

This Opinion Is Not a  
Precedent of the TTAB

Mailed: December 12, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Blackthorn IP, LLC*

Serial Nos. 97714024, 97714033

Terrence J. Edwards, of Techlaw Ventures, PLLC, for Blackthorn IP, LLC.

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Before Larkin, Dunn and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Blackthorn IP, LLC (“Applicant”) seeks registration on the Principal Register of the mark, BLACKTHORN SOFTWARE (SOFTWARE disclaimed) in standard characters, and the mark shown below



both for management and software services in International Class 42.<sup>1</sup>

The Trademark Examining Attorney issued a final refusal of registration in both Applications under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), finding a likelihood of confusion, based on the registered mark BLACKTHORNE for “Consulting services in the design and implementation of computer-based information systems for businesses; Technological planning and consulting services in the field of computer and cyber security,” in International Class 42.<sup>2</sup> The

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<sup>1</sup> Application Serial Nos. 97714024 (word mark) and 97714033 (word + design mark) were filed on December 12, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the marks in commerce. The word + design mark is described as follows: “The mark consists of a series of triangles forming a peak, with the word ‘BLACKTHORN’ above the word ‘SOFTWARE’ located on the right side of the peak. The color black represents background, outlining, shading, and/or transparent areas and is not part of the mark.” The word “SOFTWARE” is disclaimed in both Applications.

Both Applications identify the following services: “Providing on-line non-downloadable software for construction management, employee tracking and management, and contractor tracking and management; Providing on-line non-downloadable software for project management; Providing on-line non-downloadable software for construction project field management; Providing on-line non-downloadable software for time tracking and time management; Providing on-line non-downloadable software for construction asset tracking and asset management; Providing on-line non-downloadable software for construction project management; Software as a Service (SaaS) services featuring software for construction management, employee tracking and management, and contractor tracking and management; Software as a Service (SaaS) services featuring software for project management; Software as a Service (SaaS) services featuring software for construction project field management; Software as a Service (SaaS) services featuring software for time management; Software as a Service (SaaS) services featuring software for construction asset management; Software as a Service (SaaS) services featuring software for construction project management,” in International Class 42.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify the documents by title, date, and page in the downloadable .pdf version. Citations to the briefs and other materials in the appeal record refer to the Board’s TTABVue online docket system.

<sup>2</sup> Registration No. 6788232, issued July 12, 2022.

Trademark Examining Attorney moved to consolidate the appeals,<sup>3</sup> and we granted the motion because “of the similarity of the records and issues in these cases ....”<sup>4</sup> The appeals are fully briefed and ready for final decision. We affirm the refusals to register.

### **I. Section 2(d) – Applicable Law**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 1378-79 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1318 (Fed. Cir. 2018). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods or services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208 (Fed. Cir. 1993).

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<sup>3</sup> 8 TTABVUE. We refer to the appeal records, which are identical, except that each refers to the respective mark being appealed. We will cite to the appeal record for the standard character mark, Application Serial No. 97714024, unless otherwise noted.

<sup>4</sup> 9 TTABVUE.

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011); *Shell Oil*, 992 F.2d at 1206 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See 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, 1164-65 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004); *Federated Foods, 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.”).

## **II. Likelihood of Confusion – Analysis**

Applicant and the Trademark Examining Attorney presented arguments under *DuPont* factors one, two, three and four. We address these factors in turn below.

### **A. Similarity of the Marks**

To evaluate the similarity of the marks under the first *DuPont* factor, we consider the marks in their entirety as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (citing *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*, 2018 TTAB LEXIS 170, \*13 (quoting *In re Davia*, 2014 TTAB LEXIS 214, \*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).

“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.” *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.” *In re i.am.symbolic, llc*, 2018 TTAB LEXIS 281, \*11.

### **1. Applicant’s Word Mark**

Applicant’s word mark BLACKTHORN SOFTWARE and the Cited Mark BLACKTHORNE are similar, with the only differences being that Applicant does not use an “e” at the end of the word BLACKTHORN in its mark and adds the descriptive, disclaimed word “software.” These two distinctions are of little significance, as consumers are likely to focus on and recall the word “Blackthorn(e)” from both marks. As to Applicant’s mark, it is often observed that the first element of a mark tends to play a dominant role in the mark’s commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1296, 1303 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those

words first”); *Palm Bay Imps.*, 396 F.3d at 1372-73; *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 1988 TTAB LEXIS 60, \*8 (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). In the context of this appeal, consumers’ tendency to focus on and recall the first part of a trademark means the added generic word “software” in Applicant’s mark provides little distinction from the cited mark BLACKTHORNE.

The first word of Applicant’s mark, BLACKTHORN is phonetically equivalent to the cited mark BLACKTHORNE. As noted above, this type of similarity, standing alone, may be enough to show the similarity of the marks, particularly in word-of-mouth uses of the marks.

It is true, as Applicant argues, that its mark includes the word “software” and this is both a visual and aural distinction from the cited mark. But the question under the first *DuPont* factor is not simply whether there are distinctions between the marks, but whether the marks are similar enough that consumers are likely to mistake or confuse the two marks. And when a descriptive term, like “software” for Applicant’s software-based services, is added to a mark, consumers will understand the term as describing the services, not as identifying the source of the services. For this reason, descriptive terms, like the disclaimed “software” in the applied-for mark, receive less emphasis in the likelihood of confusion analysis.

This weighting of the different parts of a mark is not an improper dissection of the mark, as Applicant argues. While it is true that consumers will see the full mark, it is also true that “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 entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985) (quoted by *Detroit Athletic Co.*, 903 F.3d at 1305). We find the marks, in their entirety, are similar in appearance and sound.

Though Applicant submitted evidence of different possible meanings of the word BLACKTHORN as used in its mark, we find the record fails to provide a clear definition for either mark. 6 TTABVue 15-16. More importantly, there is no evidence that the word “Blackthorn(e)” means something different in the applied-for mark than it does in the cited mark. *In re Embiid*, 2021 TTAB LEXIS 168, \*20-21. We find that consumers are likely to attribute the same meaning to both marks. We further find that both marks are likely to create the same commercial impression in the market. Applicant’s word mark and the cited mark are similar in every respect and this fact increases the likelihood of confusion.

## **2. Applicant’s Word + Design mark**

In the second application involved in this appeal, Applicant seeks to register the mark shown below



This mark adds “a series of triangles forming a peak” to the word mark we considered above. Much of the preceding analysis applies with equal force to this mark, as the

literal elements of this mark are virtually identical to Applicant's word mark BLACKTHORN SOFTWARE. In this mark, there is an added design element preceding the literal elements, and the word BLACKTHORN is presented more prominently (above and in a larger and bolder font) than the word SOFTWARE. This emphasis on the word BLACKTHORN makes it clear that this word is the dominant literal element of the mark.

But does the addition of the design element render the marks dissimilar? Applicant argues that this "design element is arbitrary and fanciful, is conspicuously located as part of the mark, and is taller than, and is located to the left of, the word portion." 6 TTABVue 14 (Ser. No. 97714033). This description is accurate and the design element does create a visual distinction between the applied-for mark and the cited mark. We agree that Applicant's word + design mark is less visually similar to the cited mark than we found for Applicant's word mark. However, this difference does not prevent the marks from being visually similar in their entireties based on the almost identical dominant literal term.

But this is only one aspect of similarity. The marks remain equally similar in sound as the word marks. When consumers ask for Applicant's services, they will use the literal elements of the mark. The same will occur when Applicant's mark is verbalized by consumers or used in audio marketing, such as radio or podcast promotion. The similarity of sound analysis provided above applied with equal force to this mark, and that fact alone is enough to render the marks similar for our likelihood of confusion analysis.



Applicant provides no meaning of the design element of its mark, and we find that this element does not create a new and different meaning for that created by the literal elements of this mark (i.e., from the word mark BLACKTHORN SOFTWARE). We have no evidence as to the commercial impression created by the design element of this mark, though Applicant argues the design element “creates a distinct impression when the entirety of the mark is considered.” *Id.* This is attorney argument and does not replace actual evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1370 (Fed. Cir. 2018). Lacking such evidence, we find that Applicant’s word + design mark is likely to create a commercial impression similar to that created by the cited BLACKTHORNE mark.<sup>5</sup> The first *DuPont* factor, therefore, also supports the refusal as to Applicant’s word + design mark.

### **B. Similarity or Relatedness of the Services**

We evaluate the second *DuPont* factor based on the services identified in the Application and the Cited Registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990). It is sufficient for a finding of likelihood of confusion if relatedness is established between any of the services identified in the Application and cited Registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981); *see also Double Coin Holdings Ltd. v. Tru Dev.*, 2019 TTAB LEXIS 347, \*18; *In re Aquamar, Inc.*, 2015 TTAB LEXIS 178, \*9 n.5. In

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<sup>5</sup> Applicant appears to concede that design elements are often less impactful than the literal elements of a mark, but argues the Office went too far and ignored the design element of its mark. *Id.* We gave due weight to the design element in our analysis, but found that this element’s impact on the similarity analysis is limited.

addition, the services need only be sufficiently related that a relevant consumer would be likely to assume, upon encountering services marketed under the marks at issue, that the services originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, 2007 TTAB LEXIS 50, \*25-26.

The Cited Registration identifies: “Consulting services in the design and implementation of computer-based information systems for businesses; Technological planning and consulting services in the field of computer and cyber security.” Applicant identifies a range of software services, all limited in some manner to construction or project management, employee tracking and management, contractor tracking and management, or time tracking and management. While these services are limited to these fields of use, the services identified in the cited Registration are essentially unlimited, and apply to all fields of business. If the services in the cited Registration are broad enough to cover the narrower services in the Application, the services are legally identical. *See In re OSF Healthcare Sys.*, 2023 TTAB LEXIS 353, \*8-9 (we must construe the services identified in a cited registration as broadly as reasonably possible, and we must also give the identification in the application its full scope); *In re Hughes Furniture Indus.*, 2015 TTAB LEXIS 65, \*10 (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Jump Designs LLC*, 2006 TTAB LEXIS 209, \*14-15 (same).

The cited Registration does not directly identify software services, instead referring to “computer-based information systems.” Applicant concedes that this phrase involves “software or computing,” as does the listing of services in the Application. 6 TTABVue 17 (“both [the Application and cited Registration] involve software or computing ...”). Applicant’s argument is that it “provides software solutions, whereas Registrant offers consulting services unrelated to any specific software platform.” *Id.* at 17-18. Applicant misses the point. The cited Registration identifies a broad range of consulting services relating to software of any kind, and for that reason, the narrower software services identified by Applicant may be effectively subsumed within the scope of the services identified in the cited Registration. As we noted above, Applicant cannot avoid overlap or relatedness in the services by narrowing its own identification.

We find that Applicant’s software services include at least some amount of consulting or planning with prospective customers of the services. To provide the sort of specialized software solutions identified in the Application without any consultation or planning would make no sense. Applicant concedes this point when it acknowledges “a market trend whereby companies that offer particular software products also offer consultations on use and implementation of those particular software products sold by the same company.” *Id.* at 20. Applicant even provides examples of third parties that offer the same type of specialized construction or project management software and consultation relating to such software under a

single mark. *Id.* This evidence shows that the services Applicant identifies are related to those identified in the cited Registration.

Applicant argues that these consultation services are not a separate service, apparently because such consultation is inextricably intertwined with providing the software services. *Id.* (“Those third party companies provide both proprietary software platforms and consulting services related specifically to the implementation of their own software. The consultation services they offer are inseparable from their role as software providers.”). Applicant goes on to argue:

To interpret Registrant’s services as including consultation on its own software would require reading into the recitation a nonexistent software offering, effectively transforming the claimed service into one that is not registrable—because it would then represent an internal function or incidental service related to the delivery of its goods, which is not recognized as a standalone registrable service under USPTO standards (see TMEP 1301.01(a), 1301.01(a)(ii) and (a)(iii)).

*Id.* at 20-21. Applicant again misses the point.

The cited Registration identifies consultation and planning services, and because the Registration is presumed valid, we must compare those services, construed as broadly as reasonably possible, to the services identified in the Application. 15 U.S.C. § 1057(c). Applicant’s argument is effectively a concession that the services are so closely related that all providers of the type of specialized software services identified in the Application also provide the sort of consultation and planning services identified in the cited Registration. We find this concession is consistent with the

evidentiary record<sup>6</sup> and common sense. The services are closely related and this increases the likelihood of confusion.

The second *DuPont* factor supports the Section 2(d) refusal.

### **C. Trade Channels**

As we noted above, the cited Registration broadly identifies consulting and planning services relating to “computer-based information systems.”

Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof.

*In re Jump Designs*, 2006 TTAB LEXIS at \*13-14; *see also In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“it is well established that, ‘absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers’”) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002)). We found the

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<sup>6</sup> The Trademark Examining Attorney submitted registration and Internet evidence showing third parties that offer the type of services identified in the Application and the cited Registration under a single mark. *See* Office Action dated September 18, 2023, 4-10; Final Office Action dated May 7, 2024, 2-11; Denial of Request for Reconsideration dated April 18, 2025, 14-22. This evidence supports our finding that the services are related, independent of Applicant’s concessions noted above. Applicant does not dispute this evidence, but cites to seven examples of third parties who provide specialized construction or project management software and also “offer consultations on use and implementation” of that software. 6 TTABVUE 19-20.

services related, and we find that the software-related services also flow through similar trade channels. Indeed, Applicant's concession that providers of the type of specialized software identified in the Application also provide consultation services confirms that these two types of related services flow through the same trade channels. 6 TTABVUE 19-20. The third *DuPont* factor supports the refusal.

Applicant argues that its software solutions are offered through its own website and that the Registrant probably does the same. *Id.* at 23-24. This argument is based on actual market uses (or likely uses). Our analysis, on the other hand, must be limited to the normal trade channels based on the services identified in the Application and cited Registration. *Stone Lion*, 746 F.3d at 1325.

#### **D. Customer Care**

The fourth *DuPont* factor considers the likely care exercised by relevant consumers. *DuPont*, 476 F.2d at 1361 ("The conditions under which ... sales are made, i.e. "impulse" vs. careful, sophisticated purchasing"). Applicant argues that the customers of these services are careful, and further, that the consumers do not overlap. 8 TTABVUE 9. These arguments again ignore the identifications in the Application and cited Registration, which contain no limitations as to consumers or method of marketing the goods. The cited Registration identifies a broad range of services and there is no evidence that consumers of such services consistently exercise care when making purchasing decisions.

We find this is a mixed market, with some consumers likely making careful purchasing decisions and some making less careful decisions, and we are required to

base our decision “on the least sophisticated potential purchasers.” *Stone Lion Capital Partners*, 746 F.3d at 1325. We find that the “least sophisticated potential purchasers” of Registrant’s consultation and planning services likely exercise ordinary care in making purchasing decisions, which does not materially alter the likelihood of confusion. The fourth *DuPont* factor is neutral.

**E. Conclusion: Weighing the Factors**

The marks are similar (in both appealed Applications) and the services are related, the trade channels overlap, and there is no evidence of consistent consumer care in purchasing the services. In short, the first three *DuPont* factors point toward a likelihood of confusion. The fourth *DuPont* factor is neutral. The first two *DuPont* factors—the similarity of the marks and the similarity of the services—weigh most heavily in this appeal. Confusion is likely and the Section 2(d) refusal must be affirmed.

**Decision:** The Section 2(d) refusal is affirmed.