

This Opinion is not a
Precedent of the TTAB

Mailed: January 21, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re SEMILLAS FITO, S.A.
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Serial No. 79311562
—


James H. Walters, of patenttm.us,
for SEMILLAS FITO, S.A.

Ryan Cianci, Trademark Examining Attorney, Law Office 116,
Elizabeth Jackson, Managing Attorney.

—
Before Goodman, Lebow, and Casagrande,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:


SEMILLAS FITO, S.A. (“Applicant”) seeks registration on the Principal Register

of the mark  for goods ultimately identified as “Natural seeds for agricultural and horticultural purposes; Agricultural and aquacultural crops, horticulture and forestry products namely, fresh fruits, fresh vegetables, seeds for

horticultural purposes, crop seeds, agricultural seeds, plant seeds, fruit seeds,” in International Class 31.¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to likelihood of confusion with the registered



mark  for goods currently identified as “Unprocessed edible seeds not containing alfalfa; Unprocessed fruits; Unprocessed grain not containing alfalfa.”²

¹ Application Serial No. 79311562 was filed on April 15, 2021, based on a request for extension of protection of International Registration No. 1350799 under Section 66a of the Trademark Act of 1946, 15 U.S.C. § 1144f(a). Applicant later filed a statement describing the mark as follows: “The mark consists of the stylized wording ‘FITO.’” Color is not claimed as part of the mark.

² Reg. No. 4943858 issued on April 26, 2016; Section 8 declaration accepted on May 12, 2023. *See also* October 12, 2023, Final Office Action, at TSDR 2. The registration disclaims exclusive rights in the term “PERU” apart from the mark as a whole and contains the following translation statement: “The English translation of ‘FITO’ in the mark is ‘A ROOT TERM INDICATING PLANT OR VEGETATION’.” *See* Dec. 17, 2021, Nonfinal Office Action, at TSDR 13. The registration describes the mark as follows: “The color(s) dark green, green, light green, white, and beige is/are claimed as a feature of the mark. The mark consists of the phrase ‘FITO PERU’ in dark green on a beige wavy background, above the wavy background is a light green circular element, inside the circular element is a stylized plant element consisting of three leaf-like elements two of which are white and the middle one is light green, behind the plant is a green globe with a series of light green grid lines below the plant is a dark green portion; to the right of the flower is the phrase ‘IN THE WORLD’ in dark green curved vertically.” *See id.* at 14 (capitalization altered).

Citations in this opinion to the application records refer to the versions of those records downloaded in .pdf format from the Trademark Status and Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

After the Examining Attorney made the refusal final,³ Applicant appealed⁴ and requested reconsideration.⁵ We suspended the appeal and remanded the application to the Examining Attorney to consider the request for reconsideration.⁶ After the Examining Attorney denied reconsideration,⁷ the appeal resumed.⁸ Applicant filed a brief,⁹ as did the Examining Attorney.¹⁰ Applicant filed a reply brief.¹¹ The case is now ready for decision. For the reasons explained below, we reverse the refusal to register.

I. Section 2(d) refusals generally

Section 2(d) of the Trademark Act prohibits registration of a mark that “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). We determine whether confusion is likely by analyzing all probative facts in evidence relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361

³ See Oct. 12, 2023, Final Office Action.

⁴ See 1 TTABVUE. References to the briefs and appeal record cite to the Board’s TTABVUE electronic docket system. The number preceding “TTABVUE” represents the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specifically-cited page(s), if any.

⁵ See Apr. 10, 2024, Request for Reconsideration.

⁶ See 2 TTABVUE.

⁷ See 4 TTABVUE.

⁸ See 5 TTABVUE.

⁹ See 6 TTABVUE.

¹⁰ See 8 TTABVUE.

¹¹ See 9 TTABVUE.

(CCPA 1973) (providing a nonexclusive list of 13 factors potentially relevant to likelihood of confusion). *See, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023).¹² We then weigh together the findings we have made on the relevant likelihood-of-confusion factors to determine if, on balance, they indicate that confusion is likely. *See, e.g., Charger Ventures*, 64 F.4th at 1381; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1319 (Fed. Cir. 2003).

“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.” *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993); *see also Charger Ventures*, 64 F.4th at 1381 (“In any given case, different ... factors may play a dominant role and some factors may not be relevant to the analysis.”) (citation omitted). Here, as we explain below, an unusual factor is not only relevant but intensely disputed and, ultimately, plays a significant role in the outcome of this appeal.

II. Analysis

We will start with the relevant factors that Applicant does not dispute.

¹² This opinion is issued as part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases. It cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Westlaw (WL) citations are used for decisions of the Board. Serial or proceeding numbers are provided where available to assist finding cited Board opinions in USPTO and other databases. This opinion thus conforms to the practice set forth in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024).

A. Comparison of the goods

The second likelihood-of-confusion factor assesses “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *du Pont*, 476 F.2d at 1361. The similarity of the goods (or services) is, along with the similarity of the marks, usually considered one of the relatively more important likelihood-of-confusion factors. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”), *quoted in In re Dare Foods Inc.*, No. 88758625, 2022 WL 970319, at *1 (TTAB 2022).

Here, the Examining Attorney argues that Applicant’s goods are identical in part to those in the registration because the registration identifies “unprocessed edible seeds” and the application lists several kinds of seeds, including plant seeds, which are a subset of the seeds in the registration.¹³ This is significant because a refusal may be based on a likelihood of confusion as between only one type of good in the application and one type of good in a registration. *See, e.g., Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 330 (CCPA 1963) (“the board properly held that where there is likelihood of confusion as to any of the goods listed in the application, it is not necessary to rule on other goods listed therein”); *Bond v. Taylor*, No. 91213606, 2016 WL 3771777, at *4 (TTAB 2016) (“[A] likelihood of confusion may be found with

¹³ *See* 8 TTABVUE 11-12.

respect to a particular class based on any item within the identification of goods for that class.”) (citation omitted). Applicant’s brief does not address this factor.

We find that the respective goods are identical-in-part. *See, e.g., Hunt Foods & Indus., Inc. v. Anderson, Clayton & Co.*, 353 F.2d 250, 251 (CCPA 1965) (where goods were “hydrogenated vegetable oil shortening” and “vegetable oil shortening,” court held that the goods were “the goods listed in the application for registration [are] in legal contemplation are the goods of appellant, and they are legally identical to the goods of opposer-appellee”); *In re Hitachi High-Techs. Corp.*, No. 79110412, 2014 WL 879500, at *4 (TTAB 2014) (where goods “overlap in part,” they are “legally identical”). Thus, this factor favors a determination that confusion is likely.

B. Comparison of the channels of trade and the classes and characteristics of the relevant customers

We also consider “[t]he similarity or dissimilarity of established, likely-to-continue trade channels” as well as “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *du Pont*, 476 F.2d at 1361. Where an application or registration is unrestricted, the identified goods are “presumed to be sold in all normal trade channels to all the normal classes of purchasers.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1308 (Fed. Cir. 2018) (citation omitted). The Examining Attorney argues, and we agree, that where, as in this case, the goods are in-part identical, we further presume that the trade channels and classes of customers are, to that extent, identical as well.¹⁴ *See, e.g., In re Viterra Inc.*,

¹⁴ *See* 8 TTABVUE 12.

671 F.3d 1358, 1362 (Fed. Cir. 2012) (when an application and registration list identical goods, “absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers”) (citations omitted); *Nazon v. Ghiorse*, No. 91216729, 2016 WL 3876810, at *9 (TTAB 2016) (where services are “legally identical in part ... they must also be presumed to travel in the same channels of trade to the same classes of consumers) (citation omitted).

Applicant does not argue that the trade channels and classes of customers are different.

We find that the trade channels and classes of customers for the goods overlap. These two factors therefore also favor a conclusion that confusion is likely.

C. Comparison of the marks

We now come to the two factors as to which Applicant directs its arguments. We start with the first-listed factor in *du Pont*: “[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” 476 F.2d at 1361. “Marks are compared along the axes of their ‘appearance, sound, connotation and commercial impression.’” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015) (citation omitted); *accord In re i.am.symbolic, llc*, 866 F.3d 1315, 1324 (Fed. Cir. 2017). We do not compare marks side-by-side, but consider them instead against the backdrop of the fallibility of consumer memory. *See, e.g., In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981).

As a reminder, the two marks we're comparing are these:

Registered Mark:



Applicant's Mark:



The Examining Attorney argues that the marks are confusingly similar, emphasizing that the literal element “FITO” is the entirety of Applicant’s mark and that “‘FITO’ drives the commercial impression of the registered mark”¹⁵ In support, the Examining Attorney invokes two general rules-of-thumb:

- where a mark comprises both words and a design, the words are usually the dominant element in creating the commercial impression of the mark; and¹⁶
- disclaimed or descriptive terms, such as “Peru” in the registered mark, cannot be considered the dominant element of a mark.¹⁷

For its part, Applicant highlights that its mark is in a highly-stylized typeface, and that the registered mark employs two stylized typefaces, both of which are more mundane than Applicant’s. Applicant points to the fact that the registered mark contains several additional words besides FITO and that it also contains several prominent non-literal graphic elements.¹⁸

¹⁵ See 8 TTABVUE 9.

¹⁶ See *id.* at 8; see also *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015).

¹⁷ See *id.*; see also *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1351 (Fed. Cir. 2011).

¹⁸ See 6 TTABVUE 19-21.

While both marks contain the term “FITO,” we think their overall commercial impressions are significantly different. First, Applicant’s mark is in an unusual, highly-stylized typeface.¹⁹ In the registered mark, the literal element is FITO PERU IN THE WORLD. While the term FITO, because it is the lead literal element, is certainly prominent in the registered mark, it does not strike us as “dominating” the commercial impression of that literal component, which comprises several words. Moreover, the words FITO PERU are integrated into a banner, which itself is attached to a semi-circular element partially surrounding a prominent design comprising a circular element vaguely reminiscent of a globe that itself serves as the background for a prominent leaved, plant-like design. In other words, the cited mark comprises several prominent literal and design elements integrated together.

While it is true that, in many cases, words tend to make more of an impression than an accompanying design, it is also true that each case presents its own unique set of facts. *See, e.g., Jack Wolfskin*, 797 F.3d at 1371 (that words generally tend to make more of an impression than designs does “not trump ... our duty to consider marks on a case-by-case basis”). And there have been times when such cases arise. An example is *Methuen International Mills v. Rajinder Fabrics, Inc.*, 406 F.2d 1392 (CCPA 1969). There, the owner of a registration for INDIA in standard characters alleged a likelihood of confusion would result from registration of the word & design

¹⁹ While the description of the mark in the application makes clear that the literal element is “FITO,” there is an accent mark over the “o,” and that in the highly-stylized form used, it is contiguous with, not separated from, the “o.” And we cannot refrain from observing that, in that stylized form, the “o” with the attached accent could be seen as the numeral “6,” and for those observers unfamiliar with Applicant (or who have not read the application) plausibly could interpret the mark as a stylized form of “fit6.”



mark . On appeal, the Court of Customs and Patent Appeals agreed with the Board that “[t]his image ... is sufficiently distinctive to set the proposed mark apart from any association with opposer’s mark so that the average purchaser would be unlikely to be confused by the application of the two marks to the same or similar goods.” *See id.* at 1394. We emphasize that we’re not saying the *Methuen* decision “controls” this case, because no one trademark decision “controls” subsequent cases involving different marks and evidence. But it illustrates that, sometimes, design elements and/or additional wording can significantly impact the overall commercial impression of a mark. And here, we have the added distinction of the unusual and memorable stylization of Applicant’s mark. *See also Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 124 (CCPA 1966) (confusion unlikely between the applicant’s FERRO-GARD & Design mark and several marks consisting of or containing FERRO due to “the presence of the animated bolt carrying a flag on which are the letters ‘VCI’; and that the word ‘gard’ is in larger and bolder lower case letters than the term ‘Ferro’ which is in smaller letters”).

In sum, while Applicant’s mark is for a stylized version the word FITO, and that word is also the first word in the word + design mark of the cited registration, we find that, viewed in their entirety, the marks primarily convey different commercial impressions. We find that this important factor weighs against a conclusion that confusion is likely.

D. The thirteenth, “catch-all” factor and *Strategic Partners*

We now come to Applicant’s lead (and primary) argument: that the mark in the cited registration “co-existed”²⁰ on the register with two registrations of Applicant’s marks that are quite similar to Applicant’s current registration, and that this circumstance strongly suggests confusion is unlikely as between the marks in the cited registration and Applicant’s current application. In support of this argument, Applicant points primarily to the discussion of *du Pont*’s thirteenth factor in the Board’s precedential decision in *In re Strategic Partners, Inc.*, No. 77903451, 2012 WL 1267930 (TTAB 2012).²¹

Before we assess Applicant’s argument invoking *Strategic Partners* and *du Pont*’s thirteenth factor, it is important to understand the basis of *Strategic Partners*’ holding. Contrary to the assertion of the Examining Attorney,²² *Strategic Partners* does not create some indeterminate form of estoppel against the USPTO where there was a relevant period of co-existence. In other words, it’s not about whether the USPTO is treating the current registration in a manner allegedly inconsistent with a prior, similar mark. That is because it is a bedrock principle that the USPTO is statutorily required to refuse registration of a mark **anytime** the evidence shows that the statutory requirements have not been satisfied. *See, e.g., In re Cordua Rests., Inc.*,

²⁰ We put the term “co-existed” in parentheses because it’s a bit odd to characterize two inanimate, two-dimensional objects in a database of millions of other words and designs as “co-existing.”

²¹ *du Pont*’s thirteenth factor is phrased as a catch-all. *See* 476 F.2d at 1361 (“Any other established fact probative of the effect of use.”).

²² *See* 8 TTABVUE 4-5.

823 F.3d 594, 600 (Fed. Cir. 2016). And that requirement applies irrespective of whether the agency has previously treated similarly-situated marks in an allegedly different manner. *See, e.g., In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009).

Rather, the way that a *Strategic Partners* co-existence circumstance bears on likelihood of consumer confusion is that it can provide circumstantial evidence as to the view of the owner of the cited registration on whether confusion is likely. Keep in mind that it is well settled that, when a prior registrant expressly and in writing agrees that registration of a later mark is unlikely to cause confusion (and the agreement provides a factual basis for that conclusion), we generally give such an express written agreement from the owner of a cited registration great weight—often overriding weight—in determining whether confusion is likely. *See, e.g., In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1568-69 (Fed. Cir. 1993). A *Strategic Partners*-type situation also can provide insight into the view of the owner of the cited registration. But it relies on inferences derived from a particular circumstance—the owner’s inaction in the face of the applicant’s prior, similar registration—as opposed to the owner’s act of entering into an express agreement.

A typical *Strategic Partners*-type scenario has the following characteristics:

- First, the cited registration issues;
- Later, an applicant obtains a registration for a mark and goods arguably similar to the mark and goods in the cited registration;
- A period of time then passes during which the owner of the cited registration does not file a petition to cancel the applicant’s later registration for causing a likelihood of confusion;

- Later still, the applicant applies for another registration of a mark similar to its prior registration both in terms of the mark and the goods, but, unlike the applicant's first registration, that application is refused due to a likelihood of confusion with the mark in the cited registration.

When that scenario is present, we can often infer that the prior registrant does not believe that the applicant's first registration is likely to cause confusion, or else it would have petitioned to cancel it on that basis during the period of time when such a claim was permissible. But because this does not involve the registrant's express written agreement to that effect—just the registrant's inaction in those circumstances—that inference is typically given less weight in the confusion calculus than the registrant's express written agreement would be given. The five-year period after the applicant's first registration is significant because, once reached, that first registration is statutorily exempted from the possibility of being cancelled for causing a likelihood of confusion under Section 2(d). *See* 15 U.S.C. § 1064.

In the situation just described, any inference under the thirteenth *du Pont* factor is based on the **inaction** of the owner of the cited registration after the applicant later receives its prior registration. But there's a variation on the *Strategic Partners* scenario where the timing is flipped: the applicant owns a registration that pre-dates when the owner of the cited registration filed its application for the cited mark. In this scenario, the five-year period of coexistence is not as significant, because we can infer from the **action** of the owner of the cited registration (in applying to register its mark after the applicant received its first registration) that the owner of the cited registration does not believe confusion is likely, or else it would not have filed its

application in view of the presence of the prior-registered mark.²³ Of course, once the applicant's original registration reaches the age of five years, we can read a bit more into the fact that the owner of the cited registration didn't try to cancel it.

In either *Strategic Partners* scenario, the co-existence of the two registrations may give rise—depending on the circumstances—to an inference about whether the owner of the cited registration has acted, or declined to act, in a way that tends to show that it believes that confusion is unlikely. And, of course, if the owner disagrees with our inference, there is a failsafe mechanism: if the applicant's current mark ultimately is allowed for registration, the owner may file a statutory opposition proceeding against the application or later petition to cancel it.

The strength of the inference depends on the circumstances. While there certainly are others, three circumstances seem universally relevant. First, how close is the mark in applicant's prior registration to both the cited registered mark and the mark in the present application? Second, how close are the goods/services in the applicant's prior registration to those in both the present application and to those in the cited registration? For example, are the goods/services in the applicant's current application moving closer to, or increasingly overlapping, the goods/services in the cited registration to any significant degree? Third, how long did the applicant's prior registration and the cited registration co-exist on the Register?²⁴

²³ In this situation, we presume that the owner of the cited registration was aware of the applicant's prior registration because "[r]egistration of a mark on the principal register ... shall be constructive notice of the registrant's claim of ownership thereof." 15 U.S.C. § 1072.

²⁴ In the circumstance where an applicant obtained a prior registration and, later, the owner of the cited registration obtained several registrations of close variants of the cited registration, from several different examining attorneys, none of whom issued a refusal based

With that background laid out, we next will examine the particulars of the registrations at issue here. Applicant points to two of its prior registrations: a 2002 registration that pre-dates the 2016 cited registration by over a decade and co-existed with it for the next (almost) seven years, and a 2019 registration that it obtained three years after the cited registration issued which has now co-existed with the cited registration for over five years.

1. *Strategic Partners* and Applicant's 2002 Registration

In 2002, Applicant received Registration No. 2611134 for the mark



for goods identified as “Plant Seeds, agricultural seeds, and flower seeds” (Applicant’s ’134 Registration). The Examining Attorney leads off arguing that Applicant is automatically disqualified from pursuing a *Strategic Partners*/thirteenth factor argument because the ’134 Registration expired in 2023. According to the Examining Attorney, once a registration expires, the statutory presumption of validity of the registered mark disappears, making the registration of “no probative value.”²⁵ But a *Strategic Partners*-type thirteenth factor argument does not depend

on the applicant’s prior registration, a somewhat different consideration arises. In that situation, the fact that several different examining attorneys all independently concluded that confusion was unlikely suggests that the mark in the application at issue also is unlikely to cause confusion. *See In re Allegiance Staffing*, No. 85663950, 2015 WL 4658961, at *3 (TTAB 2015). We hasten to point out that even an *Allegiance Staffing*-type situation, however, does not create a form of agency estoppel. *See id.* (“we do not hold that this Board is bound by the decisions of the examining attorneys that there was no likelihood of confusion between the cited ALLEGIS marks and Applicant’s prior ALLEGIANCE STAFFING mark”). In any event, we are not here faced with an *Allegiance Staffing*-type case.

²⁵ *See* 8 TTABVUE 5.

on the current validity or status of the applicant's prior-registered mark. Rather, it looks to see if we can infer something from the fact that, while the applicant's prior registration was in existence, the owner of the cited registration did nothing to contest it. We therefore disagree with the notion that the expiration or cancellation of an earlier registration automatically precludes a *Strategic Partners* argument.²⁶

But, where an applicant's prior registration has expired, how long ago it expired is a relevant consideration as to the force of any inference we might make. It is well settled that registrability is determined as of the time we're considering the application. *See, e.g., Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, No. 91064943, 1985 WL 72022, at *6 (TTAB 1985) ("The likelihood of confusion must be decided on the basis of facts as they exist at the time when the issue is under consideration.") (citing *R. J. Reynolds Tobacco Co. v. Am. Brands, Inc.*, 493 F.2d 1235, 1238 (CCPA 1974)); *accord In re Air Filters, Inc.*, No. 72397658, 1974 WL 20048, at *1 (TTAB 1974). The further in the past the period of co-existence, the less confident we can be that it bears on likelihood of confusion at the current time. *Cf. Converse, Inc. v. ITC*,

²⁶ The Examining Attorney cites *In re Sunrise Apparel Group, LLC*, No. 88571635, 2022 WL 634432 (TTAB 2022) (nonprecedential), in support of this categorical disqualification argument. Nonprecedential decisions do not bind later Board panels, though we permit them to be cited "for whatever persuasive value [they] may have." *See* TBMP § 801.03. In *Sunrise Apparel*, the applicant framed the 13th factor argument in terms of the Office having an obligation to be "consistent" in examination. But, as we explained earlier, arguments for alleged "consistency" must yield if the evidence and the governing statutes show that a mark is not registrable. *See, e.g., Cordua Rests.*, 823 F.3d at 600; *Shinnecock Smoke Shop*, 571 F.3d at 1174. If, as it appears from the opinion, agency "consistency" based on registering the earlier mark was the sole basis of the applicant's thirteenth-factor argument, then the panel there had no occasion to delve further into the impact of the period of pre-cancellation co-existence on the issue of likelihood of confusion. We therefore are not persuaded that *Sunrise Apparel* bears on the specific argument the Examining Attorney raises here.

909 F.3d 1110, 1121 (Fed. Cir. 2018) (in acquired distinctiveness context, evidence bearing on the marketplace within the past five years is relevant to current conditions, but evidence older than five years “should only be considered relevant if there is evidence that such uses were likely to have impacted consumers’ perceptions of the mark as of the relevant date”).


Here, Applicant’s ’134 Registration expired a little less than two years ago, after co-existing on the Register with the cited registration (which issued in 2016) for over six years. Two years isn’t that long ago, so we still have confidence, absent evidence to the contrary, that the co-existence period is relevant to registrability now.

With this threshold argument resolved, we turn to the particulars of the ’134 Registration to determine if it is close enough to the cited registration and current application for the period of co-existence (which began when the cited registration issued in 2016 and ended with the 2023 expiration of the ’134 Registration) to shed light on the current likelihood of confusion. First, we point out that this is a situation where the focus is primarily on inferences to be drawn from the owner of the cited registration’s action in applying to register its mark despite the presence on the register of Applicant’s ’134 Registration.

As of the time of its renewal in 2012, Applicant’s ’134 Registration identified “Plant Seeds, agricultural seeds, and flower seeds.”²⁷ In 2016, the cited registration

²⁷ See June 20, 2022, Response to Nonfinal Office Action, at TSDR 8-9.



issued for the mark . The registration identifies goods that include “Unprocessed edible seeds not containing alfalfa; Unprocessed fruits; Unprocessed grain not containing alfalfa.”²⁸ The goods overlap at least in part because “Unprocessed edible seeds” necessarily include seeds from plants and flowers. For nearly seven more years, until Applicant’s 2002 registration expired in 2023, these registrations co-existed.

Because the owner of the cited registration applied to register its mark despite the presence on the register of Applicant’s ’134 Registration, we now look to the particulars of the marks to determine if we can make a *Strategic Partners*-type inference as to the likelihood of confusion in the case before us. One key factor is, how different the mark in Applicant’s current application is from the mark in its expired ’134 Registration? Plainly, the term FITÓ in the ’134 Registration is in the same

²⁸ See Dec. 17, 2021, Nonfinal Office Action, at TSDR 13-14. The Examining Attorney suspended examination of Applicant’s application for a time as the cited registration was approaching the deadline for renewal. See July 7, 2022, Suspension Letter. But after the cited registration was, in fact, renewed, the Examining Attorney issued the final refusal. See Oct. 12, 2023, Final Office Action. When the owner of the cited registration renewed the registration, it deleted the following goods from the registration: “Agricultural grains for planting not containing alfalfa; Agricultural seeds not containing alfalfa; Bulbs for horticultural purposes; Flower seeds; Fresh fruit; Fresh vegetables; Malt for brewing and distilling not containing alfalfa; Natural plants and flowers not containing alfalfa; Raw fruits; Seeds for horticultural purposes not containing alfalfa.” See, e.g., *In re Audemars Piguet Holding SA*, No. 90045780, 2025 WL 21318, at *21 n.103 (TTAB 2025) (Board confirmed recent renewals of registrations in the record); *In re Wilson*, No. 75285881, 2001 WL 58395, at *6 n.15 (TTAB 2001) (Board checked to determine if Office records reflected a second renewal of a registration in the record).

typeface as it appears in the current application. And like the current application, color is not claimed. All that's missing is the smaller-sized, less-stylized term "SEMILLAS" contained within the long upper tail of the "F." The '134 Registration disclaims the exclusive right to use the term "SEMILLAS" apart from the mark as a whole and contains the translation statement: "The English translation of the word 'SEMILLAS' is 'SEEDS'."²⁹ Since seeds are identified as a type of goods covered by the registration, "SEMILLAS" is a generic term and therefore does not play much, if any, role in source identification. *See, e.g., Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 1119 (Fed. Cir. 2024). Thus, we find the mark in Applicant's '134 Registration highly similar to the mark in its current registration.

Turning to the goods, we look to see if Applicant, in its current application, moved appreciably closer to the goods in the cited registration. Both Applicant's '134 Registration and the current application list seeds, so that remains the same. But in the current application, Applicant adds "fresh fruits" and "fresh vegetables," which, at first blush, seems to incrementally encroach on the "unprocessed fruits" in the cited registration. But since there already had been overlap as to seeds, the encroachment does not strike us as that significant. And, as we noted earlier, when renewing its registration in 2022, the owner of the cited registration deleted "fresh fruit" and "fresh vegetables" from its registration, a circumstance that suggests that the owner does not view "unprocessed fruits" as including "fresh fruit." In other words, we strain to see how the goods in the current application differ in any respect material to our

²⁹ *See* June 20, 2022, Nonfinal Office Action, at TSDR 10.

Strategic Partners thirteenth factor analysis. Thus, we find that the fact that the owner of the cited registration applied to register its mark notwithstanding the existence on the Register of Applicant's '134 Registration to be a circumstance that weighs somewhat against a finding that confusion is likely as between the mark in the cited registration and the mark in the current application.

2. Assessing the interplay of the cited 2016 Registration and Applicant's 2019 Registration

In 2019, Applicant received a registration for the word + design mark



.³⁰ The Examining Attorney suggests that, because that registration is less than five-years old, it does not qualify under *Strategic Partners* to tilt the thirteenth factor against a likelihood of confusion, because *Strategic Partners* concerned a prior registration that the applicant had obtained more than five-years earlier.³¹ Technically, at the time the Examining Attorney filed his brief in September 2024, Applicant's '285 Registration was, in fact, two months shy of its fifth birthday. But as of the time we are making our determination of registrability (i.e., the date of this opinion), the '285 Registration has passed that milestone. As mentioned, registrability is determined as of the time we decide the case, so the Examining Attorney's argument appears to have gone passed its "sell by" date.

³⁰ Reg. No. 5914285 (Applicant's '285 Registration) covers goods identified as "Natural seeds for agricultural and horticultural purposes; Agricultural and aquacultural crops, horticulture and forestry products, namely, seeds for horticultural purposes, crop seeds, agricultural seeds, plant seeds, fruit seeds, except for foodstuffs for animals."

³¹ See 8 TTABVUE 5-6.

Even if the '285 Registration hadn't reached the five-year mark, however, we think the rule for which the Examining Attorney advocates is too categorical. We see no requirement that, for this type of *Strategic Partners* thirteenth factor to apply at all, the case has to be just like *Strategic Partners*. No two trademark cases are the same, and each is decided on its own unique facts and evidence. *See, e.g., Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc.*, 530 F.2d 1396, 1399 (CCPA 1976) ("Each case must be decided on its own facts and the differences are often subtle ones.") (citation omitted).


Like many other factors, a *Strategic Partners*-type thirteenth factor can vary from zero (i.e., neutral) to dispositive. The shorter the co-existence period, the weaker any inference that confusion is unlikely. The longer the coexistence period, the more it tends to indicate that confusion is unlikely. It's not a binary thing. We do agree, however, that the five-year birthday of the applicant's registration is significant, but not because it is an absolute requirement. Rather, because five years marks the end of the period within which the prior registrant may petition for cancellation based on likelihood of confusion, we can be more confident after five years in inferring that the owner of the cited registration believes that the applicant's registration does not create a likelihood of confusion.

We turn now to the particulars of Applicant's '285 Registration to determine if it is close enough to the current application and cited registration for its period of co-existence (which began when the cited registration issued in 2016 and continues to the present) to shed light on the current likelihood of confusion. Applicant's '285



Registration is for the mark  and identifies goods including plant



seeds.³² The cited 2016 registration is for the mark , identifying goods that are currently include “Unprocessed edible seeds.”³³ The goods overlap at least in part because “Unprocessed edible seeds” necessarily include plant seeds.

The mark in Applicant’s ’285 Registration is arguably closer than its ’134 Registration to the cited registration in that it drops the term SEMILLAS from the mark. The word “FITO” is also depicted in the color green, several hues of which are used in the cited registration. The owner of the cited registration, however, neither opposed the application that matured into the ’285 Registration, nor did it petition to cancel the registration for creating a likelihood of confusion during the five-year statutory period when such a petition was permitted.³⁴ We add that, even if the ’285 Registration was a few months shy of its five-year anniversary, we would consider such a period of co-existence significant.

³² See June 20, 2022, Response to Nonfinal Office Action, at TSDR 8.

³³ See Dec. 17, 2021, Nonfinal Office Action, at TSDR 13-14.

³⁴ Although the prosecution record closed prior to the five-year anniversary of the issuance of the ’285 Registration, we note that the file for Applicant’s ’285 Registration contains no indication that the owner of the cited registration ever petitioned to cancel the ’285 Registration. See, e.g., *Audemars Piguet*, 2025 WL 21318, at *21 n.103; *Wilson*, 2001 WL 58395, at *6 n.15.

3. Overall finding on the *Strategic Partners*/thirteenth factor

In this case we have two significant periods of co-existence between Applicant's very similar prior registrations and the cited registration: a several-year period while the '134 Registration existed through and beyond the date when the owner of the cited registration applied for registration; and a several-year period after Applicant obtained its '285 Registration. Either period separately would tilt the *Strategic Partners* thirteenth factor against a determination that confusion is likely as between the cited registration and the application at issue. Together, they amplify each other.

In sum, we find that the thirteenth likelihood-of-confusion factor weighs against a finding that confusion is likely.

E. Weighing the findings on the relevant factors together

Having made findings on all the relevant likelihood-of-confusion factors, our final step is to assess these findings together to determine if, on balance, confusion is likely. *See, e.g., Charger Ventures*, 64 F.4th at 1384.

Here, we have found that the goods are identical in part. The overlap in the channels of trade and classes of customers generally add weight to the "confusion is likely" side of the scale.

Weighing against a conclusion that confusion is likely is that we find the mark in the cited registration to be significantly dissimilar in several key respects to Applicant's mark despite the fact that the cited mark contains the term FITO. And sometimes, the dissimilarities in the marks can by themselves warrant a conclusion that confusion is unlikely notwithstanding that other factors may point to a different

conclusion. *See, e.g., Kellogg Co. v. Pack'Em Enters. Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) (“The only remaining question is whether the Board correctly held that here a single *duPont* factor—the dissimilarity of the marks—was dispositive of the likelihood of confusion issue. The Board correctly so ruled. We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”), *aff'g* 1990 WL 354499, at *5 (TTAB 1990) (FROOTEE ICE and FROOT LOOPS are so different that, even were the goods, channels of trade, and customer classes the same, confusion would still be unlikely).

But the dissimilarity of the marks in this case is not the only factor weighing in favor of a conclusion that confusion is unlikely. As we explained in detail above, the thirteenth likelihood-of-confusion factor also tilts in that direction. Together, in the unique circumstances presented in this case, we think those two factors outweigh the other three factors. *See, e.g., Citigroup Inc.*, 637 F.3d at 1356 (“mechanically tallying the *DuPont* factors addressed is improper, as the factors have differing weights”). We therefore conclude that, on balance, confusion is unlikely.

Decision: The refusal to register Applicant’s mark is reversed.