

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: January 24, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Iona College*

Serial No. 90069213  
Serial No. 90069574  
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Kevin J. Harrington of Harrington Ocko & Monk LLP,  
for Iona College.

Eliana Torres, Trademark Examining Attorney, Law Office 110,  
Chris Pedersen, Managing Attorney.

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Before Kuhlke, Greenbaum and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Iona College (“Applicant”) seeks registration on the Principal Register of the marks GAELNATION and GAEL NATION, both in standard characters, for

Encouraging intercollegiate athletic programs by organizing sporting teams, sporting activities, and sporting events for intercollegiate athletes and alumni and associated entertainment activities in the nature of live entertainment performances by the players of sports of baseball, basketball, track and field, golf, rowing, soccer, swimming and diving, water polo, lacrosse, softball, volleyball, rugby, e-sports, weightlifting and cheerleading,

and by the performers in pipe bands, pep bands and dance teams, in International Class 41.<sup>1</sup>

The Trademark Examining Attorney has refused registration of both marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks, when used in connection with the identified services, so resemble the registered mark GAELS (typeset) for "educational services, namely providing courses of instruction at the college and post graduate level; and organizing and conducting sports competitions and sports events" in International Class 41 as to be likely to cause confusion, mistake or deception.<sup>2</sup>

When the refusal was made final in each application, Applicant appealed. Applicant requested reconsideration in Application Serial No. 90069213 only, which was denied. The appeals are now fully briefed.<sup>3</sup>

We affirm the refusals to register Applicant's marks.

## I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts

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<sup>1</sup> Application Serial Nos. 90069213 and 90069574 were filed on July 23, 2020, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as October 1, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

<sup>2</sup> Registration No. 2590747 issued July 9, 2002; twice renewed. A typed drawing is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (July 2022).

<sup>3</sup> The Board sua sponte consolidated the appeals on March 16, 2022. 8 TTABVUE 1-2. All references to the applications are to the TSDR record in Application Serial No. 90069574 unless otherwise specified.

As a point of clarification, the above identification of Applicant's services reflects Applicant's latest proposed amendment, which the Examining Attorney accepted in both applications. *See* Ex. Atty. Br., 9 TTABVUE 2, n.1 (accepting amendment in Serial No. 90069213); November 29, 2021 Request for Reconsideration Denied, TSDR 6 (Serial No. 90069574).

in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). 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) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and services. *See 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.”).

The Examining Attorney focuses on the similarities of the marks due to the shared term GAEL, and the similarities between the identified services and their channels of trade, which include organizing and conducting college sports competitions and events.<sup>4</sup>

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<sup>4</sup> “Gael” is defined as “a Scottish Celt or Highlander” and “a Gaelic-speaking Celt.” “Celt” is defined as “a member of an Indo-European people now represented chiefly by the Irish, Gaels, Welsh, and Bretons.” Dictionary.com Unabridged, based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2023), accessed January 14, 2023. The Board may take judicial

Applicant does not dispute the similarities between the marks and identified services. Instead, as discussed below, Applicant focuses on purported “real world” differences in the channels of trade based on geographical differences between Applicant and Registrant, who are universities located on opposite coasts of the United States, and who have different supporters or potential supporters based on their loyalty to the university or their location in the same geographic region as the university (e.g. through participation in regional athletic conferences), as well as purported consumer sophistication due to such loyalty and to the use and registration of many other third-party marks that incorporate or consist entirely of a shared nickname for different sports teams. Applicant also argues that the shared term GAEL is weak due to third-party uses and registration of GAEL/GAELS for athletics services that are the same as, or similar to, those identified in the applications and registration. Applicant asserts that there has been no actual confusion by “students, alumni or fans” despite Applicant’s and Registrant’s use of “Gaels’ concurrently for decades” and Applicant’s use of the phrase “Gael Nation” since 2015 in association with their athletic teams, and “there is no reason to believe that the addition of the word ‘Nation’ to form the phrase ‘Gael Nation’ would be confusing” since “consumers have managed to distinguish between the two school’ uses of the nickname ‘Gales’ for some 80 years without difficulty.” App. Br., 6 TTABVUE 14-15.

For the reasons discussed below, we agree with the Examining Attorney’s

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notice of dictionary definitions, including online dictionaries. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). We do so here.

assessment, and therefore affirm the Section 2(d) refusal in each application.

A. Similarity or Dissimilarity of the Services

We make our determination about the similarity or dissimilarity of the services based on the services as they are identified in the applications and cited registration. *See In re Detroit Athl. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any service encompasses by the identification in these single-class applications. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

Here, the services identified in the cited registration, “organizing and conducting sports competitions and sports events,” are broadly worded and encompass the more specific services of “[e]ncouraging intercollegiate athletic programs by organizing sporting teams, sporting activities, and sporting events for intercollegiate athletes and alumni” in various athletic fields as identified in the applications. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s

narrowly identified ‘residential and commercial furniture.’”). *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). The services therefore are legally identical, in part, and Applicant does not argue otherwise.

The second *DuPont* factor strongly favors a finding of likelihood of confusion.

#### B. Channels of Trade

Given the in-part legal identity of the identified services in the applications and cited registration, and the lack of restrictions or limitations in the registration as to their nature, channels of trade, or classes of customers, we must presume that the channels of trade and classes of purchasers for these services are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in the same channels of trade to the same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ2d 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). In other words, because the identification of services in the cited registration is unrestricted as to channels of trade and classes of customers, we must presume that the services could be offered and sold to the same classes of purchasers, such as consumers who are interested in collegiate sports competitions and events, through the same channels of trade, such as colleges, tournaments and broadcast media, as would be Applicant’s more narrowly restricted, but legally identical, services. *See Viterra*, 101 USPQ2d at 1908.

Applicant urges the Board to apply an incorrect legal presumption, namely, that the services are presumed to move in all channels of trade that are normal and usual

for such services and to all normal potential purchasers. App. Br., 6 TTABVUE 11. Based on this presumption, and extrinsic evidence of actual use of the marks by Applicant and Registrant, Applicant contends that the geographical differences between Applicant and Registrant, and the differences in their normal purchasers, i.e., individuals associated with Applicant or Registrant and fans of the schools and their teams, makes confusion unlikely. App. Br., 6 TTABVUE 6, 11-13. However, that presumption applies “in the absence of specific limitations” when the goods or services are not identical/legally identical. *i.am.symbolic*, 123 USPQ2d at 1751; *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). However, as discussed above, absent geographic or other meaningful restrictions as to trade channels or classes of customers in the identifications of services, we are **required** to presume that they are the same for the legally identical sports competitions and events services identified in the applications and registration. *See Viterra*, 101 USPQ2d at 1008.

We also remind Applicant that our determination under this *DuPont* factor is based on the descriptions of services in the applications and cited registration, not on extrinsic evidence of actual use. *i.am.symbolic*, 123 USPQ2d at 1749-50. In other words, an applicant may not restrict the scope of the services covered in its applications or the cited registration by argument or by extrinsic evidence. *Stone Lion*, 110 USPQ2d at 1162 (“It was proper, however, for the Board to focus on the

application and registrations rather than on real-world conditions ....”); *Octocom*, 16 USPQ2d, at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”). Accordingly, Applicant’s arguments about the “normal” “real world” channels of trade and classes of purchasers are inapposite.

In any event, Applicant’s argument that confusion is not likely because Applicant and Registrant are universities who provide their services in geographically distinct areas and to different classes of purchasers specific to each university and geographic region (through attendance at athletic conferences) is unavailing. App. Br., 6 TTABVue 11-12. This is so because Applicant seeks geographically unrestricted registrations, and Registrant owns a nationwide registration, which give Registrant presumptive exclusive rights to nationwide use of its mark in connection with the identified services under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983) (“Applicant seeks a geographically unrestricted registration under which it might expand throughout the United States. Under these facts, it is not proper, as the TTAB found, to limit our consideration to the likelihood of confusion in the areas presently occupied by the parties. Section 7(b) of the Trademark Act of 1946, 15 U.S.C. § 1057(b), creates a presumption that the registrant has the exclusive right to use its mark throughout the United States. Therefore, the geographical distance



between the present locations of the respective businesses of the two parties has little relevance in this case.”).

This *DuPont* factor also strongly favors a finding of likelihood of confusion.

C. Strength of the Cited Mark

Under the sixth *DuPont* factor, we consider “[t]he number and nature of similar marks in use on similar goods [or services].” *DuPont*, 177 USPQ at 567. Evidence of third-party use bears on the strength or weakness of a registrant’s mark. *i.am.symbolic*, 123 USPQ2d at 1751. If the evidence establishes that the consuming public is exposed to third-party uses of similar marks for similar goods or services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant contends that “Gael” is a weak term entitled to a narrow scope of protection or exclusivity of use in view of an asserted plethora of third-party uses of GAEL-formative marks for educational and/or sports-related services where the term is used to evoke Irish heritage and traditions, including use as nicknames for sports teams that are affiliated with academic institutions, and registrations for GAEL-formative marks. App. Br., 6 TTABVUE 9-11. According to Applicant, if the cited registration for GAELS can coexist with other GAEL-formative marks, then its marks also should be permitted to register. *Id.*

In support of this contention, Applicant points to two use-based GAEL-inclusive registrations, one of which has been cancelled (November 10, 2021 Request for

Reconsideration, Exhibits 4-5, TSDR 17-23); business listings from the California and New York Secretaries of State (*id.*, Exhibits 6-8, TSDR 24-68); and screenshots from 11 third-party high schools across the United States, and an amateur sports club in Washington, DC (*id.*, Exhibits 26-27, TSDR 374-388). App. Br., 6 TTABVUE 9-11. We address each evidentiary category in turn.

1. Third-Party Registrations

As an initial point, and as the Examining Attorney notes, Reg. No. 3852036 has expired because its owner did not file the required maintenance documents. Ex. Atty. Br., 9 TTABVUE 6. A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“‘dead’ or cancelled registrations have no probative value at all.”).

The other registration (Reg. No. 6218166) for the mark ALBA Y GAEL conveys the impression of two Spanish names, rather than connoting Irish or Gaelic heritage, as do Applicant’s and Registrant’s marks. Moreover, none of the goods and services identified in this registration (e.g., “computers” in Class 9, “magazines in the field of languages” in Class 16, “providing access to databases” in Class 38, and “seminars and ongoing television and radio talk show in the field of public interest concerning languages” in Class 41) are even facially related to the athletic services here at issue, and Applicant made no showing otherwise. This third-party registration has no probative value. *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686 (Fed. Cir. 2018) (error to rely on third-party evidence of

similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, ... support a finding that registrants' marks are weak with respect to the goods identified in their registrations”).

## 2. Business Listings from Secretaries of State

The lists from the New York and California Secretaries of State of active, suspended and dissolved businesses that contain GAEL as part of the business name, with no corresponding registration certificates, are of little probative value. On this record, we do not know the nature of the services these entities provide, but in any event, the listings do not constitute technical service mark use, and as the Examining Attorney notes, they “do not establish that the relevant consumers are accustomed to encountering GAEL as a source-indicator for the concerned sporting activity and event services in question.” Ex. Atty. Br., 9 TTABVUE 7-8.

## 3. Third-Party Use of GAEL/GAELS

The evidence shows that 11 high schools use the term GAEL/GAELS to refer to their students and their athletic teams, and the “Washington DC Gaels GAA is an amateur sports club that promotes Irish sports in the Washington, DC metropolitan area.” November 10, 2021 Request for Reconsideration, Exhibits 26-27, TSDR 387-88. The extent and impact of the uses is unknown.

“[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established,”

*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) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Here, however, Applicant's evidence consists of marketplace evidence of 12 different entities using GAEL or GAELS in association with their schools and sports teams, and no third-party registrations covering services similar to the sports competitions and events services identified in the applications and registration. While this evidence is similar in volume to that in *Jack Wolfskin*, where there were at least 14 relevant third-party uses or registrations of record, it is far short of the at least 26 relevant third-party uses or registrations of record found convincing in *Juice Generation*. See also *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

Despite the evidentiary infirmities, the record supports a finding that the term "GAEL" is not entirely unique when used in connection with athletics programs associated with schools that promote their Irish/Gaelic history, traditions and pride, and certain members of the general public, such as students/faculty/alumni of the schools, would be aware of this connotation. We find, therefore, that the mark in the

cited registration is somewhat weak, and accordingly, it is entitled to a slightly narrowed scope of protection.

#### D. Similarity or Dissimilarity of the Marks

We compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Detroit Athl.*, 128 USPQ2d at 1048 (quoting *DuPont*, 177 USPQ at 567); *see also Palm Bay Imps.* 73 USPQ2d at 1691. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

Because similarity is determined based on the marks in their entireties, our analysis is not predicated on dissecting the marks into their various components. *Stone Lion*, 110 USPQ2d at 1161 (Fed. Cir. 2014). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion

rests on consideration of the marks in their entireties.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Further, the marks “must be considered ... in light of the fallibility of memory ....” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). We focus on the recollection of the average consumer – here, an ordinary consumer who enjoys college sports – who normally retains a general rather than a specific impression of trademarks. *Id.*; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). And we bear in mind that where, as here, services are legally identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quotation omitted).

Applicant’s marks GAEL NATION and GAELNATION look and sound similar to Registrant’s mark GAELS because of the common wording GAEL. While Registrant’s mark is the plural form of the shared word GAEL, this is a minor distinction without source identifying significance. *See Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (“It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word ‘Zombie’ and they will therefore be regarded here as the same mark”); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (singular and plural of SWISS GRILL deemed “virtually identical”).

The connotation and commercial impression of the marks also are very similar due to the common element, GAEL, which evokes Gaelic/Irish heritage and traditions. Applicant and the Examining Attorney agree that GAEL retains this meaning when applied to organizing and conducting college sports competitions and events. App. Br., 6 TTABVUE 11 (“[Applicant’s] sports teams have been competing under the nickname ‘Gaels’ for decades. The nickname was selected because it reflects the school’s Irish-Christian heritage. Since 2015, [Applicant] has used the Mark[s] to encourage its students alumni, faculty and staff to support the Gaels by being a part of ‘Gael Nation.’”) (internal citations omitted); Ex. Atty. Br., 9 TTABVUE 6-7 (“[B]ased on the ‘GAEL’ wording shared in common and the similar context of use, [consumers] are likely to conflate the marks in their memories because they create highly similar, if not identical overall commercial impressions, namely, a sense of belonging to a team characterized by its Gaelic roots, traditions or heritage.”).

The additional word NATION in Applicant’s marks GAEL NATION and GAELNATION does not change the commercial impression of the shared term GAEL; it simply suggests a community with Gaelic/Irish roots, tradition and heritage. This is so regardless of the inconsequential space, or lack thereof, between GAEL and NATION in Applicant’s marks. *See, e.g., Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEAGUARD and SEA GUARD “are, in contemplation of the law, identical”).

As the first part of each of Applicant’s marks, the common wording GAEL “is most likely to be impressed upon the mind of a purchaser and remembered,” *Presto Prods.*,

*Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) and *Palm Bay Imps.*, 73 USPQ2d at 1692, and so to play a dominant role in each mark. *See, e.g., Detroit Athl.*, 128 USPQ2d at 1049 (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (stating that, “upon encountering each mark, consumers must first notice this identical lead word”). Thus, while Applicant’s marks contain the additional term NATION, the dominant term in Applicant’s marks is essentially identical to the entirety of Registrant’s mark, rendering the marks similar overall in appearance, sound, meaning and commercial impression. *See Nat’l Data*, 224 USPQ at 751 (Fed. Cir. 1985); *see also Stone Lion*, 110 USPQ2d at 1161.

Finally, Applicant’s contentions that Applicant and Registrant actually display their marks with different logos and school colors, and Registrant “uses the phrases ‘#GaelsRise’ and ‘Gael Force’ – not ‘Gael Nation,’” do not affect this analysis. App. Br., 6 TTABVUE 11. Because Applicant's marks are presented in standard characters and Registrant’s mark is presented in the legally equivalent typed format, each may display their marks the identical “font style, size or color.” Trademark Rule 2.52, 37 C.F.R. § 2.52. *See Citigroup*, 98 USPQ2d at 1256 (noting that standard character marks are not limited to any particular presentation); *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968) (noting that “the display of a mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of



the mark”); *cf.*, *Frances Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959) (“In determining the applicant’s right to registration, only the mark as set forth in the application may be considered; whether or not the mark is used with an associated house mark is not controlling.”).

The first *DuPont* factor favors a finding of likelihood of confusion.

#### E. Purchasing Conditions

Under the fourth *DuPont* factor, we consider the “conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567.

##### 1. Third-Party Use and Registration of Other Identical Nicknames

Applicant argues that “consumers are accustomed to exercising care in distinguishing among teams that use the same nickname, and that the general understanding in the industry – as reflected by the common practice of using identical names – is that consumers are sufficiently sophisticated to make these distinctions.” Reply Br., 10 TTABVUE 10-11. In support, Applicant points to “dozens of examples of team nicknames that have been registered as trademarks and/or used by more than one organization, including by more than one college or university.” App. Br., 4 TTABVUE 13 (citing November 10, 2021 Request for Reconsideration, Exhibits 15-19, TSDR 112-303).

The record includes 18 sets of third-party registrations for marks comprising or consisting of the same nickname for professional teams in different sports leagues (e.g., GIANTS for a professional baseball team and NEW YORK GIANTS for a

professional football team), or for marks comprising or consisting of the same nickname for professional teams and universities (e.g., PHILADELPHIA EAGLES and BOSTON COLLEGE EAGLES).<sup>5</sup> *Id.*, Exhibits 15-17, TSDR 112-193. The record also includes two lengthy Wikipedia articles listing numerous professional sports teams who share the same name or a portion of the same name, and various college's athletic teams who compete under the same moniker (e.g., "Bears," "Bobcats," "Bulldogs"). *Id.*, Exhibits 18 and 19, TSDR 194-303.

According to Applicant, the registration and use evidence collectively shows that those marks "peacefully coexist" and the organizations "believe that their respective [services] are distinct enough that confusion between even identical marks is unlikely." App. Br., 4 TTABVUE 13 (citing *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015)). Applicant therefore posits that its marks can coexist with Registrant's mark: "Similarly, here, consumers will have no more difficulty distinguishing between St. Mary's Gaels and Iona's Gael Nation than they currently do in distinguishing among the many other colleges and professional teams that share the same or similar nicknames." App. Br., 6 TTABVUE 13. We disagree.

First, there is no evidence as to how many, if any, of the third-party unregistered marks "peacefully coexist," or what the organizations "believe." Unsupported attorney argument does not aid Applicant. *See Cai*, 127 USPQ2d at 1799 ("Attorney argument is no substitute for evidence.") (quoting *Enzo Biochem, Inc. v. Gen-Probe*

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<sup>5</sup> None of the sets of third-party registrations relied upon by Applicant include the term GAEL or a formative thereof.

*Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2004) (finding there was no proof to support the statements in the record by counsel).

Second, unlike the goods involved in *Thor Tech*, the services identified in the applications and registration are legally identical in part, and there is no evidence that they are a type of “special purchase” for which a consumer would exercise a greater than average degree of care in purchasing. Indeed, Applicant’s specimens support the opposite finding, in that they show the mark GAEL NATION used on a bleacher in a sports field, on a banner in a school hall, and painted on a brick wall in a school hall with four members of the cheer squad seated below, with no additional wording suggesting that Applicant offers any luxury or expensive services.<sup>6</sup> Consequently, the rationale underlying the Board’s decision to reverse a Section 2(d) refusal in *Thor Tech* does not apply here.<sup>7</sup>

Third, Applicant’s evidence of third-party uses and registrations of other coexisting marks for athletic services has little probative value because most of the registered marks include additional terms (often geographic or school names), and

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<sup>6</sup> The specimens for Serial No. 90069213 (GAELNATION) are a photo of “athletes playing basketball wearing team uniforms” and a “silkscreen logo on t-shirts for distribution at college athletic events.” As with the specimens in Serial No. 90069574, there are no additional words on the specimens.

<sup>7</sup> In *Thor Tech*, the Board reversed a Section 2(d) refusal where the marks were identical but the goods were not, and the evidence of nearly 50 pairs of third-party registrations owned by different entities for substantially identical marks for both types of goods (land motor vehicles and towable recreational vehicle trailers) “suggests to us that businesses in these two industries believe that their respective goods are distinct enough that confusion between even identical marks is unlikely.”

many include design elements or are presented in specific formats, all of which may help distinguish the marks. There also is no evidence that the same nickname is registered by more than one college or university, as would be the case if we were to reverse the refusal here. Moreover, many reasons to which we are not privy may explain the coexistence of these team nicknames, such as the inherent weakness or the commercial weakness of the shared term (for both registered and unregistered coexisting nicknames). Such weakness also could limit the scope of protection of the prior co-existing registrations. “Applicant’s attempt to equate those co-existing registrations, for each of those marks, with the situation herein is not persuasive. Suffice it to say that each case must be decided on its own set of facts.” *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2010); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (“[E]ach case must be decided on its own facts and the differences are often subtle ones.”). Further, we are not bound by the allowance of prior registrations, even if they have some characteristics that may appear relevant to this case. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

## 2. Third-Party Use of Gael/Gaels

Applicant identifies the relevant customers as “students, alumni, faculty, employees and collegiate sports fans, who have an emotional connection to their respective schools.” App. Br., 6 TTABVUE 6. According to Applicant, “None of these consumers are likely to attend a college, support a team, attend a pep rally or booster event, pay to watch a game, or otherwise engage with either school on a whim. Rather, they are sophisticated, dedicated to their schools, and fully capable of distinguishing

between St. Mary's 'Gaels' and Iona's 'Gael Nation' without any difficulty." *Id.*, 6 TTABVUE 6-7. Like Applicant's arguments regarding the channels of trade, this argument is unavailing because it is based on limitations or restrictions that do not appear in the identifications of services. *See i.am.symbolic*, 123 USPQ2d at 1748 ("It is well established that the Board may not read limitations into an unrestricted registration or application.").

We recognize that the customers identified by Applicant represent typical fans of college athletics teams, and they likely will be familiar with the trademarks of a particular school and likely will look for sports competitions and events believed to be related to the school. *See Bd. of Regents v So. Illin. Miners, LLC*, 110 USPQ2d 1182, 1193 (TTAB 2014). But we cannot presume that these purchasers are the only purchasers of Applicant's and Registrant's legally identical sports competitions and events services, *id.*, and Applicant has presented no evidence to support such a contention. *See Cai*, 127 USPQ2d at 1799 ("Attorney argument is no substitute for evidence."). To the contrary, we must presume that relevant customers for Applicant's and Registrant's identified sports competitions and events include members of the general public who enjoy college sports, including those with no affinity to either school, who support any team with the name "Gael" due to their own heritage, traditions, roots, or affinity with, the Irish/Gaelic community.

Even assuming that some purchasers of Applicant's and Registrant's sports competitions and events services exercise significant care in purchasing the services, "Board precedent requires the decision to be based 'on the least sophisticated

potential purchasers.” *Stone Lion*, 110 USPQ2d at 1163. Here, there is no evidence that the least sophisticated potential purchasers will exercise anything other than ordinary care. Also, it is settled that even sophisticated purchasers are not immune to source confusion, especially in cases such as this one involving very similar marks and in-part legally identical services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)).

In view thereof, we find this *DuPont* factor neutral.

#### F. Lack of Actual Confusion

Applicant argues under the eighth *DuPont* factor that Applicant and Registrant have used “Gaels” for “[s]ome 80 years without difficulty.” 6 TTABVUE 14-15. *See In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020) (“The eighth *du Pont* factor ... – ‘[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,’ *see du Pont*, 177 USPQ at 567—requires us to look at actual market conditions, to the extent there is evidence of such conditions of record.”). Applicant submitted no supporting evidence.

Applicant’s “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *Majestic Distilling*, 65 USPQ2d at 1205. Moreover, “in this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story.” *Guild Mortg.*, 2020 USPQ2d 10279, at \*23. Nor can we assess

whether there has been any significant opportunity for actual confusion to have occurred, as we have little or no evidence as to the nature and extent of use by Applicant and Registrant. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*9 (TTAB 2019) (explaining that “for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred”); *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends on there being a significant opportunity for actual confusion to have occurred).

In any event, “the relevant test is likelihood of confusion, not actual confusion.” *Detroit Athl. Co.*, 128 USPQ2d at 1053. And, as often stated, “a showing of actual confusion is not necessary to establish a likelihood of confusion.” *i.am.symbolic*, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

The eighth *DuPont* factor is neutral.

## II. Conclusion

The overall similarity of the marks for in-part legally identical sports competitions and events services that are presumed to move in the same channels of trade to the same classes of consumers renders confusion likely, despite some weakness of the shared term GAEL. Purchasing conditions and the lack of actual confusion are neutral.

**Decision:** The refusals to register Applicant’s marks GAEL NATION and GAELNATION are affirmed under Trademark Act Section 2(d).