

This Opinion is Not a
Precedent of the TTAB

Mailed: March 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PixelGood

Serial No. 98163828

PixelGood, pro se.¹

Heather Kennedy, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.²

Before Lykos, Coggins, and Stanley,
Administrative Trademark Judges.

Opinion by Stanley, Administrative Trademark Judge:

PixelGood (“Applicant”) seeks registration on the Principal Register of the standard-character mark DESIGN IS IN THE DETAILS. for “visual design services

¹ The application identifies Applicant’s “Principal” as “C D” and is signed “/PixelGood/”. September 4, 2023 Application, TSDR 1. Applicant’s brief is signed “/pg/” on behalf of PixelGood. 4 TTABVue 18.

² The application was reassigned from the original Examining Attorney for purposes of appeal. We refer to both Examining Attorneys as “the Examining Attorney.”

in the nature of designing visual elements for on-line, broadcast, print, outdoor and other communication media” in International Class 42.³

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used in connection with the identified services, so resembles the registered standard-character mark DESIGN IS IN THE DETAILS for the goods listed below, that it is likely to cause confusion, to cause mistake, or to deceive:

Accent lights for indoor use; Desk lamps; Electric lamps; Electric lighting fixtures; Floor lamps; Lamp finials; Lamp shades; Lamps; Lighting fixtures in International Class 11;

Accent pillows; Armchairs; Bedside tables; Benches; Bookcases; Bookshelves; Buffets; Busts of plaster, plastic, wood; Chairs; Chests of drawers; Console tables; Cushions; Decorative centerpieces of plaster, plastic, wood; Dining chairs; Dressers; End tables; Figures of closed cell resin polymer material; Figures of plaster, plastic, wood; Figurines of plaster, plastic, wood; Furniture of metal; Night tables; Nightstands; Ottomans; Sculptures of plaster, plastic, wood; Statues of plaster, plastic, wood; Statuettes of plaster, plastic, wood; Tables; Tea tables; Wall plaques made of plaster, plastic, wood; Wood carvings; Works of art in mixed media composed primarily of polymers; Works of art of plaster, plastic, wood in International Class 20; and

Bowls; Candlesticks not of precious metal; Ceramic figurines; Chargers; Clay floor vases; Clay pots; Decorative glass; Floor vases; Flower pots; Flower vases; Fruit bowls; Statues of ceramic, earthenware, terra cotta; Statuettes of

³ Application Serial No. 98163828 was filed on September 4, 2023, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging June 2, 2007, as the date of first use anywhere and March 18, 2008, as the date of first use in commerce.

ceramic, earthenware, terra cotta; Vases; Works of art made of glass in International Class 21.⁴

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed. The case is now briefed. We affirm the refusal to register Applicant's mark.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). *See also In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023). 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.*

⁴ Registration No. 4796833 issued on August 18, 2015 on the Principal Register. A Section 8 declaration has been accepted. Registration No. 4796833 is owned by StyleCraft Home Collections, Inc. ("Registrant"). The cited registration also covers goods in International Class 6, but the Section 2(d) refusal is based on the goods in International Classes 11, 20, and 21. *See* April 30, 2024 Non-Final Office Action, TSDR 2-4 (citing only Classes 11, 20, and 21 in the cited registration); June 13, 2024 Final Office Action, TSDR 3-6 (same). The Examining Attorney's evidence and arguments focus on Classes 20 and 21 of the cited registration. We do the same in this opinion.

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 online docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, Conc. No. 94002505, 2014 TTAB LEXIS 17, at *6 n.6 (TTAB 2014).

As part of an internal Board pilot program, this opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion uses citations to the LEXIS legal database and cites only precedential decisions, unless otherwise noted. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03(a)(2) (2024) for acceptable citation forms to TTAB cases.

Hargis Indus., Inc., 575 U.S. 138, 144 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). When analyzing the likelihood of confusion factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods and services, but also to protect registrants from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207-08 (Fed. Cir. 1993).

In any likelihood of confusion analysis, different *DuPont* factors may play a dominant role and some factors may not be relevant. *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 1116 (Fed. Cir. 2024) (quoting *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022)). In addition, varying weight may be assigned to each factor depending on the evidence presented, and “any one of the factors may control a particular case.” *Id.*; *see also Charger Ventures*, 64 F.4th at 1381. Although we consider each *DuPont* factor for which there is evidence and argument, *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019), 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, 1164-65 (Fed. Cir. 2002)). These factors, and others, are discussed below.

A. The Marks

Under the first *DuPont* factor, we compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir.

2005) (quoting *DuPont*, 476 F.2d at 1361); *see also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1319 (Fed. Cir. 2014). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, Serial No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018) (quoting *In re Davia*, Serial No. 85497617, 2014 TTAB LEXIS 214, at *4 (TTAB 2014)), *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).

There is no dispute that the standard-character mark DESIGN IS IN THE DETAILS. in the application and the mark DESIGN IS IN THE DETAILS in the cited registration are identical in sound and virtually identical in appearance. Their only difference in appearance is the inclusion of a period at the end of Applicant’s mark, which is insufficient to distinguish the marks. *See In re St. Helena Hosp.*, 774 F.3d 747, 750-51 (Fed. Cir. 2014) (agreeing with the Board’s finding that punctuation in registrant’s mark TAKE10! did not alter the pronunciation of the mark in any significant way or otherwise distinguish it from applicant’s mark TAKETEN); *In re Peace Love World Live, LLC*, Serial No. 86705287, 2018 TTAB LEXIS 220, at *23 (TTAB 2018) (“Slight differences in marks do not normally create dissimilar marks.”); *Davia*, 2014 TTAB LEXIS 214, at *9 (“As for the raised dots and periods in the mark, they are unpronounceable and contribute very little to the overall commercial impression of the mark.”); *In re White Swan Ltd.*, Serial No. 617169, 1988 TTAB LEXIS 37, at *3 (TTAB 1988) (when the same words are used in marks, the presence

or absence of hyphens or other punctuation marks generally will be of little significance).

Applicant concedes that “[w]ithout visual adornment, [Applicant’s] mark is nearly identical in appearance, sound, and connotation” to the cited mark, but Applicant further contends that “[t]he commercial application is benign until it’s given meaning or substance based on actual presentation and usage.”⁵ However, inasmuch as both marks are in standard characters and may be displayed in any font style, size, or color, they have the potential to be used in exactly the same manner. *In re Viterra, Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012); *In re i.am.symbolic, llc*, 866 F.3d 1315, 1324 (Fed. Cir. 2017); Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). We cannot make any determination regarding a likelihood of confusion based on alleged differences in the actual presentation and appearance on the respective goods and services. Although the connotation and commercial impression of a mark must be determined in relation to the respective goods and services, *see, e.g., In re i.am.symbolic, llc*, Serial No. 85916778, 2018 TTAB LEXIS 281, at *17 (TTAB 2018) (considering the meaning of the mark to customers of the identified goods), there is no evidence that consumers would perceive the virtually identical phrases DESIGN IS IN THE DETAILS. and DESIGN IS IN THE DETAILS to engender a different meaning or commercial impression in the context of the services listed in the application than in the context of the goods in the cited registration. *Compare In re Country Oven, Inc.*, Serial No. 87354443, 2019 TTAB LEXIS 381, at *3-4 (TTAB 2019) (no evidence that identical

⁵ Applicant’s Br., 4 TTABVUE 12.

marks engender different impressions as applied to non-identical goods (i.e., bread buns) and services (i.e., bakery shops and bakery services)) *with In re Sydel Lingerie Co.*, 1977 TTAB LEXIS 189, at *4-5 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

Due to the virtual identity of the marks, the first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

B. The Goods and Services, and Trade Channels

We turn now to the second *DuPont* factor, which considers the "similarity or dissimilarity and nature of the goods and services as described in an application or registration," and the third *DuPont* factor, which considers "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306, 1308 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361). 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, 1369 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *28 (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.*, Serial No. 85861533, 2015 TTAB LEXIS 178, at *9 n.5 (TTAB 2015). Additionally, where, as here, the parties’ marks are virtually identical, “the degree of similarity between the goods or services required for confusion to be likely declines.” *DeVivo v. Ortiz*, Opp. No. 91242863, 2020 TTAB LEXIS 15, at *36 (TTAB 2020); *see also Shell Oil*, 992 F.2d at 1207 (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”).

Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both an applicant’s goods and services (or similar goods and services) and the goods and services listed in the cited registration (or similar goods and services). *See, e.g., Davia*, 2014 TTAB LEXIS 214, at *21-24 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

Here, the record supports that Applicant’s visual design services and Registrant’s goods are of a type which may emanate from a single source. More specifically, the record includes website screenshots from several third-parties, including Alpha

Graphics, CT Prints, Jar Graphic Design, LoBo Designs, and Precision, each of whom provides both “visual design services in the nature of designing visual elements for on-line, broadcast, print, outdoor and other communication media” on the one hand, and products within the identifications of goods for Class 20 and Class 21 in the cited registration on the other, including wall plaques, bowls, vases, and works of art in various media (e.g., wood prints, plastic, and glass).⁶ *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65 (Fed. Cir. 1988) (BIGGS for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture).

The record also includes the following subsisting use-based,⁷ third-party registrations introduced by the Examining Attorney showing that the same entity has registered a single mark identifying Applicant’s services and at least one of the goods listed in Class 20 or 21 of the cited registration:

- Registration No. 5807331 for the standard-character mark PETITE FRITURE for, among other things, “benches,” “chairs,” “cushions,” “tables,” “bedside tables,” “console tables,” “dining chairs,” “end tables,” and “night tables,” in International Class 20, “bowls” in International Class 21, and “graphic design services” in International Class 42;⁸

⁶ *See* June 13, 2024 Final Office Action, TSDR 8-105.

⁷ We have not considered Registration No. 6496125 because the relevant Class 42 services are not based on Section 1(a), and the mark has been registered less than five years. *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *30 (TTAB 2022) (“third-party registrations that are not based on use in commerce; but rather issued under Trademark Act Sections 44(e) or 66(a), 15 U.S.C. §§ 1126(e) or 1141f(a), based on the foreign trademark owners’ home country registrations or as extensions of protection to the United States based on an international registration -- and have been registered for less than five years . . . lack probative value, and we have not considered them”).

⁸ April 30, 2024 Non-Final Office Action, TSDR 8-9.

- Registration No. 3797541 for the standard-character mark COMMUNE for, among other things, “end tables” and “nightstands” in International Class 20 and “graphic design services” in International Class 42;⁹



- Registration No. 7092327 for “bowls” in International Class 21 and “graphic design services” in International Class 42;¹⁰ and
- Registration No. 6831144 for the standard-character mark PATTERNED UNION for, among other things, “flower pots” and “vases” in International Class 21 and “graphic design services” in International Class 42.¹¹

As a general proposition, third-party registrations that cover goods from both the cited registration and an applicant’s application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark. *See, e.g., Country Oven*, 2019 TTAB LEXIS 381, at *9-10; *In re Albert Trostel & Sons Co.*, Serial No. 74186,695, 1993 TTAB LEXIS 36, at *7 (TTAB 1993).

Based on the foregoing evidence and discussion, we find that Applicant’s services and Registrant’s Classes 20 and 21 goods related. *See, e.g., In re C.H. Hanson Co.*, Serial No. 77983232, 2015 TTAB LEXIS 357, at *17 (TTAB 2015) (six websites showing sale of the subject goods, coupled with five third-party registrations of marks for them, “support the conclusion that the goods are related”).

Turning to the trade channels, the Internet evidence demonstrating that Applicant’s services are related to Registrant’s goods also supports a finding that those goods and services move in the same channels of trade because they are offered

⁹ *Id.* at 10-11.

¹⁰ *Id.* at 12-13.

¹¹ *Id.* at 14-15.

by the same entities and sold to consumers via their own business-to-consumer websites. *See, e.g., Stone Lion*, 746 F.3d at 1323.

Applicant does not address the Examining Attorney's third-party use or third-party registration evidence. Instead, Applicant argues that the second and third *Dupont* factors weigh against a likelihood of confusion because Applicant's and Registrant's goods and services are in "different classes" and in "different industries," and that Applicant and Registrant make "different uses" of their marks, including that Registrant's mark appears on a "retail label" seen at the "point of sale retail purchases" and Applicant's mark is a "slogan/tagline" that appears with its "company brand name" (i.e., "as in PixelGood—Design Is in the Details.").¹² Applicant's arguments are inapposite and unpersuasive.

That Applicant's services and Registrant's goods are in different International Classes does not establish that they are commercially unrelated. The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to likelihood of confusion. *Detroit Athletic*, 903 F.3d at 1307 (citing *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993)).

Furthermore, as we have explained in innumerable decisions, the Board may not consider arguments "about how the parties' actual goods, services, customers, trade channels, and conditions of sale are narrower or different from the goods and services identified in the applications and registrations." *In re FCA US LLC*, Serial No. 85650654, 2018 TTAB LEXIS 116, at *12 n.18 (TTAB 2018); *see also, e.g.,*

¹² Applicant's Br., 4 TTABVue 10-12.

i.am.symbolic, 866 F.3d at 1327 (“[T]he Board properly declined to import restrictions into the identification of goods based on alleged real world conditions.”); *Stone Lion*, 746 F.3d at 1321 (the Board must “give full sweep” to an identification of goods regardless of registrant’s actual business); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373 (Fed. Cir. 2013) (“The [US]PTO proceedings are ‘based on the content of the registration application’ and not upon any specific use of the challenged mark in commerce.”) (quoting *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232 (Fed. Cir. 2005)); *In re Thor Tech, Inc.*, Serial No. 78634024, 2009 TTAB LEXIS 253, at *15 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Applicant’s actual use of its mark as a tagline with a house mark is irrelevant. Applicant has applied to register DESIGN IS IN THE DETAILS. on its own, and it is the manner in which the Applicant and Registrant have identified their goods and services that is controlling. See *Nat’l Football League v. Jasper Alliance Corp.*, Opp. No. 77966, 1990 TTAB LEXIS 37, at *10-11 & n.5 (TTAB 1990).

The Examining Attorney has demonstrated that the goods and services are related and that the trade channels overlap. Accordingly, the second and third *DuPont* factors favor a likelihood of confusion.

C. Purchasing Conditions

We turn now to the conditions under which the goods and services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. Purchaser

sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive goods or services may tend to have the opposite effect. *Palm Bay*, 396 F.3d at 1376.

Applicant argues that its “mark is more likely to be assessed in connection with careful, sophisticated contracting due to the assertion that the Applicant provides graphic design services,” whereas “Registrant’s mark is more likely to be assessed in impulse buys as shoppers are more inclined to make purchases of its goods in a point of sale presentation, as in a visit to a retail store.”¹³ Applicant, however, failed to introduce any supporting evidence concerning purchasing conditions, and “argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)).

The application and cited registration identify goods and services that are not restricted by target market, price, or consumer sophistication. Applicant acknowledges that Registrant’s consumers are not sophisticated, and we can infer from the nature of Applicant’s services that potential purchasers may include sophisticated as well as unsophisticated consumers. We must base our decision “on the least sophisticated potential purchasers.” *Stone Lion*, 746 F.3d at 1325.

In view thereof, we find the fourth *DuPont* factor is neutral.

¹³ Applicant’s Br., 4 TTABVUE 13-14.

D. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of actual confusion, if any, in light of the length of time and conditions under which there has been contemporaneous use of the subject marks. *DuPont*, 476 F.2d at 1361.

Applicant argues that it has been using its mark since 2007 and that Registrant has presumably been using its mark since 2014; yet, Applicant “has not once encountered or interfaced with the Registrant’s product offerings in any capacity in which to generate confusion.”¹⁴

Applicant’s argument regarding the absence of actual confusion is misplaced. To begin, “a showing of actual confusion is not necessary to establish a likelihood of confusion.” *Herbko Int’l*, 308 F.3d at 1165 (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983)). Moreover, “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *Majestic Distilling*, 315 F.3d at 1317. We also have no evidence of whether the extent and circumstances of Applicant’s and Registrant’s uses of the respective marks were such as to give rise to meaningful opportunities for actual confusion to occur. *In re Kangaroos U.S.A.*, Serial No. 319021, 1984 TTAB LEXIS 77, at *6-7 (TTAB 1984).

In view thereof, the seventh and eighth *DuPont* factors are neutral.

E. Applicant’s Alleged Common Law Rights

The eleventh *DuPont* factor considers “the extent to which applicant has a right to exclude others from use of its mark on its [services].” *DuPont*, 476 F.2d at 1361.

¹⁴ Applicant’s Br., 4 TTABVUE 15.

Applicant argues that it “holds a Common Law use right that originates in 2007 and likely predates any use by any other parties in the same capacity or industry” and that “Applicant has a right to exclude any other entities from using the same mark to identify its services in a similar capacity.”¹⁵ However, there is no evidence of “an appreciable level of consumer recognition,” or “that Applicant, in fact, has successfully asserted its rights so as to ‘exclude’ anyone else from using [Applicant’s mark] or any similar mark.” *McDonald’s Corp v. McSweet, LLC*, Opp. No. 91178758, 2014 TTAB LEXIS 351, at *45 (TTAB 2014) (treating the eleventh *DuPont* factor as neutral); see also *In re Davey Prods. Pty Ltd.*, Serial No. 77029776, 2009 TTAB LEXIS 524, at *25 (TTAB 2009) (treating the eleventh *DuPont* factor as neutral; applicant’s “mere assertion of common-law use of its mark for ten years in itself” does not suffice to establish that applicant has any significant right to exclude others from use of the mark).

In view thereof, the eleventh *DuPont* factor is neutral.

F. Applicant’s Prior Registration

Applicant argues that the Examining Attorney’s refusal to register Applicant’s mark is inconsistent because “Applicant had previously registered the mark ‘DESIGN IS IN THE DETAILS. (Registration No. 3542988)’” “for the very same mark and use, from 2008-2019” and the cited mark was allowed to register despite Applicant’s prior

¹⁵ Applicant’s Br., 4 TTABVUE 16-17.

registration.¹⁶ Applicant contends that the two registrations coexisted for four years, until Applicant's prior registration was cancelled on July 12, 2019.¹⁷

More than four years after Applicant concedes that its prior registration was cancelled, Applicant filed the subject application to re-register the same mark for the same services. Applicant contends that "[s]ince both part[ies] use of the mark remains unchanged from their stated use as such on their applications/registrations, the same conclusion should be drawn today—as it was [when the cited registration was allowed to issue]."¹⁸

We consider Applicant's arguments about its prior registration under the thirteenth *DuPont* factor, which pertains to "any other established fact probative of the effect of use," *DuPont*, 476 F.2d at 1361, and "accommodates the need for flexibility in assessing each unique set of facts" *Country Oven*, 2019 TTAB LEXIS 381, at *19.

The Board's decision in *In re Strategic Partners, Inc.*, Serial No. 77903451, 2012 TTAB LEXIS 80 (TTAB 2012) is instructive. In that case, the applicant owned a registered mark that had coexisted with the cited mark for over five years. Because the applicant's prior registration was over five years old, the Board noted that any

¹⁶ Applicant's Br., 4 TTABVUE 9-10, 17-18. Applicant did not submit a copy of its prior registration in the record, but we will treat it as if is of record. *See In re Olin Corp.*, Serial No. 86651083, 2017 TTAB LEXIS 337, at *29 n.22 (TTAB 2017) (although registrations owned by applicant were not made of record, Board considered them because applicant and examining attorney addressed them without objection). However, because the registration was not submitted, we do not know what the actual registered mark and services were, but we presume Applicant's representations to be true.

¹⁷ *Id.* at 9.

¹⁸ *Id.* at 18.

challenge thereto by the owner of the cited registration based on a claim of likelihood of confusion would be time-barred under Section 14 of the Trademark Act, 15 U.S.C. § 1064. *Id.* at *8. In finding no likelihood of confusion in *Strategic Partners*, the Board provided the following explanation:

[T]he present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant's applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth *du Pont* factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

Id. at *9.

While we acknowledge that refusing to register the mark now before us may at first blush be considered inconsistent with the previous co-existence of the cited registration and Applicant's prior registration, we must consider that Applicant's prior registration has been cancelled and thus is not entitled to any of the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248 (CCPA 1973) ("Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled."); *In re Hunter Publ'g Co.*, 1979 TTAB LEXIS 87, at *19 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought."). Unlike the situation in *Strategic Partners*, Applicant's earlier registration is not an "**existing** registered mark." *Strategic Partners, Inc.*, 2012 TTAB

LEXIS 80, at *9 (emphasis added). The special circumstances and “unique situation” of *Strategic Partners* are not present here. *Id.*

While we are sympathetic to Applicant’s position, we do not consider, on this record, the co-existence of Applicant’s earlier, now-cancelled registration and the cited registration to outweigh the other *DuPont* factors. Moreover, the Board is not bound by the prior decisions of examining attorneys in allowing marks for registration. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) (“The [US]PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *see also In re Blvd. Entm’t Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (“The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.”). As is often noted by the Board and the courts, each case must be decided on its own merits. The determination of registrability of a mark in another case does not control the merits in the case now before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) (“[T]he [US]PTO’s allowance of such prior registrations does not bind the Board or this court.”). Applicant’s ownership of an earlier registration, even if for the identical mark, does not compel the approval of another if, as in this case, it would otherwise be improper to do so. *See, e.g., In re Perez*, Serial No. 73777892, 1991 TTAB LEXIS 32, at *5-6 (TTAB 1991) (Section 2(d) refusal affirmed even though the cited

registration had not been cited against applicant's previous registration, now expired, of the same mark for the same goods).

In view thereof, the thirteenth *DuPont* factor is neutral.

G. Other *DuPont* Factors

In addition to the *DuPont* factors discussed above, Applicant briefly mentions the fifth, sixth, ninth, tenth, and twelfth factors.¹⁹

Applicant did not present any evidence concerning these factors, and its arguments on these factors overlap with its arguments on the other factors (e.g., Applicant and Registrant operate in different industries, Applicant's mark is used as a tagline with its house mark, Applicant's mark is used on services different than the goods on which Registrant's mark appears). Because Applicant's arguments on these additional factors have been duly considered in connection with other factors, we treat the fifth, sixth, ninth, tenth, and twelfth factors as neutral.

II. Conclusion – Balancing the DuPont Factors

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto.

¹⁹ Applicant's Br., 4 TTABVue 14-17. The fifth *DuPont* factor considers "[t]he fame of the prior mark (sales, advertising, length of use)." *DuPont*, 476 F.2d at 1361. The sixth *DuPont* factor considers "[t]he number and nature of similar marks in use on similar goods." *Id.* The ninth *DuPont* factor considers "the variety of goods and services on which a mark is or is not used (house mark, 'family' mark, product mark)." *Id.* The tenth *DuPont* factor considers "[t]he market interface between applicant and the owner of a prior mark[.]" *Id.* The twelfth *DuPont* factor considers "[t]he extent of potential confusion, i.e., whether de minimis or substantial." *Id.*

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.” *Charger Ventures LLC*, 64 F.4th at 1384. “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, 1346 (Fed. Cir. 2010). *See also Naterra Int’l*, 92 F.4th at 116-17.

Here, the marks are identical in sound, meaning, and commercial impression, and virtually identical in appearance. The first *DuPont* factor therefore weighs heavily in favor of finding a likelihood of confusion. The Class 42 services of Applicant’s application and the goods in Classes 20 and 21 of the cited registration are related and the record shows that they move in the same channels of trade. Accordingly, the second and third *DuPont* factors weigh in favor of a likelihood of confusion. The fourth, fifth, sixth, seventh, eighth, ninth, tenth, eleventh, twelfth, and thirteenth factors are neutral in our likelihood of confusion analysis. No *DuPont* factor weighs against a finding of likelihood of confusion. Accordingly, we conclude that confusion is likely between Applicant’s mark for the identified services in Class 42 and the mark in the cited registration for the identified goods in Classes 20 and 21.

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