This Opinion is Not a Precedent of the TTAB

Hearing: July 18, 2023 Mailed: September 15, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Locals Technology Inc.

Serial No. 90632969

Robert W. Dickerson, Jr. of Burke, Williams & Sorenson, LLP for Locals Technology Inc.

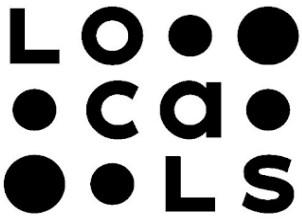
Diana Zarick, Trademark Examining Attorney, Law Office 126,[1] Andrew Lawrence, Managing Attorney.

Before Kuhlke, Larkin, and Casagrande, Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Locals Technology Inc. ("Applicant") seeks registration on the Principal Register of the mark shown below

[1] Ms. Zarick appeared at the oral hearing on behalf of the United States Patent and Trademark Office ("USPTO"). Trademark Examining Attorney Carl A. Konschak examined the application, issued the final refusal to register from which this appeal was taken, and filed the USPTO's brief. We will refer to them both as the "Examining Attorney."



for services ultimately identified as

> Broadcasting, webcasting, streaming, and transmission of audio, video, subscription television programs, and video-on-demand content via the internet and electronic communications networks; telecommunication services, namely, transmission of voice, data, images, graphics, audio, video, and multimedia by means of wired and wireless networks in International Class 38, and
>
> Providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content; hosting an online website featuring artists and digital content creators; providing a website featuring technology that enables users to raise and transfer money to pay for media content; providing a website featuring technology that enables users to offer rewards to their customers; providing an interactive website featuring technology that enables users to share user-created media content, comment on media content, and exchange commentary concerning the same with one another in International Class 42.[2]

The Examining Attorney refused registration of Applicant's mark 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 LOCALZ, registered on the Principal Register for, among many goods and services,

[2] Applicant Serial No. 90632969 was filed on April 8, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of the mark and first use of the mark in commerce in both classes at least as early as December 3, 2019. Applicant describes its mark as follows: "The mark consists of the stylized word 'LOCALS' and six shaded circles, arranged in a rectangular grid such that the letters 'LO' are to the left of two circles, above the letters 'CA' with one circle to the left and another circle to the right, above the letters 'LS' to the right of two circles." Color is not claimed as a feature of the mark.

> Computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks in International Class 9, and
>
> Providing temporary use of nondownloadable computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks, in International Class 42,[3]

as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant first requested reconsideration, which was denied, and then appealed. The case is fully briefed,[4] and counsel for Applicant and the Examining Attorney appeared at an oral hearing before the panel on July 18, 2023. We affirm the refusal to register as to both Class 38 and Class 42.

I. Record on Appeal[5]

The record on appeal includes the following:

[3] The cited Registration No. 5776278 issued on June 11, 2019.

[4] 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 4 TTABVUE and its corrected reply brief appears at 10 TTABVUE. The Examining Attorney's brief appears at 7 TTABVUE.

[5] Citations in this opinion to the application record are to pages in the USPTO's Trademark Status & Document Retrieval ("TSDR") database.

- Applicant's specimen, which Applicant describes as an "[i]mage of screenshot at website bearing mark in connection with video broadcast;"[6]
- USPTO electronic records regarding the cited registration;[7]
- Dictionary definitions of the words "say," "org," and "organization," and pages from acronymfinder.com regarding the letters "ORG;"[8]
- Wikipedia entries captioned "org.," "Facebook," "YouTube," and "Instagram;"[9]
- Pages from Applicant's website at locals.com and the cited registrant's website at localz.com;[10]
- The cited registrant's specimen of use;[11]
- Pages from the WIPO Global Brand Database listing various marks containing the word "local;"[12]
- Third-party webpages and third-party use-based registrations of marks that the Examining Attorney argues display and identify the involved services,[13] and

[6] April 8, 2021 Application at TSDR 1, 3-4.

[7] December 7, 2021 Office Action at TSDR 10-15. The Examining Attorney originally refused registration based on three additional cited registrations, *id.* at 1, 16-23, and noted that registration also might be refused based on four prior-pending applications. *Id.* at TSDR 1-9. Applicant submitted a letter of consent from the owner of three of the prior-pending applications, April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 53-54, 65-66, and the Examining Attorney subsequently withdrew the prospective refusals based on all four prior-pending applications, and also made the refusal to register final as to only cited Registration No. 5776278. June 8, 2022 Final Office Action at TSDR 1. We will not summarize record evidence regarding the additional refusals and prospective refusals.

[8] December 7, 2021 Office Action at TSDR 24-25, 26-28, 29-30, 31-32.

[9] *Id.* at TSDR 33-35; October 18, 2022 Denial of Request for Reconsideration at TSDR 5, 10, 18.

[10] February 18, 2022 Response to Office Action at TSDR 2-5; April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 2-6, 43-52.

[11] April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 43-52.

[12] February 18, 2022 Response to Office Action at TSDR 6-35.

[13] December 7, 2021 Office Action at TSDR 36-108; June 8, 2022 Final Office Action at TSDR 2-156; October 18, 2022 Denial of Request for Reconsideration at TSDR 2-4, 6-9, 11-17.

- Third-party registrations of LOCAL-formative marks.[14]

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*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an 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*"). *Charger Ventures*, 2023 USPQ2d 451, at *4. 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." *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *14 (TTAB 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)) *civil action filed*, No. 5:23-cv-00549-GW-PVC (C.D. Cal. Mar. 28, 2023). Applicant agrees that the "likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the services," 4 TTABVUE 11-12, and focuses in its appeal brief primarily on these two key factors. *Id.* at 12-21.

[14] April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 7-42.

Applicant's appeal brief also briefly discusses the fourth *DuPont* factor, the "conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. 4 TTABVUE 19.[15]

A. Similarity or Dissimilarity of the Marks

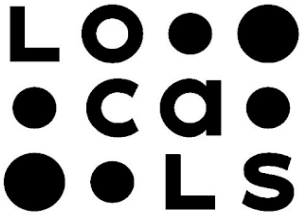
"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *26 (TTAB 2021) (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (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) (quoting *In re*

[15] As noted above, Applicant made of record a number of third-party registrations of LOCAL-formative marks during prosecution, but did not provide argument in its appeal brief regarding their possible significance under the sixth *DuPont* factor, the "number and nature of similar marks in use on similar goods." *DuPont*, 177 USPQ at 567. *See* 4 TTABVUE. We therefore consider Applicant to have forfeited any argument that the sixth factor favors it. *See, e.g., Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1077 (TTAB 2011) (claim that applicant's mark was famous, which was not discussed by applicant in its main brief and which was raised for the first time in its reply brief, was improper rebuttal argument); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims deemed forfeited because they were not argued in its main brief), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014); *see generally In re Google Techs. Holdings, LLC*, 980 F.3d 858, 2020 USPQ2d 11465, at *3-4 (Fed. Cir. 2020) (argument not timely raised is forfeited). We acknowledge that in its reply brief, Applicant argues that the cited registration is "not strong" as part of its discussion of "[t]he 8-factor test for likelihood of confusion first set forth in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341[, 204 USPQ 808] (9th Cir. 1979)," 10 TTABVUE 11-12, which Applicant claims "is most often used by all courts . . . ." *Id.* at 11. We must, of course, apply the *DuPont* factors that govern registrability determinations, not analogous likelihood of confusion factors applied by regional circuit courts in infringement cases, and so, beyond forfeiture, we have given no consideration to any of Applicant's arguments under the *Sleekcraft* factors.

Davia, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

"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.'" *Sabhnani*, 2021 USPQ2d 1241, at *26 (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 specific impression of marks.'" *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customers here include members of the general public who use the Internet.

The cited mark is LOCALZ in standard characters. Applicant's mark is the composite word-and-design mark shown again below:



Applicant's general position is that the "Examining Attorney's finding that Applicant's Mark and the Cited Mark are substantially similar does not withstand scrutiny" because it "not only fails to compare Applicant's Mark and the Cited Mark in their entireties, but also fails to appreciate the significant differences in appearance, connotation, and commercial impression between the respective marks."

4 TTABVUE 13. Applicant does not specifically address the similarity or dissimilarity of the marks in sound.

With respect to appearance, Applicant argues that "the Examining Attorney erred by generally applying the oft-stated principle – in a composite mark, the text portion will be prominent and given greater weight," *id.* at 13 (citations omitted), without taking into account that greater weight may be given "'to a design element of a composite mark.'" *Id.* (quoting *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.2d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015)). According to Applicant, "[s]uch may be the case where, as here, the mark contains unusual or uncommon design features." *Id.*

Applicant further argues that

> [g]iven [the] unique arrangement of the letters in the mark in which the letter couplets are asymmetrically arranged on different lines, partially overlap, and are in upper and lower case, with the eye-catching symmetrical and large shaded circles interspersed, the vocalization of the letter couplets as "LOCALS" is not immediately apparent.

Id. at 13-14.[16]

According to Applicant, the design elements of its mark "are its most visually prominent feature and create a distinct commercial impression." *Id.* at 14. In support of its position, Applicant cites *In re Comput. Commc'ns, Inc.*, 484 F.2d 1392, 179

[16] Applicant argues in a footnote in its appeal brief that "[t]he eye-catching nature of symmetrical objects is universally acknowledged," 4 TTABVUE 14 n.2, citing a June 2021 article entitled *Why Do We Get So Much Pleasure From Symmetry?* that Applicant claims is available on the website at science.howstuffworks.com. The referenced article is not in the record and Applicant does not request that we judicially notice it. We have given Applicant's argument based on the article no consideration in our decision.

USPQ 51 (CCPA 1973), *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009), and *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987). 4 TTABVUE 14-15.[17] In its reply brief, Applicant argues that the "distinctive design portion of Applicant's mark and the disjointed arrangement of the letters are to be given greater weight." 10 TTABVUE 6.

In a section of its appeal brief captioned "The Refusal to Register Places Too Much Emphasis on the Fact That the Registered Mark is in Standard Characters," 4 TTABVUE 19, Applicant argues that "the Examining Attorney wrongly adopts the position that merely because the Registrant theoretically could in the future add stylization of the word portion and could add every conceivable design element to create a composite mark (regardless of how that might change the overall commercial impression of the then highly-stylized and modified mark)," Applicant's composite mark "must be view[ed] only [as] LOCALS and must still be compared against only the initial word portion of that materially revised hypothetical mark." *Id.* at 20. Applicant further argues that "just because a standard-character mark is not necessarily limited to any particular font, style, etc., does not mean its reach can be

[17] Applicant also cites *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071, 1072 (Fed. Cir. 1993), in support of a fallback argument that "[e]ven assuming that the word portion of a composite mark is normally given greater weight than the design, the mere fact that the two respective marks share common letters does not lead to a likelihood of confusion." 4 TTABVUE 15. *Four Seasons Hotels* does not aid Applicant, however, because that case concluded that there was no likelihood of confusion between the marks FOUR SEASONS BILTMORE and THE BILTMORE LOS ANGELES, both for hotel services, based on a consent agreement between the applicant and the cited registrant, and there is no consent agreement here between Applicant and the owner of the cited Registration No. 5776278.

extended to any possible embodiment" and that the Examining Attorney "(mis)interprets the law such that there are limitless embodiments, no matter how far removed from the initial mark, no matter how the new embodiment(s) might overwhelm the literal element of the mark and drastically change its commercial impression, and those can simply be ignored." *Id.* Applicant concludes that the cited LOCALZ standard-character mark cannot be assumed to appear in the manner of Applicant's composite mark. *Id.*

With respect to meaning, Applicant argues that the "connotation and commercial impression cast by Applicant's Mark is vastly different from that cast by the Cited Mark," and that "Applicant's Mark is easily distinguishable because of the unique design elements, arrangement of the differing-case letter couplets, and font styles as discussed above," while "the Cited Mark does not connote a unique impression and is much more ambiguous." *Id.* at 16. In support of this position, Applicant cites *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984), *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987), *In re Sydel Lingerie Co.*, 197 USPQ 629 (TTAB 1977), and *Revlon Inc. v. Jerell Inc.*, 713 F. Supp. 93, 11 USPQ2d 1612 (S.D.N.Y. 1989). 4 TTABVUE 15-16.

Applicant concludes that

> [t]he Examining Attorney's cursory conclusion that the respective marks are "similar" failed to take these key distinctions of font style and design elements into consideration. Therefore, Applicant's Mark is not similar in appearance and commercial impression to the Cited Mark, and the first *Du Pont* factor weighs heavily against likelihood of confusion.

Id. at 16.

The Examining Attorney responds that the "applied-for mark LOCALS is similar to the registered mark LOCALZ because they both contain or comprise a variation on the term LOCALS." 7 TTABVUE 6.[18] The Examining Attorney argues that the design elements in Applicant's mark "fail to significantly distinguish it from the registered mark in this case, because the term LOCALS in the applied-for mark predominates over the mark's design elements." *Id.* According to the Examining Attorney,

> Applicant's characterization of these design elements belies their relationship with the mark's sole literal element, however, and overstates their contribution to the mark's overall commercial impression. The term LOCALS, as depicted in the applied-for mark, is easily and immediately recognizable, as its letters are arranged in a left-to-right, top-to-bottom manner that is typical of English wording. The term LOCALS is, moreover, presented in a typeface that is as large--or larger--than the six shaded circles in the mark, which imbues LOCALS with a significant visual presence. The term LOCALS also constitutes the sole literal element in the mark, and is the only means consumers may use to verbally reference or request applicant's services. . . . The wording LOCALS in the applied-for mark therefore predominates over the mark's design elements, and is more significant to the mark's overall commercial impression.

Id. at 7.

With respect to appearance, the Examining Attorney acknowledges that the "applied-for mark differs from the registered mark in that it substitutes the letter S for the letter Z in the registered mark, and adds a design element, i.e. a set of six shaded circles," but argues that "these differences fail to significantly distinguish the

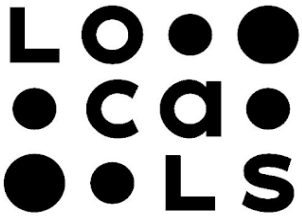
[18] The Examining Attorney does not specifically address the similarity or dissimilarity of the marks in connotation and commercial impression.

marks' appearances in this case." *Id.* The Examining Attorney further argues that the cited LOCALZ mark is in standard characters and that Applicant's argument regarding the manners in which the mark may be displayed "misinterprets the relevant legal precedent, conflates the concepts of character stylization and design elements, and fails to acknowledge the full scope of the cited registration." *Id.* at 10 (citations omitted). The Examining Attorney also argues that Board cases have "consistently recognized the distinction between character stylization and design elements in the likelihood of confusion context, and have found that the owner of a standard character mark is entitled to all depictions of that mark, including depictions of wording that, like the wording in the applied-for mark LOCALS, has been vertically and/or laterally displaced." *Id.* at 11 (citations omitted). At the oral hearing, however, the Examining Attorney agreed that the Board could not assume that the registration could cover a design element like Applicant's together with the letters in Applicant's mark.

As to sound, the Examining Attorney argues that "[e]vidence obtained from the American Heritage dictionary shows . . . that the letter 's' often makes the 'z' sound, as in the word 'says,'" and the "marks LOCALS and LOCALZ may therefore be pronounced identically, and similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar." *Id.* at 6 (citations omitted).

Although the marks must be considered in their entireties, *Charger Ventures*, 2023 USPQ2d 451, at *5, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons,

more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *Sabhnani*, 2021 USPQ2d 1241, at *30-31 (quoting *In re Detroit Athletic Co.*, 903 F.2d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018)). As noted above, Applicant argues that the design elements of its mark "are its most visually prominent feature and create a distinct commercial impression," 4 TTABVUE 14, and that the "distinctive design portion of Applicant's mark and the disjointed arrangement of the letters are to be given greater weight," 10 TTABVUE 6, while the Examining Attorney argues that the word LOCALS "predominates over the mark's design elements, and is more significant to the mark's overall commercial impression." 7 TTABVUE 7. Accordingly, we will begin our analysis by identifying the dominant portion of Applicant's composite mark. For ease of reference in following our discussion, we reproduce Applicant's mark again below

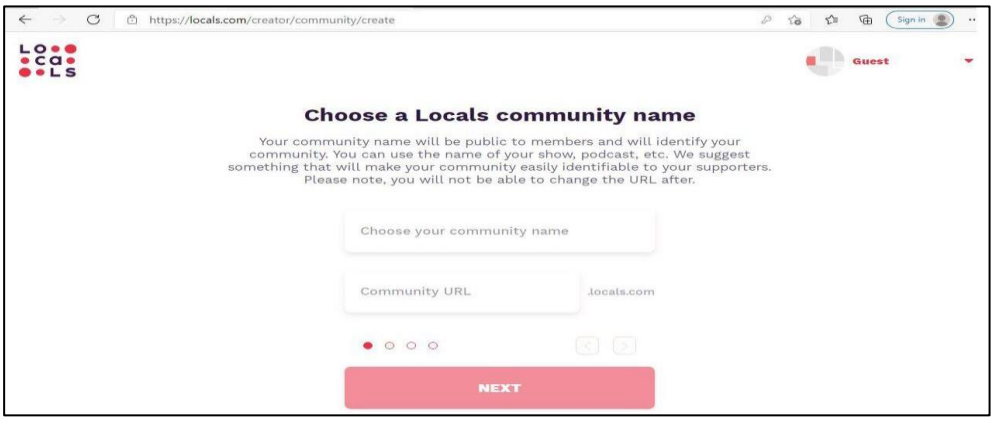


Applicant describes its mark as "consist[ing] of the stylized word 'LOCALS' and six shaded circles, arranged in a rectangular grid such that the letters 'LO' are to the left of two circles, above the letters 'CA' with one circle to the left and another circle to the right, above the letters 'LS' to the right of two circles."[19] "In the case of marks,

[19] April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 1. Applicant originally described its mark as "[t]he word LOCALS arranged in a four by three quadrilateral, having six colored circles in the places that did not have lettering," April 8,

such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods [or services]." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). "The verbal portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Id.* (quoting *Viterra*, 101 USPQ2d at 1908).

As shown below, Applicant's composite mark is displayed on its website at locals.com together with the words "Locals" and "Locals TV":



[20]

2021 Application at TSDR 1; February 18, 2022 Response to Office Action at TSDR 1. At the oral hearing, Applicant's counsel stated that he had never seen a mark like Applicant's, and argued that the word "Locals" is not easy to read in the mark. The Examining Attorney responded that the word is easy to read because the letters forming the word are large, centrally located, and presented in a left-to-right order. We agree with Applicant's counsel that the presentation of the word "Locals" in Applicant's mark is quite unusual, but we do not share his difficulty in seeing the word "Locals" within the mark. It is immediately apparent, upon viewing the mark, that it contains letters, and as the Examining Attorney noted, the letters L-O-c-a-L-S are displayed in the mark diagonally, and from left-to-right as the English language is read. As shown below, Applicant also displays its mark on its website with the circles in red and the letters in black, which sets the letters off from the circles.

[20] April 8, 2021 Application at TSDR 4.

[21]

Applicant's own use of the word "Locals" that appears in its mark in text on its website, through which consumers can avail themselves of the services identified in Applicant's application, supports the inference that consumers of Applicant's services offered under its mark are also likely to use the word "Locals" to refer to and request Applicant's services, and in dialogue with others regarding Applicant's services. *See Viterra*, 101 USPQ2d at 1911; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 & n.5 (Fed. Cir. 1983). Indeed, as a practical matter, there is no way to verbalize Applicant's mark by reference to the shaded circles.

Marks "must be considered on a case-by-case basis" in determining their dominant portions, *Viterra*, 101 USPQ2d at 1908, but we agree with the Examining Attorney that the cases that Applicant cites in support of its argument that the design elements of its mark are dominant are readily distinguishable. We display below the involved marks in the cited *Covalinski*, *White Rock Distilleries*, and *Steve's Ice Cream* cases:[22]

[21] April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 4.

[22] In its briefs, Applicant does not show or describe the mark involved in the CCPA's 1973 decision in the *Comput. Commc'ns* case that Applicant also cites. 4 TTABVUE 14. As discussed above, identifying the dominant portion of a particular mark is an individualized

(*Covalinski*)

(*White Rock Distilleries*)

(*Steve's Ice Cream*)

Viterra illustrates why the marks in *White Rock Distilleries* and *Steve's Ice Cream* are qualitatively different from Applicant's mark. In *Viterra*, the Federal Circuit

determination. We have reviewed the mark involved in the *Comput. Commc'ns* case, and find that it is not similar in nature to Applicant's mark and does not provide guidance for our determination here.

affirmed the Board's decision that the applicant's standard-character mark XCEED and the cited composite mark displayed below

were confusingly similar. In doing so, the court found that the Board had properly concluded that "the literal portion of the X-Seed Mark (i.e., the words 'X-Seed') formed the dominant portion of the registrant's mark," *Viterra*, 101 USPQ2d at 1911, because

> the design feature of the X-Seed Mark is not entirely distinct from the literal portion of the mark; rather, the color and design features are incorporated in the letter "X" and are covered in part by the "-Seed" portion of the mark. **This is not a case, therefore, where a larger design is separate and independent from the literal features of the mark**. The design itself is a stylized letter that overlaps with, and is covered by, other literal portions of the mark. Accordingly, the Board's determination that the entire literal portion "X-Seed" is the dominant portion of the mark, and not just the stylized "X," is supported by substantial evidence.

Id. (emphasis added).

Unlike the marks in the *White Rock Distilleries* and *Steve's Ice Cream* cases, the shaded circles in Applicant's mark, like the design element in the cited composite mark in *Viterra*, are not "separate and independent from the literal features of the mark," *id.*, but rather are interspersed with the letters LO-ca-LS that form the word "Locals."

Applicant's mark is also dissimilar in nature from the composite mark in *Covalinski*, in which the Board found that the highly stylized "RR" design, rather

than the words "Redneck Racegirl," was the dominant portion of the mark. The Board noted that the "graphic devices [in the mark] serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the 'a-c-e' of the word 'RACEGIRL' difficult to notice." *Covalinski*, 113 USPQ2d at 1168. Here, the letters L-O-c-a-L-S in Applicant's mark that form the word "Locals" are not made "difficult to notice" by the shaded circles because the letters are in bold, easily readable fonts, are not obscured by the shaded circles, and are presented in a manner that invites English-speaking viewers of the mark to combine them into one word.

We find that the word "Locals" is the portion of Applicant's mark that is dominant in driving consumer perception of the mark, and turn now to the required comparison of the marks in their entireties, giving greater weight in that comparison to the word "Locals" in Applicant's mark than to the circle elements.

We begin by considering the similarity or dissimilarity of the marks in sound and meaning. Applicant's brief does not specifically address the similarity or dissimilarity of the marks in sound, and Applicant's counsel acknowledged at the oral hearing that its mark would be verbalized as "Locals." The word "Locals" that dominates Applicant's mark is the plural of the noun "local," a recognized word in English that means, among other things, "**a person who lives in the particular small area that you are talking about: The café is popular with both locals and visitors**." CAMBRIDGE DICTIONARY (dictionary.cambridge.org, last accessed on September 11, 2023) (emphasis in bold after the colon appears in italics in the original).[23] Applicant's

[23] "The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions." *Monster Energy*, 2023 USPQ2d

website states that it is "Empowering Authentic Communities" to allow its users to "Get Intimate Access to the people and ideas you care about,"[24] that is, to make users figurative online "locals" who figuratively "live in the particular small area that you are talking about" in the vastness of the Internet.

The cited mark LOCALZ contains the word LOCAL, but is not a grammatically recognized plural of that word. "There is no correct pronunciation of a trademark that is not a recognized word," *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014), and we must consider "all the reasonable possibilities" for the pronunciation of LOCALZ. *Inter IKEA Sys., B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.19 (TTAB 2014) (citing *Centraz Indus., Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport Int'l GmbH*, 230 USPQ 530, 533 (TTAB 1986)). The pronunciation of the cited mark LOCALZ as a slang or phonetic plural of the word "local," with the final letter "z" taking the place of the traditional plural-indicating letter "s," is at least a reasonable possibility. *See*, *e.g.*, *Fleetwood Co. v. Mende*, 298 F.2d 797, 132 USPQ 458, 460 (CCPA 1962) (noting that TINTZ is a phonetic spelling of "tints"); *In re Carlson*, 91 USPQ2d 1198, 1201 (TTAB 2009) (finding that URBANHOUZING was phonetically identical to URBAN HOUSING).[25]

87, at *20 n.41. Except where otherwise indicated, emphasis in bold in this opinion appeared in italics or underscoring in the original text.

[24] February 18, 2022 Response to Office Action at TSDR 2.

[25] The definition of the word "say" in THE AMERICAN HERITAGE DICTIONARY made of record by the Examining Attorney, December 7, 2021 Office Action at TSDR 24, shows that the letter "s" is sometimes pronounced as "z" in English. 7 TTABVUE 6. The dictionary entry notes that the third-person singular conjugation of the verb "say" is "says," which is noted as being

Just as marks are not viewed side-by-side when comparing them in appearance, they are not pronounced sequentially when comparing them for aural similarity or dissimilarity. A consumer with a general rather than specific impression and recollection of the sound of the cited mark LOCALZ who separately hears Applicant's mark verbalized as LOCALS is not likely to hear any difference in the sound of the marks. *Cf. Viterra*, 101 USPQ2d at 1912 (finding that substantial evidence supported the Board's determination that "any minor differences in the sound of these marks [XCEED and X-SEED] may go undetected by consumers and, therefore, would not be sufficient to distinguish the marks."). We find that the marks are identical in sound.

Similarly, a consumer with a general rather than specific impression and recollection of the cited mark LOCALZ as a slang misspelling of the noun "locals" who separately encounters Applicant's mark, which is dominated by the word "Locals," is likely to perceive the marks as connoting essentially the same thing, namely, that a consumer of the services is figuratively "a person who lives in the particular small area that you are talking about."[26] We find that the marks are also identical in connotation and commercial impression.

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pronounced "sĕz." The record also contains a website in which the word "fans" is misspelled as "fanz." December 7, 2021 Office Action at TSDR 87-108 (truefanz.com).

[26] As noted above, Applicant cites the Board's decisions in the *British Bulldog*, *Sears, Roebuck & Co.*, and *Sydel Lingerie* cases, and the *Revlon* case from the Southern District of New York, for the proposition that identical or very similar marks may have different meanings. 4 TTABVUE 15-16. We are not bound by the cited district court case, and the cited Board cases all found that the same mark had a different meaning in the context of different goods. Applicant argues simply that "Applicant's Mark and the Cited Mark create entirely different commercial impressions also because they are applied to different services as discussed in greater details below." *Id.* at 16. Unlike in the cited Board cases, there is "no evidence here, or other reason to find, that the mark [LOCALZ and the word LOCALS in Applicant's mark have] one meaning when used with [the services identified in the application] and a second

We turn now to the issue of the marks' similarity or dissimilarity in appearance, to which Applicant and the Examining Attorney devoted considerable attention in their briefs and at the oral hearing. The cited LOCALZ standard-character mark "may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant's mark" because "the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color." *Aquitaine Wine USA*, 126 USPQ2d at 1186 (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)). At the same time, where, as here, "we are comparing a standard character mark to a word + design mark for Section 2(d) purposes, we will consider variations of the depictions of the standard character mark **only with regard to** 'font style, size, or color' of the 'words, letters, numbers, or any combination thereof.'" *Id.* at 1187 (emphasis in bold in original).

As discussed above, *Viterra* involved a comparison between the applicant's standard-character mark XCEED and the cited composite mark shown above. In affirming that the applicant's standard-character mark was not limited to any particular font style, size, or color in that comparison, the Federal Circuit stated that it was "not suggesting that a standard character mark encompasses all possible design elements of the mark" and left "for future cases to determine the appropriate method of comparing design marks with standard character marks." *Viterra*, 101

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and different meaning when used with [the goods and services identified in the cited registration] based on the nature of the respective goods [and services]." *In re Embiid*, 2021 USPQ2d 577, at *21 (TTAB 2021).

USPQ2d at 1910. The court noted, however, that in the decision under review, the Board "did not find that the XCEED mark could be considered to have taken on the precise depiction shown in the cited registration, with full color and design," but only that "the XCEED mark could be depicted as a capital 'X' followed by 'ceed' in small letters, making it similar to the X-Seed Mark." *Id.* at 1910-11. The court concluded that "[s]uch a finding is not a departure from our case law and is not as remarkable as [the applicant] suggests." *Id.* at 1911.

In *Aquitaine Wine USA*, the Board essentially picked up where the Federal Circuit left off in *Viterra* in envisioning the manners in which a standard-character mark may be displayed. The Board noted that in *Viterra*, the Federal Circuit "addressed only the fact that applicant's standard character mark could be depicted in the stylized fashion of the **literal** portion of registrant's design mark; the court did not extend that finding to the background 'splatter' dot design of the registrant's mark." *Aquitaine Wine USA*, 126 USPQ2d at 1186-87. Noting the court's reference in *Viterra* to "future cases to determine the appropriate method of comparing design marks with standard character marks," the Board stated that "[t]his case presents such facts." *Id.* at 1187. This formed the backdrop for the Board's holding that the scope of a standard-character mark extends only to the "font style, size, or color' of the 'words, letters, numbers, or any combination thereof" in the composite mark. *Id.*

Applicant and the Examining Attorney appear to agree that, in visualizing how the cited LOCALZ standard-character mark may be displayed, we cannot assume its use together with the six shaded circles that appear in Applicant's mark, but their

agreement ends there. Applicant does not attempt to define the outer bounds of the possible displays of the cited mark beyond arguing that its display in the manner of Applicant's mark is not one of them; its counsel suggested at the oral hearing that defining the breadth of protection of a standard-character mark was akin to defining obscenity under Supreme Court Justice Potter Stewart's famous "test": "I know it when I see it." *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring).

For her part, as noted above, the Examining Attorney acknowledged at the oral hearing that in visualizing ways in which the standard-character mark LOCALZ may be displayed, we cannot assume its use with "designs elements," which we understand to include the shaded circles in Applicant's mark, but the Examining Attorney did not address whether the stacked diagonal display of the letters L-O-c-a-L-S in Applicant's mark is itself a "design element."

In the final analysis, we need not decide that question because under *Viterra* and *Aquitaine Wine USA*, it is clear that the cited standard-character mark could be displayed horizontally in the same font as the literal elements of Applicant's mark, as shown below:

LO ca LS

with a "Z" replacing the "S." *Viterra*, 101 USPQ2d at 1910-11 (holding that it was proper for the Board to consider that the standard-character "XCEED mark could be depicted as a capital 'X' followed by 'ceed' in small letters, making it similar to the X-Seed Mark."). That visualized depiction is sufficient for us to conclude that the marks

are more similar than dissimilar in appearance from the perspective of a consumer with a general rather than specific recollection of the cited LOCALZ mark displayed in this manner who separately encounters Applicant's mark.

The marks are identical in sound and meaning, and more similar than dissimilar in appearance, and the first *DuPont* factor strongly supports a conclusion that confusion is likely.

B. Similarity or Dissimilarity of the Goods and Services, Channels of Trade, and Classes of Consumers

"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 *Detroit Athletic Co.*, 128 USPQ2d at 1051), while "the third *DuPont* factor considers 'the similarity or dissimilarity of established, likely-to-continue trade channels.'" *Id.* (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1052).

1. Similarity or Dissimilarity of the Goods and Services

"The goods [or services] need not be identical, but '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)).

> 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.

Id., at *22-23 (quoting *In re Ox Paperboard LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020) (internal citations omitted)). "The application and registration themselves may provide evidence of the relationship between the [goods or] services." *Monster Energy*, 2023 USPQ2d 87, at *14.

The record contains pages from third-party websites.[27] In assessing the probative value of these webpages, we must take into account that the offered services may not be explicitly described at all, or may be described in colloquial language that does not track the technical language of acceptable identifications of goods and services in applications and registrations, including those involved here. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1402 (July 2022) (discussing identifications of goods and services in applications). In such instances, we must determine the nature of the services that are offered, and decide whether they fall within the full scope of the language in the involved identifications. *Cf. In re Dare Foods, Inc.*, 2022 USPQ2d 291, at *6 (TTAB 2022) (broadly construing smoked salmon, shellfish, and caviar cream spread displayed on a website as "falling within the ambit of Applicant's 'snack food dips'.").

[27] patreon.com and apps.apple.com/us/app/patreon (December 7, 2021 Office Action at TSDR 36-44 and June 8, 2022 Final Office Action at TSDR 2-11); onlyfans.com and onlyfans-app.com (December 7, 2021 Office Action at TSDR 45-59 and June 8, 2022 Final Office Action at TSDR 12-25); fangage.com (December 7, 2021 Office Action at TSDR 60-86); truefanz.com (December 7, 2021 Office Action at TSDR 87-108; June 8, 2022 Final Office Action at TSDR 26-38); topfan.com (June 8, 2022 Final Office Action at TSDR 39-54; facebook.com and apps.apple.com/us/app/facebook (October 18, 2022 Denial of Request for Reconsideration at TSDR 2-4); youtube.com, google.com/youtube, and apps.apple.com/us/youtube (*id.* at TSDR 6-9); and instagram.com and apps.apple.com/us/instagram (*id.* at TSDR 11-17).

The record also contains third-party, use-based registrations.[28] In assessing the probative value of these third-party registrations,

> [j]ust as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, 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, a registration that describes goods [or services] broadly is presumed to encompass all goods or services of the type described.

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

"Because each class in Applicant's multi-class application is, in effect, a separate application, we consider each class separately, and determine whether [the Examining Attorney] has shown a likelihood of confusion with respect to each." *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015).[29] At the same time, the "Examining Attorney need not prove, and we need not find, similarity as to each [service] listed in the description of [services]." *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3-4 (TTAB 2020). "'[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any [service] encompassed by

[28] Many of these third-party registrations contain very lengthy and dense identifications of goods and services. Examining attorneys should facilitate the Board's review of third-party registrations by highlighting the pertinent portions of the identifications.

[29] On the appeal of a refusal to register directed to more than one class in a multi-class application, examining attorneys and applicants should discuss the evidence of relatedness and, if appropriate, the evidence on other *DuPont* factors, on a class-by-class basis.

the identification of [services] within a particular class in the application.'" *Id.*, at *4 (quoting *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015)); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). The Examining Attorney is thus required to show only that one of the services identified in each class in the application is similar to one of the goods or one of the services identified in the cited registration to support a conclusion of a likelihood of confusion.[30]

Applicant argues that its "services on their face are focused on, *inter alia*, 'broadcasting,' 'webcasting,' 'streaming,' and 'providing a website that gives users that are content providers the ability to publish their own text-based reading content, audio content, and audio-visual content,'" and that all of these services "do not coincide with the services offered under the Cited Mark" because "[w]hile the services under the respective marks both include web-based services, this is not enough of a similarity to show relatedness." 4 TTABVUE 17.

According to Applicant, its "services on their face cater to digital content creators and their viewers" while the registrant's "services are providing use of **unspecified** computer software which do not immediately connote digital content creation and streaming." *Id.* at 18.[31] Applicant further argues that its "services are uniquely linked

[30] Where, as here, the involved multi-class application and registration contain multiple goods or services, examining attorneys should specify the goods or services in each class in the cited registration that they contend are related to specific goods or services in each class in the application.

[31] At the oral hearing, Applicant's counsel argued that the presence or absence of software is the key distinction between the services, and that Applicant does not offer software in

to and associated with video content streaming platforms; by contrast, Registrant's recited services do not appear to target video content streaming services at all." *Id.*

The Examining Attorney responds that "Applicant's services are related to the registrant's goods and services because of the way that they are commonly provided to the consuming public." 7 TTABVUE 12. The Examining Attorney cites the third-party webpages discussed above, which he claims "show[ ] that software applications and online services for posting, sharing, transmitting, and/or monetizing digital content commonly emanate from the same commercial sources, under the same brands or marks," *id.* (record citations omitted), and the third-party registrations mentioned above, which he claims cover "software for posting and transmitting media content, telecommunications services in the nature of 'webcasting, streaming, and transmission of audio, video', and . . . the provision of websites that permit the publication and dissemination of text and media content." *Id.* at 14.

The Examining Attorney further argues that "Applicant's services are also related to registrant's goods and services because they may be used together," *id.* at 13,[32] giving the example of an amateur musician or would-be social influencer who "might use a website to self-publish their media content, e.g. musical recordings or short videos, use the same website to transmit their content to fans and patrons, as well as to solicit and collect donations, and then post additional content and messages via a

rendering its services. This argument echoes Applicant's reply brief, which claims that "software is not a website." 10 TTABVUE 9.

[32] At the oral hearing, the Examining Attorney argued that a user of Applicant's website services uses software on the site to log in and post content.

related software application for 'posting, transmitting, retrieving, receiving . . . text, audio, visual and multimedia data and content.'" *Id.*

In its reply brief, Applicant argues that the Examining Attorney's Internet evidence

> is not relevant as the services identified in these websites do not fall within the purview of services identified by Registrant. Rather, they appear at best related to Applicant's services only. While as to some of Registrant's listed services there is an element of transmitting and receiving data (as do virtually all websites), Registrant's services are in connection with software for management and optimization of delivery systems, such as tracking order, payment, delivery, and store pick-up. Moreover, Registrant's web-based services are confined to "technology that enables users to view and manage a productivity dashboard for the purpose of task management and hosting an online community website featuring shared communications between technicians." Accordingly, Registrant's services are vastly different from the services identified by the third-party websites referenced in the Examiner's Brief; the only similarity is the use of a website—as virtually all businesses now use—to transmit data through the Internet.

10 TTABVUE 9-10. Applicant argues that the Examining Attorney's third-party registration evidence "suffers from the same failing as the argument about third-party website evidence" because "[i]t is simply not relevant." *Id.* at 10.

We begin our analysis "with the identifications of goods and services in the registration and application under consideration." *Country Oven*, 2019 USPQ2d 443903, at *5. The application covers the following services:

> Broadcasting, webcasting, streaming, and transmission of audio, video, subscription television programs, and video-on-demand content via the internet and electronic communications networks; telecommunication services, namely, transmission of voice, data, images, graphics,

> audio, video, and multimedia by means of wired and wireless networks (Class 38), and
>
> Providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content; hosting an online website featuring artists and digital content creators; providing a website featuring technology that enables users to raise and transfer money to pay for media content; providing a website featuring technology that enables users to offer rewards to their customers; providing an interactive website featuring technology that enables users to share user-created media content, comment on media content, and exchange commentary concerning the same with one another (Class 42).

The cited registration covers the following pertinent goods and services:

> Computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks (Class 9), and
>
> Providing temporary use of nondownloadable computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks (Class 42).

The referenced portions of the registrant's Class 9 identification of goods and Class 42 identification of services are separated from the rest of the lengthy identifications in the registration by a semicolon, which in current examination practice is "'used to separate distinct categories of goods or services within a single class.'" *Monster*

Energy, 2023 USPQ2d 87, at *15 n.35 (quoting TMEP Section 1402.01(a)).[33] As a result, contrary to Applicant's arguments, these discrete goods and services are not limited to "a **business-to-business** offering of mobile workforce solution software and location technology which target a markedly different group of consumers – businesses who are **not** looking for steamed video contents from content creators," 4 TTABVUE 18, or to "software for management and optimization of delivery systems, such as tracking order, payment, delivery, and store pick-up" and "'technology that enables users to view and manage a productivity dashboard for the purpose of task management and hosting an online community website featuring shared communications between technicians.'" 10 TTABVUE 9-10.[34]

We must construe the discrete goods and services in the cited registration as broadly as reasonably possible "to include all goods [and services] of the nature and type described therein," *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (quoting *In re Jump Designs 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

[33] The same principle applies, of course, to the two services separated by semi-colons in Applicant's Class 38 identification, and the five services separated by semi-colons in Applicant's Class 42 identification.

[34] Applicant's argument that "Registrant's services are providing use of **unspecified** computer software which does not immediately connote digital content creation and streaming," 4 TTABVUE 18, simply ignores the field-of-use language regarding the identified software in both classes in the cited registration, which indicates that the uses of the Class 9 software and Class 42 software-related services in the cited registration both pertain to the Class 38 "broadcasting, webcasting, streaming, and transmission" services and the "telecommunications services" identified in the application. The third-party registrations discussed below confirm that these services are commonly offered by the same entity.

the Trademark Act. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015) (citing 15 U.S.C. §1057(b)); *see also David Crystal, Inc. v. Soo Val. Co.*, 471 F.2d 1245, 176 USPQ 326, 327 (CCPA 1973) ("In view of the requirement in the law that the description of goods in an application for registration be specific, we consider it proper in this case to construe [applicant's] description of its goods in the manner most favorable to [registrant].") (footnote omitted).

a. Class 38

The Examining Attorney does not specify whether both of the Class 38 services identified in the application are related to the goods and services identified in the cited registration. The record establishes, however, that one or both of Applicant's Class 38 services are related to the goods and services identified in the cited registration.

The record contains 14 third-party, use-based registrations, owned by 10 separate owners, of marks for one or both of the Class 38 services (or equivalents) identified in the application and one or both of the pertinent Class 9 goods and Class 42 services (or equivalents) identified in the cited registration. We describe them below:

- Registration No. 5001027 for (1) "downloadable software to enable uploading, creating, posting, showing, displaying, blogging, sharing and otherwise providing electronic media or information over the internet and other communications networks" (Class 9); (2) "electronic communications services, namely, transmission of data, text, audio, video, images and multimedia content among users of computers, mobile and handheld computers, and wired and wireless communication devices," "webcasting services," "transmission of messages, data and content via a global computer network and other computer and communications networks," and "telecommunications services, namely, streaming of audio, visual and audiovisual material via the Internet or other computer or communications networks" (Class 38); and (3) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying,

blogging, sharing and transmitting of electronic media, videos, or information via a global communication network" and "providing a web hosting platform featuring temporary use of non-downloadable software allowing users to post, display, and share videos and digital content" (Class 42);[35]

- Registration No. 5418573 for (1) "downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming, and transmitting of electronic media, video, real-time news, entertainment content, or information over the internet and other communications networks" (Class 9); (2) "telecommunications services, namely, transmission and streaming of voice, data, images, audio, video, real-time news, entertainment content, or information by means of telecommunications networks, wireless communication networks, and the internet" (Class 38); and (3) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos, or information via a global communication network" (Class 42);[36]

- Registration No. 5800559 for (1) "telecommunications services, namely, transmission of podcasts," "Internet broadcasting services," "webcasting services," "transmission of messages, data and content via a global computer network and other computer and communications networks," and "telecommunications services, namely, electronic transmission of streamed audio and video files via computer and other communications networks" (Class 38), and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos or information" (Class 42);[37]

- Registration No. 5788394 for (1) "downloadable software to enable creating, recording, uploading, posting, editing, showing, displaying, blogging, sharing, streaming, accessing or transmitting of digital media content, electronic media, video, music, entertainment content, educational content, live events, data, news, and information over the internet and other communications networks or via mobile devices" (Class 9); (2) "electronic transmission or streaming of digital media content, electronic media, video, music, entertainment content, educational content, live events, data, news, and information over the internet and other communications networks or via mobile devices networks" (Class 38); and (3) "providing temporary use

[35] June 8, 2022 Final Office Action at TSDR 55-65. This registration and Registration Nos. 5001027 and 6611217 discussed below show different marks, but have a common owner.

[36] *Id.* at TSDR 66-69.

[37] *Id.* at TSDR 70-88.

of non-downloadable software to enable creating, recording, uploading, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of digital media content, electronic media, video, music, entertainment context, educational content, live events, data, news, and information over the internet and other communications networks" (Class 42);[38]

- Registration No. 5840293 for (1) "downloadable computer software for transmitting data, graphics, audio and/or video over electronic communications networks" (Class 9); (2) "video on demand transmission," "streaming of audio, visual, multimedia material on the Internet," and "telecommunications services, namely, broadcasting a wide variety of programs, meetings, events, and real time information over global computer communications networks" (Class 38); and (3) "providing temporary use of non-downloadable software to enable uploading, posting, showing, playing, streaming, viewing, sharing, publishing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content and information via the Internet and other communications networks" (Class 42);[39]

- Registration No. 6364710 for (1) "software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer and communications networks" (Class 9), and (2) "telecommunications services, namely, electronic transmission of data, messages, graphics, images, audio, video and information" (Class 38);[40]

- Registration No. 6211730 for (1) "computer software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer[,] the internet and communications networks" (Class 9); (2) "telecommunications services, namely, electronic transmission of data, messages, graphics, photographs, images, audio, video, audio-visual content, and information," "audio, text and video broadcasting services over the internet and other communications networks," and "streaming and live streaming of video,

[38] *Id.* at TSDR 89-92.

[39] *Id.* at TSDR 93-96.

[40] *Id.* at TSDR 97-106. This registration and Registration No. 6318050 discussed below show different marks, but have a common owner.

audiovisual, and interactive audiovisual content via the internet" (Class 38); and (3) "providing temporary use of non-downloadable software for social networking, creating a virtual community, and transmission of audio, video, images, text, content, and data" and "providing temporary use of non-downloadable software for uploading, downloading, archiving, enabling transmission of, and sharing images, audio-visual and video content and associated text and data" (Class 42);[41]

- Registration No. 5805691 for (1) "telecommunication services, namely, transmission and streaming of voice, data, images, audio, video, real-time news, entertainment content, or information by means of telecommunications networks, wireless communication networks, and the internet" (Class 38), and (2) "providing temporary use of non-downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news, entertainment content, or information" and "providing a web hosting platform featuring temporary use of non-downloadable software allowing users to upload, post, display, stream, and share videos and digital content" (Class 42);[42]

- Registration No. 6318050 for (1) "downloadable software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, and transmitting, and sharing or otherwise providing electronic media or information via computer and communications networks" (Class 9), and (2) "audio, text and video broadcasting services over the internet and other communications networks," "streaming and live streaming of video, audiovisual and interactive audiovisual content via the internet," and "telecommunication services, namely, electronic transmission of electronic media, data, messages, graphics, images, audio, and video and information" (Class 38);[43]

- Registration No. 5959066 for (1) "downloadable computer software for transmitting data, graphics, audio and/or video over electronic communications networks" and "downloadable computer software to enable uploading, posting, showing, playing, streaming, viewing, sharing, publishing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content and information via the Internet and other communications networks" (Class 9); (2) "telecommunications and information technology services, namely,

[41] *Id.* at TSDR 107-13.

[42] *Id.* at TSDR 114-17.

[43] *Id.* at TSDR 118-24.

transmission of voice, data, images, audio, and information via telephone and global communications networks," "transmission and delivery of electronic media, multimedia content, videos, movies, text, and audio content, namely, streaming of audio, visual, multimedia material on the Internet," and "transmission and delivery of electronic media, multimedia content, videos, movies, text, and audio content, all of the foregoing digital content via the Internet and other communications networks being wireless communications networks" (Class 38); and (3) "providing temporary use of non-downloadable software to enable uploading, posting, showing, playing, streaming, viewing, sharing, publishing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content and information via the Internet and other communications networks" (Class 42);[44]

- Registration No. 6512267 for (1) "downloadable software for receiving, creating, editing, uploading, downloading, accessing, modifying, organizing, viewing, posting, displaying, analyzing, annotating, indicating sentiment about, commenting on, transmitting, storing, managing, delivering, and sharing or otherwise providing audio, video, audio-visual content, data, and information via computer, the Internet, and communications networks" and "downloadable software for uploading, downloading, transmitting, and sharing audio, audio-visual and video content and associated text and data" (Class 9), and (2) "telecommunications and peer-to-peer network computer services, namely, electronic transmission of audio, video, and audio-visual content, data, comments, and information" (Class 38);[45]

- Registration No. 6366064 for (1) "computer software for streaming, broadcasting, transmitting, distributing, reproducing, organizing and sharing music, audio, video, audiovisual, multimedia content and other data via a global communications network" and "software for text, image and sound transmission and display" (Class 9); (2) "telecommunications, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks," "electronic transmission of data, audio, video, and audio-video files," "broadcasting services, namely, audio and video broadcasting services, broadcasting of cinematographic films and audiovisual programs, internet broadcasting," "video communication services, namely, broadcasting, streaming, and transmitting videos, images, music audio, multimedia over the Internet or

[44] *Id.* at TSDR 124-30.

[45] *Id.* at TSDR 135-38. This registration and Registration No. 6667979 discussed below show different marks, but have a common owner.

other communications networks," "telecommunication services, namely, transmission and streaming of voice, data, images, films, television programs, audio and audiovisual programs and other digital media content and information by means of telecommunications networks, wireless communication networks, and the internet," "streaming of audio, video and audiovisual material on the Internet, communications networks and wireless telecommunications networks," "audio and video broadcasting services," and "Internet broadcasting services" (Class 38); and (3) "providing temporary use of non-downloadable computer software for streaming, broadcasting, transmitting, distributing, reproducing, organizing and sharing music, audio, video, games, and other data" (Class 42);[46]

- Registration No. 6667979 for (1) "downloadable software and downloadable software in the nature of a mobile application for receiving, creating, editing, uploading, downloading, accessing, modifying, organizing, viewing, posting, displaying, analyzing, annotating, indicating sentiment about, commenting on, transmitting, storing, managing, delivering, and sharing or otherwise providing audio, video, audio-visual content, data, and information via computer, the Internet, and communications networks" and "downloadable software and downloadable software in the nature of a mobile application for uploading, downloading, transmitting, and sharing audio, audio-visual and video content and associated text and data" (Class 9); (2) "telecommunications and peer-to-peer network computer services, namely, electronic transmission of audio, videos, and audio-visual content, data, comments, and information" (Class 38); and (3) "providing on-line non-downloadable software for uploading, downloading, enabling transmission of, and sharing audio, audio-visual and video content and associated text and data" (Class 42);[47] and

- Registration No. 6611217 for (1) "downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming, and transmitting of electronic media, video, real-time news, entertainment content, and information over the Internet and other communications networks" (Class 9); (2) "telecommunication services, namely, transmission and streaming of voice, data, images, audio, video, real-time news, entertainment content, and information by means of telecommunications networks, wireless communication networks, and the internet" (Class 38); and (3) "providing temporary use of online non-downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of

[46] *Id.* at TSDR 139-48.

[47] *Id.* at TSDR 149-52.

> electronic media, video, real-time news, entertainment content, and information" (Class 42).[48]

"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 (citing *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)). Particularly given that the majority of these registrations cover one of the Class 38 services in the application and **both** the Class 9 goods and the Class 42 services in the cited registration, these registrations "are sufficient in both quality and quantity to provide a reasonable predicate supporting the Examining Attorney's position on relatedness [regarding Class 38] and shift the burden to Applicant to rebut the evidence with competent evidence of its own." *Country Oven*, 2019 USPQ2d 443903, at *10.[49] Applicant did not rebut this evidence

[48] *Id.* at TSDR 153-56.

[49] As the Examining Attorney implicitly acknowledges, 7 TTABVUE 12-13, the third-party webpages in the record that are directed to assisting influencers or content creators to connect with their fans, or to fundraise or monetize content, including pages from Facebook and Instagram, October 18, 2022 Denial of Request for Reconsideration at TSDR 3-4, 11-17, which together own three of the registrations discussed above, do not appear to have as their primary function providing Applicant's Class 38 services of "broadcasting, webcasting, streaming, and transmission of audio, video, subscription television programs, and video-on-demand content via the internet and electronic communications networks" and the "transmission of voice, data, images, graphics, audio, video, and multimedia by means of wired and wireless networks." The third-party registration evidence is sufficient, however, to establish that the involved identified goods and services commonly originate from a common source.

"with competent evidence of its own,"[50] and we find that the second *DuPont* factor supports a conclusion that confusion is likely with respect to at least one of Applicant's Class 38 services.

b. Class 42

The five Class 42 services identified in the application are:

> Providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content; hosting an online website featuring artists and digital content creators; providing a website featuring technology that enables users to raise and transfer money to pay for media content; providing a website featuring technology that enables users to offer rewards to their customers; providing an interactive website featuring technology that enables users to share user-created media content, comment on media content, and exchange commentary concerning the same with one another.

The pertinent Class 42 services in the cited registration are:

> Providing temporary use of nondownloadable computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks. . . .

[50] Applicant made of record pages from its own website and that of the cited registrant, February 18, 2022 Response to Office Action at TSDR 2-5; April 6, 2022 Response to Suspension Inquiry or Letter of Suspension at TSDR 2-6, 43-52, and, as discussed above, Applicant argues that its actual services and the registrant's actual services differ. "[B]ecause there are no restrictions in the [pertinent] identifications in either the application or cited registration, we may not 'import restrictions into the identification[s] 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 (quoting *New Era*, 2020 USPQ2d 10596, at *16).

Construing the registrant's discrete service of "providing temporary use of nondownloadable computer software for use in posting [and] transmitting . . . text, audio, visual and multimedia . . . content via computers, mobile phones, wired and wireless communication devices, and . . . electronic communications networks" as broadly as reasonably possible, and resolving any ambiguity regarding its coverage in favor of the registrant, we hold that it is intrinsically related to Applicant's service of "providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content." Both services perform the same function of allowing persons accessing a website to post and disseminate text, audio, and audiovisual content through the website, and, as the Examining Attorney noted at the oral hearing, Applicant's service necessarily involves the "temporary use of nondownloadable computer software" even if the user of the website is unaware that such software is being used when logging in and posting content.

The intrinsic relatedness of these Class 42 services is reflected in and corroborated by the record, which contains 11 third-party, use-based registrations, owned by nine separate owners, of marks for the first of the five Class 42 services identified in the application (or an equivalent) and the pertinent Class 42 services identified in the cited registration (or an equivalent). We describe them below:

- Registration No. 5001027 for (1) "providing a website that gives computer users the ability to transmit, cache, receive, download, stream, broadcast, display, format, transfer and share content, text, visual works, audio works, audiovisual works, data, files, documents and electronic works," and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos, or information via a global communication network" and "providing a web hosting platform featuring

temporary use of non-downloadable software allowing users to post, display, and share videos and digital content;"[51]

- Registration No. 5418573 for (1) "providing a website featuring non-downloadable software to enable recording, transmitting, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news and entertainment content and other information" and "providing a web hosting platform featuring temporary use of non-downloadable software allowing users to upload, post, display, stream, and share videos and digital content," and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos, or information via a global communication network;"[52]

- Registration No. 5800559 for (1) "providing online facilities, namely, a website that gives users the ability to upload, modify and share audio, video, photographic images, text, graphics and data," "hosting an interactive website and providing temporary use of online non-downloadable software for uploading, downloading, posting, showing, displaying tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio context, animation, pictures, images, text, information, and other user-generated content via a global computer network and other computer and communications networks;" "providing a website featuring non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos, or information," and "providing a web hosting platform featuring temporary use of non-downloadable software for allowing users to post, display, and share videos and digital content," and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, displaying, blogging, sharing and transmitting of electronic media, videos or information;"[53]

- Registration No. 5788394 for (1) "providing a website featuring non-downloadable software to enable creating, recording, uploading, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of digital media content, electronic media, video, music, entertainment content, educational content, live events, data, news, and information over the internet and other communications networks," and (2) "providing

[51] June 8, 2022 Final Office Action at TSDR 55-65. This registration and Registration Nos. 5001027 and 6611217 discussed below show different marks, but have a common owner.

[52] *Id.* at TSDR 66-69.

[53] *Id.* at TSDR 70-88.

temporary use of non-downloadable software to enable creating, recording, uploading, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of digital media content, electronic media, video, music, entertainment context, educational content, live events, data, news, and information over the internet and other communications networks;"[54]

- Registration No. 5840293 for (1) "providing an interactive website featuring non-downloadable software technology that enables users to post, search, watch, share, critique, rate, and comment on, video and other multimedia content via the Internet and other communications networks," and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, playing, streaming, viewing, sharing, publishing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content and information via the Internet and other communications networks;"[55]

- Registration No. 6211730 for (1) "providing online sites that gives [sic] users the ability to upload, modify and share augmented reality content, information, experiences and data" and "providing online facilities that give users the ability to upload, modify and share audio, video, photographic images, text, graphics and data," and (2) "providing temporary use of non-downloadable software for social networking, creating a virtual community, and transmission of audio, video, images, text, content, and data" and "providing temporary use of non-downloadable software for uploading, downloading, archiving, enabling transmission of, and sharing images, audio-visual and video content and associated text and data;"[56]

- Registration No. 5805691 for (1) "providing a website featuring non-downloadable software to enable recording, transmitting, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news and entertainment content and other information," and (2) "providing temporary use of non-downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news, entertainment content, or information" and "providing a web hosting platform featuring temporary use of non-

[54] *Id.* at TSDR 89-92.

[55] *Id.* at TSDR 93-96.

[56] *Id.* at TSDR 107-13.

downloadable software allowing users to upload, post, display, stream, and share videos and digital content;"[57]

- Registration No. 5959066 for (1) "computer services, namely, hosting and maintaining an online website for others to electronically store content in the nature of photos, videos, text, and audio for others," "providing a website featuring technology that enables users to upload and share videos on a wide variety of topics and subjects," and "providing an interactive website featuring on-line non-downloadable software technology that enables users to post, search, watch, share, critique, rate, and comment on, videos and other multimedia content via the Internet and other communications networks," and (2) "providing temporary use of non-downloadable software to enable uploading, posting, showing, playing, streaming, viewing, sharing, publishing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content and information via the Internet and other communications networks;"[58]

- Registration No. 6366064 for (1) "hosting a website for the electronic storage of data, audio files, images, and videos," "hosting of third party content, photos, videos, text, data, images, web sites and other electronic works" and "providing a web site that gives computer users the ability to transmit, cache, receive, download, stream, broadcast, display, format, transfer and share content, text, visual works, audio works, audiovisual works literary works, photos, videos, data, files, documents, images and other electronic works," and "providing a website featuring technology enabling users to upload and download electronic files," and (2) "providing temporary use of non-downloadable computer software for streaming, broadcasting, transmitting, distributing, reproducing, organizing and sharing music, audio, video, games, and other data;"[59]

- Registration No. 6667979 for (1) "creating a virtual community for registered users to share, view, subscribe to and interact with audio, audio-visual and video content and related data and information," and (2) "providing on-line non-downloadable software for uploading, downloading, enabling transmission of, and sharing audio, audio-visual and video content and associated text and data;"[60] and

[57] *Id.* at TSDR 114-17.

[58] *Id.* at TSDR 124-30.

[59] *Id.* at TSDR 139-48.

[60] *Id.* at TSDR 149-52.

- Registration No. 6611217 for (1) "providing a website featuring non-downloadable software to enable recording, transmitting, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news and entertainment content and other information," and (2) "providing temporary use of online non-downloadable software to enable uploading, creating, posting, editing, showing, displaying, blogging, sharing, streaming and transmitting of electronic media, video, real-time news, entertainment content, and information."[61]

The third-party use evidence also shows some websites that offer services that fairly fall within the full scope of the Class 42 services identified in the application as "providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content."[62] As discussed above, when content-provider users access and use these sites, they necessarily make "temporary use of nondownloadable computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks."

[61] *Id.* at TSDR 153-56.

[62] December 7, 2021 Office Action at TSDR 51, 56 (OnlyFans allows an actress to "share unseen photos, videos, and advice!" and a vocalist to "share[ ] exclusive music content for his dedicated fans"), 63 (fangage.com allows "fans to unlock tracks, playlists, video's [sic], contests, coupons, live streams, merchandise, event tickets and even in-person meet & greets on your website"), 89 (truefanz.com allows users to "[e]asily create and upload tutorials, tips, behind the scenes footage, or whatever your fanz want to see"); June 8, 2022 Final Office Action at TSDR 40-41 (topfan.com allows creators to "Bring All Your Content & Sales Into One Place" to "Deliver free & premium content and sell merchandise directly to your audience without the middlemen"); October 18, 2022 Denial of Request for Reconsideration at TSDR 3 (discussing uploading content to Facebook), 9 (discussing ways to publish content on YouTube), 12-13, 17 (discussing ways to publish content through Instagram).

Against the backdrop of the intrinsic relatedness of the involved Class 42 services, the third-party registration and use evidence is sufficient to support the Examining Attorney's position on relatedness regarding Class 42. *Country Oven*, 2019 USPQ2d 443903, at *14. The second *DuPont* factor supports a conclusion that confusion is likely with respect to at least one of the Class 42 services identified in the application.

2. Similarity or Dissimilarity of the Channels of Trade and Classes of Consumers

The Class 38 and 42 services identified in the application as

> Broadcasting, webcasting, streaming, and transmission of audio, video, subscription television programs, and video-on-demand content via the internet and electronic communications networks; telecommunication services, namely, transmission of voice, data, images, graphics, audio, video, and multimedia by means of wired and wireless networks (Class 38), and
>
> Providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content (Class 42)

and the Class 9 goods and Class 42 services identified in the cited registration as

> Computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks (Class 9) and
>
> Providing temporary use of nondownloadable computer software for use in posting, transmitting, retrieving, receiving, reviewing, organizing, searching and managing text, audio, visual and multimedia data and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks (Class 42).

are either expressly rendered or provided through "electronic communications networks" or are, by definition, rendered through such networks ("transmission of voice, data, images, graphics, audio, video, and multimedia by means of wired and wireless networks" (Class 38) and "providing a website that gives users the ability to publish their own text-based reading content, audio content, and audio-visual content" (Class 42)). The channels of trade for these goods and services all involve website providers and thus overlap with respect to both Class 38 and Class 42.

There are no limitations on the classes of customers to whom the involved goods are sold and the involved services are rendered, and the involved identifications and webpages show that the "usual customers for such goods [and services]," *Embiid*, 2021 USPQ2d 577, at *31 (quoting *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *13-14 (TTAB 2020)), include members of the general public.[63]

The third *DuPont* factor supports a conclusion that confusion is likely with respect to both Class 38 and Class 42 in the application.

C. Purchase Conditions and Consumer Sophistication

The fourth *DuPont* factor considers "the conditions under which and buyers to whom sales are made, i.e., 'impulse vs. careful, sophisticated purchasing." *Embiid*, 2021 USPQ2d 577, at *31 (quoting *DuPont*, 177 USPQ at 567).

In its appeal brief, Applicant argues, without citing any record evidence, that

> [u]sers of Applicant's digital content creation platforms are typically certain of the type video content they are seeking and therefore are particularly discerning and pay close

[63] As explained above, contrary to Applicant's claims, the involved portions of the identifications in the cited registration are not limited to businesses and technicians.

> attention to the content the online platform offers. The consumers of Registrant's business-to-business offering of mobile workforce solution software and location technology are also likely to be sophisticated and discerning. So here, the consumers of the goods and services for both these separate groups will be discerning and would exercise a high degree of care in utilizing services under the respective marks, and thus there is no likelihood of confusion.

4 TTABVUE 19.

The Examining Attorney responds that the "relevant purchasers for [the] parties' goods and services . . . include casual, non-professional buyers and members of the general public. The relevant consumers in this case are therefore not sophisticated, which weighs in favor of a likelihood of confusion." 7 TTABVUE 14-15. The Examining Attorney further argues that "Applicant's characterization of the registrant's goods and services . . . artificially limits the type and number of relevant consumers for those goods and services" because the cited registration "identifies a broad array of goods and services" that "presumably encompass all goods and services of those types, including goods and services intended for and/or primarily used by casual consumers, who are neither businesses nor professionals," *id.* at 15 (citations omitted), while the application "identifies media transmission and website services, e.g. 'providing an interactive website featuring technology that enables users to share user-created media content, comment on media content, and exchange commentary concerning the same with one another'," which "presumably encompass all services of those types, including services intended for and/or primarily used by casual consumers, who are neither businesses nor professionals." *Id.* at 16 (citation omitted).

The Examining Attorney also argues that Applicant's claims regarding the sophistication of the relevant purchasers are "unsupported by the evidence of record," *id.*, and that the record evidence shows that "the goods and services identified in the application and registration are commonly provided to the public at little or no cost." *Id.* (record citations omitted).

The Examining Attorney concludes that the "relevant purchasers for the parties' respective goods and services include casual, non-professional buyers and members of the general public," that the "goods and services identified in the application and registration are also relatively inexpensive and/or free," and that the "relevant purchasers in this case therefore cannot be considered sophisticated for likelihood of confusion purposes." *Id.* at 17.

In its reply brief, Applicant frames the issue under the fourth *DuPont* factor as follows: "Is expert testimony or evidence of likely consumer care and sophistication required when, given the goods and services at issue, the common-sense conclusion is that the likely purchasers will be careful and sophisticated?" 10 TTABVUE 5. Applicant answers that "a simple review of the goods and services associated with the Registered Mark (software mainly for business use) leads to the inescapable, common sense conclusion that the consumers or [sic] those goods and services are likely to be sophisticated and careful in their purchasing decisions" and "[e]xpert testimony is not necessary to establish such common knowledge and common sense conclusions." *Id.* at 11. Applicant cites a Federal Circuit patent case in which the court, discussing a claim of patent invalidity for obviousness, held that "some cases involve technologies

and prior art that are simple enough that no expert testimony is needed," *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 124 USPQ2d 1081, 1090 (Fed. Cir. 2017) (citations omitted), and concluded that what was claimed and described in the patent-in-suit "makes this such a case." *Id.* Applicant argues that the "same can be said for whether consumers of software for business purposes are going to be careful, cautious, cost-conscious and discerning; *i.e.,* sophisticated." 10 TTABVUE 11.

Although *Intercontinental Great Brands* did not involve the issue here, we agree with Applicant that expert testimony is not required here to show consumer sophistication. But **some** evidence of consumer care is required where, as here, the inherent nature of the goods or services, or the circumstances of their purchase, do not make an enhanced degree of care self-evident, and Applicant provides only argument of counsel, "which is 'no substitute for evidence.'" *Embiid*, 2021 USPQ2d 577, at *40 (quoting *In re OEP Enters. Inc.*, 2019 USPQ2d 309323, at *46 (TTAB 2019)).

"Board precedent requires our decision to be based on the least sophisticated potential purchasers." *In re FCA US LLC*, 126 USPQ2d 1218, 1222 (TTAB 2018) (citing *Stone Lion,* 110 USPQ2d at 1163), *aff'd mem.*, 778 F. App'x 962 (Fed. Cir. 2019). The least sophisticated potential purchasers of the Class 38 and Class 42 services identified in the application include members of the general public who are unlikely to exercise anything more than ordinary care in purchasing the services. The

fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion in both classes.

D. Summary

The first, second, and third *DuPont* factors support a conclusion that confusion is likely as to both Class 38 and Class 42 in the application, while the fourth *DuPont* factor is neutral. The marks are identical in sound and meaning, and more similar than dissimilar in appearance. The Class 38 services in the application may emanate from entities who also offer the Class 9 goods and the Class 42 services identified in the cited registration, while the first of the five Class 42 services identified in the application are intrinsically related to the pertinent Class 42 services identified in the cited registration, and those sets of services also may emanate from the same entities. The channels of trade and classes of consumers for the involved services identified in the application and the pertinent goods and services identified in the cited registration overlap. We conclude, based on the record as a whole, that consumers familiar with the LOCALZ standard-character mark shown in the cited registration for the first set of goods in Class 9 and the first set of services in Class 42 identified therein, who separately encounter Applicant's composite mark, dominated by the word "Locals," for the Class 38 services and the first of the Class 42 services identified in the application, are likely to believe mistakenly that the involved goods and services have a common source.

Decision: The refusal to register is affirmed as to both Class 38 and Class 42 in their entireties.