

This Opinion is Not a
Precedent of the TTAB

Mailed: February 2, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re GFactor Enterprises, LLC d/b/a Gfactor Films
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Serial No. 90159334
—————

Andrea H. Evans of The Law Firm of Andrea Hence Evans, LLC,
for GFactor Enterprises, LLC d/b/a Gfactor Films.

Theodore Sotland, Trademark Examining Attorney, Law Office 105,
Katrina Goodwin, Acting Senior Attorney.

—————
Before Lykos, Heasley and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

GFactor Enterprises, LLC d/b/a Gfactor Films (“Applicant”) seeks registration on
the Principal Register of the standard character mark MAKE YOUR PASSION
YOUR PAYCHECK for:

Series of non-fiction books in the field of passion, self-awareness,
EQ-emotional intelligence, student, adolescent, adult and career success
in International Class 16, and

Education services, namely, providing classes, seminars, and workshops
in the fields of passion, self-awareness, EQ-emotional intelligence,
student, adolescent, adult and career success; Educational and
entertainment services, namely, providing motivational speaking

services in the field of passion, self-awareness, EQ-Emotional Intelligence, student and career success in International Class 41.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's applied mark so resembles the registered mark MAKE YOUR PASSION YOUR PROFESSION for "[e]ducational services, namely, providing courses of instruction at the undergraduate and professional level," in International Class 41,² on the Principal Register as to be likely to cause confusion, mistake, or deception. The Examining Attorney also refused registration under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127, on the ground that Applicant's mark, as applied to the above-noted goods and services, is a widely used commonplace term, message, or expression that does not function as a trademark or service mark to indicate the source of Applicant's goods or services and to identify and distinguish them from others.

Applicant and the Examining Attorney filed briefs.³ We affirm the refusal to register Applicant's mark under Trademark Act Section 2(d) as to the goods and

¹ Application Serial No. 90159334 was filed on September 4, 2020, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), for the goods in Class 16, based upon Applicant's allegation of a bona fide intention to use the mark in commerce; and under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), for the services in Class 41, based upon Applicant's claim of first use of the mark anywhere and first use in commerce since at least as early as October 12, 2018. As originally filed, Application Serial No. 90159334 also recited goods in Class 25. The Class 25 goods were divided out of this application prior to the present appeal.

² Registration No. 3211181 was issued on February 20, 2007; renewed.

³ Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board's

services in Classes 16 and 41. Because we resolve this appeal on the likelihood of confusion refusal under Trademark Act Section 2(d), we do not reach the failure-to-function refusal under Trademark Act Sections 1, 2, 3 and 45. *See In re Suuberg*, 2021 USPQ2d 1209, *9-10 (TTAB 2021) (affirming nonuse refusal, and declining to reach failure to function refusal).

I. Likelihood of Confusion: Applicable Law and Analysis

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We have considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, 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

TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page numbers, if applicable.

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”). Moreover, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent consumer confusion as to source, and to protect registrants from damage caused by registration of marks for goods or services that are likely to cause confusion. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

A. Similarity or Dissimilarity of the Marks

1. Strength of the Cited Mark

Before we evaluate the similarity or dissimilarity of the respective marks, we first consider the strength of the cited MAKE YOUR PASSION YOUR PROFESSION mark. The strength of Registrant’s mark affects the scope of protection to which it is entitled. Thus, we consider the conceptual strength of Registrant’s mark, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See 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”).

In an *ex parte* appeal such as this one, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate consumers’

exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). So the mark's commercial strength, as usual, is presumptively treated as neutral. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(ix) (2022). Because the cited registration is "prima facie evidence of the validity of the registered mark," see Trademark Act Section 7(b), 15 U.S.C. § 1057(b), we must presume that the cited mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). See *Tea Bd. Of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); see also *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020).

Applicant argues that, "with regard to any type of educational service, the word[s] "your passion" ... [are] very commonly used,"⁴ citing the following registered marks that it made of record:⁵

⁴ Applicant's Brief, 4 TTABVUE 15.

⁵ Office Action Response of June 24, 2021, at TSDR 43-61. We find no probative value to the FIND YOUR PASSION mark of Registration No. 4869038, because that registration was cancelled. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. See *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a cancelled registration does not provide constructive notice of anything."); *In Re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007).

**Mark and
Registration Number**

Services

OWN YOUR PASSION
6105933

Business education and training services, namely, developing customized in-company leadership and executive development programs, providing executive coaching services, and providing public and in-company keynote presentations to business leaders, Cl. 41

CASH IN YOUR
PASSION
5780145

Educational and entertainment services, namely, providing motivational speaking services in the fields of art, artistic creativity, artistic expression, personal motivation and business growth through creative expression; Educational services, namely, conducting classes, seminars, conferences, workshops in the fields of art, artistic creativity, artistic expression, personal motivation and business growth through creative expression; Instruction in the field of puppeteering, puppet building, voice acting, drawing, sculpting and pumpkin carving, Cl. 41

SEW YOUR PASSION
5895237

Educational services, namely, providing classes, conferences, and workshops in the fields of sewing and quilting, Cl. 41

FUEL YOUR PASSION
5726830

Providing a website featuring non-downloadable videos on inspirational and motivational topics in the field of personal and artistic creativity and development, Cl. 41

LIVE YOUR PASSION
5009625

Providing educational and instructional classes, workshops and seminars in the fields of fitness, exercise, lifestyle, general wellness, yoga and nutrition; Providing information in the fields of fitness, exercise and yoga; Providing instruction and training in the fields of fitness, exercise, lifestyle, general wellness, yoga and nutrition; Arranging, organizing and conducting community sporting, athletic and social entertainment events in the fields of health, fitness, yoga, nutrition, exercise, lifestyle, general wellness and community involvement, Cl. 41

Mark and Registration Number	Services
SEIZE YOUR PASSION 5291462	Providing an ongoing dramatic series via a global computer network featuring topics related to personal fulfillment, professional development and community service; providing online blogs featuring topics related to personal fulfillment, professional development and community service, Cl. 41
BRAND YOUR PASSIONS 5072843	Education services, namely, providing on-line live classes in the field of entrepreneurship, Cl. 41
GROW YOUR PASSION 4205776	Education services, namely, providing classes and workshops in the field of gardening, Cl. 41

“Third-party registrations ‘may bear on conceptual weakness if a term is commonly registered for similar goods or services.’” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)). Third-party registrations alone may be relevant, in the manner of dictionary definitions, “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted); *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).

“Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be conceptually weak because the more descriptive a term is, the less likely prospective purchasers are to attach source-identifying significance to it.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745-46 (TTAB 2016).

We find Applicant has made of record a sufficient number of third-party registrations for educational services to establish that “YOUR PASSION” is conceptually weak for such services. However, this evidence does not demonstrate that the mark MAKE YOUR PASSION YOUR PROFESSION as a whole is conceptually weak for these services.

The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567. Applicant thus further argues “[c]ertain terms can be considered weak if they are used in common law. ... To that end, Applicant attached several other references showing the word ‘your passion’ used for a number of services involved in some sort of learning or education.”⁶ In support, Applicant made the following online uses of “YOUR PASSION” marks of record:⁷

⁶ Applicant’s Brief, 4 TTABVUE 16-17.

⁷ Office Action Response of June 24, 2021, at TSDR 62-91.

Mark and Online Location	Services
MAKE YOUR PASSION YOUR LIFE (donkavi.com)	Marketing and business development services.
MAKE YOUR PASSION YOUR VOCATION (extension.ucsd.edu)	Lactation continuing education programs and learning materials.
MAKE YOUR PASSION YOUR REALITY (amazon.com)	A book (in Kindle format) for coaches, counselors, and anyone looking for vocational fulfillment.
HOW TO MAKE YOUR PASSION YOUR MISSION (advisorpedia.com)	A blog post on discovering one's passion and making it a goal for fulfillment in every day life and at work.
5 REASONS TO MAKE YOUR PASSION YOUR CAREER (boldsky.com)	An online article on making one's passion one's career, including passion for work, resolving workplace tension, making money and job satisfaction.

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). Third-party uses may bear on the commercial weakness of a mark, *Tao Licensing*, 125 USPQ2d at 1057, and may be “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).

“As to commercial weakness, ‘[t]he probative value of third-party trademarks depends entirely upon their usage.’” *Tao Licensing*, 125 USPQ2d at

1059 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693). Applicant offers evidence regarding the use of five third-party YOUR PASSION marks for seemingly disparate educational, personal betterment and professional improvement pursuits. Applicant “did not show how long or how extensively” these marks have been used. *Id.* at 1058. A small number third-party of YOUR PASSION marks for such services is insufficient to show the commercial weakness of YOUR PASSION-formative marks, let alone the MAKE YOUR PASSION YOUR PROFESSION mark as a whole. *Id.* at 1059 (finding that numerous third-party uses of TAO-formative marks without evidence of “the current nature and extent of use of the third-party marks” did not permit Board to “infer such a degree of recent consumer exposure as would show that consumers generally distinguish among the marks containing ‘tao’ based on minor distinctions.”); *see also Sabhnani*, 2021 USPQ2d 1241, at *22 (same).

Moreover, Applicant did not make of record a sufficient number of marks identical or similar to Registrant’s MAKE YOUR PASSION YOUR PROFESSION mark as a whole for similar services “to show that ... [the] mark is relatively weak and entitled to only a narrow scope of protection.” *In re FabFitFun*, 127 USPQ2d 1670, 1674 (TTAB 2018).

In sum, the conceptual and commercial strength of the cited MAKE YOUR PASSION YOUR PROFESSION mark are neutral considerations on this appeal. We thus afford the MAKE YOUR PASSION YOUR PROFESSION mark the typical scope of protection afforded an inherently distinctive mark registered on the Principal Register pursuant to Trademark Act Section 7(b), 15 U.S.C. § 1057(b). *See Bell’s*

Brewery, Inc. v. Innovation Brewing, 125 USPQ2d 1340, 1347 (TTAB 2017) (“Considering the record as a whole, including evidence pertaining to both conceptual and commercial strength, we find that Opposer's marks are inherently distinctive and accord them the normal scope of protection to which inherently distinctive marks are entitled.”).

2. Comparison of Applicant’s Mark and the Cited Mark

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entirety, considering their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “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) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019)).

Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must instead rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). “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) (quotation omitted).

The parties' 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) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, the focus is on the recollection of the average purchaser – here, the consumer of educational services or printed matter – who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *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.”). Further, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)).

Nonetheless, 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 a consideration of the marks in their entireties. *Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Further, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). For instance, “it is often the first part of a mark which 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). Moreover, if an important or, as in the case here, a significant portion of both marks is the same, then the marks may be confusingly similar notwithstanding some peripheral differences. *See Stone Lion*, 110 USPQ2d at 1160-61.

We begin our analysis of the marks by noting the obvious; both Applicant’s mark and Registrant’s mark begin with “MAKE YOUR PASSION YOUR ...,” and end with a final word that starts with the letter “P.” We therefore find that the marks are similar in sight and sound.

Applicant argues:

The marks at issue differ as to the significant terms “paycheck” and “profession”. Neither word looks alike, sounds alike, or has the same meaning. “Paycheck” is defined as “wages or salary” ...,⁸ and “profession” is defined as “a calling requiring specialized knowledge and often long and intensive academic preparation”. ...⁹ These definitions coincide with the products and services intended by the parties, as Applicant is specifically referencing the ability to make money, while Registrant’s services are academic based, as set forth in the definition for “profession”.¹⁰

⁸ Office Action Response of June 24, 2021, at TSDR 20.

⁹ Office Action Response of June 24, 2021, at TSDR 32.

¹⁰ Applicant’s Brief, 4 TTABVUE 15.

The Examining Attorney argues:

[I]n their entirety, the marks at issue stimulate the same mental reaction notwithstanding the single term difference (e.g. PAYCHECK vs. PROFESSION) because both marks start with the identical wording “MAKE YOUR PASSION YOUR”. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. (citing cases). ... Furthermore, the terms “PAYCHECK” and “PROFESSION” both create a general impression relating to what a person does to earn a living wage. Accordingly, Applicant’s argument that “[t]he marks at issue differ as to the significant terms “paycheck” and “profession”. Neither word looks alike, sounds alike, or has the same meaning” (Applicant’s Brief pp. 10) and the exhibits submitted in support thereof consisting of dictionary definitions are unpersuasive.

In sum, when looking at the entirety of each mark, both marks convey the exact same meaning that one should strive to do what they love, their passion, for their career, i.e., their profession or their means to obtain a paycheck. As a result, consumers would be confused as to the source of the goods and services.¹¹

We agree with the Examining Attorney’s position, however, that “PAYCHECK” and “PROFESSION” both create a general impression relating to what a person does to earn a living wage. As a further part of our analysis, we take judicial notice of the term “passion” as meaning “a strong liking or desire for or devotion to some activity, object, or concept.”¹² Overall, then, both marks implore someone to make their avocation their vocation. Both marks thus convey the same connotation and commercial impression.

¹¹ Examining Attorney’s Brief, 6 TTABVUE 17-18.

¹² Definition of “passion” from Merriam-Webster online dictionary (<https://www.merriam-webster.com/dictionary/passion>), last visited January 31, 2023. The Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

Comparing the marks in their entireties, we therefore find that they are more similar than dissimilar in sight, sound, connotation and commercial impression. The first *DuPont* factor supports a finding that confusion between the marks is likely.

B. The Similarity or Dissimilarity of the Respective Goods and Services, and Channels of Trade

1. Goods and Services

We now turn to the comparison of the goods and services at issue, the second *DuPont* factor. In making our determination regarding the similarity of the goods and services, we must look to the goods and services as identified in the appealed MAKE YOUR PASSION YOUR PAYCHECK application and the cited MAKE YOUR PASSION YOUR PROFESSION registration. *See Stone Lion*, 110 USPQ2d at 1162 (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [and services] set forth in the application ... regardless of what the record may reveal as to the particular nature of an applicant’s goods [or services], the particular channels of trade or the class of purchasers to which the sales of the goods [or services] are directed.”)); *see also Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [and services]”). This controlling case law renders irrelevant Applicant’s arguments and those portions of Applicant’s

evidence attempting to show the origins and differences in services rendered by Applicant and Registrant in the marketplace.¹³

The compared goods and services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). “It is sufficient that the respective goods [or services] are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods [or services] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.” *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

a. Class 41 Services

The cited registration uses broad wording to describe the Class 41 services (i.e., “[e]ducational services, namely, providing courses of instruction at the undergraduate and professional level”). The Registrant’s identification does not restrict the educational services to a particular subject matter. Therefore, it presumably encompasses all services of the type described, including Applicant’s more narrowly identified Class 41 services (i.e., “[e]ducation services, namely, providing classes, seminars, and workshops in the fields of passion, self-awareness, EQ-emotional intelligence, student, adolescent, adult and career success; [e]ducational and entertainment services, namely, providing motivational speaking

¹³ See Applicant’s Brief, 4 TTABVUE 18-19; Office Action Response of June 24, 2021, at TSDR 110-142.

services in the field of passion, self-awareness, EQ-[e]motional [i]ntelligence, student and career success”) *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-14 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). The respective services are, therefore, legally identical.

Further, the Examining Attorney made of record 14 use-based third-party registrations of marks registered in connection with the same or similar services in Class 41 as those of both Applicant and Registrant.¹⁴ Although active third-party registrations are not evidence that the marks shown therein are currently in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind that may emanate from a single source under a single mark. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (finding that third-party registrations covering both wine and water were probative of the relatedness of those beverages). Thus, this additional evidence demonstrates that Applicant’s and Registrant’s Class 41 services are related.

b. Class 16 Goods

The Examining Attorney also made of record screen captures from five third-party websites showing that the same entities commonly manufacture, produce, or provide non-fiction books and educational and motivational speaking services and markets the goods and services under the same mark:

¹⁴ Third-party registrations, Office Action of January 19, 2021 at TSDR 9-41. *See* Reg. Nos. 3211181, 6222999, 6246617, 6236510, 6203929, 6214765, 6193328, 6207440, 6199180, 6231940, 6226152, 6238027, 6244546 and 6245108.

- youcanchoose.info – showing speaking services and an associated book offered under the same mark [Office Action of January 19, 2021, at TSDR 50-51].
- managingyourcrazy.com – showing professional development and education services and an associated book offered under the same mark [Office Action of January 19, 2021, at TSDR 52-54].
- fasterwaytofatloss.com – showing education services and an associated book offered under the same mark [Office Action of January 19, 2021, at TSDR 55-56].
- tonyrobbins.com – showing professional development and education services and a book offered under the same mark [Office Action of November 12, 2021, at TSDR 30-31].
- beyondei.inc – showing education services and a book offered under the same mark [Office Action of November 12, 2021, at TSDR 32-33].

Evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis ...” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *see also In re Integrated Embedded*, 120 USPQ2d at 1514 (“[Third-party] websites [made of record] demonstrate that services of the type offered by both Applicant ... and Registrant are marketed and sold together online under the same marks.”).

c. Summary

The evidence of record shows that Applicant’s Class 41 services are encompassed within Registrant’s Class 41 services; and that some, but not all, of Applicant’s Class 16 goods are related to Registrant’s services. However, it is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified services within that class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Under the second *DuPont* factor, we find Applicant’s goods and services and Registrant’s services are related, which in turn supports a finding that confusion is likely.

2. Channels of Trade and Potential Consumers

The third *DuPont* factor “considers [t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USPQ at 567). The trade channels factor considers the modalities and means (e.g., print, media, store aisles or shelves, or online) by which the respective goods and services are marketed, see *In re Majestic Distilling*, 65 USPQ2d at 1204, sold or distributed in relative proximity, see *Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

Because Applicant’s and Registrant’s Class 41 services are legally identical, we must therefore presume that the channels of trade and potential consumers are also identical. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 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 re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018).

Regarding the overlap of trade channels between Applicant’s Class 16 goods and Registrant’s Class 41 services, the Examining Attorney has supplied the proof we require, in the form of the five third-party websites listed above, showing that the same entities market and provide the same or similar goods and services as those of both Applicant and Registrant under the same mark through the same trade

channels.¹⁵ Target customers for Applicant's Class 16 materials are thus the same class of consumers who would afford themselves of Registrant's Class 41 educational services. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009) (where goods identified in applicant's application and in registrant's registration would be encountered by the same purchasers on the same websites, this overlap in trade channels supports a finding, under the third *DuPont* factor, that a likelihood of confusion exists). This is particularly so given that the identification of Class 16 goods in the Application and the Class 41 services in the cited Registration do not include any restrictions or limitations as to trade channels. We therefore presume the respective goods and services are or would be marketed in all normal trade channels for such services. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."); *In re Jump Designs*, 80 USPQ2d at 1374.

The record therefore shows that both Applicant's types of goods and services and Registrant's types of services are marketed and sold through the overlapping trade channels to the same target audience. The third *DuPont* factor, related and overlapping trade channels, supports a finding that confusion is likely.

¹⁵ Third-party websites, Office Action of January 19, 2021, at TSDR 50-56; Office Action of November 12, 2021, at TSDR 30-33.

C. Sales Conditions

“The fourth *DuPont* factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.’” *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that:

[I]n this case that both parties’ services are not impulse buys. ... They involve college-based and motivational learning services that would require research and cost evaluation before making a selection. ... Sophistication of purchasers is a factor used to test for likelihood of confusion, and in this case, there are factors that support careful selection of the parties’ services. ... Furthermore, with the costs of the services being prohibitively expensive, it is unlikely that consumers will choose either party’s services without careful consideration. ... In this case, the services are chosen after deliberation for both parties’ services, so each purchaser will take care in selecting these educational services.¹⁶

In support of these arguments, Applicant points to the significant tuition costs for Registrant’s educational services, and the multi-week time period for Applicant’s lectures that are provided to consumers on a limited availability basis.¹⁷

The Examining Attorney counters that the evidentiary record is insufficient to support Applicant’s arguments. Even if Applicant’s contentions are supported by the record, there are no limitations in the Application on appeal or the cited Registration as to the intended audience or purchasers of the goods or services.¹⁸

Where the purchasers consist of both professionals and the public, the standard of purchaser care is that of the least sophisticated potential buyer. *In re FCA US LLC*,

¹⁶ Applicant’s Brief, 4 TTABVUE 21-24.

¹⁷ Office Action Response of June 24, 2021, at TSDR 110, and 113-142.

¹⁸ Examining Attorney’s Brief, 6 TTABVUE 22.

126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion*, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 USPQ2d 375518 (Fed. Cir. 2019). We also cannot resort to extrinsic evidence to restrict the prices of Applicant's goods or services, or Registrant's services, or to distinguish the goods or services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Moreover, even with "careful purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods [or services], but will see the marks as variations of each other, pointing to a single source." *In re Hitachi High-Techs. Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014) (citing *Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992)). Given the similarity of Applicant's and Registrant's marks, these customers could easily, if mistakenly, infer that the source of the goods and services is the same.

We therefore find that sales conditions, the fourth *DuPont* factor, is neutral in our analysis.

II. Balancing the *DuPont* Likelihood of Confusion Factors

We find that the cited mark is entitled to the typical level of strength and scope of protection, afforded to a registered mark under Trademark Act Section 7(b). Applicant's evidence is insufficient to detract from this finding. We also find that Applicant's mark and Registrant's mark are similar in appearance, sound, meaning and commercial impression.

We further find that Applicant's goods and services and Registrant's services are related, and that the channels of trade and potential consumers overlap, based upon the evidence made of record. The conditions of sale is a neutral factor.

On balance, we find confusion is likely between Applicant's MAKE YOUR PASSION YOUR PAYCHECK mark and Registrant's MAKE YOUR PASSION YOUR PROFESSION mark for the identified goods and services.

Decision:

The refusal to register Applicant's mark MAKE YOUR PASSION YOUR PAYCHECK under Trademark Act Section 2(d) is affirmed in Classes 16 and 41.