

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

*In re Mark Cachia*

Serial No. 88276115

Lisa M. DuRoss of Harness, Dickey & Pierce, P.L.C.,  
for Mark Cachia.

Grace Duffin, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

Before Adlin, Lynch and Stanley, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Mark Cachia seeks registration of SCYTALE, in standard characters,  
for:

advertising, marketing and promotion services; business administration assistance; business advice and analysis of markets; business management analysis; business management assistance; assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization; market research and business analyses; providing a website featuring company profiles entrepreneurs can use to attract venture capital; all of the foregoing in the field of financial services and none of the foregoing in the field of open source software development, in International Class 35; and

financial affairs and monetary affairs, namely, financial information, management and analysis services;

investment consultancy; investment management; investment of funds; venture capital advisory services; venture capital financing; venture capital fund management; venture capital funding services to emerging and start-up companies; venture capital services, namely, providing financing to emerging and start-up companies; financial valuations; intellectual property valuation services; providing venture capital, development capital, private equity and investment funding; providing information and advice in the field of finance, financial investments, financial valuations, and the financial aspects of retirement; none of the foregoing in the field of open source software development, in International Class 36.<sup>1</sup>

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered identical mark SCYTALE, in standard characters, for:

business consulting services in the field of open source software development and execution, in International Class 35; and

providing information in the field of open source software; providing information and advice in the field of open-source software design, implementation and integration; consulting services in the field of selection, implementation and use of open-source computer software; facilitating an open source project, namely, providing a web site containing information in the fields of open source computer software development, computers, computing, computer software, technology, and technology for management of electronic media via electronic communications networks, in International Class 42;<sup>2</sup>

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<sup>1</sup> Application Serial No. 88276115, filed January 25, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use dates of November 1, 2017.

<sup>2</sup> Registration No. 6125032, issued August 11, 2020.

that it is likely to cause confusion. After the refusal became final, Applicant appealed. The appeal is fully briefed.

### **I. Examining Attorney’s Objection Sustained**

The Examining Attorney’s objection, 17 TTABVUE 3-4,<sup>3</sup> to evidence Applicant submitted for the first time with his Appeal Brief, 15 TTABVUE 20-21, is sustained because the evidence is untimely. Trademark Rule 2.142(d) (“The record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.”). If Applicant wanted to introduce new evidence following his appeal, the proper course would have been to request a remand to do so. Trademark Rule 2.142(d)(1); *In re Information Builders, Inc.*, Ser. No. 87753964, 2020 WL 2094122, at \*2 & n.5 (TTAB 2020) (“To the extent Applicant wished to introduce additional evidence after its appeal had been filed, Applicant should have filed a written request with the Board to suspend the appeal and remand the application for further examination pursuant to Trademark Rule 2.142(d).”).<sup>4</sup>

### **II. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont*

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<sup>3</sup> Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

<sup>4</sup> As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, 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 U.S. Court of Appeals decisions by the page numbers on which they appear in the Federal Reporter (e.g. F.2d, F.3d, or F.4th). For Board opinions, this decision cites to the Westlaw legal database.

*de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1381 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

#### **A. The Marks**

The marks are identical – “SCYTALE” in standard characters. Thus, they look and sound identical.

Applicant argues, however, “that the term ‘scytale’ refers to a type of cipher or code,” and thus “does not correlate with Applicant’s services,” but does “correlate” with Registrant’s. 15 TTABVUE 17. We are not persuaded that the connotation and commercial impression differs. The record reveals, and Applicant and the Examining Attorney agree, that “scytale” has a single meaning that is consistent with Applicant’s claim that the term “refers to a type of cipher or code.”<sup>5</sup> October 8, 2021 Office Action

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<sup>5</sup> According to Wikipedia, “[i]n cryptography,” a scytale “is a tool used to perform a transposition cipher, consisting of a cylinder with a strip of parchment wound around it on which is written a message ... [t]he recipient uses a rod of the same diameter on which the parchment is wrapped to read the message.” October 8, 2021 Office Action response TSDR 29.

response TSDR 2;<sup>6</sup> January 3, 2022 Office Action TSDR 3. This single meaning will be conveyed to consumers, and contrary to Applicant’s argument, that meaning “correlates” to Applicant’s services as well as Registrant’s. Indeed, it is common knowledge that consumers and businesses alike tend to prefer to keep their financial affairs and transactions private. Thus, a “cipher or code” could be used with, or a feature of, the types of services offered by both Applicant and Registrant.

Because the marks are identical, this factor not only weighs heavily in favor of finding a likelihood of confusion, but also reduces the degree of similarity between the services required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993); *Time Warner Ent. Co. v. Jones*, Opp. No. 91112409, 2002 WL 1628168, at \*8 (TTAB 2002); and *In re Opus One Inc.*, Ser. No. 75722593, 2001 WL 1182924, at \*3 (TTAB 2001).

**B. The Services, Channels of Trade and Classes of Consumers**

In considering the identified services, we keep in mind that they need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the services are marketed in a manner that “could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431084, at \*6 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public

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<sup>6</sup> Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, in the downloadable .pdf format.

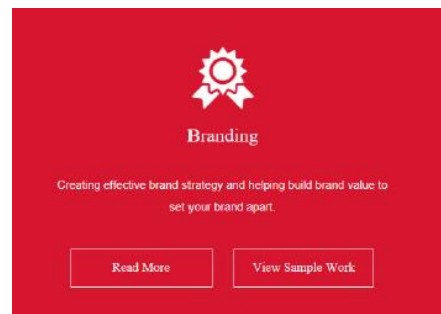
may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”).

Here, in the initial Office Action, the Examining Attorney claimed that the third-party evidence she introduced “establishes that the same entity commonly manufacturers, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark.” April 8, 2021 Office Action TSDR 3, 8-30.<sup>7</sup> However, we find that the evidence introduced by the Examining Attorney does not show use of the same mark for services similar to Applicant’s and services similar to Registrant’s. Rather, it only shows use of third-party marks for services similar to those identified in the involved application. None of the evidence shows use of third party marks for Registrant’s “business consulting services in the field of open source software development and execution,” in Class 35, or its “open source software”-related information, consulting or facilitation services in Class 36.

For example, Lubicom’s website promotes the company’s “business consulting,” “marketing,” “event planning” and “branding” services, as shown below:

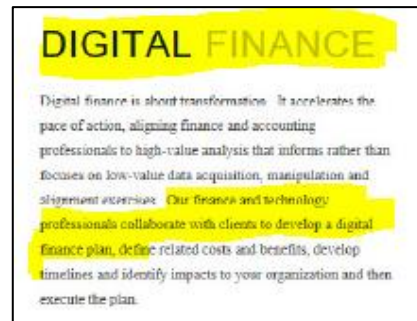
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<sup>7</sup> The involved application and cited registration identify only services; they do not identify any goods.



*Id.* at 8, 12-14. But there is no evidence of record that Lubicom has any involvement with open source software, much less that it offers business consulting or other services in connection with open source or other software. Again, all of the services identified in the cited registration specifically relate to open source software.

Similarly, the Examining Attorney introduced evidence from WG Consulting's website, showing that this third party offers "financial and transaction services," as shown below:



*Id.* at 16, 18, 19 (highlighting added). While WG Consulting’s website mentions “digital finance,” and developing digital finance plans, it does not mention open source or other software, much less demonstrate that WG Consulting provides open source or other software-related services. Thus, it does not show use of the WG CONSULTING mark/name for services similar to Registrant’s.



Third party Invisionate is a “venture capital consulting” company that provides “business development consulting,” “technology consulting” and “sourcing advisory consulting,” as shown below:



*Id.* at 29-30 (highlighting added). While Invisionate’s website mentions technology and “venture tech,” there is no indication that it provides any open source or other

software-related services. The Examining Attorney does not explain how this evidence supports a finding that Invisionate offers services similar to Registrant's.

After Applicant pointed out that none of this third-party evidence shows service marks used for open source software-related services, October 8, 2021 Office Action response TSDR 1-2, the Examining Attorney issued the Final Office Action. With it, the Examining Attorney introduced additional evidence that, she claimed, "establishes that the same entity commonly manufactures, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark." January 3, 2022 Office Action TSDR 2. The Examining Attorney further claimed that

the attached evidence shows that it is common for these types of services, specifically, business management, business consulting, marketing, and financial services to be provided by the same entity and marketed together. The attached evidence shows that generally these entities provide these services in a broad scope of fields and even when more focused on a particular field do not necessarily not serve or exclude others. As such, the services are still related as they are commonly provided by the same entity.

*Id.* Thus, the Examining Attorney again apparently overlooked, and did not acknowledge, that Registrant's services all relate to open source software. This is reflected in the additional evidence she introduced.

For example, Higher Purpose Co. is a "Black business relief fund." *Id.* at 5. Its "mission is to build community wealth with Black residents in Mississippi by supporting the ownership of financial, cultural, and political power," as shown below:

The screenshot displays the 'Grant Recipients' section of the Higher Purpose website. At the top left, the logo reads 'HIGHER PURPOSE' with a stylized 'g' below it. To the right is a hamburger menu icon. Below the logo, the text 'BLACK BUSINESS RELIEF FUND' is visible. The main heading 'Grant Recipients' is in a large, bold, teal font. Three recipients are featured in a grid:

- Robbie Pollard**: A photo of a man in a grey shirt and green gloves working in a garden. Below the photo, a quote reads: "It hasn't really affected how we sell our produce."
- Barbara Henry**: A portrait of a smiling woman. Below the photo, a quote reads: "I just want people to know that Higher Purpose is a Godsent for small Black-owned businesses."
- Arthur Jones**: A photo of a man in a white polo shirt and cap talking to a young boy on a tennis court. Below the photo, a quote reads: "We are still under restrictions... was able to pay one of my worst salary for helping run the clinic then pay the lease."

Below the grid is the 'Our Mission' section, with the heading in a large, teal, italicized font. The mission statement reads: "Higher Purpose Co mission is to build community wealth with Black residents in Mississippi by supporting the ownership of financial, cultural, and political power. Our theory of change is anchored by an integrated model: asset building, narrative change, and advocacy." Below this, a paragraph states: "Solutions-based organizing and community wealth building amplify our theory of change to unapologetically tackle generational poverty, structured inequality, and institutionalized racism in the state of Mississippi"

*Id.* (highlighting added). While the Higher Purpose website discusses “asset building,” “wealth building,” funding of Black entrepreneurs and entrepreneurship education, *id.* at 5-15, it does not mention open source or other software, much less reveal that Higher Purpose provides open source software-related services.

The Examining Attorney’s evidence about Prolific, a “growth firm” that is “industry agnostic” and focuses on “aggressive gains against the growth metrics that matter most to you,” *id.* at 16-28, suffers the same flaw. There is no indication in the record that Prolific has anything to do with open source or other software, much less that it provides open source software-related services. Similarly, Catalyst Innovation

Lab “is focused on incubating, piloting and scaling innovative solutions, tools and partnerships that drive operating margins” in the “multifamily sector,” and assists “PropTech entrepreneurs.” *Id.* at 29. But there is no indication in the record that it provides open source-related goods or services. *Id.* at 29-30. The Examining Attorney’s remaining evidence, from Leviathan Capital, ONCE Ventures,<sup>8</sup> Revenue Park and Tamarak, *id.* at 31-51, is no more helpful because none of it shows any third party that offers open source software-related services.

In response to this Office Action, Applicant pointed out that the Examining Attorney “incorrectly stated” Applicant’s and Registrant’s identifications of services, July 5, 2022 Request for Reconsideration TSDR 6-8, following which the Examining Attorney issued a Subsequent Final Office Action that correctly states Applicant’s and Registrant’s identified services. November 7, 2022 Subsequent Final Office Action TSDR 3.

This time, rather than submitting additional third-party use evidence, the Examining Attorney relied on 30 third-party registrations to support her contention that the services are related. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which

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<sup>8</sup> “ONCE” stands for Otsuka Nutraceutical Emerging Ventures.

may emanate from a single source.” *In re Mucky Duck Mustard Co., Inc.*, Serial No. 73603019, 1988 WL 252484, at \*3 n.6 (TTAB 1988).

However, the vast majority of the third-party registrations suffer the same flaw as the Examining Attorney’s third-party use evidence. Specifically, few if any of them cover business consulting services in the field of open source software development and execution, or other open source software-related services. The following third-party registrations cover services most similar to the services identified in the cited registration (as well as services similar or related to those in the involved registration):

VERCUS (Reg. No. 4190535) is registered for “business technology software consultation services,” “computer hardware and software consulting services” and “consultancy in the field of software design” on the one hand, and “assistance, advisory services and consultancy with regard to business planning, business analysis, business management, business organization, marketing and customer analysis; business administration consultancy, “financial analysis and consultation” and “insurance and financial information and consultancy services” on the other. November 7, 2022 Office Action TSDR 12-13.



(Reg. No. 5656410) is registered for “consulting services for others in the field of design, planning, and implementation project management of scientific research, clinical trials, computer software testing” on the one hand, and “advertising agency services,” “business management and organization consultancy” and “venture capital financing” on the other. *Id.* at 18-20.

MQCC (Reg. No. 6667630) is registered for “advisory services relating to computer software,” “business technology software consultation services,” “computer software design, computer programming, and maintenance

of computer software,” “consultancy in the field of software design” and “consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others” on the one hand and “advertising agency services,” “business administration consultancy,” “business consultation services” and “financial advice and consultancy services” on the other. *Id.* at 49-83.<sup>9</sup>



(Reg. No. 6361207) is registered for “financial investment services in the field of digital media, mobile solutions, enterprise software, storage and cyber security technology, and media and technology companies” on the one hand and “advertising, marketing, public relations and promotional and publicity services, business administration and management services” on the other. *Id.* at 92-93.

SEEDTOSCALE (Reg. No. 6823707) is registered for “technological engineering consulting and advising services, namely, electrical, industrial, mechanical, and software engineering consulting excluding software as a service (SAAS) services featuring data auditing functionality,” on the one hand, and “advertising and marketing services, namely, media strategy consulting, media channel buys featuring consultation about how much media time, and where the client should be purchasing advertising, development and execution of advertising campaigns, and development of advertising content for others, market research services, product and consumer market segmentation consultation” and “providing venture capital, development capital, private equity and investment funding” on the other. *Id.* at 100-101.

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<sup>9</sup> We should point out that in addition to spanning 34 pages, the identification of goods and services in this registration consists of over 20,000 words. This perhaps makes it less significant that a few of the many identified services in this third-party registration are similar to Applicant’s and Registrant’s services.

Although none of these registrations mention open source software, we find that software consulting services without limitation are broad enough to encompass Registrant's "business consulting services in the field of open source software development and execution." Similarly, the "assistance, advisory services and consultancy" with regard to business planning and analysis, "financial analysis and consultation" and "insurance and financial information and consultancy services" in Registration No. 4190535, and the "advertising agency services," "business administration consultancy" and "financial advice and consultancy services" in Registration No. 6667630 are broad enough to encompass Applicant's services limited to the financial services field. Thus, the VERCUS and MQCC registrations unequivocally support a finding that Applicant's and Registrant's services are related.

The design mark in Registration No. 5656410 is not registered for software consulting. Nonetheless, it identifies consulting services (set forth above) that may relate in some way to "software testing." This registration therefore may also tend to support a finding of relatedness.

The JVP & Design mark in Registration No. 6361207 is registered for "financial investment services" in the fields of "enterprise software." Because "financial investment" services are different than "business consulting" and "information" services, we find that this registration is not probative on whether Applicant's and Registrant's goods are related.

Similarly, the SEEDTOSCALE registration's software-related services are limited to "technological engineering consulting and advising services." We find these distinct from the "business consulting" and "information" services identified in the cited registration. We therefore find that this registration is also not probative.

Thus, there are at most three third-party registrations which may tend to suggest that Applicant's and Registrant's services "are of a type which may emanate from a single source." *In re Mucky Duck*, 1988 WL 252484, at \*3 n.6. Based on the specific evidence of record in this particular case, including the marketplace evidence that conspicuously does not pertain to open source software, we find this small number of third-party registrations insufficient. In the absence of any other probative evidence, these third-party registrations do not establish the necessary relationship between Applicant's and Registrant's services. *See e.g. In re Princeton Tectonics*, Ser. No. 77436425, 2010 WL 2604976, at \*3-4 (TTAB 2010) (finding six third-party registrations insufficient to show that personal headlamps are related to lighting fixtures); *The H.D. Lee Co., Inc. v. Maidenform, Inc.*, Opp. No. 91168309, 2008 WL 1976596, at \*8-9 (TTAB 2008) (finding women's undergarments unrelated to clothing such as coats, shirts, skirts and pants, despite eight third-party registrations covering both types of goods, finding the goods to not be complementary).

In addition, there is simply no evidence that the channels of trade and classes of consumers for Applicant's and Registrant's services are similar or overlap. In fact, while there is no evidence of record concerning the channels of trade or classes of consumers for software-related services generally or open source software-related



services specifically, there is some evidence of record concerning the financial services field, which is the focus of Applicant's identified services. That evidence does not reveal any non-incidental overlap between the channels of trade or classes of consumers for services in the financial field on the one hand and services in the software field on the other. Finally, the involved application and cited registration both include trade channel restrictions – Applicant's identified services are expressly limited to the "financial services" field, with none "in the field of open source software development," while Registrant's services are expressly limited to "the field of open source software."

In short, these factors weigh heavily against a finding of likelihood of confusion.

### **III. Conclusion**

In particular cases, the dissimilarity of the services and their channels of trade and classes of consumers may be dispositive. *See e.g. M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006) ("The board placed the greatest weight on its findings that the goods in question were not related and that the channels of trade and purchasers are different. Because of the dominant role these factors play in this case, we find no error in the weight the board accorded them."); *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) ("While it must consider each [*DuPont*] factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods."); *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive."); *The North Face Apparel Corp. v. Sanyang Indus. Co., Ltd.*, Opp. No.

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91187593, 2015 WL 6467820, at \*18 (TTAB 2015) (“The difference in the goods and services is dispositive on the issue of likelihood of confusion.”); *In re HerbalScience Group LLC*, Ser. No. 77519313, 2010 WL 5651672, at \*4 (TTAB 2010) (despite nearly identical marks, “there is no evidence of overlap between the channels of trade for and purchasers of applicant’s and registrant’s products ... the examining attorney has failed to prove that applicant’s mark, if used for its identified goods, is likely to cause confusion with the cited registration”); *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, Opp. No. 91173806, 2009 WL 1719597, at \*9 (TTAB 2009) (finding no likelihood of confusion despite nearly identical marks, stating “the dissimilarity of the goods due to their nature, the manners in which they are sold or distributed, and the circumstances under which consumers would encounter them, is a dispositive factor in this case”).

Here, the record lacks sufficient evidence that Applicant’s and Registrant’s services are related, or that the channels of trade and classes of consumers for those services overlap, so this is such a case. Despite the marks being identical, we find that confusion is unlikely because the services have not been shown to be related, or to travel in the same channels of trade to the same classes of consumers. In fact, these factors are dispositive.

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