

This Opinion is Not a
Precedent of the TTAB

Mailed: January 24, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re SCU Community Foundation

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Serial No. 97848911

James A. Sheridan of Sheridan Law LLC,
for SCU Community Foundation.

Shari Gadson, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

—
Before Lykos, Dunn, and Stanley,
Administrative Trademark Judges.

Opinion by Stanley, Administrative Trademark Judge:


SCU Community Foundation (“Applicant”) seeks to register on the Principal Register the standard-character mark CLIMB COMMUNITY FOUNDATION for “charitable foundation services, namely, providing financial assistance for programs and services of others” in International Class 36.¹

¹ Application Serial No. 97848911, filed March 21, 2023 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of an intent to use the mark in commerce.

Citations to the prosecution file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. Citations to the appeal record are to TTABVUE, the Board’s

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when applied to the identified services, so resembles the previously registered standard-character mark KEEP CLIMBING FOUNDATION ("FOUNDATION" disclaimed) (subject of Registration No. 6995943), the composite



mark  ("FOUNDATION" disclaimed) (subject of Registration No. 7142028), and the standard-character mark KEEP CLIMBING (subject of Registration No. 7204651), each for the services listed below, that it is likely to cause confusion or mistake or to deceive:

Charitable fundraising; Charitable fundraising services; Charitable fundraising services by means of organizing and conducting special events; Charitable fundraising services for childhood illness and empowerment, Veterans' support, first responders and frontline workers support, and urgent community needs; Charitable services, namely, fundraising services by means of organizing special events for helping and empowering children, helping veterans and first responders, and others in need; Conducting fundraising campaigns to support childhood illness and empowerment, Veterans' support, first responders and frontline workers support, and urgent community needs; Charitable fundraising services by means of running and walking events in International Class 36.²

online docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

² Registration No. 6995943 registered on the Principal Register on March 7, 2023, Registration No. 7142028 registered on the Principal Register on August 22, 2023, and Registration No. 7204651 registered on the Principal Register on October 31, 2023.

The Examining Attorney also required that Applicant disclaim the phrase “COMMUNITY FOUNDATION” on the ground that it is merely descriptive of the identified services. *See* Section 6(a) of the Trademark Act, 15 U.S.C. § 1056.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. The appeal is fully briefed. We affirm the disclaimer requirement under Section 6(a), but reverse the Section 2(d) refusal to register.

I. Evidentiary Matter

In its February 16, 2024 Response to Office Action refusing registration under Section 2(d), Applicant argued that the Cited Marks are “weak” because “the term CLIMB is used by well over **40 different parties** as shown in EXHIBIT A and EXHIBIT B, and accordingly should be given only limited area of coverage.”³ Exhibit A to Applicant’s February 16, 2024 Response to Office Action is titled “USPTO Records” and consists of a list of twenty-six trademark registrations and applications,⁴ and Exhibit B is titled “ReferenceUSA.COM Records” and consists of a list of fifty-nine companies with the root word “Climb” in the name of the company.⁵

Registration No. 7142028 includes the following description of the mark: “The mark consists of the wording ‘KEEP CLIMBING FOUNDATION’ within a mountain and cloud design, within a circle.” Registration Nos. 6995943, 7142028, and 7204651 are each owned by the same registrant, Keep Climbing Foundation (“Registrant”), and are collectively referred to hereafter as the “Cited Marks.”

³ February 16, 2024 Response to Office Action, TSDR 4-6 (emphasis in original).

⁴ *Id.* at 8-17.

⁵ *Id.* at 18-21.

In the April 4, 2024 Final Office Action, the Examining Attorney explained that “the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record” and therefore “these registrations will not be considered.”⁶ In its April 24, 2024 Request for Reconsideration, Applicant submitted status and title copies from TSDR for twenty-four marks and requested that these marks be considered.⁷ Applicant further argued that the list of names identified in Exhibit B have been properly submitted and should be considered.⁸ In its opening appeal brief, Applicant references both Exhibit A and Exhibit B to its February 16, 2024 Response to Office Action and argues that the Examining Attorney committed “clear error” by previously refusing to consider Exhibit B.⁹

The status and title copies of the marks submitted with Applicant’s Request for Reconsideration are properly in the record, and we have considered those marks. In her appeal brief, the Examining Attorney did not object to Applicant’s reliance on Exhibit B. Instead, the Examining Attorney acknowledges:

[A]pplicant submitted a search report obtained from a commercial database. June 14, 2024, Request for Reconsideration Denied, TSDR pp. 7-16. Applicant has submitted 32 examples of third-party use of marks including the components CLIMB or CLIMBING to show that the term CLIMBING in the marks in the cited registrations is commercially weak and should not be afforded a broad scope of protection.¹⁰

⁶ April 4, 2024 Final Office Action, TSDR 6 (citations omitted).

⁷ April 24, 2024 Request for Reconsideration, TSDR 6-7, 21-79.

⁸ *Id.* at 7.

⁹ Applicant’s Br., 6 TTABVUE 10-12.

¹⁰ Examining Attorney’s Br., 8 TTABVUE 7-8.

The Examining Attorney then argues that “the [third-party use] evidence [i.e., Exhibit B] is insufficient to establish that a portion or all of the mark is commercially weak and entitled to a narrow scope of protection” and that “the third-party use evidence submitted by applicant is not probative on whether a portion or all of the mark is commercially weak and entitled to a narrow scope of protection.”¹¹

If an examining attorney discusses the content of third-party use evidence not properly made of record in an Office Action or appeal brief, without objecting to them, the evidence is considered for whatever probative value it may have. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1208.02 and 1208.03 (2024). The Examining Attorney did not object to Exhibit B in her appeal brief but instead addressed the contents of Exhibit B substantively. As such, we will consider Exhibit B for whatever probative value it may have.

II. Disclaimer Requirement

Under Section 6(a) of the Trademark Act, an applicant may be required “to disclaim an unregistrable component of a mark otherwise registrable.” 15 U.S.C. § 1056(a). *See In re Grass GmbH*, 79 USPQ2d 1600, 1601-02 (TTAB 2006); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.03(a) (Nov. 2024). As noted above, the Examining Attorney required that Applicant disclaim the phrase “COMMUNITY FOUNDATION” on the ground that it is merely descriptive of the identified services. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See, e.g., In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d

¹¹ *Id.* at 8-9.

1859, 1860, n.1 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975); *In re Nat'l Presto Indus. Inc.*, 197 USPQ 188, 190 (TTAB 1977).

In its opening appeal brief, Applicant did not address the requirement that it disclaim the phrase “COMMUNITY FOUNDATION.” The Examining Attorney argues that “Applicant’s appeal brief failed to provide arguments and/or evidence against the disclaimer requirement, and such is construed as an acquiescence to the issue raised.” In its reply brief, Applicant argues for the first time that “no disclaimer is required or appropriate” because “CLIMB COMMUNITY FOUNDATION is a unitary term having multiple meanings, and this mark creates a distinct commercial impression from any purported descriptive wording.”¹² This argument is untimely. *Cf. Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1035 (TTAB 2010).

The filing of a notice of appeal has the effect of appealing all refusals or requirements made final. *In re Harley & Jones*, 119 USPQ2d 1755, 1757 (TTAB 2016) (citing *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985)). Applicant, however, waived its right to challenge the disclaimer requirement by failing to address it in its opening brief. Thus, the refusal to register Applicant’s mark on the ground that Applicant failed to enter a disclaimer of “COMMUNITY FOUNDATION” is affirmed. *In re Rainier Enters., LLC*, 2019 USPQ2d 463361, at *2 (TTAB 2019) (if an applicant fails to address a requirement or refusal, the Board may consider “any challenge to that requirement or refusal waived and affirm”); *In re Katch, LLC*, 2019 USPQ2d 233842, at *1-2 (TTAB 2019) (applicant who briefed only the refusal under Section

¹² Applicant’s Reply Br., 9 TTABVUE 7.

23(c) waived its appeal of the refusal to registration under Trademark Sections 1, 2, 3 and 45); *see also* TBMP § 1203.02(g) (“If an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board.”).

Although Applicant’s failure to comply with the disclaimer requirement is a sufficient basis for refusing registration of Applicant’s mark and deeming moot the refusal of registration under Trademark Act Section 2(d), *see In re DTI P’ship, LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003), for the sake of completeness and efficiency, we exercise our discretion to determine the merits of the Section 2(d) refusal.

III. Likelihood of Confusion Refusal

Section 2(d) of the Trademark Act prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive.

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, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only

to prevent buyer confusion as to the source of the 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, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). “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, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). These factors, and others, are discussed below.

A. The Services

We begin our analysis with the second *DuPont* factor, which considers the “similarity or dissimilarity and nature of the [] services as described in an

application or registration.”¹³ *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). It is “not necessary that the products [or services] be similar or even competitive to support a finding of a likelihood of confusion.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective products [or services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.* “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods [or services] within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

As noted above, the services identified in Applicant’s application are: “charitable foundation services, namely, providing financial assistance for programs and services of others,” and the services identified in the cited registrations include “charitable fundraising services.”

The record supports that Applicant’s “charitable foundation services” in the form of “providing financial assistance for programs and services of others” and

¹³ As noted by the Examining Attorney, “Applicant did not argue that its services are unrelated to those provided by applicant,” and therefore the Examining Attorney contends that this should be “construed as an acquiescence to the issue.” In its reply brief, Applicant again does not address the similarity of services. Having conceded the issue, we offer only a brief explanation of our conclusion on the second *DuPont* factor. *See In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1740 (TTAB 2016) (Board considered Applicant to have conceded the issue of similarity or dissimilarity of the goods or channels of trade, by not addressing the issues).

Registrant’s “charitable fundraising services” are of a type which may emanate from a single source. More specifically, the record includes website screenshots from several third-party community foundations, in which the community foundation raises funds, usually through a donation link, and provides financial assistance for programs and services of others and itself.¹⁴ *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion where website evidence showed that “[t]he same companies, including applicant itself, produce both ultrasound and MRI medical diagnostic imaging machines”). Accordingly, the second *DuPont* factor favors a likelihood of confusion.

B. Weakness of the Common Root Word “CLIMB” in the Marks

Because it affects the scope of protection to which it is entitled, we turn now to the sixth *DuPont* factor, which considers “[t]he number and nature of similar marks in use on similar goods [or services].” *DuPont*, 177 USPQ at 567. This *DuPont* factor allows an applicant in an ex parte appeal to contract the scope of protection of a cited mark by adducing evidence of conceptual and commercial weakness. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73

¹⁴ December 22, 2023 Non-Final Office Action, TSDR 18-20 (Screenshots from the website of the Community Foundation of Louisville); *id.* at 21-22 (Screenshots from the website of the Ripley County Community Foundation); *id.* at 23-25 (Screenshots from the website of the Crown Point Community Foundation); April 4, 2024 Final Office Action, TSDR 24-25 (Screenshots from the website of The Community Foundation); *id.* at 26 (Screenshot from the website of the Sunmark Charitable Community Foundation); *id.* at 27 (Screenshot from the website of the Red Lodge Area Community Foundation).

USPQ2d 1689, 1693 (Fed. Cir. 2005)) (the sixth *Dupont* factor “is a measure of the extent to which other marks weaken the assessed mark”).

“[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “The weaker [the cited] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1674 (internal citations omitted).

In determining the strength of a cited mark, we consider both its inherent or conceptual 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. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

Conceptual or inherent strength is a measure of a mark’s distinctiveness. *Chippendales*, 96 USPQ2d at 1686. Distinctiveness is “often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992). “Marks that are descriptive or highly suggestive are

entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Spireon*, 2023 USPQ2d 737, at *4 (quoting *Juice Generation*, 115 USPQ2d at 1674); see also *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

“Commercial strength, on the other hand, is the marketplace recognition value of the mark.” *Spireon*, 2023 USPQ2d 737, at *4 (internal citation and quotation marks omitted). Commercial strength is a question of “whether consumers in fact associate the ... mark with a unique source.” *Id.* In this regard, the purpose of introducing evidence of third-party marketplace use is “to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay*, 73 USPQ2d at 1694). Accord *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674.

“Extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation*, 115 USPQ2d at 1674). Accord *Spireon*, 2023 USPQ2d 737, at *7.

1. Conceptual Strength

We first address the third-party registration evidence presented as a challenge to the Cited Marks’ conceptual strength. Third-party registrations may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has

a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 115 USPQ2d at 1675 (internal citation quotation marks omitted); *see also Spireon*, 2023 USPQ2d 737, at *4-5; *Jack Wolfskin*, 116 USPQ2d at 1136. Even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

Applicant argues that its third-party evidence “demonstrate[s] that the term CLIMB has been adopted by a number of other users as a laudatory designation,” and therefore the Cited Marks are “weak” and entitled to only a narrow scope of protection.¹⁵ Of the twenty-four TSDR records submitted, we find the following third-party registrations probative:¹⁶

¹⁵ Applicant’s Br., 6 TTABVue 10-12.

¹⁶ We have not considered the following TSDR records: (1) Registration No. 7204651 for the standard-character mark KEEP CLIMBING because it is one of the Cited Marks, not a third-party registration (April 24, 2024 Request for Reconsideration, TSDR 24-26); (2) Application Serial No. 97848911 for the standard-character mark CLIMB COMMUNITY FOUNDATION because it is Applicant’s involved application (*id.* at 31-32); (3) Application Serial No. 90646990 for the standard-character mark LENDMARK CLIMB TO CURE (*id.* at 29-30), Application Serial No. 85017996 for the standard-character mark CF CLIMB FOR LIFE (*id.* at 38-39), and Application Serial No. 85466111 for the composite mark CF CLIMB STEPPING UP TO CURE CYSTIC FIBROSIS (and design) (“CF” disclaimed) (*id.* at 57-59), because third-party applications have no probative value in that they evidence only the fact that the applications were filed. *See, e.g., Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003) (“[T]hird-party applications are evidence only of the fact that they were filed; they have no other probative value.”); and (4) Registration No. 2817028 for the standard-character mark CLIMB TO FIGHT BREAST CANCER (April 24, 2024 Request for Reconsideration, TSDR 47-48), Registration No. 4011738 for the standard-character mark CLIMB4LIFE (*id.* at 52-53), and Registration No. 3745775 for the composite

- Registration No. 4415343 for the standard-character mark CF CLIMB (“CF” Disclaimed) and Registration No. 4536047 for the composite mark



CYSTIC FIBROSIS FOUNDATION (“CF” Disclaimed), both for “charitable fundraising services” in International Class 36.¹⁷

- Registration No. 5049672 for the standard-character mark CLIMB TO FIGHT CANCER for “charitable fundraising services” in International Class 36.¹⁸
- Registration No. 5310125 for the standard-character mark CLIMBING FOR LOST LINEMEN for “charitable fundraising services and charitable fundraising activities to support injured and fallen linemen and their families” in International Class 36.¹⁹
- Registration No. 2899186 for the standard-character mark CLIMB FOR LIFE for “charitable fundraising for cancer research, treatments, care, and education” and Registration No. 5665211 for the standard-character mark

mark CLIMBING FOR KIDS BAY AREA WILDERNESS TRAINING (and design) (“CLIMBING FOR KIDS BAY AREA WILDERNESS TRAINING” disclaimed) (*id.* at 54-56), because these registrations have been cancelled. *See Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at *11 (TTAB 2022) (disregarding cancelled third-party registrations; “A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b)”).

We further note that Registration No. 4654999 for the standard-character mark CLIMBAMERICA!, Registration No. 4696827 for the standard-character mark CLIMB OUT OF THE DARKNESS, and Registration No. 6406318 for the composite mark REACH FOR EXCELLENCE COMMIT TO THE CLIMB (and design) are each listed on Exhibit A (*see* April 24, 2024 Request for Reconsideration, TSDR 13, 17, 19), but status and title copies for these registrations were not provided and therefore they have not been considered. Additionally, status and title copies were provided for Registration No. 5682455 for the standard-character mark CHARISMA UNIVERSITY (*id.* at 73-74), but this mark was not identified on Exhibit A, does not include the root word CLIMB, and appears irrelevant to this matter.


¹⁷ *Id.* at 26-28, 44-46. Registration Nos. 4415343 and 4536047 are owned by the same registrant, Cystic Fibrosis Foundation.

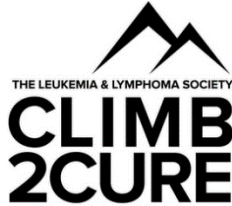
¹⁸ *Id.* at 33-35.

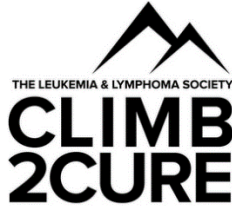
¹⁹ *Id.* at 36-37.

CLIMB4LIFE for “charitable fundraising services by means of climbing event,” both in International Class 36.²⁰



- Registration No. 7568135 for the composite mark  for “Charitable fundraising services by means of an entertainment event; Charitable fundraising services by means of organizing and conducting fundraising events to promote organ and tissue donation and healthy lifestyles” in International Class 36.²¹
- Registration No. 4185879 for the standard-character mark BIG CLIMB (“CLIMB” disclaimed) and Registration No. 4189858 for the standard-character mark CLIMB CONQUER CURE (“CLIMB” disclaimed), both for “charitable fund raising, namely, organizing and conducting a stair climbing event to raise money for leukemia, lymphoma, Hodgkin’s disease, and myeloma research, patient aid, and public and professional education” in International Class 36, and Registration No. 5150184 for the composite



mark  for “charitable fund raising” in International Class 36.²²

- Registration No. 5198683 for the standard-character mark CLIMB FOR CAPTIVES for “Charitable services, namely, organizing and developing projects and events that aim to promote global awareness about human trafficking” in International Class 35.²³
- Registration No. 4841059 for the standard-character mark CLIMB FOR HEROES for “Charitable services, namely, organizing and conducting volunteer programs and community service projects aimed at increasing

²⁰ *Id.* at 40-43. Registration Nos. 2899186 and 5665211 are owned by the same registrant, HERA Women’s Cancer Foundation.

²¹ *Id.* at 49-51.

²² *Id.* at 60-62, 70-72, 75-77. Registration Nos. 4185879, 4189858, and 5150184 are owned by the same registrant, The Leukemia & Lymphoma Society, Inc.

²³ *Id.* at 63-64.

support and morale for veterans, soldiers, marines and military families” in International Class 35.²⁴



- Registration No. 5713011 for the composite mark (“FOUNDATION” disclaimed) for “charitable services, namely, promoting public awareness of suicide prevention and mental health” in International Class 35.²⁵

The Examining Attorney contends that “the cited marks are not weak and are entitled to a broad scope of protection.”²⁶ With respect to the third-party registrations of record, the Examining Attorney argues that these registrations are “entitled to little weight in determining the strength of a mark” because they comprise only a “small number” and “the marks in those registrations are not as similar in format or commercial impression as registrant’s and applicant’s marks are to each other.”²⁷ We disagree.

The word “climb” is defined as “to go up or ascend, especially by using the hands and feet or feet only.”²⁸ The above-referenced third-party registrations demonstrate that the root word CLIMB has been adopted by many engaged in the charitable services field as a laudatory or aspirational designation, suggesting that the charitable service, or one involved with the charitable service, is “ascending” to

²⁴ *Id.* at 65-66.

²⁵ *Id.* at 67-69.

²⁶ Examining Attorney’s Br., 8 TTABVUE 7.

²⁷ *Id.* at 9.

²⁸ December 22, 2023 Non-Final Office Action, TSDR 16 (Dictionary.com definition of the word “Climb”).

whatever cause the charitable service supports. As such, the root word CLIMB has less than arbitrary significance with respect to such charitable services. *See In re Hartz Hotel Servs.*, 102 USPQ2d 1150, 1154 (TTAB 2011) (finding that the term “grand” was a highly suggestive term for a hotel: “unlike a situation involving an arbitrary or fanciful mark, the addition of other matter to a laudatory or suggestive word may be enough to distinguish it from another mark”); *In re Dayco Prods. Eglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988) (the submission of the third-party registrations probative to demonstrate that “IMPERIAL” has been adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation).

In view of this evidence, we find the root word CLIMB in the Cited Marks is conceptually weak.

2. Commercial Strength

Purporting to establish diminished commercial or marketplace strength of the Cited Marks, Applicant has presented a list of fifty-nine company names with the root word “Climb” in the company’s name. *See Palm Bay*, 73 USPQ2d at 1693 (“Evidence 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.”); *see also Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). All we have before us, however, are the names of fifty-nine companies incorporating the root word “climb,” their address, and a general designation for the type of company or organization they are (e.g., “charitable institution,” “non-profit organization,” “educational association,”

“church,” etc.). We do not have information of what specific goods and services each entity offers. Furthermore, without website screenshots or other evidence establishing use, we cannot establish whether the word CLIMB (or CLIMBING) is in current use by any of these entities and, if so, how the word is being used. We therefore cannot find on the record before us that the Cited Marks have been commercially weakened by the list of names identified on Applicant’s Exhibit B.²⁹ See *Aerodyne Dev. Corp. v. Aerodyne Mach. Corp.*, 176 USPQ 94, 95 (TTAB 1972) (listings in a trade name search report were “manifestly insufficient” to show weakness of common term in subject marks).

3. Conclusion

Based on the totality of the evidence, we find that the root word CLIMB is conceptually weak in the context of the identified services in the Cited Marks. Overall, this weakness leads us to the conclusion that marks containing the root word CLIMB used in connection with charitable financial services are capable of co-

²⁹ Even if we assume the company names listed in Exhibit B evidence use of the root word “Climb,” their probative value is limited because they do not show the public’s awareness of the respective businesses, see *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009) *aff’d*, 415 Fed. App’x 222 (Fed. Cir. 2010), and fall short of the persuasive evidence of “numerous” third-party uses to demonstrate commercial weakness, such as those involved in *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560-62 (TTAB 1996) (evidence of hundreds of yellow and white pages listings of restaurant names containing the word BROADWAY, almost 600 similar entries from the American Business Directory, and more than 500 similar entries from the Dun & Bradstreet database were together sufficient to establish that a significant number of persons are using names and marks containing the word “Broadway” for restaurant services and related goods) and *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987) (226 businesses identified in electronic classified phone directories, 100 of which were verified uses of the name, “demonstrate that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term, or something closely related to it, and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks”).

existing without confusion where “the remaining portions of the mark [are] sufficient to distinguish the marks as a whole from one another.” *Promark v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015). The sixth *DuPont* factor therefore weighs against a likelihood of confusion based on the inherent or conceptual weakness of the common root word “Climb.”

C. The Marks

Against the backdrop of the conceptual weakness of the shared root word “Climb,” we turn now to the first *DuPont* factor, which involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay*, 73 USPQ2d at 1693 (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). The proper test regarding similarity “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721) (internal quotation marks and citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests, Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). The average purchasers here are donors to, or beneficiaries of, charitable activities.

Our analysis cannot be predicated on dissecting the marks into their various components; that is, our finding must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs, Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, 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 a

consideration of the marks in their entireties. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

With these principles in mind, we compare Applicant's mark CLIMB COMMUNITY FOUNDATION with the Cited Marks KEEP CLIMBING, KEEP CLIMBING FOUNDATION, and KEEP CLIMBING FOUNDATION and design.

Applicant argues, among other things, that: (1) Applicant's mark and the Cited Marks are different in sound because only the word "FOUNDATION" in the marks is similar in sound to one another; (2) Applicant's mark and the Cited Marks do not have a similar appearance because Applicant's mark "includes different terms, in different order, with a different connotation than KEEP CLIMBING or KEEP CLIMBING FOUNDATION"; and (3) Applicant's mark and the Cited Marks have different commercial impressions because the phrase "community foundation" has a specific meaning different than simply the word "foundation."³⁰

Although the Examining Attorney acknowledges that Applicant's mark and the Cited Marks are different in sound and appearance,³¹ she contends that Applicant's mark and the Cited Marks "convey similar ideas, stimulate the same mental reaction, and have the same overall meaning" because: (1) "Applicant's use of the root word 'CLIMB' is not distinguished from the derivative term 'CLIMBING' in the registrant's

³⁰ Applicant's Br., 6 TTABVUE 8-9.

³¹ Examining Attorney's Br., 8 TTABVUE 6 ("The differences in sound and/or appearance of applicant's and registrant's marks do not obviate their overall similarities because, as explained above, the marks convey similar ideas, stimulate the same mental reaction, and have the same overall meaning."); *see also* April 4, 2024 Final Office Action, TSDR 6 ("As to the marks, the examining attorney does not argue that they are similar as to sound and/or appearance.").

marks because both words convey the idea of the same action, namely, going up and/or ascending”; (2) “Registrant’s use of the word ‘KEEP’ in its marks does not obviate their similarities with the applied-for mark because that word functions as a verb, and when combined with the word ‘CLIMBING’, the composite wording conveys that idea of continuing the action of going up and/or ascending”; and (3) “the latter words in applicant’s and registrant’s marks are not distinguishing elements.”³²

We recognize that the word CLIMB in Applicant’s mark is the dominant portion, as we have affirmed the disclaimer requirement for the phrase “COMMUNITY FOUNDATION.” We further recognize that the word CLIMBING is the dominant portion of the Cited Marks, as the word KEEP emphasizes CLIMBING and the word FOUNDATION (as found in two of the three Cited Marks) has been disclaimed. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed and generic word less dominant). However, as previously discussed, the root word CLIMB is weak in connection with charitable financial services. Moreover, the marks begin with different words (i.e., CLIMB for Applicant’s mark and KEEP for the Cited Marks), Applicant’s mark includes a word not found in the Cited Marks (i.e., COMMUNITY), and the phrase “COMMUNITY FOUNDATION” has a specific meaning not found in the Cited Marks.³³

³² Examining Attorney’s Br., 8 TTABVUE 3-7.

³³ December 22, 2023 Non-Final Office Action, TSDR 14 (defining “community foundation” on www.fidelitycharitable.org website as “a public charity that typically focuses on supporting a geographical area, primarily by facilitating and pooling donations used to address community needs and support local nonprofits”).

“Additions ... to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see, e.g., Citigroup*, 98 USPQ2d at 1261 (affirming Board’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, would not likely cause confusion, based, in part, on findings that the phrase “City Bank” was frequently used in the banking industry and that “CAPITAL” was the dominant element of applicant’s marks, which gave the marks a geographic connotation as well as a look and sound distinct from opposer’s marks). Taking into account the conceptual weakness of the root word CLIMB in relation to charitable financial services, and the admitted differences in sound and appearance in the marks, we find that Applicant’s mark is not sufficiently similar to the Cited Marks for consumers to be confused.

Accordingly, the first *DuPont* factor weighs against a finding of likelihood of confusion.

D. Balancing the DuPont Factors

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there is evidence and argument; “explain the results of that weighing;” and “the weight [we] assigned to the relevant factors.” *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). “No mechanical rule determines

likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d, 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). *See also Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 2024 USPQ2d 293, at *2 (Fed. Cir. 2024). We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto.

Notwithstanding the relatedness of the services, we find that confusion is not likely between Applicant’s mark and the Cited Marks because the marks are sufficiently dissimilar overall, given that the shared root word “CLIMB” is quite weak when used in connection with charitable financial services. The first and sixth *DuPont* factors, accordingly, are dispositive in this case. *See, e.g., Kellogg Co. v. Pack’em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive. ... ‘each [of the thirteen factors] may from case to case play a dominant role.’”).

IV. Decision:

The Section 2(d) refusal to register is reversed.

The requirement for a disclaimer under Section 6(a) of the Trademark Act, and the refusal of registration in the absence of a disclaimer, is affirmed. However, if Applicant submits the required disclaimer of “COMMUNITY FOUNDATION” to the Board **within thirty days**, this decision will be set aside as to the affirmance of the

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disclaimer requirement, and the application then shall proceed to publication.³⁴ *See* Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g).

³⁴ The standardized printing format for the required disclaimer text is as follows: “No claim is made to the exclusive right to use ‘COMMUNITY FOUNDATION’ apart from the mark as shown.” *See* TMEP § 1213.08(a).