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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Unclesign Co., Ltd.

Serial No. 88123168


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Rosenberg, Klein & Lee, for UnclesignCo., Ltd

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Before Taylor, Shaw, and Heasley
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant, Unclesign Co., Ltd., seeks registration on the Principal Register of the

stylized mark  for “identity plates, not of metal; pillows; head supporting pillows; inflatable pillows; latex pillows; neck pillows; neck-supporting pillows; u-shaped pillows; bean bag pillows; travel pillows” in International Class 20.¹

¹ Application Serial No. 88123168 was filed on September 19, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere as of September 22, 2016, and use in commerce since at least as early as September 28, 2016. The description of the mark reads “[t]he mark consists of the word ‘UNO’ in stylized font.”

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark UNO (in standard characters) for "office furniture, namely, seating" in International Class 20.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) ("Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.")).

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

² Registration No. 4107248, issued on the Principal Register on March 6, 2012; Section 8 and 15 declarations accepted and acknowledged.

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. 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) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods. See *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)); *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 differences in the marks.”).


A. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *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, 1692 (Fed. Cir.

2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

Applicant describes its mark as follows: “The mark consists of the word ‘UNO’ in stylized font.” Both the Application and the cited Registration contain the following translation statement: “The English translation of ... ‘UNO’ in the mark is ‘ONE.’”³ So the Application and Registration consist of the same word, with the same sound and the same connotation. *See In re i.am.symbolic*, 123 USPQ2d at 1748 (“Symbolic does not, and cannot, dispute that the mark, I AM in standard character form, and the registrants’ marks, I AM in standard character, typed, or stylized form, are pronounced the same way and, at a minimum, legally identical.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (To the extent LAROQUE has a meaning in connection with wine, it would have the same connotation in Applicant’s mark as in Registrant’s mark.).



Applicant argues, however, that its  mark is so stylized that the respective marks have a different appearance and commercial impression. “[A]dvertisements for goods associated with the [registered] mark present ‘UNO’ in a very basic font and without any stylization at all” it argues, whereas “Applicant’s Mark is imprinted clearly on the goods themselves....”⁴

³ *See also* the Spanish dictionary definition: “uno” means “one.” SpanishDict.com, Jan. 4, 2019 Office Action at TSDR 47.

⁴ Applicant’s brief, 4 TTABVUE 7-8.

But as the Examining Attorney correctly notes,⁵ “we do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application.” *In re Aquitaine Wine*, 126 USPQ2d at 1186, *quoted in In re Medline Indus., Inc.*, 2020 USPQ2d 10237, *13 (TTAB 2020). “[T]he registrant is entitled to depictions of the standard character mark regardless of font style, size, or color” *Citigroup v. Capital City Bank Group*, 98 USPQ2d at 1259; *see generally* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); TMEP § 807.03(a).

Applicant counters that the Registered mark’s display is limited to variations in font style, size or color, whereas Applicant’s mark goes beyond that range of variations, and is more like a design:

Applicant’s Mark goes far beyond mere variation of “font style, size, or color” to also include a complex and abstracted interconnectedness that forms a unique design of its own. In particular, it is impossible to use a standard word processor to produce even an approximation of Applicant’s Mark. This places it in contrast with other cases (such as those cited by the Examining Attorney and by TMEP 1207.01(c)(iii)) where one could reproduce the “stylized” mark simply by typing a standard character mark into a word processor and then applying particular font settings; that is, by applying variations of font style, size, and/or color.

The Examining Attorney also cited to *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012). However, the *Viterra* decision explicitly did not address a “background dot design” which immediately surrounded and framed one letter of the mark at issue (*id.* at 1365 n. 4). Such a dot design could not be reproduced by selection of particular font settings. This Board recognized this limit on *Viterra* in *Aquitaine Wine*, and therefore distinguished *Viterra* from cases where more than font style, size, or color was at issue (126 USPQ2d at 1186-1187).⁶


⁵ Examining Attorney’s brief, 6 TTABVUE at 5-6.


⁶ Applicant’s brief, 4 TTABVUE 8-9.


Applicant concludes that “The *Aquitaine Wine* rule therefore applies, and the distinct design of Applicant’s Mark should not be imputed to the standard character mark of the ‘248 Registration.”⁷

We find that the case law is to the contrary. In *Viterra*, the Federal Circuit Court of Appeals agreed that Viterra’s standard character mark XCEED was confusingly



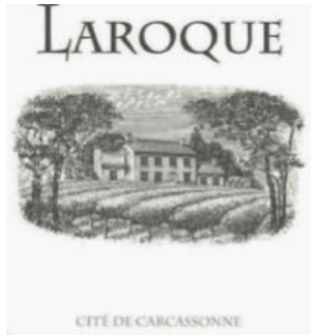
similar to the registered mark , even though the “X” was abstract, overlapping and interconnected with “-SEED.” *In re Viterra*, 101 USPQ2d at 1906, 1909-10 (citing *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983) (rejecting argument that SQUIRT SQUAD in standard letters is distinct from SQUIRT registered in “distinctive lettering on a dark medallion”) and *In re Conti Graphics Corp.*, 52 USPQ2d 1374, 1376 (TTAB 1999) (finding that the standard character mark CONTINENTAL GRAPHICS was similar to the registered mark CONTINENTAL containing a globe design within a large letter “C” at the beginning of the mark)).

Board decisions also find highly stylized marks with interconnected letters similar to standard character marks for the same words. For example:  is similar to LITE, *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988), and

 is similar to ESSENTIALS. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

⁷ *Id.* at 9.

The *Aquitaine* decision on which Applicant relies involved a pictorial design feature,



, which the Board compared with the standard character mark **CHATEAU LAROQUE**. *In re Aquitaine*, 126 USPQ2d 1181 (affirming refusal to register under Section 2(d)).

Unlike *Aquitaine*, Applicant states in its application that its mark simply “consists of the word ‘UNO’ in stylized font.”⁸ As the Examining Attorney notes, the mark is presented with a mark drawing code of “5,” indicating that it is stylized, with no design feature.⁹ See TMEP § 807.18 (“marks comprising stylized letters and/or numerals with no design feature are coded as mark drawing code 5”). As *Viterra* and similar decisions show, a stylization of this sort, even with interconnected letters, does not differentiate the marks.

All of these decisions reflect the fundamental principle that identical words typically dominate differences in style and design between marks. For instance, the

Federal Circuit found  similar to ,

⁸ Applicant’s description of the mark.

⁹ Examining Attorney’s brief, 6 TTABVUE 7.

holding that:

The identity of words, connotation, and commercial impression weighs heavily against the applicant. ... We agree with the Board that the words dominate these marks, and that their differences in script and arrow design do not diminish their substantial identity when viewed as a whole.

In re Shell Oil, 26 USPQ2d at 1688.

So even if, as Applicant argues, its stylization verges on a design, “the verbal portion of a word and design mark likely will be the dominant portion. ... This makes sense given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *In re Viterra*, 101 USPQ2d at 1911.

Given that the respective marks in this case consist of the same word with the same meaning, “a purchaser who sees one mark and later encounters the other is likely to think, if the two marks are applied to the same or related goods and/or services, that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source.” *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Accordingly, we find that the marks are at least virtually identical in appearance, sound, connotation, and commercial impression. The first *DuPont* factor thus weighs heavily in favor of finding a likelihood of confusion.

B. Relatedness of the Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third

DuPont factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161.

The Examining Attorney maintains that the consuming public will perceive the respective goods as related office furnishings and accessories. In support of this position, he introduced evidence from the following third-party webpages that offer both Registrant’s and Applicant’s types of goods:

- Ashley Homestore offers office chairs and home office chairs, as well as throw pillows:



ONLINE ONLY
Morgan Quilted Office Chair



Cross Island Home Office Desk Chair



Townser Home Office Desk Chair
★★★★☆ 3.0 (4)



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- Wayfair offers office chairs, back support pillows, and decorative pillows:

¹⁰ Jan. 4, 2019 Office Action at 8-15.



Banker's Chairs



Office Stools



Office Chair Accessories

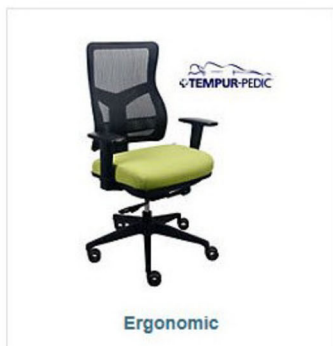


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- OfficeFurniture.com offers “Office Chairs for Your Home or Business” offices and accent pillows for office décor:

Office Chairs for Your Home or Business

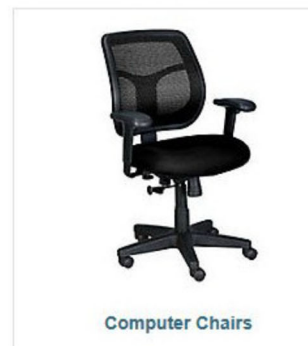
Are you in need of new office chairs for your home office or business office? Our office seating provides the perfect blend of style and support that you need at affordable prices!
[show more](#)



Ergonomic

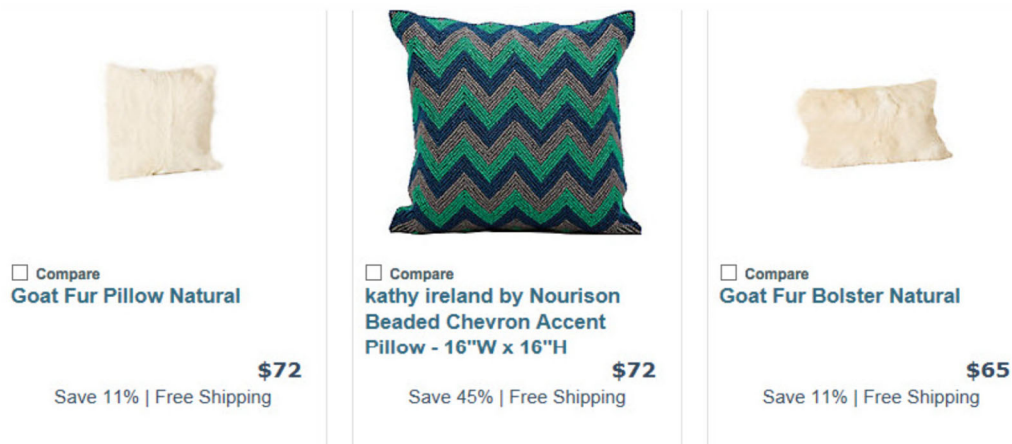


Mesh



Computer Chairs

¹¹ *Id.* at 16-35.



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This marketplace evidence shows goods of the type offered by both Applicant and Registrant offered for sale by a single source. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis...”) *quoted in In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (TTAB 2016).

In addition, the Examining Attorney adduces evidence showing that the respective goods travel through the same channels of trade, with entities such as Pier 1,¹³ CB2,¹⁴ Circle Furniture,¹⁵ ZGallerie,¹⁶ and Crate & Barrel¹⁷ offering office chairs and pillows. This evidence is relevant to show that the respective goods flow through the same normal channels of trade—furniture stores—such that they would be

¹² OfficeFurniture.com/Accept-Pillow-Item/Office'décor-Group, *id.* at 36-42.

¹³ May 34, 2019 Office Action at 7-8.

¹⁴ *Id.* at 15-16.

¹⁵ *Id.* at 17-18.

¹⁶ *Id.* at 19-20.

¹⁷ *Id.* at 21-22.

encountered by the same or overlapping classes of customers, that is, purchasers of office furnishings and accessories. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-73 (TTAB 2009) (website evidence shows same or overlapping channels of trade and classes of customers).

Applicant states that this is “an unacceptably broad argument. It is noted, for example, that of the ten website excerpts submitted as evidence by the Examining Attorney, eight also sell decorative wall art, and five also sell both flatware and candles....”¹⁸ “Using the Examining Attorney’s evidence and logic,” it continues, “the ‘248 Registration could defeat a trademark application for wall art, because both office-style chairs and wall art are sold on the same websites, and the class or ‘people with offices’ purchase both products, one to furnish and the other to decorate.”¹⁹

A proper comparison of the goods “considers whether ‘the consuming public may perceive [the respective goods...] as related enough to cause confusion about the source or origin of the goods....” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004). “[I]t is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.’ *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). Instead, likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances

¹⁸ Applicant’s brief, 4 TTABVUE 11.

¹⁹ *Id.*

surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’ *Id.*” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

Applicant’s goods are not limited to “travel pillows”; they are broadly described as “pillows,” and include all goods of the type identified—be they lumbar support pillows, pillows used as seat cushions, accent pillows or throw pillows. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). If *any* of these goods listed are related to office seating, that will support a finding of likelihood of confusion as to the entire class of goods Applicant has identified. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

In this case, where the respective marks are virtually identical, the degree of similarity between the goods required for confusion to be likely declines. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 5 (TTAB 2019). Because the marks are so similar, consumers could easily infer that office furnishings, such as chairs and pillows, bearing the marks emanate from a single source. “Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985). It is true, as Applicant notes, that the Examining Attorney’s channels-of-trade evidence

encompasses both office and household goods, but as the website evidence indicates, office chairs are appropriate for both home and business offices.²⁰ And we would be blind indeed if we did not note the inexorable movement of late, born of necessity, toward home offices.

The second and third *DuPont* factors thus weigh in favor of a likelihood of confusion.

C. Sophistication and Care

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues that purchasers of office seating are sophisticated consumers who will exercise care in their purchases:

Purchasers of the ‘248 Registrant’s goods are people who are seeking to furnish an office, as the Examining Attorney acknowledges. This office will be central to the continued success of the purchaser’s business. Poor purchasing choices in such circumstances could delay business operation or make a bad impression on clients, and thereby cost far more than the expense of repair or replacement. As such, even more care and sophistication can be expected for such purchases than in [*In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1383 (TTAB 2006) (finding that purchasers of fence rails, even do-it-yourself homeowners, “would exercise a relatively high degree of care in their purchasing decisions”)].²¹

²⁰ OfficeFurniture.com offers “Office Chairs for Your Home or Business” offices and accent pillows for office décor. Office Action OfficeFurniture.com/Accept-Pillow-Item/Office’décor-Group. Jan. 4, 2019 at 36-42.

²¹ Applicant’s brief, 4 TTABVUE 17-18.

In fact, Applicant notes the Registrant has stated that purchasers of its office seating solutions are sophisticated purchasers.²² Applicant thus contends that “consumers of the respective goods would be well-versed in the products they were seeking to purchase and would thus be readily able to differentiate between an office chair and a travel pillow.”²³

However, “the issue is not whether purchasers would confuse the goods, but whether there is a likelihood of confusion as to the source of the goods.” *In re Aquitaine Wine*, 126 USPQ2d at 1188. “[W]ith identical or similar marks used on such goods, even a careful, sophisticated consumer of these goods is likely to believe that the goods emanate from a common source. ... In other words, even careful purchasers who do notice the difference in the marks will not ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1739 (TTAB 2018). For that reason, the sophistication and care of consumers can be outweighed by the similarity of marks for related goods. *See HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff’d*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods.). “[B]eing knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with

²² Registrant’s Response to Office Action for Application Serial No. 78921767, which matured into the cited Registration No. 4107248. *See* Applicant’s May 2, 2019 Response to Office Action at 23, ex. B.

²³ Applicant’s brief, 4 TTABVUE 16.

the use of trademarks.” *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988) (citing *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983)).

In this case, a customer furnishing his or her business or home office may exercise care in choosing seating, then purchase accessories—such as support, seating, or throw pillows—with far less care and sophistication. The standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d at 1163 cited in *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) *aff’d* 778 Fed. Appx. 962 (Fed. Cir. 2019) (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”). And since the subject Application does not restrict the price or quality of Applicant’s pillows, there is no reason to infer that their purchasers will be particularly discriminating or careful. *See Stawski v. Lawson*, 129 USPQ2d 1036, 1054 (TTAB 2018).

In sum, we have no basis to find that ordinary consumers would exercise more than an ordinary degree of care. This factor is neutral.

D. Similar Registered Marks in Use on Similar Goods

Under the sixth *DuPont* factor, we consider “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. This factor concerns the strength of the cited registered mark with respect to both its inherent strength, based on the nature of the word mark itself, and its commercial strength, based on the marketplace recognition value of the mark. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014) (citing *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).”).

We presume the cited registered mark is inherently distinctive—at least suggestive—because it is registered on the Principal Register. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) cited in *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517 (TTAB 2016).

Applicant contends that the word “UNO,” comprising the cited registered mark, is diluted and only entitled to a narrow scope of protection. In support of this contention, Applicant has adduced evidence of five registered marks in International Class 20 that include “UNO.”²⁴ These are depicted in the following table:

Mark	Reg. No.	Pertinent Goods
SERVO-DRIVE UNO	4133805	Furniture fittings.
UNO FORM	4307194	(Cancelled.)
CUROCELL UNO	4374086	Mattresses
UNO SHELF	4813509	Metal shelving
UNO	5570810	Television stands ²⁵

²⁴ Applicant’s brief, 4 TTABVUE 13-14. Applicant also asserts that there are 215 live trademark registrations and applications that include the word “UNO,” 4 TTABVUE 13, but since this assertion is merely attorney argument, unsupported by evidence, we give it no consideration. *See Enzo Biochem Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005).

²⁵ Applicant’s May 2, 2019 Response to Office Action at 34-45.

We find that these registrations do not dilute the strength of Registrant's mark or narrow its scope of protection so much as to permit registration of Applicant's mark. A handful of use-based registrations showing registration of a term is not very availing, especially in the absence of any evidence of the actual use of the registered marks. "We have frequently said that little weight is to be given such [third-party] registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them...." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) quoted in *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) aff'd 777 Fed. Appx. 516 (Fed. Cir. 2019). The cancelled registration "is evidence of nothing but the fact that it once issued," *Anheuser-Busch, LLC v. Innovopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 n.4 (TTAB 2016), and is of "little, if any, probative value." *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1117 (TTAB 2019).

The remaining third-party evidence is a far cry from the large quantum of evidence in *Juice Generation*, where there were at least twenty-six relevant third-party uses or registrations of record, supported by testimony of Juice Generation's founder that a considerable number of third parties used similar marks. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1673 n.1 (Fed. Cir. 2015); *In re Inn at St. John's, LLC*, 126 USPQ2d at 1746. Of the four live third-party registrations in this case, three use additional wording that distinguish them from the cited registered mark. And while the last one, UNO, is identical to the cited

mark, “the existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark.” *Lilly Pulitzer, Inc. v. Lilly Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967).

We add that even if we had found the scope of the cited registered mark to be somewhat narrowed based on Applicant’s evidence, it would not change the result, as even weak marks are entitled to protection against registration of identical or virtually identical marks for related goods. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (CCPA 1974). “Assuming arguendo that the existence of two third-party registrations could demonstrate the weakness of a mark, ‘the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.’” *In re i.am.symbolic*, 123 USPQ2d at 1751-52.

Hence, the sixth *DuPont* factor is neutral.

E. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the subject marks. *DuPont*, 177 USPQ at 567.

Applicant contends:

[T]he mark of the ‘248 Registration has been used in commerce since at least as early as November 1999, and Applicant’s Mark has been used in commerce since at least as early as September 28, 2016. For more than three years, the respective marks have enjoyed concurrent use in commerce and, during that time, Applicant has not become aware of any instances of confusion between the marks. The fact that the marks have been able to peacefully co-exist in the marketplace without confusion suggests that either the goods are not encountered by the same class of

purchasers, or, if they are, that consumers are readily able to differentiate between the respective marks to obtain the desired products. It is believed that such peaceful and non-confusing co-existence will continue notwithstanding the registration of Applicant's Mark.²⁶

We acknowledge Applicant's assertion that there has been no actual confusion between the marks despite their contemporaneous use for several years, but are unable to accord this assertion probative value, for several reasons.

To begin with, Applicant's assertion is uncorroborated.

Generally, in an *ex parte* proceeding a lack of evidence of actual confusion carries little weight, because the cited registrant is not a party to the proceeding and the typical contentions of the applicant's witnesses, to the effect that they are not aware of any instances of actual confusion, tell only one side of the story and are often uncorroborated. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 ("we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value.")

In re FCA, 126 USPQ2d at 1225 *aff'd* 778 Fed. Appx. 962 (Fed. Cir. 2019). We are left, then, with attorney argument, which is no substitute for evidence. *Enzo Biochem v. Gen Probe*, 76 USPQ2d at 1622.

Moreover, the record does not reflect the extent of Applicant's and Registrant's contemporaneous use of their respective marks in the marketplace. The seventh and eighth *DuPont* factors require us to look at actual market conditions. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, * 15 (TTAB 2020). Yet the record does not reveal Applicant's or Registrant's volume of sales. *See Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (absence of actual confusion deemed "of little

²⁶ Applicant's brief, 4 TTABVUE 19.

probative value” because of the absence of a significant opportunity for such confusion to occur, given “the minimal scope of applicant’s actual use of her mark in the marketplace”). Nor does it reveal the extent of overlap in the marketplace; “there is a lack of evidence that in the actual marketplace, the same consumers have been exposed to both marks for the respective” goods. *In re Guild Mortg.*, 2020 USPQ2d 10279, *19. Consequently, we are at a disadvantage to gauge the opportunity for actual confusion to have occurred. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039-40 (TTAB 2016).

Due to this dearth of evidence, Applicant’s and Registrant’s coexistence for several years is of little or no probative value. Much longer periods of coexistence have also been found wanting. *See Barbara’s Bakery v. Landesman*, 82 USPQ2d at 1287 (the respective marks coexisted in the marketplace for at least nine years, yet absence of actual confusion deemed “of little probative value”); *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1383-84 (TTAB 2012) (“Applicant’s assertion, in an ex parte proceeding, of the contemporaneous use of applicant’s and registrant’s marks for a period of over 18 years without actual confusion is entitled to little weight.”).

For these reasons, the seventh and eighth *DuPont* factors are neutral.

II. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant’s arguments relating thereto, we conclude that consumers familiar with Registrant’s goods offered under its mark would be likely to believe, upon

encountering goods offered under Applicant's mark, that the goods originated with or are associated with or sponsored by the same entity. There is therefore a likelihood of confusion under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d).

Decision: The refusal to register Applicant's mark is affirmed.