

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 21, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pizza Inn, Inc.

Serial No. 88244151

Rebecca Liebowitz of Venable LLP, for Pizza Inn, Inc.

Lakeisha Lewis, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

Before Goodman, Heasley and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Pizza Inn, Inc., seeks to register the mark HIGH FIVE (in standard characters) on the Principal Register for “Pizza for consumption on or off the premises” in International Class 30.¹

The Trademark Examining Attorney has refused registration under Section 2(d)

¹ Application Serial No. 88244151 (“the Application”) was filed on December 28, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and first use in commerce since as early as 2017.

TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations in this opinion refer to the docket and electronic file database for the involved application and are to the downloadable .PDF version of the documents.

of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, used in connection with the identified goods, is likely to cause confusion with the marks HIGH FIVE and HIGH FIVE FOR HEALTHY KIDS, both in standard characters and owned by the same entity, for "bakery goods" in Class 30.²

After the refusal was made final, Applicant filed a request for reconsideration, which the examining attorney denied, and appealed to this Board. For the reasons discussed below, we affirm the refusal.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark may be refused registration if it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

15 U.S.C. § 1052(d), *quoted in In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023).

To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. duPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (the "DuPont factors"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). "Whether a likelihood of confusion exists

² Registration Nos. 3336233 (HIGH FIVE) and 3299146 (HIGH FIVE FOR HEALTHY KIDS) issued on November 13, 2007 and September 25, 2007, respectively; both renewed.

between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). "The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods." *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (internal punctuation omitted).

We focus our analysis on Registrant's standard-character mark HIGH FIVE in Registration No. 3336233, which is identical to Applicant's mark HIGH FIVE in the Application. If we find confusion likely between these marks, we need not consider the likelihood of confusion between Applicant's mark and Registrant's mark HIGH FIVE FOR HEALTHY KIDS. On the other hand, if we find no likelihood of confusion between these marks, we would not find confusion likely based on the HIGH FIVE FOR HEALTHY KIDS mark. *See Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *12 (TTAB 2023) (confining likelihood of confusion analysis to most similar pleaded mark) (citing *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *6 (TTAB 2020)) (subsequent history omitted).

A. Similarity of the Marks

Under the first *DuPont* factor, we find that Applicant's mark HIGH FIVE and Registrant's mark HIGH FIVE are identical "in their entirety as to appearance,

sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567. Because they are identical, the marks are likely to engender the same connotation and overall commercial impression when considered in connection with Applicant’s and Registrant’s respective goods. *In re i.am.symbolic*, 116 USPQ2d at 1411-12.

And since both marks are in standard characters, they could be displayed in the same font, size, style, and color, with the same letters capitalized or in lower-case, thereby enhancing the likelihood of confusion. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1158-59 (TTAB 2017). Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a).

Applicant does not address the similarity of the marks in its brief. The first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

B. Similarity of the Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration” A proper comparison of the goods “considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

Applicant’s goods, again, are “pizza[s] for consumption on or off the premises” and Registrant’s goods are “bakery goods.”

The Examining Attorney asserts that the goods are identical in part and thus

overlapping because “bakery goods” “presumably encompasses all goods of the type described, including applicant’s more narrow ‘pizza for consumption on or off the premises.’”³ Furthermore, she asserts quoting Bakerpedia.com, “Pizza is one of the most widely consumed savory bakery products,” and the evidence shows that “pizza is considered a baked good.”⁴

“To the extent that applicant’s and the registrant’s goods are not legally identical,” the Examining Attorney provides Internet evidence from approximately thirty third-party websites that she contends “further supports that these goods are related and sold in the same trade channels....”⁵ The following examples are representative:

- Di Camillo Bakery (dicamillobakery.com) has several locations and “is best known for Handmade breads, rolls, pizza, cakes, cookies, donuts & Italian bakery specialties.”⁶



- Tripoli Pizza Bakery (tripolibakery.com) offers pizza, cakes, cookies, pastries,

³ 9 TTABVUE 5-6 (Examining Attorney’s Brief).

⁴ *Id.*

⁵ *Id.* at 6.

⁶ March 24, 2019 Office Action, TSDR 12.

and bread in its store. “In 1944, the Zappala family decided to add to their offerings, and introduced pizza to the bakery. In no time, the pizza business began to boom.”⁷



- Village Bakery (villagebakerync.com) “start[s] each day as a bakery, baking off a large assortment of breakfast pastry (scones, bagels, Danish, croissant, cookies and more) and organic brick over breads,” and “[b]y 11:00 am we start serving lunch which includes salads, wood fired pizza, and hearty sandwiches on our house made breads.”⁸

- Nanas (nanasct.com) “is an organic bakery and pizza shop, offering naturally leavened dough using regional and sustainable grown grains”:⁹



- Savastano’s Bakery & Pizzeria (savastanosbakerypizzeria) offers pizzas, stuffed bread, submarine sandwiches, and cookies.¹⁰

⁷ *Id.* at 16.

⁸ November 8, 2022 Final Office Action, TSDR 7-16.

⁹ *Id.* at 18-21.

¹⁰ *Id.* at 22-23.

- Yia Yia's Pizzeria (yiayiasbakery.com/pizzeria) offers pizza, breads, pastries, and cakes, and pies.¹¹



- Berkshire Mountain Bakery provides a variety of bakery items including artisanal breads and pizzas.¹²
- Bakery San Juan (bakerysanjuan.com) bakes pizzas, breads, and cakes.¹³
- Maiké's Bakery & Coffee Shop (maikesbakery.weebly.com) is a bakery and café that offers pizza and coffee in addition to other foods:¹⁴



- Kilauoa Bakery (kilauoabakery.com) offers a variety of bakery items such as cinnamon buns, chocolate coconut cream eclairs, apple turnovers, cakes, and pizzas.¹⁵

¹¹ *Id.* at 24-33.

¹² *Id.* at 34-38.

¹³ *Id.* at 39-48.

¹⁴ *Id.* at 49-50.

¹⁵ *Id.* at 52-55.



- Nabolom Bakery (nabolombakery.com) offers a variety of baked goods such as croissants, buns, muffins, cakes, scones, and pizzas.¹⁶



- Hideaway Bakery (hideawaybakery.com) offers frozen wood oven pizzas, as well as muffins, sweet breads, cookies, pastries and other desserts.¹⁷



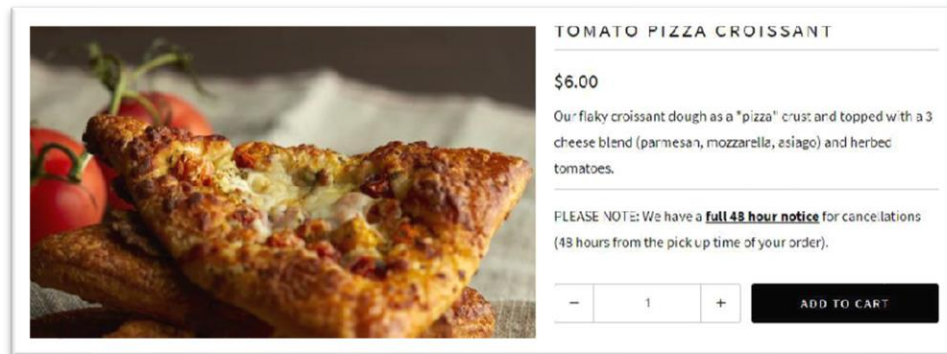
- Wayfarer (wayfarerbakery.com) offers breads, croissants, buns, scones, cookies, and other baked goods, and has “pizza night” on Saturdays and Sundays.¹⁸

¹⁶ June 7, 2023 Reconsideration Letter, TSDR 13-21.

¹⁷ *Id.* at 22-25.

¹⁸ *Id.* at 27.

- Noe Valley Bakery (noevalleybakery.com) provides various breads and pastries, including a tomato pizza croissant:¹⁹



- Goode & Fresh Pizza Bakery (pizzabakery.com) offers a variety of menu items, including pizza, pasta, salads, subs and sandwiches, and desserts at its pizza bakery.



- Roma Bakery and Pizzeria (romabakeryandpizzeria.com) offers pizza and Mediterranean baked goods at its Dearborn, Michigan location.²⁰
- Bread & Roses Bakery (bnrbakery.com) offers pizzas, breads, and pastries.²¹
- Original Italian Bakery (theoriginalitalianbakery.com) offers pizzas, pizza

¹⁹ *Id.* at 32-37.

²⁰ *Id.* at 39-41.

²¹ *Id.* at 43-47.

chips, pastries, and biscuits.²²

- Honey Moon Bakery & Pizzeria (shophoneymoon.co) offers various baked goods and artisanal sourdough pizza in Frenchtown, NJ.²³



- Blue Moon bakery, pizzeria, and café (bigskybluemoonbakery.com) operates in Blue Sky, Montana.²⁴

- Sunrise Bakery (sunrisebakery.com) serves pizzas, calzones, sandwiches, and cakes at its Hibbing, Minnesota location.²⁵

- “Since 1953,” Cacia’s Bakery (caciabakery.com) in Philadelphia, PA offers bread/rolls, pizza, Stromboli, cannoli, pastries, and catering.²⁶

- River to River Bakery & Pizza (raccoonforks.com/rivertoriverbakery) serves donuts, breads, bagels, pizzas, and other pastries at its Adel, IA location.²⁷

- Piro’s Italian Bakery (pirosbakery.com) offers Sicilian-style pizza, fresh meat and spinach pies, and a “large variety of Italian breads, desserts, cookies, pies and

²² *Id.* at 48-50.

²³ *Id.* at 52-54.

²⁴ *Id.* at 55-57.

²⁵ *Id.* at 58-63.

²⁶ *Id.* at 68-73.

²⁷ *Id.* at 74.

cakes....”²⁸

- Ken’s Artisan (kensartisan.com) offers a bakery and a pizzeria at different locations in Portland, OR.²⁹

Ken’s Artisan Bakery



338 NW 21st Avenue, Portland, OR. (Map)

Ken’s Artisan Pizza



304 SE 28th Avenue, Portland OR. (Map)

- Fabiani’s Bakery (fabianis.com) offers “Fine Italian Dining and Baked Goods.”³⁰
- Yale Bakery (yalebakery.com) offers stone fired pizzas and a variety of bakery goods including donuts, cookies, muffins, turnovers, breads, and pies.³¹
- Boca Argentine Bakery and Pizzeria (bocarestobar.com) is “[a] new Seattle pizza lunch and bakery spot” with sandwiches, pastries, desserts “and of course, pizza.”³²



²⁸ *Id.* at 75-76.

²⁹ *Id.* at 77-78.

³⁰ *Id.* at 79-80.

³¹ *Id.* at 82-87.

³² *Id.* at 88-90.

Internet evidence may be probative of relatedness. *Made in Nature, LLC v. Pharmavite, LLC*, 2022 USPQ2d 557, at *46 (TTAB 2022) (third-party websites promoting sale of both parties' sorts of goods showed relatedness); *In re Embiid*, 2021 USPQ2d 577, at *28-29 (TTAB 2021) (evidence of third-parties offering goods of both applicant and registrant pertinent to relatedness of the goods); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015) (relatedness found where Internet evidence demonstrated goods commonly emanated from the same source under a single mark). The foregoing evidence provided by the Examining Attorney is sufficient to show that the goods of both Applicant and Registrant are often offered under the same mark by the same purveyors and thus are related. *See In re Detroit Athl. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir 2018) (crediting relatedness evidence that third parties use the same mark for the goods at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard*, 62 USPQ2d at 1004 (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

In addition to this Internet evidence, the Examining Attorney submits approximately “fifty (50) registrations that provide goods of both” Applicant and Registrant, including the following examples:³³

Registration No.	Mark	Relevant Goods
5463818	SURF RIDER PIZZA CO.	Prepackaged meals primarily consisting of pizza

³³ *Id.* at 96-178.

		Desserts, namely, baked goods
5709757	LOVE IS WHAT WE KNEAD (Stylized)	Pizza
		Bread, buns, cakes, cookie dough, cookies, croissants, Danish, dough, muffins, pastries, scones
6119809	PANGEA KETO	Frozen pizzas
		Bread, bakery desserts and candies
7031289	9 SISTERS GOORMÁ	Pizza
		Bakery goods; baked goods, namely, cakes, cookies, pastries, cupcakes, muffins, bread, biscuits
6183710	KARLA BAKERY	Pizza
		Bakery products; baked goods, namely, bread, cakes, pastries, quiche, tarts
6027664	PIE JACKED	Pizza
		Bakery desserts, bakery goods, pies, cakes, cookies, brownies, cupcakes, pastries, doughnuts
5760975	RISE + ROAM	Pizza
		Bakery products; bakery goods; bakery desserts; bread; pastry and confectionery
5735516	THREE BAKERS	Gluten-free pizza
		Gluten-free baked goods, namely, breads, rolls, bagels, buns, pastries, brownies, cookies

5734822	FARINOLIO	Pizza
		Baked goods, namely, bread, pastries
6868072	GRUB & CO	Pizza
		Buns, rolls, biscuits, bread, bakery goods and dessert items, namely, bakery desserts, cake, cupcakes, Danishes, brownies, muffins
6503658	KARLA CUBAN BAKERY	Pizza
		Bakery products; baked good, namely, bread, cakes, pastries, tarts
6907816	SCHLOTZSKY'S IT'S A MOUTHFUL	Pizza
		Bakery goods, cookies, cakes, cheesecake, brownies

Third-party registrations have probative value to the extent they may serve to suggest that such goods are of a type which emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, n.6 (TTAB 1988).

In view of the foregoing, we find that Applicant's pizza and Registrant's bakery goods are closely related.

Despite the foregoing evidence, Applicant maintains that pizza and bakery goods are unrelated. According to Applicant, "the Examining Attorney's evidence consisted primarily of examples of business that have both a bakery operation and a separate

restaurant or café operation.”³⁴ “In many instances,” Applicant argues, “the bakery operation exists either at an entirely separate location or it operates at limited morning hours, whereas the pizzeria, restaurant or café side of the business operates in separate evening hours.”³⁵ Applicant’s argument, however, is unsupported. Contrary to Applicant’s contentions, the numerous examples provided by the Examining Attorney show ordinary pizzerias and bakeries that, for the most part, provide their respective pizza and bakery goods from the same locations. While a couple of the businesses, e.g., Ken’s Artisan’s discussed above, have specific locations and hours for their bakeries versus their pizzerias, Applicant fails to explain how that detracts from their relatedness, as both products nonetheless emanate from the same source.

“Second,” argues Applicant, “the evidence of businesses with coinciding bakery and pizzeria operations shows that these businesses call out their bakery services separate and apart from their pizzeria operation through use of separate headings, links and – in some cases – even separate web pages. Clearly, these business owners consider pizzas to be their own category of goods separate from bakery goods.”³⁶ This argument is also unpersuasive. The fact that a business has different menu pages, headings, or links for its various goods does not necessarily detract from their relatedness. Obviously, a consumer interested in purchasing a salad would view the

³⁴ 6 TTABVUE 9 (Applicant’s Brief).

³⁵ *Id.* at 9-10.

³⁶ *Id.* at 10.

part of a business' menu that lists salads, not pizza. Similarly, one interested in a brownie or cookie would search the dessert listing on the menu, rather than more savory bakery items such as pizza that might be listed. All the goods originate from the same producer.

"Third," argues Applicant, "while the Examining Attorney's evidence has focused on business establishments that may offer both 'pizza for consumption on or off the premises' and 'bakery products,' the evidence has not shown that those goods are offered under the same trademark by such "establishments."³⁷ However, Applicant's argument is contrary to the record, which shows that it is common for pizza and other bakery goods to be provided by businesses under the same marks.

Applicant also argues that the standard of "something more" applies here. Specifically, argues Applicant, quoting TMEP § 1207.01, that "[w]hile likelihood of confusion has often been found where similar marks are used in connection with both food or beverages products and restaurant services, there is no *per se* rule to this effect. Thus, the relatedness of such goods and services may not be assumed and the evidence of record must show 'something more' than that similar or even identical marks are used for food products and for restaurant services."³⁸

In Coors Brewing the Federal Circuit extended *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982), and applied the "something more" requirement in a case involving beer on the one hand and restaurant services on the

³⁷ *Id.* at 10.

³⁸ *Id.* at 12.

other. It found that even though the record showed that “several” restaurants offered private or house brands of beer, “several” third-party registrations showed that a single mark was registered for beer and restaurant services, and some brewpubs offered restaurant services, that evidence did not meet the “something more” requirement. *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063.

Applicant’s reliance on *Coors Brewing* is misplaced because, as the Federal Circuit clarified in *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082 (Fed. Cir. 2014), the heightened “something more” standard first enunciated in *Coors Brewing* may be required in any context where “the relatedness of the goods and services is not evident, well-known or generally recognized.” *See also In re Country Oven, Inc.*, 2019 USPQ2d 443903, *12 (TTAB 2019). As the Examining Attorney points out here, the evidence in this case shows that Registrant’s bakery **goods** and Applicant’s pizza **goods** are closely related. Because the evidence sufficiently demonstrates that Applicant’s goods are related to those in the cited registration, there is no need to address the “something more” standard.

Finally, Applicant argues that “the Board has previously determined that pizzas are not related to bakery goods” in *Luvera v. Pepperidge Farm, Inc.*, 186 USPQ 302 (TTAB 1975) when it found no likelihood of confusion between the mark NAPLES for pizza and NAPLES for cookies.³⁹ “We . . . are of the opinion that the sale of pizza, under the mark NAPLES PIZZA’ as take-out item in a restaurant, and the sale of cookies under the mark ‘NAPLES’ in the usual channels of trade therefor, is not likely to lead to confusion as to origin of either product or lead the consumer into mistake or be a means of deceiving the consumer.”

³⁹ *Id.* at 12-13.

Id. at 304. According to Applicant, “[i]n saying this, the Board implies that the usual channels of trade for cookies (and by extension, bakery goods) are not the same as the usual channels of trade for ‘pizza as a take-out item in a restaurant’ i.e., ‘pizza for consumption on or off the premises.’ As a result, the Board’s opinion is determinative of the fact that “pizza for consumption on or off the premises” is not related to “bakery goods.”⁴⁰

We disagree. As we have repeatedly explained, each case must be determined on its own merits. *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014) (“Although the United States Patent and Trademark Office strives for consistency, each application must be examined on its own merits.”); *see also In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits.”); *In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, at *11 (TTAB 2020) (consistency in examination is desirable but the Board “must yield to proper determinations under the Trademark Act and rules”) (internal quotations omitted). We are not privy to record in *Luvera* and thus do not know what evidence was presented to prove the relatedness of pizza and cookies and their usual trade channels. On the other hand, the evidence in this case is more than sufficient to establish that pizza and baked goods are related.

C. Similarity or Dissimilarity of the Trade Channels

We turn now to the third *DuPont* factor, which considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at

⁴⁰ *Id.* at 13.

567. Here, both Registrant's and Applicant's identifications are unrestricted as to trade channels. Moreover, in the absence of specific limitations in Applicant's and Registrant's respective identifications, we must assume that the products set forth in the identifications are sold in all normal channels of trade for goods of that type. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *39-41 (TTAB 2020) (“[A]bsent an explicit restriction in the application, the identified goods in the application must be presumed to move in all channels of trade that would be normal for such goods and to all usual prospective purchasers for goods of that type.”).

For similarity of trade channels, the Examining Attorney relies on the same evidence discussed above for relatedness of the goods, including the webpage evidence from Di Camillo Bakery, Tripoli Pizza and Bakery, Village Bakery, Nanas, Savastano's, Yia Yia's Pizzeria, Berkshire Mountain Bakery, Bakery San Juan, Maike's Bakery & Coffee Shop, Kilauoa Bakery, Nabolom Bakery, Wayfarer, Hideaway Bakery, Noe Valley Bakery, Goode & Fresh Pizza Bakery, Roma Bakery and Pizzeria, Bread & Roses Bakery, Original Italian Bakery, Honey Moon Bakery & Pizzeria, Blue Moon Bakery, Sunrise Bakery, Cacia's Bakery, River to River Bakery, Piro's Italian Bakery, and Ken's Artisan, Fabiani's Bakery, Yale Bakery, and Boca Argentine Bakery and Pizzeria.⁴¹ This evidence supports a finding that these goods are offered and marketed in at least one common channel of trade, that is, the websites operated by the third-party bakers and pizzerias, often on the same page.

The third *DuPont* factor weighs in favor of finding a likelihood of conclusion.

⁴¹ 9 TTABVUE 7 (Examining Attorney's Brief).

D. Strength or Weakness of HIGH FIVE

“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength” *In re Chippendales USA Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010), *quoted in Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, 2023 USPQ2d 753, *9 (TTAB 2023). Because the cited mark is registered on the Principal Register without a claim of acquired distinctiveness, its commercial strength is presumptively treated as neutral, *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016), and its conceptual strength is treated as inherently distinctive—at the very least, suggestive. 15 U.S.C. § 1057(b). *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007). Here, the mark is HIGH FIVE, a well-known phrase that refers to the “slapping of an upraised hand by two people (as in celebration)” and is arbitrary with respect to the goods.

Under the sixth *DuPont* factor, however, a mark’s strength may be attenuated by “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. Based on the evidence, its strength may vary along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017). “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015), *quoted in Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *7 .

An applicant may adduce evidence of active third-party registrations to show that a mark or a segment thereof is descriptive, suggestive, or so commonly adopted that

the public will look to other elements to distinguish the source of the goods or services. *See, e.g., Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1364, 2023 USPQ2d 737, at *5 (Fed. Cir. 2023) (citing 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90); *Sock It to Me v. Fan*, 2020 USPQ2d 10611, at *9 (quoting *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“The conclusion to be drawn [from third-party registrations] is that there is an inherent weakness in a mark comprised in whole or in part of the word in question and that, therefore, the question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other.”)).



Applicant argues that the field of marks containing or consisting of the term HIGH FIVE with respect to foods, beverages and restaurant, café, and bar services is “crowded.”⁴² Specifically, it asserts, “the United States Federal Trademark Register already contains numerous HIGH FIVE-formative registrations covering food, beverages and related café and restaurant services.”⁴³ In addition to the two cited by the Examining Attorney, Applicant provides evidence of the following eight additional third-party registrations for HIGH FIVE-formative marks:⁴⁴

Mark	Registration	Goods/Services
HIGH 5	2837852	Meats, namely, hamburgers (Class 30); staple foods, namely, barbecue sauce.

⁴² 6 TTABVue 13-14 (Applicant’s Brief).

⁴³ *Id.* at 15.

⁴⁴ April 15, 2023 Request for Reconsideration, TSDR 113-35.

 HIGH FIVE COFFEE	4884324 4884325	Cocoa; Coffee and tea; Espresso; Prepared coffee and coffee-based beverages; Roasted coffee beans (Class 30); Coffee bars; Coffee-house and snack-bar services (Class 43).
HIGH FIVE HIGH FIVE HEFE.	5719967 4554113	Beer (Class 32).
HIGH FIVE RAMEN	4671892	Bar services; Restaurant services; restaurant services featuring ramen; take-out restaurant services (Class 43).
HIGH FIVER	6963269	Seasoning rubs (Class 30).
	3979434	Pet food (Class 31).

One of the eight registrations is for the mark HIGH FIVER, which is different from HIGH FIVE and therefore not probative of a crowded field of HIGH FIVE MARKS. The remaining seven examples are for different goods (e.g., beer, coffee, rubs, pet food) and as such are not relevant for the determination of weakness in the context of Applicant's pizza. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 128 USPQ2d at 1694 (Board must focus "on goods shown to be similar"); *In re i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for unrelated goods and services). In any event, the existence of confusingly similar marks already on the Register will not aid an applicant in registering yet another

confusingly similar mark—in this case, an identical mark. *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016).

Applicant’s third-party registration evidence does not appreciably weaken the cited mark HIGH FIVE for bakery products. Nor does Applicant’s mark contain any additional elements that would enable consumers to distinguish its mark from Registrant’s. The sixth *DuPont* factor is therefore neutral.

E. Lack of Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the subject marks. *DuPont*, 177 USPQ at 567.

Invoking these factors, Applicant argues that its HIGH FIVE mark “has peacefully coexisted with the cited marks” “for the past six years since 2017 without any evidence of actual confusion,” and “[t]he ability of these and other HIGH FIVE formative marks to coexist on the register for such a significant amount of time, including Applicant’s own past registration, is indicative that no confusion between Applicant’s mark and the cited Registrant’s marks is at all likely.”⁴⁵

We disagree. “[T]he the relevant test is likelihood of confusion, not actual confusion.” *In re Detroit Athl. Co.*, 128 USPQ2d at 1053. And since there is no evidence of the duration, extent, or geographic reach of Applicant’s pizza sales under its mark, the record does not show a reasonable opportunity for confusion to occur.

⁴⁵ 6 TTABVUE 18 (Applicant’s Brief).

See Monster Energy Co. v. Lo, 2023 USPQ2d 87, at *37; *Chutter v. Great Mgmt.*, 2021 USPQ2d 1001, at *48-49 (TTAB 2021), *rev'd on other grounds*, 90 F.4th 1333, 2023 USPQ2d 1215 (Fed. Cir. 2023), decision modified January 10, 2024.⁴⁶

F. Conclusion

The marks are identical in appearance, sound, connotation and commercial impression and the goods and trade channels are closely related. The first, second, and third *DuPont* factors thus weigh in favor of a finding of likelihood of confusion, with no factors weighing against a likelihood of confusion; the sixth, seven, and eighth *DuPont* factors are neutral. Accordingly, we find that Applicant's standard-character mark HIGH FIVE for "Pizza for consumption on or off the premises" is likely to cause confusion with the mark HIGH FIVE for "bakery goods" in Registration No. 3336233.

Decision: The refusal to register is affirmed under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

⁴⁶ Applicant also argues that its mark PIE FIVE HIGH FIVE in Registration No. 4268978 "was able to coexist" the third-party HIGH FIVE-formative registrations it submitted "for six years on the register (and for eight years in the marketplace) until it expired in 2019." 6 TTABVUE 17. "Where an applicant owns a prior registration that is over five years old and the mark is substantially the same as in the applied-for application, this can weigh against finding that there is a likelihood of confusion." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (2018) (citing *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)). But that is not the case here, as the applied-for mark, HIGH FIVE, "moves closer to the cited registration [HIGH FIVE] rendering the new mark more similar in appearance, sound, and meaning to Registrant's mark...." *Id.* at 1748. Furthermore, as the Examining Attorney points out, Applicant's prior registration is cancelled, and cancelled registrations are "not entitled to any of the presumptions of Section 7(b) of the Trademark Act." *In re Embiid*, 2021 USPQ2d 577, *35 n.48 (TTAB 2021). *See In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought."). Applicant's cancelled prior registration does not obviate the Section 2(d) refusal.