

This Opinion is not a
Precedent of the TTAB

Mailed: March 3, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re JSS Concepts Holding Co., LLC
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Serial No. 88362890
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Rebecca L. Wilson of The Dobrusin Law Firm PC
for JSS Concepts Holding Co., LLC.

Megan M. Hartnett, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.
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Before Bergsman, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

JSS Concepts Holding Co., LLC (“Applicant”) seeks registration on the Principal Register of the mark HEIRLOOM HOSPITALITY, in standard characters, for services identified as: “Offering business management assistance in the establishment and operation of restaurants and bars; Outsource service provider in the field of business management of restaurants and bars,” in International Class 35.¹ Applicant has disclaimed HOSPITALITY.

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¹ Application Serial No. 88362890 was filed on March 29, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and alleges December 28, 2012 as the date of first use

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, as used in connection with the identified services, so resembles the mark HEIRLOOM, also in standard characters, for "Branding services, namely, consulting, development, management and marketing of brands for businesses and/or individuals," in International Class 35,² as to be likely to cause confusion or mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration, which was denied. After resumption of the appeal, Applicant twice requested remand for the purpose of submitting additional evidence, which the Board granted.³ Upon remand, the final refusal was continued and the case was returned to the board and the appeal again resumed. The case is fully briefed. We affirm the refusal to register the mark.

I. Evidentiary Issue

In its brief, Applicant relies on six third-party registrations to support its argument against a likelihood of confusion.⁴ The Examining Attorney objects to Applicant's arguments relying on the six registrations on the ground that the

anywhere and August 31, 2017 as the date of first use in commerce.

² Registration No. 4859418, issued November 24, 2015; Section 8 affidavit filed and accepted.

³ Applicant first requested remand on May 21 2021, which the Board granted on June 4, 2021. 6 and 7 TTABVUE. On the same day that the Board granted the remand, Applicant filed another request for remand, which the Board granted on June 9, 2021. 8 and 9 TTABVUE. The Examining Attorney continued the final refusal to register in a single Office Action dated July 8, 2021. 10 TTABVUE.

⁴ Applicant's Br., p. 10, 12 TTABVUE 11.

registrations were not made of record.⁵ Applicant has not introduced the six registrations upon which its point of argument is based. Thus, the record contains only argument. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018). Accordingly, in assessing Applicant’s arguments, we have not considered the six registrations.

II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). 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) (“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.”).

⁵ Examining Attorney’s Br., 14 TTABVUE 5.

A. The strength of the cited mark.

Because the strength of the cited HEIRLOOM mark informs our comparison of the marks, we address Applicant's argument that the term HEIRLOOM is "weak and should be afforded a very narrow scope of protection."⁶

In determining the strength of a mark, we consider both its inherent or conceptual strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength"); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. 2021) ("The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use."). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Applicant did not submit any evidence regarding the inherent or conceptual strength of the mark HEIRLOOM. Regarding the commercial or marketplace strength of the cited HEIRLOOM mark, Applicant introduced excerpts from the

⁶ Applicant's Br., p. 12, 12 TTABVUE 13.

following six third-party web sites purporting to show use of HEIRLOOM in connection with branding services:⁷

- **Heirloomcreative.com** – The web site of Heirloom Creative, a Kentucky-based marketing and branding company offering brand strategy, digital marketing, and branded goods such as packaging, business, cards, and t-shirts.⁸
- **Heirloomfp.com** – The web site of Heirloom Films & Photography, a Colorado-based company that offers photography and filming services to businesses for use in their media campaigns.⁹
- **Heirloomdigital.com** – The web site of a company that digitizes and preserves photographs, movies and documents.¹⁰
- **Tryheirloom.com** – The web site of a different company that also digitizes and preserves photographs, movies and documents.¹¹
- **Heirloomstudio.com** – The web site of a Pennsylvania-based photography studio that provides a variety of photographic services, including family and wedding photography, business, medical, editorial, and culinary photography. The web page describing the editorial photography services, including “branding photography,” states that

⁷ Applicant’s second request for remand of June 4, 2021, 8 TTABVUE 8-44.

⁸ *Id.* at 8-12.

⁹ *Id.* at 13-20.

¹⁰ *Id.* at 21-28.

¹¹ *Id.* at 29-35.

“Branding Photography is your visual identity, your process, your team, your environment, visually described. Professional photography is the most direct and consistent [sic] way to promote your unique brand.”¹²

- **Melodybattentier.com** – the web site of Melody Battentier, a photographer, presenting a graphic design, branding, and art direction project entitled “Heirloom,” and described as “Logotype, brand guidelines and website design for the luxury pashmina brand as well as photo guidelines for their products shots.”¹³

Only the first web site, Heirloomcreative.com, describes services that are arguably similar to Registrant’s consulting, development, management and marketing of brands for businesses or individuals. The other five websites lack probative value because they appear to describe services that are dissimilar to Registrant’s services, such as digitizing and preserving personal media or providing photography services which are merely ancillary to Registrant’s services. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (the controlling inquiry under the sixth *DuPont* factor is the extent of third-party marks in use on “similar” services).

Evidence that one other company provides branding services under the mark HEIRLOOM is insufficient to establish that HEIRLOOM is weak for purposes of likelihood of confusion. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison*

¹² *Id.* at 36-39.

¹³ *Id.* at 40-41.

Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (“[T]he purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” (internal quotation omitted)); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 707 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“voluminous” and “extensive” evidence of relevant third-party uses and registrations were made of record by the applicant).

We find that Applicant has not demonstrated any weakness of the term HEIRLOOM in connection with Registrant’s identified services. Further, because Registrant’s mark is registered on the Principal Register without a claim of acquired distinctiveness, it is entitled to a presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including that it is inherently distinctive for the services. *Tea Bd. of India*, 80 USPQ2d at 1899. In view thereof, we find that the fifth and sixth *DuPont* factors are neutral.

B. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We next consider the *DuPont* factor relating to the similarity of the marks. In comparing the marks in their entirety, we must consider their appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. Similarity as to any one of these factors 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, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or

sound alone is likely to cause confusion.”); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Applicant’s mark is HEIRLOOM HOSPITALITY, in standard characters, and Registrant’s mark is simply HEIRLOOM, also in standard characters. Applicant has disclaimed the merely descriptive term HOSPITALITY, which is defined as “the activity or business of providing services to guests in hotels, restaurants, bars, etc.”¹⁴

It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their

¹⁴ <https://www.merriam-webster.com/dictionary/hospitality>, June 17, 2019 Office Action, TSDR p. 26.

entireties. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data*, 224 USPQ at 751.

Further highlighting the significance of the word “Heirloom” in Applicant’s mark is its position as the first part of the mark. The lead element in a mark has a position of prominence; it is likely to be noticed and remembered by consumers, so as to play a dominant role in the mark. *See In re Detroit Athletic*, 128 USPQ2d at 1049 (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Under these circumstances, likelihood of confusion is often found where the entirety of one mark is incorporated within another. *See Coca-Cola Bottling Co. of Memphis Tenn., Inc. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ2d 105, 106 (CCPA 1975) (BENGAL and BENGAL LANCER for closely related goods found confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (PRECISION and PRECISION DISTRIBUTION CONTROL confusingly similar). Comparing the marks here, we find that Applicant’s HEIRLOOM HOSPITALITY mark incorporates the entirety of Registrant’s HEIRLOOM mark. The addition of HOSPITALITY does little to distinguish the marks.

As noted above, both marks are in standard characters, without limitation on the manner of display. For that reason, we must assume that the marks could be displayed in a stylization identical or similar to each other. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)); *see also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

We find that Applicant’s mark HEIRLOOM HOSPITALITY is overall very similar to the cited mark HEIRLOOM in terms of appearance, sound, connotation and commercial impression. While we acknowledge the difference between the two marks created by the presence of the term HOSPITALITY, this difference does not outweigh the strong similarities created by the identical term HEIRLOOM and overall connotation and commercial impression engendered by the marks as a whole. *See Code Consultants*, 60 USPQ2d at 1702 (finding disclaimed matter is less significant in creating mark’s commercial impression). Consumers encountering HEIRLOOM HOSPITALITY are likely to mistakenly believe that the mark represents a variation on the registered mark, HEIRLOOM, and that Registrant is offering additional services directed to a particular industry under a variant mark.

The *DuPont* factor regarding the similarity of the marks favors a finding of a likelihood of confusion.

C. The nature and similarity or dissimilarity of the services, the established, likely-to-continue trade channels, and the classes of purchasers.

Under the second *DuPont* factor, we compare the services as they are identified in the application and the cited registration. *See Detroit Athletic Co.*, 128 USPQ2d at 1052; *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Under this *DuPont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the identification of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

In view of our finding that Applicant's mark and Registrant's mark are very similar, a lesser degree of similarity between the Applicant's and Registrant's services is required to support a finding of likelihood of confusion. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) ("The greater the degree of similarity between the marks, the lesser the degree of similarity between the goods [or services] necessary to support a finding of likelihood of confusion.") (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)).

Applicant's services include "offering business management assistance in the establishment and operation of restaurants and bars." Registrant's services include "Branding services, namely, consulting, development, management and marketing of

brands for businesses” “Branding” is defined as “the promoting of a product or service by identifying it with a particular brand”.¹⁵

The Examining Attorney argues:

[I]t is commonplace in the relevant industry for a single entity to provide business management assistance in the establishment and operation of restaurants and bars and outsource service provider services in the field of business management of restaurants and bars as well as provide consulting, development, management and marketing of brands for businesses and/or individuals under the same mark.¹⁶

To establish the relatedness of the respective services, the Examining Attorney introduced seventeen excerpts from third-party web sites showing that companies offering hospitality business-management services also offer branding and related marketing services. The following examples are representative:

- **Apexbmg.com** – The web site of the Apex Group, offering, “Brand Development” and “Business Consulting,” including “Operations Management.”¹⁷
- **Accesshospitality.com** – The web site of Access Hotels & Resorts, offering, “hospitality management consulting,” including management consulting in the areas of “Project Management,” “Training Programs,” “Branding and Positioning,” and “Food and Beverage.”¹⁸

¹⁵ <https://www.merriam-webster.com/dictionary/branding>, Applicant’s first request for remand of May 21, 2021, 6 TTABVUE 12-22.

¹⁶ Examining Attorney’s Br., 14 TTABVUE 16.

¹⁷ June 17, 2019 Office Action, TSDR pp. 8-10.

¹⁸ *Id.* at 15-17.

- **Valenciahotelgroup.com** – The web site of the Valencia Hotel Group, offering, “hospitality development, branding, repositioning, and ongoing operations and logistics management.”¹⁹
- **Bespokeby.us** – The web site of the Bespoke Group, which bills itself as “leading hospitality, hotel, restaurant, bar, and fine dining industry strategists and designers who specialize in marketing, branding, management, renovations and consulting.” The web site states that Bespoke provides “Business Planning, Brand Management, Marketing Strategy, Public Relations, Customer Service Training, Hotel Acquisition, Building and Interior Renovation Design, Bar and Menu Design and much more.”²⁰
- **Gilkeyrestaurantconsulting.com** – The web site of the Gilkey Restaurant Consulting Group, which provides a variety of services for restaurants, including developing business plans for restaurants, “Hospitality Management” and “Brand Development.”²¹
- **Synergyconsultants.com** – The web site of Synergy Consultants restaurant management company, offering “Hospitality Management,” operations management, consulting on “Restaurant Marketing & Branding,” and “Branding & Brand Development” services.²²

¹⁹ *Id.* at 18-20.

²⁰ August 31, 2020 Office Action, TSDR pp. 2-3.

²¹ *Id.* at 7-10.

²² *Id.* at 14-18.

- **TRGrestaurantconsulting.com** – The web site of TRG Consulting, offering “Existing Restaurant Consulting” on “restaurant operations assessment,” “Restaurant Startup Development,” and “Restaurant Branding.”²³
- **VSAG.com** – The web site of VSAG consulting, offering “Restaurant Brand Identity” services and “Restaurant Operations & Management Support.”²⁴
- **Eight88hospitality.com** – The web site of Eight88 Hospitality, offering restaurant “Food & Beverage Management” and “Branding” services.²⁵
- **Thermg.com** – The web site of The Restaurant Management Group, offering “3rd party restaurant management” services, including “operations,” “Marketing and Promotion,” and “Brand positioning.”²⁶
- **Urban-restaurants.com** – The web site of the Urban Restaurant Group, a restaurant management and consultation group. The web site offers restaurant concept development services, “Marketing” services, including “Brand development” services, and “Supervision of kitchen operations.”²⁷
- **Cayugahospitality.com** – The web site of Cayuga Hospitality Consultants, offering “Restaurant Operations Consulting,” “Food and

²³ *Id.* at 19-21.

²⁴ *Id.* at 22-24.

²⁵ March 22, 2021 Office Action, TSDR pp. 2-3.

²⁶ *Id.* at 4-6.

²⁷ *Id.* at 11-12.

Beverage Management Consulting,” and “Restaurant Concept Development Consulting” including “branding.”²⁸

We find that the web page excerpts submitted by the Examining Attorney establish that entities such as Applicant, that provide “business management assistance in the establishment and operation of restaurants and bars,” regularly provide Registrant’s services, namely, “consulting, development, management and marketing of brands” under the same mark and directed to the same consumers. That is, the services of establishing and operating restaurants, as provided by Applicant, may also include brand development and marketing services provided by Registrant.

Applicant nevertheless argues that Registrant’s services are not the same as Applicant’s business management services:

[B]rand management . . . is a specialty field. Furthermore, it can be seen from the Registrant’s website that they help brands define themselves, they are essentially brand development and marketing. They do not help to manage the business; they do not help to establish and operate a business.²⁹

This argument is unpersuasive. It is well settled that the involved “services need not be identical or even competitive to find a likelihood of confusion.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *4 (TTAB 2019) (citing *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)). “They need only be ‘related in some manner and/or if the circumstances surrounding their marketing

²⁸ July 8, 2021 Office Action, TSDR pp. 2-8

²⁹ Applicant’s Br., p. 15, 12 TTABVUE 16.

are such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Id.* (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation omitted)).

Here, the Examining Attorney’s web site evidence establishes that the respective services are frequently offered by the same hospitality management and consulting companies to the same customers. Contrary to Applicant’s argument, the web site evidence shows that brand development and marketing are not a “specialty field.” Rather, they are frequently offered as part of comprehensive business consulting services covering all aspects of establishing, managing, and operating a successful business. This is not surprising, given that “establishment and operation of restaurants and bars” would first require the development of a brand or concept for the restaurant or bar, which then must be marketed for the establishment to succeed.

As to the third *DuPont* factor, the similarity of trade channels, we find that the Examining Attorney’s web page excerpts also establish that the respective services are offered in the same trade channels and to the same classes of purchasers, namely current and aspiring business owners, which would include restaurateurs seeking help with the establishment and operation of restaurants. *DuPont*, 177 USPQ at 567.

The *DuPont* factors regarding the similarity of the services, channels of trade, and classes of purchasers favor a finding of a likelihood of confusion.

D. Conditions of sale

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*, 177 USPQ at 567. Applicant argues that its consumers “are not going to

accidentally purchase branding services if they are looking for someone to manage their business.”³⁰ According to Applicant:

In the present case, it is submitted that consumers of the services offered by Applicant or the Registrant seek to transact business with each party based on or to satisfy a specific need or purpose for specific goods, heightening the degree of care that each consumer exercises; additionally, given the idea that these services are high in cost, consumers are likely to comparison shop, another factor cited as creating a heightened degree of care and corresponding reduction in the likelihood of confusion.³¹

Applicant has not submitted evidence regarding the cost of the services. The Examining Attorney argues that “it is not clear that based on the services[,] consumers would exercise such a high degree of care that confusion would be unlikely.”³²

Because Applicant has not submitted evidence regarding the cost of the services, “[w]e must therefore presume that [the] services are offered to both sophisticated and unsophisticated consumers,” and “[a]ccordingly, the applicable standard of care for the likelihood of confusion analysis is that of the least sophisticated consumer.” *Primrose Retirement Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (citing *Stone Lion*, 110 USPQ2d at 1163)).

At the same time, however, the fact that the respective services involve the establishment, operation or marketing of a business, are somewhat complex, and may be costly, suggests that even the least sophisticated potential purchaser will exercise

³⁰ Applicant’s Br., p. 21, 12 TTABVUE 22.

³¹ *Id.*

³² Examining Attorney’s Br., 14 TTABVUE 21.

more than ordinary care in selecting the source of the services. *See id.* (“[E]ven in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily.”).

We find that the fourth *DuPont* factor supports a finding that confusion is not likely.

E. Consistency of Examination – Thirteenth DuPont Factor

Applicant points out that a now-cancelled third-party registration for a similar mark, HEIRLOOM HOSPITALITY GROUP³³ for “Consulting services in the field of hospitality,” in International Class 43, was previously cited against it, and also coexisted on the register with the cited mark. According to Applicant, the coexistence of this prior registration and the cited registered mark “weigh in the Applicant’s favor.”³⁴

Argument related to the existence of the prior registration falls under the thirteenth *DuPont* factor, which relates to “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. We disagree that the prior registration weighs in Applicant’s favor. The cancelled registration is not entitled to any of the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See In re*

³³ Registration No. 3847803 registered on September 14, 2010, and was cancelled on May 21, 2020 under Section 18 of the Trademark Act, 15 U.S.C. § 1068. The registration was cited against the pending application in the Examining Attorney’s first Office Action. The refusal was withdrawn after Applicant filed a cancellation proceeding and obtained a default judgment leading to cancellation of the registration.

³⁴ Applicant’s Br., p. 8, 12 TTABVUE 10.

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.”). In addition, the identified services in the prior registration differ from Applicant’s services.

It is well settled that “the [US]PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the [USPTO] or [the reviewing] court.” *In re Boulevard Entm't*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003); *In re Nett Designs*, 236 F.3d 1339, 1342 (Fed. Cir. 2001). The issuance of the prior registration does not compel the issuance of a second registration if it would otherwise be improper to do so based on the evidence of record. *Cf. In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009). To hold otherwise would give preclusive effect to the decision of the examining attorney in granting the prior registration, and the Board is not bound by the decisions of examining attorneys.

The thirteenth *DuPont* factor is neutral.

F. Balancing the DuPont factors

The first, second, and third *DuPont* factors support a finding of a likelihood of confusion because the marks are very similar, the services are related, and the channels of trade and classes of consumers are the same.

The fourth *DuPont* factor weighs against a finding that confusion is likely because purchasers of the services would exercise a higher degree of care in purchasing. However, the fact “[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar

trademarks for similar goods [or services]. ‘Human memories even of discriminating purchasers . . . are not infallible.’” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)). The “[s]ophistication of buyers and purchaser care are relevant considerations but are not controlling on this factual record.” *Id.* This is particularly so where, as here, the marks are very similar and the services are related.

The remaining *DuPont* factors are neutral.

We find the record establishes that consumers who are familiar with the services offered in connection with the cited mark who encounter the Applicant’s services under its mark, are likely to believe that the services emanate from a single source.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.