

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ironside Realty

Serial No. 98410651


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for Ironside Realty.

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Brandon Marsh, Managing Attorney.

Before Goodman, Stanley, and Brock,
Administrative Trademark Judges.


Opinion by Stanley, Administrative Trademark Judge:

Ironside Realty (“Applicant”) seeks to register on the Principal Register the

composite mark  (with “REALTY” disclaimed) for “real estate management” in International Class 36 and “real estate development,” in International Class 37.¹

¹ Application Serial No. 98410651 was filed on February 19, 2024, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging July 12, 2021 as the date of first use anywhere and date of first use in commerce. The application contains the following description of the mark: “The mark consists of the stylized terms ‘IRONSIDE REALTY’ wherein the letter ‘O’ in ‘IRONSIDE’ is stylized with chevrons.”

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to a likelihood of confusion with two registered marks on the Principal Register, both owned by Newark Warehouse Redeveloper Company, LLC (“Registrant”):

- IRONSIDE NEWARK (with “NEWARK” disclaimed), in standard characters, for “real estate services, namely, rental, leasing and management of commercial properties, offices and office space,” in International Class 36, and “real estate development and construction of commercial properties, offices and office space,” in International Class 37;² and
-  (with “NEWARK” disclaimed) for “real estate services, namely, rental, brokerage, leasing and management of commercial properties, offices and office space,” in International Class 36.³

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

² Registration No. 5429365 issued on March 20, 2018 (“the ’365 Registration”). A Section 8 and 15 combined declaration has been accepted and acknowledged.

³ Registration No. 5880590 issued on October 8, 2018 (“the ’590 Registration”). A Section 8 and 15 combined declaration has been accepted and acknowledged. The ’590 Registration contains the following description of the mark: “The mark consists of the stacked words ‘IRONSIDE NEWARK’ wherein the horizontal lines compassing the ‘I’ in ‘IRONSIDE’ are broken.” Both the ’365 and ’590 Registrations also cover services in International Class 39, but the Section 2(d) refusal is based on the services in International Classes 36 and 37. *See* September 9, 2024 Non-Final Office Action, TSDR 2-4 (citing only Classes 36 and 37 in the ’365 and ’590 Registrations); December 10, 2024 Final Office Action, TSDR 3-6 (same).

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.

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*”); *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.

As noted above, the refusal covers two separate classes of services. “Because each class in Applicant’s multi-class application is, in effect, a separate application, we consider each class separately, and determine whether [the Examining Attorney] has shown a likelihood of confusion with respect to each.” *In re OSF Healthcare Sys.*, Ser. No. 88706809, 2023 TTAB LEXIS 353, at *9-10 (TTAB 2023) (“On the appeal of a refusal to register directed to all classes in a multi-class application such as this one, examining attorneys and applicants should facilitate the Board’s review by discussing the evidence of relatedness on a class-by-class basis.”). *See also N. Face Apparel Corp. v. Sanyang Indus. Co.*, Opp. No. 91187593, 2015 TTAB LEXIS 328, at *32 (TTAB 2015).

We first consider the Examining Attorney’s refusal based on the ’365 Registration for the standard-character mark IRONSIDE NEWARK for services in Classes 36 and 37 (hereafter, the “Cited Mark” or “the ’365 Registration”). If we conclude there is a likelihood of confusion with respect to the Cited Mark, we need not address the Examining Attorney’s likelihood of confusion refusal with regard to the registered

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mark. *Sock It To Me, Inc. v. Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *20-21 (TTAB 2020) (confining Section 2(d) analysis to most similar pleaded mark); *In re Max Cap. Grp. Ltd.*, Ser. No. 77186166, 2010 TTAB LEXIS 1, at *4-5 (TTAB 2010) (comparing applicant’s mark to most similar cited mark).

A. The Services and Trade Channels

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,” 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.’”⁴ *Id.*

As noted above, the Class 36 services in the subject application are “real estate management,” and the Class 37 services in the subject application are “real estate development,” and the Class 36 services in the ’365 Registration are “real estate services, namely, rental, leasing and management of commercial properties, offices and office space,” and the Class 37 services in the ’365 Registration are “real estate development and construction of commercial properties, offices and office space.” Registrant’s “management of commercial properties” services are fully

⁴ Applicant did not address the second or third *DuPont* factors in its brief, thereby impliedly conceding the issues. See *In re Morinaga Nyugyo K. K.*, Ser. No. 86338392, 2016 TTAB LEXIS 448, at *3 (TTAB 2016) (Board considered Applicant to have conceded the issues of similarity of the goods and channels of trade by not addressing the issues).

encompassed by Applicant's "real estate management" services. Likewise, Registrant's "real estate development ... of commercial properties" services are fully encompassed by Applicant's "real estate development" services. When a registrant's services are fully encompassed within the wording of the subject application, they are considered legally identical.⁵ *See In re Medline Indus.*, Ser. No. 87680078, 2020 TTAB LEXIS 16, at *13 (TTAB 2020) (goods legally identical in part where "gloves for medical use" and "protective gloves for medical use" encompass "medical examination gloves"); *In re Info. Builders Inc.*, Ser. No. 87753964, 2020 TTAB LEXIS 20, at *9-11 (TTAB 2020) (finding services legally identical in part where registrant's services encompassed by applicant's services).

⁵ The Examining Attorney also submitted Internet evidence showing that Applicant's "real estate management" and "real estate development" services and Registrant's Class 36 and Class 37 services are of a type which may emanate from a single source. December 10, 2024 Final Office Action, TSDR at 10-58 (website screenshots from several third-parties, including Paradigm, Block, Dominion Real Estate Advisors, Manzitto, McGuire Development, and Meek, each of whom provides the relevant Class 36 and Class 37 services under the same mark). *See Detroit Athletic*, 903 F.3d at 1306 (evidence that third parties use the same mark for the involved goods and services "suggests that consumers are accustomed to seeing a single mark associated with a source that sells both"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (stating that evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis").

The record also includes twelve subsisting use-based, third-party registrations introduced by the Examining Attorney showing that the same entity has registered a single mark identifying Applicant's and Registrant's respective Class 36 and Class 37 services. December 10, 2024 Final Office Action, TSDR at 59-82 (identifying Registration Nos. 7365898, 5392417, 6403120, 5978814, 2975812, 7260256, 7317042, 4371168, 7277893, 6148798, 6539931, and 6340415). *See In re Country Oven, Inc.*, Serial No. 87354443, 2019 TTAB LEXIS 381, at *9-10 (TTAB 2019) ("As a general proposition, third-party registrations that cover goods and services 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.").

While this additional evidence is not needed given the legally identical nature of the Class 36 and Class 37 services in the subject application and certain of the Class 36 and Class 37 services in the '365 Registration, this evidence provides additional support for the Examining Attorney's refusal.

Based on the foregoing evidence and discussion, we find that Applicant's services and Registrant's services are in-part legally identical and otherwise related.

Turning to the trade channels, because Applicant's services in the application are legally identical to certain of the Class 36 and Class 37 services in the '365 Registration, we must presume that the channels of trade and classes of purchasers are the same for such services. *See In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 TTAB LEXIS 150, at *26 (TTAB 2016) ("Because the goods at issue are legally identical, we must presume that the goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers."); *see also In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

The Examining Attorney has demonstrated that Applicant's and Registrant's services are in-part legally identical and otherwise related, and we presume that the trade channels are the same for the legally identical services. Accordingly, the second and third *DuPont* factors favor a likelihood of confusion.

B. The Strength or Weakness of the Cited Marks

Because it may affect the scope of protection to which the cited marks are entitled, we turn next to the sixth *DuPont* factor, which considers "[t]he number and nature of similar marks in use on similar goods [or services]." *DuPont*, 476 F.2d at 1361. 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.⁶ *Id.*

“[T]he strength of a mark is not a binary factor” and instead “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (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 1338.

In determining the strength of a cited mark in the course of an ex parte appeal, we consider its inherent or conceptual strength based on the nature of the mark itself. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength . . . and its marketplace strength . . .”). Conceptual or inherent strength is a measure of a mark’s distinctiveness. *Id.* 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, 768 (1992). “Marks that are descriptive or highly suggestive are entitled to a narrower scope of

⁶ The fifth *DuPont* factor examines the extent to which the public perceives the mark as indicating a single source of origin, i.e., its fame or commercial strength. *DuPont*, 476 F.2d at 1361. There is no evidence of record relating to commercial strength under the fifth *DuPont* factor, but in an ex parte appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, Ser. No. 86140341, 2016 TTAB LEXIS 470, at *26 (TTAB 2016). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(ix) (May 2025). The fifth *DuPont* factor, as is normally the case in ex parte proceedings, is treated as neutral. *See In re Thomas*, Ser. No. 78334625, 2006 TTAB LEXIS 135, at *18 n.11 (TTAB 2006).

protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (quoting *Juice Generation*, 794 F.3d at 1339); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373 (Fed. Cir. 2015).

Here, the cited registrations issued on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). We must presume, therefore, that the cited marks as a whole are inherently distinctive for Registrant’s services even though the registrations each include a disclaimer of the term NEWARK as geographically descriptive for the services. *See Sock It To Me*, 2020 TTAB LEXIS 201, at *30 (SOCK IT TO ME for socks “taken as a whole, is inherently distinctive, although its strength is somewhat limited by its first word, SOCK, which is generic for socks.”); *Tea v. Republic of Tea*, Opp. No. 91118587, 2006 TTAB LEXIS 330, at *62 (TTAB 2006) (“A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.”). Nonetheless, we may consider whether an inherently distinctive mark, or portion thereof, is “weak as a source indicator” in the course of a *DuPont* analysis. *Fat Boys Water Sports*, 2016 TTAB LEXIS 150, at *23.

As noted above, NEWARK in the cited marks is disclaimed as geographically descriptive. The record includes the definition of the term “ironside,” which is defined

as “a man of great strength or bravery.”⁷ The term “IRONSIDE” appears to be arbitrary in connection with Registrant’s services. Third-party registrations, however, may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [mark] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 794 F.3d at 1339; *see also Spireon*, 71 F.4th at 1363; *Jack Wolfskin*, 797 F.3d at 1373-74; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (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”).

Applicant challenges the inherent or conceptual strength of the cited marks by relying on evidence of third-party registrations on the Principal Register.⁸ More specifically, Applicant relies on the following third-party registrations to show that the IRON-portion of the cited marks is weak and entitled to limited protection:⁹

⁷ September 9, 2024 Non-Final Office Action, TSDR at 12 (screenshot of definition of “ironside” from merriam-webster.com).

⁸ Applicant’s Br., 6 TTABVue 12-15. Applicant has not challenged the commercial strength of the cited marks by introducing evidence of third-party marketplace uses of the marks for services similar to Registrant’s services. 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, 1324 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374 (Fed. Cir. 2005)).

⁹ We have not considered the following TSDR records: Application Serial No. 98398282 for the standard-character mark IRON ARROW (March 10, 2025 Request for Reconsideration, TSDR at 37-39), Application Serial No. 98594665 for the standard-character mark IRON MOUNTAIN CAPITAL FUND (“CAPITAL FUND” disclaimed) (*id.* at 71-73), and Application Serial No. 98594669 for the standard-character mark IRON MOUNTAIN CAPITAL GROUP (“CAPITAL GROUP” disclaimed) (*id.* at 74-76), because third-party applications have no

- Registration No. 5271104 for the standard-character mark IRON VALLEY REAL ESTATE (“REAL ESTATE” disclaimed) for “Real estate agency services; real estate brokerage services; Providing real estate listings and real estate information via the Internet,” in International Class 36;¹⁰
- Registration No. 5936894 for the standard-character mark IRON KEY REAL ESTATE (“REAL ESTATE” disclaimed) for “Real estate agency services; Real estate brokerage; Real estate brokerage of commercial and residential properties; Residential real estate agency services,” in International Class 36;¹¹
- Registration No. 6856934 for the standard-character mark IRON RIVER CAPITAL (“CAPITAL” disclaimed) for “Providing information in the field of real estate; Real estate investment services; Real estate syndication,” in International Class 36;¹²
- Registration No. 6770560 for the composite mark **IRONGREY** for, in relevant part, “Real estate investment services in the nature of purchasing and selling of real estate for others,” “Real estate services relating to the sale, purchase and leasing of real estate, namely, real estate consultation and real estate management,” “Providing advice relating to real estate investment services,” and “Financing of real estate,” in International Class 36;¹³
- Registration No. 6065430 for the standard-character mark IRON CREST for, in relevant part, “Title insurance services, namely, agency and

probative value in that they evidence only the fact that the applications were filed. *See, e.g., Interpayment Servs. Ltd. v. Docters & Thiede*, Opp. No. 91119852, 2003 TTAB LEXIS 104, at *14 n.6 (TTAB 2003) (“[T]hird-party applications are evidence only of the fact that they were filed; they have no other probative value.”).


¹⁰ March 10, 2024 Request for Reconsideration, TSDR at 15-18.

¹¹ *Id.* at 19-21.

¹² *Id.* at 22-24.

¹³ *Id.* at 25-28. We note that Registration No. 6770560 issued under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), and has been registered for less than five years. As such, we give this registration less probative weight. *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *30 (TTAB 2022) (refusing to consider third-party registrations issued under Sections 44(e) and 66(a) of the Trademark Act where the marks are not based on use in commerce and have been registered for less than five years, because they “lack probative value”).

information services for real property; real estate escrow services,” in International Class 36;¹⁴

- Registration No. 5833901 for the standard-character mark IRONSTATE for “real estate development; real estate development and construction of commercial, residential, hotel and mixed-use properties,” in International Class 37;¹⁵
- Registration No. 3680265 for the standard-character mark IRON POINT REAL ESTATE PARTNERS (“REAL ESTATE PARTNERS” disclaimed) for “real estate investment fund services,” in International Class 36;¹⁶
-  Registration No. 2472205 for the composite mark IRON HORSE for, in relevant part, “Residential real estate development,” in International Class 37;¹⁷
- Registration No. 2474260 for IRON HORSE, in typeset form,¹⁸ for, in relevant part, “Residential real estate development,” in International Class 37;¹⁹
- Registration No. 7452724 for the standard-character mark IRON VALLEY REAL ESTATE FIND YOUR THING (“REAL ESTATE” disclaimed) for “Administration of the business affairs of real estate franchises,” in International Class 35;²⁰
- Registration No. 4731387 for the standard-character mark IRONWORKS for, in relevant part, “Real estate management of residential, retail and commercial property,” in International Class 36;²¹

¹⁴ March 10, 2025 Request for Reconsideration, TSDR at 29-33.

¹⁵ *Id.* at 34-36.

¹⁶ *Id.* at 40-43.

¹⁷ *Id.* at 48-51.

¹⁸ Prior to November 2, 2003, “standard character” drawings were known as “typed” or “typeset” drawings. *See Viterro*, 671 F.3d at 1363 n.2 (“[U]ntil 2003, ‘standard character’ marks formerly were known as ‘typed’ marks[.]”). A typed or typeset mark is the legal equivalent of a standard character mark. TMEP § 807.03(i).

¹⁹ March 10, 2024 Request for Reconsideration, TSDR at 52-55.

²⁰ *Id.* at 56-59.

²¹ *Id.* at 60-63.

- Registration No. 7172564 for the standard-character mark IRON GRAIN DISTRICT (“DISTRICT” disclaimed) for “Construction, maintenance and renovation of real property; Land development services, namely, planning and laying out of residential and/or commercial communities; Real estate development services in the field of a planned community of mixed residential and commercial use,” in International Class 37;²²
- Registration No. 5573914 for the standard-character mark IRON CREEK for, in relevant part, “private real estate investment services,” in International Class 36;²³



- Registration No. 7418306 for the composite mark (“IRONBOUND BUSINESS IMPROVEMENT DISTRICT MANAGEMENT CORP. NEWARK, NJ” disclaimed) for, in relevant part, “Providing consumer information in the field of job openings, residential rental real estate, businesses, events, and restaurants,” in International Class 35;²⁴ and
- Registration No. 6896570 for the standard-character mark IRONCLAIM for, in relevant part, “Appraisals for insurance claims of real estate,” “Insurance administration in the field of claim settlement assistance for commercial property owners,” and “Insurance administration in the field of claim settlement assistance for residential property owners,” in International Class 36.²⁵

We find that these registrations, albeit for different marks, demonstrate some conceptual weakness of the term “IRON” for real estate-related services, including real estate management and real estate development services. However, “IRON” alone is not a component term of the cited marks. Furthermore, Applicant’s mark and the cited marks are much more similar to one another than either is to any of the

²² *Id.* at 64-66.

²³ *Id.* at 67-70.

²⁴ *Id.* at 77-80.

²⁵ *Id.* at 81-84.

marks shown in these third-party registrations. *See, e.g., Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at *32 (TTAB 2021) (third-party registration evidence discounted where they contained “additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are”).

We further note that none of the registrations identified in Applicant’s brief are for IRONSIDE-formative marks. Applicant did previously identify thirteen third-party registrations for IRONSIDE-formative marks and argued that the “IRONSIDE” portion of the cited marks was weak.²⁶ In the December 10, 2024 Final Office Action, the Examining Attorney correctly noted that “none are for services in the real estate industry.”²⁷ Applicant did not rely on the thirteen IRONSIDE-formative registrations thereafter. We agree with the Examining Attorney that the thirteen IRONSIDE-formative third-party registrations in the record have no probative value, as none covers services similar to Registrant’s Class 36 or Class 37 services.²⁸ *See Omaha Steaks*, 908 F.3d at 1325 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *i.am.symbolic*, 866 F.3d at 1328 (disregarding third-party registrations for

²⁶ December 9, 2024 Response to Office Action, TSDR 12-13, 15-65.

²⁷ December 10, 2024 Final Office Action, TSDR at 8.

²⁸ For the same reason, we give little, if any, consideration to Registration No. 4078919 for the standard-character mark IRONHORSE, as the services specifically exclude those relating to “real estate development” (i.e., “Hedge fund investment services; investment advisory services; and strategic financial advisory services; **all of the foregoing excluding** golf course services, **real estate development services** and financial investment services **in the field of real estate**,” in International Class 36). March 10, 2024 Request for Reconsideration, TSDR at 44-47 (emphasis added).

other types of goods where the applicant had neither proven nor explained that they were related to the goods in the cited registration); *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 TTAB LEXIS 437, at *51 (TTAB 2017) (third party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case.”).

In sum, we find Applicant’s third-party registration evidence insufficient to demonstrate conceptual weakness of the IRONSIDE-portion of the cited marks for Registrant’s Class 36 and Class 37 services. We find that the IRONSIDE-portion of the cited marks is inherently distinctive for the relevant services, and the cited marks as a whole have not been shown to be conceptually weak. We therefore treat the sixth *DuPont* factor as neutral in our likelihood of confusion analysis, and accord the cited marks “the normal scope of protection to which inherently distinctive marks are entitled.” *Info. Builders*, 2020 TTAB LEXIS 20, at *26.

C. The Marks

We turn now to the first *DuPont* factor, which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *Palm Bay Imps.*, 396 F.3d at 1371; *see also Stone Lion Cap. Partners, LP 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.” *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018) (quoting *In re Davia*, Ser. 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).

“Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (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, 1373 (Fed. Cir. 2018) (quoting *Coach Servs.*, 668 F.3d at 1368). “The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *In re St. Julian Wine Co.*, Ser. No. 87834973, 2020 TTAB LEXIS 196, at *13 (TTAB 2020). Here, the average purchasers are members of the general public seeking real estate management or real estate development services.

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. *See, e.g., In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (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.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293 (CCPA 1974)). Nonetheless, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Detroit Athletic*, 903 F.3d at 1305 (quoting *Nat’l Data*, 753 F.2d at 1058). Moreover, in comparing the marks, “we are mindful that where, as here, the services are [in-part legally] identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services.” *Inn at St. John’s*, 2018 TTAB LEXIS 170, at *13 (citing *Coach Servs.*, 668 F.3d at 1368 and *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992)).

With these principles in mind, we compare Applicant’s composite mark



with the cited standard-character mark IRONSIDE NEWARK.

Applicant argues that, when comparing the appearance and sound of Applicant’s mark and the cited marks: (1) the Examining Attorney ignored the design element of Applicant’s mark; and (2) the Examining Attorney improperly dissected the marks by solely focusing on the shared word “IRONSIDE.”²⁹ Applicant further argues that Applicant’s mark and the cited marks have dissimilar connotations because the cited

²⁹ Applicant’s Br., 6 TTABVUE 9-11.

marks “connote a location, namely Newark, New Jersey,” whereas Applicant’s mark “connotes real estate generally,” with “no connotation of a specific location.”³⁰

The Examining Attorney counters that Applicant’s mark and the cited marks are similar because: (1) they share the same initial word “IRONSIDE,” which is the dominant word in both Applicant’s mark and the cited marks; (2) the word “IRONSIDE” means the same thing in both Applicant’s mark and the cited marks, namely “a man of great strength or bravery”; (3) the design elements of Applicant’s mark do not change the commercial impression of the mark relative to the meaning of the word “IRONSIDE;” and (4) the word portion of Applicant’s mark is more dominant than the design element.³¹

In reply, Applicant reiterates that the Examining Attorney improperly dissects Applicant’s mark and the cited marks and does not sufficiently consider the design elements in Applicant’s mark.³²

We agree with the Examining Attorney that the word “IRONSIDE” in Applicant’s mark and the Cited Mark is the dominant portion of each mark. We find so because the word “REALTY” in Applicant’s mark and the word “NEWARK” in the Cited Mark have little source-identifying significance. The word “REALTY” in Applicant’s mark is highly descriptive of or generic for Applicant’s services, and the word “NEWARK” in the Cited Mark is geographically descriptive of Registrant’s services. As a result, Applicant and Registrant appropriately disclaimed these terms in their respective

³⁰ *Id.* at 11-12.

³¹ Examining Attorney’s Br., 8 TTABVUE 4-8.

³² Applicant’s Reply Br., 9 TTABVUE 2-6.

marks. Due to their descriptive nature, the word “REALTY” in Applicant’s mark and the word “NEWARK” in the Cited Mark are entitled to less weight in our determination. *See Charger Ventures*, 64 F.4th at 1382 ([“W]hile the Board must consider the disclaimed term, an additional word or component may technically differentiate a mark but do little to alleviate confusion.”); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *Nat’l Data*, 753 F.2d at 1060); *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 TTAB LEXIS 108, at *8 (TTAB 2018) (disclaimed, geographically descriptive term “entitled to less weight in the likelihood of confusion determination”); *In re Code Consultants, Inc.*, Ser. No. 75645560, 2001 TTAB LEXIS 685, at *12 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

While Applicant is correct to emphasize that the disclaimed matter must also be evaluated in considering the marks, the Examining Attorney did not ignore the disclaimed matter. Rather, the Examining Attorney properly analyzed the marks by comparing them in their entirety and recognizing that the most dominant and memorable portion of Applicant’s mark and the Cited Mark, and the portion with the greatest potential source-identifying impact, is the word “IRONSIDE.”

Moreover, the significance of the word “IRONSIDE” as the dominant and memorable portion of Applicant’s mark and the Cited Mark is further reinforced by its position as the first word in both marks. *See Palm Bay*, 396 F.3d at 1372-73 (“The

presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.”); *Century 21 Real Estate*, 970 F.2d at 876 (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, Opp. No. 91074797, 1988 TTAB LEXIS 60, at *8 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

When marks have clearly dominant elements, as they do here, it is important to “also keep in mind the penchant of consumers to shorten marks.” *In re Bay State Brewing Co., Inc.*, Ser. No. 85826258, 2016 TTAB LEXIS 46, at *9 (TTAB 2016); *see also Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant’, it does indicate that people have called it by that name, omitting the word ‘Hamburgers’. Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant’, there likely would be confusion about which ‘Giant’ they were talking about.”). It is likely consumers of Applicant’s and Registrant’s services will shorten the marks to simply IRONSIDE, as the remaining parts of the marks add no more source-identifying information.

Furthermore, the stylized font and addition of the chevron design elements in Applicant’s mark do not detract from the word “IRONSIDE” being the dominant portion of Applicant’s mark. The word “IRONSIDE” is more important than the

design in Applicant's mark because it will be used to call for Applicant's services and more clearly and readily identifies the source of Applicant's services than the design. *See, e.g., Viterra*, 671 F.3d at 1366 ("[T]he verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co.*, Ser. No. 423405, 1987 TTAB LEXIS 47, at *3 (TTAB 1987) ("[I]f one of the marks 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 or services."). Additionally, the Cited Mark is in standard-character format, so we must consider that Registrant could display its mark in a font style, size or color similar to Applicant's mark, thereby heightening the likelihood of confusion. *See Aquitaine Wine USA*, 2018 TTAB LEXIS 108, at *13; *In re Strategic Partners Inc.*, Ser. No. 77903451, 2012 TTAB LEXIS 80, at *6-7 (TTAB 2012).

While the marks are not identical in sound and appearance, they are similar in sound and appearance in that they share the same dominant leading word "IRONSIDE."

The marks also share similar commercial impressions. As already discussed, the identified Class 36 and Class 37 services in Applicant's application and the '365 Registration are in-part legally identical and otherwise related. In the context of such services, the common use of the same first word "IRONSIDE" in the marks creates a similar commercial impression for both marks, namely the commercial impression of "a man of great strength or bravery." There is no evidence or reason to believe that the shared word would have one meaning when used for Applicant's services and

another when used for Registrant's services. The inclusion of the descriptive word "REALTY" in Applicant's mark and the geographically descriptive word "NEWARK" in the Cited Mark does not alter the shared commercial impression. In the context of the services identified in the application, consumers with a general impression of the Cited Mark could readily view Applicant's mark as a variant of the Cited Mark reflecting a line extension or expansion of Registrant's services (i.e., an expansion of Registrant's services outside of Newark or New Jersey, generally). *See, e.g., Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, Opp. No. 91197659, 2013 TTAB LEXIS 314, at *32 (TTAB 2013) ("Purchasers of opposer's GOTT and JOEL GOTT wines are likely to assume that applicant's goods, sold under the mark GOTT LIGHT and design, are merely a line extension of goods emanating from opposer."); *Schieffelin & Co. v. Molson Cos., Ltd.*, Opp. No. 69312, 1989 TTAB LEXIS 1, at *12 (TTAB 1989) ("Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product.").

Applicant compares this appeal to the facts of *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992), where the court found VARGA GIRL and VARGAS distinct because the additional term "GIRL" altered the appearance, sound, and commercial impression, even though "VARGA" was shared.³³ The present appeal is distinguishable from *Hearst*, where the first words in the marks were similar but not identical. In this case, Applicant's mark and the Cited Mark share the identical first

³³ Applicant's Br., 6 TTABVUE 10-11; *see also* Applicant's Reply Br., 9 TTABVUE 3-4.

word “IRONSIDE.” Applicant has not provided any evidence to demonstrate that consumers would attach a different connotation or commercial impression to the identical word “IRONSIDE” appearing in both marks.

In view of the foregoing, although we recognize that Applicant’s mark and the Cited Mark are not identical, when we compare the marks in their entirety, there is sufficient similarity to increase the likelihood of source confusion. This is true especially when we keep in mind: (1) that the degree of similarity between the marks necessary for finding likelihood of confusion is lessened between marks used in connection with legally identical services; (2) “the fallibility of memory over a period of time;” and (3) that the “average” purchaser “normally retains a general rather than a specific impression of trademarks.” *Sealed Air Corp. v. Scott Paper Co.*, 1975 TTAB LEXIS 236, at *6 (TTAB 1975). *See also St. Helena Hosp.*, 774 F.3d at 751 (“marks must be considered in light of the fallibility of memory”) (citation, internal quotation marks, and ellipsis omitted).

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

II. Conclusion – 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 address “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 1116-17 (“Only the *DuPont* factors of significance to the particular mark need be considered in the likelihood of confusion analysis.”).

We have carefully considered all of the evidence and arguments. The Class 36 and Class 37 services of Applicant’s application and the Class 36 and Class 37 services of the ’365 Registration are in-part legally identical and otherwise related, and the trade channels and classes of consumers for the legally identical services are presumed to be the same. Accordingly, the second and third *DuPont* factors weigh in favor of a likelihood of confusion for the services in both Class 36 and Class 37. Applicant’s mark and the Cited Mark are similar in appearance, sound, meaning, and commercial impression. The first *DuPont* factor therefore weighs in favor of finding a likelihood of confusion. The fifth and sixth *DuPont* 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 Classes 36 and 37 and the Cited Mark for the identified services in Classes 36 and 37.

Decision: The Section 2(d) refusal to register Applicant’s mark in both International Classes 36 and 37 is affirmed.