

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 10, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Legion of Good Will aka LGW*

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Serial No. 87164803

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Phillip Thomas Horton of the Law Office of Philip Thomas Horton  
for Legion of Good Will aka LGW.

Jonathon Schlegelmilch, Trademark Examining Attorney, Law Office 108,  
Steven R. Berk, Managing Attorney.<sup>1</sup>

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Before Cataldo, Wolfson and Hightower,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Legion of Good Will aka LGW, seeks registration on the Principal Register of the mark LEGION OF GOOD WILL, in standard characters, identifying the following services:

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<sup>1</sup> This application was previously assigned to Trademark Examining Attorney Natalie Polzer during examination and was reassigned to Jonathon Schlegelmilch for preparation of the brief on appeal.

Charitable services, namely, organizing and developing projects that aim to improve the lives of underprivileged and impoverished people, in International Class 35; and

Education services in the nature of early childhood instruction, in International Class 41.<sup>2</sup>

The Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with eight registered marks issued to Goodwill Industries International Inc. on the Principal Register for various formatives of GOODWILL, alone and with other wording and designs, identifying a variety of goods and services, notably, Registration No. 5010715 for the mark GOODWILL (in standard characters) identifying numerous goods and services including the following:

Charitable services, namely, accepting charitable donations of a wide variety of goods for resale to the public, for purposes of providing education, training, career, and other personal opportunities and services to benefit people with disabilities and disadvantaging conditions;

Charitable services, namely, organizing and conducting volunteer programs, in International Class 35; and

Child and adult day care services, in International Class 43.<sup>3</sup>

The Examining Attorney further refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. § 1051 and § 1127 on the ground that Applicant failed

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<sup>2</sup> Application Serial No. 87164803 was filed September 8, 2016, alleging January 20, 2009 and October 30, 1986 as dates of first use of the mark in commerce in connection with the services identified in International Classes 35 and 41, respectively, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

<sup>3</sup> Registration No. 5010715 issued August 2, 2016. The registration also recites goods in International Class 9, additional services in International Classes 35, 36, 41, 42, 43, 44 and 45, and collective membership services in International Class 200.

to submit a verified substitute specimen of use in connection with its recited services in both classes.

After the final Office Action, Applicant appealed. Applicant and the Examining Attorney filed briefs.<sup>4</sup> We affirm the refusals to register for the reasons set out below.

### I. Evidentiary Objections

In its brief on appeal, Applicant appended dictionary definitions of the terms comprising its mark,<sup>5</sup> and printouts from its internet webpage.<sup>6</sup> Applicant further made reference in its brief to a third-party registration, assertedly for a mark similar to the mark in the cited registration.<sup>7</sup> Applicant did not introduce into the record during prosecution of its involved application a copy of the asserted third-party registration. In his brief, the Examining Attorney objects to these materials and references as constituting “new evidence” on the basis that none of them were properly introduced into the record.<sup>8</sup>

It is well-settled that the Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *In re CyberFinancial.Net Inc.*, 65

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<sup>4</sup> Applicant did not submit a reply brief.

<sup>5</sup> 4 TTABVUE 15-16.

Page references herein to the application record refer to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board’s TTABVUE docket system.

<sup>6</sup> *Id.* at 17-21.

<sup>7</sup> *Id.* at 9.

<sup>8</sup> 6 TTABVUE 5.

USPQ2d 1789, 1791 n.3 (TTAB 2002); *see also Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In accordance with this established practice, we hereby exercise our discretion to take judicial notice of the definitions appended to Applicant's brief, and the Examining Attorney's objection thereto is overruled.

However, the Board does not take judicial notice of applications or registrations; they must be proved by competent evidence. *See, e.g., In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011) (stating that "the Board's well-established practice is not to take judicial notice of registrations that reside in the USPTO"); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) ("[W]e do not take judicial notice of application and registration files that reside in the Patent and Trademark Office on the basis of their mere identification in briefs, pleadings and evidentiary submissions."). As a result, the referenced third-party registration is not evidence in this appeal, and it will not be given any consideration. The Examining Attorney's objection thereto is sustained.

With regard to the printouts from Applicant's website, it further is well-settled that the evidentiary record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); Trademark Board Manual of Procedure (TBMP) §§ 1203.02(e), 1207.01 (June 2017<sup>9</sup>); Trademark Manual of Examining Procedure (TMEP) § 710.01(c) (Oct. 2017). The proper procedure for an

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<sup>9</sup> The June 2018 edition of the TBMP issued after this case was submitted to the Board for decision.

applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TBMP § 1207.02 and authorities cited therein. We see no reason why Applicant could not have availed itself of the well-established procedure for introducing evidence after commencement of its appeal. As a result, the Examining Attorney's evidentiary objection is sustained, and the website printouts Applicant submitted for the first time with its appeal brief are untimely and will not be considered. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP § 1203.02(e) and § 1207.01 and authorities cited therein.

We turn now to the merits of this appeal.

## II. Likelihood of Confusion

The determination under Section 2(d) involves 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, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods [and services] and differences in the marks.”). We have considered each relevant *du Pont* factor for which there is evidence or argument, and have treated any other factors as neutral. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (factors “may play more or less weighty roles in any particular determination”).

A. Focus on Cited Registration No. 5010715

We determine this appeal based on Applicant’s involved mark and identified services and the GOODWILL mark that is the subject of cited Registration No. 5010715, identifying, *inter alia*, the services listed above. If likelihood of confusion is found as to the mark and services in this registration, it is unnecessary to consider the other cited registrations. See *Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

B. Strength of the Cited Mark

We begin by evaluating the strength of the cited mark and the scope of protection to which it is entitled. The fifth *du Pont* factor is the “fame” or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for

similar goods or services. *du Pont*, 177 USPQ at 567. In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

As noted above, we have taken judicial notice of the definitions of the terms comprising the marks at issue. “Goodwill” or “good will” is defined as “benevolence; kindness.”<sup>10</sup> “Legion” is defined as “any great number of persons or things; multitude.”<sup>11</sup> Applicant argues

In the instant case, the trademarks at issue share the same, weak, overlapping term(s), namely GOODWILL. In both marks, the word “goodwill” retains its defined meaning. However, in Applicant’s mark, the defined meaning is modified, unlike the [registered] Goodwill Marks. Therefore, as the case law sets forth above, if the primary similarity as between the Applicant’s Trademark and that of the registrant are descriptive in nature, this consideration must also lend to a conclusion of an absence of a likelihood of confusion under *du Pont*.<sup>12</sup>

There is no additional evidence in the record regarding the significance of the term “goodwill” in relation to the various goods and services identified in the cited registration. Based upon this evidence, we find that regarding conceptual strength, the GOODWILL mark is at worst suggestive of the benevolent nature of the services at issue.

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<sup>10</sup> 4 TTABVUE 16. Definition from [dictionary.com/browse/legion?s=t](http://dictionary.com/browse/legion?s=t)

<sup>11</sup> *Id.* at 15. Definition from [dictionary.com/browse/goodwill?s=t](http://dictionary.com/browse/goodwill?s=t)

<sup>12</sup> *Id.* at 13.

We further note that cited Registration No. 5010715 issued on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Registration under Section 2(f) of the Trademark Act is a concession that the mark was merely descriptive of the identified services, at least at the time of registration. 15 U.S.C. § 1052(f); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Similarly, registration on the Supplemental Register is a concession that the mark was merely descriptive of the identified services. *Quaker State Oil Ref. Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984). However, such is not the case with the cited GOODWILL registration.

In addition, Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. Absent the filing of a cancellation petition against a cited registration, during *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., the mere descriptiveness or lack of distinctiveness of the mark). *In re Dixie Restaurants*, 41 USPQ2d at 1534; *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). We thus reject Applicant's contention that the GOODWILL mark is merely descriptive.

As for marketplace strength, there is no evidence regarding the GOODWILL mark's commercial strength, as is typical with *ex parte* appeals in which the owner

of the cited registration is not a party. Also, Applicant submitted no evidence that third parties are using similar GOODWILL or GOOD WILL-formative marks in connection with the services at issue. Further, there is no evidence of any third-party registration for a similar mark in connection with the services recited in the registration. *Cf. Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015).

Considering the record as a whole, we find that the registered mark is by its nature suggestive and there is no evidence of third-party use or registration of confusingly similar marks for similar or related goods. We therefore find that the registered mark is not weak and entitled only to a narrow scope of protection, but rather we accord the GOODWILL mark the normal scope of protection to which suggestive marks are entitled. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

### C. Similarity of the Marks

We next address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Applicant’s mark LEGION OF GOOD WILL in standard characters consists of the entirety of the registered mark and merely adds the wording “LEGION OF” to modify “GOOD WILL” therein. While there is no rule that likelihood of confusion automatically applies where one mark encompasses another, in this case, as in many others, the fact that the entire cited mark is incorporated in Applicant’s mark increases the similarity between the two. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (finding applicant’s CAREER IMAGE marks similar to registered mark CREST CAREER IMAGES). The presence or absence of a space between virtually the same words, GOODWILL and GOOD WILL does not distinguish the marks. *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties

[STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical . . . .”). Thus, the marks are similar in appearance and sound to the extent that Applicant’s LEGION OF GOOD WILL mark fully encompasses the registered GOODWILL mark.

In addition, there is no evidence to suggest that the term GOODWILL or GOOD WILL has a different meaning or connotation as applied to the respective services at issue. The registered mark connotes kindness and benevolence and the applied-for mark very similarly connotes a great number or multitude of persons engaged in kindness and benevolence. As a result, LEGION OF GOOD WILL and GOODWILL are far more similar than dissimilar in connotation or meaning. Consumers also are often known to use shortened forms of names, and it is possible that Applicant and its services are referred to as “Good Will.” *Cf. In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: “the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words”). Finally, it is not necessary for Registrant’s mark to include the term “legion” or legion imagery to support a finding that the marks are similar. *See Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721.

We acknowledge that the presence of “LEGION OF” as the leading term in Applicant’s mark distinguishes it somewhat visually and aurally from the registered mark. This point of distinction, however, does not significantly diminish the strong

similarities in connotation and overall commercial impression engendered by these two marks. We find that the first *DuPont* factor weighs in favor of a finding that confusion is likely.

D. Similarity of the Services, Channels of Trade and Classes of Consumers

With regard to the services, channels of trade and classes of consumers, we must make our determinations based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A proper comparison of the services considers whether “the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.” *Hewlett Packard*, 62 USPQ2d at 1004. Therefore, to support a finding of likelihood of confusion, it is not necessary that the services be identical or even competitive. It is sufficient that the services are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the services. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

Applicant's Class 35 services are "Charitable services, namely, organizing and developing projects that aim to improve the lives of underprivileged and impoverished people." These services are broadly-worded inasmuch as the projects Applicant organizes and develops to aid the underprivileged and impoverished may include the more narrowly identified services in the cited registration, such as charitable services in the nature of accepting donations of goods for resale for the purposes of education, training, and providing services to people with disabilities and disadvantaging conditions. Accepting donations of goods for resale to benefit the disabled and disadvantaged, or educational training programs are types of projects that Applicant may organize and develop. In other words, Registrant's charitable activities are encompassed by Applicant's projects intended to benefit the underprivileged and impoverished. Similarly, the cited registration recites charitable services in the nature of organizing and conducting volunteer programs. Volunteer programs also are a type of project that may improve the lives of the underprivileged and impoverished. As a result, Applicant's Class 35 services, as identified, appear to encompass some of the Class 35 services identified in the cited registration and thus are legally identical thereto in part.

Applicant's Class 41 services are "Education services in the nature of early childhood instruction." In support of the refusal of registration, the Examining Attorney introduced with her June 16, 2017 Final Office Action<sup>13</sup> printouts from the following third-party internet websites offering, under the same mark, early

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<sup>13</sup> At .pdf 8-56.

childhood education services identified in the subject application and child care services of a type identified in the cited registration.

Kinder Care Learning Center offers early childhood education provided as part of a childcare program (at [www.kindercare.com](http://www.kindercare.com));

Family Wise offers childcare for infants, toddlers, and preschoolers in a learning environment, advertising superior quality education and child care (at <http://familywiseservices.org>);

Learning Experience offers innovative childcare and early education programs throughout the country (at <https://thelearningexperience.com>);

Bright Horizons Family Solutions offers early education programs as part of their child care programs (at [www.brighthouse.com](http://www.brighthouse.com));

People Serving People offers a child care program that focuses on preparing children to enter kindergarten (at [www.peopleservingpeople.org](http://www.peopleservingpeople.org));

Catholic Charities USA offers education, training and care for vulnerable populations of all ages, including children (at <https://catholiccharitiesusa.org>); and

The Salvation Army offers youth camps and after school programs including various educational programs for children (at [www.salvationarmyusa.org](http://www.salvationarmyusa.org)).

This evidence demonstrates that at least seven third parties offer services of a type identified in the involved application and cited registration under the same mark.

The Examining Attorney also introduced into the record with her December 20, 2016 First Office Action<sup>14</sup> copies of ten use-based, third-party registrations for marks identifying, *inter alia*, services identified in the involved application and cited registration. The following examples are illustrative:

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<sup>14</sup> At .pdf 36-64.

Registration No. 4341055 for the mark BRIGHTSIDE ACADEMY EARLY EDUCATION AND CHILD CARE (in standard characters, “ACADEMY EARLY EDUCATION AND CHILD CARE” disclaimed) identifying “education services in the nature of early childhood instruction,” and “child care services;”

Registration No. 5086490 for the mark ENCOURAGING THE WHY? IN CHILDREN (in standard characters) identifying “education services in the nature of early childhood instruction,” and “preschooler and infant care at daycare centers;”

Registration No. 4856578 for the mark INNOVATORS IN EDUCATIONAL CHILD CARE (in standard characters, “EDUCATIONAL CHILD CARE” disclaimed), identifying “educational services in the nature of early childhood instruction,” and “child care centers.”

As a general proposition, although use-based, third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have some probative value to the extent they may serve to suggest that the services are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *Mucky Duck Mustard Co.*, 6 USPQ2d at 1470 n.6. In this case, the totality of the website and third-party registration evidence demonstrates that consumers would readily expect that these services likely emanate from the same sources.

With regard to trade channels, inasmuch as there are no restrictions recited in the Class 35 services identified in either the involved application or cited registration, the in-part legally identical services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *see also, e.g., Sw.*

*Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

Evidence of record discussed above demonstrates that both Applicant's Class 41 services and Registrant's Class 43 services may be encountered in at least one common trade channel, i.e., the websites of charitable organizations that offer both child care services and early childhood education under the same marks, by the same classes of consumers. This evidence supports a finding that these goods are offered in the same channels of trade. In addition, the identification of services in the cited registration and involved application do not recite any limitations as to the channels of trade in which the services are offered. In the absence of trade channel limitations on the services under the registered and applied-for mark, we must presume that these services are offered in all customary trade channels. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

We find that the *du Pont* factors of the relatedness of the services, channels of trade and consumers weigh in favor of likelihood of confusion.

#### E. Actual Confusion

The final *du Pont* factor discussed by Applicant and the Examining Attorney is that of the lack of instances of actual confusion. Applicant asserts that the absence of actual confusion despite concurrent use of the marks since 1985 suggests no likelihood of confusion. However, it is not necessary to show actual confusion in order

to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an ex parte proceeding, Applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817-1818 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 337 (TTAB 1984). In those situations where the Board has recognized the absence of actual confusion as probative in an ex parte setting, there existed a "confluence of facts" which together strongly suggested that the absence of confusion was meaningful and should be given probative weight. *See In re Opus One Inc.*, 60 USPQ2d at 1817; *In re Jeep Corp.*, 222 USPQ at 337. Such a "confluence of facts" is not present in this record.

Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"); *see also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

This *du Pont* factor is neutral.

#### F. Summary on Likelihood of Confusion

We have carefully considered all of the evidence of record, including any evidence not specifically discussed herein. The marks are more similar than dissimilar, particularly with regard to meaning or connotation. Applicant's Class 35 services are legally identical in part to certain of the Class 35 services recited in the cited registration, and are presumed to be offered in the same channels of trade to the same classes of consumers. Evidence of record establishes that Applicant's Class 41 services are related to the Class 43 services in the cited registration, and may be marketed and sold by third parties under the same marks in at least one common channel of trade. Applicant's arguments regarding the asserted weakness of the mark in the cited registration and distinctions between the marks are insufficient to overcome these similarities.

### III. Substitute Specimen and Verification

In her December 20, 2016 First Office Action, the Examining Attorney rejected Applicant's specimen of use as to both classes of services and required Applicant to either: (1) file a substitute specimen verified by a supporting affidavit or declaration pursuant to Trademark Rule 2.20, 37 C.F.R. § 2.20; or (2) amend the filing basis of the involved application to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).<sup>15</sup> Applicant submitted a substitute specimen with its June 13, 2017 response to the first Office Action.<sup>16</sup> In her June 16, 2017 Final Office Action, the Examining Attorney

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<sup>15</sup> At .pdf 5. The original specimen was a photocopy of the drawing of the mark. The substitute specimen consists of photographs of, *inter alia*, brochures displaying the applied-for mark and discussing Applicant's activities that include the recited services in both classes.

<sup>16</sup> At .pdf 6-28.

noted that Applicant “provided substitute specimens that appear to show use of the applied-for mark in commerce but is not verified.”<sup>17</sup> The Examining Attorney repeated and made final the requirement for verification of Applicant’s substitute specimen and explained several alternative methods of satisfying it.<sup>18</sup> Applicant did not request reconsideration of either of the final refusals of registration or otherwise submit the required verification, and did not address the verification requirement in its brief on appeal.

We agree with the Examining Attorney that the substitute specimen submitted by Applicant with its June 13, 2017 communication appears to be acceptable inasmuch as it displays the applied-for mark in commerce in connection with both classes of recited services. However, we also agree with the Examining Attorney that Applicant failed to submit the required verification in support of its substitute specimen as required by Trademark Rule 2.20, 37 C.F.R. § 2.20.

Substitute specimens must be properly verified, and because “applicant never submitted the required verification...none of the additional materials which applicant submitted [with its June 13, 2017 communication] may be considered as substitute specimens.” *In re Adair*, 45 USPQ2d 1211, 1212 n.2 (TTAB 1997); *see also* Trademark Rule 2.59(a); 37 C.F.R. § 2.59(a). In consequence thereof, Applicant has failed to submit sufficient evidence of actual use of the applied-for mark in commerce as required under Sections 1 and 45 of the Trademark. 15 U.S.C. §§ 1051, 1127;

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<sup>17</sup> At .pdf 6.

<sup>18</sup> *Id.*

Trademark Rules 2.34(a)(1)(iv), 2.56(a); 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); *see also*, *e.g.*, *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017).

#### IV. Conclusion

**Decision:** The refusal to register Applicant's mark under Trademark Act Section 2(d) is affirmed.

The refusal to register Applicant's mark under Trademark Act Sections 1 and 45 is affirmed.