

This Opinion is not a  
Precedent of the TTAB

Mailed: March 28, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board

—  
*In re Gree, Inc.*

—  
Serial No. 86170852

—  
Ann K. Ford, David M. Kramer, and James K.S. Stewart of DLA Piper LLP,  
for Gree, Inc.

Christopher Buongiorno, Trademark Examining Attorney, Law Office 102,  
Mitchell Front, Managing Attorney.

—  
Before Quinn, Kuhlke and Heasley,  
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Gree, Inc. (“Applicant”) seeks registration on the Principal Register of the mark GREE (in standard characters) for “providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images

and digital music via a global communication network for social networking in the fields of social games, video games, and general interest,” in International Class 38.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the following registered mark as to be likely, when used on or in connection with the identified goods, to cause confusion or mistake, or to deceive:



“G GREE” in stylized font) for “radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network” in International Class 38, among other goods and services not relevant here.<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration.<sup>3</sup> After the Examining Attorney denied the request for reconsideration,<sup>4</sup> the appeal was resumed. We affirm the refusal to register.

---

<sup>1</sup> Application Serial No. 86170852 was filed on January 21, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> Registration No. 4362969, registered on the Principal Register on July 9, 2013.

<sup>3</sup> 4 TTABVUE. In the request for reconsideration, Applicant added Section 44(e), 15 U.S.C. § 1126(e), as a filing basis and amended its identification of services to its current description.

<sup>4</sup> TTABVUE 3.

<sup>4</sup> 5 TTABVUE.

## I. Analysis

### A. Identification of Services.

We first address a preliminary issue that has arisen concerning Applicant's identification of services. In its request for reconsideration, Applicant amended its recitation of services from this:

“providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest; electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network”

to this:

“providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest.”<sup>5</sup>

The Examining Attorney found Applicant's amendment unacceptable because it impermissibly broadened the identification--first by adding goods in the form of “software applications” and second by deleting the limiting language “in the fields of social networking and general interest.”<sup>6</sup> *See generally In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re Thomas White Int'l, Ltd.*, 106 USPQ2d 1158, 1160 n.2 (TTAB 2013); 37 CFR § 2.71(a); TMEP § 1402.06 (2015).

As Applicant explains, though, the amendment proposed in its May 13, 2015 request for reconsideration does not expand the scope of services. It does not purport

---

<sup>5</sup> Request for reconsideration, 4 TTABVUE 3.

<sup>6</sup> Office Action denying request for reconsideration, 5 TTABVUE 2, Examining Attorney's brief, 9 TTABVUE 15-16.

to offer “software applications” as goods sold under the mark; it delimits the *channels* through which its services are rendered to Applicant’s social networking websites and software applications.<sup>7</sup> And the limiting language “in the fields of social networking and general interest” is retained, in substance, in the amended phrase “for social networking in the fields of social games, video games, and general interest,” which modifies and delimits the entire identification of services.<sup>8</sup> Hence, Applicant’s May 13, 2015 amendment limits, rather than broadens, its scope of services, and is acceptable. *Id.* As will be seen, however, the amendment does not materially affect the likelihood-of-confusion analysis or the outcome of this decision.

**B. Likelihood of Confusion.**

We determine the likelihood of confusion *vel non* between Applicant and Registrant’s marks under Section 2(d) of the Trademark Act based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B & B Hardware, Inc. v. Hargis Industries, Inc.*, \_\_ U.S. \_\_, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor that is relevant and for which there is evidence of record. See *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d

---

<sup>7</sup> Applicant’s reply brief, pp. 9-10, 10 TTABVUE 10-11.

<sup>8</sup> Applicant’s reply brief, pp. 8-9, 10 TTABVUE 9-10.

1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). And we treat as neutral those *DuPont* factors for which there is no evidence or argument of record.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1409 (TTAB 2015). We address these factors in turn.

### 1. Similarity of the Marks.

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's mark to the cited registered mark as viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013).

Applicant does not take issue with the Examining Attorney's finding that its applied-for mark is similar to the cited registration, for good reason: its mark, **GREE** (in standard characters), is virtually identical to the registered mark:



The stylized font of Registrant's "G GREE" mark makes little difference. “Indeed, we previously have rejected an applicant's argument that its standard character

mark was distinct from a mark registered in stylized lettering with a design.” *In re Viterra Inc.*, 671 F.3d 1358, 1364, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012) (quoting *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937 (Fed. Cir. 1983) (“[b]y presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party” (emphasis in original))). Applicant could display its standard character mark in the same style and font as shown in Registrant’s mark:

The image shows the word "GREE" in a bold, italicized, sans-serif font. The letters are thick and slanted to the right, with a slightly irregular, hand-drawn appearance. The 'G' is particularly prominent, with a thick vertical stem and a curved top that extends to the right.

Registrant’s mark incorporates Applicant’s mark in its entirety, increasing the similarity between the two. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women’s clothing stores and women’s clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women’s clothing). Prospective customers would tend to pay less attention to the stylized “G” in Registrant’s mark, which appears more like a design than a letter. *In re Viterra Inc.*, 101 USPQ2d at 1908 (Where marks consist of words and a design, the words are normally given greater weight because they would be used by consumers to request the goods or services.).

Consumers would tend to view GREE as a shortened form of Registrant’s mark, and to pronounce the marks the same, as they naturally shorten their pronunciation of marks and trade names. *See U.S. Shoe Corp.*, 229 USPQ at 709 (“Applicant’s mark

would appear to prospective purchasers to be a shortened form of registrant's mark.”); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992).

Consequently, under the first *DuPont* factor, the pronounced similarity of the marks weighs heavily against Applicant.

## **2. Relatedness of Services.**

We have devoted attention to the first *DuPont* factor because it has an effect on the second: comparing the services identified in the application and the registration. *See Stone Lion Capital Partners*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The greater the degree of similarity between the marks, the lesser the degree of similarity between the services necessary to support a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Applicant's services are “providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest” in International Class 38. Registrant's relevant services are “radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about

telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network” in International Class 38.

Applicant argues that its services differ so greatly from those in the cited registration that confusion is unlikely. It argues, specifically, that “Applicant provides online chat rooms and electronic bulletin boards exclusively via its proprietary GREE-brand social networking websites. Applicant is not an Internet service provider and does not provide radio, television, cable or other broadcasting services. ... Applicant respectfully notes that the Cited Registration does not relate to social networking services or electronic transmission of messages via such proprietary services.”<sup>9</sup>

The issue, though, is not whether purchasers would confuse the services, but whether they would confuse the source of the services. *In re Binion*, 93 USPQ2d 1531, 1535 (TTAB 2009). “[I]t is not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services 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 originated from the same producer.” *Id.* at 1534-35.

---

<sup>9</sup> Applicant’s brief, pp. 7-9, 7 TTABVUE 8-10.

In this case, Registrant provides users access to a global computer network, and Applicant provides users access to one another—via chat rooms and electronic bulletin boards—within that global computer network. Users are likely to perceive that these complementary and overlapping services derive from the same source, as evidenced by multiple third-party registrations for both sorts of services. *See In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). The record, in fact, reveals over twenty use-based, third-party registrations covering services of the type identified in the application and the cited registration. For example:

- Reg. No. 3174386 for *inter alia* “providing on-line chat rooms and on-line electronic bulletin boards for transmission of messages among computer and telephone users ... and providing multiple-user access to a global computer information network....”
- Reg. No. 3568975 for *inter alia* “providing multiple-user access to a global computer information network, providing private and secure real time electronic communication over a computer network, providing telecommunications connections to a global computer network, voice chat services, ... providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest....”
- Reg. No. 3664274 for *inter alia* “providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest, providing telecommunications connections to a global

computer network, providing multiple-user access to a global computer network, providing Internet chatrooms....”

- Reg. No. 3697570 for *inter alia* “providing multiple user access to the Internet to allow users to access information, audio and video via websites, online forums, chat rooms, and blogs, providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest, ...providing high speed access to area networks and global computer information networks....”<sup>10</sup>

These registrations, as well as the others of record, show that the services identified in the application and the cited registration may indeed emanate from a single source under a single mark. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) *aff'd per curiam* 864 F.2d 149 (Fed. Cir.1988). Hence, under the second *DuPont* factor, Applicant’s services are related to those provided under the cited registration.

### **3. Channels of Trade.**

Even though the third-party registrations “may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source,” *Albert Trostel & Sons*, 29 USPQ2d at 1786 (emphasis added), Applicant argues that the registrations are by no means conclusive

---

<sup>10</sup> Office Action of April 28, 2014, pp. 2, 6, 9, 15.

in demonstrating that consumers would perceive the services at issue as emanating from a single source.<sup>11</sup> Rather, Applicant asserts, “As shown by the amended recitation of services [as of May 13, 2015] the services intended to be offered by Applicant under the applied-for mark are offered strictly within the context of Applicant’s proprietary social networking website. Therefore, a consumer will only encounter the services covered under the Application within the framework of Applicant’s proprietary social network. This means that a consumer will not have access to the services appearing in the Application unless they have already registered an account on Applicant’s proprietary social network.”<sup>12</sup>

As the Examining Attorney notes, however, Applicant “offers no explanation on how this ‘proprietary network’ is so exclusive within the Internet whereby it prevents users of registrant’s services from associating registrant’s services with applicant’s services. ... An individual using such a network is exposed to various services offered by other entities. His or her mere use of a social network would not insulate that individual from services offered within it or outside of it.”<sup>13</sup> As Applicant’s reply brief illustrates, the iTunes App Store and Google Play offer myriad downloadable mobile software applications for “chat,” “messages,” and “bulletin board.”<sup>14</sup> Hence, the channels of trade would not insulate Registrant’s users from exposure to Applicant’s

---

<sup>11</sup> Applicant’s reply brief, p. 7, 10 TTABVUE 8.

<sup>12</sup> Applicant’s appeal brief, p. 9, 7 TTABVUE 10.

<sup>13</sup> Examining Attorney’s brief, 9 TTABVUE 13-14.

<sup>14</sup> Applicant’s reply brief, pp. 10-17, 10 TTABVUE 11-18.

related services offered under a confusingly similar mark, and would not mitigate the likelihood of confusion.

Users, having gained access to the Internet, could still infer, mistakenly, that Applicant's services were sponsored, affiliated or connected with Registrant. As the Board has observed, "likelihood of confusion encompasses confusion of sponsorship, affiliation or connection." *Gen. Mills, Inc. v Fage dairy Proc. Ind. S.A.*, 100 USPQ2d 1584, 1594 (TTAB 2011) *judgment set aside, opinion not vacated by General Mills, Inc. v. Fage Luxembourg S.A.R.L.*, 110 USPQ2d 1679 (TTAB 2014). *See also In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 n.7 (TTAB 1984) ("It may be appropriate at this point to note, as has been observed by one commentator, that the statutory concept of 'likelihood of confusion' denotes any type of confusion, including not only source confusion but also 'confusion of affiliation; confusion of connection; or confusion or sponsorship"). 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:6 (4th ed. 2016).

This *DuPont* factor is therefore neutral.

#### **4. Applicant's Companion Application.**

Applicant finally argues that on September 14, 2011, it filed a "Companion Application," Serial No. 85422099, seeking registration on the Principal Register of the following word and design mark:



based on intent to use under Section 1(b) and later, on Section 44(e), for *inter alia* “Providing on-line chat rooms and electronic bulletin boards for social networking; providing on-line chat rooms and electronic bulletin boards for registered users for transmission of messages and photographs concerning collegial life, general interest, social networking, social gaming and photo sharing,” in International Class 38.

In its initial brief on appeal, Applicant noted that the Companion Application’s filing date of September 14, 2011 predated the May 2, 2012 filing date of the cited Registration. The USPTO’s failure to suspend further examination of the underlying application for the cited Registration pending disposition of the Companion Application therefore implied, in Applicant’s view, that the USPTO found the marks’ services dissimilar. Applicant asked the Board to rule consistently with that implied finding.<sup>15</sup>

In its reply brief, however, Applicant noted that the Companion Application received a December 15, 2015 Office Action refusing registration as to its International Class 38 services due to a likelihood of confusion with the cited Registration.<sup>16</sup> Applicant insists that that refusal is improper under 37 CFR § 2.83(a) and TMEP § 1208.01, given its earlier effective filing date. It argues: “Therefore, the refusal of the Companion Application cannot be used by the Examining Attorney to support the refusal of the Application here. Applicant respectfully requests that the Board act consistently and withdraw the likelihood of confusion refusal on the basis

---

<sup>15</sup> Applicant’s brief, pp. 10-11, 7 TTABVUE 11-12.

<sup>16</sup> Application Serial No. 85422099, Office Action of Dec. 15, 2015.

that the marks at issue are not likely to be confused. A failure to do so would be to the prejudice of the Applicant in light of its prior rights in the GREE & Design mark in Class 38, as established by the existence of the Companion Application.”<sup>17</sup>

The authority on which Applicant relies refers to pending applications. *Id.* Section 1208.01 of the Trademark Manual of Examining Procedure goes on to state, “However, once a registration issues, a likelihood-of-confusion refusal that is required by the Trademark Act applies regardless of the filing-date priority of the underlying application. Internal examination procedures do not have primacy over statutory law, and a refusal that is authorized by the Trademark Act will not be considered invalid due to errors in examination procedure.” TMEP § 1208.01. As the Board stated in *In re House Beer, LLC*, 114 USPQ2d 1073 (TTAB 2015), where a similar state of facts arose:

[R]efusal of registration was procedurally sound, being based upon Section 2(d) of the Trademark Act, which provides for refusal on the basis of a mark's resemblance to “a mark *registered* in the Patent and Trademark Office. ...” 15 U.S.C. § 1052(d) (emphasis added). This provision of the statute makes no reference to the filing date of the application underlying the registration cited as the basis for the refusal. If the mark is registered, it may be cited as grounds for refusing registration.  
*Id.* at 1076.

The cited registration is presumed valid, 15 U.S.C. § 1057(b) *cited in B & B Hardware*, 113 USPQ2d at 2049, and Applicant cannot rebut that presumption by a thinly-veiled and impermissible collateral attack made in the course of this *ex parte* proceeding. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed.

---

<sup>17</sup> Applicant's reply brief, p. 6, 10 TTABVUE 7.

Cir. 1997); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 n.13 (TTAB 2015). We therefore decline Applicant's request to reverse the likelihood-of-confusion refusal in this case based on the claimed priority of Applicant's Companion Application.

## II. Conclusion

Each case must be decided on its own facts. *In re Binion*, 93 USPQ2d at 1536. In this case, after considering all evidence and arguments bearing on the *DuPont* factors, including the evidence and arguments that we have not specifically discussed herein, we find that Applicant's GREE mark, as used in connection with the services identified in the application, so resembles the registered mark,



as used in connection with the services identified in the registration, as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

**Decision:** The refusal to register Applicant's mark GREE is affirmed.