U.S. Application Serial No. 90501168  
Mark: BLACK BELT  

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Reference/Docket No. N/A  

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EXAMINING ATTORNEY’S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the following three applications under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) for the marks: (1) BLACK BELT (Serial No. 90501147, hereinafter the "'1147 Mark") on the basis that it is confusingly similar to Registration Nos. 3897278, 5394605, and 6357703; (2) BLACK BELT (Serial No. 90501155, hereinafter the "'1155 Mark") on the basis that it is confusingly similar to Registration Nos. 4498366 and 5543145, both owned by Chikaranomoto Holdings Co., Ltd.; and (3) BLACK BELT (Serial No. 90501168, hereinafter the "'1168 Mark") on the basis that it is confusingly similar to Registration No. 4482561.
FACTS

On February 1, 2021, applicant filed the three applications that are the subject of this consolidated appeal, each for the mark BLACK BELT in standard characters: the '1147 Mark for use in connection with a variety of advertising and promotional services in Class 35; the '1157 Mark for use in connection with a variety of hotel and restaurant services in Class 43; and the '1168 Mark for use in connection with a variety of construction services, real estate development services, and consulting and advisory services related thereto in Class 37. The examining attorney submitted a Motion to Consolidate the appeals for each of applicant's three BLACK BELT applications which was granted on December 20, 2022.

Serial No. 90501147

On August 31, 2021, the examining attorney issued an Office action partially refusing registration of the '1147 Mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that applicant's mark is likely to cause confusion with the marks BUSINESS BLACK BELT (Registration No. 3897287), BLACKBELT COMMERCE (Registration No. 5394605), and AGILE BLACK BELT CONSULTING (Registration No. 6357703). Applicant submitted a response with evidence and arguments against the refusal on February 28, 2022.

On March 24, 2022, the examining attorney issued a partial final refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with respect to the three registrations cited in the first Office action.

On June 15, 2022, applicant submitted a Request for Reconsideration containing additional arguments against the refusal, which was denied by the examining attorney on July 13, 2022.

On September 6, 2022, applicant filed a second Request for Reconsideration concurrently with a timely notice of appeal. This Request for Reconsideration was denied by the examining attorney on September 28, 2022, and the appeal was resumed.

As a preliminary matter, after further consideration of the facts of this case, the examining attorney believes it appropriate to withdraw Registration No. 5394605 (BLACKBELT COMMERCE) as a bar to registration. Accordingly, the refusal is maintained only as to Registration Nos. 3897287 (BUSINESS BLACK BELT) and 6357703 (AGILE BLACK BELT CONSULTING).

Serial No. 90501155
On August 27, 2021, the examining attorney issued an Office action partially refusing registration of the '1155 Mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that applicant's mark is likely to cause confusion with a mark comprising Japanese characters that translate to "BLACK BELT" (Registration No. 4498366) and the mark KURO-OBI, also translating to "BLACK BELT" (Registration No. 5543145) (hereinafter collectively referred to as the "Chikaranomoto Marks"). Applicant submitted a response with evidence and arguments against the refusal on January 29, 2022.

On February 22, 2022, the examining attorney issued a partial final refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with respect to the Chikaranomoto Marks, to which applicant replied with a Request for Reconsideration on June 15, 2022. The examining attorney denied this Request for Reconsideration on July 13, 2022.

On August 22, 2022, applicant filed a second Request for Reconsideration concurrently with a timely notice of appeal. The examining attorney denied this second Request for Reconsideration on October 12, 2022, and the appeal was resumed.

**Serial No. 90501168**

On August 27, 2021, the examining attorney issued an Office action refusing registration of the '1168 Mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that applicant's mark is likely to cause confusion with the mark BLACKBELT in Registration No. 4482561. Applicant submitted a response with evidence and arguments against the refusal on January 28, 2022.

On February 16, 2022, the examining attorney issued a final refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with respect to the BLACKBELT mark, to which applicant replied with a Request for Reconsideration on June 15, 2022. The examining attorney denied the Request for Reconsideration on July 13, 2022.

On August 16, 2022, applicant filed a second Request for Reconsideration, concurrently with a timely notice of appeal. The examining attorney denied this second Request for Reconsideration on September 8, 2022 and the appeal was resumed.

**ISSUE ON APPEAL**

The sole issue on appeal is whether the applied-for BLACK BELT marks should be denied
registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because of a likelihood of confusion with the registered marks cited in the respective applications.

ARGUMENT

I. APPLICANT'S AND REGISTRANT'S MARKS ARE HIGHLY SIMILAR AND THE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT

A. Legal Considerations for a Likelihood of Confusion Analysis

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “du Pont factors”). In re i.am.symbolic, llc, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the DuPont factors are relevant or of similar weight in every case.” In re Guild Mortg. Co., 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting In re Dixie Rests., Inc., 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

There are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared services. See In re i.am.symbolic, llc, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting Herbko Int’l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and differences in the marks.”); TMEP §1207.01.

B. Applicant's Marks Are Confusingly Similar to the Registered Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin
Maison Fondee En 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “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) (citing In re Davia, 110 USPQ2d 1810, 1812 (TTAB 2014)), aff’d per curiam, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

1. The ’1147 Mark is Confusingly Similar to the Registered Marks AGILE BLACK BELT CONSULTING and BUSINESS BLACK BELT

Applicant's mark and the registered marks AGILE BLACK BELT CONSULTING and BUSINESS BLACK BELT are similar because they all share the dominant term BLACK BELT; indeed, the entirety of applicant's mark appears in each of the registered marks. Although applicant’s mark does not contain the entirety of the registered marks, applicant’s mark is likely to appear to prospective purchasers as a shortened form of the registrants’ marks. See In re Mighty Leaf Tea, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting United States Shoe Corp., 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. See In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257; In re Optica Int’l, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant’s mark does not create a distinct commercial impression from the registered marks because it contains some of the wording in the registered marks but does not add any wording that would distinguish it from them.

Further, the wording BLACK BELT is the dominant portion of each of the marks such that the inclusion of additional wording or design elements (as are present in AGILE BLACK BELT CONSULTING, for example) does not obviate the otherwise similar nature of these marks. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); In re Nat’l Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. See In re Detroit Athletic Co., 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing In re Dixie Rests., 105 F.3d
at 1407, 41 USPQ2d at 1533-34); \textit{Made in Nature, LLC v. Pharmavite LLC}, 2022 USPQ2d 557, at *41 (TTAB 2022); TMEP §1207.01(b)(viii), (c)(ii). Here, Registration No. 3897278 disclaims BUSINESS and Registration No. 6357703 disclaims CONSULTING. Accordingly, even to the extent that consumers recognize that the registered marks do contain these additional words, consumers will nevertheless perceive this additional wording as being less significant in terms of the marks' overall impressions because it merely indicates to consumers some aspect of the services (e.g., involving consulting or related to business).

Additionally, although the mark AGILE BLACK BELT CONSULTING contains the non-descriptive word AGILE and the design of a martial arts black belt, this mark is stylized such that the words BLACK BELT and the accompanying design dominate the mark's overall impression. Specifically, the wording BLACK BELT and the black belt design appear as the largest elements in the mark compared to the words AGILE and CONSULTING, which appear in a small text size above and below the BLACK BELT words and design. As noted above, one feature of a mark may be more significant or dominant in creating a commercial impression, and greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See \textit{In re Detroit Athletic Co.}, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing \textit{In re Dixie Rests.}, 105 F.3d at 1407, 41 USPQ2d at 1533-34). Accordingly, the dominant portions of both the registered marks AGILE BLACK BELT CONSULTING and BUSINESS BLACK BELT is the term BLACK BELT, which is identical to the entirety of applicant's mark.

Comparing the marks on the whole, consumers will perceive applicant's BLACK BELT mark and the registered marks AGILE BLACK BELT CONSULTING and BUSINESS BLACK BELT as having the same overall commercial impression, namely, of the rank of "black belt" in one of the martial arts. This impression is further reinforced in the AGILE BLACK BELT CONSULTING mark because of the black belt design also present in this mark. Applicant's and the registrants' marks are therefore considered highly similar for likelihood of confusion purposes.

2. The '1155 Mark is Confusingly Similar to the Registered Marks Which Mean "BLACK BELT" in English
The Chikaranomoto Marks are confusingly similar to applicant's mark BLACK BELT because applicant's mark is the direct and literal translation of each of the registered marks. Specifically, the registered marks are (1) a pair of Kanji characters that translate to "Black Belt" in English, and (2) the wording KURO-OBI, which is the Latin-character transliteration of the Kanji characters in the registrant's Kanji mark. Both of these marks are in Japanese, which is a common, modern language in the United States. See In re Tokutake Indus. Co., 87 USPQ2d 1697 (TTAB 2008). Further, evidence from the U.S. Census and worlddata.gov shows that there are at least 500,000 Japanese speakers in the United States. February 22, 2022 Office Action, Serial. No. 90501155, TSDR at 6–8, 34. Additionally, Japanese language classes are popular among U.S. college students to the point that Japanese is the fifth most commonly taught language in the United States. February 22, 2022 Office Action, Serial No. 90501155, TSDR at 35–36.

Under the doctrine of foreign equivalents, a mark in a common, modern foreign language and a mark that is its English equivalent may be held confusingly similar. TMEP §1207.01(b)(vi); see, e.g., In re Aquamar, Inc., 115 USPQ2d 1122, 1127-28 (TTAB 2015); In re Thomas, 79 USPQ2d 1021, 1025 (TTAB 2006). Consequently, marks comprised of foreign wording are translated into English to determine similarity in meaning and connotation with English word marks. See Palm Bay, 396 F.3d at 1377, 73 USPQ2d at 1696. Equivalence in meaning and connotation may be sufficient to find such marks confusingly similar. See In re Aquamar, Inc., 115 USPQ2d at 1127-28; In re Thomas, 79 USPQ2d at 1025.

The doctrine is applied when “the ordinary American purchaser” would “stop and translate” the foreign term into its English equivalent. Palm Bay, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting In re Pan Tex Hotel Corp., 190 USPQ 109, 110 (TTAB 1976)); TMEP §1207.01(b)(vi)(A). The ordinary American purchaser includes those proficient in the foreign language. In re Spirits Int’l, N.V., 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); see In re Thomas, 79 USPQ2d at 1024. In this case, the ordinary American purchaser would stop and translate the Chikaranomoto Marks because they are in Japanese and Japanese is a common, modern language spoken by an appreciable number of consumers in the United States.

Registrant's Kanji character mark directly and literally translates to the English term "Black Belt". This is supported both by registrant's transliteration statement and by the translation evidence in the
The wording KURO-OBI, as a transliteration of these Japanese Kanji characters, also means "Black Belt." The Board recently reviewed the significance of wording comprising a transliteration of foreign wording and found that such wording must be considered a foreign term. *In re Advanced New Tech., Co., Ltd.*, 2023 USPQ2d 60 (TTAB 2023) (finding that the transliterated wording ZHIMA is equivalent in meaning to the Chinese characters pronounced ZHIMA and translating to "sesame" where the evidence of record showed the transliteration ZHIMA is used commonly to refer to "sesame" in the marketplace). Following *Advanced New Tech.*, even to the extent that the English transliteration KURO-OBI is not technically in the foreign language (i.e., it is not written in Kanji), the evidence of record establishes that U.S. consumers will perceive this transliteration as being equivalent to its Japanese-character counterpart. In particular, the Board will note the following evidence showing English language websites using the term "kuro-obi" to refer specifically to "black belts" in martial arts, in some cases as a standalone term without any specific reference to the Kanji characters represented by the Kanji characters pronounced "Kuro" and "Obi":

- *Kimonosport*, "For the uninitiated, Kuro Obi literally means Black Belt . . . in English . . . " (October 12, 2022 Request for Reconsideration Denial Letter, Serial No. 90501155, TSDR at 5)
- *Jikandojo*, "Kuro Obi - The Black Belt" (*Id.* at 6)
- *StockKanji*, "The Japanese word kuroobi meaning 'Black Belt' is composed of the kanji [] (read kuro) meaning 'black' and [] (read obi) meaning 'belt' and refers to a Black Belt as awarded in such Martial Arts disciplines as Judo and Karate." (*Id.* at 8) (emphasis in original)
- *Learnthesword* at YouTube.com, "The Kuro-Obi Black Belt Series by Century Martial Arts" (*Id.* at 9)
- *Japan Karate Association Arizona*, "Kuro-obi: black belt, refers to those who have mastered the basic techniques and beyond" (*Id.* at 11)
- *Premier Martial Arts*, ". . . the next level of karate knowledge is knowing the Japanese term for black belt: kuro obi." (*Id.* at 12) (emphasis in original)
It is also significant that unlike the application in *Advanced New Tech.*, Registration No. 5543145 contains a translation statement explicitly stating that KURO-OBI means "black belt". Accordingly, the direct English equivalent of each of the Chikaranomoto Marks is identical to the applied-for mark.

Applicant argues that the doctrine of foreign equivalents does not apply in this case because the circumstances in which consumers encounter the registrant's marks are such that the registered marks are likely to be taken at face value. In particular, applicant argues that because the registrant's restaurants are overtly Japanese themed, consumers will simply accept the Japanese wording in the Chikaranomoto Marks as-is. Applicant's Appeal Brief, Serial No. 90501155, at 14–15. However, applicant has not provided any evidence in support of this claim. Thus, based on the evidence that is in the record, the status of Japanese as a common modern language spoken by an appreciable number of consumers in the United States instead makes it likely that such wording would be translated, regardless of the decor of applicant's restaurants. Further, because the marks are identical in meaning, the practical differences in the appearance and pronunciation of applicant's BLACK BELT mark and the Chikaranomoto Marks are outweighed by their identical meanings. *See generally In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649-50 (TTAB 2008). Accordingly, the doctrine of foreign equivalents does apply and applicant's mark is confusingly similar to the Chikaranomoto Marks because they are direct and literal foreign equivalents.

3. The '1168 Mark is Essentially Identical to the Registered Mark BLACKBELT

The '1168 Mark and the registered mark BLACKBELT are identical except for a slight difference in appearance between registrant's mark, which appears as a compound word with no space separating the words, that is, BLACKBELT; and applicant’s mark, which appears as two words with space separating the words, that is, BLACK BELT. As such, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. *See, e.g.*, *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Stock Pot,
Inc., v. Stockpot Rest., Inc., 220 USPQ 52, 52 (TTAB 1983), aff’d 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

4. Applicant's Argument that the Meaning of the Term "BLACK BELT" in the Applied-for Marks Differs from the Meaning of the Term "BLACK BELT" in Each of the Cited Registrations is Unpersuasive

In each of applicant's three appeal briefs, applicant maintains its argument that despite sharing the dominant term "BLACK BELT", the applied-for and registered marks nevertheless have different meanings such that consumers will not perceive them as conveying the same overall commercial impression. In particular, applicant argues that applicant's BLACK BELT marks are intended to (and purportedly do) convey the idea of the "Black Belt", a region of the southern United States extending across central Alabama and Mississippi known for its black soil and historical significance during the Civil Rights movement. Applicant's Appeal Brief, Serial No. 90501147, at 14–16; Applicant's Appeal Brief, Serial No. 90501155, at 15–16; Applicant's Appeal Brief, Serial No. 90501168, at 10–12. Applicant contrasts this with the usage of this term in the registered marks, which applicant asserts refers exclusively to the registrants' level of skill in providing their respective services. Id.

In determining the likelihood of confusion under Trademark Act Section 2(d), marks are compared as they appear in the drawing of the application and in the registration; the USPTO does not consider how an applicant and registrant actually use their marks in the marketplace. In re Aquitaine Wine USA, LLC, 126 USPQ2d 1181, 1186 (TTAB 2018) (citing In re i.am.symbolic, llc, 866 F.3d at 1324, 123 USPQ2d at 1749). Applicant's marks are all in standard characters; the drawings contain no stylization or design beyond the plain words "BLACK BELT". Based on the drawings of applicant's marks, there is nothing to suggest that a consumer would perceive the applied-for marks as referencing a particular geographic region over perceiving the mark as a reference to martial arts. In fact, the latter is arguably more likely because it appears to be the more well-known meaning. See, e.g., Merriam-Webster Dictionary, "Black belt", February 16, 2022 Office Action, Serial No. 90501165, TSDR at 123 (showing the primary definition of "black belt" is "one who holds the rating of expert in various arts of self-defense"). Further, even to the extent that, for example, AGILE BLACK BELT CONSULTING and the Chikaranomoto Marks appear more overtly unrelated to the historical meaning of "Black Belt"
advanced by applicant, at best applicant's marks are at least equally as likely to convey the concept of the martial arts rank as they are to convey applicant’s preferred meaning. Regardless of which meaning consumers ascribe to the marks, however, applicant has still not adduced any evidence to support its implicit assertion that consumers will arbitrarily assign different meanings to the same term based only on the fact that it appears in applicant's marks on the one hand and in registrants' marks on the other. Applicant's argument is therefore unpersuasive.

C. The Services in the Applications are Related to the Services in the Respective Cited Registrations

In a likelihood of confusion analysis, the services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); Herbko Int'l, Inc., 308 F.3d at 1165, 64 USPQ2d at 1381; TMEP §§1207.01, 1207.01(a)(vi). The compared 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, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). 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 [the services] emanate from the same source.” Coach Servs., Inc., 668 F.3d at 1369, 101 USPQ2d at 1722 (quoting 7-Eleven Inc. v. Wechsler, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i); see Made in Nature, 2022 USPQ2d at *44 (quoting In re Jump Designs LLC, 80 USPQ2d 1370, 1374 (TTAB 2006)). Notably, applicant's briefs do not specifically address this du Pont factor. However, the relevant evidence and arguments are nevertheless briefly addressed and summarized below for completeness.

1. The '1147 Mark

As a preliminary matter, the examining attorney believes it would be appropriate to narrow further the partial refusal of registration in this application to exclude "Promoting visual and performing arts events by means of providing an online events calendar, original articles, interviews, and information
about art, artists and arts events via an internet web site, all for promotional purposes; Providing facilities for business meetings; Providing facilities for the use of office equipment and machinery; Rental of office equipment in co-working facilities". Accordingly, applicant's services relevant to this refusal are as follows in Class 35:

"Advertising services, namely, providing information as to the availability of co-working spaces for rent or purchase; Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Digital advertising services; Hotel management for others; Incubation services, namely, providing work space containing business equipment to freelancers, start-ups, existing businesses and non-profits; Online advertising and promotional services; Providing a web site featuring business information in the form of audio and video interviews, transcripts and other educational materials; Business management of hotels; Preparing advertisements for others, namely, preparing video advertising and promotional videos for commercial use via the internet and television, digital cable and video-on-demand or download."

The services in Registration No. 6357702 (AGILE BLACK BELT CONSULTING) are as follows in Class 35, in relevant part:

"Business consultancy; Business consultation; Business management and consultation; Business administration consultancy; Business management consultancy; Business management consultation; Business organizational consultation; Business risk management consultation; Business management consulting; Business organization consulting."

The services in cited Registration No. 3897278 (BUSINESS BLACK BELT) are as follows in Class 35, in relevant part: "Business organization and management consulting services; business assistance,
namely, assistance with business management and planning."

Generally, determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See In re Detroit Athletic Co., 903 F.3d at 1307, 128 USPQ2d at 1052 (citing In re i.am.symbolic, llc, 866 F.3d at 1325, 123 USPQ2d at 1749). In this case, the registrations use broad wording to describe "business management and consulting", which presumably encompasses all services of the type described, including applicant’s more narrow business management and consulting applicable specifically to hotels. See, e.g., Made in Nature, 2022 USPQ2d at *44; In re Solid State Design Inc., 125 USPQ2d 1409, 1412-15 (TTAB 2018); Sw. Mgmt., Inc. v. Ocinomled, Ltd., 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s services are legally identical in part. See, e.g., In re i.am.symbolic, llc, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc., 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); Inter IKEA Sys. B.V. v. Akea, LLC, 110 USPQ2d 1734, 1745 (TTAB 2014); Baseball Am. Inc. v. Powerplay Sports Ltd., 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

To the extent that applicant's and the registrants' services are not legally identical, the evidence of record further supports that these services are related; in total, the evidence attached to the Office actions that issued in this case comprises Internet screenshots from a total of 18 consulting and management firms generally showing the same entities offering a combination of business consulting, hotel management and hotel management consulting, marketing, business development, and business incubation services. See August 31, 2021 Office Action, Serial No. 90501147, TSDR at 16–26; March 24, 2022 Final Office Action, Serial No. 90501147, TSDR at 2–98, 112–121, 126–160.

Additionally, the services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” In re Viterra Inc., 671 F.3d at 1362, 101 USPQ2d at 1908 (quoting Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); Made in Nature, 2022 USPQ2d at *49.

2. The '1155 Mark
Applicant's services are as follows in Class 43, in relevant part:

"Catering; Hotels; Restaurant; Bar services; Bed and breakfast inn services; Catering services; Cocktail lounge services; Coffee shops; Hotel accommodation services; Hotel services; Making reservations and bookings for restaurants and meals; Resort hotel services; Resort lodging services; Restaurant services featuring Creole, African, Italian, Jamaican, Mediterranean, Spanish, and American cuisine; Restaurant and bar services; Restaurant services; Providing banquet and social function facilities for special occasions"

The services in Registration No. 4498366 are as follows in Class 43: "Restaurant services, namely, ramen noodle restaurants."

The services in Registration No. 5543145 are as follows in Class 43:

"Ramen restaurant services; providing foods and beverages services; restaurants; cafes; self-service restaurants; shops for serving food and drinks in the nature of a restaurant; bars; cocktail lounge services; coffee shop; providing foods and beverages services for banquet and party; takeaway restaurant; buffet restaurant; fast food restaurant; Japanese restaurant."

In this case, the application and registrations use broad wording to describe "Restaurant", "Bar" "Bar services", "Cocktail lounge services", which presumably encompasses all services of the type described, including the restaurant services featuring specific cuisine identified in both the application and registrations. See, e.g., Made in Nature, 2022 USPQ2d at *44; In re Solid State Design Inc., 125 USPQ2d at 1412-15; Sw. Mgmt., 115 USPQ2d at 1025. Thus, applicant’s and registrant’s services are legally identical in part. See, e.g., In re i.am.symbolic, llc, 127 USPQ2d at 1629 (TTAB 2018) (citing Tuxedo Monopoly, 648 F.2d at 1336, 209 USPQ at 988; Inter IKEA Sys. B.V., 110 USPQ2d at 1745;
Further, the following services are identical between the application and Registration No. 5543145: "Restaurants; Cocktail lounge services; Coffee shops." Therefore, it is presumed that the channels of trade and classes of purchasers are the same for these services. See Cai v. Diamond Hong, Inc., 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting In re Viterra Inc., 671 F.3d at 1362, 101 USPQ2d at 1908). Thus, applicant’s and registrant’s services are related.

As with the '1147 Mark, any doubt as to the relatedness of applicant's other services and the services in the registrations is further assuaged by the evidence of record, which in this case comprises Internet screenshots from a total of 11 hotels offering hotel and restaurant services and eight restaurant chains offering restaurant and catering services. See August 27, 2021 Office Action, Serial No. 90501155, TSDR at 8–80; February 22, 2022 Final Office Action, Serial No. 90501155, TSDR at 2–5, 9–20, 22–27, 19–32. The Board has also found hotel services and restaurant services to be related. In re Binion, 93 USPQ2d 1531, 1535 (TTAB 2009); see also In re Hartz Hotel Servs., 102 USPQ2d 1150, 1151 (TTAB 2012).

3. The '1168 Mark

Applicant's services are as follows in Class 37:

"Advisory services relating to building construction; Advisory services relating to the construction of buildings; Advisory services relating to the maintenance of buildings; Building construction; Building construction and repair; Building construction information; Building construction services; Building construction supervision; Building construction, remodeling and repair; Commercial building construction; Construction consultancy; Construction consultation; Construction management; Construction planning; Construction project management services; Construction services, namely, planning, laying out and construction of residential and commercial communities; Construction services, namely, planning, laying out and construction of a planned residential community; Construction services, namely, planning, laying out and custom construction of commercial buildings; Construction supervision; Construction and renovation of buildings; Construction and repair of buildings; Construction of buildings; Construction, maintenance and renovation of real property; Consultancy relating to residential and building construction; Consulting in the field of building construction; Custom building
construction; Custom construction of homes; General construction contracting; Housing services, namely, development of real property, namely, repair, improvement, and new construction; Housing services, namely, repair, improvement, and construction of residential real property; Land development services, namely, planning and laying out of commercial buildings; Real estate development and construction of commercial, residential and hotel property; Residential building construction; Residential and building construction consulting; Residential and commercial building construction."

The registrant's services are as follows in Class 36, in relevant part: "Financial planning and investment advisory services; real estate management consultation; real estate management services."

In addition to being somewhat intuitively related inasmuch as applicant's building, construction, and related advisory services and the registrant's real estate management services all serve as different stages in the development of real property, the record in this application is replete with evidence that the same entity offers services in the nature of those offered by both the applicant and registrant. In total, this evidence comprises Internet screenshots from 12 real estate and construction development companies showing the same entity providing construction and construction advisory services alongside real estate management services. See August 27, 2021 Office Action, Serial No. 90501168, TSDR at 5–10; February 16, 2022 Final Office Action, Serial No. 90501168, TSDR at 5–122.

Although applicant did not explicitly argue against the relatedness of these services, applicant did assert that "relevant pairs" of coexisting third-party registrations for marks featuring the same or similar wording in connection with both construction and real estate services shows that these services are at least different enough that consumers are readily able to differentiate between them. See Applicant's Appeal Brief, Serial No. 90501168, at 17–24. Applicant's evidence in support of this argument consists of 30 examples of these "relevant pairs." This argument is unpersuasive. Third-party registrations are entitled to little weight on the issue of confusing similarity because the registrations are “not evidence that the registered marks are actually in use or that the public is familiar with them.” In re Midwest Gaming & Entm't LLC, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing In re Mighty Leaf Tea, 601 F.3d at 1346, 94 USPQ2d at 1259); see TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability of the applied-for

Applicant also notes that this evidence "demonstrates that the USPTO allows analogous pairs of marks to coexist." Applicant's Appeal Brief, Serial No. 90501168, at 24. However, prior decisions and actions of other trademark examining attorneys in applications for other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

Moreover, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the services needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); see also *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

The relevant services in the applications are therefore related to the various services identified in the registrations for purposes of determining a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

**D. Applicant's Arguments Regarding Other du Pont Factors Are Unpersuasive**

Applicant provided several additional arguments common between the three applications that are the subject of this consolidated appeal. These arguments are addressed below.

1. **The '1147 and '1168 Marks — Applicant's Argument that the Term "BLACK BELT" is Conceptually Weak with Respect to the Registrant's Services is Unsupported by Evidence and Therefore Unpersuasive**

   Applicant argues that the term "BLACK BELT" is conceptually weak with respect to the registrants' services because of the term's suggestive meaning in connection with a service provider's level of
expertise in rendering a service. Applicant's Appeal Brief, Serial No. 90501147, at 16; Applicant's Appeal Brief, Serial No. 90501168, at 13. In particular, applicant asserts that although the definition of "black belt" refers literally to mastery of a particular martial art, this term as used in connection with the registrants' services merely communicates to prospective purchasers that each "[r]egistrant is an expert in [its] industries." Applicant's Appeal Brief, Serial No. 90501147, at 17; Applicant's Appeal Brief, Serial No. 90501168, at 13. Applicant argues that the term BLACK BELT is therefore entitled only to a narrow scope of protection. Id.; see Jack Wolfskin Ausrustung Fur Draussen Gmbh v. New Millennium Sports, SLU, 797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); Juice Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); 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)); TMEP §1207.01(d)(iii).

A large number of active use-based third-party registrations including the same or similar term or mark segment for the same or similar services may be relevant to prove, in the same way dictionaries are used, that a term or mark segment has "a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak" and entitled to only a narrow scope of protection. Jack Wolfskin, 797 F.3d at 1374, 116 USPQ2d at 1136 (quoting Juice Generation, 794 F.3d at 1339, 115 USPQ2d at 1675); Sabhnani, 2021 USPQ2d at *22 (citing Tao Licensing, 125 USPQ2d at 1057).

However, applicant has not submitted any third-party registrations or other evidence beyond a single dictionary definition to show that the wording "BLACK BELT" is conceptually weak with respect to the registrant's services. Applicant's arguments and the single dictionary definition are "not evidence of what happens in the market place" or that customers are familiar with usage of this term applicant puts forth. See Sock It To Me, 2020 USPQ2d at *9 (quoting AMF Inc., 474 F.2d at 1406, 177 USPQ at 269). Thus, applicant's arguments, as presented in its briefs, are insufficient to establish that the mark or portion of the mark is inherently or conceptually weak.

2. The '1147 and '1168 Marks — Even Sophisticated Consumers Are Susceptible to Confusion Between Similar Marks
Applicant further argues that consumers seeking out applicant's construction advising and consulting services and the registrants' business consulting services are sophisticated such that confusion is not likely. Applicant's Appeal Brief, Serial No. 90501147, at 17–20; Applicant's Appeal Brief, Serial No. 90501168, at 15–17. In support of this argument, applicant explains generally the time and cost involved in engaging the services of applicant and the registrants, and concludes that consumers of consulting and advising services are generally sophisticated in nature. Applicant's Appeal Brief, Serial No. 90501147, at 18; Applicant's Appeal Brief, Serial No. 90501168, at 15–16.

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., Stone Lion Capital Partners, 746 F.3d. at 1325, 110 USPQ2d at 1163-64; Top Tobacco LP v. N. Atl. Operating Co., 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. In re FCA US LLC, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing Stone Lion Capital Partners, 746 F.3d. at 1325, 110 USPQ2d at 1163), aff’d per curiam, 777 F. App’x 516, 2019 BL 375518 (Fed. Cir. 2019). In this case, applicant has not provided any evidence suggesting that members of the general public are or will be precluded from the class of purchasers to whom the parties' services are offered. Accordingly, though consumers of these services perhaps should possess a level of sophistication, the least sophisticated purchaser (such as, for example, a private individual engaging in construction contracting for the first time) may not, and therefore may nevertheless be susceptible to confusion as to the source of these services if they are offered under highly similar marks.

Further, even if consumers of the compared services are considered sophisticated and discriminating, it is settled that “even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and related goods [and/or services].” In re i.am.symbolic, llc, 116 USPQ2d at 1413 (citing In re Research & Trading Corp., 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)), aff’d, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); see also In re Shell Oil Co., 992 F.2d at 1208, 26 USPQ2d at 1690. The identity of the marks and the relatedness of the services “outweigh any presumed sophisticated purchasing decision.” In re i.am.symbolic, llc, 116 USPQ2d at 1413 (citing HRL Assocs., Inc. v. Weiss Assocs., Inc., 12 USPQ2d
1819, 1823 (TTAB 1989), **aff’d**, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)); **see also Stone Lion Capital Partners**, 746 F.3d at 1325, 110 USPQ2d at 1163-64.

3. The '1168 Mark — Applicant's Evidence to Show Commercial Weakness of the Term "BLACK BELT" Comprises Only a Small Number of Third-Party Marks

As additional support for its claims against the strength of the term BLACK BELT in the registration cited against the '1168 Mark, applicant has also submitted evidence of 10 third-party marks including the term "BLACK BELT" or "BLACKBELT" to show that the registered mark is commercially weak and should not be afforded a broad scope of protection. **See Juice Generation, Inc. v. GS Enters., LLC**, 794 F.3d at 1338-39, 115 USPQ2d at 1674 (Fed. Cir. 2015); **Palm Bay**, 396 F.3d at 1373-74, 73 USPQ2d at 1693; TMEP §1207.01(d)(iii). This evidence comprises the marks as follows:

- **Blackbeltbrokerage.com**, BLACK BELT BROKERAGE, real estate broker training program services (Id. at 45–48)
- **Blackbeltbroker.team**, BLACK BELT BROKER TEAM, real estate agent services (Id. at 49–52)
- **Blackbeltrealty.com**, BLACKBELT LAND AND REALTY COMPANY INC., real estate agency services (Id. at 53–57)
- **Blackbeltcapitalgroup.com**, BLACK BELT CAPITAL, real estate investment services (Id. at 58–64)
- **Blackbeltwealthadvisory.com**, BLACKBELT WEALTH ADVISORY, financial advisor services (Id. at 65–68)
- **Blackbeltinvestors.com**, BLACK BELT INVESTORS, real estate investment firm Id. at 69–71
- **Blackbelt-capital.com**, BLACKBELT CAPITAL, real estate investment services (Id. at 72–74)
- **Blackbeltpropertyprotection.com**, BLACK BELT PROPERTY PROTECTION, home
Evidence of third-party use falls under the sixth *du Pont* factor, which assesses the number and nature of similar marks in use on similar services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567. Considerable or ubiquitous evidence of third-party use of similar marks on similar services can be relevant to show that consumers have become conditioned by encountering so many similar marks in the marketplace that they distinguish between them based on minute distinctions, such that the mark or component should be considered relatively weak and entitled to only a narrow scope of protection. *See Jack Wolfskin*, 797 F.3d at 1373-74, 116 USPQ2d at 1136-37; *Juice Generation*, 794 F.3d at 1338-39, 115 USPQ2d at 1674 (citing *Palm Bay*, 396 F.3d at 1373, 73 USPQ2d at 1693); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

As a preliminary matter, the third-party marks BLACK BELT PROPERTY PROTECTION and STARTUP BLACKBELT are for services unrelated to those offered by either the applicant or registrant (home security services and startup company consulting services, respectively). Evidence comprising third-party use of similar marks for different or unrelated services has "no bearing on the strength of the term in the context relevant to this case." *See Tao Licensing*, 125 USPQ2d at 1058 (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751).

In making a determination as to the commercial weakness of a particular term, evidence comprising only a small number of third-party uses of similar marks is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d at 1328-29, 123 USPQ2d at 1751-52; *AMF Inc.*, 474 F.2d at 1406, 177 USPQ at 269. Here, given that applicant has provided evidence of only eight relevant third-party marks, applicant's evidence thus falls short of the "ubiquitous" or "considerable" use of similar marks found probative in the cases. *See In re i.am.symbolic, llc*, 866 F.3d at 1329, 123 USPQ2d at 1752 (citing *Jack Wolfskin*, 797 F.3d at 1374, 116 USPQ2d at 1136-37; *Juice Generation*, 794 F.3d at 1339, 115 USPQ2d at 1674). Thus, applicant's small number of examples is insufficient to establish that the registered mark is commercially weak and
entitled to a narrow scope of protection.

The Board will also note that all third-party marks provided by applicant contain additional wording along with the term "BLACK BELT" or "BLACKBELT". Descriptive though this wording may be in many instances, the presence of any additional terms results in greater differentiation between the marks in applicant's evidence than exists between the applicant's and registrant's marks, which are essentially identical.

E. The Applied-for Marks are Likely to Cause Confusion with the Registered Marks

The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See In re Shell Oil Co., 992 F.2d at 1208, 26 USPQ2d at 1690. Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see Hewlett-Packard Co., 281 F.3d at 1265, 62 USPQ2d at 1003; In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). Because the marks are similar and the services are related, the applied-for mark is likely to cause confusion with the registered mark.

CONCLUSION

For the foregoing reasons, the refusal to register the applied-for marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the basis of a likelihood of confusion with the registered marks should be affirmed.
Respectfully submitted,

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A USPTO examining attorney has issued an appeal brief. Follow the steps below.

(1) **Read the appeal brief.** This email is NOT the appeal brief.

(2) **Submit reply brief within 20 days of February 16, 2023**, if you wish to do so. If submitted, a reply brief must be submitted using the [Electronic System for Trademark Trials and Appeals (ESTTA)](https://www.uspto.gov/trademark/trials-and-appeals) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.

(3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.