

This Opinion is Not a  
Precedent of the TTAB

Hearing: May 21, 2024

Mailed: October 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Ateara L. Garrison*

*v.*

*Neidy E. Hornsby*  
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Opposition No. 91269392  
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Dayna C. Cooper of Cooper Legal LLC for Ateara L. Garrison.

Brandon J. Leavitt of Leavitt & Eldredge Law Firm for Neidy E. Hornsby.  
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Before Zervas, Larkin, and Allard,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

This case involves dueling intellectual property law attorneys. Neidy E. Hornsby (“Applicant”) seeks registration on the Principal Register of the standard-character mark GUARD YOUR GENIUS WITH NOIR IP for “legal services.”<sup>1</sup> Ateara L.

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<sup>1</sup> The opposed application Serial No. 88933811 was filed on May 26, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s allegation of first use of the mark anywhere and first use of the mark in commerce at least as early as January 9, 2020. Applicant subsequently amended the filing basis of her application to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intention to use the mark in commerce.

Garrison (“Opposer”) opposes registration on two grounds: (1) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s GUARD YOUR GENIUS WITH NOIR IP mark so resembles Opposer’s standard-character mark GUARD YOUR GIFTS, registered on the Principal Register for “legal services,”<sup>2</sup> as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive, and (2) on the ground that Applicant lacked a bona fide intention to use her mark in commerce when she filed the opposed application.

The case is fully briefed,<sup>3</sup> and attorneys for the two dueling attorneys appeared at an oral hearing before the panel on May 21, 2024.<sup>4</sup> We sustain the opposition based on Opposer’s Section 2(d) claim and do not reach her claim that Applicant lacked a bona fide intention to use her mark.<sup>5</sup>

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<sup>2</sup> As discussed below, Opposer’s registration originally also covered specific forms of legal services, but it has been amended by agreement of the parties to cover only “legal services.”

<sup>3</sup> Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 WL 2853282, at \*1 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer’s main brief appears at 62 TTABVUE and her reply brief appears at 67 TTABVUE. Applicant’s brief appears at 63 TTABVUE. Opposer filed a motion to strike Applicant’s briefly as untimely, which we decide below.

<sup>4</sup> Both of the dueling attorneys appeared pro se at some point in this case. Opposer filed the case pro se, but subsequently retained counsel. 9 TTABVUE. Applicant was originally represented by counsel, 4 TTABVUE, but her counsel received permission to withdraw, 36 TTABVUE 1, and Applicant entered an appearance pro se. 37 TTABVUE 2. During trial, Applicant’s current counsel entered an appearance on her behalf. 55 TTABVUE 2.

<sup>5</sup> This opinion is issued as part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases. The citation form in this opinion is in a form provided in Section 101.03(a) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) (2024). This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the

## I. The Record and Various Preliminary Matters

The record consists of the pleadings,<sup>6</sup> the file history of the opposed application,<sup>7</sup> by operation of Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), and the following materials submitted by the parties:

### Opposer

- Opposer’s Testimony Declaration (“Garrison Declaration”/“Garrison Decl.”) and Exhibits A-E thereto, 43 TTABVUE 2-83;
- Opposer’s Rebuttal Testimony Declaration (“Garrison Rebuttal Declaration”/“Garrison Rebut. Decl.”), and Exhibit A thereto, 60 TTABVUE 2-6;<sup>8</sup>
- Opposer’s First Notice of Reliance on various of Opposer’s First Requests for Admissions and on certain of Applicant’s responses to Opposer’s First Sets of Interrogatories and Requests for Production of Documents, 39 TTABVUE 2-83;
- Opposer’s Amended First Notice of Reliance on various of Opposer’s First Requests for Admissions and on certain of Applicant’s responses to Opposer’s First Sets of Interrogatories and Requests for Production of Documents, 42 TTABVUE 2-98; and

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Board, this opinion employs citations to the Westlaw legal database (“WL”) and, in the initial full citation of a case, also identifies the number of the Board proceeding. The Board’s decisions issued since 2008 are available in TTABVUE. Practitioners should also adhere to the practice set forth in TBMP § 101.03(a).

<sup>6</sup> The operative pleadings are Opposer’s Second Amended Notice of Opposition, 22 TTABVUE 2-7, and Applicant’s answer thereto, in which she denied the salient allegations in the Second Amended Notice of Opposition. 23 TTABVUE 2-6. Applicant filed a counterclaim to cancel Opposer’s pleaded registration and amended it three times, but the parties stipulated to its withdrawal, 59 TTABVUE 2, and we have dismissed it below.

<sup>7</sup> Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

<sup>8</sup> Exhibit A to the Garrison Rebuttal Declaration was designated Confidential under the Board’s Standard Protective Order and was filed under seal at 61 TTABVUE.

- Opposer’s Second Notice of Reliance on various dictionary definitions, 40 TTABVUE 2-12.

### **Applicant**

- Applicant’s Testimony Declaration (“Hornsby Declaration”/“Hornsby Decl.”),<sup>9</sup> and Direct Testimony Declaration (“Hornsby Direct Testimony Declaration”/“Hornsby Dir. Test. Decl.”), 45 TTABVUE 2-5; 56 TTABVUE 2-4;<sup>10</sup>
- Applicant’s First Notice of Reliance on dictionary definitions and USPTO electronic records regarding various registrations and applications (Exhibits 1-36), 47 TTABVUE 2-76; 49 TTABVUE 1-100; 50 TTABVUE 2-13; 51 TTABVUE 2-14;
- Applicant’s Second Notice of Reliance on USPTO electronic records regarding various registrations and applications, including excerpts from the file history of Opposer’s ’081 Registration (Exhibits 19, 27, 37, 38-40), 46 TTABVUE 3-70;<sup>11</sup>

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<sup>9</sup> The Board’s July 29, 2022 final scheduling order prior to trial stated that Applicant’s 30-day trial period as the defendant in the opposition, and as the plaintiff on a then-pending counterclaim to cancel Opposer’s pleaded Registration No. 5895081 (the “’081 Registration”), ended on July 25, 2023. 38 TTABVUE 2. Applicant, then appearing pro se, filed the Hornsby Declaration, executed on June 12, 2023, and all of her Notices of Reliance, on June 12 and June 13, 2023, prior to the opening of her assigned trial period. 45-53 TTABVUE. Trademark Rule 2.121(a) provides that “[n]o testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.” 37 C.F.R. § 2.122(a). Opposer did not move to strike Applicant’s prematurely-filed evidence and in her main brief, Opposer treated it as if it were properly of record, 62 TTABVUE 7-8, so we have considered it in our decision. Applicant timely filed the Hornsby Direct Testimony Declaration and the Garrison deposition transcript discussed below. 56 TTABVUE; 57 TTABVUE.

<sup>10</sup> Ms. Hornsby testified that she “personally created each and every exhibits submitted with my notices of reliance” and purported to “incorporate each and every such exhibit by reference herein.” Hornsby Decl. ¶ 3 (45 TTABVUE 2). The exhibits were not attached to her Declaration and we do not consider them to have been incorporated into Ms. Hornsby’s testimony by reference. We have considered them as exhibits to Applicant’s notices of reliance.

<sup>11</sup> The ’081 Registration was made of record by attachment of appropriate USPTO electronic records as Exhibit C to Opposer’s Second Amended Notice of Opposition. 22 TTABVUE 31-36. As discussed below, the parties stipulated to the granting of Opposer’s motions to amend the ’081 Registration in certain respects.

- Applicant’s Third Notice of Reliance on Applicant’s Registration No. 6373954 of the mark NOIR IP for “legal services,” 52 TTABVUE 2-6; and
- The transcript of Opposer’s deposition (“Garrison Transcript”/“Garrison Tr.”) taken on July 10, 2023 and exhibits thereto, 57 TTABVUE 2-137.<sup>12</sup>

### **Opposer’s Motion to Strike Applicant’s Brief**

Applicant’s brief was filed on February 9, 2024, 63 TTABVUE, four days after the February 5, 2024 due date set in the Board’s last scheduling order prior to trial. 38 TTABVUE 2.<sup>13</sup> Applicant’s brief contained a “Certificate of Transmission” by email on Applicant’s counsel. 63 TTABVUE 22.

On February 23, 2024, Opposer filed a motion to strike Applicant’s brief on the grounds that it was untimely and had not been served on Opposer. 64 TTABVUE 2-11. The motion was supported by a declaration of Opposer’s counsel Dayna C. Cooper, who stated that “Applicant did not serve her final brief on Opposer,” Cooper Decl. ¶ 3 (64 TTABVUE 5), and that “[t]his is not the first time that such conduct has occurred.” Cooper Decl. ¶ 4; Ex. A (64 TTABVUE 5-11). Opposer did not explain when or how she learned of the filing of Applicant’s brief.

On February 27, 2024, Applicant opposed the motion to strike and moved to reopen her time to file her brief. 65 TTABVUE 2-8. Applicant argued that the four-day delay in the filing of her brief was the result of excusable neglect under the factors set forth by the United States Supreme Court in *Pioneer Inv. Servs. Co. v. Brunswick*

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<sup>12</sup> The Garrison Transcript was not submitted under notice of reliance, but Opposer did not object to its standalone submission, so we have considered it in our decision.

<sup>13</sup> The scheduling order provided for Applicant’s filing of a combined brief as the defendant in the opposition and as the plaintiff on the counterclaim to cancel Opposer’s ’081 Registration. 38 TTABVUE 2.

*Assocs. L.P.*, 507 U.S. 380 (1993). 65 TTABVUE at 3-6. Applicant argued that her lead counsel had instructed a staff member to remove all deadlines pertaining to her counterclaim following the August 14, 2023 filing of a stipulation to withdraw the counterclaim, and that the staff member had “failed to disassociate the Main Brief from the Counterclaim Brief” and had removed the deadline entirely. *Id.* at 2. These arguments were supported by the affidavit of Reece Leonard, an associate attorney working for Applicant’s counsel Brandon Leavitt, who stated that he had been instructed by Mr. Leavitt to alter a deadline in the firm’s calendar and in so doing had removed the deadline for filing Applicant’s brief as defendant in the opposition from the calendar. Leonard Aff. ¶¶ 3-4 (65 TTABVUE 8).

In an order in response to the motion to strike, the Board allowed Opposer the opportunity to file a reply brief on the motion, 66 TTABVUE 1, but Opposer did not do so. The Board also extended the deadline for the filing of Opposer’s reply brief on the merits until March 13, 2024, *id.*, and Opposer timely filed its reply brief. 67 TTABVUE.<sup>14</sup> The Board deferred consideration of the motion to strike until the case was submitted for decision. 66 TTABVUE 1.

Because Applicant did not timely file her brief, she must establish that the untimeliness was the result of excusable neglect. *See Pumpkin, Ltd. v. The Seed Corps*, Opp. No. 99224, 1997 WL 473051 (TTAB 1997) (discussing *Pioneer* excusable neglect factors). The relevant excusable neglect factors include (1) the danger of

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<sup>14</sup> Opposer’s combined reply brief as the plaintiff in the opposition and as the defendant on the counterclaim was originally due on March 6, 2024 under the Board’s scheduling order. 38 TTABVUE 2.

prejudice to the non-movant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Id.* at \*5.

With respect to prejudice, Opposer's motion to strike argued that "Applicant's untimely filing and failure to serve her brief on Opposer has caused prejudice to Opposer because the timeframe for Opposer's response has lapsed as Opposer's Reply would have been due 15 days from Applicant's due date (not actual filing or upon Opposer's discovery of the filing)." 64 TTABVUE 3. At the oral hearing, Opposer's counsel claimed that Opposer did not learn of the filing of Applicant's brief until 11 days after February 9, 2024, and argued that Opposer had been prejudiced because she had not received the full time to file her reply brief, but was instead rushed in its preparation. As discussed above, the Board altered the original schedule for the filing of Opposer's reply brief to give her an additional week in which to file it, and even assuming that Opposer first learned of the filing of the reply brief on February 20, 2024, Opposer ultimately had until March 13, 2024 to file her reply brief, a period of slightly more than three weeks. Under the Board's last scheduling order, she originally had a period of about four weeks to file a reply brief. Prejudice to the non-movant under *Pioneer* involves prejudice to its ability to litigate the case effectively, not simply inconvenience or delay. *Pumpkin*, 1997 WL 473051, at \*7. Opposer filed a reply brief that discussed Applicant's procedural and substantive arguments,<sup>15</sup> and

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<sup>15</sup> Opposer's reply brief notes Opposer's "object[ion] to the introduction of Applicant's trial brief as it was untimely and not served on Opposer," 67 TTABVUE 5, but does not discuss

Opposer has not shown how not having a few additional days to prepare her reply brief prejudiced her ability to litigate the case effectively. The first *Pioneer* factor weighs in favor of a finding of excusable neglect.

The second *Pioneer* factor, the length of the delay, involves a factual issue as to when Opposer first learned of the filing of Applicant's brief. There is no dispute that the brief was filed four days late, and Applicant does not deny Opposer's claim that Applicant's brief was not served on Opposer when it was filed on February 9, 2024, but Opposer's counsel Ms. Cooper did not state in her declaration on the motion to strike when or how Opposer learned of the filing of Applicant's brief.<sup>16</sup> She claimed at the oral hearing that Opposer only learned of Applicant's brief 11 days after its filing, but that claim is not supported by her testimony. As discussed above, the impact of the four-day delay in filing on the orderly litigation of this proceeding is negligible, and the second *Pioneer* factor weighs in favor of a finding of excusable neglect.

The third *Pioneer* factor is the reason for Applicant's delay. Although Mr. Leonard does not specify when he removed the February 5, 2024 deadline from Applicant's counsel's docket following the August 14, 2023 filing of the stipulation in which

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how the late filing of Applicant's brief compromised Opposer's ability to prepare her reply brief.

<sup>16</sup> Opposer surely also docketed the dates set forth in the Board's final scheduling order, and reasonably could have been expected to monitor the TTABVUE docket for the case to see if Applicant filed her brief. We note in that regard that the email correspondence between the parties' counsel attached to Ms. Cooper's declaration indicates that Ms. Cooper monitored the filing of Applicant's trial testimony. Cooper Decl. ¶ 4; Ex. A (64 TTABVUE 7).



Applicant withdrew her counterclaim,<sup>17</sup> the removal of the September 5, 2024 due date for the filing of Applicant's brief as the defendant in the opposition in the course of removing all counterclaim-related dates is a plausible oversight. The third *Pioneer* factual is neutral.

The fourth *Pioneer* factor involves whether Applicant acted in bad faith in filing her brief four days late. There is no evidence that Applicant intentionally delayed the filing of her brief to obtain a tactical advantage over Opposer.<sup>18</sup> The fourth *Pioneer* factor is also neutral.

We find, on the basis of the applicable *Pioneer* factors, that Applicant's tardy filing of her brief was the result of excusable neglect and did not result in material prejudice to Opposer. Accordingly, we **deny** Opposer's motion to strike the brief and have considered it our decision.

### **The Parties' Stipulations**

After the close of Applicant's trial period, the parties filed a document captioned "Stipulations By the Parties," 59 TTABVUE 2-3, which contains six numbered Stipulations regarding various subjects. We discuss them below.

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<sup>17</sup> Applicant also does not explain why her brief was filed on February 9, 2024, four days after the original docketed due date.

<sup>18</sup> Opposer argues that Applicant's alleged failure to serve her brief on Opposer was "likely a calculated decision," 64 TTABVUE 3 n.1, in light of past instances in which Opposer had requested Applicant to serve documents that she had filed. There is no evidence to support this argument.

### **Stipulation 5**

We begin with Stipulation 5, which states that “[a]ll evidence and testimony submitted by the Parties is admissible and authenticated.” *Id.* On its face, Stipulation 5 appears to preclude any objection to the admissibility of any “evidence and testimony submitted by the Parties . . . .”

Nevertheless, Opposer objects in her reply brief “to the consideration of the NOIR IP registration and any other unpleaded marks” as well as “any evidence for the purpose of contradicting Applicant’s admissions.” 67 TTABVUE 5. Opposer cites paragraphs 11-12 of the Hornsby Direct Testimony Declaration, *id.* at 5 n.1, in which Applicant testified that she had provided legal services “in the past under different marks,” Hornsby Dir. Test. Decl. ¶ 11 (56 TTABVUE 3), including the mark NOIR IP. Hornsby Dir. Test. Decl. ¶ 12 (56 TTABVUE 3). She referred to Exhibit 41 to her Third Notice of Reliance, which consists of a plain copy of the certificate of registration of Registration No. 6373954 of the mark NOIR IP for legal services. 52 TTABVUE 5. This evidence was filed prior to Opposer’s entry into Stipulation 5, and we find that Opposer’s objection to it is foreclosed by Stipulation 5.<sup>19</sup>

Opposer’s objection in her reply brief to “to the introduction of any evidence for the purpose of contradicting Applicant’s admissions,” 67 TTABVUE 5, is directed to various deemed admissions resulting from Applicant’s failure to respond timely to

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<sup>19</sup> We are not sure exactly what Opposer means by “any other unpleaded marks,” 67 TTABVUE 5, but Applicant’s evidence regarding third-party marks, discussed below in connection with Stipulation 6, was also filed prior to Opposer’s entry into Stipulation 5, and we find that any objection to it by Opposer is similarly foreclosed by Stipulations 5 and 6.

Opposer's First Set of Requests for Admissions, which we discuss below. These objections go to the weight, if any, to be given to any evidence offered by Applicant to contradict or limit the impact of the deemed admissions, rather than to the admissibility of that evidence per se. We have considered any evidence that Applicant offers to contradict or limit the impact of the deemed admissions to the extent to which an admitting party is permitted to introduce contrary or mitigating evidence in the face of its deemed admissions.

**Stipulations 1, 2, and 4**

Stipulation 1 is that "Opposer's mark is valid" and Stipulation 2 is that "Opposer's mark has priority over the Applicant's mark." 59 TTABVUE 2. Stipulation 4 is that "Applicant withdraws all counterclaims (fraud/nonuse/invalidity)." *Id.*<sup>20</sup>

Taken together, these stipulations eliminate any issues as to the validity of the GUARD YOUR GIFTS mark shown in the '081 Registration and as to Opposer's priority of use of that registered mark for purposes of her likelihood of confusion claim. Pursuant to Stipulation 4, we have given Applicant's Third Amended Counterclaim no consideration in our decision, and have dismissed it following entry of the amendments to the '081 Registration discussed below in connection with Stipulation 3.

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<sup>20</sup> Applicant's Third Amended Counterclaim to cancel Opposer's '081 Registration on the grounds of fraud and non-use and Opposer's answer thereto were the operative pleadings on the counterclaim when the parties filed their Stipulations. 25 TTABVUE 2-14; 33 TTABVUE 1-7; 35 TTABVUE 2-12.

### Stipulation 3

Stipulation 3 is that “Opposer’s Motion to amend registration is valid and unopposed.” *Id.* This stipulation appears to provide Applicant’s consent to the granting of one or both of Opposer’s prior unconsented motions to amend her ’081 Registration, which we discuss immediately below. *See Phat Scooters, Inc. v. Fatbear Scooters, LLC*, Canc. No. 92078878, 2023 WL 3034537, at \*2-3 (TTAB 2023).

Shortly after issue was initially joined through the filing of Applicant’s Answer to Opposer’s original Notice of Opposition, Opposer filed a “Motion to Amend Registration,” 6 TTABVUE 2-5, in which she stated that there was “an error in Opposer’s registration and Opposer’s original Notice of Opposition,” *id.* at 4,<sup>21</sup> namely, that Opposer “was not a licensed and/or practicing attorney on 08/01/2015 and thus did not use Opposer’s registered mark in connection with the services listed in said registration.” *Id.*<sup>22</sup> Opposer requested to “amend the registration of the GUARD YOUR GIFTS mark . . . to include the date 08/01/2016 as the date of first use of the mark in question anywhere.” *Id.* at 4.

Two days later, Opposer filed a document captioned “Motion to Strike,” in which she requested that the Board give no consideration to her initial request, but instead

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<sup>21</sup> Opposer pleaded the ’081 Registration in her original Notice of Opposition, 1 TTABVUE 5 (Not. of Opp. ¶ 12), but did not attach USPTO electronic records regarding the registration.

<sup>22</sup> In her deposition, Opposer characterized this as a typographical error. Garrison Tr. 6:14-23; 11:12-21 (57 TTABVUE 7, 12). Applicant appeared to accept that characterization. Garrison Tr. 11:23-25 (57 TTABVUE 12).

consider an amended version. 8 TTABVUE 2-11.<sup>23</sup> The Board noted these filings, stated that “Applicant has not consented to the proposed amendment to Opposer’s registration,” and deferred consideration of the requested amendment until final decision or summary judgment. 15 TTABVUE 4.<sup>24</sup>

Opposer subsequently filed a new motion to amend the ’081 Registration “to amend the recitation of services to remove the redundant listing of specific legal services and thus leaving only the board [sic] category of ‘legal services.’” 27 TTABVUE 2. Opposer’s new motion alluded to her request to the USPTO to amend the claimed date of first use of her mark, *id.* at 4, and argued that the fraud claim in Applicant’s Third Amended Counterclaim based on the incorrect use date was insufficient as a matter of law. *Id.* Applicant opposed this motion on procedural and substantive grounds, 30 TTABVUE 2-7, and Opposer filed a reply. 32 TTABVUE 2-13. As on Opposer’s first motion, the Board deferred action on Opposer’s second motion to amend the ’081 Registration until final decision or summary judgment. 33 TTABVUE 7-8.

When the parties filed their Stipulations, Opposer had filed two motions to amend the ’081 Registration in different respects, but Stipulation 3 that “Opposer’s Motion to amend registration is valid and unopposed” refers to a singular “Motion.” 59 TTABVUE 2. In view of the withdrawal of Applicant’s counterclaim to cancel the ’081

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<sup>23</sup> Opposer also filed a request with the USPTO under Section 7 of the Trademark Act, 15 U.S.C. § 1057, to amend the ’081 Registration to change the claimed date of first use. 11 TTABVUE 2-7.

<sup>24</sup> In an order following the parties’ discovery conference, the Board noted the deferral of consideration of the first motion to amend the ’081 Registration. 21 TTABVUE 2.

Registration on all grounds, including fraud in Opposer's allegation of first use, we interpret Stipulation 3 to manifest Applicant's consent to amendment of the '081 Registration by amending (1) the claimed date of first use of the GUARD YOUR GIFTS mark anywhere from August 1, 2015 to August 1, 2016 and (2) the identification of services to delete all services that follow "Legal services" in the identification. The Board had jurisdiction over the '081 Registration when Stipulation 3 was filed because it was then the subject of Applicant's Third Amended Counterclaim to cancel that registration, and the Board has retained jurisdiction over the '081 Registration up to the time of the dismissal of the Third Amended Counterclaim in this decision. We grant Opposer's motion to amend the '081 Registration and hereby amend that registration by (1) amending the claimed date of first use anywhere from August 1, 2015 to August 1, 2016, and (2) deleting all services described in the identification of services following the first services identified as "legal services." For purposes of our analysis below of Opposer's Section 2(d) likelihood of confusion claim, the services identified in Opposer's '081 Registration are simply "legal services."

**Stipulation 6**

On its face, Stipulation 6 is a head-scratcher. It states that "[t]he following marks are synonymous and similar and the offices associated with each such mark are (or might be) close for the purposes of the TTAB's review of the issues." 59 TTABVUE 2. There are no "following marks" listed in the document and no reference in Stipulation 6 to another document or source that might identify them, no definition of "the offices

associated with each such mark,” and no discussion of the TTAB’s “review of the issues.”

Opposer’s main brief does not discuss Stipulation 6. Applicant’s brief claims that Stipulation 6 means that “the record collectively demonstrates that all registrations identified therein are synonymous and similar and the offices associated with each such mark are (or might be) close for purposes of the TTAB’s review of the issues.” 63 TTABVUE 6. It is unclear what Applicant means by “all registrations identified therein,” but Applicant cites certain testimony from Opposer’s deposition taken on July 10, 2023. We discuss that testimony and other relevant testimony, documentary evidence, and oral argument immediately below.

In her deposition, Opposer was examined about the co-existence of her GUARD YOUR GIFTS mark with various other marks. Garrison Tr. 26:13-37:19 (57 TTABVUE 27-38). After Opposer was examined about the third-party marks SECURE YOUR GENIUS and GUARD YOUR BRAND, Opposer’s counsel stated that “we can stipulate that **all of those registrations that Ms. Hornsby submitted are synonymous with** - - so we don’t have to go through each one, we’ll stipulate that those are similar.” Garrison Tr. 29:16-20 (57 TTABVUE 30) (emphasis added).

Later in her testimony about co-existence with third-party users, Opposer was asked about the proximity of the registrants’ offices to her office in Atlanta, Georgia. Opposer’s counsel stated as follows: “Can I stipulate to something else? Just because . . . **if we’re going to go through this for all 50 of those - - well, let me confirm with my client. I would propose to her that those other offices are close, and**

that's going to speed things along." Garrison Tr. 37:4-10 (57 TTABVUE 38) (emphasis added). Opposer subsequently agreed with her counsel's suggested stipulation. Garrison Tr. 37:14-16 (57 TTABVUE 58).

Like Stipulation 6 itself, these portions of Opposer's deposition transcript are confusing. The phrase "all of those registrations that Ms. Hornsby submitted" appears to refer to the third-party registrations that Applicant referenced in the Hornsby Declaration or submitted under her Notices of Reliance, but as noted below, a number those registrations do not cover marks for the legal services at issue in this case.

In the Hornsby Declaration, Applicant testified that she conducted a search of the USPTO's Trademark Electronic Search System ("TESS") that "show[ed] 50 records in response to the query '(guard preserve protect save secure fortify shelter) [COMB] ADJ (your my their her his) [COMB] and (legal) [GS] and 1A[CB]'," which she identified as Exhibit 18. Hornsby Decl. ¶ 12 (45 TTABVUE 3). The referenced Exhibit 18 is an exhibit to Applicant's First Notice of Reliance rather than to the Hornsby Declaration itself. 47 TTABVUE 42-43.<sup>25</sup> It listed 50 results, including 43 registrations, about a dozen of which were designated as "Dead" in the search results. *Id.* at 43.

In the Hornsby Declaration, Applicant listed 13 registrations from the search that were designated as "Live" at the time, Hornsby Decl. ¶ 12 (45 TTABVUE 3-4), and

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<sup>25</sup> The better practice is to attach exhibits to declarations in which the exhibits are identified, authenticated, and discussed, rather than to cross-reference notices of reliance.



Applicant's Notices of Reliance collectively made of record the following "Live" third-party registrations of marks for legal services: GUARD YOUR BRAND, 46 TTABVUE 5-7; SECURE YOUR GENIUS, *id.* at 8-10; PROTECT MY INTELLECT, 47 TTABVUE 47-59; PROTECT YOUR BRAND + PROTECT YOUR IDEAS = GROW YOUR PROFIT, *id.* at 60-62; PROTECT YOUR BRILLIANCE, *id.* at 63-64; PROTECT YOUR CREATION CREATE YOUR PROTECTION, *id.* at 65-66; PROTECT YOUR INNOVATIONS, *id.* at 67-69; PROTECT YOUR MAGIC, *id.* at 70-72; PROTECT YOUR PASSION, *id.* at 73-75; PROTECT YOUR INTELLECT, 48 TTABVUE 22-23; PROTECT YOUR IDEAS!, *id.* at 24-25; START. RUN. GROW. PROTECT. PROFIT, 49 TTABVUE 6; PROTECT YOUR BIGGEST BUSINESS INVESTMENTS, *id.* at 7; WE PROTECT YOUR BUSINESS LIKE IT'S OUR BUSINESS, 51 TTABVUE 6; WORKING TO PROTECT YOUR BUSINESS, IDEAS, AND PROPERTY ON THE WEB, *id.* at 7; YOUR BRAND IS YOUR BUSINESS, PROTECT IT!, *id.* at 10; SECUREYOURTRADEMARK.COM, 53 TTABVUE 5; WE HELP YOU PROTECT YOUR SMARTS, *id.* at 7-8; WE PROTECT YOUR CREATIVITY, *id.* at 9-10; PURSUE YOUR PASSION, PROTECT YOUR ASSETS, *id.* at 11-13; and PROTECT YOUR BIG IDEAS, *id.* at 14-15.<sup>26</sup>

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<sup>26</sup> The Notices of Reliance also collectively cover some third-party registrations of marks for services other than legal services. 49 TTABVUE 2-4; 51 TTABVUE 2-5, 8-9, 11-14. We do not construe the parties' Stipulation 6 to involve these registrations because the opposed application and the '081 Registration cover identical "legal services," and third-party uses for other services have "no real probative value for the analysis at hand . . . ." *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1326 (Fed. Cir. 2018).

In her brief, Applicant refers to “48 active registrations employing the identical formulaic structure to market closely related legal services,” 63 TTABVUE 14, but that is inaccurate because, as noted above, the TESS results include seven applications and about a dozen “Dead” registrations,<sup>27</sup> and, in any event, the TESS listing is insufficient to make the listed registrations of record. *See, e.g., Edom Labs., Inc. v. Lichter*, Opp. No. 91193427, 2012 WL 1267961, at \*4 (TTAB 2012). We construe Stipulation 6 to apply to the third-party registrations for legal services listed above, and deem those marks to be “synonymous and similar” to the parties’ marks GUARD YOUR GIFTS and GUARD GENIUS WITH NOIR IP for purposes of our analysis of Opposer’s likelihood of confusion claim under Section 2(d). We will also assume for those purposes that the third-party registrants’ respective offices are (or might be) close geographically to Opposer’s office in Atlanta, Georgia.<sup>28</sup>

### **Applicant’s Deemed Admissions**

Under her Amended First Notice of Reliance, Opposer made of record her First Requests for Admissions served on Applicant on August 29, 2022. 42 TTABVUE 4-26. Opposer argues that “Applicant’s response was due on September 28, 2022,” that “Applicant failed to respond timely,” and that “[a]ccordingly, the Requests for

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<sup>27</sup> Applicant’s counsel made a similar reference at the oral hearing to 48 registrations, and Opposer’s counsel identified a similar number.

<sup>28</sup> We are surprised that Opposer would enter into this portion of Stipulation 6 because some of the third-party registrants have addresses that are far afield from Atlanta, Georgia, including Higley, Arizona, 47 TTABVUE 63-64; Sheridan, Wyoming, *id.* at 73-75; Irvine, California, 48 TTABVUE 22-23; Fallbrook, California, *id.* at 24-25; Waltham, Massachusetts, 49 TTABVUE 6; Seattle, Washington, 51 TTABVUE 6; Salinas, California, 51 TTABVUE 10; and New York, New York, 53 TTABVUE 5.

Admissions are deemed admitted.” 62 TTABVUE 10-11 (citing Fed. R. Civ. P. 36(a)(3)). Applicant does not deny that she did not timely respond to Opposer’s First Requests for Admissions and that the Requests are thus deemed admitted under Rule 36(a)(3). 63 TTABVUE 7.<sup>29</sup> We set forth below the deemed admissions that are potentially relevant to Opposer’s likelihood of confusion claim:

- “Opposer’s Mark and the Disputed Mark are similar in appearance,” 42 TTABVUE 8 (Request for Admission No. 9);<sup>30</sup>
- “the phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ intellectual property rights,” *id.* (Request for Admission No. 10);
- “the phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ creativity or talent,” *id.* (Request for Admission No. 11);
- “the phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ ideas,” *id.* (Request for Admission No. 12);
- “the phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ smarts or intellect,” *id.* (Request for Admission No. 13);
- “GUARD YOUR GENIUS is the dominant component of Applicant’s Mark,” *id.* (Request for Admission No. 14);
- “the term GIFTS is synonymous with the term ‘GENIUS,’” *id.* (Request for Admission No. 15);
- “the term GIFTS is synonymous with the term ‘TALENT,’” *id.* at 9 (Request for Admission No. 16);

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<sup>29</sup> Applicant characterizes the deemed admissions as “technical admissions,” 63 TTABVUE 7, but as discussed below, they have the same effect as admissions that were made expressly.

<sup>30</sup> The “Disputed Mark” is defined in the Requests for Admissions as “the mark identified in Application Serial No. 88933811 and any variations.” 42 TTABVUE 5.

- “the phrase GUARD YOUR GIFTS is synonymous with GUARD YOUR GENIUS,” *id.* (Request for Admission No. 17);
- “the NOIR IP elements in the Disputed Mark is or references Applicant’s trade name,” *id.* (Request for Admission No. 18);
- “Applicant’s legal services are identical to Opposer’s legal services; legal services in relation to the negotiation of contracts for others; legal services relating to company formation and registration; legal services relating to the exploitation of broadcasting rights; legal services relating to the exploitation of film copyright; legal services, namely, preparation of applications for trademark registration; legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of entertainment/radio/tv/film/media; legal services, namely, trademark maintenance services; legal services, namely, trademark searching and clearance services; legal advisory services; legal consultation services; legal document preparation services; licensing of intellectual property in the field of trademarks and copyrights,” *id.* (Request for Admission No. 19);
- “Applicant’s legal services are competitive with Opposer’s legal services; legal services in relation to the negotiation of contracts for others; legal services relating to company formation and registration; legal services relating to the exploitation of broadcasting rights; legal services relating to the exploitation of film copyright; legal services, namely, preparation of applications for trademark registration; legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of entertainment/radio/tv/film/media; legal services, namely, trademark maintenance services; legal services, namely, trademark searching and clearance services; legal advisory services; legal consultation services; legal document preparation services; licensing of intellectual property in the field of trademarks and copyrights,” *id.* (Request for Admission No. 20);
- “[Y]ou intend to offer your services under the Disputed Mark via social media,” *id.* (Request for Admission No. 21);<sup>31</sup>
- “[Y]ou intend to offer your services under the Disputed Mark using a top-level domain via the world wide web,” *id.* at 10 (Request for Admission No. 22); and

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<sup>31</sup> “You” is defined in the Requests for Admissions as “Applicant or any of her employees or agents, or any Person or entity acting for or on behalf of Applicant.” 42 TTABVUE 7.

- “[T]he target purchasers of Applicant’s services offered or intending [sic] to be offered under the Disputed Mark are small businesses and entrepreneurs,” *id.* (Request for Admission No. 29).

These “requests are deemed admitted by operation of law,” and “[t]he effect of such admissions is that the subject matter of the requests is ‘conclusively established unless the [Board], on motion, permits the admission[s] to be withdrawn or amended under Fed. R. Civ. P. 36(b), or reopens the time to respond to the admission requests ‘so that the admissions would not be deemed admitted as put.’” *Learning Journey Int’l, L.L.C. v. Youngfu*, Canc. No. 92082654, 2024 WL 4117143, at \*3 (TTAB 2024) (citing and quoting *Giersch v. Scripps Network, Inc.*, Canc. No. 92045576, 2007 WL 1653585, at \*1 (TTAB 2007)). The Board took neither action in this case, and the admissions are conclusively established.

## **II. Opposer’s Entitlement to a Statutory Cause of Action**

“To establish entitlement to bring 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 or continued registration of the mark.” *Iron Balls Int’l Ltd. v. Bull Creek Brewing, LLC*, Canc. No. 92079099, 2024 WL 284425, at \*1 (TTAB 2024) (citations omitted). Applicant does not address Opposer’s entitlement to oppose, but “[a] plaintiff’s entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case even if, as here, the defendant does not contest the plaintiff’s entitlement.” *Sabhnani v. Mirage Brands, LLC*, Canc. No. 92068086, 2021 WL 6072822, at \*6 n.14 (TTAB 2021).

Opposer argues that she has “standing” to maintain this opposition because she “alleges (i) common law rights in, and ownership of registration for Opposer’s Mark; (ii) Opposer would be damaged by registration of Applicant’s Disputed Mark; and (iii) the marks of the parties are similar, the services at issue are related, and confusion is the likely result.” 62 TTABVUE 10.<sup>32</sup> As noted above, Opposer properly made of record her pleaded subsisting ’081 Registration of GUARD YOUR GIFTS for legal services, giving her the basis of a Section 2(d) likelihood of confusion claim that is not wholly without merit. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000). Having established her entitlement to oppose on that ground, Opposer has established her entitlement to oppose on any other ground, including her claim that Applicant lacked a bona fide intention to use her mark. *Spotify AB v. U.S. Software Inc.*, Opp. Nos. 91243297 and 91248487, 2022 WL 110251, at \*9 (TTAB 2022) (citation omitted).

### **III. Opposer’s Section 2(d) Claim**

“Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits 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

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<sup>32</sup> “We now refer to what previously had been called ‘standing’ as entitlement to a statutory cause of action. But our prior decisions and those of the Federal Circuit interpreting ‘standing’ under §§ 13 and 14 [of the Trademark Act] remain applicable.” *Sabhnani*, 2021 WL 6072822, at \*6 n.14 (quotation and quotation marks omitted).

to deceive.” *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 WL 1638376, at \*4 (TTAB 2024) (quoting 15 U.S.C. § 1052(d)).

### **A. Priority**

As discussed above, Opposer properly made of record her '081 Registration of GUARD YOUR GIFTS for legal services. Priority is not at issue when a plaintiff asserts a registered mark and the defendant does not counterclaim to cancel the involved registration. *Id.* Here, Applicant originally counterclaimed to cancel the '081 Registration, but withdrew all of her counterclaims prior to trial and stipulated that “Opposer’s mark has priority over the Applicant’s mark.” 59 TTABVUE 2. Accordingly, Opposer has priority of use of GUARD YOUR GIFTS for the legal services identified in the '081 Registration.

### **B. Likelihood of Confusion**

To prevail on her Section 2(d) claim, Opposer must show by a preponderance of the evidence that “Applicant’s use of [her] mark is likely to cause confusion, mistake, or deception regarding the source of the services identified in [her] Application.” *Sage Therapeutics*, 2024 WL 1638376, at \*4 (citation omitted).

“Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion.” *Id.* at \*4 (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). “We must consider each *DuPont* factor for which there is evidence and argument.” *Id.* (citing *In re Guild Mortg.*, 912 F.3d 1376, 1380 (Fed. Cir. 2019)). “Two key factors in every Section 2(d) case are the first two factors

regarding the similarity or dissimilarity of the marks and the goods or services, because the fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *DC Comics v. Cellular Nerd LLC*, Opp. No. 91246950, 2022 WL 17832492, at \*10 (TTAB 2022) (internal quotations and quotation marks omitted).

In her main brief, Opposer discusses the key first and second *DuPont* factors, 62 TTABVUE 13-14, as well as the third *DuPont* factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *id.* at 14 (quoting *DuPont*, 476 F.2d at 1361), and the seventh *DuPont* factor, the “nature and extent of any actual confusion.” *Id.* at 15 (citing *DuPont*, 476 F.2d at 1361).

Applicant’s brief also discusses the first, second, and third *DuPont* factors, 63 TTABVUE 7, 13-14, as well as the sixth and eleventh factors, the “number and nature of similar marks in use on similar goods” and the “extent to which applicant has a right to exclude others from use of [her] mark on [her services],” respectively, *DuPont*, 476 F.2d at 1361, 63 TTABVUE 7-9, 14-16; the seventh factor, *id.* at 17-18, 20; and the eighth factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 476 F.2d at 1361. 63 TTABVUE 18-19.<sup>33</sup>

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<sup>33</sup> Applicant also refers to the tenth *DuPont* factor, the “market interface between applicant and the owner of a prior mark . . . .” *DuPont*, 476 F.2d at 1361. 63 TTABVUE 18-19. “The tenth *DuPont* factor requires us to consider evidence pertaining to the ‘market interface’ between the parties, including evidence of any past dealings between the parties that might indicate a lack of confusion in the present case.” *KME Ger. GmbH v. Zhe Jiang Hailiang Co.*, Opp. No. 91267675, 2023 WL 6366806, at \*19 (TTAB 2023). “*DuPont* lists several possible market interfaces, such as (1) consent to register or use; (2) contractual provisions designed to preclude confusion; (3) assignment; and (4) laches and estoppel attributable to the



**1. Similarity or Dissimilarity of the Services, Channels of Trade, and Classes of Consumers**

“The second *DuPont* factor concerns the ‘similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *Iron Balls*, 2024 WL 2844425, at \*15 (quoting *DuPont*, 476 F.2d at 1361), while the “third *DuPont* factor concerns [t]he similarity or dissimilarity of established, likely-to-continue trade channels . . . .” *Id.* at \*22 (quoting *DuPont*, 476 F.2d at 1361).

The '081 Registration and the opposed application both cover identical “legal services,” and “[w]ith respect to similarity of the established trade channels through which the services reach customers, we presume identical services move in the same channels of trade and are available to the same classes of customers for such services . . . .” *Sage Therapeutics*, 2024 WL 1638376, at \*8 (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“it is well established that, absent restrictions in the application and registration, [identical] [services] are presumed to travel in the same channels of trade to the same class of purchaser.”)). In her brief, Applicant concedes

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challenge that would indicate lack of confusion.” *Id.* (quoting *Cunningham*, 222 F.3d at 949). In *KME*, the Board “expand[ed] the types of ‘market interfaces’ relevant under the tenth *DuPont* factor to include the sale of a portion of an ongoing business to a direct competitor, and to consider the impact of certain ‘agreement provisions’ . . . ‘designed to prevent confusion.’” *KME*, 2023 WL 6366806, at \*19 (quoting *DuPont*, 476 F.2d at 1361). Applicant does not discuss any of these types of market interfaces, but instead misuses the term to support her arguments under the eighth *DuPont* factor, concluding that Opposer’s mark, third-party marks, and Applicant’s mark “have coexisted in overlapping market interfaces, without confusion” for a number of years and “will continue to coexist in this manner regardless of the outcome of this proceeding.” 63 TTABVUE 19. Where, as here, there is no “market interface” of the sorts discussed in *Cunningham* and *KME*, the tenth factor simply does not apply in our analysis of the likelihood of confusion, and we have given it no consideration in our decision.

“the similarity of services and trade channels under *du Pont* factors 2 and 3 . . . .” 63 TTABVUE 21.

The services, channels of trade, and classes of consumers are identical, and “the second and third *DuPont* factors thus strongly favor a finding of a likelihood of confusion.” *KME*, 2023 WL 6366806, at \*9.

## 2. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Iron Balls*, 2024 WL 2844425, at \*11 (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Sage Therapeutics*, 2024 WL 1638376, at \*5 (quotation and quotation marks omitted). “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.” *Id.* (quoting *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)). “The focus is on the recollection of the average purchaser, who normally ‘retains a general rather than a specific impression of marks.’” *Id.* (quoting *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 WL 3993582, at \*4 (TTAB 2018)). The average purchasers here, consumers of legal services, include members of the general public.

“Similarity is not a binary factor but is a matter of degree.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at \*14 (TTAB 2023) (quoting *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (internal quotation omitted)).

Because the involved services are identical, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines.” *Id.* (citing *i.am.symbolic*, 2018 WL 3993582, at \*5).

Applicant’s mark is GUARD YOUR GENIUS WITH NOIR IP, while Opposer’s mark is GUARD YOUR GIFTS. As noted above, with respect to the marks, Applicant has conclusively admitted that:

- GUARD YOUR GENIUS WITH NOIR IP and GUARD YOUR GIFTS “are similar in appearance;”
- “GUARD YOUR GENIUS is the dominant component of Applicant’s Mark;”
- “The phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ intellectual property rights;”
- “The phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ creativity or talent,”
- “The phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ ideas;”
- “The phrase GUARD YOUR GENIUS WITH NOIR IP means or is a reference to protecting business owners’ and/or creators’ smarts or intellect;” and
- “The phrase GUARD YOUR GIFTS is synonymous with GUARD YOUR GENIUS.”

Opposer argues that Applicant’s admissions “establish that Applicant’s Disputed Mark is confusingly similar to Opposer’s Mark.” 62 TTABVUE 11. Opposer further argues that “[b]y Applicant’s own admission, the Disputed Mark and Opposer’s Mark share the same dominant component and are similar in appearance,” *id.* at 13, that the “Disputed Mark and Opposer’s Mark are aurally similar in that the dominant

component, ‘GUARD YOUR’ is identical, both have three syllables, and they share the ‘G’ alliteration,” and that “[b]y Applicant’s own admission, the Disputed Mark and Opposer’s Mark have identical connotations and commercial impressions.” *Id.* at 13-14.

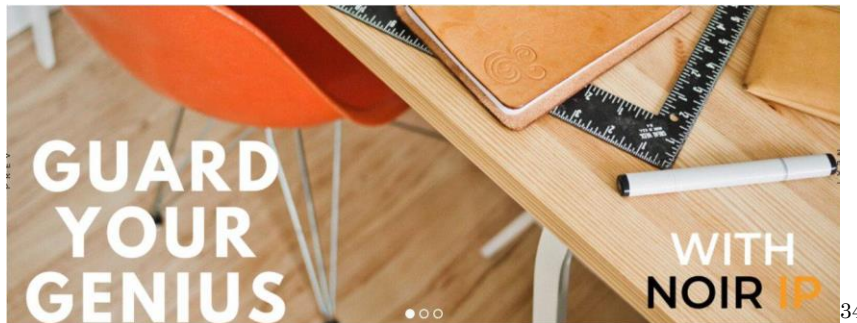
Under the argument heading “**The Parties’ marks are similar, but not confusingly similar,**” 63 TTABVUE 13 (emphasis supplied by Applicant), Applicant “acknowledges that its technical admissions establish similarities between the marks in certain respects,” *id.*, “concedes that the marks share the dominant [guard your] element which creates similarity in appearance,” *id.*, and “admits that this dominant element carries the same laudatory meaning connoting protection of intellectual property rights.” *Id.* Applicant nevertheless argues that “these admissions do not establish that the marks share an identical commercial impression or necessitate a finding of confusing similarity. Rather, taking into account all relevant facts, the technical admissions of similarity do not compel a determination of **confusing** similarity.” *Id.* at 13-14 (emphasis in bold here in italics in Applicant’s brief).

In her reply brief, Opposer responds to these arguments as follows:

Applicant[ ] provides no explanation as to her conclusory argument that the marks do not share the same commercial impression and thus, it should be given no consideration because Applicant’s admissions concede that the connotation and commercial impression are not just similar but identical. The marks have the identical meanings and are applied to identical services. Therefore, when used in connection with those services, the commercial impression is the same – Our Firm will/can help you to protect (*i.e.*, Guard) your talents/intellectual property (*i.e.*, Gifts/Genius).

67 TTABVUE 9.

Given Applicant’s conclusive admission that “GUARD YOUR GENIUS is the dominant component of Applicant’s Mark,” we will give greater weight in the required comparison of the marks in their entireties to the phrase GUARD YOUR GENIUS at the outset of Applicant’s mark than to the phrase WITH NOIR IP at its end. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1305 (Fed. Cir. 2018) (“in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties” (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)). In addition, because Applicant’s mark is a standard-character mark, “we consider possible displays that emphasize the common element” between the marks, the two lead words GUARD YOUR. *Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Canc. No. 92079409, 2024 WL 3739358, at \*9 (TTAB 2024). A portion of Applicant’s specimen of use reproduced below emphasizes that common element between the marks by displaying the phrase GUARD YOUR GENIUS in a more prominent font than, and separate and apart from, the words WITH NOIR IP:



<sup>34</sup> May 26, 2020 Application at TSDR 3. Applicant described her specimen as the homepage on her firm’s website. *Id.* at TSDR 1.

Applicant has conclusively admitted that GUARD YOUR GIFTS and GUARD YOUR GENIUS WITH NOIR IP are similar in appearance. With respect to sound, both marks begin with the identical lead words GUARD YOUR followed by a third word beginning with the letter “G,” making Opposer’s mark GUARD YOUR GIFTS and the lead portion of Applicant’s mark GUARD YOUR GENIUS more similar than dissimilar in sound even if Applicant’s mark is verbalized in full as GUARD YOUR GENIUS WITH NOIR IP. The similarity of the marks in sound will be greater “if consumers engage in ‘the penchant of consumers to shorten marks,’” *Sabhnani*, 2021 WL 6072822, at \*18 (quoting *In re Bay State Brewing Co.*, Ser. No. 85826258, 2016 WL 1045677, at \*3 (TTAB 2016)), and do not verbalize the phrase WITH NOIR IP, which is separated from the phrase GUARD YOUR GENIUS on Applicant’s website.

With respect to meaning, Applicant has conclusively admitted that the “phrase GUARD YOUR GIFTS is synonymous with GUARD YOUR GENIUS,” and Applicant admits in her brief that the GUARD YOUR element in the parties’ marks “carries the same laudatory meaning connoting protection of intellectual property rights.” 63 TTABVUE 13. We find that the marks GUARD YOUR GIFTS and GUARD YOUR GENIUS WITH NOIR IP are more similar than dissimilar in meaning when used with identical legal services.

A consumer with a general rather than specific recollection of Opposer’s mark GUARD YOUR GIFTS for legal services who separately sees or hears Applicant’s mark GUARD YOUR GENIUS WITH NOIR IP in connection with the identical services could reasonably assume that Applicant’s mark contains the name of the

previously anonymous provider of legal services offered under the GUARD YOUR GIFTS mark, or involves additional services from that previously anonymous source. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48 (Fed. Cir. 2011) (holding that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical” and finding that the marks ML in standard characters and ML MARK LEES (stylized) were similar when used on identical goods); *In re Fiesta Palms, LLC*, Ser. No. 76595049, 2007 WL 950952, at \*7 (TTAB 2007) (finding that the marks CLUB PALMS MVP and MVP were similar when used on identical services).

The marks GUARD YOUR GIFTS and GUARD YOUR GENIUS WITH NOIR IP are more similar than dissimilar in all means of comparison when used with identical services, and the first *DuPont* factor supports a conclusion that confusion is likely. *Naterra, Inc. v. Bensalem*, 92 F.4th 1113, 1119 (Fed. Cir. 2024).

### **3. The Nature and Number of Marks in Use on Similar Services**

The sixth *DuPont* factor is “the number and nature of similar marks in use on similar goods [or services],” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (quoting *DuPont*, 476 F.2d at 1361), “which is a measure of the extent to which other marks weaken the asserted mark.” *Id.* “There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.” *Id.* “Conceptual strength is a measure of a mark’s distinctiveness,” *id.*, while commercial strength “is the marketplace recognition value of the mark.” *Id.* at 1363 (quotation omitted).

As discussed above, Applicant made of record numerous third-party registrations of marks for legal services that are the subject of the parties' Stipulation 6. "The existence of third-party registrations on similar goods [or services] can bear on a mark's conceptual strength," *id.* (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)), and "third-party registrations containing an element that is common to both the opposer's and the applicant's marks can show that the element has 'a normally understood and well-recognized descriptive or suggestive meaning.'" *Id.* (quoting *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015)).

Applicant argues that "the solitary commonality between the marks lies in a formulaic structure of [action verb] + [possessive pronoun] + [abstract IP noun]." 63 TTABVUE 14. Applicant claims that "overwhelming evidence establishes that this precise structural formulation is exceptionally weak and diluted across the field of intellectual property legal services." *Id.*

Opposer responds that Applicant "has not provided any evidence of third party marks that share the 'same or similar term or mark component' such that any 'term' or 'component' of Opposer's Mark is weak," 67 TTABVUE 10-11, and "fails to cite to a single authority that her theory that the 'formulaic structure' of the mark renders a mark weak or precludes a finding of a likelihood of confusion." *Id.* at 11.

We agree with Opposer that Applicant's claimed "formulaic structure" of the involved marks GUARD YOUR GENIUS WITH NOIR IP and GUARD YOUR GIFTS, and the marks in the third-party registrations, is not the sort of "common element"



between marks that is contemplated in the Federal Circuit's *Spireon*, *Jack Wolfskin*, and *Juice Generation* cases. It is self-evident that consumers focus on words and other elements of marks, which may have "a normally understood and well-recognized descriptive or suggestive meaning," and do not look at marks as grammatical forms. Here, the "common element" of the marks GUARD YOUR GENIUS WITH NOIR IP and GUARD YOUR GIFTS is the words 'GUARD YOUR' that are the lead words in each mark, and only one of the registered third-party marks for legal services, GUARD YOUR BRAND, 46 TTABVUE 5-7, contains that common element.

As discussed above, the parties agreed in Stipulation 6 that the following marks for legal services are "synonymous and similar" to GUARD YOUR GIFTS: GUARD YOUR BRAND; SECURE YOUR GENIUS; PROTECT MY INTELLECT; PROTECT YOUR BRAND + PROTECT YOUR IDEAS = GROW YOUR PROFIT; PROTECT YOUR BRILLIANCE; PROTECT YOUR CREATION CREATE YOUR PROTECTION; PROTECT YOUR INNOVATIONS; PROTECT YOUR MAGIC; PROTECT YOUR PASSION; PROTECT YOUR INTELLECT; PROTECT YOUR IDEAS!; START. RUN. GROW. PROTECT. PROFIT; PROTECT YOUR BIGGEST BUSINESS INVESTMENTS; WE PROTECT YOUR BUSINESS LIKE IT'S OUR BUSINESS; WORKING TO PROTECT YOUR BUSINESS, IDEAS, AND PROPERTY ON THE WEB; YOUR BRAND IS YOUR BUSINESS, PROTECT IT!; SECUREYOURTRADEMARK.COM; WE HELP YOU PROTECT YOUR SMARTS; WE PROTECT YOUR CREATIVITY; PURSUE YOUR PASSION; PROTECT YOUR ASSETS; and PROTECT YOUR BIG IDEAS. Through Stipulation 6, the parties

agreed that these marks are all similar in meaning to GUARD YOUR GIFTS in the context of legal services.

We find, however, that with the exception of the GUARD YOUR BRAND mark, none of these third-party marks is as similar in overall appearance, sound, and meaning to either of the involved marks GUARD YOUR GIFTS and GUARD YOUR GENIUS WITH NOIR IP as those marks are to each other.<sup>35</sup> Almost all of the third-party marks contain the word PROTECT, which the parties agree is similar in meaning to GUARD, but they also contain significant additional matter that makes the marks different from GUARD YOUR GIFTS in appearance and sound. The single registration of GUARD YOUR BRAND is “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both *Jack Wolfskin* and *Juice Generation*.” *Sabhnani*, 2021 WL 6072822, at \*13 (quotation and quotation marks omitted). *See In re Morinaga Nyugyo K.K.*, Ser. No. 86338392, 2016 WL 5219811, at \*9 (TTAB 2016) (“in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record . . . and in *Jack Wolfskin*, there were at least fourteen . . .”). We find that the third-party registrations in the record, coupled with Stipulation 6, are insufficient to show that the common element GUARD YOUR in the involved marks “has ‘a normally

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<sup>35</sup> Ms. Garrison acknowledged that GUARD YOUR BRAND and SECURE YOUR GENIUS both convey the same meaning as GUARD YOUR GIFTS. Garrison Tr. 29:10-15 (57 TTABVUE 30). She testified that she did not believe that the marks were “the same or similar” to her mark because while they meant the same thing, “the wording is not the same and it’s not similar.” Garrison Tr. 32:7-19 (57 TTABVUE 33).

understood and well-recognized descriptive or suggestive meaning,'” *Spireon*, 71 F.4th at 1363, and is thus conceptually weak.

The actual use of third-party marks may diminish the commercial strength of an asserted mark. *Id.* at 1364-66. The numerous third-party registrations in the record are themselves “not evidence of what happens in the market place or that consumers are familiar with them.” *Id.* at 1365 (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406 (CCPA 1973)). In *Spireon*, the Federal Circuit held that the opposer bears the “burden of showing non-use of identical [registered] marks for identical goods,” *Spireon*, 71 F.4th at 1365, but there are no such marks in the record here, so “the burden rested on the applicant to establish that [the] prior [registered] marks were actually in use.” *Id.* (citing *AMF*, 474 F.2d at 1406).

Applicant elicited testimony from Ms. Garrison that the marks GUARD YOUR BRAND and SECURE YOUR GENIUS are in use in commerce. Garrison Tr. 30:3-10; 31:11-14, 22-25; 32:1-3 (57 TTABVUE 31-33). She further testified that she was familiar with the owner of the GUARD YOUR BRAND mark, Sperry IP Law, and acknowledged that Sperry IP Law had an office fewer than five miles from her own office. Garrison Tr. 33:16-34:7, 17-19; 35:13-36:22 (57 TTABVUE 36-37). She denied knowing much about the practice of Sperry IP Law, Garrison Tr. 33:16-22 (57 TTABVUE 34), and Applicant did not offer other evidence regarding the nature, duration and extent of the firm’s rendition of legal services under the GUARD YOUR

BRAND mark. Applicant similarly offered no evidence of the nature, duration, or extent of the use of any of the other registered marks for legal services.<sup>36</sup>

We find that with the exception of the GUARD YOUR BRAND and SECURE YOUR GENIUS marks, Applicant did not establish that the “prior marks were actually in use,” *Spireon*, 71 F.4th at 1365, and that as to the GUARD YOUR BRAND and SECURE YOUR GENIUS marks, Applicant did not show that the use of the marks was sufficient to diminish the commercial strength of Opposer’s GUARD YOUR GIFTS mark.

Opposer’s GUARD YOUR GIFTS mark issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and “so is treated as inherently distinctive.” *Monster Energy*, 2023 WL 417620, at \*10. Applicant did not show the conceptual or commercial weakness of the mark through the third-party marks in the record, and we will give Opposer’s GUARD YOUR GIFTS mark ‘the normal scope of protection to which inherently distinctive marks are entitled.’” *Sage Therapeutics*, 2024 WL 1638376, at \*10 (quoting *Bell’s Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 WL 6525233, at \*9 (TTAB 2017)). The sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

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<sup>36</sup> As discussed above, the parties agreed in Stipulation 6 that the offices of the third-party registrants are (or might be) close geographically to Opposer’s office in Atlanta, Georgia, but that alone tells us nothing about the registrants’ uses of their respective marks for legal services.

#### 4. The Seventh and Eighth *DuPont* Factors

“The seventh and eighth *DuPont* factors respectively address ‘the nature and extent of any actual confusion’ and ‘the length of time during which and the conditions under which there has been concurrent use without evidence of actual confusion.’” *Monster Energy*, 2023 WL 417620, at \*18 (quoting *DuPont*, 476 F.2d at 1361).

Opposer argues that she has provided evidence of actual confusion in her Rebuttal Declaration, in which she testified that “I am aware of at least one occasion of actual confusion.” Garrison Rebut. Decl. ¶ 7 (60 TTABVUE 3). She recounted an instance “[o]n or about September 2020” in which a person who ultimately became her client “was inquiring about my brand while browsing instagram” and “typed in ‘guardyour’ to search for my instagram page [and] Ms. Hornsby’s page came up.” Garrison Rebut. Decl. ¶ 7 (60 TTABVUE 3). According to Ms. Garrison, the prospective client “gave me the phone and asked me if that was my brand and after looking at it I confirmed that it wasn’t.” Garrison Rebut. Decl. ¶ 7 (60 TTABVUE 3).

Applicant argues that “an inquiry as to the relationship between a company and a brand, as we have here, is not evidence of confusion.” 63 TTABVUE 18 (citations omitted). We agree. “A single inquiry about whether a mark indicates affiliation between parties does not generally evidence actual confusion.” *Major League Baseball Players Ass’n v. Chisena*, Opp. Nos. 91240180, 91242556, and 91243244, 2023 WL 2986321, at \*25 (TTAB 2023), *appeal docketed*, No. 23-2073 (Fed. Cir. June 26, 2023). *See also Sabhnani*, 2021 WL 6072822, at \*23 (“inquiries as to whether the companies are related . . . do not demonstrate confusion [but] rather . . . that the individuals unders[tood] that the companies may be different entities.”) (internal quotation and

quotation marks omitted). We find that there is no evidence of actual confusion in the record and the seventh *DuPont* factor is thus neutral in our analysis of the likelihood of confusion.

“The eighth *du Pont* factor . . . ‘[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion’ . . . requires us to look at **actual market conditions**, to the extent there is evidence of such conditions of record. In this regard, we consider all of the evidence of record that may be relevant to the eighth *du Pont* factor.” *In re Guild Mortg. Co.*, Ser. No. 86709944, 2020 WL 1639916, at \*8 (TTAB 2020) (emphasis in *Guild Mortg.*) (quoting *DuPont*, 476 F.2d at 1361).

The “absence of evidence of actual confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of [her] mark for a significant period of time in the same markets as those served by Opposer under [her] mark.” *KME*, 2023 WL 6366806, at \*21. “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Id.* In that regard, Applicant argues only that the “Parties’ marks have coexisted . . . for at least 3 years,” 63 TTABVUE 19, and “submits that, if confusion were likely to occur given these overlapping market interfaces, there would have been a more robust showing of actual confusion by now.” *Id.*

At the time of trial, Opposer was a solo practitioner with an office in Atlanta, Georgia and Applicant was a solo practitioner with an office in Miami, Florida. The subject areas of their practices overlap to the extent that both include intellectual

property law, but there is no evidence that their respective marks have been exposed to the same potential purchasers of their legal services. We cannot find on this record that there has been “appreciable and continuous use by Applicant of [her] mark for a significant period of time in the same markets as those served by Opposer under [her] mark.” *KME*, 2023 WL 6366806, at \*21. The eighth *DuPont* factor is also neutral in our analysis of the likelihood of confusion.

#### 5. Eleventh *DuPont* Factor

Applicant argues in passing that the existence of the GUARD YOUR BRAND and SECURE YOUR GENIUS marks discussed above “implicates *du Pont* factor 11.” 63 TTABVUE 15. The eleventh *DuPont* factor “considers any evidence that **an applicant** has a right to exclude third parties from using **its** mark.” *KME*, 2023 WL 6366806, at \*22 (citing *DuPont*, 476 F.2d at 1361) (emphasis added). “The applicant’s right to exclude is a right appurtenant to the applicant’s trademark use,” and “‘applicant’s right to exclude’ considers applicant’s place in the market and any resulting consumer perception as defined by the applicant’s trademark use, insofar as that use is reflected in the mark and goods described in the application.” *Monster Energy*, 2023 WL 417620, at \*20. “Under this factor, the Board assesses whether the applicant has achieved ‘an appreciable level of consumer recognition’ **and** whether the applicant could demonstrate having ‘successfully asserted its [trademark] rights.’” *KME*, 2023 WL 6366806, at \*22 (emphasis in *KME*) (citing *Monster Energy*, 2023 WL 417620, at \*21-22).

Applicant has provided no information regarding the exposure of her mark and whether she has enforced it. Because “there is no evidence that Applicant has

successfully asserted [her] rights so as to ‘exclude’ third parties from using [her] mark, this *DuPont* factor is not relevant, or is neutral.” *Id.*

## **6. Discussion of *DuPont* Factors**

The key first and second *DuPont* factors, and the third factor, strongly support a conclusion that confusion is likely. The marks are more similar than dissimilar in appearance, sound, and connotation and commercial impression, and the involved services, channels of trade, and classes of consumers are identical. The sixth *DuPont* factor is neutral because while there are multiple marks that are registered for legal services that are synonymous and similar in meaning to the parties’ marks, virtually all of those marks are different in appearance and sound from Opposer’s mark, the record shows that only two of the marks are in use, and only one of them is as similar to the parties’ marks as those marks are to each other. The seventh and eighth *DuPont* factors are neutral because while the record does not show any actual confusion, the record also shows that there has not been a reasonable opportunity for confusion to have occurred, and the eleventh *DuPont* factor is neutral because the record does not show that Applicant has enforced either her applied-for mark or her registered NOIR IP mark.

We find, on the basis of the record as a whole, that a consumer with a general rather than specific recollection of Opposer’s mark GUARD YOUR GIFTS for legal services who separately encounters Applicant’s mark GUARD YOUR GENIUS WITH NOIR IP for the identical services is likely to believe mistakenly that the services have a common source.



#### **IV. Summary**

Opposer proved her entitlement to oppose and the priority and likelihood of confusion elements of her Section 2(d) claim. Because she prevailed on that claim, we need not and do not reach her additional claim that Applicant lacked a bona fide intention to use her mark when the opposed application was filed. *KME*, 2023 WL 6366806, at \*2.

**Decision:** The opposition is sustained. Opposer's Registration No. 5895081 is amended by (1) amending the claimed date of first use anywhere from August 1, 2015 to August 1, 2016, and (2) deleting all services described in the identification of services following the first services identified as "legal services." Applicant's Third Amended Counterclaim to cancel Opposer's registration is dismissed following the entry of the amendments to the registration set forth above.