

This Opinion is Not a
Precedent of the TTAB

Mailed: June 29, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Samjen of Tampa, Inc.

Serial No. 90501168
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Eric M. Pelton and Olivia M. Muller of Eric M. Pelton & Associates, PLLC,
for Samjen of Tampa, Inc.

Andrew Janson, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

—
Before Taylor, English and Lebow,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Samjen of Tampa, Inc. (“Applicant”) seeks registration on the Principal Register of the standard-character mark BLACK BELT for the following services in International Class 37:

advisory services relating to building construction; advisory services relating to the construction of buildings; advisory services relating to the maintenance of buildings; building construction; building construction and repair; building construction information; building construction services; building construction supervision; building construction, remodeling and repair; commercial building construction; construction consultancy; construction consultation; construction management; construction planning; construction project management services; construction services, namely, planning, laying out and construction of residential and commercial communities; construction services, namely,

planning, laying out and construction of a planned residential community; construction services, namely, planning, laying out and custom construction of commercial buildings; construction supervision; construction and renovation of buildings; construction and repair of buildings; construction of buildings; construction, maintenance and renovation of real property; consultancy relating to residential and building construction; consulting in the field of building construction; custom building construction; custom construction of homes; general construction contracting; housing services, namely, development of real property, namely, repair, improvement, and new construction; housing services, namely, repair, improvement, and construction of residential real property; land development services, namely, planning and laying out of commercial buildings; real estate development and construction of commercial, residential and hotel property; residential building construction; residential and building construction consulting; residential and commercial building construction.¹

The Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard-character mark BLACKBELT registered on the Principal Register for the following services in International Class 36:

advice relating to investments; financial advice; financial advice and consultancy services; financial and investment services, namely, asset and investment acquisition, consultation, advisory and development; financial and investment services, namely, management and brokerage

¹ Application Serial No. 90501168; filed on February 1, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of an intent to use the mark in commerce.

Applicant owns two additional pending applications (Serial Nos. 90501147 and 90501155) for the same mark that have been refused under Section 2(d) of the Trademark Act and are pending appeal. After Applicant filed its appeal brief, the Examining Attorney filed a motion to consolidate the three appeals. 10 TTABVUE. On December 20, 2022, the Board granted the motion to consolidate. 11 TTABVUE. Notwithstanding the consolidation order, we issue a separate opinion in each appeal because the cited marks and evidence in the appeals are different and there are some significant differences in the arguments at issue in each case.

Citations in this opinion to the briefs, the Examining Attorney's motion, and the consolidation order refer to TTABVUE, the Board's online docket system. Citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents.

in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; financial planning; financial planning and investment advisory services; financial planning consultation; investment banking services; land acquisition, namely, real estate brokerage; real estate brokerage; real estate management consultation; real estate management services.²

When the refusal was made final, Applicant twice requested reconsideration and appealed. The requests for reconsideration were denied and the appeal proceeded. The appeal is fully briefed. For the reasons explained, we affirm the refusal to register.

I. Analysis

“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] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up). Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also Charger Ventures*, 2023 USPQ2d 451, at *4.

We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed.

² Registration No. 4482561; registered February 11, 2014; Section 8 declaration accepted; Section 15 declaration acknowledged.

Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weight, however, may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Moreover, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). We address these two factors and other relevant *DuPont* factors below.

A. Strength of the Cited Mark

We start by considering Applicant's contention that the cited mark is weak, as that will affect the scope of its protection. "In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *21 (TTAB 2022).

1. Commercial Strength

Applicant contends that the cited mark is commercially weak due to "[w]idespread third-party use of the word 'BLACKBELT'" in connection with "real estate, real estate investing, real estate management, and land-related services."³ Under the sixth *DuPont* factor, evidence that the public is confronted with significant use by others of similar marks for similar services tends to indicate a lack of commercial strength. *DuPont*, 177 USPQ at 567; *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015). "The purpose of introducing evidence of third-party use is 'to show that customers have become so conditioned by a plethora of ... similar marks that customers have been educated to distinguish between

³ Appeal Brief, 8 TTABVUE 14.

different [such] marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

Applicant introduced evidence of ten third-parties using marks consisting of or incorporating BLACKBELT as follows:⁴

- BLACK BELT REALTY for real estate brokerage and property management services serving “South Phoenix, Laveen, and Tolleson areas of Phoenix”;
- BLACK BELT BROKER TEAM identifying a real estate brokerage team in Colorado Springs, Colorado with RE/MAX Properties, Inc.;
- BLACKBELT LAND AND REALTY COMPANY INC. selling land in Alabama;
- BLACKBELT CAPITAL identifying a real estate investment firm;
- BLACK BELT CAPITAL for real estate investment services with a portfolio “across the country” as well property renovation, development and management;
- BLACK BELT WEALTH ADVISORY offering financial and insurance planning;
- BLACK BELT INVESTORS identified as “an education, consulting and investment firm specializing in the art of creating cash and wealth through

⁴ August 16, 2022 Second Request for Reconsideration, TSDR 51-88.

buying, selling and investing in real estate”; “provides top rank coaching, seminars and one-on-one training .. educating investors to help them achieve success”;

- BLACK BELT BROKERAGE for educational services in the nature of “a commercial real estate agent development system” for brokerage owners and managers, with a curriculum covering topics such as prospecting, selling, communicating, and brand development; certificates are provided “for each of the belt levels achieved”;
- BLACK BELT PROPERTY PROTECTION providing building security services in the area of Orlando, Florida; and
- STARTUP BLACK BELT a website with “a contributed post” by PropertyGuru titled “The Ins & Outs of Commercial Property Investment”; the website promotes: “Discover How We Help Startups Scale To Their First 100,000 Users with this FREE WHITE PAPER!”

Not all of the third-party marks are pertinent. Even though the last mark is associated with a blogpost related to commercial property investment, it appears that the post is by a third-party and that STARTUP BLACK BELT offers services for scaling startup businesses generally. Two additional marks are for education services for real estate professionals and building security services. We find these three third-party marks “essentially irrelevant” because these services are different from those identified in the cited registration. *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (argument that

mark is weak made “as an abstract proposition, is not only unpersuasive but essentially meaningless”); *see also Omaha Steaks*, 128 USPQ2d at 1694 (“[T]he controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services.”).

While the remaining seven third-party marks are relevant, they are not of a sufficient quantity to show that the term BLACKBELT is commercially weak for Registrant’s services. *See i.am.symbolic*, 123 USPQ2d at 1751 (evidence of third-party use for the same or similar goods fell short of “ubiquitous” or “considerable” use); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (discussing “voluminous evidence” of registration and use of paw print design elements); *Juice Generation*, 115 USPQ2d at 1674 & n.1 (referring to evidence of “a considerable number,” 26 third-party marks); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1674 (TTAB 2018) (finding ten third-party uses “reflects a more modest amount of evidence than that found convincing in *Jack Wolfskin* and *Juice Generation* wherein ‘a considerable number of third parties’ use of similar marks was shown.’ Ultimately, we do not believe the evidence of weakness here is as persuasive as that in either *Jack Wolfskin* or *Juice Generation*.”) (internal citations omitted). In addition, three of the third-parties appear to operate in discrete geographic areas lessening the likelihood that consumers will encounter all three of these marks and learn to distinguish among them by looking to specific differences in the marks. *Anthony’s Pizza & Pasta, Int’l, Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278

(TTAB 2009) (noting 29 third-party uses of the word “Anthony’s’ in whole or in part” for restaurants, but the evidence did not indicate whether the uses were in the same trading areas such that consumers would be likely to encounter overlapping uses of “Anthony’s”).

2. Conceptual Strength

Applicant argues that Registrant’s BLACKBELT mark “has diminished source identifying significance because it is highly suggestive ... imply[ing] that Registrant is an expert” in “investment advisory and real estate services[.]”⁵ A mark is suggestive if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *In re Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (a mark is suggestive if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515 (TTAB 2016).

We acknowledge that one meaning of “black belt” is “one who holds the rating of expert in various arts of self-defense,”⁶ and therefore the cited mark BLACKBELT may suggest to consumers that Registrant is an expert in its field. As discussed in the similarity of marks section to follow, “black belt” also refers to land with “rich black soil,” “an area densely populated by Black people” and a “strip of rolling prairie

⁵ Appeal Brief, 8 TTABVUE 14.

⁶ August 16, 2022 Second Request for Reconsideration, TSDR 37.

land extending across central Alabama and Mississippi.”⁷ Accordingly, Registrant’s mark for the identified real estate services may also suggest characteristics of the involved land or population. We do not agree, however, that the cited mark is “highly suggestive” and thus conceptually weak.

The seven third-party BLACKBELT/BLACK BELT marks discussed above, for services similar to those of Registrant, corroborate that BLACKBELT has a somewhat suggestive meaning for Registrant’s services, but the third-party uses are not so numerous as to support that the cited BLACKBELT mark is highly suggestive. *Cf. Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (third-party registration evidence may show that a term carries a highly suggestive or descriptive connotation in the relevant industry and therefore may be considered somewhat weak); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1075 (TTAB 2011) (“That so many third parties have adopted marks that include the term ELEMENTS indicates that the term has some measurable significance in the clothing industry along the lines of the term’s first defined meaning, as in ‘essential’ clothing items or the ‘fundamentals’ for apparel or one’s wardrobe.”); *Knight Textile Corp. v. Jones Invest. Co.*, 75 USPQ2d 1313, 1316 (TTAB 2005) (highly suggestive nature of ESSENTIALS based on its defined meaning was corroborated by numerous third-party registered marks containing the same term for clothing); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987) (“The existence of numerous third party registrations in the food field for marks

⁷ *Id.* at 37-38.

which include ‘QUICK’ as a portion thereof, (including a number of marks which include ‘QUICK ‘N’), buttresses” the conclusion that “QUICK” is a highly suggestive term); *Glidden Co. v. Dixie Paint & Varnish Co.*, 128 USPQ 261, 262 (TTAB 1961) (“The numerous third party registrations of record show that the term ‘FLEX’ has been adopted by a large number of manufacturers of paint products as a portion of trademarks in connection with other suggestive, descriptive and/or arbitrary terms; and it would appear therefrom that ‘FLEX’ is highly suggestive of a desirable quality for paints and paint products.”).

3. Finding Regarding Strength of the Cited Mark

Applicant has failed to prove that the cited mark is commercially or conceptually weak. Accordingly, the cited mark is entitled to the normal scope of protection accorded an inherently distinctive mark. *Bell’s Brewery*, 125 USPQ2d at 1347 (finding opposer’s marks were inherently distinctive and entitled to “the normal scope of protection to which inherently distinctive marks are entitled” where the evidence was insufficient “to establish that the terms either have a descriptive significance or are in such widespread use that consumers have come to distinguish marks containing them based on minute differences.”).

B. Similarity or Dissimilarity of the Marks

The first *DuPont* factor focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLC*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. “Similarity in any one of these

elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). We must focus on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

On comparison, Applicant’s mark BLACK BELT and the cited mark BLACKBELT are essentially identical in appearance and sound. The only visual difference between the marks is a space in Applicant’s mark between the words BLACK and BELT while the cited mark is one word, BLACKBELT. The space in Applicant’s mark is “an

inconsequential difference that even if noticed by consumers would not serve to distinguish these marks.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *37 (TTAB 2021), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021) (finding the marks DANTANNA’S and DAN TANA’S for restaurant services to be very similar in all means of comparison); *In re Iolo Tech., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (finding ACTIVECARE and ACTIVE CARE confusingly similar); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that petitioner’s mark DESIGNED2SELL is phonetically identical to respondent’s mark DESIGNED TO SELL and the “marks are also highly similar visually” in part because “the spaces that respondent places between the words do not create a distinct commercial impression from petitioner’s presentation of his mark as one word”); *Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are “essentially identical”). The marks also sound the same.

Applicant focuses its argument under the first *DuPont* factor on the connotations and commercial impressions of the marks. Applicant argues that it “is **not** using BLACK BELT to refer to a belt rank that can be achieved in martial arts,” as is the case with Registrant’s mark, but instead “is using BLACK BELT to refer to [a specific] geographic region of the United States (similarly [sic] to the ‘Bible Belt,’ ‘Rust Belt,’

or ‘Corn Belt’).⁸ To support this assertion, Applicant cites to the following dictionary definitions for BLACK BELT:⁹

- “One who holds the rating of expert in various arts of self-defense (such as judo and karate); “**also:** the rating itself”;
- “An area characterized by rich black soil”;
- “**Often capitalized both Bs:** an area densely populated by Black people”;
and
- “strip of rolling prairie land extending across central Alabama and Mississippi with fertile black clayey soil formerly notable for the production of cotton.”

Applicant also cites an April 19, 2004 article in *Southern Spaces* titled “The Black Belt”:¹⁰

This essay considers the historical-geographical Black Belt, beginning as a rich, dark-soil, cotton-growing region of Alabama occupied by slaveholders in the 1820s and 30s and becoming, over time, a more generalized designation for a region or place with a majority black

⁸ Appeal Brief, 8 TTABVUE 12. Applicant incorrectly refers to Registrant’s mark as “BLACKBELT CAPITAL.” *Id.* at 13. The mark as registered is BLACKBELT, standing alone, and it is this mark that we are bound to consider in comparing the similarities between the marks. *See, e.g., In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181 (TTAB 2018) (“We must compare the marks as they appear in the drawings[.]”); *see also i.am.symbolic, llc*, 123 USPQ2d at 1749 (“To the extent that Symbolic is advocating that we consider another mark, will.i.am, that is not part of the applied-for mark in analyzing the similarity of the marks, we decline to do so. The correct inquiry requires comparison of the applied-for mark, which only includes the words ‘I AM,’ to the registrants’ marks.”); *Blue Cross and Blue Shield Assoc. v. Harvard Cmty. Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990) (“It need hardly be said that in determining the applicant’s right to registration, only the mark as set forth in the application may be considered....”) (quoting *Frances Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959)) (internal quotation marks omitted).

⁹ August 16, 2022 Second Request for Reconsideration, TSDR 37-38.

¹⁰ *Id.* at 42-49.

population. By the late twentieth century, the Alabama Black Belt as a region of insurgent African American aspirations made a strong claim to take over the meaning of the term from its older and other senses.

Applicant, however, has not introduced any evidence to support its argument that its mark “evoke[s] a connection to deriving wealth through land” and “[c]onsumers ... will understand the reclaimed term to reference the quality and prosperity they can expect by working with Applicant.”¹¹ Attorney argument is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018).

Further, Applicant has not explained why Registrant’s mark for, inter alia, “land acquisition, namely, real estate brokerage; real estate brokerage; real estate management consultation; real estate management services” would not evoke the same commercial impression. That is, because both Applicant’s and Registrant’s marks cover real estate services, both marks may connote those definitions of the word “Black Belt” that pertain to real estate, namely, “an area characterized by rich black soil,” “an area densely populated by Black people” and “a strip of rolling prairie land extending across central Alabama and Mississippi with fertile black clayey soil formerly notable for the production of cotton.”

Similarly, because there are no limitations in the involved application or cited registration that would call to mind these specific definitions, it is just as likely that some consumers encountering both marks might also perceive the marks as “the rating of expert in various arts of self-defense.” For these reasons, Applicant’s argument that the marks have difference connotations and commercial impressions

¹¹ Appeal Brief, 8 TTABVUE 13.

is unpersuasive. *In re Embiid*, 2021 USPQ2d 577, at *21 (TTAB 2021) (rejecting the applicant’s argument that the identical standard-character marks created different commercial impressions for the parties’ respective goods).

We find that the first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion because Applicant’s and Registrant’s marks are nearly identical in appearance and are the same in sound, connotation and commercial impression.

C. Similarity or Dissimilarity of the Services

Under the second *DuPont* factor, we consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration[.]” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567)). It is sufficient for a finding of likelihood of confusion if relatedness is established for any services encompassed in the identifications in a particular class in an application. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*, 123 USPQ2d 1744 (“Likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and cited registration.”); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *see also, e.g., Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019).

We must base our comparison of the services on the identifications in the cited registration and Applicant’s application. *Charger Ventures*, 2023 USPQ2d 451, at *6

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(“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration.”) (emphasis omitted); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021) (“In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the parties’ registrations.”) (quoting *Double Coin*, 2019 USPQ2d 377409, at *5); *see also Stone Lion*, 110 USPQ2d at 1162; *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In analyzing the evidence under the second *DuPont* factor, we keep in mind that because Applicant’s and Registrant’s marks are nearly identical, the necessary degree of similarity between the services for confusion to be likely is reduced. *Shell Oil*, 26 USPQ2d at 1689 (“[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in the cited registration. *Embiid*, 2021 USPQ2d 577, at *22-23 (citing *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)).

The Examining Attorney introduced Internet printouts showing 12 third-parties using a single mark to identify Applicant's services, including "advisory services relating to building construction; advisory services relating to the construction of buildings" and "construction management; Construction project management services" on the one hand and Registrant's services, including real estate management, real estate brokerage services and investment advisory services on the other hand:¹²

- PARADIGM – offering "construction of multi-family residential properties," real estate development, and property management services;
- ROSS – offering building renovation and construction services as well as property management services;
- SL GREEN – identifying "property management & construction" services;
- AKRIDGE – a "full service commercial real estate company" offering design and construction management, "finance and asset management" and property management;
- BLAKE REAL ESTATE – offering building construction services and "real estate management, leasing and development services"; promoting "real world real estate experience to guide projects through the entire life-cycle";

¹² August 27, 2021 Office Action, TSDR 8-14; February 16, 2022 Final Office Action, TSDR 9-129.

- BONAVENTURE – offering building construction and renovation services, property management services and performance analytics for property holdings “to improve productivity and profitability”;
- BREEDEN – offering building construction and property management services; “Our team is comprised of experts in development, marketing, construction, accounting and all aspects of property operations in-between”;
- CTG REAL ESTATE SERVICES – offering “commercial construction project management,” “realtor” services; and “turnkey property management,” which includes “finding a property in an undervalued market[;] funding the investment[;] acquiring the property[;] renovating the property[;] managing the property[;] [and] planning for the property’s future”;
- KM and KIDDER MATHEWS – both for building project and construction management, “debt equity and finance” services, property management services, and brokerage consulting services;
- LINCOLN PROPERTY COMPANY – offering construction management, asset management and finance in the market of real estate investments and property management services;
- PEMBROKE REALTY GROUP – offering construction management services, real estate asset management, and commercial property management services; and

- SHINGOBEE – offering building construction and construction management services, real estate investment services, “representation and strategic advice for buying and selling a property” and brokerage services.

This evidence establishes that it is common for a single entity to offer under a single mark a full range of real estate services from construction building and management to building financing and investment, real estate brokerage services and property management services and supports a finding that Applicant’s and Registrant’s services are related. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1050 (crediting relatedness evidence showing that third parties use the same mark for the goods and services); *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”); *Made in Nature v. Pharmavite* 2022 USPQ2d 557, at *46 (third-party websites promoting sale of both parties’ goods showed relatedness); *L’Oreal v. Marcon*, 102 USPQ2d at 1140-41 (evidence that “companies have marketed cosmetics and beverages under the same mark” supported finding goods related); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2007) (finding retail women’s clothing store services and clothing related to cosmetics, including fragrances, based on evidence of third-parties using a single mark for clothing and retail store services featuring clothing and beauty care products and fragrances).



In an attempt to rebut the Examining Attorney's evidence, Applicant submitted 27 pairs of third-party use-based registrations¹³ "currently coexisting on the Register that feature the same wording in connection with separate construction and real estate services."¹⁴ Five of the third-party registration pairs each include one registration that supports the Examining Attorney's position that Applicant's and Registrant's services are related because the registrations cover services of the types identified in both the involved application and cited registration, while both registrations in a sixth pair do so.




The pertinent registration information is set out in the chart below:¹⁵

¹³ Applicant introduced 30 pairs of registrations but we do not consider three of the pairs because: (1) Applicant introduced only one of the registrations comprising the pair of CE (Stylized) marks (Reg. No. 2333072); and (2) one registration has been cancelled in each of the pairs of registration for the marks THE OASIS and LIBERTY PROPERTY TRUST/LIBERTY HOME BUILDERS & Design (cancelled Reg. Nos. 5069317 and 4935703). *Made in Nature*, 2022 USPQ2d 557, at *26 ("A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b).").

¹⁴ Appeal Brief, 8 TTABVUE 18. Applicant submitted "soft copies" of registration certificates for the third-party marks. *Id.* at 138-201. Generally such evidence is insufficient to make registrations of record because it does not reflect the current status and title of the registrations. TBMP § 1208.02 ("[T]o make a third-party registration of record ... a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted."). Nonetheless, the Examining Attorney did not object to the third-party registrations and has treated them as of record so we deem the third-party registrations stipulated into the record. *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant's registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they are of record).



¹⁵ August 16, 2022 Second Request for Reconsideration, TSDR 149, 150, 167, 168, 180, 193, and 196.

| Registration No. | Mark | Services |
|------------------|---|---|
| 3675285 |  | <p>Real estate services, namely, real estate brokerage services; real estate management services, and development and construction of commercial communities including but not limited to hotels, business complexes, business buildings, retail properties, research and development complexes</p> |
| 5926818 |  | <p>Real estate services, namely, real estate brokerage and real property management for commercial and residential real property including offices and office space; Land development, management, and construction services, namely, planning, laying out, and construction of communities consisting of residential and commercial property; Building construction of planned communities consisting of homes, stores, commercial space, restaurants, and various recreational facilities; Residential developments, namely, planning and layout out of residential communities</p> |


| Registration No. | Mark | Services |
|------------------|---|---|
| 3999689 | EXP | Building management services; urban planning services; engineering and architectural consulting; engineering project management |
| 5148947 |  | Real estate services, namely brokering; Real estate development and construction and construction of mixed use commercial and residential property |
| 5191442 |  | Real estate services, namely, brokerage and management of real estate, real estate development services, real estate property repair and maintenance services |
| 5174165 |  | Real estate services in the nature of commercial property management; financial asset management; consultation in the field of leasing, managing, and selling real property; Construction management; real estate development services in the nature of shopping center design and site selection; consultation in the field of real property development |
| 2790479 | LIBERTY PROPERTY TRUST | Real estate services, namely, the management, acquisition, development and leasing of commercial real estate |

“[U]se-based, third-party registrations, although not evidence that the marks shown therein are in use or that the public is familiar with them, nonetheless have probative value to the extent that they serve to suggest that the goods [or services] listed therein are of a kind which may emanate from a single source under a single mark.” *Made in Nature*, 2022 USPQ2d 557, at *45 (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013)); *Embiid*, 2021 USPQ2d 577, at *22-23 (evidence of relatedness may include prior use-based registrations covering both parties’ goods or services) (citing *Ox Paperboard*, 2020 USPQ2d 10878, at *5); *see also, e.g., Country Oven*, 2019 USPQ2d 443903, at *8 (ten third-party registrations buttressed the Board’s conclusion that the involved goods and services were related); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d* (unpublished), No. 88-1444, 864 F.2d 149 (Fed. Cir. Nov. 14, 1988).

The remaining 21 pairs of registrations introduced by Applicant have limited probative value for a number of reasons. First, a few of the cited pairs of marks are in stylized format or contain design elements that arguably distinguish them in

overall appearance and commercial impression, *e.g.*  and  ;

 and  ; and  and .

Second, at least one pair of registrations issued pursuant to a concurrent use proceeding.¹⁶ The marks SILVERLEAF (standard characters) and  SILVERLEAF are subject to concurrent use registrations that are restricted to different claimed geographic areas of use (e.g. “West of the Mississippi River” v. “[E]ast of the Mississippi River”).

For the other registrations, we lack important marketplace information such as whether the registrants entered into any coexistence agreements, whether the marks themselves have actually coexisted in the marketplace without confusion and whether the marks coexist in a crowded field such that consumers have been conditioned to distinguish among the specific marks based on minute differences. *Thomas*, 79 USPQ2d at 2028 (fact that marks co-existed on register does not prove that they coexisted in the marketplace without confusion); *In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1745 (TTAB 2016) (third-party registrations are not evidence of use in the marketplace). The record also does not include the file histories for the registrations so we are not privy as to why the marks were approved for registration.

Third, the fact that the respective services may sometimes emanate from different sources does not negate the other evidence of record supporting that the goods and service may emanate from a common source. *Made in Nature*, 2022 USPQ2d 557, at *46 (“For Applicant’s and Registrant’s identified goods to be related, it is not necessary that they **always** emanate from the same source under the same mark.”).

¹⁶ August 16, 2022 Second Request for Reconsideration, TSDR 159, 161.

Last, the 20 pairs of third-party registrations do not justify the registration of Applicant's mark if confusion with the cited mark is likely. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (citing *Plus Prods. v. Star-Kist Goods, Inc.*, 220 USPQ 541, 544 (TTAB 1983)). Indeed, the cited pairs of marks are so different from the marks at issue in the present case that they "merely stand for the principle[s] that the Office determines each case on its own merits" and the Office is not bound by the prior determinations and actions of examining attorneys on different factual records. *Id.* at 1272; *see also, 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"); *Hilson Rsch. Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1439 (TTAB 1993) (Board is not bound by an examining attorney's determination).

In sum, the record demonstrates that Applicant's and Registrant's services are related and, therefore, the second *DuPont* factor supports a finding that consumer confusion is likely.

D. Similarities or Differences in Trade Channels and Classes of Purchasers

We next consider the similarity or dissimilarity of established, likely-to-continue channels of trade, and the buyers to whom sales are made. Since there are no restrictions as to trade channels or classes of purchasers in the services as identified in the involved application and cited registration, we presume that the services travel

through all usual channels of trade for such services and are offered to all normal potential purchasers for such services. *Stone Lion*, 110 USPQ2d at 1161.

The Internet evidence submitted by the Examining Attorney demonstrates that Registrant's real estate brokerage, real estate management, and investment advisory services and Applicant's building construction, management and repair services may be found in some of the same trade channels, namely, offered by a single entity advertising on a single website to at least some of the same consumers, namely, real estate investors and those members of the general public seeking home construction, home repair and real estate brokerage services.

The overlap in trade channels and classes of consumers further favors a finding that confusion is likely.

E. Sophistication of the Relevant Purchasers and Conditions under which Sales are Made

Under the fourth *DuPont* factor we consider "the conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive goods or services may tend to have the opposite effect. *Palm Bay Imps.*, 73 USPQ2d at 1695.

Applicant argues that Applicant's and Registrant's "services are relatively expensive and would be generally purchased by sophisticated consumers who have researched their options with a high amount of scrutiny."¹⁷ Applicant introduced: (1) a screenshot from a design/build company explaining that "[a] mid-sized project consisting of 1500-2800 square feet will typically take 6-9 months" and a "large renovation or new construction project consisting of 3,000-5,000 square feet with high-end details can easily take 9-12 months";¹⁸ (2) articles stating that new home construction costs on average range from \$100 to \$155 per square foot while the average commercial construction project is \$490 per square foot;¹⁹ and (3) an article to support that building projects are "subject to a whole host of pre-construction considerations such as permits, architectural decisions, interior design decisions, HVAC and plumbing planning, and labor availability."²⁰ Applicant also introduced Registrant's specimen of use showing that Registrant's "services include preparation of in-house reports for bankers, meetings with advisors, managing financial accounting and planning, and handling transactions on behalf of its client company."²¹ We further recognize that Applicant's and Registrant's services are the type that may be subject to negotiated agreements.²²

¹⁷ Appeal Brief, 8 TTABVUE 17.

¹⁸ August 16, 2022 Second Request for Reconsideration, TSDR 91.

¹⁹ *Id.* at 94-123.

²⁰ 8 TTABVUE 17.

²¹ *Id.*

²² August 16, 2022 Second Request for Reconsideration, TSDR 125-36 (Registrant's specimen).

The record supports that some consumers may be likely to exercise a high degree of care in purchasing Applicant's and Registrant's services. That said, we must base our decision "on the least sophisticated potential purchasers." *Stone Lion*, 110 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011)) (internal quotation marks omitted); *see also In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018). Applicant's services are broad, encompassing "repair ... of residential property," which includes minor home repairs that are unlikely to involve significant cost. In addition, these services, like Registrant's "real estate brokerage" services are the types of services provided to home owners generally who may not exercise any particular degree of sophistication in purchasing the services.

We further keep in mind that even those purchasers who may be sophisticated or knowledgeable in a particular field may not be sophisticated in the field of trademarks or immune from source confusion. *See, e.g., Stone Lion*, 110 USPQ2d at 1163-64; *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). This is particularly true where, as here, the marks are nearly identical. *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)) ("Human memories even of discriminating purchasers ... are not infallible.").

Considering the evidence as a whole, we find that the fourth *DuPont* factor is

neutral or only slightly favors finding no likelihood of confusion.

II. Conclusion

The first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion as Applicant's standard-character mark BLACK BELT and Registrant's standard-character mark BLACKBELT are nearly identical in appearance and have the same sound, connotation and commercial impression. The record further demonstrates that the services are related and may be sold to some of the same purchasers in at least one common trade channel. Accordingly, the second and third *DuPont* factors also support that confusion is likely. The fourth *DuPont* factor is neutral or only slightly favors finding no likelihood of confusion. The strength of the cited mark also is neutral.

On balance, the *DuPont* factors weigh in favor of finding a likelihood of confusion. We therefore find that Applicant's mark is likely to be confused with the cited mark.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.