

THIS ORDER IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 10, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Everwest Technologies - FZCO
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Serial Nos. 97417414 and 97417422
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Joseph V. Norvell, James M. McCarthy, Samantha J. Yozze, and Anthony M. DeLongis of NORVELL IP LLC,
for Everwest Technologies - FZCO.

Marc Leipzig, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Wellington, Lynch, and Elgin,
Administrative Trademark Judges.

Order by Elgin, Administrative Trademark Judge:

A typographical error in a registration number in the October 2, 2024 opinion of the Board is corrected as follows. On page 3 of the opinion, footnote 4 is corrected to read:

Reg. No. 4919699 registered March 15, 2016 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a); declaration of use under Trademark Act Section 8, 15 U.S.C. § 1058, accepted.

The period for filing an appeal continues to run from the October 2, 2024 mailing date of the decision.

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Before Wellington, Lynch, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Everwest Technologies - FZCO (“Applicant”) seeks registration on the Principal
Register of the marks MYQRCODE.COM (in standard characters) and the composite

mark  MyQR**CODE** (both with “QR**CODE**” disclaimed) for the following services:

“Providing on-line non-downloadable software for generating machine-readable

barcodes; Software as a service (SAAS) services featuring software for generating machine-readable barcodes,” in International Class 42.¹

Although these appeals were not formally consolidated, we issue a single decision because the records are essentially the same and there are many common issues. *See In re Locus Link USA*, Exp. No. 2022-100137E, 2024 TTAB LEXIS 225, at *1 (issuing single opinion in related cases) (citing *In re Pohl-Boskamp GmbH & Co.*, Ser. No. 85007428, 2013 TTAB LEXIS 7, at *3 (TTAB 2013) and *In re Binion*, Ser. No. 76590702, 2009 TTAB LEXIS 701, at *3 (TTAB 2009)).²

The Trademark Examining Attorney refused registration of Applicant’s marks under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that, as applied to the services identified in the application, they so resemble the three marks below as to be likely to cause confusion, to cause mistake, or to deceive. The cited marks are registered on the Supplemental Register and owned by Denso Wave Inc.

QR Code (stylized) for “two dimensional data code readers; bar code readers; two dimensional datacode scanners; bar code scanners; electronic database featuring two dimensional codes recorded on computer media and capable of being read by two dimensional code readers and scanners; computer programs for two dimensional code drawing, computer programs for bar code drawing,

¹ Ser. Nos. 97417414 (standard character mark) and 97417422 (composite mark) were filed on May 21, 2022 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegations of bona fide intention to use the marks in commerce. The composite mark is described as “four rectangles in an overall rectangle shape, with the top left and bottom right rectangles having a smaller rectangle inside, all appearing to the left of the wording ‘MYQRCODE.’”

² Citations to filings with the Board are to TTABVUE. Citations to the prosecution records refer to the .pdf versions in the TSDR system. *See In re Integra Biosciences Corp.*, Ser. No. 87484450, 2022 TTAB LEXIS 17, at *6 (TTAB 2022); *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020).

computer program recorded on compact disks for two dimensional code drawing; and computer program recorded on memory cards for two dimensional code drawing,” in International Class 9;³

QR CODE (standard characters) for “Downloadable electronic data files featuring two dimensional codes; two dimensional data code readers; bar code readers; two dimensional datacode scanners; bar code scanners; electronic database featuring two dimensional codes recorded on computer media and capable of being read by two dimensional code readers and scanners; computer programs for two dimensional code drawing, computer programs for bar code drawing, computer program recorded on compact disks for two dimensional code drawing; and computer program recorded on memory cards for two dimensional code drawing; downloadable mobile application for scanning and reading codes,” in International Class 9;⁴ and

QR CODE (standard characters) for “Providing on-line non-downloadable computer software and computer programs for generating two dimensional code; providing on-line non-downloadable computer software and computer programs for enabling barcode scanners, two dimensional code scanners, barcode handy terminals, two dimensional code handy terminals, printers, laser markers to read barcode, and laser markers to read two dimensional code; computer software design, computer programming, or maintenance of computer software; consultation services in the field of technical advice relating to performance and operation of two dimensional code generating computer software, barcode scanners, two dimensional code scanners, barcode handy terminals, two dimensional code handy terminals, printers, and laser markers,” in International Class 42.⁵

³ Reg. No. 2435991 registered March 13, 2001 under Trademark Act Section 44(e), 15 U.S.C. § 1126(e); renewed.

⁴ Reg. No. 4919699 registered March 15, 2016 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a); declaration of use under Trademark Act Section 8, 15 U.S.C. § 1058, accepted.

⁵ Reg. No. 4770603 registered July 7, 2015 under Trademark Act Section 1(a); declaration of use under Trademark Act Section 8 accepted.

When the refusals were made final, Applicant appealed and requested reconsideration, which were denied. The appeals are fully briefed.⁶

We have considered all of the evidence of record, and reverse the refusals to register.

I. Likelihood of Confusion Factors

When the question is likelihood of confusion, we analyze the evidence relating to the factors set out in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence or argument; varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) (“The Board is required to consider each factor for which it has evidence, but it can focus its analysis on dispositive factors.”); *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011) (“Not all of the *DuPont* factors are necessarily ‘relevant or of equal weight in a given case, and any one of the factors may control a particular case.’”) (quoting *Majestic Distilling*, 315 F.3d at 1315).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002)); *see also Federated Foods*,

⁶ In each case, Applicant’s Briefs and Reply Briefs are at 6 TTABVUE and 9 TTABVUE. The Trademark Examining Attorney’s Briefs are at 8 TTABVUE.

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103 (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.”).

Those factors, and others, are considered below.

A. Strength or Weakness of the Cited Marks

The bulk of Applicant’s arguments in both cases rests on the alleged weakness of the cited marks. Thus, we first consider the strength and any weakness of the cited marks, because that determination informs us as to their scope of protection. In doing so, we consider the fifth and sixth *DuPont* factors in tandem (i.e., “the fame of the prior mark (sales, advertising, length of use) and “the number and nature of similar marks in use on similar goods”). *DuPont*, 476 F. 2d at 1351. “[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003); *see also Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017). Applicant argues that Registrant’s highly descriptive marks are entitled to a very narrow scope of protection, allowing competitors to come closer to Registrant’s marks without violating its rights.⁷

⁷’414 App., 6 TTABVUE 10-12; ’422 App., 6 TTABVUE 10-11. Despite conceding that it may not challenge the validity of the registrations in this ex parte appeal, Applicant asserts that “the Denso Marks consist solely of the generic term, ‘QR code,’” *id.* at 11. An argument that the marks are generic would be a collateral attack on the validity of the registrations, and a genericness challenge may be accomplished only in an adversarial proceeding brought against the registrant. *See e.g., In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 1060 n.8 (Fed. Cir. 1985) (argument that registered mark is generic “would require the filing of a petition to cancel the registration”). For the same reason, we do not consider any suggestion by

“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).” *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1352 (Fed. Cir. 2010); *see also New Era Cap. Co. v. Pro Era LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *28-29 (“In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength.”) (citations omitted).

Turning first to commercial strength, in an ex parte appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re i.am.symbolic, llc*, Ser. No. 85044494, 2015 TTAB LEXIS 369, at *22, *aff’d*, 866 F.3d 1315, 1330 (Fed. Cir. 2017) (affirming the Board’s decision on this point); *In re Integrated Embedded*, Ser. No. 86140341, 2016 TTAB LEXIS 470, at *26. For that reason, we generally do not consider this type of commercial strength of a cited registered mark.

On the other hand, “[e]vidence of third-party use of similar marks on similar goods [or services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *In re FabFitFun, Inc.*, Ser. No. 86847381, 2018 TTAB LEXIS 297, at *13 (quoting *Palm Bay Imps., Inc. v Veuve Cliquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005)). Applicant did not

Applicant that Registrant has abandoned its QR CODE marks by failing to police them. *See* ’414 App., 6 TTABVUE 14; ’422 App., 6 TTABVUE 13.

point to any evidence of third party use or registrations of QR CODE for similar goods or services.

Thus, we turn to conceptual strength, which is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)). The weaker the mark on the fanciful to generic continuum, the less its ability to preclude registration of a similar mark under Section 2(d). *In re Morinaga Nyugyo KK*, Ser. No. 86338392, 2016 TTAB LEXIS 448, at *18 (citing *In re Smith & Mehaffey*, Ser. No. 74213737, 1994 TTAB LEXIS 19, at *8 (TTAB 1994)).

A mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services. *In re N.C. Lottery*, 866 F.3d 1363, 1367 (Fed. Cir. 2017) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64 (Fed. Cir. 2007)); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012). It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *Chamber of Commerce*, 675 F.3d at 1300 (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001)); *In re Zuma Array Ltd.*, Ser. No. 79288888, 2022 TTAB LEXIS 281, at *5 (citation omitted).

As noted above, all three of Registrant's cited marks are registered on the Supplemental Register which is, in effect, an admission that these marks were merely descriptive and not inherently distinctive in connection with the goods or services at the time the applications were filed, or when amended to seek registration on the Supplemental Register. *In re Haden*, Ser. No. 87169404, 2019 TTAB LEXIS 387, at *3 ("Inasmuch as Applicant has amended the application to seek registration on the Supplemental Register, the mark is at best merely descriptive."); *see also In re Clorox Co.*, 578 F.2d 305, 308 (CCPA 1978) (application for Supplemental Registration is an admission of descriptiveness); *In re Future Ads LLC*, Ser. No. 85134539, 2012 TTAB LEXIS 283, at *12 ("Registration on the Supplemental Register is prima facie evidence that, at least at the time of registration, the registered mark was merely descriptive.") (citation omitted).

Thus, our analysis as to the weakness of the cited marks is not guided by a determination as to whether the marks are descriptive, but their degree of descriptiveness. In cases where marks are so highly descriptive and inherently weak as applied to goods or services, relevant purchasers upon encountering marks which incorporate such terms will readily look to other elements in the marks in order to distinguish the various goods or services as to source. *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at *22-23.

Applicant argues that “the term is highly descriptive to describe a two-dimensional barcode.”⁸ Applicant made of record the following evidence as support for its argument that QR CODE is weak:

- Printouts from Registrant’s website depicting how it uses “QR code” and “QR Code.” This evidence also informs us that “QR” stands for “Quick Response and it is so named because it was developed to make code scanning faster and more efficient” in place of linear bar codes.⁹
- Dictionary and “Wiktionary” definitions of “QR code,” as well as other Internet materials, indicating that the term refers to a pattern of black and white squares that can be read by a cell phone to represent information, such as the following example:¹⁰



Applicant also provided evidence that it contends shows that the term QR CODE has become “a staple in everyday life. Companies now utilize QR codes to interact with consumers, public awareness of QR codes is uncontested, and daily interaction with QR codes is unavoidable for anyone who uses a smartphone or the Internet.”¹¹

⁸ ’414 App., 6 TTABVUE 12; ’422 App., 6 TTABVUE 12.

⁹ ’414 and ’422 Apps., May 31, 2023 Resp. to Office Action Exhs. 1-2, 59, at TSDR 41-47, 263-64. Registrant’s materials use “QR code” and sometimes “QR Code,” but never as an adjective modifying a noun.

¹⁰ *Id.* Exhs. 3-13, at TSDR 48-81. These include materials from a government Internet website, <digital.gov> (Exh. 12). *See In re Nieves & Nieves LLC*, Ser. No. 85179263, 2015 TTAB LEXIS 12, at *8 (taking judicial notice of U.S. government online publications).

¹¹ ’414 and ’422 Apps., 6 TTABVUE 11.

These materials include Internet materials referencing the use of “QR codes,” particularly as to health immunization records;¹² and Internet materials promoting use of “QR codes” to enhance various services, such as restaurant menus; event ticketing; membership cards; merchant payment, loyalty rewards programs, and coupons; contact cards; social media accounts; cryptocurrency exchanges; augmented reality experiences; and promotions.¹³ The Examining Attorney conceded that “[t]here is little doubt that the wording ‘QR CODE’ is a highly descriptive term with respect to the applicant’s and registrant’s goods and services.”¹⁴

The evidence of ubiquitous use of “QR code” to merely describe a two-dimensional barcode to represent information demonstrates that the cited QR CODE marks are at least on the far end of the scale of highly descriptive marks as applied to Registrant’s Class 9 goods and Class 42 services, all of which relate to products or software to read or generate two-dimensional code, or consulting services relating to that subject matter.¹⁵ Consumers are accustomed to seeing the term used in this manner. As stated in *H. Marvin Ginn Corp. v. Int’l Assoc. of Fire Chiefs, Inc.*, “[t]he name of a thing is in fact the ultimate in descriptiveness.” 782 F.2d 987, 989 (Fed.

¹² ’414 and ’422 Apps., May 31, 2023 Resp. to Office Action Exhs. 14-28, at TSDR 82-135.

¹³ *Id.* Exhs. 29-58, at TSDR 136-262.

¹⁴ ’414 and ’422 Apps., July 4, 2023 Final Office Action, at TSDR 4; ’414 and ’422 Apps., Feb. 5, 2024 Denial of Req. for Recon., at TSDR 4.

¹⁵ A term is merely descriptive if it refers to the subject matter of consulting services. *Cf. In re Web Commc’ns*, Ser. No. 74588773, 1998 TTAB LEXIS 424, at *8 (because WEB COMMUNICATIONS is generic for publication and communication via the World Wide Web, it is also generic for consulting services directed to assisting customers in setting up their own websites for such publication and communication).


Cir. 1986) (quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847 (CCPA 1961)). We conclude that the cited marks are extremely weak and therefore entitled to a very narrow scope of protection.

B. Similarity or Dissimilarity of the Marks

We turn to the first *DuPont* factor, which is “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *4, *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord, Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322 (Fed. Cir. 2014) (citing *Nat’l Data*, 753 F.2d at 1059). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterra Inc.*, 671 F.3d 1358, 1362-63 (Fed. Cir. 2012).

As a reminder, Applicant's marks are MYQRCODE.COM (in standard characters)

and the composite mark , both with QR CODE disclaimed.¹⁶ Registrant's marks are QR CODE in standard characters and in a stylized font **QR Code** with the letters Q, R, and C capitalized. The Examining Attorney argues that the additional elements in Applicant's marks do not distinguish the marks, and even Registrant's weak marks are entitled to protection as against Applicant's marks under Section 2(d).¹⁷

Applicant's and Registrant's marks share the literal terms "QR" and "CODE," in the same order. Although these terms are presented in the applied-for marks without a space, consumers are likely to view and verbalize them as "QR CODE." The presence or absence of a space between the terms "QR" and "CODE" is an inconsequential difference that, even if noticed or remembered by consumers, does not distinguish these marks. *See, e.g., In re Iolo Techs., LLC*, Ser. No. 77399654, 2010 TTAB LEXIS 223, at *5 (finding ACTIVECARE and ACTIVE CARE confusingly similar); *Giersch v. Scripps Networks Inc.*, Can. No. 92045576, 2009 TTAB LEXIS 72, at *18 (finding that petitioner's mark DESIGNED2SELL is phonetically identical to respondent's mark DESIGNED TO SELL and the "marks are also highly similar

¹⁶ The Examining Attorney erred in briefing concerning the composite mark, MYQRCODE and design. In particular, the Examining Attorney mistakenly termed the mark "MYQRCODE.COM (and design)." *See* '422 App., 8 TTABVUE 1, 2, 5, 6. Accordingly, we give no consideration to arguments relying on these errors, including those concerning the addition of a generic top level domain, or gTLD, to the mark.

¹⁷ '414 App., 8 TTABVUE 2-5; '422 App., 8 TTABVUE 3-6.

visually” in part because “the spaces that respondent places between the words do not create a distinct commercial impression from petitioner’s presentation of his mark as one word.”); *In re Best Western Family Steak House, Inc.*, Ser. No. 315241, 1984 TTAB LEXIS 173, at *1 (“there can be little doubt that the marks [BEEFMASTER for restaurant services and BEEF MASTER for frankfurters and bologna] are practically identical and indeed applicant has not argued otherwise.”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, Can. No. 13157, 1983 TTAB LEXIS 83, at *5, *aff’d* 737 F.2d 1576 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT AND STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

The shared term, however, is extremely weak, and thus is more easily distinguished by additional matter. *Cf. Kellogg Co. v. Pack'em Enters, Inc.*, 951 F.2d 330 (Fed. Cir. 1991) (FROOTEE ICE for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products); *Keebler Co. v. Murray Bakery Prods. Inc.*, 866 F.2d 1386 (Fed. Cir. 1989) (PECAN SHORTIES not likely to cause confusion with PECAN SANDIES for cookies).

Applicant adds the possessive pronoun “MY” (without a space) to both of the subject marks, which as the first element “is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 74797, 1988 TTAB LEXIS 60, at *8. This results in a difference in appearance, sound, connotation and commercial impression that distinguishes Applicant’s marks from Registrant’s marks, which are entitled to a very narrow scope

of protection. The term MY also adds a meaning not present in meaning in Registrant's marks – that the service creates a personalized QR code for the user.

In Application Ser. No. 97417414 (standard character mark), Applicant also adds the gTLD “.COM” to the end of the mark (pronounced “dot com”), which serves as an additional difference in the way this mark looks and sounds, as well as in its meaning and impression (as a domain name) in comparison to the cited marks. The Examining Attorney argues that “.COM” has no source-identifying significance.¹⁸ We agree that “.COM” by itself, is not distinctive; rather, it merely indicates an Internet address for use by a commercial, for-profit organization. *See, e.g., In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1176 (Fed. Cir. 2004). Nevertheless, this is a question of whether Applicant's mark MYQRCODE.COM is similar to Registrant's marks, and we consider the marks in their entirety, including Applicant's .COM component.¹⁹

The Examining Attorney contends that merely adding a term (here, MY or .COM) to a registered mark generally does not obviate the similarity between the compared marks. *See, e.g., Stone Lion*, 746 F.3d at 1322 (affirming the Board's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part


¹⁸ '414 App., 8 TTABVUE 5.



¹⁹ *Cf. USPTO v. Booking.com B.V.*, 591 U.S. 549, 557 (2020) (determining that “generic.com” marks are eligible for registration when consumers do not perceive them, taken as a whole, as the generic name for a class of goods or services; “Because “Booking.com” is not a generic name to consumers, it is not generic.”), *cited in* '414 App., 9 TTABVUE 8.

of both parties' marks); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557-58 (CCPA 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar).


This case, however, presents unique facts given the high degree of demonstrated weakness of the shared term, QR CODE, rendering it less significant and driving consumers to focus on the other elements of the Applicant's marks. We conclude that the added distinctive term MY and the term .COM create differences between Applicant's and Registrant's marks in sight, sound, meaning, and commercial impression.

As to the composite mark in Application Ser. No. 97417422, Applicant also adds a

four-rectangle design  to the mark, which the Examining Attorney argues is subordinate to the dominant literal portion of the mark, MYQRCODE.²⁰ Applicant disagrees, relying on *In re Box Solutions Corp.*, Ser. No. 76267086, 2006 TTAB LEXIS

176, at *17. There, the Board held that the marks  and  (where SOLUTIONS is disclaimed and the shared term BOX was found to be highly suggestive) were more dissimilar than similar in appearance, commercial impression, and connotation. The Examining Attorney argues that *Box Solutions* is inapposite, because there both parties' marks "had substantial design elements which impacted

²⁰ '422 App., 8 TTABVUE 4.

the overall commercial impressions of the marks,” whereas here all of Registrant’s marks are in standard characters.²¹ Nonetheless, the rectangle design element  in Applicant’s composite mark adds another point of differentiation with Registrant’s marks.

In sum, we conclude that, in view of the weakness of the cited marks, the added distinctive term MY in both of Applicant’s marks, the term .COM in the standard character mark, and the design in the composite mark, together are sufficient to render the marks more dissimilar than similar from Registrant’s marks in sight, sound, meaning, and commercial impression, weighing against likelihood of confusion.

C. Similarity or Dissimilarity of Goods and Services and Established, Likely-to-Continue Trade Channels

The second *DuPont* factor “considers “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir 2018) (quoting *DuPont*, 476 F.2d at 1361).

Our comparison is based on the goods and services as identified in Applicant’s applications and the cited registrations, regardless of what the record may reveal as to their actual nature in the marketplace, the particular channels of trade or the class of purchasers to which sales of the goods and services are directed. *Stone Lion*, 746 F.3d at 1323 (citing *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d

²¹ *Id.* at 6. One of Registrant’s marks is in a stylized format, not standard characters.

937, 942 (Fed. Cir. 1990), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019)). Moreover, the classification of goods and services by the USPTO is a purely administrative determination and has no bearing on the issue of likelihood of confusion. *Nat'l Football League v. Jasper Alliance Corp.*, Opp. No. 77966, 1990 TTAB LEXIS 37, at *10 n.5 (“The classification system was established for the convenience of the Office rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related.”); *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993) (stating that classification is for the convenience of the Office and is “wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification”); *see also* Trademark Rule 2.85(f), 37 C.F.R. § 2.85(f) (“Classification schedules shall not limit or extend the applicant’s rights.”). Thus, we give no consideration to Applicant’s arguments that are based on actual use of the marks, or classification of the goods and services.²²

Applicant’s services are: “Providing on-line non-downloadable software for generating machine-readable barcodes; Software as a service (SAAS) services featuring software for generating machine-readable barcodes.” Focusing again on the cited Class 42 registration, the identified services include: “Providing on-line non-downloadable computer software and computer programs for generating two dimensional code.” Thus, the services are legally identical in part. It is sufficient for a finding of likelihood of confusion if identity is established for any item encompassed

²² ’414 App., 6 TTABVUE 21-22; ’422 App., 6 TTABVUE 19-20.

by the identification of services in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981), cited in *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at *37.

Because the services are legally identical in part, we presume that the relevant purchasers and channels of trade are also identical as to those services. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the [services] reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical [services] move in the same channels of trade and are available to the same classes of customers for such [services]”) (citing *Viterra*, 671 F.3d at 1362); *see also Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *23 (same).

The second and third *DuPont* factors weigh in favor of likelihood of confusion.

II. Balancing the *DuPont* Factors

We have weighed and balanced the *DuPont* factors for which there has been evidence and argument in this appeal. *Charger Ventures*, 64 F.4th at 1381. Even considering the in-part identical services which are presumed to travel in the same channels of trade to the same classes of purchasers, in view of the extreme weakness of the cited marks, we conclude that consumers are able to distinguish Applicant’s marks from the cited marks, and thus confusion is unlikely.

Decision

The refusals to register are reversed.