

This Opinion is Not a
Precedent of the TTAB

Hearing: March 21, 2023

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Laxamentum Technologies, LLC
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Serial No. 90441532
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Wendy B. Mills of WB Mills, PLLC for Laxamentum Technologies, LLC.

William Verhosek, Trademark Examining Attorney, Law Office 114,
Nicole Nguyen, Managing Attorney.

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Before Lykos, Greenbaum, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Laxamentum Technologies, LLC (“Applicant”) seeks registration on the Principal Register of the standard-character mark GAMEGUARDIAN for “Downloadable computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running” in International Class 9, and “Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video

games, journals, previews, reviews and commentary on video games” in International Class 38.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark in Class 38 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the standard-character mark GUARDIAN GAMES (GAMES disclaimed), registered on the Principal Register for, among other services, “Retail games stores; Retail store services featuring games” in International Class 35,² as to be likely, when used in connection with the Class 38 services identified in Applicant’s application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. The case is fully briefed,³ and an oral hearing was held on March 21, 2023. We reverse the refusal to register.

¹ Application Serial No. 90441532 was filed on December 31, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claimed first use of the mark on March 28, 2012 and first use of the mark in commerce on April 19, 2012 in both classes.

² The cited Registration No. 5208681 issued on May 23, 2017. The Examining Attorney has based the final refusal to register solely on the Class 35 services identified in the cited registration.

³ Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant’s appeal brief appears at 6 TTABVUE and its reply brief appears at 9 TTABVUE. The Examining Attorney’s brief appears at 8 TTABVUE.

I. Record on Appeal⁴

The record on appeal includes Applicant's specimen of use, consisting of a page from its website at gameguardian.net;⁵ USPTO electronic records of the cited registration;⁶ a dictionary definition of the word "guardian;"⁷ pages from third-party websites regarding various video games, including webpages displaying a Guardian-formative mark and webpages from the websites of sellers of various games;⁸ pages from the cited registrant's website and Applicant's website;⁹ and USPTO electronic records of third-party registrations that the Examining Attorney argues cover both sets of the involved services.¹⁰

II. Analysis of Refusal

"The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive." *In re Charger Ventures LLC*, ___ F.4th ___, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) is based on an

⁴ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁵ December 31, 2020 Application at TSDR 3-4.

⁶ July 7, 2021 Office Action at TSDR 45-47.

⁷ *Id.* at TSDR 2-3.

⁸ *Id.* at TSDR 4-44; January 7, 2022 Response to Office Action at TSDR 7; January 27, 2022 Final Office Action at TSDR 65-105.

⁹ January 7, 2022 Response to Office Action at TSDR 8-15.

¹⁰ January 27, 2022 Final Office Action at TSDR 2-64.

analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). 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).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *29 (TTAB 2021), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant focuses primarily on the second key factor, the dissimilarity of the services, 6 TTABVUE 12-16, and also mentions the third *DuPont* factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 177 USPQ at 567, 6 TTABVUE 5, and the fourth factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567, 6 TTABVUE 5; 9 TTABVUE 4-5.¹¹

¹¹ In its appeal brief, Applicant simply recounts that during prosecution, it argued that “the purchasers of the goods and services were sophisticated and that the trade channels in which the parties operated their respective businesses were distinctly different,” 6 TTABVUE 5, but does not separately provide argument on those factors in its appeal brief. In its reply brief, Applicant lists the *DuPont* factors to show that the fourth factor is among them, 9 TTABVUE 4-5, but again does not provide argument or evidence on that factor. The Federal Circuit recently reiterated that the “Board is required to consider each factor for which there is evidence,” *Charger Ventures*, 2023 USPQ2d 451, at *4, but Applicant also did not provide any evidence regarding the channels of trade for the identified services, or the sophistication of consumers of those services, and we will “focus [our] analysis on dispositive factors.” *Id.*

A. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *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.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014)).

“The proper test regarding similarity ‘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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than a specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customers here are consumers of the service of “Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games,” which include members of the general public who are often colloquially referred to as “gamers.”

In its appeal brief, Applicant repeats arguments that it made during prosecution that “the two marks are not identical (GAMEGUARDIAN versus GUARDIAN GAMES),” 6 TTABVUE 5, and that “Applicant’s mark was singular and one word, rather than plural and two words like Registrant’s mark.” *Id.* at 9. Applicant also argues that the Examining Attorney “presented actual evidence as to only one *DuPont* factor,” the similarity of the services. *Id.* at 12.¹²

The Examining Attorney argues that Applicant’s “mark is merely the transposition of the registrant’s mark” and that “[c]onfusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions.” 8 TTABVUE 3 (citations omitted). He acknowledges “slight differences in appearances” between GAMEGUARDIAN and GUARDIAN GAMES resulting from the fact that the marks have different numbers of words, but suggests that the similarity of the marks in meaning outweighs any dissimilarities of the marks in appearance and sound. According to the Examining Attorney, “the marks have the same connotation whether transposed or not or in compound form or not because the term ‘game(s)’ is generic and ‘guardian’ merely means ‘one that guards, watches over, or protects,’” that “[t]aken together, the connotation means protector of games or game protector,” and that the “connotations of the mark are the same, and thus the marks create the same

¹² The Examining Attorney made of record a dictionary definition of the word “guardian” that is probative of the marks’ meaning. July 7, 2021 Office Action at TSDR 2-3. We are not certain what additional evidence Applicant believes would be relevant on the first *DuPont* factor given that 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 USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018).

commercial impression.” *Id.* at 4 (citations omitted). Finally, the Examining Attorney argues that the marks are similar because “a portion of the applied-for mark that is the singular, e.g., ‘game’ to the plural form, e.g., ‘games,’ of the registered mark is essentially identical in sound, appearance, meaning, and commercial impression,” and “thus the marks are confusingly similar.” *Id.*

The Examining Attorney rejects Applicant’s argument made during prosecution that “the marks are not identical and weak because it includes [sic] a generic term GAME(S) plus a commonly used term GUARDIAN which creates a different commercial impression from registrant’s mark.” *Id.* He argues that

the applicant’s marks [sic] share the same two terms GUARDIAN and GAME(S) and are the only marks with these two terms for similar services. The marks as a whole are suggestive and deemed protectable under Trademark laws. Moreover, the term GAME(S) used in the connection with the services are merely descriptive of the subject matter of applicant’s forums and registrant’s retail store, and thus not generic. That is, the applicant nor [sic] the registrant has identified any sort of gaming services. Therefore, the marks as a whole are arbitrarily used in connection with the respective services.

Id. at 5.¹³

As noted above, the Examining Attorney concedes “slight differences in appearances” between the marks, *id.* at 4, and the marks also differ somewhat in sound because the first portion of a mark “is most likely to be impressed in

¹³ Although Applicant does not address a third-party use of X-Box Halo Guardians that it made of record during prosecution, the Examining Attorney does, arguing that this single use of a “Guardian”-formative mark “is insufficient to show the weakness of the entire word mark that includes the combined terms GAME and GUARDIAN.” 8 TTABVUE 5. We agree. *Cf. Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *24 (TTAB 2021) (single third-party use found to be insufficient to show the commercial weakness of the petitioner’s mark).

purchasers' memories," *In re Dare Foods Inc.*, 2022 USPQ2d 291, at *10 (TTAB 2022) (citations omitted), and the first word heard when Applicant's mark is verbalized is "game," while the first word heard when the cited mark is verbalized is "guardian." *See also Charger Ventures*, 2023 USPQ2d 451, at *3.

The Examining Attorney argues that the marks are nonetheless confusingly similar because Applicant's GAMEGUARDIAN mark and the cited GUARDIAN GAMES mark share the words GUARDIAN and GAME(S) "in reverse or transposed order." *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *39 (TTAB 2022) (finding MADE IN NATURE and NATURE MADE to be similar). "Marks that include 'reverse combinations' of the same words or elements or a 'transposition' of the most important words comprising the marks have been found to be similar." *Id.* (citations omitted). "Where transposed marks convey similar commercial impressions, likelihood of confusion is ordinarily found." *Id.* (citations omitted).

The "reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions." *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (affirming refusal to register RUST BUSTER for rust-penetrating spray lubricant over BUST RUST for penetrating oil); *see also In re Wine Soc'y of Am., Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) ("Where the sole significant difference between the marks applied to similar goods or services is the transposition of the words which compose those marks and where the transposition of words does not change the overall commercial impression, confusion has been found."); *but see In*

re Best Prods. Co., 231 USPQ 988, 989-90 (TTAB 1986) (finding that BEST JEWELRY and design for retail jewelry stores services was not confusingly similar to JEWELERS' BEST for bracelets); *In re Akzona Inc.*, 219 USPQ 94, 95-96 (TTAB 1983) (finding that SILKY TOUCH for synthetic yarn and TOUCH O' SILK for men's clothing were not confusingly similar).

The transposed marks here convey dissimilar overall commercial impressions when they are considered in their entirety and in the context of the services for which they are used. *Cf. Embiid*, 2021 USPQ2d 577, at *17. Applicant's compound mark GAMEGUARDIAN for "Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games" connotes a person or thing that "guards, watches over, or protects" a game.¹⁴ The cited GUARDIAN GAMES mark for "Retail games stores; Retail store services featuring games" connotes a brand of retail stores selling multiple games, or the "family" name of the games, rather than, as the Examining Attorney claims, a "protector of games or game protector." 8 TTABVUE 4.¹⁵

"Similarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing*

¹⁴ July 7, 2021 Office Action at TSDR 2 (THE AMERICAN HERITAGE DICTIONARY).

¹⁵ Although "GAMES" is disclaimed in the cited mark because it is merely descriptive of the retail store services, in comparing the meanings of the marks in their entirety, we must consider the impact of the word GAMES in the cited mark because its disclaimer "has no legal effect on the issue of the likelihood of confusion" because the public is unaware what words have been disclaimed." *Charger Ventures*, 2023 USPQ2d 451, at *5.

Co., 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). We find that the marks GAMEGUARDIAN and GUARDIAN GAMES are more dissimilar than similar in appearance, sound, and connotation and commercial impression, and the first *DuPont* factor supports a finding of no likelihood of confusion.

B. Similarity or Dissimilarity of the Services

“The second *DuPont* factor ‘considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration’” *Embiid*, 2021 USPQ2d 577, at *22 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018)).

The services “need not be identical or even competitive to find a likelihood of confusion.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *4 (TTAB 2019) (citations omitted). “They need only be ‘related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [they] emanate from the same source.’” *Id.* (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal quotation omitted)).

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods [or services] are used together or used by the same purchasers; advertisements showing that the relevant goods [or services] are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods [or services] and the goods [or services] listed in the cited registration.” *Embiid*, 2021 USPQ2d 577, at

*22-23. In addition, “[t]he application and registration themselves may provide evidence of the relationship between the services.” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *14 (TTAB 2023) (citations omitted). *See also Country Oven*, 2019 USPQ2d 443903, at *6 (finding that “the identifications in the application and registration themselves support finding the goods and services are related.”).

The cited registration covers “Retail games stores; Retail store services featuring games,” while the application covers “Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games.”

Recounting arguments that it made during prosecution, Applicant argues that “it would be unreasonable for a consumer to believe that because Applicant and Registrant both relate to ‘games,’ that their goods and services emanate from the same source.” 6 TTABVUE 5. Applicant points to the registrant’s specimens of use, which Applicant claims shows that “its website only promotes its one brick-and-mortar store located in Portland, Oregon for reserving rooms to play games (not video games) and card games in-person at Registrant’s store.” *Id.* at 6. Applicant argues that the Examining Attorney “did not reference the Applicant’s and Registrant’s website screenshots that were attached as specimens to their respective applications, which clearly show the goods and services are not likely to cause confusion with any reasonable consumer, such that the consumer would believe that the goods and services emanate from the same source.” *Id.* Applicant further argues that the user

of its website is “not the consumer, the advertisers who purchased advertising to be featured on Applicant’s website were the end consumers and as such, they are necessarily sophisticated and are unlikely to be confused as to the source or origin of the goods and services offered by Applicant.” *Id.* at 6-7.¹⁶

According to Applicant,

there is a specific meaning to members of the (video) gaming trade for the term, “**cheats**” as it relates to determining the source code to help others strategize and play games effectively and in this case, it is only for use on Androids. Therefore, the card games and games referenced in Registrants [sic] specimens and goods/service identification are clearly unlikely to be confused with video game cheats or strategies that are also discussed in Applicant’s online forum.

Id. at 12-13 (emphasis in boldface originally supplied by Applicant in italics).

Applicant also accuses the Examining Attorney of arguing improperly that “there is a zone of expansion reserved for Registrant for use of a ‘forum’ similar to that of Applicant’s,” *id.* at 13, because “Registrant’s application does not identify anything relating to video games, forums or cheat codes” and Applicant’s and the registrant’s websites “are not likely to cause confusion as to the source of origin of Applicant’s goods or services.” *Id.* at 14. Applicant claims that because “Registrant’s registration clearly identifies only games (not video games), card games and games that are played in-person at Registrant’s one brick-and-mortar store located in Portland, Oregon (as depicted in Registrant’s specimen),” the Board “should find that

¹⁶ This argument is belied by the identification of Applicant’s services itself, which makes it clear that the website forum services are consumed by gamers, not advertisers.

Applicant's use of its mark in association with its identified goods and services **is not likely to cause confusion.**" *Id.* (emphasis supplied by Applicant).

Finally, Applicant acknowledges that the Examining Attorney "presented a number of third-party marks which were registered for use in connection with online forums [and] also provide retail stores, both featuring video games, like the registrant," but argues that the "Board has previously rejected a similar argument," citing a non-precedential decision, *In re The Pilot Funds*, Serial No. 74551253, 1998 WL306484 (TTAB June 5, 1998), 6 TTABVUE 15, which we discuss below.¹⁷ Applicant concludes that "while Examiner [sic] attached numerous registrations of other trademark holders that own retail stores and have forums, Examiner [sic] still fails to show how Registrant is similar to Applicant and to the third-party registrants." *Id.*

The Examining Attorney responds that the relatedness analysis "is not dependent on the location of the parties, how the services are performed, e.g., 'live card games,' nor even if 'video games' are sold by the registrant," 8 TTABVUE 6, and that he "submitted ten third party websites (and additionally an eleventh website referencing applicant's online evidence from 'X-Box Halo Guardians' noted above) and fifteen third party registrations establishing that companies like the applicant that provide

¹⁷ The Board recently addressed the citation of non-precedential decisions in *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249 (TTAB 2022). The Board noted that since 2007, it "has permitted citation to any Board decision or interlocutory order, although a decision or order designated as not precedential is not binding upon the Board, but may be cited for whatever persuasive value it might have, *id.*, at *7, but cautioned that the Board generally "discourages the citation to non-precedential decisions," *id.*, and that "[c]iting nonprecedential cases should be done judiciously and rarely." *Id.*, at *9.

online forums also provide retail stores, both featuring video games, like the registrant,” *id.*, that this “evidence shows that applicant’s and registrant’s services overlap and are commonly available from a single source,” *id.*, and that “the relevant consumers are likely accustomed to encountering ‘online forums and retail stores featuring video games’ emanating from the same source and offered under the same mark.” *Id.* at 6-7. He further argues that “the registrant’s services of ‘retail stores’ is broad enough to include ‘online retail stores’ and its subject matter goods of ‘games’ are broad and includes the more specific subject matter goods in applicant’s identification of services, ‘video games.’” *Id.* at 7. He also rejects Applicant’s arguments regarding the evidentiary value of third-party registrations and the alleged “zone of expansion” claim. *Id.* at 7-8.

We “begin with the identifications of [services] . . . in the registration and application under consideration.” *Country Oven*, 2019 USPQ2d 443903, at *5. Applicant correctly acknowledges that where, as here, “the identification of goods or services does not limit ‘their nature . . . it is presumed that the registration encompasses all goods or services of the type described” 6 TTABVUE 16 (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1207.01(a)(iii)). Indeed, we must construe the services identified in the cited registration as broadly as reasonably possible “to include all [services] of the nature and type described therein,” *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (quoting *In re Jump Design LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)), and we must resolve any ambiguities regarding their coverage in favor of the owner of the cited

registration “given the presumptions afforded the registration under Section 7(b)” of the Trademark Act. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015 (citing 15 U.S.C. § 1057(b))). We must similarly consider the “full scope” of the services identified in the application. *Country Oven*, 2019 USPQ2d 443903, at *9.

The services identified in the cited registration as “Retail games stores; Retail store services featuring games” contain no restrictions on what Applicant calls “their nature.” 6 TTABVUE 16. Construing the services as broadly as reasonably possible, we must deem them to include both online and brick-and-mortar world “retail games stores” and “retail store services featuring games,” and we must deem the “games” sold and featured in those retail stores to encompass all types of games, including video games. Applicant’s reliance on the registrant’s website to try to limit the scope and nature of the services identified in the cited registration is a textbook example of the improper use of extrinsic evidence to try to restrict an unrestricted identification. “[W]e may not import restrictions into the identification[] based on alleged real world conditions of the sort argued by Applicant . . . or consider extrinsic evidence regarding Applicant and Registrant themselves.” *Embiid*, 2021 USPQ2d 577, at *28 (quotations and quotation marks omitted).¹⁸ Accordingly, in assessing the evidence of

¹⁸ In *Embiid*, the Board noted that “[i]n innumerable cases, the Board hears arguments about how the parties’ **actual** goods [or] services . . . are narrower or different from the goods and services identified in the applications and registrations,’ but ‘as stated in equally innumerable decisions of our primary reviewing court, we may consider any such restrictions only if they are included in the identification of goods or services.’” *Embiid*, 2021 USPQ2d 577, at *28 n.38 (quoting *In re FCA US LLC*, 126 USPQ2d 1214, 1217 n.18 (TTAB 2018) (emphasis in boldface originally in italics in *FCA US*)).

relatedness, we must compare online retail store services featuring video games with the services identified in Applicant's application.¹⁹

The Examining Attorney's evidence of relatedness consists of third-party websites and registrations, which he argues establish "that companies like the applicant that provide online forums also provide retail stores, both featuring video games, like the registrant." 8 TTABVUE 6.

We begin with the registration evidence. The Examining Attorney made of record multiple third-party registrations covering some form of retail store services in Class 35 and some form of online forum services in Class 38.²⁰ In considering this evidence, "[j]ust as we must consider the full scope of the . . . services as set forth in the application and registration under consideration, we must consider the full scope of the . . . services described in a third-party registration." *Country Oven*, 2019 USPQ2d 443903, at *9. As a result, we must construe the Class 38 services identified in several of the registrations discussed below as "Providing on-line forums for transmission of messages among computer users" as encompassing messages regarding video games because there is no limitation as to the subject matter of the messages.

¹⁹ Just as we may not read into the unrestricted identifications in the cited registration any restrictions on the scope of the services, we may not read into that geographically unrestricted registration any restrictions on the registrant's exclusive nationwide right to use the registered mark in commerce for the identified services. *See, e.g., Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983).

²⁰ These registrations cover numerous services in both Class 35 and Class 38. Examining attorneys should specify the particular goods or services within a class that they believe to be pertinent to relatedness either by highlighting them in the copies of the registrations that they make of record or by referring to them specifically in their briefs. Failure to do so makes it unnecessarily difficult to review this evidence.

The third-party registrations in the record include:

- Registration No. 4863732 (“Retail store services featuring . . . video games” in Class 35 and “Providing online forums for communication in the field of electronic games” in Class 38);²¹
- Registration No. 5510740 (“Retail store services featuring video game programs . . .” and “on-line retail store services featuring . . . video games” in Class 35 and “Providing on-line forums for transmission of messages among computer users” in Class 38);²²
- Registration No. 5656255 (“Retail store services featuring video game programs” and “on-line retail store services featuring . . . video games” in Class 35 and “Providing online forums for transmission of messages among computer users” in Class 38);²³
- Registration No. 5344342 (“Retail store services in the field of computer programs featuring games . . .” in Class 35 and “Providing an on-line forum for users to discuss . . . games, computer games . . .” in Class 38);²⁴
- Registration No. 5250041 (“On-line retail store services featuring computer software, namely, . . . video games” in Class 35 and “Providing online forums for transmission of message among computer users” in Class 38);²⁵
- Registration No. 5329056 (“Retail store services featuring . . . game software” in Class 35 and “Online forums for transmission of message among computer users” in Class 38);²⁶
- Registration No. 6015375 (“On-line . . . retail store services featuring downloadable . . . game files” in Class 35 and “Providing on-line forums for transmission of messages among computer users” in Class 38);²⁷

²¹ January 27, 2022 Final Office Action at TSDR 5.

²² *Id.* at TSDR 13-14.

²³ *Id.* at TSDR 17-18. This registration is for the mark NEXTERS, which we discuss below in connection with the Examining Attorney’s third-party use evidence.

²⁴ *Id.* at TSDR 21-22. This registration is for the mark STARDOCK, which we discuss below in connection with the Examining Attorney’s third-party use evidence.

²⁵ *Id.* at TSDR 24-25.

²⁶ *Id.* at TSDR 28-29.

²⁷ *Id.* at TSDR 56-57.

- Registration No. 6015377 (“On-line . . . retail store services featuring downloadable . . . game files” in Class 35 and “Providing on-line forums for transmission of messages among computer users” in Class 38);²⁸ and
- Registration No. 6556267 (“On-line retail store services featuring video games and computer game software products and services” in Class 35 and “Providing online forums and chat rooms for the transmission of messages, comments and multimedia context among users in the fields of gaming . . .” in Class 38).²⁹

“As a general proposition, third-party registrations that cover goods and services from both the cited registration and an Applicant’s application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark.” *Country Oven*, 2019 USPQ2d 443903, at *8. The Examining Attorney’s “registrations are sufficient in both quality and quantity to provide a reasonable predicate supporting the Examining Attorney’s position on relatedness and shift the burden to Applicant to rebut the evidence with competent evidence of its own.” *Id.*, at *10. Applicant did not do so.³⁰

²⁸ *Id.* at TSDR 59-60.

²⁹ *Id.* at TSDR 62-63.

³⁰ Applicant does not address the registration evidence per se, but instead, as discussed above, cites the Board’s non-precedential decision nearly 25 years ago in *Pilot Funds*. 6 TTABVue 15. In that case, a divided panel reversed a refusal to register THE PILOT FUNDS for a “mutual fund investment service offered to bank and trust company customers” based on a registration of PILOT PLUS for “security brokerage services; namely, securities executions in a brokerage account on an annual fee basis in lieu of commissions on individual transactions.” The majority discounted the examining attorney’s evidence of third-party registrations covering both mutual funds and securities brokerage services because the examining attorney had not provided a real-world rationale for how confusion was likely to occur. *Pilot Funds*, 1998 WL 306484, at *2. As discussed above, we are not bound by this decision, and we decline to follow its analysis of the probative value of third-party registration evidence because it is inconsistent with the Board’s holding in *Country Oven* that “we must consider the full scope of the goods and services described in a third-party registration” because “the benefits of registration are commensurate with the scope of the goods [or services] specified in the certificate of registration” and “a registration that describes goods [or services] broadly is presumed to encompass all goods or services of the type described.”

The Examining Attorney also submitted third-party use evidence in the form of pages from multiple websites,³¹ which he argues establish that “companies like the applicant that provide online forums also provide retail stores, both featuring video games, like the registrant,” and that “the relevant consumers are likely accustomed to encountering ‘online forums and retail stores featuring video games’ emanating from the same source and offered under the same mark.” 8 TTABVUE 6.

Several of the websites do not offer either a discussion forum or the ability to purchase games (or both),³² and thus have no probative value on the relatedness of the involved services. The websites at gearboxsoftware.com,³³ ubisoft.com,³⁴ epicgames.com,³⁵ square-enix.com,³⁶ and steampowered.com,³⁷ however, offer forums

Country Oven, 2019 USPQ2d 443903, at *9 (citing *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)).

³¹ The Examining Attorney also cites the X-Box Halo Guardians website submitted by Applicant, which we discuss below.

³² The masthead of the gfinityesports.com website displays the headings “Gaming News,” “Guides,” “Features,” “Reviews,” “Esports News,” and “Deals,” and the body of the site contains what appear to be links to articles about various video games and a reference list of such games, but it is not clear that the site allows the purchase of games. July 7, 2021 Office Action at TSDR 4-34. The website at nexters.com, owned by a European game company, focuses on describing the company and its upcoming initial public offering, and encouraging potential employees to join the company. It offers neither a user forum nor a means to purchase games. *Id.* at TSDR 35-40. The masthead of the website at stardock.com, owned by a software development company that has developed various video games, displays various headings including “Games” and “Community,” but the pages in the record do not show any discussion forums and it is not clear that visitors are able to purchase games. *Id.* at TSDR 41-44. The website at blizzard.com offers a forum for discussion, but does not allow the purchase of games. *Id.* at TSDR 97-99.

³³ January 27, 2022 Final Office Action at TSDR 65-71.

³⁴ *Id.* at TSDR 72-80.

³⁵ *Id.* at TSDR 81-88.

³⁶ *Id.* at TSDR 89-96.

³⁷ *Id.* at TSDR 97-105.

for the discussion of video games and allow the online purchase of games, in essence functioning partially as online “retail games stores.”³⁸ These websites have probative value in establishing the relatedness of the services and against the backdrop of the third-party registration evidence discussed above, “this evidence bolsters our finding of relatedness.” *Country Oven*, 2019 USPQ2d 443903, at *11.

We find that the second *DuPont* factor supports a finding of a likelihood of confusion.

C. **Weighing the Two Key *DuPont* Factors**

We have found above that the marks are more dissimilar than similar, but that the services are related. These findings point us in opposite directions in the likelihood of confusion analysis, so we must “weigh the *DuPont* factors used in [our] analysis **and** explain the results of that weighing.” *Charger Ventures*, 2023 USPQ2d 451, at *7 (emphasis in boldface originally in italics).

“In any given case, different *DuPont* factors may play a dominant role,” *id.*, at *4, and the “weight given to each factor depends on the circumstances of each case.” *Id.* (citation omitted). A “single *DuPont* factor may, for example, be dispositive of the likelihood of confusion analysis.” *Id.* (citing *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1999) (affirming Board’s grant of summary judgment to the applicant based on Board’s conclusion that the

³⁸ The page from the Halo 5: Guardians website made of record by Applicant, January 7, 2022 Response to Office Action at TSDR 7, displays headings captioned “Games” and “Community,” but neither Applicant nor the Examining Attorney made of record pages accessed through those links, so we cannot be certain that the headings link to forums and pages on which visitors can purchase games online.

dissimilarity of the marks FROOT LOOPS and FROOTIE ICE in their entireties “made it unlikely that confusion would result from the simultaneous use of the marks.”)).

We find here that the dissimilarity of the marks outweighs the similarity of the services in our analysis of whether a consumer with a general rather than specific impression of the cited GUARDIAN GAMES mark for retail stores services featuring video games, who separately encounters Applicant’s GAMEGUARDIAN mark for a website forum relating to video games, is likely to believe mistakenly that those services have a common source or sponsorship. The marks are sufficiently dissimilar to make confusion unlikely when used in connection with related, but not identical, services.

Decision: The refusal to register is reversed and the application will proceed to publication for opposition in THE OFFICIAL GAZETTE in both Class 9 and Class 38.