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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91251836
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Serial No. 88311073 Mark: BELAY BANK Filed: February 21, 2019	)
Belay Mortgage Group, Inc. Opposer, v. FB Corporation Applicant.	) Opposition No. 91251836

OPPOSER'S TRIAL BRIEF

Opposer Belay Mortgage Group ("Belay" or "Opposer"), by and through its attorneys, files this Trial Brief in support of its Notice of Opposition and hereby moves the Trademark Trial and Appeal Board (the "Board") to refuse registration of Applicant FB Corporation's ("Applicant") pending application Serial No. 88/311,073 for registration of the mark BELAY BANK ("Applicant's Mark") because there is a likelihood of confusion between Applicant's Mark and Belay's Mark, BELAY MORTGAGE GROUP, in which Opposer has had common law rights beginning at least from April 1, 2018.

The Board has already rejected Applicant's virtually identical BELAY FINANCIAL mark, in Opposition No. 91251959. (22 TTABVUE). The facts and law in both opposition proceedings are essentially the same – and Opposer respectfully

suggests that the Board should reach the same conclusion in this proceeding, by sustaining the opposition to registration of Applicant's Mark on the ground of priority and likelihood of confusion under Section 2(d), 15 U.S.C. §1052(d).

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DESCRIPTION OF THE RECORD

The evidence of record in this case consists of:

1. The testimony declarations of Opposer's witnesses, Jodi White ("White Decl."), Carlos Caicedo ("Caicedo Decl."), Matt Molenar ("Molenar Decl."), Scott Huotori ("Huotori Decl."), Maranda Cole ("Cole Decl."), and various exhibits referenced therein.

2. File history for the mark BELAY BANK.

I. STATEMENT OF THE ISSUES

Opposer began using the mark BELAY MORTGAGE GROUP ("Opposer's Mark" or "Belay's Mark") at least as early as January 25, 2018, and in use in interstate commerce at least as early as April 1, 2018, in connection with mortgage brokerage services. As a result, Opposer owns common law rights in Opposer's Mark.

Subsequently, on February 21, 2019, Applicant filed U.S. Trademark Application Serial No. 88/311,073 (the "Opposed Application") to register BELAY BANK in connection with "banking services, financial trust operations, mortgage banking, and mortgage lending." ("Applicant's Services").

On the same day – February 21, 2019 – Applicant also filed U.S. Trademark Application Serial No. 88/311,089 to register BELAY FINANCIAL in connection with identical services – "banking services, financial trust operations, mortgage banking, and mortgage lending." **On December 23, 2021, after hearing oral argument, in Opposition**

No. 91251959, the Board sustained Opposer's opposition to Applicant's BELAY FINANCIAL mark, which is now abandoned (see Sections II.D and III.B below).

The first use date for Opposer's Mark precedes the filing date for the Opposed Application. Applicant did not submit any evidence during its testimony period and thus, the earliest date that Applicant can rely upon for priority is the filing date of its intent-to-use application, namely, February 21, 2019. *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009); *see also* TBMP 704.03.

The only issue before the Board is whether registration of Applicant's BELAY BANK mark should be refused registration under 15 U.S.C. § 1052(d) based upon a likelihood of confusion with Opposer's common law use of the BELAY MORTGAGE GROUP mark.

II. RECITATION OF FACTS

A. Summary of the Parties' Marks and Services.

Belay Mortgage Group, Inc. was founded in January 2018. (White Decl. ¶8.) Opposer's business was registered in Washington State as BELAY MORTGAGE GROUP in April 2018. (Id. ¶8 Ex. A.) Opposer offers mortgage lending services and is licensed to do business in California, Washington, and Oregon. (Id. ¶4.) Opposer also provides credit assessment services. (Id. ¶10.) Opposer is licensed to do business in those three states under the name BELAY MORTGAGE GROUP. (Id. ¶9 Ex. B.)

On February 21, 2019, Applicant applied for registration of the mark BELAY BANK, U.S. Application Serial No. 88/311,073, in connection with "banking services,

financial trust operations, mortgage banking, and mortgage lending." The application was based on intent-to-use. See file history for Applicant's Mark.

Opposer's first use of the BELAY MORTGAGE GROUP mark, as well as its first use in commerce of that mark, both occurred well before the filing date of Applicant's application for Applicant's Mark, BELAY BANK. Thus, priority is not an issue.

B. Use and Promotion of the BELAY MORTGAGE GROUP mark by Opposer.

Since Opposer began its operations in 2018, Opposer has invested countless hours on branding activities in Washington, Oregon, and California. (White Decl. ¶12.) Opposer's promotional activities have included serving on charity boards, making charitable donations, holding events for fundraising for nonprofits, and attending annual conferences in California and Washington. (Id. ¶13.) Opposer's co-founder Jodi White has attended a number of professional business events and has handed her business card out to many contacts throughout the United States. (Id. ¶14.) These business cards prominently display Opposer's mark, BELAY MORTGAGE GROUP – and Opposer has used cards with Opposer's Mark since 2018. (Id. ¶23 Ex. J.) Opposer's principal, Jodi White, began promoting Opposer's services on social media in April 2018, and Opposer's business network was fully aware at that time that Ms. White had "launched Belay." (Caicedo Decl. ¶8.)

Belay's marketing efforts have been dedicated towards building personal relationships over time, rather than dedicating money towards other forms of advertising such as print or TV commercials. (White Decl. ¶11.) A substantial part of

Opposer's strategy is to create long-standing relationships with real estate agents. (Id.) These agents in turn refer Opposer to their clients for both refinance and purchase transactions. (Id.) The investment in building relationships rather than print and media marketing is much more effective long term for Opposer. (Id.)

The success of Opposer's aggressive personal marketing efforts is evident – Opposer Belay has received numerous referrals leading to satisfied clients in Washington State, Oregon, and California. (White Decl. ¶¶23-31.) Opposer's referral sources include Scott Huotori, who Belay's principal met at a networking event (Id. ¶25.) Mr. Huotori has referred Opposer approximately twelve clients in Washington, Oregon, and California since 2018. (Id.; see also Huotori Decl. ¶4.) Another referral source, Maranda Cole, sent Opposer a refinancing deal in Sonoma County, California. (White Decl. ¶26, Exs. L and M.) Opposer provided loan origination services for this client at least as early as July 18, 2018. (Cole Decl. ¶¶3-4, Ex. A at BELAY000021) (listing "Belay Mortgage Group, Inc." as the loan origination organization).

Moreover, Opposer has maintained an active presence on the internet since early 2018, purchasing the domain name <<belaymortgage.com>> in January of that year and launching a website in April. (White Decl. ¶16.) That website was active in April 2018 and was displaying Opposer's services for mortgage brokering. (Molenar Decl. ¶5.) Opposer's website has been configured since April 2018 to allow anyone in the world – including the United States – to start a loan application. (White Decl. ¶16.) Opposer's website has been active and operational since April 2018. (Id.)

Opposer has also gained significant recognition on the internet through its presence on third-party websites, such as Yelp.com. (White Decl. ¶18.) Opposer launched its Yelp page in or about August 2018; has promoted its services there in Washington, Oregon, and California; and has received stellar reviews from customers in all three states. (Id. ¶¶18-19, Exs. E and F.) Opposer also has a Google Business page which displays many rave reviews from satisfied customers. (Id. ¶20 Ex. G.) A number of people based in California have sent referrals to Opposer after discovering Belay by searching "mortgages" on Google. (Id. ¶20.) In addition, Opposer has also been active on its Facebook page since February 2018 and has promoted its services there for multiple U.S. states and interacted with page visitors about Opposer's services. (Id. ¶21 Ex. H.) Still another widely-known site, Zillow.com, displays reviews from Opposer's clients in Washington, Oregon, and California. (Id. ¶22 Ex. I.)

C. Applicant's BELAY BANK Mark.

There is no evidence of record showing that Applicant has used Applicant's Mark — the application for which was filed on an intent-to-use basis. See file history for Applicant's Mark.

D. The Board's Decision Regarding Applicant's BELAY FINANCIAL Mark.

In this proceeding, the Board has previously taken judicial notice of the prosecution history of Opposition No. 91251959. On October 4, 2021, in this '836 proceeding, the Board took notice of documents filed in the '959 proceeding (see Opposition No. 91251836 TTABVUE 15 at 2-3). The Board noted that "Applicant does

not contradict Opposer's contention that the parties had an agreement to treat these proceedings together" (Id. at 5). The Board further determined that:

> "Applicant does not challenge Opposer's contentions that 'both sides operated with the agreement that the evidence would apply equally to both,' (12 TTABVUE 10), and that 'both involve the same parties, issues, and evidence, and Applicant's counsel has had access to all of Opposer's evidence for months (since March 2, 2021).' (Id. at 13)."

(Id. at 6; citing documents filed in '959 proceeding.) The Board also noted that "Applicant does not refute Opposer's contentions that … the parties had a 'mutual understanding that the '836 and '959 proceedings were to be treated in tandem'…" (Id. at 6.)

Subsequently, on December 23, 2021, in the '959 proceeding, the Board issued a final decision and sustained Opposer's opposition to registration of Applicant's BELAY FINANCIAL mark, on the ground of priority and likelihood of confusion under Section 2(d), 15 U.S.C. §1052(d) (see Opposition No. 91251959 TTABVUE 22 at 24).

As the Board has previously noted, not only did both parties agree to treat both proceedings in tandem, but they "both involve the same parties, issues, and evidence." (Opposition No. 91251836 TTABVUE 15 at 6). Accordingly, given the Board's decision to sustain the opposition against BELAY FINANCIAL in the virtually identical '959 proceeding, a decision to sustain the opposition against registration of BELAY BANK is warranted in this case.

III. ARGUMENT

To prevail in this Opposition, Belay must establish (1) standing to bring and maintain the Opposition, and (2) a valid ground for refusal of registration of Applicant's Mark, such as a likelihood of confusion. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Belay must prove its case by a preponderance of the evidence. *Cerveceria Centroamericana S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

"[T]he decision as to priority is made in accordance with the preponderance of the evidence." *Benjamin J. Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020 (T.T.A.B. 2009) (*quoting Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) ("*Giersch*").

A. Belay Has Standing to Bring this Opposition and Has Priority.

Section 14 of the Lanham Act provides that an opposition may be filed by "any person who believes that he is or will be damaged . . . by registration of the mark on the principal register." 15 U.S.C. §1064. Belay may show that it has standing by alleging and proving that it has a real commercial interest in its own mark and has a reasonable basis for its belief that it would be damaged by the registration of the mark in question. *Lipton Industries, Inc.*, 213 USPQ at 189; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USQP2d 1023 (Fed. Cir. 1999); *Baseball Am., Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1884 (TTAB 2004); *Giersch,* 90 U.S.P.Q.2d at 1022 (common law use sufficient to establish standing). Belay has standing in this Opposition because it has a real commercial interest in its BELAY

MORTGAGE GROUP mark and reasonably believes that registration of Applicant's mark will damage Belay's rights in its BELAY MORTGAGE GROUP mark.

B. Judicial Notice of the Board's Decision in the Related '959 Opposition Is Appropriate.

Judicial notice of the record in the related '959 proceeding was appropriate when – in this '836 proceeding – the Board previously took notice of the record in the '959 opposition (see Opposition No. 91251836 TTABVUE 15 at 2-3), and it remains appropriate now. TBMP 704.12(d) permits the Board to take judicial notice at any time. The Board's decision in a related case falls well within the guidelines for judicial notice set forth in TBMP 704.12(a), in that it is "capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." As the Board has noted, both parties agreed to treat the '836 and '959 opposition proceedings in tandem, and "both [oppositions] involve the same parties, issues, and evidence". (See Section II.D above.) Indeed, since the Board's time is finite, Opposer respectfully suggests that the Board need only verify that the two cases "involve the same parties, issues, and evidence," then use its prior decision as a basis for sustaining the opposition against Applicant's virtually identical BELAY BANK Mark in this proceeding.

C. Belay Has Alleged a Valid Ground for Denial of Registration of Applicant's Mark.

Belay has alleged likelihood of confusion as the basis for the Board to refuse registration of Applicant's Mark. The applicable substantive law is supplied by *In re E.I.*

DuPont de Nemours & Co., 476 F.2d 1357, 1361 (CCPA 1973), which sets forth a list of mandatory factors to be considered, when of record, in determining a likelihood of confusion exists sufficient to preclude registration of Applicant's mark. A finding of likelihood of confusion need not be supported by all, or even a majority of, the *DuPont* factors. *See, e.g., In re Majestic Drilling Co., Inc.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003) ("Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and 'any one of the factors may control in a particular case'") (citations omitted); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565 (Fed. Cir. 1983) (reversing dismissal of opposition despite finding that one of the four *DuPont* factors favored applicant); and *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 671 (Fed. Cir. 1984) (court must consider "pertinent" factors and make likelihood of confusion determination from "the probative facts in evidence").

Rather, "[a] determination of likelihood of confusion is the ultimate legal conclusion based on findings of fact for each pertinent *DuPont* factor considered together. *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992) (citing *Giant Foods, Inc.*, 710 F.2d at 1569). Review of the pertinent *DuPont* factors clearly supports Belay's position that there is a likelihood of confusion between the parties' marks.

Oral testimony, if sufficiently probative, normally is sufficient to establish priority of use, *Powermatics, Inc. v. Global Roofing Prods. Co.*, 341 F.2d 127, 144 U.S.P.Q. 430, 432 (CCPA 1965), and the testimony of a single witness may be adequate to

establish priority. *See Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 U.S.P.Q.2d 1175, 1184 (TTAB 2017). As indicated above in Section II.B, Opposer has provided the testimony of multiple witnesses to establish Opposer's priority of use. *See also, Giersch, supra* at *6 (weighing oral testimony and contemporaneous documentation to find common law rights).

1. DuPont Factor—Similarity of the Parties' Marks.

The similarity of marks is to be considered with respect to appearance, sound, and connotation. The proper test in determining the likelihood of confusion is based on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered. *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir. June 5, 1992); *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980).

In both Opposer's Mark and Applicant's Mark, the word BELAY is prominent, leaves the greatest commercial impression, and is the dominant feature of both marks — particularly since it is the first term in the mark, and Applicant was required to disclaim the word "financial" in its application. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) ("VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *In re Integrated Embedded*, 120 U.S.P.Q.2d 1504, 1513 (TTAB 2016) ("[T]he dominance of BARR in [a]pplicant's mark BARR GROUP is reinforced by its location as

the first word in the mark."); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Additionally, we note that Opposer has disclaimed the descriptive term "COCO." Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.3d 1056, 224 U.S.P.Q. 749, 752 (Fed. Cir. 1985). Opposer's mark is BELAY MORTGAGE GROUP, and so the marks differ only by their descriptive terms that follow the word BELAY — which is insufficient to avoid confusion.

Given the nearly identical nature of the marks in this case, the average purchaser would not recall the slight difference between BELAY MORTGAGE GROUP and BELAY BANK, resulting in confusion in the marketplace. Of course, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *In Re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008); *see also In re Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Id.*

Where the goods or services are identical in part or otherwise closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. As discussed further below, Applicant's and Opposer's services are virtually identical. Both are used (or intended to be used, in Applicant's case) in connection with financial services relating to mortgages.

Judged in their entireties, the appearance, sound, and connotation of BELAY MORTGAGE GROUP and BELAY BANK render them substantially and confusingly similar. This factor favors a finding of likelihood of confusion.

2. DuPont Factor—Relatedness of the Services Offered Under the Parties' Marks.

This factor requires examination of the relatedness of the goods or services. *DuPont*, 177 USPQ at 567. In this case, the fundamental question is whether the services at issue can be related in the mind of the consuming public as to the origin of the services. *Recot, Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). The question must be decided on the basis of the identification of goods or services set forth in the application, regardless of what the record may reveal as to the particular nature of applicant's goods, the particular channels of trade, or the class of purchasers to which sales of the goods or services are directed. *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000). It is not necessary that these respective services be

identical or even competitive in order to support a finding of likelihood of confusion. *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant's services listed in connection with its application to register the BELAY BANK mark encompass "banking services, financial trust operations, mortgage banking, and mortgage lending." Opposer has been offering mortgage brokerage services to consumers throughout the United States via the internet since at least April 2018.

In short, for purposes of judging likelihood of confusion, Applicant's and Opposer's services are essentially identical or at a minimum, are related. Accordingly, this factor weighs in favor of a likelihood of confusion.

3. DuPont Factor—Channels of Trade

The Board has held that the parties' goods need not be similar or competitive or move through the same channels of trade to support a holding of likelihood of confusion. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). In this case, while Opposer offers its services nationwide via the internet and through personal appearances throughout the U.S. West Coast, Applicant is relying on an intent-to-use application. Accordingly, Applicant has no existing channels of trade to discuss.

Applicant's potential future channels of trade, however, are unlimited. Applicant's application to register BELAY BANK does not contain any limitations as to

the channels of trade. Thus, it should be assumed that the parties could use the same channels of trade for their goods even if they are not now doing so. *B.V.D. Licensing Corporation v. Rodriguez*, 83 USPQ2d 1500, 1507 (TTAB 2007), *citing Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) ("There is no evidence that Opposer's and Applicant's goods are currently being sold in the same channels of trade. Yet, in neither the applicant's application nor the opposer's registrations are the trade channels in any way restricted. Thus, we must consider, for purposes of the likelihood of confusion analysis, that applicant could sell his goods in retail department stores such as J.C. Penney's and warehouse stores such as BJ's…the outlets through which opposer's goods are sold").

Without any limitation of Applicant's channels of trade, it can be presumed that its services will be sold through the same means as Opposer's, namely, across the internet to consumers throughout the United States, and in personal appearances that include the Western states where Opposer has a significant presence. This factor weighs in favor of a finding of likelihood of confusion.

4. DuPont Factor—The Parties Are Likely to Market Their Services to the Same Classes of Consumers.

Opposer offers mortgage brokerage services to customers who wish to obtain a mortgage for the purchase of real estate. Applicant's listed services include "mortgage banking" and "mortgage lending." These services are identical – and the parties seeking them are all in the same class of consumers – prospective mortgage borrowers.

Due to the likelihood of overlap in the parties' consumer bases, Opposer asserts that Applicant's potential consumer base is the same as or highly similar to Opposer's, and this factor should weigh in Opposer's favor. Of course, there is no restriction in applicant's identification of services regarding type of consumers — and thus, the Board must assume that the services of Opposer and Applicant will be marketed to overlapping classes of consumers. *B.V.D. Licensing Corporation*, 83 USPQ2d, at 1507, *citing Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990) ("an application with an identification of goods having no restriction on trade channels obviously is not narrowed by testimony that applicant's use is, in fact, restricted to a particular class of purchasers"). This factor weighs in favor of a finding of likelihood of confusion.

5. DuPont Factor—The Increasingly Widespread Use of Opposer's BELAY MORTGAGE GROUP Mark Increases the Likelihood of Confusion with Applicant's BELAY BANK Mark.

The fifth *DuPont* factor examines the prior mark in terms of sales, advertising, and length of use. In this case, Opposer began using its BELAY MORTGAGE GROUP mark well before the filing date of Applicant's intent-to-use application. Opposer has made significant efforts for several years to promote the BELAY MORTGAGE GROUP services in multiple states – with demonstrated success — and has been active in promoting those services on the internet.

Given that Opposer's BELAY MORTGAGE GROUP mark is widely used and recognized, while Applicant's BELAY BANK mark has not been used, consumers are likely to mistakenly associate BELAY BANK with Opposer. This factor also weighs in favor of a finding of likelihood of confusion.

6. DuPont Factors Related to Actual Confusion.

The final *DuPont* factor considers whether there has been actual confusion, the length of time and conditions under which there has been concurrent use without actual confusion, and the extent of potential confusion. Opposer need not prove actual confusion to prevail in this case, only a likelihood of confusion. *Motion Picture Association of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1564 (TTAB 2007). *See also Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Although Opposer is not aware of any actual confusion to date, this is simply because Applicant's application is based on intent to use, and there has not yet been any opportunity for actual confusion to result**.** "If there has been no real opportunity for confusion to take place because of an Applicant's very limited use of its mark in an area remote from where Opposer sells its products, for example, or a completely different retail environment, for another, the lack of evidence of instances of actual confusion would be of far less significance than would be the case if applicant's use had been substantial and the trading areas of the parties had overlapped for a period of time." *Uncle Ben's, Inc. v. Stubenberg International, Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998).

7. Opposer's Prior Rights in its BELAY MORTGAGE GROUP Mark.

In a conflicting likelihood of confusion analysis, "'preference is accorded to the prior user of a mark . . . against a newcomer. The newcomer has the clear opportunity, if not the obligation, to avoid confusion with well-known marks of others.'" *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). It is well-settled that "one who adopts a mark similar to the mark of another for the same or closely related goods does so at his own peril and any doubt there might be must be resolved against him." *Carlisle Chemical Works, Inc. v. Hardman & Holden, Ltd.*, 434 F.2d 1403, 168 USPQ 110 (CCPA 1970).

Opposer is the senior user in the case at hand. Beginning at least as early as April 2018, Opposer has used the BELAY MORTGAGE GROUP Mark for mortgage brokerage services. Success in providing mortgage brokerage services requires substantial investment in time to develop relationships for direct sales as well as referral sources. Opposer has done just that since at least as early as April 2018 as it expanded its offerings from Washington and Oregon into California before Applicant's filing date. Opposer has provided uncontroverted testimony and documentation from multiple witnesses and sources showing Opposer's foray into California during the period of April 2018 through February 2019.

On the other hand, Applicant did not offer any testimony in this case, so the earliest date that Applicant can rely upon is February 21, 2019, its filing date for the BELAY BANK mark. (See file history for BELAY BANK mark.) It is clear that by the

time Applicant applied to register its mark, the BELAY MORTGAGE GROUP mark was being used and advertised nationwide and was widely known among satisfied customers and prospective mortgage borrowers.

As Opposer has prior rights in its common law BELAY MORTGAGE GROUP mark, the question of likelihood of confusion should be resolved in Belay's favor.

IV. CONCLUSION

Based on the above analysis of the relevant *DuPont* factors and the evidence of record, there is a clear likelihood of confusion between Applicant's BELAY BANK mark and Opposer's BELAY MORTGAGE GROUP mark. The Board previously agreed with this argument when it sustained the opposition to Applicant's related BELAY FINANCIAL mark in Opposition No. 91251959 – and an identical decision is warranted here.

Again, in this opposition, as in the '959 proceeding, the marks are confusingly similar in appearance and commercial impression. The parties' services are clearly related if not identical. Since Applicant filed on an intent-to-use basis, it must be assumed that the parties will market their goods through similar channels of trade and to the same classes of consumers. Furthermore, Opposer's BELAY MORTGAGE GROUP mark has clearly enjoyed years of commercial success and widespread recognition, such that the mark is strong and well-established in the minds of the consuming public as referring to services originating with Opposer. Applicant's registration of a highly similar mark, BELAY BANK, for use in connection with

financial services is likely to cause confusion with Opposer's BELAY MORTGAGE GROUP mark. Accordingly, Opposer requests that Applicant's mark BELAY BANK be refused registration.

Respectfully submitted on April 27, 2022,

By: */s/ Tim Billick*
Tim Billick

Attorney for Opposer
Belay Mortgage Group

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing was served on April 27, 2022 via electronic mail, thereby providing notice of the same to the following persons:

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