

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

Hearing Date: June 14, 2023

Mailed: October 12, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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MI-BOX Moving and Mobile Storage Inc.

v.

MyBox Inc.
—

Opposition No. 91265197
—

Ronald A. DiCerbo of McAndrews, Held & Malloy, Ltd.
for MI-BOX Moving and Mobile Storage Inc.

Deborah J. Peckham, Brooke A. Penrose and Howard J. Susser
of Burns & Levinson LLP
for MyBox Inc.

—

Before Lykos, Pologeorgis and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

MyBox Inc. (“Applicant”) seeks registration on the Principal Register of the
standard character mark MYBOX for:

Modular metallic buildings; transportable metal buildings;
prefabricated metal buildings; relocatable metal buildings, in
International Class 6,

Custom manufacture of modular components of modular buildings,
transportable buildings, prefabricated buildings, and relocatable
buildings, in International Class 40, and

Rental of portable buildings, namely, portable modular buildings, transportable buildings, prefabricated buildings, and relocatable buildings, in International Class 43.¹

In its Notice of Opposition,² MI-BOX Moving and Mobile Storage Inc. (“Opposer”) opposes registration of Applicant’s MYBOX mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods and services identified in the Application, so resembles Opposer’s pleaded standard character mark MI-BOX, registered in connection with “Moving and storage services, namely, rental, storage, delivery and pick up of portable storage units,” in International Class 39,³ as to be likely to cause confusion, mistake, or deception.

Opposer further claims prior common law use of the MI-BOX mark in connection with moving and storage services, namely, rental, storage, delivery and pick up of portable storage units; and portable storage units used as shipping containers, retail or display kiosks, housing event spaces such as retail or display kiosks and meeting spaces at festivals and other outdoor events, dressing rooms at festivals and other outdoor events, stage platforms at festivals and other outdoor events.⁴

¹ Application Serial No. 88383475 was filed on April 12, 2019, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Notice of Opposition, 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

³ Registration No. 3073509 was issued on April 6, 2005; renewed.

⁴ Notice of Opposition, 1 TTABVUE 4-6, ¶¶ 5, 15-22.

Opposer also appears to have attempted to state a claim for dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).⁵ However, if Opposer intended to assert such a claim, it was insufficiently plead. For example, Opposer failed to allege that its MI-BOX mark became famous prior to any date as to which Applicant could establish rights in its MYBOX mark. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012) (“[T]o prevail on a dilution claim ..., a plaintiff must show that: (1) it owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff’s famous mark; (3) the defendant’s use of its mark began after the plaintiff’s mark became famous; and (4) the defendant’s use of its mark is likely to cause dilution by blurring or by tarnishment.”); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1175 (TTAB 2001) (“In the case of an intent-to-use application, an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding.”). Even if we could consider the dilution claim properly plead, Opposer did not pursue this claim in its trial brief; thus it is waived. *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (opposer’s pleaded claims not argued in its brief deemed waived), *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015). We therefore do not consider the dilution claim further.

⁵ Notice of Opposition, 1 TTABVue 10, ¶¶ 60-61.

Applicant denied the salient allegations of the Notice of Opposition in its Answer.⁶

The case is fully briefed,⁷ and the parties participated in a hearing before a panel of the Board. Opposer bears the burden of proving its Trademark Act Section 2(d) claim by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). Having considered the evidentiary record, the parties' arguments and applicable authorities, as explained below, we find that Opposer only partially carried this burden. Thus, we sustain the Opposition as to Applicant's goods and services in Classes 6 and 43, and dismiss the Opposition as to Applicant's services in Class 40.

⁶ Answer, 4 TTABVUE. Applicant also pleaded a number of "affirmative defenses." The first and second defenses, asserting that "Opposer has overstated its rights in the registered [MI-BOX] mark," and that "[t]here is no likelihood of confusion between Applicant's [MYBOX] Mark and the Opposer's [MI-BOX] Mark or any other common law rights" are amplifications of Applicant's denials to the Notice of Opposition, but not true affirmative defenses, and will be treated accordingly. *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, *3-4 (TTAB 2021). The third defense that Opposer failed to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of Opposer's claim rather than a statement of a defense to a properly pleaded claim. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1101 n.6 (TTAB 2018). Because Applicant did not pursue the purported insufficiency of Opposer's pleading by way of motion, or submit a trial brief directed to this claimed deficiency, Applicant waived it. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014). Applicant's bare allegations of unclean hands in its fourth defense were inadequately pleaded. Moreover, Applicant did not pursue this defenses at trial or in its trial brief, and thus it is waived. *Id.* Applicant's attempt, in its fifth defense, to "reserve[] the right, upon completion of discovery, to assert such additional defenses as may be appropriate under the circumstances" is improper and has been given no consideration. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *6 (TTAB 2022).

⁷ The trial briefs of both parties improperly cited to the TTABVUE record, the Board's electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n. 6 (TTAB 2014). While the parties did reference the TTABVUE docket numbers, they failed to cite to the TTABVUE page numbers, referencing testimony only by paragraph numbers and evidentiary material only by exhibit numbers. Referencing the record in this fashion delayed the Board's issuance of this opinion.

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved Application. In addition, the parties introduced the following evidence:

A. Opposer's Evidence⁸

- Non-confidential/redacted and confidential versions of the Trial Declaration of Michael Born ("Born Decl." and "Born Confd'l Decl."), Vice President and Secretary of Opposer, with exhibits [14-25 TTABVUE].
- Opposer's First Notice of Reliance ("ONOR1") on Applicant's interrogatory answers, Applicant's website, and Applicant's Instagram pages [32 TTABVUE].
- Opposer's Second Notice of Reliance ("ONOR2") on a plain copy of Opposer's MI-BOX Registration, the USPTO's Notice of Acceptance of the renewal of the Registration, and the USPTO's Assignment Records pertaining to the Registration [33 TTABVUE].
- Non-confidential/redacted and confidential versions of the Trial Declaration of Richard Robison ("Robison Decl." and "Robison Confd'l Decl."), President and Founder of Mi-Box of San Diego, LLC, a franchisee and licensee of Opposer's parent company, with exhibits [39-40 TTABVUE].
- Non-confidential/redacted and confidential versions of the Trial Declaration of Dale A. Carlton ("Carlton Decl." and "Carlton Confd'l Decl."), President of Mi-Box of Central Illinois, Inc., a franchisee and licensee of Opposer's parent company, with exhibits [41-42 TTABVUE].
- Non-confidential/redacted and confidential versions of the Trial Declaration of Angie Downs ("Downs Decl." and "Downs Confd'l Decl."), Manager of MJ Storage, LLC dba Mi-Box Moving and Mobile Storage of Middle Tennessee, a franchisee and licensee of Opposer's parent company, with exhibits [43-44 TTABVUE].

⁸ Opposer filed its numerous non-confidential exhibits twice. "Suffice it to say, the probative value of documentary evidence does not increase with repetition, it needlessly increases the size of the record, and makes review of the record more difficult." *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *3 (TTAB 2022). Moreover, many of Opposer's exhibits were not properly marked with exhibit numbers, making their identification by the Board needlessly burdensome.

B. Applicant's Evidence

- Trial Declaration of Andrew Williamson (“Williamson Decl.”), President and CEO of Applicant, with exhibits [45 TTABVUE].
- Applicant’s Notice of Reliance (“ANOR”) on Opposer’s interrogatory answers, Opposer’s admissions responses, and third-party registrations [46 TTABVUE].

Notably, neither party cross-examined its adversary’s testimony declarants.

Therefore, the statements made by each party’s trial witnesses stand unrebutted in this proceeding.

II. The Parties

Opposer, MI-BOX Moving and Mobile Storage Inc., is wholly owned by its parent company, MI-BOX Holding Group LLC (“Opposer’s Parent”).⁹ They are related companies under common ownership and control.¹⁰ Opposer is the owner of the MI-BOX mark and Registration asserted in this Opposition.¹¹

Opposer has licensed Opposer’s Parent and other companies to use, and has granted the right to sublicense the use, of the MI-BOX mark on portable shipping and storage containers and trucks, and in connection with the rental, storage, delivery, and pick up of the containers. All use of the MI-BOX mark by Opposer’s Parent and its licensees inures to the benefit of Opposer.¹²

Opposer’s Parent, in turn, has entered into dealership agreements with a number of third parties. Because these agreements and the testimony relating thereto have

⁹ Born Decl., 14 TTABVUE 3-4, ¶¶ 2, 7 and 9.

¹⁰ Born Decl., 14 TTABVUE 4, ¶ 10.

¹¹ Born Decl., 14 TTABVUE 4, ¶ 11; ONOR2, 33 TTABVUE 4-6, Exhs. PX 147-49.

¹² Born Decl., 14 TTABVUE 4-5, ¶¶ 12-14.

been designated confidential, we describe them only in general terms. These dealership agreements (which Opposer and its witnesses alternatively refer to as franchise agreements) license the dealers to use the MI-BOX mark on the containers and trucks, in connection with the rental, storage, delivery, and pick up of the containers, and in materials employed to promote the use and rental of the MI-BOX containers. Under these dealership agreements, all use of the MI-BOX mark by the dealers inures to the benefit of Opposer's Parent and, therefore, the benefit of Opposer.¹³

Applicant supplies modular rental units to others to provide temporary social event spaces. Applicant advertises and offers to provide its rental units as an "event solution" for a variety of social environments and experiences, including for hosting parties, tailgating at sporting events, BBQs, concession stands, bars, retail spaces, at festivals, and at other outdoor events.¹⁴

Applicant's modular rental units are comprised of repurposed shipping containers that have been customized for the express purpose of creating comfortable, but temporary social spaces intended for people to spend time in. Finishing options

¹³ Born Decl., 14 TTABVUE 5, 16, ¶¶ 15, 63; Born Confd'l Decl., 18 TTABVUE 15-17, 125-64, ¶¶ 64-78, 19 TTABVUE 2-106, 20 TTABVUE 2-163, 21 TTABVUE 2-168, 22 TTABVUE 3-25, Exhs. PX 22-54; Robison Decl., 39 TTABVUE 3, ¶ 5; Robison Confd'l Decl., 40 TTABVUE 3, 8-26, ¶¶ 6-11, Exh. PX 49; Carlton Decl., 41 TTABVUE 3, ¶ 6; Carlton Confd'l Decl., 42 TTABVUE 3, 21-39, ¶¶ 7-12, Exh. PX 29; Downs Decl., 43 TTABVUE 3, ¶ 6; Downs Confd'l Decl. 44 TTABVUE 3, ¶¶ 7-12, 9-27, Exh. PX 42; Opposer's Int. Ans. Nos. 1, 4 and 9-11, ANOR, 46 TTABVUE 7-8, 11 and 13-15.

¹⁴ Williamson Decl., 45 TTABVUE 3, 6-27, ¶ 6, Exhs. DX 1-4.

include climate control, wall coverings, flooring, furnishings, lighting, and deck space.¹⁵

Applicant states it has never received an inquiry nor has it actually rented out its modular rental units for storage or moving purposes. Applicant believes it would be impractical its modular rental units to be used primarily to store or move physical property and belongings, as this would present an inherent risk to damaging the finishings incorporated into these rental units.¹⁶

III. Entitlement to Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case. *See 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); *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); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *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)); *Meenaxi Enter., Inc. v.*

¹⁵ Williamson Decl., 45 TTABVUE 3, 28-36, ¶ 7, Exhs. DX 5-6.

¹⁶ Williamson Decl., 45 TTABVUE 3-4, ¶¶ 9-10.

Coca-Cola Co., 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022); *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

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*, 2020 USPQ2d 10837, at *3; *Empresa Cubana*, 111 USPQ2d at 1062. There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277, at *4. Thus, “a party that demonstrates a real interest in [oppos]ing a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3].” *Id.*, 2020 USPQ2d 11277, at *7.

Here, Opposer has “assert[ed] a likelihood of confusion [claim] which is not wholly without merit[.]” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982), and has made evidence of “record establish[ing] at least the minimum requirements [for entitlement to a cause of action] pertinent to this case.” *Id.* at 190. In particular, Opposer claims rights in its MI-BOX mark since April 2005 in connection with “[c]ontainers for use as shelters, display housings, distribution centers, ticket booths, even as workshops”¹⁷ (uses that overlap with those identified in the opposed MYBOX Application), well prior to Applicant’s filing date or date of

¹⁷ Born Decl., 14 TTABVUE 4, ¶ 13.

first use, that Opposer's MI-BOX mark and Applicant's MYBOX mark are similar, and that Applicant's MYBOX branded containers used at special events like festivals, fairs, sporting events, and other big events (uses contemplated by the opposed Application) is likely to cause confusion.¹⁸ Opposer therefore has demonstrated an interest falling within the zone of interests protected by the Trademark Act, and a reasonable belief in damage proximately caused by the registration of Applicant's mark – thus establishing Opposer's entitlement to bring and maintain this proceeding. *See Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (proof of common law rights in plaintiff's mark establishes entitlement to bring proceeding).

IV. Priority

“One who opposes registration to an applicant under [Trademark Act S]ection 2(d) ... must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source, whether by ownership of a registration, prior use of a technical ‘trademark,’ prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity.” *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). We now review the methods by which Opposer has asserted, and seeks to prove, its prior rights in its MI-BOX mark.

¹⁸ Born Decl., 14 TTABVUE 31-32. ¶¶ 155-61.

A. Opposer's Pleaded MI-BOX Registration was not Properly made of Record

Generally, once an Opposer's pleaded registration is properly made of record, absent a cancellation counterclaim, priority in the opposition is not at issue with respect to the goods and services identified therein. *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)). However, Opposer did not properly make its pleaded MI-BOX registration of record in this proceeding.¹⁹

Opposer's Vice President and Secretary, Michael Born, testified to Opposer's ownership of U.S. Trademark Registration No. 3073509 for the MI-BOX trademark, and all common law trademark rights to this mark.²⁰ With its Second Notice of Reliance, Opposer made of record a plain copy of its MI-BOX Registration issued on March 28, 2006, the USPTO's Notice of Acceptance of the renewal of the Registration on April 27, 2015, and the USPTO's Assignment Records reflecting a change in Opposer's name from that shown in the Registration as originally issued to its current name, recorded with the USPTO on March 8, 2012.²¹ This testimony and evidence discusses Opposer's ownership of Registration No. 3073509, but says nothing about

¹⁹ Notwithstanding Applicant's concession that Opposer's pleaded registration "is of record[.]" Applicant's Brief, 49 TTABVUE 13, "[e]vidence not obtained and filed in compliance with ... [the Trademark Rules of Practice] will not be considered." Trademark Rule 2.123(k), 37 C.F.R. § 2.123(k); see also *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 (TTAB 1986) (collection of twenty-nine registrations listed in appendix to brief not considered because not in compliance with rules of practice).

²⁰ Born Decl., 15 TTABVUE 4, ¶ 11.

²¹ ONOR2, 33 TTABVUE 4-6, Exhs. PX 147-49.

the active status of this Registration during Opposer's testimony period; when Opposer's Second Notice of Reliance was filed. As the plaintiff in this proceeding, Opposer bears the burden of proving the current status and title of its pleaded registration. *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1602 (TTAB 2014); *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1958 (TTAB 2008) (opposer bears the burden of proof, including proving what registrations or common-law trademarks it owns).

Under Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d), a plaintiff may introduce its pleaded registration by: (1) attaching to its complaint USPTO records showing the current status and title of the registration; (2) appropriate identification and introduction during testimony; or (3) filing a notice of reliance during trial accompanied by USPTO records showing the current status and title of the registrations. *See United Global Media Grp. v. Tseng*, 112 USPQ2d 1039, 1041-42 (TTAB 2014) (explaining the ways in which a pleaded registration may be made of record).

“The Board has routinely held that the submission of a photocopy of a pleaded registration, by itself, is insufficient for purposes of establishing a party's current ownership, or the current status, of the registration, and therefore does not suffice to make the registration of record.” *Sterling Jewelers, v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014). Opposer's registration certificate does not show “current” status and ownership of the registrations, but rather reflect the status and ownership of the registration when it issued. *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90

USPQ2d 1112, 1116-17 (TTAB 2009) (explaining that copy of certificate of registration reflected registration date, not current status or title); *but see Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

Accordingly, the “plain” copy of the registration certificate Opposer attached to its Second Notice of Reliance is not sufficient to make the registration of record. *Life Zone*, 87 USPQ2d at 1956-57 (pleaded registrations not considered where opposer introduced only “plain copies” of the registration certificates).

Opposer also failed to introduce its pleaded registration through Michael Born’s declaration testimony. His testimony is sufficient to establish Opposer’s ownership of the pleaded registration, but he did not testify as to the current status of the registration. *See, e.g., Hard Rock Café Int’l (USA) Inc. v. Eles*, 56 USPQ2d 1504, 1511 (TTAB 2000) (pleaded registrations not of record where copies of the registrations did not show current status and title and witness’s “testimony was limited to indicating opposer’s ownership of the registrations”).

Lastly, for completeness, consistent with the Board’s consistent practice, we decline take judicial notice of Opposer’s pleaded registration. *Indus. Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 949-51 (TTAB 1983) (“[T]he Board deems it inappropriate to exercise any discretion it may have to take judicial notice of the

currency and subsistence of [the pleaded registration] in opposer's name. Longstanding practice of the Board and consistent treatment of litigants militates against such action."); *see also*, *Edom Labs Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) ("The Board does not take judicial notice of registrations or applications residing in the Office."); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) ("The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office.") (citing *Corp. Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987)).

As we have explained repeatedly, Trademark Rule 2.122(d) is "simple and clear" in providing various ways in which a party can properly introduce a pleaded registration. *Sterling Jewelers*, 110 USPQ2d at 1601 (citing *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991)); *Syngenta Crop Prot.*, 90 USPQ2d at 1116-17 (opposer did not take advantage of any of the means to introduce pleaded registration). Opposer failed to follow this simple and clear rule to its own detriment. *Acme Boot Co. v. Tony and Susan Alamo Found., Inc.*, 213 USPQ 591, 592 (TTAB 1980) ("It is within the Board's authority to require parties to follow a simple straightforward and inexpensive procedure of uniform applicability to prove status and title of pleaded registrations, particularly when that practice has been so carefully described.... When such minimal requirements have been painstakingly and repeatedly laid out, and the relevant regulations are so clear, opposer's failure to follow them is as its own peril.").

In view of the foregoing, Registration No. 3073509 for the MI-BOX trademark is not properly of record, and we do not consider it.

B. Opposer's Common Law Priority

Trademark Act Section 2(d) prohibits the registration of a mark that “[c]onsists 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[.]” 15 U.S.C. § 1052(d). “For purposes of [common law] priority, ‘proprietary rights may arise from ... prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.’” *ARSA Distrib., Inc. v. Salud Natural Mexicana S.A. de C.V.*, 2022 U.S.P.Q.2d 887, at *14 (TTAB 2022) (citing *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002)).

As alleged in its Notice of Opposition, Opposer relies for priority purposes on common law rights in the MI-BOX mark for:

moving and storage services, namely, rental, storage, delivery and pick up of portable storage units; and portable storage units used as shipping containers, retail or display kiosks, housing event spaces such as retail or display kiosks and meeting spaces at festivals and other outdoor events, dressing rooms at festivals and other outdoor events, stage platforms at festivals and other outdoor events.²²

²² Notice of Opposition, 1 TTABVUE 4-6, ¶¶ 5, 15-22.

To establish prior common law rights, Opposer must prove by a preponderance of the evidence that its pleaded common law MI-BOX mark is distinctive, inherently or otherwise, and that it used the MI-BOX mark prior to Applicant's actual first use or constructive first use dates. *See DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *3 (TTAB 2020); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (“[B]ecause unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer’s burden to demonstrate that it owns a trademark that was used prior to Applicant’s first use or constructive use of its mark and not abandoned.”) (citing *Life Zone*, 87 USPQ2d at 1959). In assessing whether Opposer has established priority, we consider the evidence of record as a whole. *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (“[O]ne should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”).

As to distinctiveness,²³ Opposer’s Mr. Born testified that the MI-BOX mark has “the ... connotation ... that this ‘box’ is mine; it belongs to me.”²⁴ We find that this is the connotation of Opposer’s mark that would be understood by consumers when renting Opposer’s containers, or taking advantage of Opposer’s related services. We thus further find that, in connection with Opposer’s goods and services, the common

²³ Applicant contends Opposer did not plead that its MI-BOX mark is distinctive as applied to Opposer’s common law services. Applicant’s Brief, 49 TTABVUE 13. We disagree. *See* Notice of Opposition, 1 TTABVUE 5-6, ¶¶ 15-25.

²⁴ Born Decl., 14 TTABVUE 31-32, ¶ 157.

law MI-BOX mark is suggestive, *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (“If ... a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive.”) (citing *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003)), and thus inherently distinctive without Opposer having to prove acquired distinctiveness. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992).

As to priority, Applicant’s intent-to-use application filing date for its MYBOX mark is April 12, 2019, i.e., its constructive use date.²⁵ However, Opposer made of record Applicant’s interrogatory answer which states:

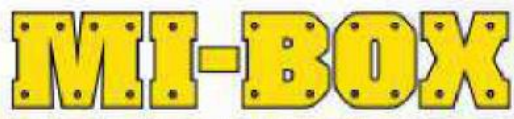
that it commenced use of Applicant’s Mark in connection with Applicant’s Goods at least as early as **November 11, 2018** at a tailgating event for a Tampa Bay Buccaneers football home game in Tampa, Florida. The MYBOX unit was located in a parking lot outside the stadium and was utilized as a social gathering area with an upper deck. (Emphasis added).²⁶

Once Opposer made Applicant’s interrogatory answer of record, Applicant was and is entitled to rely on it for any purpose permitted by the Federal Rules of Evidence. Trademark Rule 2.120(k)(7), 37 C.F.R. § 2.120(k)(7). Applicant’s statement as to the first use of its MYBOX mark is of record and stands unrebutted. Opposer, therefore, must demonstrate common law use of its MI-BOX mark prior to November 11, 2018.

²⁵ Notice of Opposition, 1 TTABVUE 6, ¶ 26; Answer, 4 TTABVUE 9, ¶ 26.

²⁶ Applicant’s Int. Ans. No. 3, ONOR1, 32 TTABVUE 7. See also Applicant’s Int. Ans. Nos. 4 and 10, ONOR1, 32 TTABVUE 7 and 9-10, providing the same information.

Opposer's witness, Mr. Born, states that Opposer's MI-BOX mark has been used in connection with moving and storage services, namely, the rental, storage, delivery, and pick up of portable storage units, and providing containers for use as shelters, display housings, distribution centers, ticket booths, even as workshops since April 2005.²⁷ The MI-BOX mark has been advertised in connection with moving and storage services, and in connection with customers' uses of Opposer's MI-BOX containers for these and a variety of other uses, on its website since November 2005.²⁸ Opposer made of record not only the capture of the current version of its MI-BOX website from 2021, but also the home page from the historical (Wayback Machine) versions of its MI-BOX website from 2005-06 and 2010-2020.²⁹ On its website, containers and trucks, Opposer's MI-BOX mark consistently appears as follows:



Opposer also discussed the first and continuing uses of the MI-BOX mark in connection with MI-BOX shipping containers, moving and storage services, and customers' uses of the MI-BOX containers for a variety of other uses, by and through Opposer's dealer-licensees:

- Mobile Moving Systems LLC, use since April 2010.³⁰
- MI-BOX of Central NH, LLC, use since June 2017.³¹

²⁷ Born Decl., 14 TTABVUE 4, 8, 19-20, ¶¶ 13, 38, 86.

²⁸ Born Decl., 14 TTABVUE 8, 40-67, ¶¶ 33-34, Exh. PX 7.

²⁹ Born Decl., 14 TTABVUE, 8-16, 40-95, ¶¶ 36-62, Exhs. PX 7-20.

³⁰ Born Decl., 14 TTABVUE 20, ¶¶ 87-90, 15 TTABVUE 113, Exh. PX 118.

³¹ Born Decl., 14 TTABVUE 20-31, ¶¶ 91-94, 15 TTABUVE 66, Exh. PX 96.

- Mi-Box of San Diego, LLC, use since 2016.³²
- Mi-Box of Central Illinois, Inc., use since 2017.³³
- MJ Storage, LLC dba Mi-Box Moving and Mobile Storage of Middle Tennessee, use since 2017.³⁴

Opposer therefore has established priority in its MI-BOX mark over Applicant's first use of its MYBOX mark with respect to the parties' goods and services as described above.

V. Likelihood of Confusion

Our likelihood of confusion analysis under Trademark Act Section 2(d) is based on all of the probative evidence of record. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*” – noting the factors to be considered). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

³² Robison Decl., 39 TTABVUE 4, 13, ¶¶ 14-18, Exh. PX 97.

³³ Carlton Decl., 41 TTABVUE 4, ¶¶ 15-17.

³⁴ Downs Decl., 43 TTABVUE 4-5, 15, ¶¶ 14-21, Exh. PX 95.

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect trademark owners from damage caused by the registration of similar marks for related goods or services that are likely to cause confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We discuss below these factors, and the other *DuPont* factors for which there is evidence and argument.

A. Strength of Opposer’s Mark

Before we evaluate the similarity or dissimilarity of the parties’ marks, we first consider the strength of Opposer’s asserted MI-BOX mark. The fifth *DuPont* factor enables Opposer to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use);” the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

Since the strength of Opposer’s mark affects the scope of protection to which it is entitled, *Made in Nature*, 2022 USPQ2d 557, at *20, we thus consider the inherent or conceptual strength of Opposer’s MI-BOX mark based on the nature of the mark itself, as well as its commercial strength based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength....”).

1. Conceptual Strength

“Conceptual strength is a measure of a mark’s [inherent] distinctiveness” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023). As noted above, we find Opposer’s MI-BOX mark to be suggestive and thus inherently distinctive. We reiterate Mr. Born’s testimony that the MI-BOX mark has “the ... connotation ... that this ‘box’ is mine; it belongs to me.”³⁵

For completeness, the dictionary definition of “MY”³⁶ (pronounced “mī”) is “of or relating to me or myself especially as possessor, agent, object of an action, or familiar person.”³⁷ The dictionary definition of “BOX” is “a rigid typically rectangular



³⁵ Born Decl., 14 TTABVUE 31-32, ¶ 157.

³⁶ Opposer concedes that “MI” is an alternative spelling of “MY”, that is: “Opposer ... admits that Applicant’s Mark is a simple misspelling of Opposer’s Mark. Visually the marks both begin with the letter M, followed by either the letter ‘Y’ or ‘I,’ and then end with the word ‘BOX.’” Opposer’s Adm. Resp. No. 5, ANOR, 46 TTABVUE 20-21.

³⁷ Definition and pronunciation of “MY” from MERRIAM-WEBSTER (<https://www.merriam-webster.com/dictionary/my>, last visited October 5, 2023). The Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions. *See Gerson Co. v. United States*, 898 F.3d 1232, 1236 n.4 (Fed. Cir. 2018); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

container with or without a cover ... such as ... a ... cargo container”³⁸ As used in Opposer’s mark as a whole, the combined terms “MI-” and “BOX”, viewed through the eyes of a consumer, do not retain their descriptive significance in relation to Opposer’s goods and services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1758 (Fed. Cir. 2012). That is, as a whole, MI-BOX does not merely describe “the qualities, ingredients or characteristics of the goods or services related to the mark.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (cleaned up, citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)). Rather, MI-BOX creates a unitary mark with a non-descriptive meaning as applied to Opposer’s goods and services. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2019) (citing *In re Colonial Stores Inc.*, 394 F.2d 549 , 157 USPQ 382 (CCPA 1968)).

We now turn to Applicant’s efforts to show that Opposer’s MI-BOX mark is conceptually weak. Applicant made of record the following use-based, active, third-party registrations for marks including the terms “MY” and/or “BOX”:³⁹

Mark	Reg. No.	Goods and/or Services
	6130656	Coordinating travel arrangements for individuals and for groups; Packaging articles for transportation; Storage of goods; Transportation of goods, Cl. 39
	5953245	Rental and leasing of metal cargo containers for storage and transportation of goods for short and long-term use; rental and leasing of metal cargo containers for storage and transportation of

³⁸ Definition and pronunciation of “BOX” from MERRIAM-WEBSTER (<https://www.merriam-webster.com/dictionary/box>, last visited October 5, 2023).

³⁹ Third-party registrations, ANOR, 46 TTABVUE 25-35, DX 9-12.

		goods for short and long-term duration for seasonal use, remodeling projects, industrial use and construction sites for commercial customers, Cl. 39
U-BOX	3620750	Moving and storage services, namely, rental, moving, storage, delivery and pick up of portable storage units, Cl. 39
MARBOX-CR	5339193	Plastic boxes for packaging consumer and retail items, Cl. 20

“The existence of third-party registrations on similar goods [or services] can bear on a mark’s conceptual strength. ... Specifically, third-party registrations containing an element that is common to both the opposer’s and the applicant’s marks can show that that element has a normally understood and well-recognized descriptive or suggestive meaning.” *Spireon*, 2023 USPQ2d 737, at *3-4 (cleaned up, citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015)).

Moreover:

Evidence of composite third-party registrations is also relevant because ... [s]uch registrations could ... show that the [US]PTO, by registering several marks with such a common segment, recognizes that portions of such composite marks other than the common segment are sufficient to distinguish the marks as a whole and to make confusion unlikely. That is, the presence of such a descriptive or suggestive weak segment in conflicting composite marks is not per se sufficient to make confusion likely.

Spireon, 2023 USPQ2d 737, at *5 (citing J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (5th ed. 2023)).

Qualitatively and quantitatively, Applicant’s evidence falls short of showing that Opposer’s MI-BOX mark is conceptually weak and entitled to only a narrow scope of

protection for its goods and services. Opposer's and Applicant's involved marks are, at the very least as we discuss below, aurally identical. Therefore, third-party registered marks incorporating other elements are of less probative value. *Cf. Spireon*, 2023 USPQ2d at *5 ("At least where the registrations and application are for non-identical marks, as they are here, it is error for the Board to effectively disregard third-party composite marks."). That is especially true here, where the additional wording in three of the four third-party marks cited by Applicant (M BOX, U-BOX and MARBOX-CR) is significant enough to make those marks less similar to Opposer's MI-BOX mark than is Applicant's MYBOX mark. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *25 (TTAB 2021) ("[W]hile the registered marks all contain the word 'MIRAGE,' they contain additional elements that cause many of them to be less similar to Petitioner's mark than Respondent's marks are.").

Collectively, we find one third-party registration for an aurally identical mark (MYBOX), and three third-party registrations for marks including the term "BOX" with other elements, may show that "BOX" is weak in connection with Opposer's goods and services. This is consistent with the dictionary definition of "BOX" discussed above. However, the four third-party registrations do not demonstrate that MI-BOX as a whole is conceptually weak for Opposer's goods and services. *See In re Inn at St. John's LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019) (four third-party registrations and no third-party uses were "a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant" in *Jack Wolfskin* and *Juice Generation*).

2. Commercial Strength

With respect to its commercial strength under the fifth *DuPont* factor, the fame of the prior mark, we must determine where to place Opposer's MI-BOX mark on the "spectrum" of marks, which ranges from "very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). The factors that we consider as to whether Opposer's MI-BOX mark has acquired commercial strength are:

[1] the volume of sales and advertising expenditures in connection with the goods sold under the mark[], for example, and other factors such as [2] length of time of use of the mark; [3] widespread critical assessments; [4] notice by independent sources of the products identified by the mark[]; and [5] the general reputation of the products and services.

Monster Energy Co. v. Lo, 2023 USPQ2 87, at *22 (TTAB 2023) (citing *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014)).

Of the factors listed above, Opposer did not make of record the volume (quantity) or dollar amount of its sales, any critical assessments of Opposer's goods or services associated with the MI-BOX mark, notice by independent sources of the goods or services identified by the mark, or evidence of the general reputation of its goods or services associated with the mark. Opposer states that it, Opposer's Parent and the MI-BOX dealers "have invested a significant amount of resources, including time, money, and effort in marketing, advertising, and promoting the MI-BOX Trademark, use of the MI-BOX Containers and MI-BOX Services."⁴⁰ Having reviewed the record, we find hard evidence supporting these efforts wanting.

⁴⁰ Opposer's Brief, 48 TTABVUE 10.

As noted above (with citations to the record), Opposer provided un rebutted evidence that its MI-BOX mark has been in use since April 2005. Opposer also supplied evidence of its advertising expenditures for the period 2014-2020.⁴¹ Since this evidence was made of record as confidential, we only discuss it in general terms. We find Opposer's advertising expenditures for this time period to be relatively modest at best.

Opposer states that its advertising expenditures have been directed to activities such as maintaining Opposer's website and Facebook page, online advertising, and supporting MI-BOX dealers with local advertising for the goods and services associated with the MI-BOX mark.⁴² Opposer provided no testimony regarding the unique number of visitors to its website or its dealers' websites. Neither the current version of Opposer's website,⁴³ nor Opposer's dealer websites,⁴⁴ made of record have visitor counters on them. The numbers of "likes" and "followers" of the Facebook

⁴¹ Born Conf'd'l Decl., 18 TTABVUE 5-6, 33-67, ¶¶ 19-31, Exhs. PX 1-6.

⁴² Born Conf'd'l Decl., 18 TTABVUE 6, ¶ 32. Opposer designated information relating to what its advertising expenditures were spent upon as confidential. We disagree with, and are not bound by, this confidential designation. *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1702 (Fed. Cir. 1990) (designation of material as confidential not controlling; court retains authority to decide what materials are deemed confidential and what part of trial shall be in camera); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1476 (TTAB 2017) (Board not bound by inappropriate designations of material as confidential).

⁴³ Opposer's current website, Born Decl., 14 TTABVUE 40-67, Exh. PX 7.

⁴⁴ Opposer's dealer websites, Born Decl., 15 TTABVUE 56-118, Exhs. PX 87-119; 16 TTABVUE 2-5, Exh. PX 120; Robison Decl., 39 TTABVUE 13, Exh. PX 97; Downs Decl., 43 TTABVUE 15, Exh. PX 95.

pages of Opposer's dealers⁴⁵ are rather low, ranging from less than ten to just under two-thousand per dealer page. The number of "posts" on, "followers" of, and persons "following" the Instagram pages of Opposer's dealers⁴⁶ also are rather low, ranging from less than a hundred to the low thousands per dealer page.

Apart from its website, Facebook, and Instagram exhibits, Opposer has not provided any other documented evidence of its online or printed advertising for its MI-BOX goods and services. Opposer's testimonial evidence in this regard is simply too general to be of significant probative value. Consequently, on this record, Opposer has not provided sufficient evidence to support the notion that its MI-BOX mark is anything more than one of average commercial strength.

On the other hand, while third-party uses of similar marks for similar goods or services may bear on the commercial weakness of a mark, *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017), and may be "relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection[.]" *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689,

⁴⁵ Opposer's dealer Facebook pages, Born Decl., 14 TTABVUE 130-166, Exhs. PX 55-70; 15 TTABVUE 3-38, Exhs. PX 71-84; Robison Decl., 39 TTABVUE 9-12, Exh. PX 78; Carlton Decl., 41 TTABVUE 9-11, Exh. PX 59; Downs Decl., 43 TTABVUE 10-14, Exh. PX 73.

⁴⁶ Opposer's dealer Instagram pages, Born Decl. 16 TTABVUE 6-101, Exhs. PX 121 139; 17 TTABVUE 2-4, Exh. PX 140; Robison Decl., 39 TTABVUE 14-24, Exh. PX 13; Carlton Decl., 41 TTABVUE 12-15, Exh. PX 125; Downs Decl., 43 TTABVUE 16-47, PX 130.

1693 (Fed. Cir. 2005)), no such evidence to this type was made of record by Applicant in this proceeding.

3. Summary: Strength of Opposer's Mark

In sum, we find Opposer's common law MI-BOX mark to be suggestive, and thus inherently distinctive, in connection with moving and storage services, and portable storage units used as shipping containers, and for other purposes. We further find Opposer's MI-BOX mark to be of average commercial strength. Overall, these factors weigh in favor of a finding that confusion is likely.

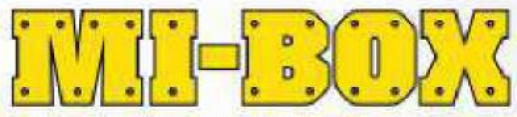
B. The Similarity or Dissimilarity of the Parties' Marks

We now consider the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *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). By "commercial impression" we mean "what the probable impact will be on the ordinary purchaser in the market place" *T. W. Samuels Distillery, Inc. v. Schenley Distillers, Inc.*, 458 F.2d 1403, 173 USPQ 690, 691 (CCPA 1972).

"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.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks omitted)). A proper emphasis is on the recollection of the average customer who normally retains a general, rather than specific, impression of trademarks. *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). Based on the evidence of record, we find average consumers for both parties’ goods and services to be members of the general public – ranging from purchasers having need of a container (and related services) for moving and storage purposes to those requiring such an item (and related services) for use at public events such as at competitive sports, fairs, occasions at parks and the like.

We again reprint Opposer’s common law MI-BOX mark, as consistently depicted in the evidence made of record:



That Opposer’s common law mark appears in a yellow, stylized, all-caps font, with small, round spots resembling the tops of screws, nails or rivets at the top and bottom of each letter, does not distinguish Opposer’s mark from Applicant’s MYBOX mark for likelihood of confusion purposes.

Because Applicant seeks to register its MYBOX in standard characters, we must consider Applicant’s mark “regardless of font style, size, or color.” *Citigroup*, 98 USPQ2d at 1259. Applicant thus could employ the same color and stylization in its display of the MYBOX mark as is shown for Opposer’s common law MI-BOX mark. *See Cunningham*, 55 USPQ2d at 1847-48 (“The record shows that the registration for

the LASERSWING mark contains a ‘typed drawing.’⁴⁷ ... Therefore, it is irrelevant that Cunningham has a particular display for his mark in commerce, and the Board was correct to ignore those features.”); Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (“Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background.”).

The small, round spots resembling the tops of screws, nails or rivets also are not features serving to distinguish Opposer’s common law mark from Applicant’s mark. Rather, they comprise common geometric shapes that consumers likely would perceive as a background design or carrier to the larger and surrounding wording. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *5 (TTAB 2019).

Our comparison of the marks therefore begins with a few of Applicant’s admissions to Opposer’s allegations made in the Notice of Opposition:

- Applicant’s Mark consists of two syllables.⁴⁸ We find that Opposer’s Mark equally consists of two syllables.
- The second syllable of Applicant’s and Opposer’s Mark, BOX, is identical.⁴⁹
- Applicant’s Mark, MYBOX, and Opposer’s Mark, MI-BOX, differ by one letter.⁵⁰

⁴⁷ Prior to November 2, 2003, “standard character” marks were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

⁴⁸ Notice of Opposition, 1 TTABVUE 7, ¶ 36; Answer, 4 TTABVUE 10, ¶ 36.

⁴⁹ Notice of Opposition, 1 TTABVUE 7, ¶ 38; Answer, 4 TTABVUE 10, ¶ 38.

⁵⁰ Notice of Opposition, 1 TTABVUE 7, ¶ 40; Answer, 4 TTABVUE 10, ¶ 40.

We continue with the parties' acknowledgement that their marks have virtually the same connotation and commercial impression. Opposer says that its MI-BOX mark has the connotation that "this 'box' is mine; it belongs to me."⁵¹ "Applicant ... chose [its MYBOX mark] because it was suggestive of the nature of its goods and services (i.e. Applicant's, or 'my', rectangular units, or 'box', for social entertainment purposes)."⁵² We see little, if any, difference in the connotation or commercial impression of Opposer's mark versus Applicant's mark; according to the statements of the parties. We find that consumers would equally perceive the parties' marks the same way.

In view of the acknowledged, practically same, connotation of the parties' marks, we disagree with Applicant's contention that "the marks cannot be understood to be 'pronounced identically'"⁵³ Even though, as Applicant further asserts, the "MI-" portion of Opposer's MI-BOX mark might be pronounced "me" when standing alone,⁵⁴ the same cannot be said when a consumer is presented with Opposer's MI-BOX mark as a whole. The consumer, when calling for Opposer's goods and services, would not refer them as "me box," but rather as "my box."

In any event, MI-BOX and MYBOX are not words normally found in the dictionary, but rather are unitary composite terms. Simply, there is no correct way to pronounce a trademark that is not a recognized word in American English. *See*

⁵¹ Born Decl., 14 TTABVUE 31-32, ¶ 157.

⁵² Applicant's Int. Ans. No. 2, ONOR1, 32 TTABVUE 7.

⁵³ Applicant's Brief, 49 TTABVUE 18.

⁵⁴ Applicant's Brief, 49 TTABVUE 19.

Central Indus. Inc. v. Spartan Chem. Co. Inc., 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that “there is no correct pronunciation of a trademark” and finding ISHINE likely to be confused with ICE SHINE); *In re Microsoft Corp.*, 68 USPQ2d 1195, 1199 (TTAB 2003) (“[I]t is impossible to control how consumers will pronounce marks”). We therefore believe it very possible that consumers would pronounce the parties’ marks identically. And we so find in this proceeding.

While we agree with Applicant’s observation that “[t]he [mark of the] Opposed Application is spelled with a ‘y’ rather than the ‘i’ used in Opposer’s Trademark[,]”⁵⁵ we do not agree with Applicant’s contention that “Applicant’s Mark is not confusingly similar to Opposer’s Mark because they are spelled differently: MYBOX compared to MI-BOX.”⁵⁶ Marks differing by only a single letter may be found similar for likelihood of confusion purposes. *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990) (“The marks [TMS and TMM] sound alike and look alike.”); *Mag Instr. Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1714 (TTAB 2010), *aff’d mem.*, 2011 WL 5400095 (Fed. Cir. Nov. 9, 2011) (“[T]he marks at issue, ... MAXSTAR versus .. MAG STAR, ... [have] obvious similarities in appearance and sound. Both marks have two syllables that begin with the letters ‘MA’ followed by another single letter and end with ‘star.’ Visually, the only real difference is the third letter in each mark, ‘g’ and ‘x’ respectively. ... In terms of sound, the two marks are also very similar”).

⁵⁵ Applicant’s Brief, 49 TTABVUE 18.

⁵⁶ Applicant’s Int. Ans. No. 27; ONOR1, 32 TTABVUE 14.

Applicant further seeks to differentiate the parties' marks because "the [mark of the] Opposed Application appears as a unitary composite term ['MYBOX'] rather than separating the component terms by a visually disruptive hyphen between the 'MI' and 'BOX' components, as reflected in Opposer's Trademark ['MI-BOX']."⁵⁷ Again, we disagree. The absence of the hyphen in Applicant's mark, and its presence in Opposer's mark, does not distinguish them from one another. *See, e.g., Thymo Borine Lab. v. Winthrop Chem. Co.*, 155 F.2d 402, 69 USPQ 512, 514 (CCPA 1946) (The hyphen in the mark THY-RIN "has no significance in speech" when being compared to the mark THYRACTIN); *Mag Instr.*, 96 USPQ2d at 1712 ("In comparing [the marks] ... MAG-NUM STAR [and] ... MAGNUM MAXFIRE ..., the obvious similarity is that both marks begin with the term MAGNUM or MAG-NUM. Thus, the initial term in both marks is essentially identical; the hyphen in the [MAG-NUM STAR] ... mark does not distinguish them.").

When we analyze the parties' marks for likelihood of confusion purposes, we consider them as a whole, in their entirety. *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at *2-3 (Fed. Cir. 2021) (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000) and *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985)). Upon doing so, we find that MI-BOX and MYBOX, despite having minor differences, are highly similar in appearance, meaning and overall commercial impression, and

⁵⁷ Applicant's Brief, 49 TTABVUE 18.

identical in sound when spoken. This vastly weighs in favor of a finding that confusion is likely.

C. The Similarity or Dissimilarity of the Parties' Goods and Services

Since Opposer's MI-BOX Registration was not properly made of record, in this proceeding we consider "[t]he similarity or dissimilarity and nature of the goods or services as described in [the MYBOX] ... [A]pplication" as compared to those "in connection with which [Opposer's] prior [common law MI-BOX mark] mark is in use." *DuPont*, 177 USPQ at 567. Where virtually identical marks are involved, as is the case here, the degree of similarity between the goods and services required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 26 USPQ2d a 687, 1688-89 (Fed. Cir. 1993) (citing *Philip Morris Inc. v. K2 Corp.*, 555 F.2d 815, 194 USPQ 81, 82 (CCPA 1977)).

Further, the issue of "likelihood of confusion ... must be resolved on the basis of the goods [and services] named in the [MYBOX Application] and, in the absence of specific limitations in the ... [Application], on the basis of all normal and usual channels of trade and methods of distribution." *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Where "[t]here is no specific limitation here, and nothing in the inherent nature of ... [Applicant's] mark[,] ... goods ... [or services] that restricts the usage of" the mark for specific purposes, it is "improper[] [to] read limitations into the [Application] ... by submitting evidence of [actual] use" of the mark. *Id.*; see also *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) ("An application with 'no

restriction on trade channels' cannot be 'narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers.'").

We need not consider whether each of Opposer's goods and services associated with its common law MI-BOX mark is related to Applicant's goods and services for purposes of a *DuPont* analysis; it is sufficient if likelihood of confusion is found with respect to use of Applicant's mark in connection with any product or service in a particular International Class. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

On the other hand, in an opposition against an application having multiple classes, as is the case here, the Board must make a separate determination as to each class. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 28 (CCPA 1976) ("[T]his opposition proceeding as to four classes of a combined application is, effectively, four different oppositions which require four different factual determinations and four different conclusions on the ultimate issue of likelihood of confusion under [Section] 2(d)."); *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015) ("Because each class in Applicant's multi-class application is, in effect, a separate application, we consider each class separately, and determine whether Opposer has shown a likelihood of confusion with respect to each.").

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods and services are used together or used by

the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same producer or dealer; or copies of use based registrations of the same mark for both the applicant's services and the goods listed in the cited registration. *See In re Davia*, 110 USPQ2d at 1816-17.

While we contemplate the similarity or dissimilarity of the respective goods and services, we also reflect upon the third *DuPont* factor, which “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). The trade channels factor considers the modalities and means (e.g., print, media, store aisles or shelves, or online) by which the respective goods or services are marketed, *see In re Majestic Distilling*, 65 USPQ2d at 1204, sold or distributed in relative proximity, *see Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

We now consider the following testimony and documentary evidence submitted by Opposer regarding its common law rights in the MI-BOX mark:

Testimony:

- Testimony from Michael Born (of Opposer) that the MI-BOX mark has been used in connection with moving and storage services, that is, the rental, storage, delivery, and pick up of portable storage units, and providing containers for use as shelters, display housings, distribution centers, ticket booths, and as workshops since April 2005, and advertising of these goods and services on its website since November 2005.⁵⁸
- Testimony from Richard Robison (of Mi-Box of San Diego, LLC) that his company has promoted the use of MI-BOX containers for storing and moving goods, as well as to house displays, as shelters, and as ticket booths, and at

⁵⁸ Born Decl., 14 TTABVUE 5, 7-8, 10-15, ¶¶ 13, 34, 38, 45-61.

events such as trade shows, launch parties, sporting events, festivals, fairs, and similar events, since 2016.⁵⁹

- Testimony from Dale Carlton (of Mi-Box of Central Illinois, Inc.) that his company has promoted the use of MI-BOX containers for storing and moving goods, as well as to house displays, as shelters, and as ATM kiosks, and at events such as trade shows, launch parties, sporting events, festivals, fairs, and similar events, since 2017.⁶⁰
- Testimony from Angie Downs (of MJ Storage, LLC dba Mi-Box Moving and Mobile Storage of Middle Tennessee) that her company has promoted the use of MI-BOX containers for storing and moving goods, as well as to house displays, as shelters, and as ticket booths, and at events such as trade shows, launch parties, sporting events, festivals, fairs, and similar events, since 2017.⁶¹

Documentary Evidence

Core Uses

- Historical (Wayback Machine) and current versions of Opposer's website, promoting its MI-BOX containers, and its MI-BOX moving and storage services, with suggested "other uses" for Opposer's containers, from 2005-06 and 2010-21; and 2021 versions of MI-BOX dealer websites.⁶²

Other Uses

- Use of a MI-BOX container for use as a shelter for contractors and construction workers – 2013.⁶³
- Use of a MI-BOX container at an outdoor running race – September 18, 2013.⁶⁴
- Use of a MI-BOX container as an outdoor misting station – 2014.⁶⁵

⁵⁹ Robison Decl., 39 TTABVUE 4, ¶¶ 14-15.

⁶⁰ Carlton Decl., 41 TTABVUE 4, ¶¶ 15-16.

⁶¹ Downs Decl., 43 TTABVUE 4, ¶¶ 15-16.

⁶² Born Decl., 14 TTABVUE 40-95, PX 7-21; 15 TTABVUE 56-118, PX 87-119; 16 TTABVUE 2-5, PX 120.

⁶³ Born Decl., 14 TTABVUE 56, PX 7 (posting date verified by Born Decl., 14 TTABVUE 9-10, ¶ 44).

⁶⁴ Born Decl., 15 TTABVUE 14, PX 74.

⁶⁵ Born Decl., 14 TTABVUE 63, PX 7; 17 TTABVUE 7-8, PX 143-44 (usage date verified by Born Decl., 14 TTABVUE 10, ¶ 45).

- Use of a MI-BOX container for a rodeo box office until a new structure is built – January 13, 2018.⁶⁶
- Use of a MI-BOX container and truck for the shipping and storage of items at a motorsports park for a public fair – September 14, 2018.⁶⁷
- Use of a MI-BOX container and truck at a public fair – August 20, 2019.⁶⁸
- Use of multiple MI-BOX containers to create a safe walkway and entrance for employees while the roof of a building was being repaired. – September 30, 2019.⁶⁹
- Use of a MI-BOX container for on-site storage at a marathon race – October 9, 2019.⁷⁰
- Use of a MI-BOX container and truck for delivery and storage of merchandise at public home show (featuring home furnishings for sale) – January 23, 2020.⁷¹
- Use of a MI-BOX container to house a workshop – February 19, 2020, March 2020 and November 7, 2020.⁷²
- Use of a MI-BOX container and truck for the shipping and storage of items for a music concert – March 24, 2020.⁷³
- Use of a MI-BOX container to house a public food exchange (distribution site) – April 28, 29, 30, and May 2, 2020.⁷⁴
- Use of a MI-BOX container to house a public food exchange (collection and distribution site) – May 5, 2020.⁷⁵

⁶⁶ Born Decl., 15 TTABVUE 24, PX 75-83; Robison Decl., 39 TTABVUE 12, PX 78.

⁶⁷ Born Decl., 14 TTABVUE 149, PX 61-63.

⁶⁸ Born Decl., 15 TTABVUE 6, PX 71-73.

⁶⁹ Born Decl., 14 TTABVUE 144, PX 60.

⁷⁰ Born Decl., 15 TTABVUE 4, PX 71-73.

⁷¹ Born Decl., 15 TTABVUE 23, PX 75-83; Robison Decl., 39 TTABVUE 11, PX 78.

⁷² Born Decl., 15 TTABVUE 36-37, PX 84; *see also* 17 TTABVUE 3, PX 140 (Instagram photo, posting date verified by Born Decl., 14 TTABVUE 28, ¶ 137).

⁷³ Born Decl., 14 TTABVUE 147, PX 61-63.

⁷⁴ Born Decl., 14 TTABVUE 138, 150, PX 55-59, PX 61; 15 TTABVUE 13, 34, PX 74, 75-83; *see also* 17 TTABVUE 3, PX 140 (Instagram photo that is undated); Carlton Decl., 41 TTABVUE 11, 13, PX 59, 125 (PX 125 is an Instagram photo that is undated).

⁷⁵ Born Decl., 14 TTABVUE 157, PX 64.

- Use of a MI-BOX container to house an ATM machine for use at a public fair – June 18, 2020.⁷⁶
- Use of a MI-BOX container for on-site storage at a farmer’s market – June 27, 2020.⁷⁷
- Use of a MI-BOX container for on-site storage at a public donations center for goods to be sold off for charity at an auction – September 1, 201.⁷⁸
- Use of a MI-BOX container for on-site storage at a public fair – August 2 and 6, 2021.⁷⁹
- Use of a MI-BOX container for on-site storage at a public fair – September 12, 2021.⁸⁰
- Use of a MI-BOX container to house individuals and Halloween treats being distributed at a public festival – October 23, 2021.⁸¹
- Use of a MI-BOX container as part of a concert stage setup – May 12 and 18, [year unspecified].⁸²
- Use of MI-BOX containers for on-site storage at a special event – August 25, [year unspecified].⁸³
- Use of a MI-BOX container as an information/literature distribution booth – undated.⁸⁴

Based on this testimony and documentary evidence, we find that Opposer has demonstrated its regular, recurring and continuous use of the MI-BOX mark, so as to create common law rights in this mark in connection with the rental, storage, delivery, and pick up of portable storage containers, and providing containers for use

⁷⁶ Born Decl., 14 TTABVUE 137, PX 55-59; *see also* 16 TTABVUE 11, PX 121-33 (Instagram photo that is undated); Carlton Decl., 41 TTABVUE 10, PX 59.

⁷⁷ Born Decl., 15 TTABVUE 26, PX 75-83.

⁷⁸ Born Decl., 14 TTABVUE 139, PX 60.

⁷⁹ Born Decl., 14 TTABVUE 140-141, PX 60.

⁸⁰ Born Decl., 14 TTABVUE 153, PX 64.

⁸¹ Born Decl., 14 TTABVUE 156, PX 64; *see also* 16 TTABVUE 18, PX 121-33 (Instagram photo that is undated).

⁸² Born Decl., 14 TTABVUE 142-143, PX 60.

⁸³ Robison Decl., 39 TTABVUE 10, PX 78.

⁸⁴ Born Decl., 16 TTABVUE 20, PX 121-33 (multiple Instagram photos that are undated).

in the off-site storage of goods, the on-site storage goods at various public events, as well as for on-site shelters, displays, collection and distribution centers, ticket booths, and workshops, from a date preceding Applicant's November 11, 2018 date of first use and continuing thereafter. From such uses, we find that the public has come to associate Opposer's common law MI-BOX mark with the source of these goods and services. *See SquirtCo*, 216 USPQ at 940; *Morgan Creek Prods., Inc. v. Foria Int'l, Inc.*, 91 USPQ2d 1134, 1144 (TTAB 2009); *Giersch*, 90 USPQ2d at 1023.

As recited in its Application, Applicant's identified goods and services are: "Modular metallic buildings; transportable metal buildings; prefabricated metal buildings; relocatable metal buildings," in Class 6; "Custom manufacture of modular components of modular buildings, transportable buildings, prefabricated buildings, and relocatable buildings," in Class 40; and "Rental of portable buildings, namely, portable modular buildings, transportable buildings, prefabricated buildings, and relocatable buildings," in Class 43. None of the identified goods or services are limited as to channels of trade or classes/types of purchasers. The modular, transportable, prefabricated and relocatable metal buildings described in the opposed Application are "repurposed shipping containers," intended for use to house persons and various furnishings at various public events.⁸⁵

1. Classes 6 and 43

We find that Applicant's identified goods and services in Classes 6 and 43 of its MYBOX Application are related and therefore similar to the goods and services for

⁸⁵ Williamson Decl., 45 TTABVUE 3, 6-36, ¶¶ 6-7, DX 1-6.

which Opposer has established common law rights in connection with its MI-BOX mark. Not only can Applicant's "buildings," and the rental thereof, be used for the same purposes as Opposer's rented containers (as shelters for people and the housing of furnishings), but also at the same places (public events such as music festivals and sporting events). *See In re Davia*, 110 USPQ2d at 1816-17. We further find that the parties' goods and services are sold, distributed and provided in relative proximity (that is, at public events as described immediately above). *See Kangol*, 23 USPQ2d at 1946. In short, "the respective goods or services [of the parties] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer." *Morgan Creek*, 91 USPQ2d at 1141-42.

2. Class 40

On the other hand, we find Opposer has not established any rights in its MI-BOX mark in connection with the custom manufacture of modular components of any structures, whether they be characterized as "buildings," "containers," "rental units" or otherwise. To the contrary, the evidence demonstrates that Opposer and its authorized dealers provide MI-BOX containers to customers "as is"; empty. Whatever customization is done to Opposer's containers once rented, its customers do that themselves.

"It is the burden of [O]pposer to demonstrate that it has used its [MI-BOX] mark in a regular or recurring manner so that the consuming public would be aware that [O]pposer offers the ... [services] under the mark and therefore associate [O]pposer's mark with ... [those services]. [With respect to the custom manufacture of modular

components of any structures, whether buildings or containers, t]he testimony and evidence submitted by [O]pposer does not meet that burden.” *Morgan Creek*, 91 USPQ2d at 1144. Because Opposer has not (1) established common law rights in its MI-BOX mark for “custom manufacture of modular components [etc.],” or (2) submitted any evidence to establish the relatedness of Opposer’s goods and services with Applicant’s services of “custom manufacture of modular components [etc.],” it is unlikely that consumers would be confused with respect to Applicant’s use of its MYBOX mark for its services identified in Class 40. The goods and services in connection with which Opposer has shown it has used the MI-BOX mark are not related to Applicant’s identified Class 40 services, nor (from the evidence of record) do these respective goods and services travel in overlapping channels of trade.

D. Actual Confusion

The seventh *DuPont* factor is “[t]he nature and extent of any actual confusion,” while the eighth *DuPont* factor considers “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. The eighth *DuPont* factor “requires us to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mortg.*, 2020 USPQ2d 10279, at *15 (TTAB 2020).

Applicant’s President and CEO, Mr. Williamson, says that Applicant “has never received in [sic] inquiry or other communication obviously intended for Opposer” and “has never experienced any instance of actual confusion between it and Opposer.”⁸⁶

⁸⁶ Williamson Decl., 45 TTABVUE 4, ¶¶ 11-12.

However, any reliance by Applicant on the absence of actual confusion is misplaced, because its Application was filed on the basis of intent-to-use, under Trademark Act Section 1(b), rather than use in commerce. The only evidence of record that Applicant has used its MYBOX mark for its identified goods and services comprises 15 public events extending from November 2018 to April 2021 – all within the state of Florida.⁸⁷ We do not know the number of persons attending these events, nor are we aware of the extent to which Applicant promoted these events. Applicant’s limited use of its MYBOX mark is not a meaningful opportunity for confusion to occur with Opposer’s MI-BOX mark. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because ... no evidence was presented as to the extent of ETF’s use of the VITTORIO RICCI mark on the merchandise in question in prior years ...”). In any event, “it is unnecessary to show actual confusion in establishing likelihood of confusion.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). The presence or absence of actual confusion is therefore a neutral factor in our analysis.

VI. Conclusion on Likelihood of Confusion

We now weigh the *DuPont* factors for which there has been evidence and argument in this appeal, *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023) (“[I]t is important ... that the Board ... weigh the *DuPont* factors used in its analysis *and* explain the results of that weighing.”).

⁸⁷ Applicant’s Int. Ans. No. 10, ONOR1, 32 TTABVUE 9-10.

We do so mindful that this is an opposition against a multi-class application, requiring that we make a separate determination as to each class. *Federated Foods*, 192 USPQ at 28; *N. Face Apparel*, 116 USPQ2d at 1228.

Conceptually, Opposer's common law MI-BOX mark is suggestive, and thus inherently distinctive, in connection with the rental, storage, delivery, and pick up of portable storage containers, and providing containers for use in the off-site storage of goods, the on-site storage goods at various public events, as well as for on-site shelters, displays, collection and distribution centers, ticket booths, and workshops. Opposer's MI-BOX mark is of average commercial strength in connection with these goods and services.

Classes 6 and 43: We find that Applicant's MYBOX mark is virtually identical to Opposer's common law MI-BOX mark. Applicant's goods and services in Classes 6 and 43 are related to, and travel in overlapping channels of trade with, the goods and services for which Opposer has established common rights as to its MI-BOX mark. We find confusion is likely as between Applicant's MYBOX mark with respect to its goods and services in Classes 6 and 43 and Opposer's common law MI-BOX mark and associated goods and services.

Class 40: On this record, there is insufficient evidence to demonstrate that Applicant's Class 40 services are similar or related to any of the goods or services in connection with which Opposer has established common law rights as to its MI-BOX mark. We find this factor plays a dominant role over all the other *DuPont* factors in our finding against a likelihood of confusion. *Kellogg Co. v. Pack'em Enters., Inc.*, 951

F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *[D]uPont* factor may not be dispositive.”).

The presence or absence of actual confusion is a neutral factor in our analysis as to all the goods and services identified in the MYBOX Application.

Decision:

The Opposition to Applicant’s MYBOX mark under Trademark Act Section 2(d) is sustained as to the goods and services in Classes 6 and 43, but is dismissed as to Applicant’s identified Class 40 services. The Application will proceed as to the services in Class 40 only.