

This Opinion is not a
Precedent of the TTAB

Mailed: June 30, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Mighty Buildings, Inc.
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Serial Nos. 90384068, 90384173, 90384232 and 90384272¹
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Olivia Maria Baratta and Collier L. Johnson II of Kilpatrick Townsend & Stockton
LLP, for Mighty Buildings, Inc.

Brendan McCauley, Trademark Examining Attorney, Law Office 114,
Nicole A. Nguyen, Managing Attorney.
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Before Zervas, Shaw and Allard,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Mighty Buildings, Inc. (“Applicant”) seeks registration on the Principal Register
of four standard-character marks, MIGHTY STUDIO, MIGHTY DUPLEX, MIGHTY
HOUSE, and MIGHTY DUO, all for services identified as “3D printing for others; 3D
printing of building components and structures for others; Custom 3D printing;

¹ Citations to the record are to Serial No. 90384068, unless otherwise noted, and refer to the
USPTO’s Trademark Status & Document Retrieval (“TSDR”) system’s online database, by
page number, in the downloadable .pdf format.

Because the appeals involve similar issues and nearly identical records, the Board
consolidated the appeals by an order dated October 21, 2022. 8 TTABVUE. We issue a single
opinion for all four appeals.

Custom 3D printing for others; Custom 3D printing of building components and structures for others; Custom 3D printing of residential buildings [for others],” in International Class 40.²

The Trademark Examining Attorney refused registration of all four of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the mark MIGHTY SMALL HOMES, in standard characters (SMALL HOMES disclaimed), registered for “Planning and custom construction services limited to diminutive residential homes, custom construction of small-footprint residential structures,” in International Class 37.³

When the refusals were made final, Applicant appealed. Both Applicant and the Examining Attorney filed briefs. We affirm the refusals to register.

I. Background

During prosecution, the Examining Attorney also refused registration on the ground of likelihood of confusion with the mark MIGHTY BUILDINGS in standard characters (BUILDINGS disclaimed) for “3D printing for others; 3D printing of building components and structures for others; Custom 3D printing; Custom 3D printing for others; Custom 3D printing of residential buildings; Custom 3D printing

² Application Serial Nos. 90384068, 90384173, 90384232 and 90384272, filed on December 15, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the marks in commerce. Applicant has disclaimed STUDIO, DUPLEX, and HOUSE, respectively. The language “for others” in brackets appears only in application Serial No. 90384068. Otherwise, the remaining services are essentially identical, differing only in variations in the order of the identified services.

³ Registration No. 5532771, issued August 8, 2018.

of building components and structures for others,” in International Class 40.⁴ The registration is owned by Applicant’s related company but no claim of ownership was of record. In addition, the Examining Attorney advised Applicant of seven pending applications for other MIGHTY-formative marks, also owned by Applicant’s related company, and stated that absent a claim of ownership, Applicant’s mark might be refused under Section 2(d) if any of these marks registered.⁵ In its responses to the respective Office Actions, Applicant claimed ownership of Registration No. 6316919 and the then-pending applications, and the refusal and potential refusals were withdrawn.⁶

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) (“*DuPont*”). *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*

⁴ Registration No. 6316919, issued on April 6, 2021. Office Action of June 11, 2021, TSDR 4-6.

⁵ Office Action of June 11, 2021, TSDR 11.

⁶ Four of the pending applications for other MIGHTY-formative marks eventually registered. Applicant did not introduce current status and title copies of these later-issued registrations, nor did the Examining Attorney introduce copies of the registrations. Inasmuch as they are not properly of record and neither Applicant nor the Examining Attorney discuss these registrations in their briefs, we have not considered them under the thirteenth *DuPont* factor discussed below. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1208.02 (June 2022) (for registrations that are not the subject of the appeal, a copy from the electronic records of the USPTO must be submitted); *see In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (Board declined to take judicial notice of registrations owned by applicant).

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 goods or services and the similarities between the marks. *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.”).

A. Strength of the cited mark

Before considering the similarity or dissimilarity of Applicant’s and Registrant’s marks, we address the strength of the cited mark. *DuPont*, 177 USPQ at 567. The strength of a mark may be assessed based on its conceptual strength arising out of the nature of the mark itself and its commercial strength, derived from the marketplace recognition of the mark. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, a mark’s strength “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

Although Registrant’s mark is registered on the Principal Register and hence is presumptively valid and distinctive for the identified services, we may acknowledge the weakness of a registered mark in the course of a *DuPont* analysis. *See* Trademark Act Sections 7(b) and 33(a), 15 U.S.C. §§ 1057(b) and 1115(a); *In re Fat Boys Water*

Sports LLC, 118 USPQ2d 1511, 1517-18 (TTAB 2016); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007).

In view of a dictionary definition of MIGHTY, we find that the mark MIGHTY SMALL HOMES falls on the suggestive end of the spectrum.⁷ That is, although the term MIGHTY is defined as “great or imposing in size or extent : EXTRAORDINARY” and could be considered laudatorily descriptive, when combined with SMALL HOMES, the entire mark, MIGHTY SMALL HOMES, is incongruous. *See In re Shutts*, 217 USPQ 363, 365 (TTAB 1983) (“[I]ncongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark.”). We therefore accord the MIGHTY SMALL HOMES mark the normal scope of protection inherently distinctive marks are entitled. *See Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (finding that the opposer’s marks were entitled to “the normal scope of protection to which inherently distinctive marks are entitled”).

The *DuPont* factors relating to the strength of Registrant’s mark are neutral.

B. The similarity or dissimilarity of the marks in their entireties 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, we must consider their appearance, sound, connotation and

⁷ *See* <https://www.merriam-webster.com/dictionary/mighty> which defines “mighty” as, inter alia, “great or imposing in size or extent : EXTRAORDINARY.” Accessed June 29, 2023. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006) (the Board may take judicial notice of dictionary definitions that exist in printed format or regular fixed editions). Neither the Examining Attorney nor Applicant introduced evidence regarding the conceptual or commercial strength of the cited mark.

commercial impression. *Palm Bay*, 73 USPQ2d at 1692. “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)). *Accord 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).

The dominant portion of Registrant’s and Applicant’s marks is the term MIGHTY. It comes first in all of the marks and hence is the first term consumers will encounter when perceiving the marks. Although not the strongest of terms, as noted above, MIGHTY is more distinctive than the other terms in the marks, which are merely descriptive and—except for the term DUO in the MIGHTY DUO mark—have been disclaimed by Applicant. *See 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); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). In the MIGHTY DUO mark, the term DUO is not the dominant term because it follows the

term MIGHTY, and it is highly suggestive of a duplex or small home with two rooms or bedrooms.⁸

When we consider the marks as a whole, we find that they are overall very similar, particularly in connotation and commercial impression, despite any lesser incongruity in Applicant's marks. In other words, Registrant's and Applicant's marks all convey the connotation and commercial impression that the finished home will be great or extraordinary.

Applicant argues that the Examining Attorney errs in comparing the marks by ignoring the additional wording in each of its marks which "constitutes fifty percent of the mark"⁹ and which "creates a commercial impression that is significantly distinct from the Cited Mark to avoid any confusion."¹⁰ We disagree.

It is well settled that a single feature of a mark may be more significant than other features, and it is not improper to give more weight to a dominant feature in determining the similarity of the marks. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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 entirety. Indeed,

⁸ See <https://www.collinsdictionary.com/us/dictionary/english/duo> which defines "duo" in American English as "two [or] double." Accessed June 29, 2023. Applicant initially disclaimed DUO but withdrew the disclaimer in a response to an Office Action. Serial No. 90384272, December 10, 2021 Response to Office Action, TSDR 13.

⁹ See *e.g.*, Applicant's Br., p. 4, 4 TTABVUE 5.

¹⁰ *Id.*

this type of analysis appears to be unavoidable.”). Here, given the dominance of the term MIGHTY, by position and meaning, we find it likely that prospective consumers, upon encountering Applicant’s marks, would perceive them to be a variation on Registrant’s mark, used in connection with building a particular type of home of home.

The argument that the marks are not similar because the additional wording in each of Applicant’s marks “constitutes fifty percent of the mark”¹¹ is unpersuasive as well. A determination of likelihood of confusion is not made on a purely mechanical basis, counting the number of words, syllables or even letters that are similar or different. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.”); *Fuji Jyukogyo K.K v. Toyota Jidosha K.K.*, 228 USPQ 672, 674 (TTAB 1985) (“Purchasers do not count letters when reacting to trademarks in the marketplace.”); *Am. B.D. Co. v. N.P. Beverages, Inc.*, 213 USPQ 387, 388 (TTAB 1981) (“Purchasers are not expected to, and do not, count the number of letters which marks have in common.”).

The *DuPont* factor regarding the similarity of the marks weighs in favor of a finding of likelihood of confusion as to all of Applicant’s marks.

¹¹ *See e.g.*, Applicant’s Br., p. 4, 4 TTABVUE 5.

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

We next consider the similarity of the respective services. “[I]t is not necessary that the [services] of the parties be similar or even competitive to support a finding of likelihood of confusion” in order to find that they are related for purposes of our likelihood of confusion analysis. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). The issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. See *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012); *In re Rexel*, 223 USPQ 830, 831 (TTAB 1984). Moreover, it is sufficient for a finding of likelihood of confusion if relatedness is established for any service encompassed by the recitation of services within a particular class in an application. See *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant’s services are 3D printing services, including custom 3D printing of residential buildings. Registrant’s services are planning and custom construction services limited to diminutive residential homes, [and] custom construction of small-footprint residential structures. The Examining Attorney argues that the respective services are similar:

3D printing is the process of creating or building which is the exact nature of registrant’s construction services. In addition, both services are for the construction of buildings particularly as related to applicant’s custom 3D printing of building components and structures and registrant’s construction of custom residential homes and structures.

While the services are not identical as described or classified, the essence and end result of the services are the building of residential structures and buildings. Moreover, these services are clearly custom and residential in nature as expressly identified in the identification of services in the applications and registration.¹²

To support the refusal, the Examining Attorney introduced the following evidence:

- Definitions of the terms “construction,” “construct,” “3D printing” and “manufacture;”¹³
- Excerpts from the USPTO website of acceptable trademark identifications explaining that “3D printing services” “refer to the process of creating or building three-dimensional solid objects from a digital model by laying down successive layers of material;”¹⁴ and
- Seven Internet articles, online videos, or builder webpages discussing the growing business of building 3D printed houses as an alternative to other traditional home-building methods.¹⁵

For its part, Applicant argues that:

In this case, there are significant differences between the 3D printing services offered by the Applicant and the construction services offered by the Registrant. The services offered by the Applicant feature a specialized 3D printer and composite material to build sustainable modern homes. On the other hand, the Registrant’s services are more traditional construction services unlikely to be used by the same class of users seeking to use new 3D

¹² Examining Attorney’s Br., p. 11, 9 TTABVUE 12.

¹³ Merriam-webster.com, Office Action of June 11, 2021, TSDR 12-40.

¹⁴ <https://idm-tmng.uspto.gov/idml/id-master-list-employee.html>, Office Action of June 11, 2021, TSDR 41-43.

¹⁵ Office Action of January 7, 2022, TSDR 8-63.

printing technology. These distinctions are important as it demonstrates that the services are commercially unrelated and unlikely to travel in the same trade channels.¹⁶

We disagree with Applicant that there are significant differences between its services and Registrant's. Although the method of building the house may differ, upon completion, the consumer gets the same product, i.e., a house. In addition, Registrant's "custom construction services" are not limited to a particular construction material or method, such as using wood or cinderblock. Thus, Registrant's MIGHTY SMALL HOMES also could be built using 3D custom printing services, just as Applicant's are. Accordingly, we find that Registrant's broadly-worded "custom construction services" encompass Applicant's more narrowly worded "custom 3D printing of residential buildings." See *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"); *S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the goods [or services] in an application or registration are broadly described, they are deemed to encompass all the goods [or services] of the nature and type described therein).

Considering the channels of trade and classes of consumers, because the services are in part overlapping, and the identifications of services in the application and registration contain no limitations, it is presumed that the services identified therein move in all channels of trade normal therefor, and that they are available to all

¹⁶ Applicant's Br., p. 5, 4 TTABVUE 6.

classes of purchasers, including prospective custom home buyers. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). *See also Coach Services*, 101 USPQ2d at 1723 (absent limitation “goods [or services] are presumed to travel in all normal channels . . . for the relevant goods [or services].”). Here, given the finding that the respective services are in part overlapping, we find the channels of trade and classes of purchasers for the respective services to be similar as well. *Id.*

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

D. Applicant’s ownership of prior registrations¹⁷

The thirteenth and final *DuPont* factor pertains to “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. Seldom invoked, this factor “accommodates the need for flexibility in assessing each unique set of facts” *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012), *aff’d mem.*, (Fed. Cir. Sept. 13, 2019). This includes a variety of circumstances, such as the coexistence of an applicant’s prior-registered mark with a cited registration. *See, e.g., Inn at St. John’s*, 126 USPQ2d at 1748 (no likelihood of confusion found with the registered mark ANYWEAR BY JOSIE NATORI and design where the applicant’s previously registered mark ANYWEARS was substantially similar to the applied-for mark ANYWEAR for identical goods and had been registered for over 5 years).

¹⁷ Applicant argued this evidence under the *DuPont* factor regarding the similarity of the respective services. Applicant’s evidence of prior registrations is more appropriately analyzed under the thirteenth *DuPont* factor.

As noted above, Applicant owns Registration No. 6316919 for the mark MIGHTY BUILDINGS, in standard characters (BUILDINGS disclaimed), for 3D building printing services. Thus, we are presented with the unusual situation wherein an applicant's existing registration for a similar mark for the same services has coexisted with the cited registration.

In *Strategic Partners, supra*, the applicant owned a registered mark that had coexisted with the cited mark for over five years. Because the applicant's prior registration was over five years old, it was not subject to challenge by the owner of the cited registration based on a Section 2(d) claim of likelihood of confusion. In finding no likelihood of confusion in *Strategic Partners*, the Board explained:

[T]he present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant's applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth *du Pont* factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

Strategic Partners, 102 USPQ2d at 1400.

When we consider Applicant's prior registration under the thirteenth *DuPont* factor, we find that it does not weigh strongly in Applicant's favor against a finding of a likelihood of confusion. The claimed registration is barely two years old and is not incontestable. It therefore is subject to a cancellation proceeding under Section 2(d). *Cf. Strategic Partners*, 102 USPQ2d at 1399 (“[A]pplicant's existing registration is over five years old, and thus is not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion.”).

Moreover, it is well settled that each case must be decided on its own merits; we are not bound by the prior determinations and actions of examining attorneys on different factual records. *See, e.g., In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Davey Prods. Pty.*, 92 USPQ2d 1198, 1206 (TTAB 2009) (“Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board.”).

This *DuPont* factor only slightly favors a finding that confusion is not likely.

E. Conclusion

The similarity of the marks for overlapping services, which move in the same channels of trade to the same classes of customers, renders confusion likely. Applicant’s prior registration of MIGHTY BUILDINGS for the same services does not outweigh the other *DuPont* factors which weigh heavily in favor of a finding that there is a likelihood of confusion. We find the record establishes that consumers familiar with the services offered under Applicant’s marks, MIGHTY STUDIO, MIGHTY DUPLEX, MIGHTY HOUSE, and MIGHTY DUO, who encounter the services offered under Registrant’s mark, MIGHTY SMALL HOMES, are likely to believe that the services emanate from a single source.

Decision: The refusals to register Applicant’s marks under Section 2(d) of the Trademark Act are affirmed.