

Therefore, the third *DuPont* factor also heavily weighs in favor of a finding of likelihood of confusion.

### **C. Strength of the Cited Mark**

Before we compare the marks at issue, we consider the strength, as well as any weakness, of the cited mark ENSEMBLE as used in connection with the relevant services listed in the cited registration. We do so because a determination of the strength or weakness of the mark helps inform us as to its scope of protection. *See In re Morinaga Nyugyo K.K.*, Ser. No. 86338392, 2016 TTAB LEXIS 448, at \*17-18 (TTAB 2016) (“[T]he strength of the cited mark is—as always—relevant to assessing the likelihood of confusion under the *du Pont* framework.”).

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself and its commercial strength in the marketplace. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (“There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.”); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at \*24 (TTAB 2022).

#### **1. Conceptual Strength of the Cited Mark**

Conceptual strength is a measure of a mark’s distinctiveness and may be placed “in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

Because the cited mark issued on the Principal Register without a claim of acquired distinctiveness, the mark is presumed to be inherently distinctive for the relevant services in the cited registration. 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 9118587, 2006 TTAB LEXIS 330, at \*62 (TTAB 2006) (“A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.”).

However, the Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the mark or common element has some non-source-identifying significance that undermines its conceptual strength as an indicator of a single source. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ . . . that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that segment is relatively weak.’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)).

Here, Applicant alludes to third-party registrations for marks that “coexist on the registry and [were] initially or later determined by the Examining Attorney to not be

confusingly similar to Applicant's Mark."<sup>12</sup> Applicant asserts that "many of these third party [sic] marks . . . cover services in Class 38, where the term 'ensemble' is highly suggestive."<sup>13</sup> To support this argument, Applicant attached copies of third-party registrations to its appeal brief, which, as discussed above, we have not considered because they were not timely submitted. During prosecution, Applicant also submitted a list of third-party registrations with its request for reconsideration,<sup>14</sup> but, in the Examining Attorney's denial of that request for reconsideration, the Examining Attorney timely and appropriately advised Applicant that this evidence would not be considered because the mere submission of such a list does not make the listed registrations of record.<sup>15</sup> *See, e.g., In re 1<sup>st</sup> USA Realty Pros., Inc.*, Ser. No. 78553715, 2007 TTAB LEXIS 73, at \*3-4 (TTAB 2007); TMBP § 1208.02 ("Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record.").

Applicant's appeal brief seems to imply that the Examining Attorney subsequently considered the listed registrations, stating that "the Examining Attorney is dismissive of these registrations because they may contain other terms."<sup>16</sup> However, we can find no indication in the record that the Examining Attorney otherwise considered or discussed the listed registrations. In fact, the Examining

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<sup>12</sup> *Id.* at 11.

<sup>13</sup> *Id.*

<sup>14</sup> *See* December 25, 2023 Request for Reconsideration at TSDR 4.

<sup>15</sup> January 30, 2024 Denial of Request for Reconsideration at TSDR 1-2.

<sup>16</sup> Appeal Brief, 6 TTABVUE 12.

Attorney's brief reiterates the evidentiary objection to the list and does not further address it or the listed registrations.<sup>17</sup> Therefore, the third-party registrations in the list are not properly of record and we have not considered the list or the registrations on it. *See id.*; TBMP § 1208.02 (indicating that the Board will not consider a list of registrations for whatever probative value it may have unless the list is deemed stipulated into the record because the examining attorney failed to timely and properly object to its introduction or otherwise discussed the registrations listed).

In view of the foregoing, there is no third-party registration evidence properly of record to show that ENSEMBLE has a normally understood and well-recognized descriptive or suggestive meaning when applied to the relevant services, such that the term could be considered conceptually weak.

The record does include a definition of "ensemble" indicating that the term refers to either "a group of musicians, actors, or dancers who perform together" or "a group of items viewed as a whole rather than individually."<sup>18</sup> Based on this definition, Applicant contends that ENSEMBLE, "in relation to delivery services is highly suggestive and nearly merely descriptive in that the consumer uses registrant's services to gather a bunch of items for delivery, just as the dictionary definition eludes [sic]."<sup>19</sup> This argument is unpersuasive, as it focuses on the meaning of ENSEMBLE in connection with delivery services, rather than Registrant's more relevant legally

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<sup>17</sup> Examining Attorney's Brief, 8 TTABVUE 9-10.

<sup>18</sup> December 25, 2023 Request for Reconsideration at TSDR 2 (consisting of a screenshot of search results for a search of the wording "definition of ensemble").

<sup>19</sup> Appeal Brief, 6 TTABVUE 12.

identical telecommunications services. Thus, even if we assume for the sake of argument that consumers would perceive ENSEMBLE as connoting the gathering of “a bunch of items for delivery,” that would not render the term “nearly merely descriptive” or even highly suggestive when applied to the relevant services. Accordingly, we deem the cited mark to have the normal scope of protection afforded an inherently distinctive mark.

## **2. Commercial Strength of the Cited Mark**

### **a. Fame – Fifth *DuPont* Factor**

The fifth *DuPont* factor examines the extent to which the public perceives the mark as indicating a single source of origin, i.e., its fame or commercial strength. *DuPont*, 476 F.2d at 1361. As is typical in an ex parte appeal, where the owner of the cited registration is not a party to the proceeding, the record in this case provides no basis for finding that the cited mark is famous or commercially strong when used in association with Registrant’s services.

Applicant argues that, because the cited mark is not famous, “there is no support for broad protection to be afforded to [the] registration.”<sup>20</sup> However, “[i]t is not necessary that a registered mark be famous to be entitled to protection against a confusingly similar mark.” *In re Big Pig, Inc.*, Ser. No. 78249582, 2006 TTAB LEXIS 479, at \*11 (TTAB 2006); *see also In re Davey Prods. Pty*, Ser. No. 77029776, 2009 TTAB LEXIS 524, at \*21 (TTAB 2009) (noting that the absence of evidence of fame “is not particularly significant in the context of an ex parte proceeding”).

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<sup>20</sup> *Id.* at 16.

In short, given that lack of evidence as to the fame of the mark, we consider the fifth *DuPont* factor to be neutral. See *In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 TTAB LEXIS 80, at \*4 (TTAB 2016) (citing *In re Thomas*, Ser. No. 78334625, 2006 TTAB LEXIS 135, at \*18 n.11 (TTAB 2006)).

**b. Similar Marks on Similar Services – Sixth *DuPont* Factor**

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods and services. *DuPont*, 476 F.2d at 1361; see *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at \*11 (TTAB 2016). The Federal Circuit has held that evidence of extensive registration and use of a term by others for similar goods or services can be “powerful” evidence of the term’s weakness. *Jack Wolfskin*, 797 F.3d at 1373-74; *Juice Generation*, 794 F.3d at 1339. If the evidence establishes that the consuming public is exposed to widespread third-party use of similar marks for similar goods or services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005).

Here, there are no third-party registrations properly of record for marks including the term ENSEMBLE in connection with telecommunication services. Further, the only potential evidence of third-party marketplace uses of marks identical or similar to the cited mark ENSEMBLE consists of a single page of truncated Google® search

results for the wording “ensemble company.”<sup>21</sup> Based on the minimal information listed in the search results, we find that none of these uses of ENSEMBLE on the page are in connection with services identical or similar to the relevant services listed in the cited registration. Thus, we find the sixth *DuPont* factor is neutral.

#### **D. Comparison of the Marks**

We now turn to the first *DuPont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 396 F.3d at 1371 (quoting *DuPont*, 476 F.2d at 1361). Similarity as to any one of these elements may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 732 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”); *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at \*13 (TTAB 2018).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic*, 866 F.3d 1315, 1324 (Fed. Cir. 2017)

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<sup>21</sup> December 25, 2023 Request for Reconsideration at TSDR 7. Applicant ostensibly submitted these search results in support of its argument that the extent of potential confusion is de minimis. *See* Appeal Brief, 6 TTABVUE 18. Nonetheless, because it has some relevance to the issue of third-party use, we consider it for whatever probative value it may have in that respect. While the search results are truncated, most of the listed entries have enough information for us to determine the nature of the services that the term ENSEMBLE is used in connection with. *Cf. Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, Opp. No. 91195552, 2017 TTAB LEXIS 300, at \*28-29 (TTAB 2017) (noting that the Google® of record were “not very probative” because they were “very truncated and [did] not provide . . . sufficient information upon which to make a clear finding”),



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(quoting *Coach Servs. Inc.*, 668 F.3d at 1368 (internal quotation marks 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 Box Sols. Corp.*, Ser. No. 76267086, 2006 TTAB LEXIS 176, at \*14 (TTAB 2006).

All elements of the respective marks must be considered. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). However, “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 consideration of the marks in their entireties.” *Id.*

Here, Applicant’s mark is **ENSOMBL** in standard characters and the cited mark is **ENSEMBLE**, also in standard characters.

The only difference in the spelling of the two marks is that Applicant’s mark substitutes an “O” for the second “E” in the cited mark and deletes the final “E.” Thus, the marks are highly similar in terms of appearance and the slight difference in spelling does little to visually distinguish the marks. *See In re Peace Love World Live, LLC*, Ser. No. 86705287, 2018 TTAB LEXIS 220, at \*23 (TTAB 2018) (“Slight differences in marks do not normally create dissimilar marks.”).

As to the sound of the marks, Applicant argues that they are “pronounced differently” because “Applicant’s mark contains the sound SOM”<sup>22</sup> and the cited mark “contains the sound SEM.”<sup>23</sup> This argument, however, is unavailing because it ignores

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<sup>22</sup> Appeal Brief, 8 TTABVUE 9.

<sup>23</sup> *Id.*

the fact that the American English pronunciation of the “SEM” syllable in the word “ensemble” is essentially the phonetic equivalent of “SOM,” i.e., both can be pronounced as “sahm.”<sup>24</sup> We acknowledge that, generally, there is no correct pronunciation of a trademark that is not a known word. *See In re Belgrade Shoe Co.*, 411 F.2d 1352, 1353 (CCPA 1969). And it is not possible for a trademark owner to control how purchasers will vocalize its mark. *See Centraz Indus., Inc. v. Spartan Chem. Co.*, Opp. No. 91159335, 2006 TTAB LEXIS 20, at \*10 (TTAB 2006). However, in this case, given that ENSOMBL is highly similar to the known word ENSEMBLE, it is reasonable to conclude that consumers viewing the respective marks would view them as phonetic equivalents and thus pronounce them the same way.

Applicant argues that the respective marks have different meanings, because the cited mark ENSEMBLE is an actual word with a known definition, whereas ENSOMBL is “a coined term that relates to the Applicant” and “has no actual meaning in the English dictionary.”<sup>25</sup> However, given that ENSOMBL and ENSEMBLE are highly similar in appearance, may be pronounced the same, and are applied to services that are legally identical in part, consumers will likely view them as having the same connotation and commercial impression. Accordingly, we find that the first *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

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<sup>24</sup> See December 25, 2023 Request for Reconsideration at TSDR 2 (consisting of a screenshot of a definition of “ensemble” indicating the pronunciation as “/än sämbel/”).

<sup>25</sup> Appeal Brief, 8 TTABVUE 11.

**E. Purchasing Conditions and Sophistication of Purchasers**

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. Applicant contends that its “purchasers . . . are sophisticated business professionals”<sup>26</sup> who are “not likely to be confused by a food delivery service and that of a service that provides financial market information.”<sup>27</sup>

Applicant’s argument relies on a presumption, based on some of the wording in the cited registration’s identification of services, that Registrant’s services are qualitatively different from Applicant’s, and thus cater to different types of consumers. However, Registrant’s services are identified in such a way that we cannot limit each segment by what is in the other segments. *See In re Midwest Gaming & Entm’t LLC*, Ser. No. 85111552, 2013 TTAB LEXIS 55, at \*9 (TTAB 2013) (finding that, because a semicolon separated the two relevant clauses in registrant’s identification, the clause identifying “restaurant and bar services” is a discrete category of services that stands alone and independently as a basis for likelihood-of-confusion analysis, and is not connected to nor dependent on the services set out on the other side of the semicolon). Therefore, Registrant’s services identified as “Telecommunications, namely, transfer of data by telecommunications” are not limited to food delivery. As discussed above, Registrant’s services are legally identical in part to Applicant’s services. Therefore, we must presume that at least some of

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<sup>26</sup> *Id.* at 16.

<sup>27</sup> *Id.*

Applicant's services and Registrant's services travel through the same channels of trade and are offered to the same or overlapping classes of purchasers.

While Applicant has not provided evidence to support its consumer sophistication arguments, we do acknowledge that financial professionals and investment advisors may be more discerning than the average purchaser, and that telecommunications services are not typically purchased on impulse. However, even sophisticated purchasers are not immune from source confusion, especially where, as here, the relevant services are legally identical in part and are being offered under highly similar marks. *See Shell Oil Co.*, 992 F.2d at 1208 (citing *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990) (affirming the Board's reasoning that even sophisticated purchasers may be confused by similar marks)).

In any event, while Applicant's services are specifically directed toward financial professionals and investment advisors, Registrant's relevant telecommunications services have no such specification as to the relevant consumers. Thus, we must presume that the relevant consumers here could include both professionals and the general public, and our analysis must consider the purchasing care of the least sophisticated potential purchasers. *See In re FCA US LLC*, Ser. No. 85650654, 2018 TTAB LEXIS 116, at \*29 (TTAB 2018).

We find this factor to be neutral.

#### **F. Actual Confusion**

The seventh and eighth *DuPont* factors relate, respectively, to the nature and extent of any actual confusion and the extent of the opportunity for actual confusion. *See DuPont*, 476 F.2d at 1361. Applicant notes that it "has no record of any actual

confusion among consumers that would indicate a likelihood of confusion between the marks,” but concedes that “[t]here has not been concurrent use to know whether it was done with or without confusion.” Accordingly, we treat these factors as neutral and give them no weight in our analysis. *See Davey Prods.*, 2009 TTAB LEXIS 524, at \*22-25.

**G. Variety of Services Offered Under the Cited Mark**

Under the ninth *DuPont* factor, we consider any evidence or arguments as to the “variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark).” *DuPont*, 476 F.2d at 1361. Applicant argues that this factor favors it “because with a couple of dozen marks that are actually identical to the registrant’s, this information suggests that consumers are able to distinguish the identical mark for services that could be related.”<sup>28</sup> This argument not only relies on evidence not properly of record, but also appears to be based on misconception of the ninth *DuPont* factor’s significance and application. Specifically, the ninth *DuPont* factor applies when there is evidence that a mark at issue is a house mark or a product mark, which may have some bearing on the likelihood of confusion between marks. *See, e.g., In re Toshiba Med. Sys. Corp.*, Ser. No. 79046106, 2009 TTAB LEXIS 447, at \*8-9 (TTAB 2009). Here, there is no evidence relating to this factor and we therefore deem it neutral in our analysis.

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<sup>28</sup> *Id.* at 17.

## H. Market Interface Between Applicant and Registrant

Applicant also invokes the tenth *DuPont* factor, concerning the market interface between Applicant and Registrant, *DuPont*, 476 F.2d at 1361, noting that “[t]here is no evidence of market interface between Applicant and the owner of the registered references as indicated by the fact that the two companies have diverging channels of trade, distribution and target markets.”<sup>29</sup> Thus, Applicant argues, “[t]his factor should support registration of Applicant’s mark for the services.”<sup>30</sup>

Applicant appears to also misunderstand the application of this factor, which is relevant when there is evidence of prior interactions or agreements between Applicant and Registrant that would affect the likelihood-of-confusion analysis. *See id.* (listing examples of relevant market interactions or agreements between an applicant and registrant). Here, there is no such evidence and thus we treat this factor as neutral.

## I. Applicant’s Right to Exclude Others from Use of its Mark

The eleventh *DuPont* factor concerns “[t]he extent to which **applicant** has a right to exclude others from use of its mark on its goods [or services].” *DuPont*, 476 F.2d at 1361 (emphasis added). In Applicant’s appeal brief, Applicant refers instead to **Registrant’s** right to exclude use of its mark by others and argues that “[t]he couple dozen federally registered ENSEMBLE marks should be sufficient to permit registration of Applicant’s mark based on the fact that Applicant is in a particularly

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<sup>29</sup> *Id.* at 17-18.

<sup>30</sup> *Id.* at 18.

niche field with sophisticated consumers” and thus “even subtle differences in the marks overall would be noticed by the target consumers.”<sup>31</sup>

These arguments are more relevant to other factors already discussed above. As there is no evidence of circumstances or prior rights relevant to Applicant’s entitlement to exclude others from use of its mark, the eleventh *DuPont* factor is neutral in this case. *See Davey Prods.*, 2009 TTAB LEXIS 524, at \*25-26.

#### **J. Extent of Potential Confusion**

Under the twelfth DuPont factor we consider “the extent of any potential confusion, i.e., whether de minimis or substantial,” which is the twelfth *DuPont* factor. *DuPont*, 476 F.2d 1361. Applicant argues that, here, “the extent of potential confusion among consumers is de minimis,”<sup>32</sup> because “[a] simple search engine query of the two marks reveals the that neither company comes up high or at all in a search, resulting in a low chance that consumers searching for either would end up at the wrong place.”<sup>33</sup>

This argument is unavailing. The marks here are highly similar, and Applicant’s and Registrant’s services are legally identical in part and thus presumably travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. And the record contains no evidence that the telecommunications services at issue are marketed to or purchased by a small or otherwise limited number of consumers. Thus, the extent of potential confusion cannot reasonably be deemed

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<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

to be de minimis. *See, e.g., Davey Prods.*, 2009 TTAB LEXIS 524, at \*26 (rejecting applicant’s argument that the potential for confusion was de minimis where the goods at issue “would be marketed to and purchased by significant numbers of purchasers”).

This factor is, at best, neutral.

### **III. Conclusion**

Having carefully considered all of the arguments and evidence of record and all relevant *DuPont* factors, we find that (1) the respective marks are highly similar, (2) Applicant’s and Registrant’s services are legally identical in part, (3) the legally identical in part services are presumed to travel in identical trade channels and be offered to identical overlapping classes of purchasers, (4) the evidence of record does not establish that the cited mark is conceptually or commercially weak, and (5) the remaining *DuPont* factors discussed above are neutral. Thus, on the whole, the relevant *DuPont* factors weigh in favor of finding that confusion as to source is likely.

**Decision:** The refusal to register Applicant’s mark **ENSOMBL** under Section 2(d) of the Trademark Act is affirmed.