

This Opinion is not a
Precedent of the TTAB

Mailed: June 13, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Seton Hall Preparatory School
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Serial No. 90459031
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Ray A. Mantle of Mantle Law,
for Seton Hall Preparatory School.

Kemi Odusami, Trademark Examining Attorney, Law Office 117,
Cynthia Tripi, Managing Attorney.

—
Before Greenbaum, Goodman and Lynch,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Seton Hall Preparatory School (“Applicant”) seeks registration on the Principal Register of the mark SETON HALL PREP (in standard characters, PREP disclaimed) for

Educational services, namely, conducting classes, courses, seminars, workshops and conferences in the field of high school preparatory education, including sports, art, and

theater, and distribution of educational materials in connection therewith in International Class 41.¹

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), because Applicant's mark is likely to be confused with the Principal Register mark SETON HALL UNIVERSITY (in standard characters, UNIVERSITY disclaimed) for

Educational services, namely, conducting lectures, courses, workshops, seminars and conferences at the university undergraduate, graduate and post-graduate levels, and conducting extension courses and community service lectures and workshops; organizing and arranging exhibitions for entertainment purposes, namely, sports exhibitions, art exhibitions, and motion picture exhibitions; entertainment in the nature of theater productions, live music concerts, dance and ballet performances; entertainment in the nature of live stage performances in the nature of public lectures for hire in the fields of art, nursing, business, architecture and urban planning, social welfare, educator training, health sciences, information studies, natural sciences, social sciences, humanities, communications, continuing

¹ Application Serial No. 90459031 was filed on January 11, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as November 26, 1925.

The Examining Attorney initially refused registration based on the mark being primarily merely a surname and required disclaimers of HALL and PREP. Applicant amended its application under Section 2(f) and provided a disclaimer of PREP. The Examining Attorney accepted the disclaimer of PREP, withdrew the requirement for a disclaimer of HALL, and withdrew the surname refusal, finding the amendment to Section 2(f) unnecessary. February 10, 2022 Office Action, TSDR 1.

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Applicant's brief is at 4 TTABVUE and its reply brief is at 7 TTABVUE. The Examining Attorney's brief is at 6 TTABVUE.

education, engineering and applied sciences by an individual in International Class 41.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Preliminary Matters

Applicant's reply brief, while 9 pages, is single-spaced and would undoubtedly exceed the ten-page limit, if submitted with double-spaced text, as required. The applicable Trademark Rules are clear that a reply brief "shall not exceed ten pages" and submissions to the Board "must be double-spaced." Trademark Rules 2.142(b)(2) and 2.126(a) and (b), 37 C.F.R §§ 2.142(b)(2) and 2.126 (a) and (b). Therefore, we do not consider Applicant's reply brief or any material attached thereto.³

We now address the Examining Attorney's and Applicant's objections.

The Examining Attorney objects to any additional third-party registrations referenced in Applicant's brief that are not of record. To the extent Applicant's brief references third-party registrations that are not of record, we do not consider them.

Applicant objects to some of the documents submitted in the final Office Action, dated July 5, 2022.⁴

² Registration No. 4870285, issued December 15, 2015, Section 8 accepted; Section 15 acknowledged.

³ We note that even if we had considered the Applicant's reply brief, it would have changed the result we reached herein, and as to the attachments, such are not proper and could not be considered absent a request for remand. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 (2022).

⁴ Applicant also points out that during examination (May 3, 2022 Office Action, TSDR 77-130) the Examining Attorney submitted irrelevant third-party registration evidence, which Applicant pointed out in a June 17, 2022 response. Applicant renews this objection in its

Applicant objects to a Lexis article at TSDR 2 which does not have a date or URL. However, since this document is from the Lexis Database and includes sufficient identifying information as to the title, name of publication, and date, this objection is overruled. Applicant also objects to the webpage at TSDR 13, as lacking URL and date accessed. This objection is sustained. *See* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2). Applicant objects to the New York University webpage at TSDR 3 as incomplete. This objection is overruled. While we do not exclude consideration of this website, we bear Applicant's objection in mind when considering the webpage for whatever probative value it may have.

Applicant objects to Google Search evidence of "Seton Hall Prep Seton Hall University" at TSDR 14-16 as insufficient in context. To the extent the Examining Attorney is relying on the search evidence for the content of specific entries, the objection is sustained as to lack of context. *In re Bayer Aktiengesellschaft*, 488 F.3d 960 , 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (search engine results which provide little context may be insufficient to determine the relevance of the search results). However, as discussed below, we consider the Google search result relating to "People Also Ask" on which the Examining Attorney's argument is based.

Applicant has objected to the Wikipedia entry for Seton Hall Prep on the ground that Applicant did not have an opportunity to rebut it.

brief. Because the Examining Attorney has not relied on this evidence, we give no probative weight to the third-party registration evidence unrelated to the services at issue.

Here, Applicant had an opportunity to rebut the Wikipedia evidence by filing a request for reconsideration but did not do so; it also could have sought a remand.⁵ Therefore, we overrule the objection. Nonetheless, while we consider the Wikipedia evidence, we recognize its limitations as a collaborative website, also keeping in mind whether corroborating evidence exists in the record to support the accuracy of the statements the Examining Attorney relies on. *See In re IP Carrier Consulting Grp*, 84 USPQ2d 1028, 1032 (TTAB 2007).

Applicant objects to the Seton Hall Prep website attachments at TSDR 38-43 as duplicative. The Board has long discouraged multiple submissions of the same evidence because they are unnecessarily cumulative and can cause confusion in reviewing the record. *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *1 (TTAB 2019). However, here, the Examining Attorney has included additional pages from Applicant's website that were not included in the prior Office Action, so while some pages are duplicative, we need not exclude them.

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to

⁵ The TBMP notes that "in the last several years excerpts from Wikipedia have frequently been submitted during the prosecution of an application and have rarely been rebutted by an updated excerpt. The Board now may consider evidence taken from Wikipedia submitted with a denial of a request for reconsideration. ... An applicant who wishes to rebut such evidence may request a remand to submit other evidence that may call into question the accuracy of the particular Wikipedia information." TBMP § 1208.03.

deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth 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, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mtg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *4 (Fed. Cir. 2023) (“In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis.”); *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the 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 services. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *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 or services] and differences in the marks.”); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *3 (TTAB 2019) (“two key considerations are the similarities between the marks and the similarities between the goods and services”).

These factors, and others, are discussed below.

A. Similarity or Dissimilarity of the Services

We turn first to the second *DuPont* factor, where we assess the similarity or dissimilarity of Applicant's and Registrant's services. *Dupont*, 177 USPQ 567. In determining relatedness of Applicant's and Registrant's services, we must focus on the services as they are identified in the involved application and cited registration. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's services are "Educational services, namely, conducting classes, courses, seminars, workshops and conferences in the field of high school preparatory education, including sports, art, and theater, and distribution of educational materials in connection therewith"; Registrant's services include "Educational services, namely, conducting lectures, courses, workshops, seminars and conferences at the university undergraduate, graduate and post-graduate levels, and conducting extension courses and community service lectures and workshops."

Thus, Applicant and Registrant both conduct courses, workshops, seminars and conferences, but Applicant does so in connection with high school preparatory education, and Registrant does so at the university undergraduate, graduate and post-graduate levels. The Examining Attorney submitted third-party website evidence, including from universities that offer both undergraduate and high-school educational services under the same mark, to support relatedness. For example:

George Washington University offers “The George Washington University Online High School” for students in grades 8-12. It is a college preparatory academy for motivated students.⁶

Salem Academy is a girls boarding and day school for grades 9-12, and is adjacent to Salem College. The website refers to them as a single entity: “Salem Academy and College, in furtherance of its values as an educational institution....”⁷

UC San Diego offers “The Preuss School UC San Diego,” which is a charter middle and high school for low income students on the university campus.⁸

University of Nebraska offers “University of Nebraska High School,” an accredited online high school, providing core, elective, AP, dual enrollment, and NCAA approved courses.⁹

Catholic University offers dual enrollment for homeschooled students to enroll in college courses and offers, for example, intensive summer training for high schoolers in the performing arts and a pre-college workshop in architecture and design to prepare students for the rigors of architecture school in college (“The Experiences in Architecture program at The Catholic University of America” and “The Catholic University High School Drama Institute”).¹⁰

Bard High School Early College Baltimore is a four-year high school that allows students to take two years of tuition free course of study. It is a partnership between Bard College and Baltimore City Public High Schools (graduate with 60 credits and high school degree).¹¹

Cooper Union offers a summer writing program to prepare students for college.¹²

Harvard offers “Harvard Summer Programs for High School Students,” a seven week secondary school summer program for college credit, where the secondary student takes one or two college level classes either online, commuting to Harvard, or on campus (residential).¹³

⁶ February 10, 2022 Office Action, TSDR 12 (gwuohs.com).

⁷ February 10, 2022 Office Action, TSDR 17-19 (salemacademy.com).

⁸ February 10, 2022 Office Action, TSDR 35, (preuss.ucsd.edu).

⁹ February 10, 2022 Office Action, TSDR 45-46 (highschoolnebraska.edu).

¹⁰ May 03, 2022 Office Action, TSDR 6, 12 (catholic.edu/academics/precollege).

¹¹ May 3, 2022 Office Action, TSDR 8-10 (bhsec.bard.edu).

¹² May 3, 2022 Office Action, TSDR 25 (cooper.edu/academics/outreach-and-precollege).

¹³ May 3, 2022 Office Action, TSDR, 18, 20 (summer.harvard.edu).

Brown University offers “Brown Pre-College Programs,” college-level classes during the summer for high school students for periods of one to six weeks.¹⁴

John Hopkins offers summer college level programs for high school students.¹⁵

The Examining Attorney also submitted two articles that discuss “college in high school programs” and “college prep programs.”

A blog post from the website National Society of High School Scholars titled “25 Recognizable College Prep Programs for High School Students” explains that

“College prep programs are opportunities for high school students to take advantage of their summer time off to explore their academic interests Many college prep programs for high school students take place on college campus. ...” Schools listed in this article include Carnegie Mellon, Yale University, University of Pennsylvania, Notre Dame and Ohio State.¹⁶

An article from the website for the College in High School Alliance titled “What are College in High School Programs?” explains partnerships between colleges and high schools that lead to college credit:

College in high school programs, such as dual enrollment, concurrent enrollment, and early college high school, are partnerships between school districts and accredited institutions of higher education that provide high-school age students and intentionally-designed authentic postsecondary experience leading to officially transcribed and transferrable college credit towards a recognized post secondary degree or credential.¹⁷

The Examining Attorney argues that the services are related because they are complementary.¹⁸ 6 TTABVUE 13. Referencing the website evidence, the Examining

¹⁴ May 3, 2022 Office Action, TSDR 31. (precollegebrown.edu).

¹⁵ May 3, 2022 Office Action, TSDR 39. (Jhu.edu/academics/summer-programs).

¹⁶ February 10, 2022 Office Action, TSDR, 49, 50. (nshss.org).

¹⁷ July 5, 2022 Office Action, TSDR 5-6. (collegeinhighschool.org).

¹⁸ The Examining Attorney asks us to consider two non-precedential Board decisions (*In re Walsh Jesuit High School* and *In re Mesa Technical College*) involving likelihood of confusion

Attorney submits that consumers are used to seeing high school educational services that are affiliated with or sponsored by university educational service providers. 6 TTABVUE 13.

Applicant contends that the Examining Attorney has ignored the identification of services in the cited registration in considering relatedness. 4 TTABVUE 15. In particular, Applicant argues that Registrant “itself has no affiliation with a high school, does not offer pre-college or summer programs to high school students, does not offer pre-college courses to high school students and did not include high school educational services in its description of services in registering its mark.” 4 TTABVUE 24. Applicant criticizes the third-party website evidence as not relevant, arguing that there are no competing secondary school services shown on the webpages. 4 TTABVUE 15. Applicant concludes that the Examining Attorney’s sample of 24 named universities represents less than .001% (less than 1/10th of 1%) of the 24,000 plus universities in the United States.¹⁹

We find that the evidence showing that universities such as George Washington University, University of California at San Diego, University of Nebraska, Catholic

between marks applied to high school and college educational services. Although the Examining Attorney may cite to non-precedential cases, the Board does not encourage the practice. *See In re tapio GmbH*, 2020 USPQ2d 1138, at *10 n.30 (TTAB 2020) (“Generally, the practice of citing non-precedential opinions is not encouraged”; Board found unpersuasive non-precedential decisions decided on different records). We observe that our determinations in these non-precedential cases are consistent with our precedential decisions in that none apply a per se rule with regard to the relatedness of the services and that each case is decided on its own facts. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

¹⁹ Applicant’s declarant Michael G. Gallo, Headmaster of Seton Hall Preparatory School (SHP) stated that he reviewed a directory of 24,000 colleges. January 4, 2022 Response to Office Action, TSDR 9, first Gallo declaration paragraph 24.

University, Bard College, and Cooper Union offering either high school curriculum or dual enrollment, or summer college preparatory programs, under the same mark as their university-level educational services is relevant evidence of relatedness. This third-party evidence shows that consumers are exposed to colleges and universities that partner with high schools, have dual enrollment options, offer online high school or in-person charter high school, or offer summer college preparatory type programs for the high school student. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (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 sells both”); *Hewlett-Packard Co.* 62 USPQ2d at 1004 (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Applicant also references co-existing third-party registrations for the marks: Princeton University (college and university level educational services), Princeton Preparatory School (preschool, lower school, upper school, college study, graduate school educational services) and Princeton International Preparatory School (kindergarten through 12th grade educational services) in the record as support that Applicant’s and Registrant’s services are unrelated.²⁰

²⁰ June 17, 2022 Response to Office Action, TSDR 22-27.

However, we can draw no conclusions from these third-party Princeton-formative registrations for educational services that co-exist on the register.²¹ There is nothing in the record beyond the TESS printouts to indicate the circumstances surrounding registration of these three marks, and we will not speculate on the circumstances existing at the time these Princeton-formative marks registered. We hasten to add, however, that even were we to consider the co-existence of this group of third-party educational services marks, it is hardly sufficient to establish that Applicant's and Registrant's services are unrelated.

Therefore, we find Applicant's and Registrant's services are related.

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

B. Similarity or Dissimilarity of the Channels of Trade

The third *DuPont* factor considers the "established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. In connection with this factor, we again focus on the identifications of services in the application and cited registration. *See Octocom Sys.*, 16 USPQ2d at 1787.

The classes of consumers for Applicant's and Registrant's services are students and their parents or guardians, and prospective students, future students, and their parents or guardians. Although Applicant's services are geared to high school college preparatory education, and Registrant's services are geared to college education, obviously Applicant's customers are preparing to become Registrant's customers. *See*

²¹ Two of the registrations are owned by the same individual.

e.g., DeVivo v. Ortiz, 2020 USPQ2d 10153, at *14 (TTAB 2020) (finding overlapping consumers of applicant’s and opposer’s services that were marketed to girls and young women in elementary, middle and high school who seek careers and information about STEM and STEM professions, and their parents and mentors).

As to the channels of trade, the Examining Attorney argues that the services are provided under the same trade channels as shown by the internet evidence provided from the Office Actions. 6 TTABVUE 11.

The webpage evidence shows that universities providing a high school curriculum offer it online or in person and that dual enrollment and college courses offered to high school students are offered in person or online. We find that the trade channels overlap to the extent that the services are promoted and delivered in the same way, in person and online.

We find the classes of consumers are the same and the trade channels may overlap.

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

C. Conditions of Sale

We turn next to the fourth *DuPont* factor which considers the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs careful, sophisticated purchasing.”²² Purchaser sophistication or degree of care may tend to minimize

²² Although Applicant and the Examining Attorney did not address this *DuPont* factor in their briefs, there is evidence in the record relating to purchasing conditions of Applicant’s private Catholic high school preparatory services. *DuPont*, 177 USPQ 563 (likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors).

likelihood of confusion. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Id.* Precedent requires that we base our decision on the least sophisticated potential purchasers. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014).

Applicant's declarant, Michael G. Gallo, Headmaster of Seton Hall Preparatory School (SHP) indicated that the SHP website is viewed thousands of times each year by prospective students and their parents.²³ SHP sends applications and related materials bearing its SETON HALL PREP mark to approximately 2,000 prospective students and their parents throughout the United States.²⁴ SHP annually receives 550 applications from students seeking admission from multiple states and countries.²⁵

Mr. Gallo explains that prospective students and their parents view and study the SHP website, application forms, and other materials, and that Catholic, elementary, and middle school teachers and counselors may advise students who may desire to

²³ January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration paragraph 43; January 4, 2022 Response to Office Action, TSDR 12-13, second Gallo declaration, paragraph 5; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration, paragraph 16.

²⁴ January 4, 2022 Response to Office Action, TSDR 10-11, first Gallo declaration paragraph 43; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration, paragraph 16.

²⁵ January 4, 2022 Response to Office Action, TSDR 10-11, first Gallo declaration paragraphs, 43-44; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration, paragraph 16.

attend SHP.²⁶ Therefore, it is apparent that Applicant's services involve careful purchasing decisions.

Similarly, Registrant's undergraduate, graduate and post-graduate educational services from a private university involve a degree of purchaser care due to their expense.

We find the fourth *DuPont* factor weighs against a finding of likelihood of confusion.

D. Strength of the Cited Mark

We next consider the strength of the cited mark. *DuPont*, 177 USPQ at 567. "A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)." *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). *See also In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *3 (TTAB 2020) ("[A]n analysis of the similarity between marks may include an analysis of the conceptual strength or weakness of the component terms and of the cited mark as a whole."); *New Era Cap. Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020) ("In determining the strength of the cited mark, we consider its inherent strength, based on the nature of the mark itself.").

"In order to determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words." *In re Davia*, 110 USPQ2d 1810, 1814

²⁶ January 4, 2022 Response to Office Action, TSDR 12-13, second Gallo declaration, paragraph 5.

(TTAB 2014). *See generally, Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (word marks registered without a claim of acquired distinctiveness that are arbitrary, fanciful or suggestive are “held to be inherently distinctive.”); *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992)).

The cited mark SETON HALL UNIVERSITY is registered on the Principal Register without a claim of acquired distinctiveness, and therefore is considered as a whole inherently distinctive, although the mark includes a disclaimer of the term UNIVERSITY. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9-10 (TTAB 2020) (SOCK IT TO ME for socks “taken as a whole, is inherently distinctive, although its strength is somewhat limited by its first word, SOCK, which is generic for socks.”). *See also New Era Cap Co.*, 2020 USPQ2d 10596, at *10 (a standard character Principal Register mark without a claim of acquired distinctiveness is inherently distinctive). Nonetheless, we may consider whether an inherently distinctive mark is “weak as a source indicator” in the course of a *DuPont* analysis.²⁷ *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016).

²⁷ “Because this is an ex parte proceeding, we would not expect the examining attorney to submit evidence of fame [or commercial strength] of the cited mark.” *See In re Thomas*, 79 USPQ2d 1021, 1027, n. 11 (TTAB 2006). We do note however, that Mr. Gallo’s declaration includes statements that Registrant is widely known throughout the Northeastern United States for its quality university education in a Catholic-based institution setting, and that its basketball team’s “victories and losses” has received much media attention (on television, radio, newspapers, magazines, and other sports media) since 1989, with reference to Registrant as SETON HALL. January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration, paragraph 37; April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration paragraph 13.

Applicant argues that SETON is conceptually weak. 4 TTABVUE 12. In support of its contention, Applicant provided for the record one registration²⁸ for SETON HILL UNIVERSITY for services that include educational services for the undergraduate, graduate and post-graduate level.²⁹ However, one registration for a similar but not identical mark is not sufficient for us to make an inference that similar marks can register side by side without confusion. *In re Johns-Manville Corp.*, 180 USPQ 661, 662 (TTAB 1973) (one existing third-party registration is insufficient “to justify the registration sought by applicant”). *Cf. Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 779 (TTAB 1979) (eight co-existing registrations sufficient to make inference that registrant’s PLUS marks for similar goods can coexist provided there are differences in the marks).

Applicant also submitted third-party registration pairs for the marks: M University of Michigan and Michigan State University to show that the Office has

²⁸ Applicant submitted during examination a list of third-party registrations that contain the word SETON. June 27, 2022 Response to Office Action at TSDR 28-30. During examination, the Examining Attorney objected to the list, advising Applicant that the list did not make the third-party registrations of record, and indicating the registrations would not be considered. July 5, 2022 Office Action at TSDR 1. Applicant argues on appeal that the Examining Attorney was on notice of these registrations through its search for conflicting marks under Trademark Rule 2.61(a), 37 C.F.R. § 2.61(a), and had an obligation to weigh the weakness of the marks in its initial screening search before making the refusal. 4 TTABVUE 12. However, regardless of whether the registrations were considered as part of a search of Office records, and we have no indication whether or not they were, they have not been made of record in this case. Absent any third-party registration evidence in the record, we cannot evaluate whether the register reflects weakness of the term SETON based on this list of registrations, properly objected to by the Examining Attorney during examination and as addressed in the objections above.

²⁹ June 17, 2022 Response to Office Action, TSDR 20-21. As to the co-existence of SETON HILL UNIVERSITY with the SETON HALL UNIVERSITY registration, we are not privy to the registration record for this file. There might be a reason that these marks coexist on the register, but that reason is not readily apparent from the face of the registration.

registered similar marks for college level and university level educational services.³⁰ However, the Board has found this type of evidence not probative for dissimilar marks, and the nature of these marks differs from the ones at issue in this case regardless. *See In re Embiid*, 2021 USPQ2d 577, at *35-38 (TTAB 2021) (third-party registrations used to show current peaceful coexistence of registrations for identical or substantially similar marks by separate entities for shoes and clothing for “paired” COBRA and SOLE marks were so different from the involved marks TRUST THE PROCESS that Board found the evidence has no probative value).

In addition, Applicant references the declarations of Mr. Gallo as support for its argument that SETON is weak.

Mr. Gallo states that the Seton Hall marks were created to honor the contributions and “historical significance” of the actions of Elizabeth Ann Seton for commencing Catholic parochial education in the United States and founding the Sisters of Charity order.³¹ Mr. Gallo further indicates that Elizabeth Ann Seton is notable for starting Catholic parochial schools in the United States, being the first American canonized by the Catholic Church as St. Seton, and being inducted into the National Women’s Hall of Fame.³²

³⁰ June 17, 2022 Response to Office Action, TSDR 16-19.

³¹ January 4, 2022 Response to Office Action, TSDR 8-9, first Gallo declaration paragraph 16, 23, 25; April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration, paragraph 7.

³² January 4, 2022 Response to Office Action, TSDR 6, 7, first Gallo declaration, paragraphs 4, 7, 8, 10, 11.

We find that SETON in Registrant's mark, as used in connection with educational services, is suggestive as it evokes a memory and/or connection with Elizabeth Ann Seton, or St. Seton, the founder of Catholic parochial schools and the Sisters of Charity order. *See e.g., Franklin Resources, Inc. v. Franklin Credit Mgmt., Corp.*, 988 F. Supp. 322, 45 USPQ2d 1872, 1876 (SDNY 1997) (finding "Franklin" in the mark Franklin Resources used to evoke a memory and example of Benjamin Franklin, the founding father and tireless advocate of thrift and sound financial planning).

As to the term HALL, the Examining Attorney submitted a dictionary definition for HALL that defines the term as "a building used by a college or university for some special purpose;" "a college or a division of a college at some universities."³³ We find that HALL is suggestive of Registrant's university services.

Finally, as to the combined terms SETON HALL, we find it suggestive of a Catholic university named after St. Seton, a significant figure to Catholic education and Catholic charity.

Applicant also argues that there is widespread use of the term SETON, in honor of Saint Seton, as a common law mark by churches, hospitals and high schools, again relying on the declarations of Mr. Gallo who indicates there is common use of Elizabeth Ann Seton's "name by numerous Catholic Institutions ... to honor and recognize her contributions."³⁴ 4 TTABVUE 11.

³³ July 20, 2021 Office Action, TSDR 22, Merriam-Webster Dictionary (merriam-webster.com).

³⁴ January 4, 2022 Response to Office Action, TSDR 7, first Gallo Declaration paragraph 11.

Evidence and testimony of third-party use of similar marks or portions of marks for the same or similar services are relevant to a mark's commercial strength or weakness. See *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (“third-party use bears on strength or weakness” of mark) (citation omitted); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (considering third-party use evidence and uncontradicted testimony probative of the fact that “a considerable number of third parties use similar marks”); *Palm Bay Imps.* 73 USPQ2d at 1691 (“the purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different such marks on the bases of minute distinctions.’”) (citation omitted). See e.g., *In re Charger Ventures LLC*, 2023 USPQ2d 451, at *6 (twenty-four third-party uses of SPARK-formative marks relevant to weakness); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *17 (TTAB 2020) (six local Brooklyn-formative named establishments’ use of the term “Brooklyn” in connection with beer sales have significant probative value as to commercial weakness), dismissed in part, *aff’d* in part, vacated in part, and remanded, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1674 (TTAB 2018) (ten uses relevant to whether SMOKIN HOT portion of mark is weak).

In particular, Mr. Gallo declares that “[t]here are numerous Catholic churches, high schools, universities and hospitals named after Saint Seton, including Elizabeth

Seton High school (Bladensburg, MD), Seton Academy, South Holland, IL (1963-2016), Seton Catholic High School, Pittson, PA (1906-2007), Seton School (Manassas, VA), Seton Catholic High School (Hudson, OH), Bayley Seton Hospital (Staten Island, NY), Seton Family of Hospitals, and Elizabeth Ann Seton Specialty Care Hospital. There are churches in Saint Seton's name in over 40 states"³⁵

As indicated, Mr. Gallo's declaration identifies six uses of SETON for high school names,³⁶ although three of the high schools appear to no longer be in existence by the dates provided in Mr. Gallo's declaration. While this evidence has some probative value, it is a more modest showing than found probative in other cases. *See e.g., In re Charger Ventures LLC*, 2023 USPQ2d 451, at *6 (twenty-four third-party uses of SPARK-formative marks relevant to weakness).

Mr. Gallo's declaration also identifies use of the term HALL by middle and high schools. He states that "there are private middle and high schools that use HALL in their names" and mentions four schools: Choate Rosemary Hall, Cascia Hall Preparatory School, Chauncy Hall School, and Brandon Hall School.³⁷ On the other

³⁵ January 4, 2022 Response to Office Action, TSDR 7, first Gallo declaration, paragraphs 9, 11.

³⁶ Applicant has not demonstrated why use of the term in connection with churches and hospitals should bear on strength in connection with educational services. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) ("[T]he controlling inquiry [under the sixth *DuPont* factor] is the extent of third-party marks in use on "similar" goods or services.").

³⁷ January 4, 2022 Response to Office Action, TSDR 9, first Gallo declaration, paragraphs 26-32. Mr. Gallo also referenced registrations owned by these high schools. However, we do not consider the registrations to be made of record by this testimony, as no copies of the registrations were submitted as exhibits with Mr. Gallo's declaration and mention of these registrations is subject to the Examining Attorney's objection which was sustained. Therefore, we only consider Mr. Gallo's testimony as to the marks being in use.

hand, Mr. Gallo states that in searching a directory of 24,000 colleges and universities, apart from Seton Hall University, there are no other colleges or universities using HALL in their name.³⁸ The testimony relating to use of HALL by educational institutions has some probative value, but again, it is a more modest showing than found probative in other cases.

In sum, we find SETON HALL suggestive, but not highly suggestive, and accord the mark the scope of protection due an inherently distinctive mark. *Compare In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“[T]he fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.”); *Husky Oil Co. of Del. v. Huskie Freightways, Inc.*, 176 USPQ 351, 352 (TTAB 1972) (“While ‘HUSKY’ might be somewhat suggestive of strength, this factor does not necessarily make it a ‘weak’ mark entitled to a limited scope of protection.”) *with Drackett Co. v. H. Kohnstamm & Co.*, 160 USPQ 407, 408 (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods”); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (“the scope of protection for a suggestive or nonarbitrary term is less than that of a coined or arbitrary mark”); *In re Cardinal Prods. Co.*, 172 USPQ 188, 188 (TTAB 1971) (CENTRAL AIR, as applied to central air conditioning systems, is a highly suggestive term entitled to a limited scope of protection; the term CENT in applicant’s mark is an abbreviation of “centrifugal”

³⁸ January 4, 2022 Response to Office Action, TSDR 9, first Gallo declaration paragraph 24.

which is understood in the trade to suggest the centrifugal blowers which applicant employs).

E. Similarity or Dissimilarity of the Marks

We turn now to the first *DuPont* factor, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1692. Our analysis of Applicant's mark and the cited mark cannot be predicated on dissecting the marks into their various components; the decision must be based on 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). Although the marks at issue must be considered in their entireties, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *Id.*

Applicant's mark and the cited mark are in standard characters which means that the marks can be depicted in any font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). For that reason, we must assume that the marks could be displayed in a stylization identical or similar to each other. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[T]he rights associated with a standard character

mark reside in the wording per se and not in any particular font style, size, or color.”) (citation omitted).

Applicant’s mark is SETON HALL PREP (“prep” disclaimed) and the cited mark is SETON HALL UNIVERSITY (“university” disclaimed).

The marks share the wording SETON HALL. The disclaimed generic or highly descriptive wording PREP and UNIVERSITY in each mark is less significant in relation to the shared wording SETON HALL. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Therefore, we find the shared distinctive wording SETON HALL is the dominant portion of both marks and “is most likely to be impressed upon the mind of a purchaser and remembered” as the first terms in the marks. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imps.*, 73 USPQ2d at 1692.

Applicant’s mark and Registrant’s marks are overall similar in appearance and sound due to the shared term SETON HALL, which is distinctive and source identifying, despite some difference in sound and appearance due to the additional disclaimed terms PREP and UNIVERSITY, respectively, in each mark.

The connotation and commercial impressions of the marks are similar overall because of SETON HALL, but have somewhat different nuances due to the addition of the disclaimed terms UNIVERSITY and PREP to each mark. As indicated, SETON in both marks suggests an association with the historical figure Elizabeth Ann Seton or the Catholic saint, St. Seton. HALL is defined as a special purpose building used by a college or university or a college or a division of a college at some universities and

also is used by middle or high schools in their names to reference a special purpose building or school. Registrant's mark suggests a Catholic university named after St. Seton, while Applicant's mark suggests a Catholic college preparatory school named after St. Seton.

Although Applicant argues that PREP and UNIVERSITY are distinguishing elements of Applicant's and Registrant's marks, 4 TTABVUE 13, 25, such generic or highly descriptive disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001)." Therefore, the slight differences between the marks resulting from the additional disclaimed terms do little to distinguish the marks. *See In re Charger Ventures LLC*, 2023 USPQ2d 451, at *5 ("So, while the Board must consider the disclaimed term, an additional word or component may technically differentiate a mark but do little to alleviate confusion.").

"[W]e also keep in mind the penchant of consumers to shorten marks." *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1961 (TTAB 2016). There is evidence in the record that both Registrant and Applicant are referred to as SETON HALL in connection with sports teams and sports competitions, and Registrant has referred to itself as Seton Hall in connection with an article about the "Fifth Annual Giving Day."³⁹ Applicant's declarant Mr. Gallo acknowledges that media and sports broadcasters refer to Registrant as Seton Hall, especially in connection with

³⁹ May 3, 2022 Office Action, TSDR 52-56, 58-61, 68-74, 75-76.

basketball events.⁴⁰ Mr. Gallo also states that Applicant is referred to as SETON HALL in “written accounts of its educational events” in the Star Ledger, New Jersey’s largest newspaper with statewide distribution.⁴¹

Therefore, when viewed in their entirety, we find the marks overall more similar than dissimilar.

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

F. Lack of Actual Confusion⁴²

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of Applicant’s and Registrant’s subject marks. *DuPont*, 177 USPQ at 567. The seventh and eighth *DuPont* factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth factor, that there has been a significant opportunity for actual confusion to have occurred. *See In re Cont’l Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB

⁴⁰ January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration, paragraph 36-37.

⁴¹ January 4, 2022, Response to Office Action, TSDR 10, first Gallo declaration, paragraph 38.

⁴² The Examining Attorney “acknowledges applicant’s attempt to introduce the five additional *DuPont* factors” (seventh, eight, tenth, twelfth and thirteenth) into the analysis but argues “these factors are irrelevant to the instant ex parte likelihood of confusion analysis.” 6 TTABVue 23. However, this is an incorrect statement of law because we must consider those *DuPont* factors for which there is evidence or argument. *In re Guild Mortg. Co.*, 129 USPQ2d at 1163.

1992). Under the eighth *DuPont* factor, we “look at actual market conditions, to the extent there is evidence of such conditions of record.” *See In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *6.

We take judicial notice that South Orange, New Jersey township is in Essex County, northeastern New Jersey, U.S. and immediately west of Newark, New Jersey and that West Orange, New Jersey township is in Essex County, northeastern New Jersey, U.S., and about 4 miles northwest of Newark, New Jersey.⁴³

The Examining Attorney submits that the seventh and eighth factors weigh in favor of likelihood of confusion. The Examining Attorney points out that both Applicant and Registrant are located in New Jersey, with Applicant located in West Orange, New Jersey and Registrant located in South Orange, New Jersey. 6 TTABVUE 21. The Examining Attorney points to information in the record of Applicant’s and Registrant’s earlier history of sharing facilities and the same campus before Applicant moved to West Orange, New Jersey. 6 TTABVUE 21. The Examining Attorney submits that Applicant did not provide evidence of “market conditions” but argues that overlapping geographic use makes confusion likely, 6 TTABVUE 21.

Applicant contends that no likelihood of confusion would be found under the eighth *DuPont* factor and asserts that the Examining Attorney did not properly consider this factor and the “relevant factual evidence in Mr. Gallo’s Affidavits

⁴³ The Board can take judicial notice of information in encyclopedias. *See B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (the Board takes judicial notice of information in encyclopedias). Encyclopedia Britannica, www.britannica.com/place/South-Orange-Village; www.britannica.com/place/West-Orange (both accessed May 16, 2023).

showing SHP's long period of concurrent use without any evidence of actual confusion." 4 TTABVUE 18.

The Examining Attorney counters that "Mr. Gallo's uncorroborated statements are of little evidentiary value in this ex parte examination." 6 TTABVUE 16.

However, despite the Examining Attorney's position on the submitted declarations, consistent with longstanding practice, we accord Mr. Gallo's declarations such probative value as they may have, and weigh them with the totality of the evidence. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018) (considering declarations about lack of awareness of any actual confusion for whatever "probative value as they may have").

According to Mr. Gallo, SHP is the oldest preparatory school in New Jersey.⁴⁴ In 1856, Seton Hall College (now Seton Hall University (SHU)) was created as a combined Catholic preparatory school, college and seminary.⁴⁵ At the time of founding of Seton Hall College in 1856, the high school students in the preparatory school and the college students were commingled, sharing curriculum and faculty.⁴⁶ In 1870 the preparatory school curriculum became separate from the college curriculum, and in 1889 SHP was "organized as a distinct educational institution."⁴⁷ SHU and SHP

⁴⁴ January 4, 2022 Response to Office Action, TSDR 6, first Gallo declaration paragraph 3; April 8, 2022 Response to Office action, third Gallo declaration paragraph 3.

⁴⁵ July 20, 2021 Office Action, TSDR 4, Seton Hall Preparatory School website (shp.org).

⁴⁶ January 4, 2022 Response to Office Action, TSDR 7, first Gallo declaration paragraph 13; April 8, 2022 Response to Office Action, TSDR 18-19, third Gallo declaration, paragraph 6.

⁴⁷ January 4, 2022 Response to Office Action, TSDR 7, first Gallo declaration paragraph 13; April 8, 2022 Response to Office Action, TSDR 18-19, third Gallo declaration, paragraph 6.

shared campus facilities in South Orange, New Jersey until the 1920's and SHP spent 125 years on SHU's South Orange campus.⁴⁸ In 1985, SHP moved its campus facilities to West Orange, New Jersey, and in 1986, SHP formally ended its association with SHU and became separately incorporated.⁴⁹

Mr. Gallo indicates that both SHP and SHU are widely known throughout the Northeastern United States for quality educational experiences in a Catholic-based institution setting.⁵⁰ He indicates that SHP and SHU conduct their educational activities independently of the other, with no related educational activities while concurrently using their respective marks.⁵¹ Mr. Gallo declares that both SHP and SHU have used SETON HALL concurrently and continuously since 1889, or for 130 years, "with no actual confusion by prospective student applicants or their parents, applicants or their parents, enrolled students or their parents, outside faculty and researchers, or others seeking to engage either with SHP or SHU."⁵² Mr. Gallo

⁴⁸ July 20, 2021 Office action, TSDR 4, Seton Hall Preparatory School website (shp.org), TSDR 4; January 4, 2022 Response to Office Action, TSDR 7, first Gallo declaration paragraph 13; April 8, 2022 Response to Office Action, TSDR 18-19, third Gallo declaration paragraph 6.

⁴⁹ January 4, 2022 Response to Office Action, TSDR 7, first Gallo declaration, paragraph 13; April 8, 2022 Response to Office Action, TSDR 18-19, third Gallo declaration paragraph 6.

⁵⁰ January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration paragraph 43; April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration paragraph 12; April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration paragraph 13.

⁵¹ April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration, paragraph 14.

⁵² April 8, 2022 Response to Office Action, TSDR 19, third Gallo declaration paragraph 10-11.

indicates that administrative staff and others with a long history at SHP also cannot recall any instances of actual confusion.⁵³

According to Mr. Gallo, SHP has conducted extensive outreach and communication efforts over decades (for over 100 years), with communications prominently displaying the SETON HALL PREP mark.⁵⁴ These regular communications are sent to prospective students, and their parents, enrolled students and their parents, and alumni and others interested in SHP's educational and athletic activities, artistic performances, scholarly conferences, and other educational activities.⁵⁵ Materials with the SETON HALL PREP mark include SHP's "website, application forms, graduation invitations and materials, other invitations and notices, and correspondence."⁵⁶ Applicant's website is viewed, according to Mr. Gallo, "thousands of times per year by an untold number of prospective student applicants and their parents, as well as by enrolled students, and their parents, SHP alumni, and others."⁵⁷ Applicant annually sends applications and related materials bearing the SETON HALL PREP mark to 2,000 prospective students and their parents in the United States and internationally and receives 550 applications for

⁵³ April 8, 2022 Response to Office Action, TSDR 21, third Gallo declaration, paragraph 21.

⁵⁴ April 8, 2022 Response to Office Action, TSDR 21, third Gallo declaration, paragraph 21.

⁵⁵ January 4, 2022 Response to Office Action, TSDR 12, second Gallo declaration paragraph 4, April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration paragraph 15.

⁵⁶ January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration paragraph 43; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration paragraph 16.

⁵⁷ April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration, paragraph 16; January 4, 2022 Response to Office Action, TSDR 10, first Gallo declaration, paragraph 43.

admission from prospective students annually.⁵⁸ Mr. Gallo indicates that prospective students and parents who seek to apply for admission, enrolled students and parents, university admission offices who receive applications from SHP graduates, other schools and athletes who participate in athletic contests with SHP and its athletes, Catholic elementary and middle school teachers advising students who may desire to attend SHP, and others inside and outside the Catholic community, all have exposure to the SETON HALL PREP mark.⁵⁹

The Examining Attorney counters that there is evidence in the record of actual confusion. The Examining Attorney references the submitted Google search results which display a “People Also Ask” feature, indicating that one question asked by people searching “Seton Hall Prep Seton Hall University” is whether Seton Hall Preparatory School is associated with Seton Hall University.⁶⁰ The Examining Attorney submits this evidence is supportive of actual confusion. 6 TTABVUE 17.

However, we do not find this evidence probative of actual confusion, as this “People Also Ask” feature is based on an undisclosed algorithm, other metrics, and data, also resulting from a combined search of “Seton Hall Prep Seton Hall University,” rather than “Seton Hall Prep” alone.⁶¹ Also, inquiries as to whether

⁵⁸ January 4, 2022, TSDR 10-11, first Gallo declaration paragraph 43; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration paragraph 16.

⁵⁹ January 4, 2022 Response to Office Action, TSDR 12-13, second Gallo declaration paragraph 5; April 8, 2022 Response to Office Action, TSDR 20, third Gallo declaration, paragraph 19.

⁶⁰ This search yielded only one entry referencing Seton Hall University on the third page of the search result. July 5, 2022 Office Action, TSDR 2, 14.

⁶¹ We note that “related search” feature topics generated by Google’s algorithm, metrics, and other data, all relate to Seton Hall Preparatory School: “Seton Hall Prep Tuition” “Seton Hall

Applicant and Registrant are related “do not demonstrate confusion; rather they demonstrate that the individuals understand that the companies may be different entities.” *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *25; see also *Mini-Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1475 (TTAB 2016); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1479 (TTAB 2014) (inquiry is not evidence of confusion because the inquiry indicates that the prospective customer had a reason to suspect that there were two different companies).

The Examining Attorney also points to a submitted corrected New York Times article discussing the dominance of private high school football teams, where the writer attributed the wrong location in New Jersey to Seton Hall Preparatory School as supportive of actual confusion.⁶² However, this article does not show confusion as to source but as to location.

For the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred). Thus, if there was appreciable and continuous use by an applicant of its mark for a significant period of time in the same markets as those

Prep acceptance rate” “Seton Hall Prep basketball,” “Seton Hall Prep Athletics,” “Seton Hall Prep Uniform,” “Seton Hall Prep Campus,” “Seton Hall Prep Sister School,” and “Seton Hall Prep Soccer.” July 5, 2022 Office Action, TSDR 2.

⁶² July 5, 2022 Office Action, TSDR 2.

served by a registrant, absence of any reported instances of confusion is probative. *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).

Although “[t]he lack of evidence of actual confusion carries little weight, especially in an ex parte context,” *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003), the Board has found in an ex parte context, “that there may be an exception to this general rule where there is shown to be a “confluence of facts” which together strongly suggest, under the eighth *du Pont* factor, that the absence of evidence of actual confusion is meaningful and should be given probative weight in an ex parte case.” *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1273 (TTAB 2007). In particular, concurrent use of the marks in the same geographic area for a significant period may “suffice[] to establish, under the eighth *du Pont* factor, that the absence of evidence under the seventh *du Pont* factor is legally significant and entitled to some weight in our likelihood of confusion analysis in this ex parte case.” *Id.* at 1273-74. (50 years of concurrent use in the same geographic area; Board found seventh and eighth *DuPont* factors weigh against likelihood of confusion).

We find that to be the case here. Mr. Gallo’s declaration testimony is particularly detailed and credible and provides meaningful information to show the existence of the requisite “confluence of facts” under the eighth *DuPont* factor. Therefore, given the long period of concurrent use in the same geographic area, Essex County, near Newark, New Jersey, for over one hundred years, (and even on the same campus for many years), the absence of confusion is significant and meaningful. *See In re Ass’n*

of the U.S. Army, 85 USPQ2d at 1274 (finding evidence (including the declaration evidence) showing that applicant has co-existed with and interacted with registrant for over fifty years without any apparent actual confusion in the same geographic area “suffices to establish, under the eighth *du Pont* factor, that the absence of evidence under the seventh *du Pont* factor is legally significant and entitled to some weight”).

We find the seventh and eighth *DuPont* factors weigh against confusion.

G. Market Interface

The tenth *DuPont* factor considers “[t]he market interface between applicant and the owner of a prior mark.” *DuPont*, 177 USPQ at 567. Such market interfaces include “(d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.” *Id.*

Applicant argues that evidence of laches or estoppel exists in this case, and that this evidence weighs in Applicant’s favor in the likelihood of confusion analysis. 4 TTABVUE 19.

Although the equitable defenses of laches and estoppel are not applicable in ex parte proceedings, *In re Opus One Inc.*, 60 USPQ2d 1812, 1821 (TTAB 2001), this type of evidence may also be entitled to some probative value in Applicant’s ex parte appeal, at least to the extent that it “is indicative of a lack of confusion.” *Id.*

In this case, Registrant and Applicant were created in 1856 as a combined Catholic preparatory school, college, and seminary, sharing campus facilities until 1985, when Applicant moved to a separate campus and formally ended its association

by separate incorporation in 1986. Thus, we presume Registrant is well aware of Applicant's use.

However, we cannot conclude that Registrant's actions and/or inaction with respect to Applicant's use of the SETON HALL PREP mark, as detailed by Applicant's declarant Mr. Gallo, are necessarily attributable to, and necessarily evidence of, a business-driven belief on the part of Registrant that there is no likelihood of confusion. Applicant has not come forward with a consent agreement with Registrant, which, in appropriate circumstances, can be compelling evidence under this *DuPont* factor.

Therefore, even if Registrant has to date voiced no objection to Applicant's use of SETON HALL PREP,

we will not assume, on this record, that registrant has no objection to the issuance of a federal registration to applicant. If registrant in fact has no such objection, there is available to applicant in a future application a type of evidence which, under *du Pont* and subsequent case law, is entitled to great weight in the likelihood of confusion analysis, i.e., a valid consent agreement between applicant and registrant. The evidence of record applicant relies on in the present case simply does not suffice as a substitute for such an agreement. We have given that evidence due consideration, but conclude that the tenth *du Pont* evidentiary factor, i.e., the "market interface" between applicant and registrant, does not weigh in applicant's favor to any significant degree in this case.

In re Opus One Inc., 60 USPQ2d at 1822.

We find the tenth *DuPont* factor neutral.

H. Extent of Potential Confusion

The twelfth *DuPont* factor considers “the extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567.

Applicant argues that there is a de minimis chance of potential confusion “because the educational services of SHU and SHP are mutually exclusive,” the declaration of Mr. Gallo indicates no confusion has occurred, and the Examining Attorney relies on “unsupported assumption of some ‘consumer connection.’” 4 TTABVUE 20.

We find these arguments are simply additional arguments that are properly made under the second, seventh and eighth *DuPont* factors. Therefore, we find this *DuPont* factor neutral.

I. Any other Established Fact Probative of the Effect of Use

The thirteenth *DuPont* factor, examines “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. Rarely invoked, the thirteenth *DuPont* factor is intended to accommodate “the need for flexibility in assessing each unique set of facts.” *In re Strategic Partners*, 102 USPQ2d 1397, 1399 (TTAB 2012), *aff’d* mem., (Fed. Cir. Sept. 13, 2019).

In this case, the unique set of facts is connected to the seventh, eighth and tenth *DuPont* factors which we have already addressed. *See Harry Winston, Inc. and Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1440 n.120 (TTAB 2014) (“Although connected to the fifth *du Pont* factor of fame, we analyze the effect of the family relationship between the parties’ founders under the rubric of the 13th *du Pont* factor, “any other established fact probative of the effect of use.”).

Those relevant facts are:

- the circumstances under which Applicant and Registrant were initially founded;
- Applicant's earlier use date of Seton Hall Prep in 1925 compared to Seton Hall University's first use date in 1951;
- the sharing of campus facilities until 1985 by Applicant and Registrant, although distinct institutions;
- Applicant's and Registrant's shared association until 1986 when Applicant formally incorporated;
- the continued co-existence and use of the SETON HALL PREP and SETON HALL UNIVERSITY marks for over 130 years.

While it is apparent that Registrant is well aware of Applicant's use, we cannot conclude on this record that Registrant has no objection to the issuance of a federal registration to Applicant, absent a valid consent agreement between Applicant and Registrant. *See In re Ass'n of the U.S. Army*, 85 USPQ2d at 1274. Therefore, we find this *DuPont* factor neutral. *See In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (co-existence of earlier registration which could still be subject to cancellation a relevant consideration, but does not outweigh other *DuPont* factors).

III. Conclusion

The similarity of Applicant's mark to the cited mark, which is entitled to the ordinary scope of protection due an inherently distinctive mark, the relatedness of the services, and the overlapping channels of trade weigh in favor of finding a likelihood of confusion, while the fourth *DuPont* factor and the seventh and eighth

DuPont factors weigh against likelihood of confusion. The tenth, twelfth and thirteen *DuPont* factors are neutral.

Although we find the fourth, seventh and eighth *DuPont* factors weigh somewhat against likelihood of confusion, we find these factors are outweighed by the first, second and third *DuPont* factors. *See e.g., In re Info. Builders, Inc.*, 2020 USPQ2d 10444, *10 (TTAB 2020) (while goods are purchased by information technology professionals, “any weight this adds to a finding of no confusion is outweighed by the similarity of the marks, the legally identical in part goods and services, and the other factors discussed”); *In re Ass’n of the U.S. Army*, 85 USPQ2d at 1274-75 (seventh and eighth *DuPont* factors outweighed by first, second, third and fourth *DuPont* factors). Despite care in purchasing and the lack of evidence of actual confusion in this *ex parte* case, consumers who are accustomed to encountering university and high school educational services under the same marks are likely to be confused as to the source or sponsorship of services under SETON HALL UNIVERSITY and SETON HALL PREP.

We find, upon balancing the *DuPont* factors, that a likelihood of confusion exists between Applicant’s mark as applied to its services and Registrant’s mark as applied to its services. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against Applicant. *See In re Shell Oil Co.*, 26 USPQ2d at 1691; *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register Applicant’s mark SETON HALL PREP is affirmed.