

THIS OPINION IS NOT A
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Mailed: April 22, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Versatrans, Inc.

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Serial No. 88909675

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Molly B. Markley of Young Basile Hanlon & MacFarlane, P.C.,
for Versatrans, Inc.

Dinisha Nitkin, Trademark Examining Attorney, Law Office 130,
John Lincoski, Managing Attorney.

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Before Cataldo, Wellington and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Versatrans, Inc., seeks to register the mark VERSA AGENCY (AGENCY disclaimed), in standard characters on the Principal Register, for “Advertising, marketing and promotion services, namely creating advertising content and promotional materials for others; production of advertising materials,” in International Class 35.¹

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¹ Application Serial No. 88909675 (“the Application”) was filed on May 11, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

The Trademark Examining Attorney refused registration of the mark 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 aforementioned services, is likely to cause confusion with the mark VERSAFEED, also in standard characters on the Principal Register, for "Promoting the goods and services of others by means of distributing advertising on the Internet" in International Class 35.²

When the refusal was made final, Applicant appealed and requested reconsideration, which was denied. The appeal has been briefed.

We affirm the refusal.

I. Likelihood of Confusion

The fundamental purpose of Trademark Act Section 2(d) is to prevent confusion as to source, and to protect registrants from damage caused by registration of marks likely to cause confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985). Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered, hereinafter referred to as "*DuPont* factors").

In making our determination, 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). Varying weights may be assigned to each *DuPont* factor

² Registration No. 3781102 ("the Registration"), issued April 27, 2010 and was subsequently assigned to VersaFeed Inc. ("Registrant"); renewed.

depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or 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 [and services] and differences in the marks.”).

A. Comparison of the Marks

The first *DuPont* factor considers the “similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

Our focus is on the recollection of the average purchaser, who normally retains a

general, rather than specific, impression of trademarks. *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections of them over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988). Thus, “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

Citing *Palm Bay*, 73 USPQ2d at 1689, *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992), and *In re Detroit Athl. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1047 (Fed. Cir. 2018) for the proposition that “consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark,”³ the Examining Attorney argues that the marks VERSA AGENCY and VERSAFEED are confusingly similar because “[b]oth applicant’s and registrant’s marks begin with the identical term ‘VERSA’, so consumers are likely to focus on the same word when encountering each mark,” are “most likely to recall the same term ‘VERSA’ in applicant’s mark and in registrant’s mark, and are prone to mistakenly assuming that the parties’ services originate from the same source.”⁴

According to the Examining Attorney, “the addition of ‘AGENCY’ to applicant’s mark and ‘FEED’ to registrant’s mark does not diminish this similarity, as these

³ 8 TTABVUE 4 (Examining Attorney’s Brief).

⁴ *Id.* at 4-5.

terms are descriptive in relation to the parties' services and do not serve to distinguish their overall 'VERSA'-dominated commercial impressions."⁵ Rather, "when paired with such descriptive second terms, VERSA is likely to be seen as a house mark."⁶ The Examining Attorney explains her reasoning: "In applicant's case, 'AGENCY' is merely another word for an advertising firm. In registrant's case, a 'FEED' is 'the transmission or conveyance of published content, as by satellite, on the internet, or by broadcast over a network of satellites.'"⁷ She concludes that, "[w]ith 'VERSA' as the most prominent feature of both marks, it follows that the marks will create a similar commercial impression on consumers—a conclusion that is not obviated by the additional wording in the respective marks."⁸

Applicant disagrees, asserting that "the marks are distinguished from one another by the addition of different endings, FEED and AGENCY," and that "[w]hen viewed in their entirety (sic), the marks do not have the same commercial impression. The VERSA portion of the mark is not a [sic] strong in and of itself and, therefore should not be entitled to broad protection against marks that differ in wording."⁹ The issue, however, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the

⁵ *Id.* at 5.

⁶ *Id.*

⁷ *Id.*

⁸ *Id.*

⁹ 6 TTABVUE 5 (Applicant's Brief).

services offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). While the marks do not have the exact same commercial impression due to their different endings, their overall commercial impressions are quite similar. Additionally, though Registrant's VERSAFEED mark does not have a space between the terms VERSA and FEED, it is readily apparent to anyone viewing that mark that it consists of those two terms. Neither AGENCY in Applicant's mark (which describes an advertising company) nor FEED in Registrant's mark (which describes the transmission of published content on the internet) is a strong source identifier, and neither party contends that VERSA in either mark is anything but arbitrary or fanciful with respect to parties' services. VERSA is thus the dominant feature in both marks.

Applicant apparently also disagrees that VERSA is the dominant term in the marks, citing *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) in which, according to Applicant's explanation, "[t]he Court reversed the Board's decision to compare 'varga' and 'vargas' finding the dominant portion of the mark and 'girl' descriptive. While finding 'varga' and 'vargas' were similar, the Court stated that the marks must be considered in the way that they are used and perceived and that marks are usually perceived in their entirety."¹⁰ The facts in *Hearst*, however, are distinguishable. There, the marks were VARGAS and VARGA GIRL; the first words in the marks were similar but not identical, and the Court found that "[t]he

¹⁰ *Id.* at 6.

appearance, sound, sight, and commercial impression of VARGA GIRL derives significant contribution from the component ‘girl.’” *Hearst*, 25 USPQ2d at 1239. The Court recognized that the weight given terms in a mark is “not entirely free of subjectivity” and provided “some random examples” to “illustrate the fact-dependency of such determinations.” *Id.* at 1239 n. 2. In the case before us, the first term in Applicant’s and Registrant’s mark (VERSA) is identical, and the second word in Applicant’s mark (AGENCY) is descriptive, disclaimed and entitled to little weight, *see Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“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), but also serves to reinforce and direct emphasis to the fanciful term VERSA that leads the mark.

Applicant further argues that “VERSA” is a weak element because “[t]he mark VERSA is used by several third parties in the field of advertising and marketing as supported by numerous third-party registrations submitted of record. These VERSA formative marks are able to co-exist because they consist of additional terms and/or are used in a distinguishable area in the broad field of marketing.”¹¹ Third-party registrations, however, are not evidence of use in the marketplace or public familiarity with the third-party marks, and thus have no bearing on commercial strength. *See AMF Inc. v. Am. Leisure Prod., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973)

¹¹ *Id.* at 4.

Third-party registrations can be used in the manner of dictionary definitions “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak,” conceptually. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1475 (TTAB 2016) (“even where the record lacks proof of the extent of third-party use, this evidence still may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak”). However, Applicant’s VERSA-formative third-party registrations have additional wording and design elements not found in the Registration or Application (e.g., VERSAMOUNT, VERSANT, VERSATILE), and most involve unrelated goods or services.¹² *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018); *In re Integrated Embedded*, 120 USPQ2d 1504, 1512-13 (TTAB 2016). Accordingly, they fail to undermine the inherent strength of the Registration.

Applicant also cites other registrations it owns for the marks VERSATRANS (Reg. Nos. 2160399 and 5443162) for “heat transfer paper featuring designs for clothing” and “custom transfer printing services” VERSACOLOR (Reg. No. 4021831) for “custom transfers, namely, screen printing of photos and images on t-shirts and other garments”; and VERSACOLOR PLUS (Reg. No. 5074804) for “heat transfers.” Therefore, according to Applicant, “customers are going to associate VERSA

¹² February 3, 2021 Response to Office Action, TSDR at pgs. 11-34.

AGENCY with VERSATRANS, not VERSAFEED. The co-existence of Applicant's prior VERSA marks, some of which pre-date the cited mark, with the cited mark, illustrates that the marks are able to co-exist due to the differences in the additional terms and the differences in the types of advertising services offered." This argument is unpersuasive because, as the Examining Attorney notes, the goods and services identified in Applicant's other VERSA-formative registrations "are in distinctly different industries than the creative ideation of advertising campaigns and generation of promotional content," whereas, as she points out, "there is already an advertising service provider that uses 'VERSA' as a dominant element: registrant."

In sum, while the marks have some differences in appearance and sound due to their use of different descriptive endings, those endings are weak source-identifiers and instead emphasize the VERSA-portions of the marks. We thus find that marks have similar overall connotations and commercial impressions, which causes the first *DuPont* factor to weigh in favor of finding of likelihood of confusion.

B. Comparison of the Services and Channels of Trade

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration..." and the third *DuPont* factor concerns the "similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567; *Stone Lion*, 110 USPQ2d at 1161. The services need not be identical or even competitive to find a likelihood of confusion. See *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 are such that they could give rise to the mistaken belief that [they] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The Application recites “Advertising, marketing and promotion services, namely creating advertising content and promotional materials for others; production of advertising materials,” and the Registration recites “Promoting the goods and services of others by means of distributing advertising on the Internet.”

Applicant argues that “[n]o confusion is likely to occur by the use of Applicant’s mark and the cited mark because the services, while in the broad field of marketing, are non-competing and provide different functions.”¹³ The third-party use evidence submitted by the Examining Attorney, however, supports her contention that “the same entity commonly provides the relevant services and markets them under the same mark and provides them through the same trade channels.”¹⁴ For example, AdEasel (adeasel.com), Vilocity (viloocity.com), Sir Speedy (sirspeedy.com), Image Marketing (imagemarketingconsultants.com), The Creative Alliance (thecreativealliance.com), Bam Marketing Agency (bammarketingagency.com), and Pulse Marketing Agency (pulsemarketingagency.com), all offer both the production of advertising materials (Applicant’s services) and the distribution of advertising

¹³ 6 TTABVUE 7 (Applicant’s Brief).

¹⁴ 8 TTABVUE 9-10 (Examining Attorney’s Brief).

materials on the Internet (Registrant's services)¹⁵ This evidence belies Applicant's contention that Applicant's and Registrant's services are non-competing and supports the Examining Attorney's position that the services are closely related.¹⁶ As the Federal Circuit has noted, evidence that "a single company [provides the] services of both parties, if presented, is relevant to a relatedness analysis." *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). *See also Detroit Athl.*, 128 USPQ2d at 1047 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that [provides] both").

The Examining Attorney also provided evidence from the USPTO's X-Search database consisting of eight use-based third-party registrations (Reg. Nos. 5897873, 4900620, 5539839, 5588353, 5887921, 5913720, 6187053, and 6100308) for marks that recite services including both the production of advertising materials (Applicant's services), and its distribution on the internet (Registrant's services).¹⁷ This evidence suggests that both Applicant's and Registrant's services "are of a type that may emanate from a single source." *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013); *see also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

¹⁵ March 1, 2021 Final Office Action, TSDR at pgs. 22-93.

¹⁶ 8 TTABVUE 9 (Examining Attorney's Brief).

¹⁷ March 1, 2021 Final Office Action, TSDR at pgs. 94-113.

Applicant argues that “the marks are used in different channels of trade” because Applicant provides its services through its website “as an extension of the services provided to [Applicant’s] customers. Due to the strong connection to the VERSATRANS mark, customers viewing Applicant’s VERSA AGENCY services are not likely to believe the services have any connection to VERSAFEED, which provides unrelated advertising services, but rather, understand the source of the services is Applicant, Versatrans, which provides related content creation and printing services.” This argument is inapposite. Even if Applicant had supplied evidence of consumer connection to its other mark, VERSATRANS, such evidence would have no bearing on the issue of trade channels.

As the Examining Attorney points out, citing *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018), *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) and TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) §1207.01(a)(iii), “neither party’s trade channels are restricted” and “[i]n the absence of limitations as to channels of trade or classes of purchasers ..., the presumption is that the ... services move in all trade channels normal for such goods and/or services and are available to all potential classes of ordinary consumers of such ... services.” Here, the Examining Attorney’s third-party use evidence demonstrates that providing both Applicant’s and Registrant’s services together through the same website is a normal channel of trade for such services.

In sum, we find that Applicant’s and Registrant’s services are related, and are often provided together by the same source, under the same mark, through the same

trade channels. The second and third *DuPont* factors thus favor a finding of likelihood of confusion.

II. Conclusion

Having considered all evidence and arguments bearing on the relevant *DuPont* factors, including the similarity of the marks, services, and trade channels, we conclude that Applicant's mark VERSA AGENCY for "Advertising, marketing and promotion services, namely creating advertising content and promotional materials for others; production of advertising materials" is likely to cause confusion with Registrant's mark VERSAFEED for "Promoting the goods and services of others by means of distributing advertising on the Internet."

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