

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 4, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Night Owl Concrete, LLC

Serial No. 98341508

Susan S. Jackson of Nelson Mullins Riley & Scarborough LLP,
for Night Owl Concrete, LLC.

Lucy Browne, Trademark Examining Attorney, Law Office 125,
Robin Mittler, Managing Attorney.

Before Goodman, Allard, and Casagrande,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Night Owl Concrete, LLC (“Applicant”) seeks registration on the Principal




Register of the mark (‘‘CONCRETE’’ disclaimed) for the following
goods and services:

- ‘‘Downloadable computer application software for mobile devices, namely, software for use in ordering and scheduling of on-site manufacturing, supply and delivery of concrete by mixer truck,’’ in International Class 9;

- “Material supplier services, namely, online ordering services in the field of concrete and appointment scheduling services in the nature of scheduling appointments for on-site manufacturing and delivery of concrete by mixer truck,” in International Class 35; and
- “Material supplier services, namely, transportation and delivery of concrete for others by mixer trucks to construction sites,” in International Class 39.¹

Registration is refused 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 goods and services identified above, so resembles the composite word and design

mark  (“CONSTRUCTION SUPPLY, INC.” and “FREE NIGHT DELIVERIES” disclaimed) registered on the Principal Register for “Delivery services for construction tools and construction supplies,” in International Class 39,² that it is likely to cause confusion, to cause mistake, or to deceive.

After the refusal was made final, Applicant appealed and requested reconsideration. After the request was denied, the appeal resumed. Applicant and the Examining Attorney filed briefs.³ We affirm the refusal.

¹ Application Serial No. 98341508 was filed on January 4, 2024, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. The mark is described as “consist[ing] of a design of an owl adjacent to a partial bridge over the words NIGHT OWL and the word CONCRETE under the words NIGHT OWL.” Color is not claimed as a feature of the mark.

² Registration No. 2346893 was issued on May 2, 2000; renewed. The registration does not contain a description of the mark.

³ Applicant’s brief appears at 6 TTABVUE and the Examining Attorney’s brief appears at 8 TTABVUE.

I. Likelihood of Confusion

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 ... 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”15 U.S.C. § 1052(d). 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. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). 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); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976).

References to the briefs on appeal refer to TTABVue, the Board’s online docketing system. The number preceding TTABVue corresponds to the docket entry number; the number(s) following TTABVue refer to the page number(s) of that particular docket entry.

**A. Similarity or Dissimilarity and Nature of the Goods and Services,
and the Similarity or Dissimilarity of Established and Likely-to-
Continue Channels of Trade and Classes of Purchasers**

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” while the third *DuPont* factor “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306-08 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361). Our analysis under these factors is based on the identifications of goods and services in the involved application and the cited registration. *Id.* at 1306-08; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014).

1. Applicant’s Class 39 Services

Applicant’s Class 39 services are identified as “Material supplier services, namely, transportation and delivery of concrete for others by mixer trucks to construction sites.” Registrant, for its part, identifies “Delivery services for construction tools and construction supplies.” Here, the cited registration uses broad wording, i.e., “delivery services for ... construction supplies,” which presumably encompasses all services of the type described and all types of construction supplies, including Applicant’s more narrowly identified “material supplier services, namely, transportation and delivery of concrete for others by mixer trucks to construction sites,” as concrete constitutes “construction supplies.” *See Int’l Paper Co. v. Valley Paper Co.*, 468 F.2d 937, 938 (CCPA 1972) (where “registration description is broad enough to cover the goods [of the applicant], ... the legal effect of this fact is that the goods and channels of trade are to be considered the same for the purposes of this opposition”); *see also In re Solid*

State Design Inc., No. 87269041, 2018 TTAB LEXIS 1, at *13-16 (cited registration’s relatively broader “[d]ownloadable mobile applications for mobile phones and mobile electronic devices, primarily software for travel and destination marketing organizations and travel marketing professionals” encompassed application’s more specific “[c]omputer application software for mobile phones and desktop computers, namely, software for visualizing the popularity of places in real time”). Accordingly, we find that Applicant’s identified services are encompassed by Registrant’s identified services and are, as a result, legally identical to them.

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Registrant’s identified services are not restricted to any channel of trade or class of consumer. Admittedly, Applicant’s identified services are restricted to “transportation and delivery of concrete for others by mixer trucks to construction sites,” but this constitutes a delivery limitation rather than a limitation as to the channels of trade through which the services are sold. Because the services are legally identical, and because the involved application and the cited registration have no restrictions as to channels of trade or classes of consumers, Applicant’s and Registrant’s services are presumed to travel in the same channels of trade to the same class of purchasers. *See In re Viterro Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (finding Board entitled to rely on legal presumption of channels of trade and classes of consumers in determining likelihood of confusion); *Stone Lion*, 746 F.3d at 1323 (where “[t]he parties’ recited services were in part legally identical,” the Board

“properly found Stone Lion’s application and Lion’s registrations covered the same potential purchasers and channels of trade”).

2. Applicant’s Class 9 and 35 Goods and Services

We find that the face of the identifications themselves supports a finding that Applicant’s goods and services in Classes 9 and 35 and Registrant’s identified services are related. Recall that Applicant identifies (1) a mobile app for ordering and scheduling the on-site manufacturing, supply and delivery of concrete by mixer truck in Class 9, and (2) online ordering services for scheduling appointments for on-site manufacturing and delivery of concrete by mixer truck in Class 35. It is clear from the face of the identifications themselves that Applicant’s goods and services are closely related to Registrant’s “delivery services for construction tools and construction supplies,” inasmuch as both Applicant and Registrant identify goods and services that serve the same purpose: both provide the consumer with means for obtaining concrete by mixer truck. *See, e.g., In re Power Distrib., Inc.*, No. 77825939, 2012 TTAB LEXIS 402, at *9 (“By their intrinsic nature, the goods are related because they both consist of electrical power distribution products used for similar purposes, namely, for the distribution of electrical power.”); *In re Toshiba Med. Sys. Corp.*, No. 79046106, 2009 TTAB LEXIS 447, at *17 (medical MRI diagnostic apparatus and medical ultrasound devices are related in part because they have complementary purposes and may be used by the same medical personnel on the same patient to address the same medical issue).

Additionally, the Examining Attorney points out that third-party website evidence of record establishes that “registrant’s construction supply delivery services

are frequently provided under the same mark as applicant's Class 035 online ordering and scheduling services and Class 009 downloadable mobile application software, all of which pertain to the ordering and delivery of concrete.”⁴ As a result, the Examining Attorney continues, “applicant's Class 009 goods and Class 035 services and registrant's Class 039 services are considered related for likelihood of confusion purposes.”⁵

When considering the relatedness of the services, it is not necessary that the goods and services of Applicant and Registrant be similar or even competitive to support a finding of likelihood of confusion. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012). Rather, likelihood of confusion may be found if the respective goods and services are related in some manner 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.*

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods [or services] are used together or used by the same purchasers; advertisements showing that the relevant goods [or services] are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods [or services] and the goods [or services] listed in the cited registration.” *In re Embiid*, No. 88202890, 2021 TTAB LEXIS 168, at *30.

⁴ 8 TTABVUE 11.

⁵ 8 TTABVUE 11.

The record shows that the following third-parties offer both online ordering and scheduling services and a mobile app for ordering and scheduling the delivery of concrete by mixer truck:

- Made Easy Concrete offers mixers that measure, mix and dispense concrete all from one truck on-site; it offers “fresh-mix on-site (as opposed to pre-mix....),” “concrete on demand” and “on-demand dispatching when you need it.”⁶ Deliveries can be ordered and scheduled around the clock online via the “schedule your concrete” link and via the mobile app.⁷
- Concrete Direct offers concrete delivery online and via its mobile app.⁸ “You place an order of the concrete grade you want and the materials all poured inside the mixer tank and water is added. Mixing happens on the way to the job site.”⁹
- Thomas Concrete offers consumers the option to order concrete online and via a mobile application.¹⁰ “[We] ensure[] that you receive high-quality ready-mixed concrete precisely when and where you need it.”¹¹
- Ozinga, a ready mix concrete supplier and mixer, offers delivery services that can be scheduled via both (1) a mobile app, and (2) a desktop app, which is a “web-based desktop app [that] features all the real-time aspects of the [mobile app], plus access to historical and financial data. No download required.”¹² Both platforms allow “users to order, chat and track their orders anytime, anywhere.”¹³

⁶ December 10, 2024 Final Action at TSDR 6-8.

Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system.

⁷ December 10, 2024 Final Action at TSDR 9-10.

⁸ April 8, 2025 Denial of Request for Reconsideration at TSDR 2-5.

⁹ April 8, 2025 Denial of Request for Reconsideration at TSDR 2.

¹⁰ April 8, 2025 Denial of Request for Reconsideration at TSDR 11-16.

¹¹ April 8, 2025 Denial of Request for Reconsideration at TSDR at 14.

¹² April 8, 2025 Denial of Request for Reconsideration at TSDR 6-10.

¹³ April 8, 2025 Denial of Request for Reconsideration at TSDR 9.

Two other companies (J3 Concrete Pumping and QE Quality Enterprises) further evidence the relatedness of Applicant's Class 9 goods to the services in the cited registration. J3 Concrete Pumping offers ordering and scheduling of concrete delivery via a mobile app (Applicant's Class 9 goods), and that shows that these Class 9 goods are related to Registrant's identified services.¹⁴ And QE Quality Enterprises similarly offer consumers the ability to order, track and manage concrete deliveries via a mobile app (Applicant's Class 9 goods), further lending further support to a finding that these goods are related to the identified services of the cited registration.¹⁵

With the above discussion in mind, our determination that Applicant's identified Class 9 goods and Registrant's identified services are inherently closely related is bolstered by the fact that we find that the website evidence from Made Easy Concrete, Concrete Direct, Thomas Concrete, Ozinga, J3 Concrete Pumping, and QE Quality Enterprises demonstrates that Applicant's Class 9 goods are marketed under the same mark as Registrant's identified construction supply delivery services. This third-party website evidence showing both Applicant's Class 9 goods and Registrant's identified services offered by the same company under the same mark, particularly when combined with the finding that the goods and services are closely related, is

¹⁴ December 10, 2024 Office Action at TSDR 5. We disagree with the Examining Attorney that this evidence shows that J3 Concrete Pumping offers consumers the ability to order and schedule the on-site delivery of concrete online (Applicant's Class 35 services), as it merely shows that the site allows one to contact the company for a "free quote."

¹⁵ December 10, 2024 Final Action at TSDR 13. We disagree with the Examining Attorney, however, that QE Quality Enterprises offers consumers online ordering and scheduling services (Applicant's Class 35 services), as the record only shows that consumers can message the company.

sufficient to establish their relatedness under the second *DuPont* factor. *See, e.g., Detroit Athletic*, 903 F.3d at 1306-07 (evidence of third parties offering the goods and services at issue under one mark shows relatedness); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (stating that evidence that even “a single company sells the goods ... both parties, if presented, is relevant to a relatedness analysis”).

Turning to Applicant’s Class 35 services, four third-party websites show that Applicant’s Class 35 services and Registrant’s identified services are offered under the same mark: Made Easy Concrete, Concrete Direct, Thomas Concrete, and Ozinga. Absent any evidence that would indicate that relevant consumers are not exposed to any significant degree to these companies, this evidence, combined with our finding that the identifications alone demonstrate that the services are closely related, further supports that these services are related.

Because neither Applicant’s nor Registrant’s identification of goods or services includes any restrictions or limitations as to trade channels, we presume that the respective goods and services are or would be marketed in all normal trade channels for such goods and services. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1361 (Fed. Cir. 2000). The third-party website evidence demonstrating that the goods and services identified in both Applicant’s Class 9 and 35 identifications and Registrant’s registration are related (e.g., Made Easy Concrete, Concrete Direct, Thomas Concrete, Ozinga, J3 Concrete Pumping and QE Quality Enterprises) further show that such goods and services move in the same channels of trade, such as

concrete providers, and that they are sold to the same classes of consumers, namely, consumers needing concrete for residential or commercial use. *See, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) (“Because the record shows that companies are known to offer both residential and commercial services under the same mark and, often, on the same website, we find that substantial evidence supports the Board’s finding[s]” that they are related and that there is “some overlap” in trade channels). Based on this evidence, we find that the channels of trade for Applicant’s Class 9 and 35 goods and services together with the services identified in the cited registration overlap.

3. Applicant’s Arguments

Applicant does not dispute or even address in any meaningful way the Examining Attorney’s third-party website evidence showing the relatedness of the goods and services and the overlap in trade channels and customer classes, but rather argues that the differences in the identifications combined with the fact that Registrant’s “mark itself shows in its design a drill and states ‘FREE Night Deliveries[,]’” and that “[t]his collective information further emphasizes that the ... respective goods and services differ”¹⁶ We find Applicant’s arguments unpersuasive, as our determination about the relatedness of the identified goods and services must be made based on the identifications set forth in the application and registration. *See, e.g., Detroit Athletic*, 903 F.3d at 1306. As we previously found, the identification of services in the cited registration is relatively broad. That the mark in the cited

¹⁶ 6 TTABVue 9.

registration may highlight some aspects of the owner's services beyond what Applicant may provide does not detract from the inherent relatedness of Applicant's Class 39 services and the services identified in the cited registration. Nor does that detract from the third-party evidence showing that other companies offer goods and services found in both the application and the cited registration under one mark, and showing that such goods and services are offered through the same channels of trade to the same customer classes.

Applicant argues that its identified goods and services are marketed and sold in different channels of trade than Registrant's identified services because each of Applicant's three identifications "makes clear that its concrete is delivered by a concrete mixer truck (as opposed to by overnight mail)."¹⁷ While it is true that each of Applicant's identifications are limited to the delivery of concrete by mixer truck, this merely limits how the concrete is delivered and is not, as we mentioned earlier, a limitation on the channels of trade through which the services are offered or sold. First, "Night Deliveries," which means deliveries at night, is not the same thing as "overnight mail," which means using a mail service to deliver items the day after they're ordered. Second, Applicant does cite to any evidence supporting its argument that Registrant's construction supplies are delivered "by overnight mail," nor do we see any in the record. Moreover, the cited registration's identification does not, as Applicant argues, limit delivery of construction tools and supplies "by overnight mail." As stated, we must base our analysis on the identifications of the involved

¹⁷ 6 TTABVue 8.

application and cited registration, not on extrinsic evidence of actual use, even assuming it were to exist. *See Detroit Athletic*, 903 F.3d at 1306-07; *see, e.g., i.am.symbolic*, 866 F.3d at 1325.

Applicant also argues that even assuming that the marks are similar, confusion is not likely because its goods and services are not “in the same category or class” as Registrant’s services.¹⁸ As discussed above, Applicant’s Class 39 services are legally identical to Registrant’s identified services. While the cited registration does not include goods in Class 9 or services in Class 35, the fact that Applicant’s goods and services fall in different classes is not controlling. The classification of goods and services by the USPTO is a purely administrative determination and is irrelevant to whether the involved goods and services are related. *Detroit Athletic*, 903 F.3d at 1307 (“Classification is solely for the ‘convenience of Patent and Trademark Office administration,’ ... and ‘is wholly irrelevant to the issue of registrability’”) (quoting *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993)).

B. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entirety, considering their appearance, sound, meaning and commercial impression. *DuPont*, 476 F.2d at 1361; *see also Detroit Athletic*, 903 F.3d at 1303. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, No. 87075988, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, No. 85497617, 2014

¹⁸ 6 TTABVUE 8.

TTAB LEXIS 214, at *3-4), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019). “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.” *i.am.symbolic*, 866 F.3d at 1323 (quoting *Coach Servs.*, 668 F.3d at 1368). Moreover, “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (cleaned up; citation omitted).

All elements of the respective marks must be considered. *See Viterra*, 671 F.3d at 1362 (“[M]arks must be viewed ‘in their entirety,’ and it is improper to dissect a mark ..., including when a mark contains both words and a design.”); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (stating that “marks must be compared in their entirety”). However, 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. *Nat’l Data*, 753 F.2d at 1058.

Recall that Applicant seeks to register the composite mark




and




it has been refused in light of the composite mark . “In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark

is the one most likely to indicate the origin of the goods [or services] to which it is affixed.” *Viterra*, 671 F.3d at 1362 (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983)). “[T]he verbal portion of a word and design mark likely will be the dominant portion” because it “likely will appear alone when used in text and will be spoken when requested by consumers.” *Viterra*, 671 F.3d at 1366; *see also L.C. Licensing, Inc. v. Berman*, No. 91162330, 2008 TTAB LEXIS 756, at *9 (“[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods.”).

This general principle applies to the marks here. As an initial matter, the design

element in Applicant’s mark  is an image of an owl and, according to the description of the mark in the application, it is “adjacent to a partial bridge” over the literal elements of the mark. Here, the inclusion of the owl design reinforces (as a pictorial representation) the literal elements NIGHT OWL in Applicant’s mark, and the NIGHT OWL portion of the mark is at least as prominent as the owl image, rendering the verbal portion of the mark the dominant portion.

Similarly, the cited mark  consists of the large, all upper case, and bolded literal elements NIGHT OWL. Again, the image of the owl design reinforces the NIGHT OWL literal elements of the cited mark and renders the verbal portion

the dominant portion of the mark. While we acknowledge that additional words appear in the mark, such as ACME CONSTRUCTION SUPPLY, INC. and FREE NIGHT DELIVERIES, the consumer's eye is drawn to the more prominently displayed terms NIGHT OWL.

Considering all of the literal elements of Applicant's mark (NIGHT OWL CONCRETE), we find that NIGHT OWL alone is the dominant literal portion. These literal elements appear first and in larger font than the word CONCRETE. *See, e.g., Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 876 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, No. 91074797, 1988 TTAB LEXIS 60, at *8 (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]”). Moreover, Applicant's disclaimer of the term CONCRETE supports our finding, as terms that are disclaimed due to their descriptive nature have less source-identifying significance. *See, e.g., Detroit Athletic*, 903 F.3d at 1305 (“[T]he non-source identifying nature of the words ‘Co.’ and ‘Club’ and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.”) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (finding DELTA the dominant part of the mark THE DELTA CAFE, in part because the generic word “cafe” was disclaimed)).

Similarly, considering all of the literal elements of the cited mark (NIGHT OWL ACME CONSTRUCTION SUPPLY, INC. FREE NIGHT DELIVERIES), we find NIGHT OWL to be its dominant portion because these elements appear at the top of

the mark, in the largest font, in bold and all uppercase. *See, e.g., Century 21 Real Est.*, 970 F.2d at 876; *Presto Prods.*, 1988 TTAB LEXIS 60, at *8. Moreover, the literal elements CONSTRUCTION SUPPLY, INC. FREE NIGHT DELIVERIES are disclaimed, further supporting their non-trademark significance and constituting a rational reason for giving those terms less weight in our analysis. *See, e.g., Detroit Athletic*, 903 F.3d at 1305.

And we note that, in both marks, the prominent words “NIGHT OWL” are reinforced in each mark by the prominent owl designs. *Cf. Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002) (where both marks contained the terms CROSSWORD COMPANION, one mark’s crossword-puzzle design did not serve to differentiate it from the other).¹⁹

The marks are identical in part in sound because they would both be verbalized as NIGHT OWL, which they share as their most prominent literal element. They are similar in appearance because although they include different design elements and other literal elements, the most memorable visual features of each mark is their literal element NIGHT OWL, reinforced in both with owl designs. *See Shell Oil*, 992 F.2d at 1206 (composite marks containing the identical words RIGHT-A-WAY were

¹⁹ We think that, given the fallibility of memory, consumers are unlikely to recall specific differences in how the owls are graphically depicted. *Cf. Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587 (CCPA 1973) (“Side-by-side comparison is not the test... . That one figure is upright and apparently spry while the other is slightly stooped is, we believe, a difference not likely to be recalled by purchasers seeing the marks at spaced intervals. Purchasers of retail services do not engage in trademark dissection. Legal surgery, in which trademarks have parts enhanced or discarded, is of little aid in determining the effect of design marks on purchasers who merely recollect. The scalpel is employed by lawyers, not purchasers.”).

dominated by those words, and differences in scripts and arrow designs in those marks did “not diminish their substantial identity when viewed as a whole.”).

While we acknowledge Applicant’s arguments that there are some specific differences between Applicant’s and Registrant’s marks,²⁰ we disagree that “inadequate consideration has been given to the dissimilarities between the Appellant’s Mark and the ‘893 Registration.”²¹ We find that, in their entirety, the marks are similar in appearance, sound, connotation and commercial impression due to the shared dominant terms NIGHT OWL, together with owl designs.

Applicant argues that “in registrant’s mark the elements are inseparable such that there is not a likelihood of confusion” and, when viewed as a whole, create a different commercial impression than the involved mark.²² We agree with the Examining Attorney that the cited mark is not a unitary mark because the terms ACME CONSTRUCTION SUPPLY, INC. FREE NIGHT DELIVERIES are physically separated from the terms NIGHT OWL, convey two additional and different ideas, are displayed in much smaller font, and are intricately incorporated into the design element of the mark rendering them separable from, and less distinct than, the term NIGHT OWL.²³ *See, e.g., Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1561 (Fed. Cir. 1991) (Factors to consider in determining if a mark is unitary: the physical connection of the potentially unregistrable component to other elements of the

²⁰ 6 TTABVUE 10-11.

²¹ 6 TTABVUE 7.

²² 6 TTABVUE 11.

²³ 8 TTABVUE 8.

proposed mark by lines or other design features; the relative location of the respective elements of the proposed mark; and the significance of the terminology as used on or in connection with the goods or services.).

C. Balancing the Factors and Conclusion as to Likelihood of Confusion

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto and now weigh the *DuPont* factors for which there has been evidence and argument. *Charger Ventures*, 64 F.4th at 1384.

Turning first to Applicant's Class 39 services, having determined that Applicant's Class 39 services are legally identical to Registrant's identified services, the second *DuPont* factor weighs heavily in favor of a likelihood of confusion. Because the services are in part legally identical, the channels of trade and classes of consumers are, to that extent, presumed to be the same, causing these factors to weigh heavily in favor of a likelihood of confusion. While there are some differences in the marks, the marks appear in connection with legally identical services; as a result, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate*, 970 F.2d at 877; *In re La Peregrina Ltd.*, No. 78676199, 2008 TTAB LEXIS 38, at *8. Here, the shared use of the dominant literal elements NIGHT OWL causes the marks to be similar. Because all three factors weigh in favor confusion (the second and third heavily so), and none weigh against it, we find that confusion is likely.

Turning next to Applicant's Class 9 goods and Class 35 services, we find that, based on the identifications themselves, Applicant's identified goods and services and

Registrant's identified services are closely related. This finding is bolstered by third-party website evidence showing that Applicant's Class 9 goods and Class 35 services are related to those services identified by Registrant and that their channels of trade overlap. Thus, the factors comparing the goods and services, channels of trade, and classes of customers weigh in favor of a likelihood of confusion. Again, while we acknowledge that there are some differences in the marks, their shared use of the dominant literal elements NIGHT OWL causes them to be similar and, as a result, the first *DuPont* factor weighs in favor of a likelihood of confusion. Accordingly, because all the relevant factors weigh in favor of confusion and none weigh against it, we find that confusion is likely between Applicant's involved mark and the mark of the cited registration.

Decision

The refusal to register Applicant's mark is affirmed as to all classes (Classes 9, 35 and 39).