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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Knitpro International*

Serial No. 90064151

Dean W. Amburn of Amburn Law PLLC for Knitpro International.

Cameron McBride, Trademark Examining Attorney, Law Office 106,  
Mary I. Sparrow, Managing Attorney.

Before Bergsman, Lynch, and Dunn,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Knitpro International (“Applicant”) seeks registration on the Principal Register of the mark THE MANDALA COLLECTION (in standard characters) for “Buttons; Needles; Hooks and eyes; Sewing pins; all the foregoing not for use in making craft jewelry, and excluding knitting and crocheting yarns, cords, cordage, ropes, twines and hemp thread,” in International Class 26.<sup>1</sup> Applicant disclaims the exclusive right to use the word “Collection.”

<sup>1</sup> Application Serial No. 90064151 was filed on July 21, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s asserted bona fide intention to use the mark in commerce.

The Examining Attorney refused to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that THE MANDALA COLLECTION so resembles the registered mark MANDALA (in standard characters) for "knitting and crocheting yarn, not for use in making craft jewelry," in International Class 23, as to be likely to cause confusion.<sup>2</sup>

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

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

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Whether a likelihood of confusion exists between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha Steaks Int'l, Inc. v. Greater*

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When we cite to the record, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format. When we cite to the briefs, we refer to TTABVue, the Board's online docket system.

<sup>2</sup> Registered July 25, 2017.

*Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.’” *In re Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *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.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d

1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

I. The strength of the registered mark MANDALA

Applicant contends that because there are over 30 registered marks consisting of the word “Mandala,” the registered mark MANDALA is weak and only entitled to a narrow scope of protection.<sup>3</sup> However, the third-party registrations are not persuasive because the registrations are for goods and services far afield from “knitting and crocheting yarn.” *See Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar.”); *In re i.am.symbolic, llc*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven

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<sup>3</sup> Applicant’s Brief, p. 3 (13 TTABVUE 8). Applicant attached copies of the registrations to its brief. That is the first time they appear in the record. *Id.* at 13 TTABVUE 23-26 and 32-70. The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Evidence, such as these third-party registrations, submitted after appeal, without a granted request to suspend and remand for additional evidence, may be considered by the Board, despite its untimeliness, if the Examining Attorney (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. *See, e.g., In re Int'l Watchman, Inc.*, 2021 USPQ2d 1171, at \*29 n.49 (TTAB 2021) (Board treated applicant’s prior registration as if of record because examining attorney and applicant referred to it in briefing the appeal); *In re Litehouse Inc.*, 82 USPQ2d 1471, 1475 n.2 (TTAB 2007) (third-party registrations submitted for first time with applicant’s appeal brief considered because examining attorney did not object in her brief and instead presented arguments in rebuttal of this evidence); *In re Homeland Vinyl Prods. Inc.*, 81 USPQ2d 1378, 1381 n.5 (TTAB 2006) (declarations submitted for first time with applicant’s appeal brief treated of record because examining attorney did not object and addressed the evidence on the merits). In this appeal, the Examining Attorney did not object to Applicant’s late-filed evidence and treated it as if properly of record. In view thereof, we consider the copies of the late-filed third-party registrations.

nor explained that they were related to the goods in the cited registration); *TAO Licensing, LLC v. Bender Consulting Ltd.*, 125 U.S.P.Q.2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case.”).

Applicant also submitted the MERRIAM-WEBSTER DICTIONARY definition of “Mandala” defined as follows:<sup>4</sup>

- 1 : a Hindu or Buddhist graphic symbol of the universe  
Specifically: a circle enclosing a square with a deity on each side that is used chiefly as an aid to meditation
2. : a graphic and often symbolic pattern usually in the form of a circle divided into four separate sections or bearing a multiple projection of an image

According to the ENCYCLOPEADIA BRITANNICA,

Mandalas may be painted on paper or cloth, drawn on a carefully prepared ground with white and coloured threads or with rice powders (as for Buddhist Tantric ceremonies of initiation), fashioned in bronze, or built in stone, as at Borobudur, in central Java. ...

The mandala of a Tibetan tanka (cloth scroll painting) characteristically consists of an outer enclosure around one or more concentric circles, which in turn surround a square transversed by lines from the centre to the four corners. In the centre and the middle of each triangle are five circles containing symbols or images of divinities, most commonly the five “self-born” buddhas. Of the borders surrounding the mandala, the first is a ring of fire, which both bars entry to the uninitiated and symbolizes the burning of ignorance; next comes a girdle of diamonds, which stands for illumination; then a circle of eight graveyards, symbolizing the eight aspects of individuating cognition; next a girdle of lotus leaves, signifying spiritual rebirth;

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<sup>4</sup> Applicant’s Brief (6 TTABVUE 72).

and, finally, at the centre, the mandala itself, where the images are set.

Mandala, ENCYCLOPEADIA BRITANNICA (britannica.com) (November 15, 2022) (accessed November 30, 2022).<sup>5</sup> We reproduce below a representation of a Mandala pattern.<sup>6</sup>



Because “Mandala” is a pattern that could be incorporated into a knitting or crochet pattern, we find “Mandala” is suggestive when used in connection with “knitting and crocheting yarn.” As such it is inherently distinctive and has been registered on the Principal Register without a claim of acquired distinctiveness. *See* Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (“A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the

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<sup>5</sup> The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted.”); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works).

<sup>6</sup> Mandala, ENCYCLOPEADIA BRITANNICA (britannica.com) (November 15, 2022).

registered mark in commerce on or in connection with the goods or services specified in the certificate.”).

Applicant contends that “it is the combined words ‘THE’ and ‘COLLECTION’ that dominates [sic] [Applicant’s mark THE MANDALA COLLECTION] because it gives a commercial impression of a collection of curated high-quality goods.”<sup>7</sup> Applicant analogizes THE MANDALA COLLECTION to THE SIGNATURE COLLECTION that Applicant asserts “is [a] frequently used term to describe quality goods in many different areas.”<sup>8</sup> Assuming *arguendo* that THE SIGNATURE COLLECTION describes high quality goods, it is the word “Signature” that imparts that commercial impression, and the terms THE and COLLECTION merely emphasize SIGNATURE. As discussed above, the word “Mandala” has a suggestive meaning when used in connection with “knitting and crochet yarn,” and the terms THE and COLLECTION would not be perceived as source-indicating and merely emphasize MANDALA. Applicant’s argument therefore is not persuasive.

Based on the record, the registered mark MANDALA is an inherently distinctive mark and entitled to the breadth of protection to which such marks are entitled.<sup>9</sup>

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<sup>7</sup> Applicant’s Brief, p. 11 (6 TTABVUE 16).

<sup>8</sup> *Id.*

<sup>9</sup> The owner of the cited registration is not a party to this proceeding and thus cannot introduce evidence regarding its use of the mark protected thereby. *See In re Thomas*, 79 USPQ2d 1021, 1027, n. 11 (TTAB 2006) (“Because this is an *ex parte* proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark.”). As a result, the commercial strength of Registrant’s mark simply is not at issue in this proceeding.

## II. The similarity or dissimilarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *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, 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); *accord Krim-Ko Corp. v. Coca-Cola Bottling 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.”) (citation omitted).

“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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register THE MANDALA COLLECTION and the cited mark is MANDALA. The word “Mandala” is the dominant part of Applicant’s mark



because the word “Collection” is descriptive and has been disclaimed. The OXFORD ENGLISH DICTIONARY ([lexico.com/en/definition/collection](https://www.lexico.com/en/definition/collection)) defines “Collection” as, inter alia, “a group of things or people” and “an assembly of items such as works of art, pieces of writing, or natural objects, especially one systematically ordered.”<sup>10</sup> The Examining Attorney required Applicant to disclaim the exclusive right to use the word “Collection” because it is merely descriptive inasmuch as “applicant provides a group or assembly of different sewing items.”<sup>11</sup> Applicant complied with the requirement to disclaim the exclusive right to use the word “Collection” in the April 20, 2021 Response to an Office Action.

It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because consumers will tend to focus on the more distinctive parts of marks. *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”).

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<sup>10</sup> October 20, 2020 Office Action (TSDR 7).

<sup>11</sup> *Id.* at TSDR 5.

Here, consumers would focus on the shared identical term MANDALA, and would attribute the same meaning to the term in both marks. 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 entireties. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Nat'l Data Corp.*, 224 USPQ at 751.

In that regard, the indefinite article “The” at the beginning of Applicant’s mark has little, if any, trademark significance. See *Motorola, Inc. v. Griffiths Elecs., Inc.*, 317 F.2d 397, 137 USPQ 551, 552 (CCPA 1963) (THE is “of trifling importance”); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (“The marks [WAVE and THE WAVE] are virtually identical. The addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods., Inc.*, 223 USPQ 1034 n.2 (TTAB 1984) (noting “the insignificance of the word ‘the’” in comparison of THE MUSIC MAKERS and MUSICMAKERS).

In addition to the fact that the dominant part of Applicant’s mark MANDALA is identical to the registered mark MANDALA, Applicant’s mark THE MANDALA COLLECTION incorporates the entirety of the cited registered mark MANDALA. While there is no explicit rule that marks are automatically similar under these circumstances, “likelihood of confusion has often been found where the entirety of one mark is incorporated within another.” *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*6-7 (TTAB 2019) (quoting *Hunter Indus., Inc. v. Toro*

*Corp.*, 110 USPQ2d 1651, 1660 (TTAB 2014)). *See also China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (applicant's mark CHI PLUS is similar to opposer's mark CHI both for electric massagers); *Coca-Cola Bottling Co. of Mem., TN, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant's mark BENGAL LANCER for club soda, quinine water and ginger ale is similar to BENGAL for gin); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is similar to WEST POINT for woolen piece goods). Under these circumstance, consumers encountering the registered mark MANDALA are likely to mistakenly believe MANDALA "knitting and crocheting yarn" is part of THE MANDALA COLLECTION of sewing products because of the shared use of the word "Mandala."

We find that Applicant's mark THE MANDALA COLLECTION and the registered mark MANDALA are similar in appearance, sound, connotation and commercial impression.

### III. The similarity or dissimilarity and nature of the goods

Applicant is seeking to register THE MANDALA COLLECTION for "Buttons; Needles; Hooks and eyes; Sewing pins; all the foregoing not for use in making craft jewelry, and excluding knitting and crocheting yarns, cords, cordage, ropes, twines and hemp thread." The mark MANDALA in the cited registration is registered for "knitting and crocheting yarn, not for use in making craft jewelry."

To show that the goods are related, the Examining Attorney submitted three third-party registrations for goods in both classes. Third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, \*8 (TTAB 2019); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988). We list the registrations below:

- Registration No. 5060032 for the mark BBLOOP for, inter alia, yarn and “auxiliary decker needles,” “crochet hooks,” “embroidery needles,” “eyelets,” “hand knitting needles,” “hooks and eyes,” and “needles”;<sup>12</sup>
- Registration No. 5532718 for the mark ANN WILLIAMS for, inter alia, “kits comprised primarily of a hand-operated weaving loom and also including yarn, thread, cording, fabrics, and ribbon,” “hobby project craft kits for children and adults comprising one of more of the following items, namely, yarns, thread,” and “hobby project craft kits for children and adults comprising one of more the following items, namely, ... needles, ... buttons”;<sup>13</sup> and

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<sup>12</sup> October 20, 2020 Office Action (TSDR 24-25).

<sup>13</sup> October 20, 2020 Office Action (TSDR 28-31).

- Registration No. 5476911 for the mark THE ROYAL BEE YARN COMPANY for, inter alia, yarn and buttons.<sup>14</sup>

The Examining Attorney also submitted the evidence from the Internet listed below that show yarn and needles or buttons used together:

- “Beginner’s Guide to Choosing the Right Knitting Yarn and Needles,” posted on the Brown Sheep website (brownsheep.com) reporting that it is important for the novice knitter to select the right knitting yarns and knitting needles.<sup>15</sup> “After you’ve chosen the right knitting yarn and needles, you’re all set to start knitting.”<sup>16</sup>

- Amazon.com advertising KnitPicks “Yarn Knitting Needles”;<sup>17</sup>

- “6 Must-Know Tips for Adding Buttons to Crochet,” posted on the Craftsy website (craftsy.com) regarding using yarn to secure buttons;<sup>18</sup>

- A screenshot of a YouTube video (youtube.com) demonstrating how to sew hooks, eyes, and eyelets on knit or crochet items;<sup>19</sup>

- “34 Surprise Knitting Stats for 2021,” posted on the Craft Tribe Online website (crafttribeonline.com)<sup>20</sup> and “Studies Conducted About Knitting and Crochet” posted

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<sup>14</sup> October 20, 2020 Office Action (TSDR 33).

<sup>15</sup> May 10, 2021 Office Action (TSDR 21-22). The Examining Attorney submitted the article a second time in his December 3, 2021 Denial of Request for Reconsideration (TSDR 14-15).

<sup>16</sup> *Id.* at TSDR 22.

<sup>17</sup> December 3, 2021 Denial of Request for Reconsideration (TSDR 4 and 12).

<sup>18</sup> December 3, 2021 Denial of Request for Reconsideration (TSDR 16-17).

<sup>19</sup> December 3, 2021 Denial of Request for Reconsideration (TSDR 18).

<sup>20</sup> March 18, 2021 Denial of Request for Reconsideration (TSDR 15).

on the Knitting Daily Deal website (knitlikegranny.com) refer to knitting as a “needle art.”<sup>21</sup>

Finally, we note that the MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed November 23, 2022) defines a “knitting needle” as “one of two or more long, thin, usually metal or plastic sticks that are pointed at one end and used for knitting.”<sup>22</sup> The ENCYCLOPAEDIA BRITANNICA (britannica.com) (accessed November 23, 2022) describes a “needle” as a “basic implement used in sewing or embroidering and, in variant forms, for knitting and crocheting.”<sup>23</sup>

Crocheting needles are eyeless, with one hooked end, and made in several sizes, commonly of steel or plastic. Knitting needles are long, made of a variety of materials, and bluntly pointed at one or both ends, sometimes with a knob at the end opposite the point. The earliest were hooked, but modern needles are straight.<sup>24</sup>

The evidence shows that the needles in Applicant’s description of goods and “knitting and crochet yarn” in Registrant’s description of goods are complementary products that are used together. *See In re Martin’s Famous Pastry Shoppe, Inc.*,

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<sup>21</sup> March 18, 2021 Denial of Request for Reconsideration (TSDR 27).

<sup>22</sup> The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

<sup>23</sup> The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works).

<sup>24</sup> *Id.*

748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (with respect to bread and cheese, “[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”); *Sholl Dental Lab. Co. v. McKesson & Robbins, Inc.*, 150 F.2 718, 66 USPQ 223, 226 (CCIA 1945) (while not controlling, conjoint use is a fact that should be considered along with other relevant facts); *Visual Info. Inst. Inc. v. Vicon Indus., Inc.*, 209 USPQ 179, 190 (TTAB 1979) (“the products, although not interchangeable, are complementary in that they can be used together in the same close circuit television system.”).

Applicant argues that its products, specifically needles and buttons, and Registrant’s “knitting and crochet yarn” are different products and that there is no evidence that those products emanate from the same source.<sup>25</sup>

Again, nothing suggests that the products are from the same source. If anything, since they need to be put together it implies they are from different sources.<sup>26</sup>

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<sup>25</sup> Applicant’s Brief, pp. 13-14 (6 TTABVUE 18-19).

<sup>26</sup> *Id.* at p. 14 (6 TTABVUE 19). Applicant supports its argument by analogizing the products at issue with automobiles and tires.

All cars come with tires, and it would be easy to show photos of cars with tires including cars at dealerships or tire stores. Yet, how many tires are branded General Motors, Ford, Chrysler, etc. Instead, cars use a variety of sources for tires. In other words, seeing products together doesn’t mean they are from the same source. In the case of cars and tires, like knitting needles and yarn, the consuming public expects that come from different sources.

*Id.* at pp. 14-15 (6 TTABVUE 19-20). However, our precedents often find automobiles and tires are related products. *See, e.g., In re Mitsubishi Jidosha Kogyo Kabushiki Kaisha*, 19 USPQ2d 1633 (TTAB 1991) (SIGMA for automobiles is likely to cause confusion with SIGMA with a sigma design for tires); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles versus LAREDO for tires: there is such a close relationship between “land vehicles” and “pneumatic tires” that the use by different parties of the same

We disagree. First, the issue is not whether purchasers would confuse the goods of Applicant and Registrant, but rather whether there is a likelihood of confusion as to the source of these goods. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (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.”); *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (“the test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.”); *In re Cook Med. Tech. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012).

Second, in determining whether the goods are related, it is not necessary that the goods of Applicant and Registrant are similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes that goods are related in some manner or that conditions and activities surrounding marketing of these goods are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs.*, 101 USPQ2d at 1722; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corporation v. Alza*

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mark for these goods is likely to cause confusion); *In re General Motors Corp.*, 199 USPQ 234 (TTAB 1978) (“CUTLASS” for automobiles is likely to cause confusion with “CUTLASS” for tires for vehicles); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973) (GEMINI and GMINI for automobiles is likely to cause confusion with GEMINI for vehicle tires).



*Corporation*, 207 USPQ 504, 507 (TTAB 1980). In this appeal, because the relevant consumers use needles, specifically knitting or crochet needles, with knitting and crochet yarn, they are likely to mistakenly believe that the different products emanate from or are sponsored by the same source.

Finally, where as here, the marks are very similar, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993) ("even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source."); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002) ("the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion."); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (same).

The second *DuPont* factor weighs in favor of finding a likelihood of confusion.

#### IV. The lack of any reported instances of actual confusion

According to Applicant,

The earlier cited Registration No. 4,622,312 for MANDALA CRAFTS WE MAKE IT, SO YOU CAN MAKE IT and design [for, inter alia, "buckles for making craft wrist bracelets; jewelry hooks for making craft earring jewelry; beads for making craft jewelry] has a date of first use of August 15, 2014; the Registrant's mark for MANDALA has a date of first use of February 2, 2017; Registration No. 5,500,954 for MANDALA CRAFTS [for, inter alia, "buckles of common metal; bracelets; earrings; necklaces; rings; jewelry charms; and anklets] has a date of first use of

January 1, 2015. These marks have co-existed for over five years or more, without any apparent confusion, as evidenced by the lack of any opposition to the registration of later marks.<sup>27</sup>

Applicant concludes that where such a significant period of time elapses with no reported instances of confusion, the Board may infer no likelihood of confusion.<sup>28</sup>

Applicant's argument is not well taken. First, the issue of likelihood of confusion in this appeal is based on whether Applicant's mark THE MANDALA COLLECTION is likely to cause confusion with the registered mark MANDALA, not whether THE MANDALA COLLECTION is likely to cause confusion with the third-party registered marks MANDALA CRAFTS WE MAKE IT, SO YOU CAN MAKE IT or MANDALA CRAFTS. Any evidence regarding the lack of any reported instances of actual confusion must pertain to the marks at issue. Applicant may not rely, *jus tertii*, on third-party marks.<sup>29</sup> See *Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 1581, 222 USPQ 665, 669 (Fed. Cir. 1984) ("[I]t is likewise irrelevant in this cancellation proceeding that others ... may possibly have been using the same mark for the same purposes."); *Krug Vins Fins de Champagne v. Rutman Wine Co.*, 197 USPQ 572, 574-75 (TTAB 1977) ("The fact that the third persons might possess some rights in their respective marks which they could possibly assert against petitioner in a proper proceeding can avail respondent nothing herein since respondent is not in privity

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<sup>27</sup> Applicant's Brief, p. 12 (6 TTABVUE 17).

<sup>28</sup> *Id.* at p. 13 (6 TTABVUE 18).

<sup>29</sup> It is for this reason we do not consider the consent agreement the owner of Registration No. 4622312 for the mark MANDALA CRAFTS WE MAKE IT, SO YOU CAN MAKE IT; and the owner of Registration No. 5500954 for MANDALA CRAFTS. April 20, 2021 Response to Office Action (TSDR 15).

with nor is the successor in interest to any rights which such persons have acquired in their marks.”). *Cf. Opus One*, 60 USPQ2d at 1821 n.15 (“[A]ny such evidence upon which an applicant in an ex parte appeal might rely under *DuPont* factor 10(d) must pertain to the ‘market interface’ between the applicant and the prior registrant.”).

Second, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Registrant under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Double Coin*, 2019 USPQ2d 377409, at \*26-29.

Our analysis as to the second, third, and fourth *DuPont* factors, discussing the similarity or dissimilarity of the services, channels of trade, and relevant consumers, is based on the identifications as set forth in Applicant’s application and Registrant’s registration. *In re Guild Mortgage, Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020). As such, we may not consider, in assessing these *DuPont* factors, evidence of how Applicant and Registrant are actually rendering their services in the marketplace. *Id.* at \*6.

The eighth *DuPont* factor, by contrast — “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *see DuPont*, 177 USPQ at 567 — requires us to look at actual market

conditions, to the extent there is evidence of such conditions of record. In this regard, we consider all of the evidence of record that may be relevant to the eighth *DuPont* factor. *Guild Mortg.*, 2020 USPQ2d 10279, at \*6. In this regard, Applicant filed an intent to use application and because there is no evidence that Applicant has used its mark, we do not have the opportunity to assess whether there has not been an opportunity for confusion to occur.

Finally, in this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story. *See, e.g., Guild Mortg.*, 2020 USPQ2d 10279, at \*7; *Opus One, Inc.*, 60 USPQ2d at 1817 (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”) (citations omitted); *In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001) (“[I]nasmuch as we have heard from neither registrant nor the Highland Orange Association in this appeal, we cannot conclude that, in fact, no instances of actual confusion ever occurred.”). This constraint inherent in the ex parte context necessarily limits the potential probative value of evidence bearing on the eighth *DuPont* factor, compared with an inter partes proceeding, where the registrant has an opportunity to present argument and evidence in response.

The lack of any reported instances of confusion is a neutral *DuPont* factor.

## V. Conclusion

Because the marks are similar and the goods are related, we find that Applicant's mark THE MANDALA COLLECTION for "Buttons; Needles; Hooks and eyes; Sewing pins; all the foregoing not for use in making craft jewelry, and excluding knitting and crocheting yarns, cords, cordage, ropes, twines and hemp thread" is likely to cause confusion with the registered mark MANDALA for "knitting and crocheting yarn, not for use in making craft jewelry."

**Decision:** We affirm the refusal to register Applicant's mark THE MANDALA COLLECTION under Section 2(d) of the Trademark Act.