

**This Opinion is Not a
Precedent of the TTAB**

Mailed: November 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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MG Financial, LLC
v.
Kiran Sureshbhai Shah

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Opposition No. 91250240 (parent)
Opposition No. 91250316

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Marina A. Lewis of Lewis Kent LLP
for MG Financial, LLC.

Alexander Lazouski of Lazouski IP LLC
for Kiran Sureshbhai Shah.

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Before Cataldo, Bergsman, and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

On August 31, 2021, the Board issued a final decision dismissing these consolidated oppositions on the ground that Opposer, MG Financial, LLC, failed to prove its entitlement to a statutory cause of action and that it was entitled to relief under its sole pleaded claim of likelihood of confusion. In a motion filed on September

Opposition Nos. 91250240 (parent) and 91250316

30, 2021, Opposer seeks reconsideration of the final decision.¹ Applicant did not file a brief in opposition to Opposer’s request for reconsideration.² For the reasons explained, we grant the request for reconsideration and sustain the oppositions.

I. Background

On August 14, 2019, Opposer opposed Applicant’s stylized OLD HARBOR marks for, inter alia, “tea,”³ alleging a likelihood of confusion under Section 2(d) of the Trademark Act based on prior use and registration of the mark OLD HARBOR for “coffee,” subject to Registration No. 4976770. In his answers, Applicant admitted that “Opposer is listed as the owner” of the pleaded OLD HARBOR mark “according to the Trademark Status and Document Retrieval (TSDR)” database of the U.S. Patent and Trademark Office. Applicant otherwise denied the salient allegations in the notices of opposition.

During trial, Opposer introduced a copy of the registration certificate for pleaded Registration No. 4976770 issued to “MGF, Financial (Vermont Corporation)” on June

¹ 16 TTABVUE.

² “Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within twenty days from the date of service of the request.” Trademark Rule 2.129(c), 37 C.F.R. § 2.193(c).

³ Application Serial No. 79975456 for the mark **OLD HARBOR** was filed May 9, 2018 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1116(a), seeking an extension of protection of Applicant’s International Reg. No. 1418044, issued May 9, 2018.

Application Serial No. 79975446 for the mark **Old Harbor** was filed March 8, 2018 under Section 66(a) of the Trademark Act seeking an extension of protection of Applicant’s International Reg. No. 1410996, issued March 8, 2018.

Opposition Nos. 91250240 (parent) and 91250316

14, 2016, and a copy of an April 17, 2016 assignment conveying to Opposer “all of [MGF Financial Inc.’s] right, title and interest in and to the Trademark” OLD HARBOR, recorded with the USPTO on August 14, 2019 at Reel/Frame 006720/0539.

In the final decision, we found the registration certificate and assignment, on their own, insufficient to establish the current status and title of the registration in Opposer. We further determined that while Applicant admitted in his answers that “Opposer is listed as the owner of the mark[] according to the Trademark Status and Document Retrieval (TSDR) [database],” Opposer did not plead and Applicant did not admit that the registration is active. Because Opposer failed to prove the subsistence of the pleaded registration and did not introduce any evidence to establish common law rights in its pleaded mark, we dismissed the oppositions.

II. Request for Reconsideration

The premise underlying a request for reconsideration is that, based on the evidence of record before it and prevailing authorities, the Board erred in reaching the decision it issued. The request should not be devoted simply to a re-argument of the points presented in the requesting party’s brief on the case. TRADEMARK TRIAL AND APPEAL BOARD MANUAL (TBMP) § 543 (2020). Nor may a request for reconsideration be used to introduce additional evidence. *Id.*

A. Arguments

Opposer argues that the Board erred in reaching its decision because: (1) the pleaded registration was not yet due for a maintenance filing under Sections 8 or 9 of the Trademark Act so “[t]he only way in which the [Pleaded] Registration would not

have been valid and subsisting ... would have been due to affirmative steps to cancel or surrender the registration (either by Opposer or any third party)” and no such steps had been taken;⁴ and (2) “the statements made by Applicant in [his] Answer[s] to the Notice[s] of Opposition, coupled with the evidence from the file histories of the related parent applications in this proceeding” demonstrate that the pleaded registration is active and owned by Opposer.

B. Analysis

Opposer’s pleaded registration issued on June 14, 2016 and so was less than six years old when the notices of opposition were filed on August 14, 2019.⁵ Accordingly, the pleaded registration would have been active when the notices of opposition were filed unless Opposer or its predecessor-in-interest voluntarily surrendered the registration or a third-party successfully petitioned to cancel it. The conduct of both Applicant and Opposer supports that neither of these events occurred.

The file for each of Applicant’s involved applications is automatically of record in these consolidated opposition proceedings.⁶ Trademark Rule 2.122(b), 37 C.F.R.

⁴ Request for Reconsideration, 16 TTABVUE 4-5. The citations to TTABVUE are to the record in parent Opposition No. 91250240.

Opposer asserts that it submitted with its notices of opposition copies of its certificate of registration and “a printout of the Assignment Recordation Cover Sheet issued by the Assignments Division, showing assignment of the registration to Opposer from its predecessor,” 16 TTABVUE 4, but no such documents were attached to Opposer’s pleadings.

⁵ 12 TTABVUE 6. The registration is still less than six years old.

⁶ Applicant’s involved applications are child applications created after Applicant’s requests to divide were granted in parent application Serial Nos. 79235837 and 79238783 (the “Parent Applications”). Application Serial No. 79975446, March 8, 2019 Notice of Divisional Request Completed, TSDR 1; Application Serial No. 792975456, April 19, 2019 Notice of Divisional Request Completed, TSDR 1. Any documents in the Parent Applications dated after the creation of the involved child applications are not part of the file histories for the involved

Opposition Nos. 91250240 (parent) and 91250316

§ 2.122(b); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009). We focus on the prosecution history of involved application Serial No. 79975456 because the filing date of this application is closest to when the notices of opposition were filed. A relevant timeline is below:

- **September 14, 2018:** An Office action issued refusing registration of Applicant’s mark based on a likelihood of confusion with the mark in Opposer’s pleaded registration.
- **March 14, 2019:** Applicant filed a response to the Office action arguing against a likelihood of confusion with mark in Opposer’s pleaded registration. In his response, Applicant: (1) acknowledged that “[t]he Examining Attorney has cited a prior **existing** registration[],” namely, Opposer’s registration “as [a] barrier[] to registration of the Applicant’s Mark[,]” TSDR 9 (emphasis added); and (2) argued that the goods were different because “[a]t best, and as evidenced by the specimen (Exhibit E) submitted by [Opposer] to prove its use in commerce, [Opposer] provides a brewed coffee service” while “Applicant uses well-marked colorful packaging with elaborate graphics to brand his fine teas, coffees and other dry goods with his Mark prominently displayed.” *Id.* Applicant attached a copy of Opposer’s specimen as Exhibit E to its Office action response.
- **June 18, 2019:** The application was published for opposition.

child applications. Accordingly, we have not considered Opposer’s arguments that rely on such documents.

- **August 14, 2019:** Opposer filed notices of opposition against Applicant's involved applications.

As the above timeline reflects, 5 months before the oppositions were filed, Applicant expressly acknowledged Opposer's pleaded registration as "a prior existing registration[]," responded to the merits of a Section 2(d) refusal based on the pleaded registration, and accessed the Office's file for the pleaded registration to obtain a copy of Opposer's specimen. Applicant's Office action response was filed reasonably contemporaneous with the filing of the notices of opposition and strongly suggests that when Applicant filed his response, Opposer's registration was active and Applicant was aware of the registration's active status. *Cf. Daniel J. Quirk Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's office action response constituted evidentiary admissions against interest falling within the hearsay exception under Fed. R. Evid. 801(d)(2)); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copy of pleaded registration attached to notice of opposition considered of record when issued approximately four months prior to filing date of notice of opposition); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 599 (TTAB 1982) (finding statements in an application "constitute admissions and may be considered as evidence, albeit not conclusive evidence, of the truth of the assertions therein"), *aff'd* 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983).

Moreover, during trial, Opposer properly introduced a copy of an assignment and assignment coversheet reflecting that the pleaded registration was assigned to Opposer on April 17, 2016 and that Opposer recorded the assignment with the Office on the same day the opposition was filed. Common sense suggests that Opposer would not have recorded the assignment if the registration had not been active.⁷ *Cf. Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 USPQ2d 1315 (Fed. Cir. 2010) (finding, in the context of an abandonment claim, that “common sense supports the conclusion that Mattel would not have recorded Tyco’s trademark assignment with the USPTO in 1998 unless it intended to use the CRASH DUMMIES mark within the foreseeable future.”).

C. Conclusion

In sum:

- (1) when the oppositions and answers were filed, the pleaded registration was (and still is) less than six years old and vulnerable to cancellation only through a voluntary surrender of the registration or successful petition for cancellation;
- (2) during prosecution and reasonably contemporaneous with the filing of the notices of opposition, Applicant accessed the file for the pleaded registration and identified and treated the pleaded registration as “existing”; and

⁷ The pleaded registration was the only registration subject to the assignment. Accordingly, this was not a situation where numerous marks were assigned such that the assignment may have been mistakenly recorded against one or more “dead” registrations.

(3) on the same day it filed the oppositions, Opposer recorded with the Office an agreement reflecting that the pleaded registration had been assigned to Opposer.

Considering the totality of the specific circumstances here, including the admission in Applicant's answers that "Opposer is listed as the owner of the [pleaded] mark[] according to [the] Trademark Status and Document Retrieval (TSDR) [database]," we find the evidence sufficient to establish that the pleaded registration is active and owned by Opposer. To find otherwise would work an injustice on Opposer. *Cf. Tiffany & Co. v. Columbia Indus. Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) (finding it "would work an injustice" on the opposer "to deprive it of the right to rely on the statutory presumptions flowing from [the pleaded] registration" where Applicant admitted "the registrations referred to in the notice of opposition" and could not "contend lack of familiarity therewith since that is the registration that was interposed by the examiner during the ex parte examination of the opposed application"). Accordingly, Opposer's request for reconsideration is **granted**.

III. Merits of the Oppositions

A. Entitlement to a Statutory Cause of Action and Priority

Entitlement to a statutory cause of action must be established in every inter partes case.⁸ *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*,

⁸ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 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 "standing" under §§ 1063

Opposition Nos. 91250240 (parent) and 91250316

965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *reh'g en banc denied* 981 F.3d 1083 (Dec. 4, 2020), *petition for cert. filed*, No. 20-1552 (Apr. 28, 2021); (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose an application when the basis for such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 593 U.S. ____ (2021).

Because Applicant admitted Opposer's ownership of the pleaded registration and the evidence demonstrates that the registration is active, Opposer has established its entitlement to a statutory cause of action in these consolidated proceedings. *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (pleaded registration demonstrated entitlement to bring a statutory cause of action); *Barbara's Bakery v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (pleaded registration of record and opposer's likelihood of confusion claim was plausible).

In addition, because Applicant did not counterclaim to cancel Opposer's registration, Opposer's priority is not in issue with respect to Opposer's OLD HARBOR mark for the goods covered by the pleaded registration, namely, "coffee."

and 1064 remain applicable. See *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Opposition Nos. 91250240 (parent) and 91250316

King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

1. Similarity or Dissimilarity of the Marks

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567.

Opposer's mark is OLD HARBOR in standard character form. Applicant's marks consist of the same wording in stylized format. Because Opposer could display its standard character mark in any lettering style or font, including the same style and font as Applicant's marks, the parties' marks are legally identical. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) ("Symbolic does not, and cannot, dispute that the mark, I AM in standard character form, and the registrants' marks, I AM in standard character, typed, or stylized form, are pronounced the same way and, at a minimum, legally identical."); *Squirrco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re Aquitaine Wine*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("Since Registrant's mark is a standard character mark, we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant's mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.").

The first *DuPont* factor therefore heavily favors a likelihood of confusion. The legal identity of the marks also reduces the degree of similarity between the goods required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Entm't. Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

2. Similarity or Dissimilarity of the Goods, Trade Channels and Classes of Consumers

Under the second *DuPont* factor we consider “[t]he similarity or dissimilarity and nature of the goods or services” and under the third *DuPont* factor we consider “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). We must base our comparison of the goods on the identifications in Opposer’s registration and Applicant’s applications. *See Stone Lion*, 110 USPQ2d at 1162; *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The goods need not be identical or directly competitive for there to be a likelihood of confusion. The evidence need only establish that the goods are related in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *Coach Servs. Inc. v. Triumph Learning LLC*, 688 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed in the identification of goods or services in a particular class. *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).

Opposer focuses much of its arguments under the second and third *DuPont* factors on the identification of “tea” in Applicant’s applications. Opposer introduced evidence of 12 third-parties selling both coffee and tea. Nine of these entities incorporate both the terms “coffee” and “tea” in their mark: THE COFFEE BEAN & TEA LEAF, PEET’S COFFEE, ROYAL CUP COFFEE AND TEA, TEMPLE COFFEE ROASTERS, INFUSION COFFEE & TEA CRAFTERS, PASSPORT COFFEE & TEA, JOFFREY’S COFFEE & TEA COMPANY, VAIL MOUNTAIN COFFEE & TEA CO., BARNIE’S COFFEE & TEA CO., PEERLESS COFFEE & TEA, EMPIRE COFFEE & TEA CO., and STARBUCKS. This evidence supports a finding that Opposer’s coffee and Applicant’s tea are the types of goods that commonly emanate from a single source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *10-11 (TTAB 2019) (Internet evidence showing eleven third parties using the same mark for both applicant’s services and registrant’s goods supported finding of relatedness); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015) (relatedness found where Internet evidence demonstrated goods commonly emanated from the same source under a single mark); *see also, e.g., Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (third-party evidence showing applicant’s and registrant’s goods manufactured and sold by a single source bolstered finding of relatedness).

In addition, as discussed, during the prosecution of Applicant's applications, Opposer's mark was cited as a bar to registration under Section 2(d) of the Trademark Act.⁹ Trademark Rule 2.122(b) (the file of an application involved in an opposition is automatically of record "and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section"). In support of the refusals, the Examining Attorney submitted 17 third-party use-based registrations covering both coffee and tea.¹⁰ While third-party registrations are not evidence that the registered marks are in use or that the public is familiar with them, they have probative value to the extent they serve to suggest that the goods listed in the registrations are of a kind that may emanate from a single source. *See, e.g., In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001)); *In re Anderson*, 101 USPQ2d 1912, 1919-20 (TTAB 2012) (numerous third-party registrations probative of relatedness); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (21 third-party use-based registrations probative of relatedness); *In re Albert Trostel*, 29 USPQ2d at 1785-86. The third-party registrations corroborate Opposer's evidence of third-party use of the same mark on coffee and tea.

⁹ Applicant's applications originally included coffee, artificial coffee, and ground coffee beans. Pursuant to Applicant's requests, these goods were divided out and remain in the Parent Applications that are not before us. After the requests to divide were processed, the refusals based on Opposer's mark were withdrawn.

¹⁰ Application Serial No. 79975456, September 14, 2018 Office action, TSDR 6-33 (ten third-party registrations); Application Serial No. 79975446, July 15, 2018 Office action, TSDR 5-25 (seven third-party registrations). All but two of the registrations also cover cocoa, which is identified in Applicant's applications.

Because the identifications of goods in Opposer's registration and Applicant's applications do not include any restrictions or limitations as to trade channels, we presume that Opposer's coffee and Applicant's tea are or would be sold in all normal channels of trade for such goods (e.g. cafes, restaurants, hotels, offices) and to all usual purchasers of such goods (e.g. consumers of hot beverages). *See, e.g., Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1361 (Fed. Cir. 2000) ("When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade."); *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1195 (TTAB 2007) ("Absent any restrictions in the respective applications and registrations, we must presume that applicant's apparel and bags and opposer's apparel are sold through all normal channels of trade for those goods, including all the usual retail outlets."); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages."). The Internet evidence addressed above demonstrates that the involved goods are sold by the same food and beverage retailers and would be encountered by the same purchasers.

Accordingly, the second and third *DuPont* factors also weigh in favor of finding a likelihood of confusion.

C. Conclusion

On the record before us, we find that pleaded Registration No. 4976770 is active and owned by Opposer. Accordingly, Opposer is entitled to bring a statutory cause of action in these consolidated oppositions and has priority in the standard character mark OLD HARBOR for “coffee.”

The parties’ marks are legally identical and Opposer has demonstrated that its “coffee” and Applicant’s “tea” are related goods sold through the same channels of trade to the same class of consumers. Accordingly, we find that there is a likelihood of confusion between the parties’ marks under Section 2(d) of the Trademark Act.

Decision: The oppositions are **sustained**.