

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Royal Realty Corp.

Serial No. 88380382

Daniel D. Frohling and Tatyana V. Gilles of Loeb & Loeb LLP,
for Royal Realty Corp.

Jules Dean, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Kuhlke, Heasley and English,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Royal Realty Corp. (“Applicant”) seeks registration on the Principal Register for the mark LIVE ON POINT in standard characters for “Real estate services, namely, leasing and management of buildings,” in International Class 36.¹

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

¹ Application Serial No. 88380382 filed on April 10, 2019 based on an 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).

Applicant's mark, when used in connection with the identified services, so resembles the registered marks ON POINT CAROLINAS REALTY (standard characters)² and



³ for “Real estate sales management; Real estate advertising services; Real estate marketing services,” in International Class 35 and “Real estate valuation services; Residential real estate agency services; Providing a database of information about residential real estate listings in different neighborhoods and communities,” in International Class 36, as to be likely to cause confusion. Both registrations have the same owner and include a disclaimer for the wording CAROLINAS REALTY.

When the Section 2(d) refusal was made final, Applicant appealed and requested reconsideration. On July 9, 2020, the Examining Attorney denied the request, the appeal resumed and briefs have been filed. We reverse the refusal.⁴

² Registration No. 5058585, issued on October 11, 2016.

³ Registration No. 5058586, issued on October 11, 2016. The composite mark includes the following description and color claim:

The mark consists of navy fencing with light blue fencing mirroring it from below in the style of a reflection above the phrase “On Point Carolinas Realty”, where “On Point” is directly below the fencing in burgundy and “Carolinas Realty” is below “On Point” in navy blue. All of the same appearing on a white field.

The color(s) navy blue, light blue, burgundy, and white is/are claimed as a feature of the mark.

⁴ Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR).

I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We 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); *see also M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within the *DuPont* list of factors, only factors that are “relevant and of record” need be considered).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“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 [or services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). Another factor to be considered when there is evidence of record is the number and nature of similar marks in use with similar services.

DuPont, 177 USPQ at 567; *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). We focus our analysis on the standard character mark in Registration No. 5058585 because if we do not find a likelihood of confusion with respect to this registered mark, then there would be no likelihood of confusion with the mark and services in the other cited registration. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of the Services, Trade Channels and Classes of Consumers

We must make our determination based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods [or services] in question are different from, and thus not related to, one another in kind, the same goods [or services] can be related in the mind of the consuming public as to the origin of the goods [or services].”). It is sufficient that the services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks

used in connection therewith, would lead to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 14711, 1476 (Fed. Cir. 2000). The application and registrations themselves may provide evidence of the relationship between the services. *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1005.

The record shows that the respective services are legally identical and otherwise closely related. Applicant's services are "Real estate services, namely, **leasing** and **management** of buildings," and Registrant's are "Real estate **sales** management; Real estate **advertising** services; Real estate marketing services," in International Class 35 and "Real estate **valuation** services; Residential **real estate agency services**; Providing a database of information about residential real estate listings in different neighborhoods and communities."⁵

Registrant's broadly worded "real estate agency services" encompass Applicant's leasing and management of buildings." Further, the relationship between the various real estate agency services is illustrated by the examples of third-party use. The Examining Attorney submitted excerpts from third-party websites showing Applicant's and Registrant's types of services offered under the same mark in the same channels of trade. A few examples are set forth below:

Nomadic Real Estate showing real estate **leasing**, **management valuation**, databases and **sales** from a single location;⁶

⁵ Bolding is provided for ease of reference.

⁶ May 22, 2019 Office Action at 11-15 (www.nomadicrealestate.com).

Coakley Realty showing a wide variety of real estate services, including **real estate agency, leasing, management, valuation**, databases and **sales** from a single location;⁷

Sherman Agency showing **real estate agency, leasing, management, valuation**, databases and **sales** from a single location;⁸

CBRE showing a wide variety of real estate services, including **real estate agency, leasing, management, valuation**, databases and **sales** from a single location;⁹ and

EJF showing **real estate agency, leasing, management, valuation, advertising**, databases and **sales** from a single location.¹⁰

Those examples show the market context in which consumers are exposed to the same mark being used for the relevant services, indicating single source and overlapping trade channels.

Further, because there are no limitations as to channels of trade or classes of consumers, we presume that Applicant's and Registrant's services are offered in the ordinary channels of trade and offered to all the usual classes of purchasers for these services. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). In the case of Applicant's services encompassed

⁷ *Id.* at 16-23 (www.coakleyrealty.com).

⁸ *Id.* at 24-29 (www.theshermanagency.com).

⁹ December 17, 2019 Office Action at 6-9 (www.cbre.us).

¹⁰ *Id.* at 10-28 (www.ejfrealestate.com).

by Registrant's broadly worded services, we must presume that Applicant's and Registrant's services will be offered in the same channels of trade and will be purchased by the same classes of consumers. *See In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (TTAB 2012).

Applicant does not dispute the relatedness of the services and overlap in trade channels, simply the weight to be accorded these factors in relation to the comparison of the marks.

In view thereof, the relationship between the services and the overlap in their channels of trade favor a finding of likelihood of confusion.

B. Similarity/Dissimilarity of the Marks and Commercial Weakness of ON POINT

We compare Applicant's mark LIVE ON POINT and Registrant's mark ON POINT CAROLINAS REALTY in their entireties as to "appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). In

evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). However, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re Nat'l Data*, 224 USPQ at 751.

The Examining Attorney reasons that the shared “arbitrary” wording ON POINT is “distinctive and dominant in both the applicant’s and registrant’s marks.” 11 TTABVUE 5. In support of his conclusion that ON POINT is the dominant element in Registrant’s mark, the Examining Attorney points to the placement of the wording ON POINT at the beginning of the mark and the disclaimer for the remaining

wording CAROLINAS REALTY. We agree the wording ON POINT is the more dominant and identifying element in Registrant's mark.

We cannot agree, however, with the Examining Attorney's assertion that ON POINT is the dominant element, separate from the word LIVE, in Applicant's mark.

The Examining Attorney contends that:

[T]he addition of the term "LIVE" in applicant's mark merely directs the consumer's attention to the wording that follows, namely, "ON POINT." The term "LIVE" may be interpreted as a command that draws attention to the wording "ON POINT" and merely expresses an intention with respect to the applicant's real estate services. For this reason, the wording "ON POINT" is more dominant than the word "LIVE" in the applied-for mark. As such, the wording "ON POINT" remains the dominant feature of the applied-for mark in a likelihood of confusion analysis. ... [T]he focus of the marks would be the wording "ON POINT" because the applicant's mark gives the impression of living on the point, while "ON POINT" would be the commercial impression of the registered marks because it is the only dominant portion of the registered marks. Hence, the recollection of the average purchaser for these marks would be on the wording "ON POINT".

11 TTABVue 8-9.

However, LIVE ON POINT reads as a unitary phrase. By contrast, ON POINT CAROLINAS REALTY separates into two separate phrases ON POINT and CAROLINAS REALTY.

In addition, coming as the first word in the phrase, the invitation to LIVE in a certain manner, ON POINT, draws more attention to the word LIVE. *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692 (finding "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

In this regard, the record includes the definitions for ON POINT as “relevant and appropriate to what is happening or being discussed” and “extremely good, attractive, or stylish.”¹¹ Applicant argues that the “meaning and commercial impression is far from that created by the Cited Marks. There, ON POINT does not even refer to consumers; it refers to the registrant, and it tells consumers that the registrant’s services are directly relevant and attuned to Carolina homebuyers’ needs. ... These differences in connotation and overall commercial impression substantially differentiate the parties’ marks.” 9 TTABVUE 22. Applicant further argues that the “wording ‘CAROLINAS REALTY’ clearly places the registrant and its services in a particular geographic area... .” 9 TTABVUE 23.

Keeping these differences in mind, we turn to consider the commercial strength or weakness of the shared term ON POINT. In comparing the marks we consider third-party uses to determine whether “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.’” *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1694 (cleaned up). Applicant has submitted 43 examples of third-party use of ON POINT for various realty services. A few examples from Applicant’s chart summarizing them are reproduced below:¹²

¹¹ June 17, 2020 Request for Reconsideration at 25 (OXFORD DICTIONARY <https://www.lexico.com>).

¹² November 22, 2019 Response at 27-33. *See also id.* at 34, 38, 47, 50, 104, 133, 142; and generally at 34-152.



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These examples show use of ON POINT for real estate services across the United States including in Registrant's area as shown below.¹³



The Examining Attorney minimizes the weight of these examples by noting that:

[T]he applicant has not provided evidence of any third-party registered marks which comprise the wording “ON POINT”. Here, the two registrations owned by a single registrant are insufficient to establish that the wording “ON POINT” is weak or diluted. Moreover, the applicant cites the cases *Juice Generation*, 794 F.3d 1334, 115 USPQ2d 1671 and *Primrose Ret. Cmtys.*, 122 USPQ2d 1030 as relevant decisions. See October 13, 2020, Applicant’s Appeal Brief, TSDR p. 15-18. These cases showed that evidence of several third party registrations combined with paramount evidence of third party use not on the register could cause specific wording in a mark to become diluted or weak. See *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 (Fed. Cir. July 20, 2015) at 1339 ... However, the difference between the cases referenced by the applicant and the instant application is that, in the cases referenced by the applicant, numerous third party registrations supported a finding that the marks were entitled to a narrower scope[] of protections.

¹³ November 22, 2019 Response at 44.

Here, the record does not include evidence of third-party registrations for similar marks.

11 TTABVUE 10.

This is an incorrect reading of the case law. In fact, examples of third-party use indicate whether a mark or portion of a mark is commercially weak. In *Juice Generation* the Court reiterated that evidence of third-party use of similar marks on similar goods (or services) can show that a mark is relatively weak and entitled to a narrow scope of protection. *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674. The Court went on to say that despite the lack of specifics as to the extent and impact of third-party use, the “fact that a considerable number of third parties use similar marks was shown in uncontradicted testimony.” *Id.*¹⁴

The Court further observed that third-party registrations may show the sense in which a mark is used in ordinary parlance and whether it has a normally understood and well-recognized descriptive or suggestive meaning that could lead to a conclusion of conceptual weakness. *Id.* 115 USPQ2d at 1675. The Court explained that the third-party registrations added to the consideration of the weakness of the mark because “if there is no evidence of actual use” then “third-party registrations” “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1675 (quoting *Textronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976)). While third-party registrations

¹⁴ *Juice Generation* was an inter partes case and we do not have testimony supporting the evidence of third-party use; however, in ex parte proceedings the Board generally takes a somewhat more permissive stance with respect to the probative value of evidence. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208 (2020).

add to the weight of evidence regarding the conceptual strength or weakness of a mark, the absence of third-party registrations does not diminish the probative value of the evidence of third-party use. Third-party registrations are not evidence of what happens in the marketplace. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).

Here, the marketplace is filled with real estate firms offering services under the phrase ON POINT. It is used so commonly that potential consumers would distinguish marks that include the phrase ON POINT based on minute distinctions. *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1694.

Applicant's mark has the commercial impression of a unitary phrase beginning with the word LIVE, exhorting consumers to LIVE ON POINT. By contrast, the commercial impression of Registrant's mark is to inform customers that their services are "on point" and are directed to a specific geographic location. These distinctions are sufficient to distinguish the marks, given the commercial weakness of ON POINT in connection with similar services.

In terms of appearance, sound, connotation, and commercial impression, we find the marks — considered in their entireties — are distinguishable. In view thereof, the similarity of these marks weighs against a likelihood of confusion.

II. Conclusion

In balancing the relevant factors, we find the differences between the marks—in particular given the commercial weakness of the shared term and the differences in overall commercial impression—sufficient to avoid likely confusion despite the legally

identical and otherwise closely related services and trade channels. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)); *see also Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (MAYA not confusingly similar to MAYARI) (quoting *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”)).

Decision: The refusal to register Applicant’s mark is reversed.