

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: June 29, 2022

Mailed: July 6, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Shawn Hayden
v.
WorkSuites – IP Holdings, LLC
—

Opposition No. 91249435
—

James H. Creedon and Charles A. Wallace of Creedon PLLC,
for Shawn Hayden.

Robert E. Nail, Thomas G. Yoxall, and Mark R. Backofen of Locke Lord LLP,
for WorkSuites – IP Holdings, LLC.

—
Before Kuhlke, Bergsman and Allard,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

WorkSuites – IP Holdings, LLC (“Applicant”) seeks registration on the Principal Register of the marks WORKSUITES, in standard characters, and WORKSUITES and design, reproduced below, for the services listed below:

Providing virtual office services, namely, virtual office services featuring physical mailing addresses, mail handling, digital mailboxes, telephone answering services; Procurement and supply services, namely, the purchasing and supply of furniture and office equipment for others, in International Class 35;

Leasing of executive office space and shared working facilities in the nature of co-working office space, namely, offices, desk spaces, work spaces, conference rooms, meeting rooms, training rooms, kitchen spaces and videoconferencing facilities, in International Class 36.¹



Applicant's description of the mark reads as follows:

The mark consists of the term "WORKSUITES" appearing in a stylized font wherein "WORK" appears in a slightly wider and bolder stylized dark gray font as compared to "SUITES" which appears in a narrower stylized green font, with the "WORKSUITES" word element appearing immediately adjacent to a slightly tilted stylized upward pointing green arrow and dark gray diamond design, where said stylized green arrow appears centered directly above said dark gray diamond design and separated therefrom by a slight spacing.

The color(s) green. [sic] black and dark gray is/are claimed as a feature of the mark.

Shawn Haydon ("Opposer") filed a Notice of Opposition against the registration of Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer pleaded ownership of application Serial No. 87553561 for the mark SUITEWORK, in standard characters, for the services listed below:

Business management services, namely, managing office functions in the nature of providing secretarial and clerical services; telephone answering and operator services; computer data entry services; mail sorting, handling and receiving services; leasing of office equipment;

¹ Application Serial No. 87822414 for the mark WORKSUITES, in standard characters, and application Serial No. 87822428 for the mark WORKSUITES and design were filed on March 6, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's claim of a bona fide intention to use the marks in commerce.

appointment scheduling services in the nature of scheduling use of office, break, and conference rooms for others; procurement services, namely, purchasing furniture and telephone systems for others; data processing services, in International Class 35;

Rental of office space; Rental of offices for co-working, in International Class 36; and

Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Providing facilities and equipment for telepresence conferencing; Providing facilities and equipment for video conferencing, in International Class 38.²

Opposer also alleged that Applicant's marks WORKSUITES are merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Applicant, in its Answer, denies the salient allegations in the Notice of Opposition and asserts several "affirmative defenses" and a "counterclaim" of lack of bona fide intent to use against Opposer's pleaded application.³ The Board, in its October 26, 2019 order, noted that because the only counterclaim the Board considers are counterclaims to cancel a plaintiff's pleaded registration and because Applicant's

² Registration No. 6441290 registered August 3, 2021 based on application Serial No. 87553561 filed August 2, 2017. Opposer's pleaded registration did not issue until after the Board instituted the opposition; specifically, Opposer's pleaded registration issued after the close of Applicant's trial period.

³ 7 TTABVUE.

Citations to the record and briefs reference TTABVUE, the Board's online docket system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s), if any.

“counterclaim” seeks to void Opposer’s pleaded application, that “counterclaim” will be given no further consideration.⁴

As noted in footnote 2, Opposer’s pleaded application registered on August 3, 2021, the day after Applicant’s trial period ended.⁵ On November 9, 2021, Applicant filed a motion for leave to file an Amended Answer seeking a counterclaim to cancel Opposer’s Registration No. 6441290 on the grounds of nonuse, fraud based on nonuse, and lack of bona fide intent to use.⁶ In its March 23, 2022 order, the Board granted Applicant’s motion for leave to amend with respect to Applicant’s counterclaim alleging that Opposer lacked a bona fide intent to use his mark when he filed his underlying application but denied the motion for leave to amend with respect to Applicant’s counterclaim on the grounds of fraud and nonuse.⁷

Opposer denies the allegations in Applicant’s counterclaim.⁸

In sum, the grounds for opposition are likelihood of confusion under Section 2(d) of the Trademark Act and whether Applicant’s mark is merely descriptive under Section 2(e)(1) of the Trademark Act. In addition, Applicant has filed a counterclaim

⁴ 11 TTABVUE 3.

⁵ 30 TTABVUE 15.

⁶ 40 TTABVUE.

⁷ 49 TTABVUE 6 and 10.

The Board granted the motion to amend with respect to Applicant’s counterclaim alleging that Opposer lacked a bona fide intent to use his mark when he filed his underlying application because (i) Applicant raised the issue in its motion for summary judgment filed July 2, 2020 (19 TTABVUE 8-12), (ii) on March 22, 2021, Applicant filed an Answer to the Amended Notice of Opposition pleading Opposer’s lack of bona fide intent to use as an affirmative defense (32 TTABVUE 6, ¶ 3), and (iii) the parties submitted evidence on the issue at trial and argued the issue in their briefs on the case.

⁸ 50 TTABVUE.

to cancel opposer's pleaded registration on the ground that Opposer did not have a bona fide intent to use his mark at the time he filed the underlying application.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of Applicant's applications and Opposer's pleaded registration. Additional evidence introduced into the record is listed below.

A. Opposer's testimony and evidence.

1. Notice of reliance on a copy of Opposer's Registration No. 5794794 for the mark PROGUL for "providing on-line facilities for real-time interaction with other computer users which allows access to a global computer network facilitating peer to peer consulting";⁹
2. Notice of reliance on Applicant's response to Opposer's document request No. 8 (an excerpt from Applicant's website displaying a URL but no date);¹⁰
3. Notice of reliance on excerpts from Applicant's designated Fed. R. Civ. P. 30(b)(6) witness Phillip Howard, Applicant's Chief Executive Officer;¹¹
4. Notice of reliance on copies of various third-party trademark applications;¹²
5. Notice of reliance on dictionary definitions of the words "work" and "suite";¹³

⁹ 33 TTABVUE 52-54.

¹⁰ 33 TTABVUE 55-59. Phillip Howard, Applicant's Chief Executive Officer, authenticated the document in his discovery deposition. Howard Discovery Dep., p. 26 and Exhibit 5 (33 TTABVUE 49 and 95). Because the webpage was included in the discovery deposition, the introduction of the same webpage through a notice of reliance was cumulative.

¹¹ 33 TTABVUE 60-95.

¹² 33 TTABVUE 96-145.

¹³ 33 TTABVUE 146-151.

6. Notice of reliance on a dictionary definition of the word “Rowlock”;¹⁴
7. Notice of reliance on the Wikipedia.org entry for “brickwork” that defines the term “rowlock”;¹⁵
8. Notice of reliance on excerpts from Opposer’s SUITE.WORK website (June 21, 2019);¹⁶ and
9. Opposer’s testimony declaration.¹⁷

B. Applicant’s testimony and evidence.

1. Notice of reliance on Opposer’s admissions to Applicant’s requests for admission Nos. 1, 2; 5, 11, 12, and 14;¹⁸
2. Notice of reliance on Opposer’s responses to Applicant’s interrogatory Nos. 4, 10, and 11;¹⁹
3. Notice of reliance on Opposer’s responses to Applicant’s document request Nos. 1-5, 8-10, 13,14, 16, 17, 25, 30-33, and 36-38;²⁰

¹⁴ 33 TTABVUE 152.

¹⁵ 33 TTABVUE 153.

¹⁶ 33 TTABVUE 154-157.

¹⁷ 34 TTABVUE.

¹⁸ 35 TTABVUE 43-46.

A party may introduce only an admission in response to a request for admission through a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). A denial or statement that the responding party cannot respond to the request does not establish the truth or falsity of the assertion, but rather leaves the matter for proof at trial. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials to requests for admission inadmissible because “unlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial.”).

¹⁹ 35 TTABVUE 47-50.

²⁰ 35 TTABVUE 51-60.

Responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); *see also City Nat’l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are

4. Notice of reliance on excerpts from Opposer's discovery deposition;²¹
5. Notice of reliance on copies of third-party registrations incorporating the word "Suite" or "Work";²²
6. Notice of reliance on dictionary definitions of the words "Work" and "Suite";²³
7. Notice of reliance on excerpts from Applicant's website;²⁴
8. Notice of reliance on copies of unsolicited media coverage referring to Applicant's marks;²⁵
9. Testimony declaration of Philip Howard;²⁶
10. Testimony declaration of Keele Waguespack, Applicant's Director of Making Things Happen;²⁷
11. Testimony declaration of Joshua Bell, Applicant's Director of Business Strategy and Technology;²⁸ and
12. Testimony declarations from 11 of Applicant's clients.²⁹

admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance). Accordingly, we consider Opposer's responses to Applicant's document requests only the extent that they state Opposer has no responsive documents.

²¹ 35 TTABVUE 62-194.

²² 35 TTABVUE 195-374.

²³ 35 TTABVUE 415-416.

²⁴ 35 TTABVUE 418-437.

²⁵ 35 TTABVUE 437-1192.

²⁶ 36 TTABVUE.

²⁷ 37 TTABVUE.

²⁸ 38 TTABVUE.

²⁹ 39 TTABVUE.

II. Applicant's entitlement to a statutory cause of action to maintain its counterclaim.

A plaintiff's entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case. *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *10 (TTAB 2021) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021)). To establish entitlement to a statutory cause of action under Trademark Act Section 14, 15 U.S.C. § 1064, a plaintiff must demonstrate “an interest falling within the zone of interests protected by the statute and ... proximate causation.” *Corcamore*, 2020 USPQ2d 11277, at *4 (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)).³⁰ Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d

³⁰ Our decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Trademark Act Sections 13 and 14 remain applicable. *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

11277, at *4. Thus, “a party that demonstrates a real interest in cancelling a trademark under § 1064 has demonstrated an interest falling within the zone of interests protected by § 1064. ... Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 1064.” *Corcamore*, 2020 USPQ2d 11277, at *7.

Applicant’s entitlement to a statutory cause of action to assert its counterclaim arises from Applicant’s position as a defendant in the opposition initiated by Opposer. *See Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at * 12 (TTAB 2019) (citing *Oh. State Univ. v. Oh. Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999) (citing *General Mills, Inc. v. Nature’s Way Prods., Inc.*, 202 USPQ 840, 841 (TTAB 1979) (“[I]t is clear from the counterclaimant’s position as defendant in the opposition that he has a personal stake in the controversy, and it is unnecessary for him to allege likelihood of confusion.”))).

III. Whether Opposer had a bona fide intent to use his mark at the time he filed his application.

Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), states that “[A] person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark....” Whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on the totality of the circumstances. *See M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015); *A&H Sportswear Co., Inc. v. Yedor*, 2019 USPQ2d 111513, at *3 (TTAB 2019); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008 (TTAB 2015).

The evidentiary bar for showing bona fide intent to use is not high, but more is required than “a mere subjective belief.” The objective evidence must indicate an intention to use the mark that is “firm” and “demonstrable.” *M.Z. Berger*, 114 USPQ2d at 1897-98; *A&H Sportswear*, 2019 USPQ2d 111513, at *3; *Swiss Grill*, 115 USPQ2d at 2008; *see also Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

The absence of any documentary evidence regarding an applicant’s bona fide intention to use a mark in commerce establishes a prima facie case that the applicant lacks such intention as required by Section 1(b), a case that an applicant may counter with facts that adequately explain or outweigh its failure to provide documentary evidence. *See A&H Sportswear*, 2019 USPQ2d 111513, at *3; *Spirits Int’l., B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliigi*, 99 USPQ2d 1545, 1549 (TTAB 2011); *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1662-64 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

Hayden Realty LLC, a real estate management company consisting of Opposer and his wife, owns the property at 3920 Alma Road, Plano, Texas.³¹ Hayden Realty LLC purchased the property at 3920 Alma Road for Opposer’s office space (a medical

³¹ Opposer’s Discovery Dep., pp. 16-17 (35 TTABVUE 62-63).

practice) and shared office space.³² According to Opposer, “shared office space” is “renting individual offices to tenants who require short-term space.”³³ Opposer, nor any of his companies, own any other commercial properties.³⁴ Opposer had not formed a separate entity to rent individual office space in a shared office space setting. Either Hayden Realty LLC or Hayden, M.D., P.A., “one of the two,” will rent individual office space in a shared office space setting.³⁵

In an email communication dated May 20, 2016, between Dallas Hayden, Opposer’s son, and Richard Case, a prior owner of the property at 3920 Alma Road in Plano, Texas (Opposer’s facility), Dallas Hayden wrote the following (emphasis added):

While my father plans to use half the building for his orthopedic practice, **our goal is to develop out the remaining portion for executive office suites.** Renovation plans include a thorough restoration of all windows, brickwork, interior, roof, and parking lot. Our goal is to return the building to like new condition and have it last at least another 32 years!³⁶

Opposer testified that he selected the SUITEWORK trademark “after months of brand concept and development work.”³⁷ Opposer and his family began discussing using SUITEWORK in May/June 2017.³⁸

³² Opposer’s Discovery Dep., pp. 19-22 (35 TTABVUE 65-67).

³³ Opposer’s Discovery Dep., p. 21 (35 TTABVUE 67).

³⁴ Opposer’s Discovery Dep., p. 28 (35 TTABVUE 68).

³⁵ Opposer’s Discovery Dep., p. 21 (35 TTABVUE 67).

³⁶ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 107).

³⁷ Opposer’s Testimony Decl. ¶ 4 (34 TTABVUE 3).

³⁸ Opposer’s Discovery Dep., p. 36 (35 TTABVUE 76).

Q. And, again, when did you and your family members begin discussing the use of the term Suitework?

A. My - - again, my recollection is sometime in the - - in the spring to summer of 2017, so I would - - I would say it's the May, June time frame, but, again, that's - - I - - I wouldn't swear to any one specific date.³⁹

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Q. Other than the word Suite work, did you consider any other names?

A. That's a good question. We - - thought about - - I mean, in discussions with the family, it's like kind of my focus group, I know we had - - we had probably hundreds of different names that we looked at.

Q. You say you looked at hundreds of different names. How did you do that?

A. Just write them on a piece of paper and we - - and typically the process that we use is to go to - - we write names down, ask individuals in the family to look at them and rate them. The - - we go to the Internet to see if the names are in use, and then typically we'll either use the Trademark Office search engine or we'll go to GoDaddy to look at website usage to see if it's available.

Q. And do you recall how you came up with the name Suitework?

A. I believe we were looking at -- at the time the -- you know, the preeminent shared office leasing company in the country was WeWork, and I think we were looking at ways of coming up with a name that would imply shared office space and I -- and we looked at a number of different options. I think Suitework was the one that had the most appeal in our family unit.

Q. Did you like the fact that Suitework had at least some similarity to WeWork?

³⁹ Opposer's Discovery Dep., p. 36 (35 TTABVUE 76).

A. No. I think we -- we liked the idea that it was -- it had -- we liked the idea that it had work in it, but the Suite in front of it, it -- it made it less arduous. I think we liked the idea that Suite had double entendre meaning.

Q. And what is the double entendre meaning to you of Suite?

A. Well, just the -- the homonym Sweet, you know, S-W-E-E-T, versus Suite, S-U-I-T-E.

Q. So from your perspective, the S-U-I-T-E has some good meaning for your business with respect to S-W-E-E-T, correct?

A. Yes.

Q. From your perspective, I take it you believe that hearing Suitework, a potential tenant might think S-W-E-E-T, like it's a sweet place to work; is that fair?

A. That's fair.⁴⁰

After he filed the application on August 2, 2017, Opposer testified as to the following steps to make use of the mark:

I promptly planned the build-out and construction of the space where the designated services would be rendered under the SUITEWORK Mark (Exhibit 1), and I asked members of my family to help me design various potential logos and advertising material for the SUITEWORK Mark (Exhibit 2), procure a virtual private server and web domains, and solicit web developers (Exhibit 3), and otherwise assist in communications relating to brand, web, marketing, and services development under the SUITEWORK Mark (Exhibit 4).⁴¹

Opposer's testimony Exhibit 1 consists of the following:

⁴⁰ Opposer's Discovery Dep., pp. 36-38 (35 TTABVUE 76-78).

⁴¹ Opposer's Testimony Decl. ¶ 4 (34 TTABVUE 3).

- An undated photograph of Opposer’s building reproduced in relevant part below:⁴²



- An undated document entitled “Suite Work Map Specifics.”⁴³ Opposer did not expressly identify the document. Because he testified that Exhibit 1 was documents relating the build-out and construction of his facility, the document is an outline describing the purported facilities.

- An undated document entitled “Site Map.”⁴⁴ Although Opposer testified that Exhibit 1 was documents relating to the build-out and construction of this facility, the “Site Map” is an outline identifying the topics for a website.

- Blueprints for Opposer’s building entitled “Onto Orthopedics Office Building Interior Remodel” dated March 13, 2017.⁴⁵ The blueprints do not refer to SUITEWORK, they do not illustrate an office sharing facility, and they are dated prior to the filing date of Opposer’s application contrary to his testimony.

Opposer’s testimony Exhibit 2 consists of the following:

⁴² Opposer’s Testimony Decl. Exhibit 1 (34 TTABVUE 8).

⁴³ Opposer’s Testimony Decl. Exhibit 1 (34 TTABVUE 9-10).

⁴⁴ Opposer’s Testimony Decl. Exhibit 1 (34 TTABVUE 11).

⁴⁵ Opposer’s Testimony Decl. Exhibit 1 (34 TTABVUE 12-33).

- Undated renderings of the SUITEWORK logo;⁴⁶ and
- An undated brochure advertising “SUITEWORK Executive Offices.”⁴⁷

Opposer’s testimony Exhibit 3 consists of the following:

- A copy of a receipt from GoDaddy dated June 18, 2017 (prior to the August 2, 2017 filing of Opposer’s application) for registering the “suite.work” domain;⁴⁸ and
- An undated job posting on an unidentified website advertising for a web designer to start October 1, 2017 “for a growing executive suite business.”⁴⁹

Opposer’s testimony Exhibit 4 consists of the following:

- “Communications” from an unidentified source – probably email – regarding engaging a website designer dated October 9, 2017 through December 22, 2017;⁵⁰
- An email dated October 23, 2017, regarding “Your New Droplet: Suitework”;⁵¹
- Email communications, including an estimate, dated December 4, 2017, regarding a SUITEWORK logo sign;⁵² and
- Dallas Hayden’s May 20, 2016 email with Richard Case discussed above.⁵³

Opposer’s above-noted testimony is consistent with his answer to Applicant’s interrogatory No. 4 wherein Opposer testified that after the August 2, 2017 filing date

⁴⁶ Opposer’s Testimony Decl. Exhibit 2 (34 TTABVUE 34-77).

⁴⁷ Opposer’s Testimony Decl. Exhibit 2 (34 TTABVUE 78-79).

⁴⁸ Opposer’s Testimony Decl. Exhibit 3 (34 TTABVUE 80-81).

⁴⁹ Opposer’s Testimony Decl. Exhibit 3 (34 TTABVUE 82).

⁵⁰ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 83-101).

⁵¹ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 102).

⁵² Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 103-106).

⁵³ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 107).

of Opposer's underlying application for registration, Opposer took the following "actions":

Opposer continued to develop a conceptual map for the SUITEWORK offerings which included identification of the types of spaces needed, the differentiating factors of then-existing coworking spaces, the required amenities and services for clients, the pricing strategy, and the development of a website outline and logo. Opposer further identified the property at 3920 Alma Road, Plano, Texas, as the site to develop the SUITEWORK services, purchased furniture, and began developing signage for that location. Opposer has since worked to restore that property from the fire damage incurred on October 22, 2017.⁵⁴

Other than his website and the blueprints for the building at 3920 Alma Road, Opposer does not have documents reflecting or referring to: (i) product or service development,⁵⁵ (ii) promotional activities in support of SUITEWORK brand providing shared office space services,⁵⁶ (iii) specific business plans regarding SUITEWORK brand office space services,⁵⁷ (iv) specific publications, broadcasters, radio stations, trade shows, direct-mail marketers, websites or other advertising media Opposer intends to use,⁵⁸ or (v) studies, reports, or surveys identifying or describing any traits or characteristics of consumers or potential consumers of Opposer's SUITEWORK services.⁵⁹ With respect to his website, Opposer concedes that June 1, 2019, might be

⁵⁴ Opposer's response to Applicant's interrogatory No. 4 (35 TTABVUE 47-48).

⁵⁵ Opposer's Discovery Dep., p. 51 (35 TTABVUE 82).

⁵⁶ Opposer's Discovery Dep., p. 52 (35 TTABVUE 83).

⁵⁷ Opposer's Discovery Dep., p. 55 (35 TTABVUE 85).

⁵⁸ Opposer's response to Applicant's document request No. 12 (35 TTABVUE 54-55).

⁵⁹ Opposer's response to Applicant's document request No. 15 (35 TTABVUE 55-56).

the first date the public could access his website at <suitework.com> or <suite.work.com>.⁶⁰

Based on the evidence listed below, we find that Opposer had more than “a mere subjective belief,” and, in fact, had a bona fide intent to use the SUITEWORK mark at the time he filed the application to register the mark:

- The May 20, 2016 email from Dallas Hayden to Richard Case;⁶¹
- The June 18, 2017 receipt from GoDaddy registering the “suite.work” domain;⁶²
- The job posting for a web designer to start October 1, 2017 “for a growing executive suite business”;⁶³
- The communications regarding engaging a website designer dated October 9, 2017 through December 22, 2017;⁶⁴
- The October 23, 2017 email regarding “Your New Droplet: Suitework”;⁶⁵ and
- The December 4, 2017 estimate regarding a SUITEWORK logo sign.⁶⁶

The Board may consider evidence and testimony beyond the filing date of the application to infer Opposer’s bona fide intent to use the mark at the time he filed the application.

⁶⁰ Opposer’s Discovery Dep., pp. 76-77 (35 TTABVUE 91-92). Opposer contends that the website may have been operational in January 2018 but the source of his contention is unclear and he has no supporting documentation. *Id.* at pp. 111-114 (35 TTABVUE 105-108).

⁶¹ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 107).

⁶² Opposer’s Testimony Decl. Exhibit 3 (34 TTABVUE 80-81).

⁶³ Opposer’s Testimony Decl. Exhibit 3 (34 TTABVUE 82).

⁶⁴ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 83-101).

⁶⁵ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 102).

⁶⁶ Opposer’s Testimony Decl. Exhibit 4 (34 TTABVUE 103-106).

In determining the sufficiency of evidence of bona fide intent, the Trademark Act does not expressly impose “any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record.” *Lane* 33 USPQ2d at 1356. *See also Honda Motor Co.*, 90 USPQ2d at 1662. We have previously addressed the contemporaneousness of evidence (and corroboration thereof) in considering evidence which postdates the filing of an application. *Compare Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1474 (TTAB 2013), *aff'd*, 114 USPQ2d 1892 (Fed. Cir. 2015) (documents created seven months after application date were relevant to intent at time of filing), and *Lane*, 33 USPQ2d at 1355 (correspondence that occurred nine to eleven months after date was sufficiently contemporaneous), *with Swiss Grill Ltd.*, 115 USPQ2d at 2009 (vague claims about communications, meetings or events which took place one or two years after filing date, and which were uncorroborated by any other evidence of intent, insufficient to show bona fide intent at time of filing), and *Bos. Red Sox Baseball Club LP*, 88 USPQ2d at 1587 (Internet searches and investigations conducted more than two years after application filing date “not even remotely contemporaneous with” filing date).

A&H Sportswear, 2019 USPQ2d 111513, at *4.

“[L]ook[ing] at the evidence as a whole, as if each piece of evidence were part of a puzzle [to be] fitted together,” *W. Fla. Seafood, Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994), we find that Opposer purchased the building at 3940 Alma Road, Plano, Texas, for the dual purpose of housing his medical practice and for providing shared office space services for which he, with the input of his family, ultimately selected the mark SUITEWORK.

Applicant argues that Opposer did not intend to use the mark SUITEWORK; rather, Opposer actually intended to use the term ROWLOCK as demonstrated by

the ROWLOCK sign featured on Opposer's property at 3940 Alma Road and in the architectural renderings of the interior space.⁶⁷ Opposer's bona fide intent to use the term ROWLOCK for providing shared office space services does not preclude Opposer from having a bona fide intent to use another mark. Indeed, an applicant can file more than one intent-to-use application covering the same goods or services and still have the requisite bona fide intention to use each mark. *Commodore Elecs.*, 26 USPQ2d at 1506 n.7 (quoting S. Rep. No. 100-515, 100th Cong. 2d Sess. at 24-25 (1988)).

An applicant's bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing). Thus, an applicant could, under certain circumstances, file more than one intent-to-use application covering the same goods and still have the required bona fide intention to use each mark. However, if a product has already been marketed under one mark and an applicant continues to maintain additional applications for marks intended for use on or in connection with the same product, without good cause, this may call into question the bona fide nature of the intent. In addition, an applicant's bona fide intent must reflect an intention to use the mark in the context of the legislation's revised definition of "use in commerce," that is, use "in the ordinary course of trade, commensurate with the circumstances and not [made] merely to reserve a right in a mark." This bona fide intention to use must be present for all the goods or services recited in the application.

Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 24-25 (Sept. 15, 1988).

⁶⁷ Applicant's Brief, pp. 14-15 (46 TTABVue 15-16).

The House also expressly mentioned that an applicant could have a bona fide intent to use and apply to register more than one mark for the same product or service:

The Committee recognizes that this system may allow a person, under certain circumstances, to apply to register more than one mark. For example, an applicant in good faith may apply to register more than one mark because he or she is unable to determine without test-marketing which mark will be the most commercially viable. The requirement that the intention be bona fide will reduce the risk of stockpiling of marks by someone who lacks the requisite intention.

House Judiciary Committee Report on H.R. 5372, H.R. No. 100-1028, p. 9 (Oct. 3, 1988).

As noted above, Hayden Realty, LLC owns the building at 3920 Alma Road and Opposer has not decided whether he will have Hayden Realty or his orthopedic practice render the office sharing services. Accordingly, Applicant argues that Opposer does not have a bona fide intent to use the mark in commerce as an individual.⁶⁸ In support, Applicant contends that all of the activities which Opposer cites as support for Opposer's alleged intent to use the mark SUITEWORK were billed to or paid by the Hayden Realty LLC or Onto Medical, Opposer's orthopedic practice. *See, e.g.,*

- Cinemation billed Onto Medical for the renderings of Opposer's office space in October 2016;⁶⁹

⁶⁸ Applicant's Brief, pp. 15-16 (46 TTABVUE 16-17).

⁶⁹ Opposer's Discovery Dep., 84-85 and Exhibit 20 (35 TTABVUE 94-95 185).

- Hayden Reality payed the Cinemation invoice;⁷⁰
- Opposer's son Dallas Hayden created the site map for the SUITEWORK website.

Dallas Hayden, M.D., P.A. employs Dallas;⁷¹ and

- Opposer's daughter Piper Hayden worked on the above-noted renderings and the website. Hayden, M.D., P.A. compensated Piper.⁷²

The entity with a bona fide intent to use the mark is the proper applicant. *See, Hole in One Drinks Inc. v. Lajtay*, 2020 USPQ2d 10020, at *9-10 (TTAB 2020) (petitioner Hole in One Drinks was formed with Respondent and Darryl Cazares as “co-managers.” “In sum, Respondent filed the intent-to-use application in his own name, even though Respondent and Darryl Cazares were negotiating or had already agreed to form Hole-In-One Drinks, LLC, the entity through which they intended to sell HOLE IN ONE branded beverages.... Respondent did not intend to use the HOLE IN ONE trademark by himself at the time he filed the underlying application in his own name; he intended to use it with Darryl Cazares, to form Hole-In-One Drinks, LLC, and to market HOLE IN ONE beverages through that company.”); *Am. Forests v. Sanders*, 54 USPQ2d 1860, 1862 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (“[I]f it is a corporation or partnership which has the bona fide intention to use a particular mark, and yet the intent-to-use application is filed in the name of an individual, then said application will be deemed to be void ab

⁷⁰ Opposer's Discovery Dep., p. 86 (35 TTABVUE 96).

⁷¹ Opposer's Discovery Dep., p. 89 (35 TTABVUE 99).

⁷² Opposer's Discovery Dep., pp. 89-90 (35 TTABVUE 99-100).

initio.”). Here, Opposer filed the intent to use application in his own name because he had not formed a business to rent individual office space in a shared office space setting; his thinking was “the business for that will either be Hayden Realty or Hayden, M.D., P.A., one of the two.”⁷³

Opposer’s trial testimony contradicts his discovery deposition testimony.

At the time I filed the application for the SUITEWORK Mark on August 2, 2017, I intended to commercially use the SUITEWORK Mark in connection with all of the services named in my trademark application (I did not intend for a specific business to use the SUITEWORK Mark), and I intended to fully control all development and use of the SUITEWORK Mark. No other person or entity-to-date has had any control over the development or use of the SUITEWORK Mark.⁷⁴

Opposer further testifies as to how he intends to provide shared office space services:

One of my companies, Hayden Realty, LLC, is the owner of the property at 3920 Alma Road, Plano, Texas (the “Property”), where I plan to use the SUITEWORK Mark in connection with coworking services and rental of office space on one side of the Property, and where I plan to operate an orthopedic surgery practice through my company Shawn A. Hayden, MD, PA on the other side. I fully control the services offered by Hayden Realty LLC and Shawn A. Hayden MD, PA. It was my intent to pay rent to Hayden Realty LLC for the other side of the Property designated for the SUITEWORK Mark’s services, and for Shawn A. Hayden MD, PA to pay rent for the other side of the Property designated for the orthopedic surgery services.⁷⁵

⁷³ Opposer’s Discovery Dep., p. 21 (35 TTABVUE 67).

⁷⁴ Opposer’s Testimony Decl. ¶ 5 (34 TTABVUE 3).

⁷⁵ Opposer’s Testimony Decl. ¶ 6 (34 TTABVUE 3).

It is clear from the record that Opposer is the “leading light” or owner of a family enterprise engaged in an orthopedic medical practice and an associated real estate company from which Opposer renders his orthopedic medical practice. At the time Opposer filed his application, he had a bona fide intent to use the mark by himself, through his medical practice or through his realty company all of which he controlled. Opposer, his medical practice and his realty company are for all practical purposes the same entity. *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011) (“[T]he testimony of the witnesses demonstrates that petitioner is a family-owned and run business and that there is a unity of control.”); *Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1984 (TTAB 2010) (“Dr. Wiesman has been the central figure of what can be characterized as a number of research and development projects that are ultimately marketed by separate entities. ... the mark points to a single source: that is, the use of the SAVE mark was for the benefit of and inured to the benefit of Dr. Wiesman through his conglomerate.”); *Airport Canteen Servs., Inc. v. Farmer’s Daughter, Inc.*, 184 USPQ 622, 627 (TTAB 1974) (“It is clear from the record that Mr. Guagenti has been the leading light or owner of what can be considered to be family enterprises or, if you will, corporate sales, and that, for purpose of convenience, he, at the advice of counsel or accountant, transferred ownership of his various interests to one or another of his corporations without disturbing, and that is the important fact, the continuance of operation of his different activities including that of the “FARMER’S DAUGHTER” restaurant. It is apparent that there was not nor is there any claim of

adverse rights in the mark “FARMER’S DAUGHTER” by any corporation within Mr. Guagenti’s organization and that, in essence, any use of the mark by any of the corporations was for the benefit of and inured to the benefit of Mr. Guagenti. ... The determination by Mr. Guagenti in 1965 or 1966 that the title of “FARMER’S DAUGHTER” restaurant be vested in Sir Beef Industries, Inc. manifestly does not, under the circumstances herein, constitute fraud.”). Accordingly, Opposer had a bona fide intent to use the mark at the time he filed his application although he might not have been entirely sure as to how he was going to go about it.

We find that Opposer had a bona fide intent to use his mark SUITEWORK at the time he filed the underlying application for Registration No. 6441290. Accordingly, we deny Applicant’s counterclaim to cancel Opposer’s registration.

IV. Opposer’s entitlement to a statutory cause of action to maintain the opposition.

As noted above, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), “[T]he file ... each registration against which a ... counterclaim for cancellation is filed forms a part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.” Accordingly, Opposer’s pleaded registration, the subject of Applicant’s counterclaim for cancellation, is of record.

Because Opposer’s pleaded registration is of record, Opposer has established his entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff’s registrations and the products sold under the mark they register suffice to establish plaintiff’s direct commercial

interest and its standing to cancel respondent's registration); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (finding standing based on prior registration but not priority of use) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)); *Primrose Ret. Cmty.*, 122 USPQ2d 1030, 1032 (TTAB 2016) (standing established based on pleaded registration made of record).

Once an opposer has demonstrated its entitlement to a statutory cause of action in connection with any ground on which it bases the opposition, it may rely on any other statutory ground which negates the applicant's right to registration and may invoke the general public interests in support of its claim. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); *Lipton Indus.*, 189 USPQ at 190 (CCPA 1982); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1638 (TTAB 1988).

V. Whether Applicant's mark WORKSUITES is merely descriptive.

Unless it has acquired secondary meaning,⁷⁶ a mark may not be registered on the principal register if, "when used on or in connection with the [services] ... of the applicant[,] the mark is "merely descriptive ... of them." Section 2(e)(1) of the Trademark Act. A mark is merely descriptive if it "consists merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark." *DuoProSS Meditech Corp. v. Inviro Medical Devices*,

⁷⁶ Applicant has not claimed that its proposed mark acquired secondary meaning in the application or this proceeding.

Ltd., 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed. Cir. 2004)).

The determination of whether a proposed mark is merely descriptive is made in relation to an applicant's services, not in the abstract. *DuoProSS*, 103 USPQ2d at 1757. "The question is not whether someone presented with only the mark could guess what the ... services are. Rather, the question is whether someone who knows what the ... services are will understand the mark to convey information about them." *Id.* (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

"The line between a mark that is merely descriptive and may not be registered absent secondary meaning, and one that is suggestive and may be registered, is that a suggestive mark 'requires imagination, thought and perception to reach a conclusion as to the nature of the ... [services],' while a merely descriptive mark 'forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the ... [services].'" *DuoProSS*, 103 USPQ2d at 1755 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976))).

Any competent source suffices to show the relevant purchasing public's understanding of a contested term, including purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (citing *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 2000)), as well as "advertising material

directed to the ... [services].” *In re Abcor*, 200 USPQ at 218. The public’s understanding of the term also may be obtained from websites and publications, and an applicant’s own specimen[s] of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

“When determining whether a mark is merely descriptive, the Board must consider the commercial impression of a mark as a whole. ... Because a mark must be considered as a whole, the Board may not ‘dissect’ the mark into isolated elements.” *DuoProSS*, 103 USPQ2d at 1756 (internal citation omitted). On the other hand, we may consider the significance of each element separately in the course of evaluating the proposed mark as a whole. *Id.* at 1757 (noting that “[t]he Board to be sure, can ascertain the meaning and weight of each of the components that makes up the mark.”). Thus, “[w]hen two or more merely descriptive terms are combined, ... [i]f each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive.” *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012). Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise non-descriptive meaning in relation to the services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 383, 384 (CCPA 1968); *In re Positec Grp. Ltd.*, 198 USPQ2d 1161, 1162-63 (TTAB 2013).

“Whether a mark is merely descriptive or not is ‘determined from the viewpoint of the relevant purchasing public.’” *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d

1087, 1090 (Fed. Cir. 2005) (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)). Consistent with Applicant's identification of services as "providing virtual office services" and "leasing of executive office space" and shared working facilities in the nature of co-working office space," as well as Applicant's website,⁷⁷ the relevant purchasing public are individuals and businesses looking to lease offices and executive suites.

DFW and Houston, TX office space and executive suites for rent

Showing 20 WorkSuites executive business centers with office space for rent in DFW and Houston, TX. Looking for small office space for rent near your home? Searching for swing space or a spec suite for a corporate team?

WorkSuites makes renting private offices and executive suites east [sic], Rent just the amount of space you need for hours, months, or years. Whether you need an executive suite for one, a private office for three or saving space for your whole company, WorkSuites has the workspace you need.⁷⁸

What is a Virtual Office?

Need a headquarters or local branch for your business, but don't need a physical office every day? A virtual office gets you a prestigious business address for mail and package reception a professional business office with multiple rooms in which to meet your clients, and even a live receptionist to greet your clients and answer your telephone calls. And now, all our virtual office packages include coworking memberships to give you a place to stop in and work from time to time. Take your small business to

⁷⁷ 35 TTABVUE 418-437.

⁷⁸ 35 TTABVUE 421.

the next level and supplement your home office with a virtual office from WorkSuites.⁷⁹

THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (ahdictionary.com) defines “Work,” inter alia, as “a trade, profession, or other means of livelihood” and “one’s place of employment.”⁸⁰

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) defines the word “Suite,” inter alia, as “a group of rooms occupied as a unit.”⁸¹

The term WORKSUITES used in connection with “providing virtual office services” and “leasing of executive office spaces” directly conveys to persons interested in leasing offices and executive suites that the services identified by the term are a group of rooms for conducting business. Each word in the compound term retains its original dictionary meaning. The compound term does not create a new commercial impression different from the individual terms, nor does the compound term create an incongruous or non-descriptive meaning.

Applicant “emphasizes” that the Examining Attorney determined that WORKSUITES is inherently distinctive because the Examining Attorney did not refuse to register the mark as being merely descriptive under Section 2(e)(1) of the Trademark Act.⁸² However, the Board is not bound by the decisions of examining

⁷⁹ 35 TTABVUE 426.

⁸⁰ 33 TTABVUE 148.

⁸¹ 35 TTABVUE 416. *See also* THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (33 TTABVUE 149) (“A series of connected rooms, as in a hotel or office building, used as a single unit.”).

⁸² Applicant’s Brief, pp. 34-35 (46 TTABVUE 35-36).

attorneys. *Nett Designs*, 57 USPQ2d at 1566 ; *Super Bakery, Inc. v. Benedict*, 96 USPQ2d 1134, 1135 n.1 (TTAB 2010). The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by an examining attorney. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

Applicant argues that “the myriad of possible connotations of ‘work’ and ‘suites’ whether as separated terms or taken together as a composite word mark strongly indicate that Applicant’s WORKSUITES Marks do **not** convey any immediate or direct idea of a quality, characteristic, feature or function of Applicant’s services,” and, therefore, requires “a multi-stage reasoning process to determine the nature of Applicant’s services.”⁸³ We disagree. As noted above, the descriptiveness analysis is made in relation to an applicant’s services, not in the abstract, *DuoProSS*, 103 USPQ2d at 1757; that is, whether WORKSUITES conveys information about “providing virtual office services” and “leasing of executive office space.” An individual or business looking for virtual office services or executive office space does not have to exercise a multi-stage reasoning process to understand that WORKSUITES means a group of rooms for conducting business.

Applicant contends the renown of the WORKSUITES mark demonstrates that the mark is inherently distinctive.

Moreover, Applicant submits that its WORKSUITES Marks and Applicant’s services rendered in commerce for more than 3.5 years in connection with such marks have received voluminous unsolicited media coverage in a wide

⁸³ Applicant’s Brief, p. 35 (46 TTABVUE 36).

array of journals, newspapers and industry publications during that time, with such unsolicited media publications serving to highlight the impact of Applicant's advertisements under its WORKSUITES marks on the relevant industry and the distinctiveness of Applicant's marks as readily-identifiable exclusive source indicators for the public concerning Applicant's particular services.⁸⁴

Applicant is conflating acquired distinctiveness with inherent distinctiveness. Fanciful, arbitrary and suggestive words are regarded as being "inherently distinctive" and because of their nature serve to identify a particular source of a product or service. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1084 (1992) ("The ... three categories of [suggestive, arbitrary and fanciful] marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.").

If a proposed mark is not inherently distinctive, it may be registered on the Principal Register upon a showing of acquired distinctiveness; that is, proof that the proposed mark has become distinctive as applied to the goods or services of the applicant. Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f) ("nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."). The purpose and significance of acquired distinctiveness or secondary meaning may be described as follows:

A term which is descriptive . . . may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and*

⁸⁴ Applicant's Brief, pp. 36-37 (TTABVUE 37-38).

Trademarks at §37 (1947). This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 173 USPQ 820, 823 (SDNY 1972).

Here Applicant's evidence of the renown of its WORKSUITES marks goes to whether WORKSUITES has acquired distinctiveness, not whether WORKSUITES is inherently distinctive. In this regard, Applicant did not plead as an affirmative defense, that its WORKSUITES mark has acquired distinctiveness and, therefore, that issue has not been tried and is not before us.⁸⁵

Finally, Applicant contends that the 11 "executed consumer testimonials" Applicant introduced is evidence that its WORKSUITES mark is inherently

⁸⁵ If Applicant wished to prove that WORKSUITES acquired distinctiveness, it should have pleaded, in the alternative, an affirmative defense that if WORKSUITES is found to be merely descriptive, it has acquired distinctiveness, otherwise Opposer is not on notice that Applicant is claiming its mark has acquired distinctiveness. *See Colonial Arms Corp. v. Trulock Firearms Inc.*, 5 USPQ2d 1678, 1680 n.5 (TTAB 1987). *See also Perma Ceram Enters. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1139 n.13 (TTAB 1992) ("Although the application did not include a Section 2(f) claim, the defense of acquired distinctiveness clearly could have been raised.") (citing *Colonial Arms, supra*).

distinctive.⁸⁶ Nine of the declarations are by Applicant's clients in various fields and two are by vendors who all testified as follows:⁸⁷

I believe the WORKSUITES marks are inherently distinctive trademarks for the WORKSUITES services and that such marks exclusively and immediately identify WorkSuites as the source of the WORKSUITES services. The WORKSUITES marks are recognized by me, the Company and other consumers in the co-working office space industry as identifying WorkSuites as the exclusive source of high-quality and well-respected services in that industry.

None of the declarants testified as to the meaning of the term "inherently distinctive," how they came to understand the meaning of the term "inherently distinctive," or the reasons upon which they base their conclusion that WORKSUITES is inherently distinctive. Accordingly, these conclusory declarations have little, if any, probative value with respect to whether WORKSUITES is inherently distinctive.

We find that Applicant's proposed mark WORKSUITES is merely descriptive. Therefore, we sustain the opposition to register WORKSUITES in standard characters (Serial No. 87822414) and WORKSUITES and design (Serial No. 87822428) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

However, with respect to Serial No. 87822428 for the mark WORKSUITES and design, if Applicant submits the required, properly worded disclaimer to the Board within 30 days from the date of this decision and prior to filing any appeal of this decision, the requirement for the disclaimer will have been met. Trademark Rule

⁸⁶ Applicant's Brief, p. 37 (46 TTABVUE 38).

⁸⁷ 39 TTABVUE.

2.142(g), 37 C.F.R. § 2.142(g); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1218 (2021). The disclaimer should read as follows: “No claim is made to the exclusive right to use WORKSUITES apart from the mark as shown.” TMPEP § 1213.08(a)(i). The submission of the required disclaimer, however, will not overcome the refusal to register under Section 2(d) of the Trademark Act and does not serve to toll the time to appeal the Board’s decision.

Opposer argues to the contrary asserting that with respect to the composite WORKSUITES and design mark, “Applicant’s small and simple geometric shape preceding the mark is not distinctive on its own.”⁸⁸ We disagree. While common geometric shapes such circles, squares, rectangles, triangles, and ovals, when used as backgrounds for the display of a word marks or standing alone, are not regarded as trademarks for the goods or services in connection with which they are used absent evidence of acquired distinctiveness, if the design is inherently distinctive, the mark may be registered. *In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998).

First, Opposer did not introduce any evidence to prove that Applicant’s diamond/chevron design is a common geometric shape. Based on the record before us, Applicant is the only entity that uses this shape.

Second, Applicant’s diamond/chevron design, reproduced below, accompanying the term WORKSUITES, is sufficiently distinct that it engenders a commercial impression separate and apart from the term WORKSUITES.

⁸⁸ Opposer’s Brief, pp. 26-27 (43 TTABVUE 27-28).



The design is more than an ornamental design. It is not merely decorative. It is not a background design. Consumers will perceive it to be Applicant's logo used in conjunction with the term WORKSUITES. *See Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994) (“[t]he focus of the inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive.”). Accordingly, should Applicant prevail on Opposer's likelihood of confusion claim, then it may register the composite WORKSUITES and design mark if it disclaims the exclusive right to use WORKSUITES.

VI. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a trademark that “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” Section 3 of the Act extends this provision to services. Thus, there are two elements which must be proved to succeed on the ground of likelihood of confusion: priority and likelihood of confusion.

A. Priority

Because Opposer's registration is of record in accordance with Trademark Rule

2.122(b)(1) and the counterclaim denied, priority is not an issue as to the mark and the services covered by the registration. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 110 (CCPA 1974)).

B. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding

the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

1. The similarity or dissimilarity and nature of the services.

Applicant is seeking to register its WORKSUITES marks for the services listed below:

Providing virtual office services, namely, virtual office services featuring physical mailing addresses, mail handling, digital mailboxes, telephone answering services; Procurement and supply services, namely, the purchasing and supply of furniture and office equipment for others, in International Class 35;

Leasing of executive office space and shared working facilities in the nature of co-working office space, namely, offices, desk spaces, work spaces, conference rooms, meeting rooms, training rooms, kitchen spaces and videoconferencing facilities, in International Class 36.

Opposer has registered his mark for the services listed below:

Business management services, namely, managing office functions in the nature of providing secretarial and clerical

services; telephone answering and operator services; computer data entry services; mail sorting, handling and receiving services; leasing of office equipment; appointment scheduling services in the nature of scheduling use of office, break, and conference rooms for others; procurement services, namely, purchasing furniture and telephone systems for others; data processing services, in International Class 35;

Rental of office space; Rental of offices for co-working, in International Class 36; and

Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Providing facilities and equipment for telepresence conferencing; Providing facilities and equipment for video conferencing, in International Class 38.

The activities comprising the services in International Class 35 are in part legally identical. Applicant's "procurement and supply services, namely, the purchasing and supply of furniture and office equipment for others" and Opposer's "procurement services, namely, purchasing furniture and telephone systems for others" are the same activity. In addition, Applicant's "providing virtual office services, namely, virtual office services featuring physical mailing addresses, mail handling, digital mailboxes, telephone answering services" is the same as Opposer's "managing office functions in the nature of providing secretarial and clerical services; telephone answering and operator services; ... mail sorting, handling and receiving services."

Likewise, the activities comprising the services in International Class 36 are in part legally identical. Opposer's "rental of office space; rental of offices for co-working" encompasses Applicant's "leasing of executive office space and shared working facilities in the nature of co-working office space."

Because the services are in part legally identical, this *DuPont* factor weighs heavily in favor of finding likelihood of confusion.

2. Established, likely-to-continue channels of trade and classes of consumers.

Because the services described in the applications and Opposer's registration are in part legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods...."); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd mem.* (No. 18-2236) (Fed. Cir. September 13, 2019) ("Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same."); *Primrose Retirement Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016) ("Given the identity of the services, at least in part, and the lack of restrictions on trade channels and classes of consumers in the recitations of services, we presume that these services travel through the same channels of trade . . .").

This *DuPont* factor weighs in favor of finding likelihood of confusion.

3. The conditions under which and customers to whom sales are made.

Applicant argues that consumers will exercise a high degree of purchasing care when selecting the source of an office sharing lease.⁸⁹

Individuals who rent office space are relatively sophisticated consumers, with Applicant's customers for its services under its WORKSUITES Marks being primarily comprised of educated professionals including attorneys, therapists, counselors, accountants and entrepreneurs. ... In the Dallas area, monthly rental of private office space ranges from about \$500 to over \$3,500 at Applicant's locations. ... Given the cost of such services, consumers understandably take significant care and analysis before deciding on the company from which they will rent co-working office space.⁹⁰

In response, Opposer argues, without any supporting evidence, that relevant users of shared office space services primarily are interested in cost and, therefore, impulse or casual purchasers are more common than Applicant claims.⁹¹ "Attorney argument is no substitute for evidence." *Cai*, 901 F.3d 1367, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

By the inherent nature of the services, relevant consumers will exercise a high degree of purchasing care when selecting a vendor providing a shared office environment. Therefore, this *Dupont* factor weighs against finding a likelihood of confusion.

⁸⁹ Applicant's Brief, p. 34 (46 TTABVUE 35).

⁹⁰ Howard Testimony Decl. ¶ 11 (36 TTABVUE 5-6).

⁹¹ Opposer's Reply Brief, p. 20 (47 TTABVUE 21).

4. The strength of Opposer’s SUITEWORK mark.

Applicant contends that Opposer’s SUITEWORK mark is a weak mark entitled only to narrow scope of protection because there are more than 90 registered marks “utilizing ‘WORK’ and/or ‘SUITE’ as principal trademark elements in the field of office space leasing or co-working space services.”⁹² Applicant cites to the copies of the registrations it introduced via notice of reliance.⁹³ We disagree.

First, we note that none of the marks of third-party registrations Applicant introduced include both “Work” and “Suite.” The only marks that include both words are Applicant’s marks and Opposer’s mark. As a result, none of the registered third-party marks are as close to Opposer’s mark as Applicant’s marks.

Second, consumers will perceive SUITEWORK as a play on the term “Sweet Work” as in pleasing work. *See In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 (TTAB 2008) (holding THE FARMACY not merely descriptive of retail store services featuring natural herbs and organic products because it’s not just a misspelling of “pharmacy” but also a play on the “farm-fresh characteristics of applicant’s herbs and organic products.”); *In re Grand Metropolitan Foodservices Inc.*, 30 USPQ2d 1974, 1975 (TTAB 1994) (Applicant’s “MuffFuns” (stylized) mark has a different commercial impression than the generic term “muffin”). Thus, consumers will perceive SUITEWORK as more than simply a group of work offices.

⁹² Applicant’s Brief, p. 31 (46 TTABVUE 32).

⁹³ 35 TTABVUE 9-12 and 195-373.

We find that Opposer's mark is entitled to the normal scope of protection accorded an inherently distinctive mark.

5. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Inn at St. John's*, 126 USPQ2d at 1746 (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 are mindful that where, as here, the services are in part legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

"The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We keep in mind that "[s]imilarity is

not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

We begin by recognizing the obvious: Opposer’s SUITEWORK mark and Applicant’s WORKSUITES marks share the terms “SUITE(S)” and “WORK,” simply in reverse or transposed order. Marks that include “reverse combinations” of the same words or elements or a “transposition” of the most important words comprising the marks have been found to be similar. *See Made in Nature, LLC v. Pharmavite LLC*, 2020 USPQ2d 557, at *39 (TTAB 2022); *Bank of Am. Nat’l Trust and Sav. Ass’n v. Am. Nat’l Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (“the words ‘BANKAMERICA’ and ‘BANK OF AMERICA’, on the one hand, and ‘AMERIBANC’, on the other, convey the same meaning and create substantially similar commercial impressions”).

Where transposed marks convey similar commercial impressions, likelihood of confusion is ordinarily found. *See Carlisle Chem. Works, Inc. v. Hardman & Holden*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (reversing dismissal of oppositions to registration of COZIRC based on use of ZIRCO for related goods, finding that the marks “are substantially similar, the difference being in a reversal of syllables which are essentially the same.”); *Royal Crown Cola Co. v. Bakers Franchise Corp.*, 150 USPQ 698, 700 (TTAB 1966), *aff’d*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (“[T]he applicant’s compound mark includes the same words which make up opposer’s mark, that is to say ‘RITE DIET’ is merely ‘DIET-RITE’

transposed. The marks of the parties create substantially the same commercial impressions"); *Plus Prods. v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978) ("Use of identical terms in inverse order as we have in the present case is likely to cause confusion in trade when used on such closely related cosmetic products"); *Fisher Sci. Co. v. Ipco Hosp. Supply Corp.*, 165 USPQ 471, 472-73 (TTAB 1970) (sustaining opposition to MIX O THERM based on THERMIX used for identical goods, stating "they are in their essentials merely reverse combinations of the same words, and such being the case, would more than likely convey substantially the same commercial impressions.").

As discussed above, the relevant consumers will exercise a high degree of purchasing care when selecting a provider of a shared office space environment. In this regard, consumers will recognize the double entendre that SUITEWORK is a sweet place to work, but also a suite for work. As discerning consumers, they will likely focus on the literal meaning of the term which is similar to the meaning and commercial impression engendered by Applicant's marks WORKSUITES.

We moreover find the design elements present in Applicant's WORKSUITES and design mark are not sufficient to distinguish the marks. "In marks 'consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021) (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018)).

Further, Opposer's SUITEWORK word mark is presented in standard characters which "may be presented in any font style, size or color, including the same font, size and color as the literal portions of [Applicant's composite] mark," *Sabhnani*, 2021 USPQ2d 1241, at *34 (citing *In re Aquitaine Wine*, 126 USPQ2d at 1186), and in "the same stylization actually used or intended to be used by [Applicant], or one that minimizes the differences or emphasizes the similarities between the marks." *Id.* at *34-35 (citing *Anheuser-Busch, Inc. v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015)).

Despite Opposer's SUITEWORK mark being a play on the term "Sweet Work," both Opposer's mark and Applicant's mark WORKSUITES mean and engender the commercial impression of a group of business offices. Here, where the services are in part legally identical, where Opposer's mark is not inherently weak, and consumers will perceive both marks as signifying a group of business offices, the marks are more similar than dissimilar.

We find that the marks are similar in terms of appearance, sound, connotation and commercial impression.

6. Lack of any reported instances of confusion.

Neither party is aware of any reported instances of actual confusion.⁹⁴ However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its marks for a significant

⁹⁴ Opposer's response to Applicant's interrogatory No. 10 (35 TTABVUE 49); Opposer's response to Applicant's request for admission No. 14 (35 TTABVUE 46); Howard Testimony Decl. ¶ 19 (36 TTABVUE 8).

period of time in the same markets as those served by Opposer under his mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *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); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

The eighth *Dupont* factor, “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” “requires us to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Joel Embiid*, 2021 USPQ2d 577, *39 (TTAB 2021) (quoting *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at * 6 (TTAB 2020); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at * 17 (TTAB 2020).

Philip Howard, Applicant’s Chief Executive Officer, testified that “[s]ince at least as early as March 2018,” Applicant has rendered its applied for services under its

WORKSUITES marks.⁹⁵ As of July 30, 2021 (the declaration date), Applicant has 20 rental locations in Texas cities, including Dallas, Houston, Plano, Irving, and Fort Worth, offering 1,613 offices.⁹⁶ Applicant spends more than \$500,000 per year marketing and promoting its WORKSUITES shared office space services, including displaying the mark on “well-known office buildings” in Texas.⁹⁷ As of May 2021, Applicant has “actively engaged with 4,266 clients in providing of its services in commerce under its WORKSUITES Marks.”⁹⁸

On May 13, 2021, Opposer, in his personal capacity, signed a lease for a commercial property in Sherman, Texas, that allows for co-working subtenants. On May 15, 2021, Opposer and Shawn A. Hayden, MD PA signed an “Office Space License Agreement” granting a sublease to use a portion of the SUITEWORK office.⁹⁹ Thus, Opposer first used his SUITEWORK mark in connection with his office sharing services rendered in commerce on May 15, 2021.

At his June 12, 2020 discovery deposition, Opposer testified that he has not conducted any kind of media advertising to promote his SUITEWORK services.¹⁰⁰ Opposer’s website advertises introduced as an exhibit to the Howard declaration indicates that space is available at Opposer’s Sherman, Texas, location and that space

⁹⁵ Howard Testimony Decl. ¶ 8 (36 TTABVUE 3).

⁹⁶ Howard Testimony Decl. ¶ 9 (36 TTABVUE 4).

⁹⁷ Howard Testimony Decl. ¶ 9 (36 TTABVUE 4).

⁹⁸ Howard Testimony Decl. ¶ 9 (36 TTABVUE 4).

⁹⁹ Opposer’s Testimony Decl. ¶ 9 and Exhibit 6 (34 TTABVUE 4 and 136-140).

¹⁰⁰ Opposer’s Discovery Dep., p. 68 (35 TTABVUE 89).

will soon be available at the Plano, Texas, location.¹⁰¹ To be clear, however, based on the record before us, the only person to whom Opposer has rendered his services is to his orthopedic medical practice.

As of the close of Applicant's trial period (August 2, 2021), the parties had been simultaneously using their marks for two and one-half months. There is no testimony or evidence regarding Opposer's advertising and marketing of his SUITEWORK office sharing services. Finally, Opposer has rendered his SUITEWORK office sharing services only with his own orthopedic medical practice. Under these circumstances, there has not been a reasonable opportunity for confusion to occur. This *Dupont* factor is neutral.

7. Conclusion.

Because the marks are similar, the services are in part legally identical, and we presume the channels of trade and classes of consumers are the same, we find Applicant's marks WORKSUITES and WORKSUITES and design for the services set forth in the application are likely to cause confusion with Opposer's registered mark SUITEWORK for the services identified in the registration.

Decision: We deny the counterclaim to cancel Opposer's registration.

We sustain the opposition under Section 2(e)(1) on the ground that Applicant's WORKSUITES mark is merely descriptive and the term WORKSUITES in Applicant's composite mark is merely descriptive and may not be registered without a disclaimer of the term "WorkSuites."

¹⁰¹ Howard Testimony Decl. ¶ and Exhibit 12 (36 TTABVUE 9 and 867-873).

We sustain the opposition under Section 2(d) on the ground that Applicant's marks are likely to cause confusion with Opposer's mark.