This Opinion is Not a
Precedent of the TTAB

Mailed: January 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James Lindsay

Serial No. 90793706

William A. Wooten of Wooten Law Office,
for James Lindsay.

Derek Van Den Abeelen, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

Before Wellington, Larkin and Dunn,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

James Lindsay ("Applicant") seeks registration on the Principal Register of the standard character mark BOSSCOIN, on goods in International Classes 21 and 25 and in connection with the following services:[1]

[1] Application Serial No. 90793706, filed on June 24, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of a bona fide intent to use the

> Cash management; Cryptocurrency exchange services; Cryptocurrency exchange services featuring blockchain; Cryptocurrency payment processing; Cryptocurrency trading services; Financial services in the nature of an investment security; Financial services, namely, gold trading; Financial services, namely, money lending; Financial advice and consultancy services; Financial advisory and consultancy services; Financial analysis and research services; Financial brokerage services for cryptocurrency trading; Financial information and advisory services; Financial planning and investment advisory services; Financial research and information services; Electronic transfer of virtual currencies; Financial consultation in the field of cryptocurrency; Financial exchange of virtual currency; Financial services, namely, providing a virtual currency for use by members of an on-line community via a global computer network; Financial services, namely, providing electronic transfer of a virtual currency for use by members of an on-line community via a global computer network; Providing financial information in the field of cryptocurrency, in Class 36.

The Examining Attorney refused registration of Applicant's mark solely as to the Class 36 services under Section 2(d) of the Trademark Act ("the Act"), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following registered mark on the Principal Register:

> BOSCOIN (in standard characters) for:
> Supervision of payment operations and of computer payment systems, namely, payment processing services of commercial transactions using virtual currency; mobile and internet payment services, namely, payment processing services of commercial transactions using virtual currency; integrated services of mobile electronic wallet and mobile payment, namely, credit card, cash card and virtual currency payment processing services; processing of payment transactions via the Internet, namely, processing of payment services for commercial transactions using virtual currency; automated payment services, namely, processing of payment services for commercial transactions using virtual currency; electronic bill payment services; processing of electronic cash transactions, namely, processing of payment services for commercial transactions using virtual currency; electronic cash transactions, namely, processing of payment services for commercial transactions using virtual currency; electronic

mark in commerce for goods and services in Classes 21, 25 and 36. The Examining Attorney's refusal does not pertain to Applicant's goods in Classes 21 and 25.

> payment services, namely, processing of payment services for commercial transactions using virtual currency; electronic processing of payments, namely, processing of payment services for commercial transactions using virtual currency; payment transaction processing services, namely, processing of payment services for commercial transactions using virtual currency; processing of payment transactions, namely, processing of payment services for commercial transactions using virtual currency, in International Class 36.[2]

Applicant requested reconsideration of the refusal and filed an appeal with this Board. Applicant's request for reconsideration was denied by the Examining Attorney and this appeal resumed. The appeal has been fully briefed. For the reasons set forth below, we affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) of the Act is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth *DuPont* factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services or goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."). We consider the likelihood of

[2] Registration No. 5705727 issued on March 26, 2019.

confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

A. Relatedness of the Services and Trade Channels

We begin with the second and third *DuPont* factors, which respectively consider "[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration," and "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021).

We must base our comparisons under the second and third *DuPont* factors on the identifications of services in Applicant's application and the cited registration. *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *6 (Fed. Cir. 2023) ("The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration."); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLC*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *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).

With respect to the second *DuPont* factor, it is sufficient for a finding of likelihood of confusion if relatedness is established for any service encompassed in the recitation of services in a particular class in an application. *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); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

At the outset and pertinent to a proper understanding of Applicant's and Registrant's services, the Examining Attorney submitted evidence establishing that a "virtual currency" is described as "a digital representation of value only available in electronic form. … Virtual currencies are subset of digital currencies and include other types of digital currencies, such as cryptocurrencies and tokens issued by private organizations."[3] In other words, "virtual currency" is a broader term that encompasses "cryptocurrency."

Given that cryptocurrency is a type of virtual currency, we find that there is an overlap of Applicant's and Registrant's services. That is, Applicant's "cryptocurrency payment processing" services may include or be encompassed by the following services in the cited registration:

- "supervision of payment operations and of computer payment systems, namely, payment processing services of commercial transactions using virtual currency,"
- "mobile and internet payment services, namely, payment processing services of commercial transactions using virtual currency," and
- "payment transaction processing services, namely, processing of payment services for commercial transactions using virtual currency."

[3] Investopedia article, updated September 30, 2021; copy attached to Office Action issued April 9, 2022, at TSDR pp. 61-65. Additional information from the Corporate Finance Institute and TNW websites corroborates the understanding that cryptocurrency is a cryptography-based virtual currency. *Id.* at pp. 66-75.

Because Applicant's services in Class 36 are legally identical, in part, to services identified in the cited registration, and there are no limitations on trade channels or consumers, we must presume that those services are offered in the same trade channels to the same relevant purchasers. *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1661 (TTAB 2014); *Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1906 (Fed. Cir. 2012); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1935 (TTAB 2012). In other words, we assume that consumers of payment processing services using virtual currencies, which includes cryptocurrency, will encounter both Applicant's and Registrant's services in the same usual trade channels for those services and may seek to retain either Applicant or Registrant to render such services. Indeed, the Examining Attorney submitted evidence showing various third-parties offering virtual currency payment processing services, including the use of cryptocurrency payments using Bitcoin and other cryptocurrencies.[4]

We find that the second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.

B. Alleged Weakness of Terms BOS(S) and COIN

Before addressing the similarity of the marks, we address Applicant's argument that the terms BOSS and COIN are "highly diluted" in connection with financial

[4] See, e.g., Internet evidence attached to Office Action issued September 10, 2021, at TSDR pp. 5-10.

services involving virtual currency.[5] In support, Applicant points to the following four registered marks that include the term BOSS:[6]

- BOSSFACE (Reg. No. 6110543) for "providing access to benefits for others in the nature of administration of employee health insurance plans, workers' compensation, and employment practices liability (EPL) insurance";
- REALTYBOSS (Reg. No. 6152911) for "real estate agency services; real estate brokerage; real estate listing; real estate valuations";
- BA BOSSAGENT, stylized with design, (Reg. No. 6418141) for, inter alia, "providing information in the field of real estate by means of a web site geared toward real estate agents"; and
- $ THE MONEY BOSS, stylized with design, (Reg. No. 5615762) for "financial advisory and consultancy services, namely, the creation of personalized strategies to achieve financial independence; financial counseling services, namely, helping others build a better working relationship with their money; providing information in the field of personal finance."

These four registrations do not demonstrate that the term BOSS is weak in connection with virtual currency services. Indeed, none of the services described in these registrations involve virtual currency and some of the services, e.g., "real estate agency," "providing access to benefits for others…," etc., are wholly unrelated. *See Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods where the involved goods are identical, as Board must focus "on goods shown to be similar"); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for goods in other

[5] 6 TTABVUE 9-10.

[6] Applicant submitted copies of the registrations with his Request for Reconsideration filed on October 10, 2022, at TSDR pp.

classes where the proffering party "has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants' marks are weak with respect to the goods identified in their registrations").

As to the term COIN, on the other hand, it is demonstrated to be weak in connection in the field of virtual currency. In addition to the evidence showing that BITCOIN is a well-known cryptocurrency, Applicant submitted copies of the following five registrations with the term COIN, all involving virtual currency services: NOONERCOIN, stylized with design, (Reg. No. 6853691); COINMEAL (Reg. No. 6853691); COJCOIN (Reg. No. 6806276); KOIN, stylized with design and disclaimer of COIN, (Reg. No. 6800011); and CLUCOIN (Reg. No. 6767068).

Nevertheless, other than the cited registration, there is no evidence of third-party use of the combination of the terms BOS[S] and COIN. Nor is there any evidence that the combination of terms has any particular meaning in connection with the involved services. In other words, although the latter COIN element of Registrant's mark is weak, the compound BOSCOIN is not. Accordingly, the registered mark is entitled to at least the normal scope of protection to which an inherently distinctive mark is entitled. *See*, *e.g.*, *Sabhnani*, 2021 USPQ2d 1241, at *26 (citing *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017)).

C. Similarity of the Marks

We turn now to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial

impression. *DuPont,* 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

In comparing the marks, we keep in mind that where, as here, the services are legally identical in part, "the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Viterra,* 101 USPQ2d at 1912 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)); *Aquamar,* 115 USPQ2d at 1126 ("The legal identity of Applicant's and Registrant's goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of a finding of likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion.").

In comparing the marks, BOSCOIN and BOSSCOIN, it is readily apparent that they are very similar "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). The only difference between the marks is Applicant's addition of the second "s" in Applicant's mark – which is not really noticeable visually

and unlikely to alter the manner the otherwise identical manner in which the marks are pronounced or understood.

Because there is only a minimal difference between the marks and we find such difference may go easily unnoticed by consumers, the marks are overall very similar and this *DuPont* factor weighs in favor of finding a likelihood of confusion.

II. Conclusion

Because the proposed mark, BOSSCOIN, and the registered mark, BOSCOIN, are very similar, and these marks may be used in connection with legally identical services offered in the same trade channels, we find confusion is likely.

Decision: The refusal to register Applicant's mark is affirmed as to Class 36. The application will go forward as to the goods identified in Classes 21 and 25.