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

Proceeding no.	91267205
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NEST EGG LABS, INC.,

Opposer,

v.

PEEKNEST, INC.,

Applicant.

Opposition Proceeding No. 91267205

Application Serial No.: 88/746,125

Mark: NEST

**OPPOSER NEST EGG LABS, INC.'S OPENING TRIAL BRIEF**

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## **MEMORANDUM**

### **I. INTRODUCTION**

Pursuant to Rule 2.128(a) of the Trademark Rules of Practice, 37 C.F.R. § 2.128(a), Opposer, Nest Egg Labs, Inc. (“Opposer” or “Nest Egg”) respectfully submits the following Opening Trial Brief against Applicant, Peeknest, Inc. (“Applicant” or “Peeknest”) in this Opposition Proceeding. This Opposition Proceeding was initiated with the filing of a Notice of Opposition on January 22, 2021, against Application Serial No. 88/746,125 (the “Application”) to register the mark NEST, in a standard character format, in connection with International Class 9 goods (the “NEST Mark”), based upon Opposer’s prior rights in, and a likelihood of confusion with, its NEST EGG mark that is the subject of Registration No. 6,236,897 for International Class 9 goods and International Class 42 services (the “NEST EGG Mark”). Opposer and Applicant submitted Cross Motions for Summary Judgement and the Board issued an Order on May 2, 2022, determining that: (1) “Opposer has met its burden to demonstrate that there is no genuine dispute regarding its entitlement” to a statutory cause of action pursuant to Trademark Act Section 13 and, as such, has established its standing to bring the Opposition; and (2) Opposer has established its priority in the NEST EGG Mark. (12 TTABVue, at 9-10, 12) Accordingly, pursuant to the Board’s Order dated May 2, 2022, Opposer’s standing and priority in its NEST EGG Mark have been established.

### **II. STATEMENT OF THE CASE**

Since 2011, Opposer Nest Egg has continuously and extensively made use of its strong, distinctive and registered NEST EGG Mark in connection with its inventory



management software application products and services, which include the following International Class 9 goods and International Class 42 services that are the subject of Registration No. 6,236,89 (collectively, “Opposer’s Goods”):

*Downloadable, computer application software for mobile phones, namely, software for assisting with the collection of data, organization and creating an inventory of items; downloadable computer software that provides web-based access to applications and services through a web operating system or portal interface; and*

*Computer programming services; Consulting services in the field of the design of software that models, analyzes organization and inventory of various items; Design and development of computer software for computer software and systems for the hosting of computer website and storage of data; Design and development of market research software tools; Preparation, update, installation and maintenance of computer software; Providing a web site featuring technology that enables users to access platform software specializing in organizing and inventory management of various items; Software as a service (SAAS) services, namely, hosting software for use by others for use in analyzing, measuring, evaluating, and optimizing organization and personal inventory management and data organization.*

Applicant seeks to register the mark NEST, in a standard character format, in connection with the following International Class 9 goods (“Applicant’s Goods”):

*Function of downloadable software for use in displaying, grouping and organizing images and descriptions of possessions sold as a component of downloadable software in the nature of a mobile application for users to capture images and descriptions in order to catalog, organize, and inventory belongings, goods, service providers, experiences, documents, notes, and media; none of the foregoing relating to home or building automation or smart home or smart building products or services.*

Because Opposer’s Goods and Applicant’s Goods are overlapping, identical, travel in the same trade channels to the same consumers and because the relevant marks are highly similar in appearance, sound, meaning and overall commercial impression, there exists a likelihood of confusion as to the source of the involved goods

and services. As such, Opposer respectfully submits that this Opposition should be sustained by the Board under Section 2(d) of the Trademark Act.

### **III. STATEMENT OF ISSUES**

The following issue is before the Board: whether there is a likelihood of confusion between Opposer's NEST EGG Mark and the NEST Mark that is the subject of the Application.

### **IV. DESCRIPTION OF THE RECORD**

In accordance with Trademark Rule 2.128(b) of the Trademark Rules of Practice and T.B.M.P. § 801.03, Opposer provides the below description of the record.

The record consists of the pleadings, the file of Applicant's Application that is the subject of the instant Opposition by operation of Trademark Rule 2.122(b)(1) and, as noted by the Board's in its Order of May 2, 2022, pursuant to Trademark Rule 2.122(d) Opposer's Registration No. 6,236,897 for the NEST EGG Mark.

Opposer, Nest Egg has also introduced the following testimony and evidence:

- Testimony Declaration of Satya Das ("Das Decl."), together with its Exhibits A – F introduced into the trial record through such testimony (13 TTABVUE).
- Opposer's First Notice of Reliance (Opp.'s 1<sup>st</sup> NOR") (14 TTABVUE).

Exhibit A: The specifics of Opposer's Registration No. 6,236,897.

Exhibit B: Applicant's Responses to Opposer's Revised Set of Requests for Admissions ("RFA").

Exhibit C: Applicant's Amended and Restated Responses to Opposer's First Set of Interrogatories ("Rog.").

Exhibit D: Declaration of Rayyan Faris in Support of Applicant's Motion for Summary Judgment.

Exhibit E: The specifics of Opposer's suspended U.S. Application Serial No. 88/799,352 to register the mark NEST.

- Opposer's Second Notice of Reliance (Opp.'s 2<sup>nd</sup> NOR") (17 TTABVUE).

Exhibit F: An agreement, designated by Applicant as CONFIDENTIAL – ATTORNEY'S EYES ONLY, entered into by Applicant relating to its use and prospective registration of the NEST Mark.

Exhibit G: Communications with Apple, Inc., produced and authenticated by Applicant, relating to Applicant's knowledge of Opposer's NEST EGG Mark.

Exhibit H: Internet evidence relating to Applicant's pricing and billing practices for Applicant's Goods.

Exhibit I: A search report produced and authenticated by Applicant

Applicant has introduced the following testimony and evidence:

- Testimony Declaration of Rayyan Faris ("Faris Decl."), together with the Exhibits A – B introduced into the trial record through such testimony (15 TTABVUE).
- Applicant's Notice of Reliance (16 TTABVUE).

Exhibit A: The file of Applicant's Application that is the subject of the present Opposition.

Exhibit B: The file of Opposer's U.S. Application Serial No. 88/799,352 to register the mark NEST.

## **V. STATEMENT OF FACTS**

In his testimony declaration Satya Das, Opposer's Chief Executive Officer, explains that Opposer<sup>1</sup> first launched its NEST EGG inventory management computer and mobile phone application software under the NEST EGG Mark (the "NEST EGG App") in early May 2011. (Das Decl., 13 TTABVUE at ¶ 4) Mr. Das also details how the NEST EGG App enables consumers to users to easily and conveniently track, organize

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<sup>1</sup> Through Opposer's predecessor-in-interest, Winprogger, LLC.

and manage their inventory of personal and household possessions, assets, objects and items of any type with ease. (*Id.* at ¶¶ 4-5) Mr. Das goes on to describe how, since 2011, Opposer has expanded its offerings of inventory management software applications that it provides to consumers under the NEST EGG Mark by launching NEST EGG LITE in 2013, a pared down version of the application available to consumers at no cost, and NEST EGG CLOUD in 2018, which is a cloud-based version for small businesses (collectively, the “NEST EGG Apps”). (*Id.* at ¶ 6, Ex. A)

Mr. Das’ testimony also establishes that Opposer’s NEST EGG Apps have been featured in *The New York Times*, *The Boston Globe*, *The Denver Post* and *The Mercury News*, on *CNBC*, in a wide variety of additional digital publications, have been recognized as being amongst the highest-ranked software applications available through Apple, Inc.’s App Store, have facilitated the organization and management of well-over six million (6,000,000) items of inventory by consumers, and are accessible in thirty-two (32) languages and available in one hundred and twenty three (123) different countries. (*Id.* at ¶ 7-9, Exs. B-D)

Through his testimony, Mr. Das also describes how, since 2011, Opposer has continuously highlighted the NEST portion of Opposer’s NEST EGG Mark by making use of numerous variations of the mark that focus the attention of consumers to the dominant “NEST” portion of the mark, including prominently featuring a “nest” design highlighting the term “NEST”, and the imagery of an actual “NEST”, as the focal point of Opposer’s NEST EGG Mark, and utilizing business cards that direct consumers to “Look for the **NEST** in the APP STORE”. (*Id.* at ¶¶ 11-12) Mr. Das’ testimony also details how consumers have come to identify, reference, search for and locate

Opposer's NEST EGG Apps using the term "NEST", as the key, material and most significant element of Opposer's marketing and advertising of its NEST EGG Mark in connection with the NEST EGG Apps.<sup>2</sup> (*Id.* at ¶ 13).

The Application that is the subject of the present Opposition seeks to register NEST, in a standard character format, for the very same Class 9 goods that Opposer has established strong and exclusive rights in, and registered, its NEST EGG Mark for.

Moreover, by Applicant's own admission:

- Opposer's Goods and Applicant's Goods are both marketed, offered for sale and sold through the Apple App Store (Opp.'s 1<sup>st</sup> NOR, 14 TTABVUE, Ex. B at RFA Nos. 1-6);
- Opposer's Goods and Applicant's Goods both include software products that function to assist consumers in organizing, cataloging and inventorying their possessions (*Id.* at RFA Nos. 7-8);
- Opposer's Goods and Applicant's Goods both include software applications for mobile phones (*Id.* at RFA Nos. 9-10);
- Opposer's Goods and Applicant's Goods both enable consumers to organize things by cataloguing and keeping track of items (*Id.* at RFA Nos. 11-12);
- A purpose of both Opposer's Goods and Applicant's Goods is for home inventory (*Id.* at RFA Nos. 13-14);
- A purpose of both Opposer's Goods and Applicant's Goods is for personal inventory management (*Id.* at RFA Nos. 15-16);
- Opposer's Goods and Applicant's Goods both enable consumers to track inventory (*Id.* at RFA Nos. 23-26);

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<sup>2</sup> Opposer is also the owner of pending U.S. Application Serial No. 88/799,352 to register the mark NEST in connection with *Non-downloadable, computer application software for mobile phones, namely, software for assisting with the collection of data, organization and creating an inventory of items; downloadable, computer software that provides web-based access to applications and services through a web operating system or portal interface; mobile user interfaces, namely, interactive computer kiosk systems comprised primarily of computers, computer hardware, computer peripherals, and computer touchscreens, used to, catalog, collaborate, organize, manage, and inventory belongings, goods, services, experiences, documents, and notes* in International Class 9. (TTABVUE 14, Ex. E)

- Opposer's Goods and Applicant's Goods are both marketed, offered for sale and sold to home consumers (*Id.* at RFA Nos. 27-28);
- Opposer's Goods and Applicant's Goods are both marketed, offered for sale and sold to consumers for personal use (*Id.* at RFA Nos. 29-30);
- Opposer's Goods and Applicant's Goods are both marketed, offered for sale and sold to the same and/or overlapping consumers (*Id.* at RFA Nos. 31-33);
- Opposer's Goods and Applicant's Goods are both marketed, offered for sale and sold through the same, overlapping trade channels (*Id.* at RFA Nos. 34-39, 46-47); and
- Opposer's Goods and Applicant's Goods are sold at the same approximately low price points (*Id.* at RFA No. 56).

Accordingly, it is uncontested that Opposer's Goods and Applicant's Goods are: (1) identical, overlapping and serve the same exact purposes; (2) marketed, offered for sale and sold to the same, overlapping consumers; and (3) marketed, offered for sale and sold through the identical channels of trade at similarly low price points. Additionally, the testimony and evidence of record establishes that Applicant is a direct competitor of Opposer in the inventory management software application market and that the parties also provide competing versions of Opposer's Goods and Applicant's Goods to consumers at no cost to consumers, involving a lesser degree of purchasing care amongst the relevant consumers. (Das Decl., 13 TTABVUE at ¶¶ 6, 14; Exs. A, F; Faris Decl., 15 TTABVUE at ¶¶ 5, 9; Ex. A at App. 00019)

## **VI. ARGUMENT**

Given that Opposer has been making extensive and continuous use of the inherently distinctive NEST EGG Mark for well over a decade, the NEST EGG Mark has become well known amongst consumers of inventory management software application products and services. In view of Opposer's strong and exclusive prior rights, even a

small degree of similarity with another mark would be likely to cause consumer confusion. Here, however, there is a very high degree of similarity between Opposer's NEST EGG Mark and the NEST Mark that is the subject of the Application, as the first, and dominant, NEST portion of Opposer's NEST EGG Mark is identical to the NEST mark that is the subject of the NEST Application. Accordingly, based upon the high degree of similarity between the relevant marks, alone, it is likely that consumers will mistakenly believe that Applicant's use of NEST indicates that Applicant's Goods originate from, are sponsored by and/or are affiliated with Opposer, its NEST EGG Apps and/or its NEST EGG Mark.

Further, each of the other pertinent *DuPont* factors also weigh heavily in favor of a finding of likelihood of confusion between the NEST and NEST EGG marks. It is uncontested that Applicant's Goods are identical to, and serve the exact same purposes as, Opposer's Goods, that the relevant products and services travel through the very same channels of trade and are marketed, sold and provided to the very same consumers at no cost at all and similarly low price points, and are not products for which consumers exercise a high degree of care in making their purchasing decisions.

**A. Opposer Has Standing to Oppose the Application**

As determined by the Board's Order dated May 2, 2022 (12 TTABVUE), and noted above, Opposer has established its standing to oppose the Application by virtue of its ownership of the Registration that has been pleaded and attached to Opposer's Notice of Opposition. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000).

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**B. Opposer has Priority in its NEST EGG Mark**

Likewise, as established by the Board's Order of May 2, 2022 (12 TTABUVE), by virtue of Opposer having made of record its valid and subsisting pleaded Registration priority is not in issue for Opposer's NEST EGG Mark. Consequently, Opposer's priority of use has been established and is not at issue. *See Larami Corp. v. Talk to Me Programs, Inc.*, 36 U.S.P.Q.2d 1840 (T.T.A.B. 1995).

**C. There is a Likelihood of Confusion Between Opposer's NEST EGG Mark and Applicant's NEST Mark**

Section 2(d) of the Lanham Act provides that registration of a trademark should be refused if the mark:

so resembles . . . a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods and services of the applicant, to cause confusion, to cause mistake, or to deceive . . .

15 U.S.C. § 1052(d).

Pursuant to the Board's May 2, 2022 Order, there is no question that Opposer has priority of use and ownership of the NEST EGG Mark. Therefore, the sole issue before the Board is whether or not Applicant's NEST Mark is likely to cause confusion with Opposer's previously used and registered NEST EGG Mark.

Under Section 2(d) of the Trademark Act, likelihood of confusion is determined by considering the factors set forth in *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q.



563, 567, 476 F.2d 1357 (CCPA 1973) (“the *DuPont* Factors”).<sup>3</sup> Examination of each of the *DuPont* Factors is not required in order to find that there is a likelihood of confusion; different factors may play a dominant role in determining a likelihood of confusion depending on the facts of each case. See *Bose Corp. v. QSC Audio Products, Inc.*, 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002). In this proceeding the most relevant factors are the identical nature of the relevant goods and services, the identical trade channels through which the relevant goods and services are marketed, offered for sale, sold and provided to consumers, the class the consumers at issue, the strength of the NEST EGG Mark and the similarity of Applicant’s NEST Mark to Opposer’s NEST EGG Mark, each of which weighs heavily in favor of a finding of likelihood of confusion.

**1. Any Doubts Must be Resolved in Favor of Opposer**

Any doubt as to the issue of likelihood of confusion must be resolved in favor of Opposer and against Applicant, who had a legal duty to select a mark which was totally dissimilar to trademarks already in use. See *San Fernando Elec. Mfg. Co. v. JFD Elec. Components*, 565 F.2d 683, 684, 196 U.S.P.Q. 1, 2 (C.C.P.A. 1977); *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 U.S.P.Q. 191, 200-201 (T.T.A.B. 1979).

Opposer has introduced compelling evidence to support a finding of likelihood of confusion, namely, evidence of fame and strength of the NEST EGG Mark, Applicant’s

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<sup>3</sup> The “*DuPont* Factors” include the following: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimis or substantial; and (13) any other established fact probative of effect of use. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

use of a mark that is highly similar in appearance, sound and connotation, and Applicant's use of such mark on identical products, being sold through identical trade channels to the same consumers at a similar low price point, or at no cost at all. Thus, any doubt is to be resolved in favor of Opposer and the Board should deny registration of the Application as likely to cause confusion with Opposer's NEST EGG Mark. See *Nina Ricci S.A.R.L.*, 889 F.2d 1070, 1074, 12 U.S.P.Q.2d 1901, 1904 ("all doubt as to whether confusion, mistake, or deception is likely to be resolved against [the] newcomer ...") (internal citation omitted).

In sum, the overriding concern is not only to prevent consumer confusion as to the source of the goods, but to protect Opposer, as the senior user and registrant, from adverse commercial impacts due to the use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As a result, any doubt regarding a likelihood of confusion determination is resolved in favor of a prior registrant. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

## **2. Applicant's Goods Are Identical to Opposer's Goods**

In considering whether consumer confusion is likely to arise between the parties' respective marks, the relevant goods are compared to determine whether they are similar, commercially related, and/or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002). The relevant goods need not be identical or

even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). The subject goods need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the relevant goods/services] emanate from the same source”. *Coach Servs., Inc.*, 668 F.3d at 1369, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Here, the testimony and evidence of record establishes that, by Applicant’s own admission (as detailed in Section V, above) Opposer’s Goods and Applicant’s Goods both: (i) include software applications for mobile phones; (ii) include software products that function to assist consumers in organizing, cataloging and inventorying their possessions; (iii) enable consumers to organize things by cataloguing and keeping track of items; (iv) enable consumers to track inventory for the purposes of both home inventory and personal inventory management. (Opp.’s 1<sup>st</sup> NOR, 14 TTABVUE, Ex. B at RFA Nos. 7-16, 23-26; Das Decl., 13 TTABVUE at ¶¶ 4-6, 14; Ex. F; Faris Decl., 15 TTABVUE at ¶¶ 5, 8, 9; Ex. A)

Additionally, Opposer’s Registration covers a broad scope of International Class 9 goods and International Class 42 services, which encompass all goods and services of the type identified, including Applicant’s identification of Class 9 goods set forth in the Application. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, Applicant’s Goods and Opposer’s Goods are legally identical for likelihood of

confusion purposes. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

Finally, where the relevant marks are identical or virtually identical, as they are here, an even lesser degree of similarity or relatedness between the goods is needed to support a finding of likelihood of confusion. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)). As such, this factor weighs heavily in favor of a finding of likelihood of confusion.

### **3. The Channels of Trade and Relevant Consumers are Identical**

The evidence and testimony of record presently before the Board clearly establishes, by Applicant's own admission, that Opposer's Goods and Applicant's Goods are marketed, offered for sale and sold through identical and overlapping channels of trade to the very same consumers. (Opp.'s 1<sup>st</sup> NOR, 14 TTABVUE, Ex. B at RFA Nos. 1-6, 27-28, 31-39, 46-47; Ex. C at Rog. Nos. 1-3; Das Decl., 13 TTABVUE at ¶¶ 7, 9, 14; Exs. B, D, F) Opposer's Goods and Applicant's Goods are both marketed and sold to consumers through the Apple App Store, which places them in identical and overlapping trade channels, and are marketed and sold to the consumers of inventory management software application products/services. *Id.*

Moreover, the goods and services identified in Opposer's NEST EGG Registration and the goods identified in the Application have no restrictions as to nature,

type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co.*, 281 F.3d at 1268, 62 USPQ2d at 1005). Thus, it is presumed that the channels of trade for the parties’ respective goods and services are the same and are offered to the same class of consumers. *Id.*; see also *In re Cook Medical Techs. LLC*, 105 U.S.P.Q.2d 1377 (T.T.A.B. 2012) (“Because there are no limitations as to channels of trade or classes of purchasers in the identifications of goods in the application and cited registration, it is presumed that applicant’s and registrant’s goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods.”). Further, where the relevant products are closely related, or, as here, the same the Board assumes that the products will be sold in the same channels of trade to the same ordinary consumers. *Venture Out Props. LLC Wynn Resorts Holdings LLC*, 81 U.S.P.Q.2d 1887, 1894 (T.T.A.B. 2007) (“Because the services are clearly related, they would be offered in the same channels of trade and offered to the same classes of consumers”).

Here the relevant customers for the goods and services at issue are comprised of consumers of inventory management software application products and services, *i.e.*, generally all consumers. As such, Opposer and Applicant both target the same consumers and those consumers who encounter Applicant’s Goods in connection with the NEST Mark are likely to believe that such goods are affiliated with Opposer’s NEST EGG Mark and sponsored by Opposer. Thus, the identical nature of the channels of

trade and the overlapping classes of relevant consumers clearly demonstrate the existence of a likelihood of confusion between the marks at issue.

**4. The Goods/Services are Purchased with Less Care**

Where, as here, the products at issue "are relatively low-priced and subject to impulse buying, the risk of a likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot*, 54 U.S.P.Q.2d at 1899. Purchasers exercise a low degree of care when purchasing inexpensive computer software applications and a "[l]ow degree of consumer care ...increases the likelihood of confusion." See *Playboy Enters., Inc. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1028 (9th Cir.2004). The testimony and evidence of record establishes that Applicant's Goods and Opposer's Goods are offered to consumers at no cost and at similarly low and overlapping price points. (Das Decl., 13 TTABVUE at ¶¶ 6, 14; Exs. A, F; Faris Decl., 15 TTABVUE at ¶¶ 5, 9; Ex. A at App. 00019; 14 TTABVUE, Ex. B at RFA No. 56) Because the products at issue are either free or relatively inexpensive, it is likely that consumers will search for the relevant products and purchase them, or simply download a software application at no cost, on an "impulse", without investigation and without a high degree of care. Accordingly, this factor, likewise, weighs heavily in favor of a finding of likelihood of confusion.

**5. The NEST EGG Mark is Inherently Distinctive and Strong**

When evaluating the strength of a mark, the Board considers both its inherent, or conceptual, strength, based upon the nature of the mark itself, as well as its commercial strength. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 U.S.P.Q.2d 1681, 1686 (Fed. Cir.2010). See also *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101

U.S.P.Q.2d 1163, 1171-73 (TTAB 2011); *Tea Bd. of India v. The Republic of Tea Inc.*, 80 U.S.P.Q.2d 1881, 1898-99 (TTAB 2006). Here, the evidence that Opposer's NEST EGG Mark is strong is compelling. The NEST EGG Mark is inherently distinctive given that it does not immediately or directly describe any specific quality or characteristic of Opposer's Goods. Furthermore, as the subject of the Registration the validity and distinctiveness of the NEST EGG Mark has been established. 15 U.S.C. § 1065.

Moreover, since 2011 Opposer's NEST EGG Mark has enjoyed considerable recognition and commercial success and has become a well-known source identifier for Opposer's Goods throughout the United States. (Das Decl., 13 TTABVue at ¶¶ 7-9, Exs. B-D) As a result of Opposer's long and extensive use, as well as the widespread recognition the NEST EGG Mark has realized over the years, the NEST EGG Mark has achieved renown and fame amongst consumers of inventory management software application products and services throughout the United States. Consequently, Opposer's NEST EGG Mark is strong and should be entitled to a broad scope of protection when applied to inventory management software application products and services, reducing the quantum of evidence of the remaining *DuPont* factors necessary to establish a likelihood of confusion. Accordingly, this factor also weighs in favor of a finding of a likelihood of confusion in the present proceeding.

**6. The NEST and NEST EGG Marks are Highly Similar**

In determining similarity, the respective marks are compared in their entireties in terms of sight, sound and connotation. *DuPont*, 476 F.2d at 1361. Similarity as to one element, sight, sound or connotation, may be sufficient for the respective marks to be found similar. See *In re White Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988).

Determining the similarity of the marks involves comparing them in their entireties as to appearance, sound, connotation and commercial impression. *Starbucks U.S. Brands LLC v. Ruben*, 78 U.S.P.Q.2d 1741, 1752 (T.T.A.B. 2006). Additionally, the dominant portion of the relevant marks is given more weight in determining whether the marks are confusingly similar. *Fossil Inc. v. Fossil Grp.*, 49 U.S.P.Q.2d 1451, 1456 (T.T.A.B. 1998); *Jansen Enters. v. Rind*, 85 U.S.P.Q.2d 1104, 1109 (T.T.A.B. 2007).

In the present instance, NEST is the dominant portion of Opposer's NEST EGG Mark because it is the most significant and prominent element of the mark, particularly given Opposer's extensive efforts in directing the attention of consumers to the NEST portion of its NEST EGG Mark, as detailed above. See *Ty, Inc. v. Jones Grp., Inc.*, 237 F.3d 891, 57 U.S.P.Q.2d 1617, 1621- 22 (7th Cir. 2001). Although Applicant's NEST mark does not contain the entirety of Opposer's registered NEST EGG Mark, both marks are dominated by the term NEST and Applicant's mark is likely to appear to prospective purchasers as a shortened form of the NEST EGG Mark. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Merely omitting some portion of a registered mark is not, in and of itself, sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977). In the present instance, Applicant's NEST Mark does not create a distinct commercial impression from Opposer's NEST EGG Mark because it contains the dominant, initial term that is contained in the NEST EGG Mark and does not add any wording that would serve to distinguish it from the NEST EGG Mark.



Moreover, consumers are generally more inclined to focus on the first word, prefix, or syllable that is contained in a trademark or service mark – especially when searching on their phone or on-line. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVEROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir.2018) (finding “the identity of the marks’ two initial words is particularly significant because consumerstypically notice those words first”). As such, the initial term “NEST” in the NEST EGG Mark creates the dominant commercial impression in the minds of consumers.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d at 1362, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Moreover, marks may be deemed confusingly similar in appearance where similar terms or phrases, or even similar parts of terms or phrases, appear in the relevant marks and result, as here, in a highly similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial*

*Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar).

Applicant's NEST Mark is highly similar to Opposer's NEST EGG Mark in sight, sound, meaning and engenders the very same overall commercial impression. Applicant's NEST mark is highly similar to Opposer's NEST EGG Mark, as the dominant portions of the marks are both comprised of the term NEST. As such, a consumer who encounters Opposer's NEST EGG Mark and, thereafter, Applicant's NEST Mark, both in connection with inventory management software products/services, is likely to be confused and/or mistaken as to the source of the parties' respective products/services. Accordingly, this factor also weighs heavily in favor of a finding of a likelihood of confusion. *See e.g., In re Allegro Multimedia, Inc.*, 2008 T.T.A.B. LEXIS 390 (T.T.A.B. 2008) (likelihood of confusion found between WIZARD TUNES and THE WIZ, an abbreviation for "Wizard").

**7. Applicant Did Not File the Application in Good Faith**

As evidenced by the parties' communications with Apple, Inc. the record before the Board establishes that Applicant was very much aware of Opposer, and Opposer's NEST EGG Mark, at least as early as December 2019 and prior to the January 3, 2020, filing date of the Application that is the subject of the present Opposition. (Opp.'s 2<sup>nd</sup> NOR, 17 TTABVUE, Ex. G) While it is certainly not necessary to evidence bad faith in establishing a likelihood of confusion, if present, evidence of bad faith is strong

evidence of a likelihood of confusion. *Mag Instrument, Inc. v. The Brinkmann Corp.*, 96 U.S.P.Q.2d 1701, 1713 (T.T.A.B. 2010); *DC Comics v. Pan Am. Grain Mfg. Co. Inc.*, 77 U.S.P.Q.2d 1220, 1228 (T.T.A.B. 2005).

Here Applicant was aware of Opposer and its NEST EGG Mark prior to its filing of the Application and, despite this knowledge, Applicant decided to move forward with the filing of the Application. Given Applicant's knowledge of Opposer and its use of the NEST EGG Mark, Applicant filed the Application in bad faith and, consequently, this factor also weighs in favor of a likelihood of confusion.

**8. *The Balancing of the DuPont Factors Favors Opposer***

Opposer's NEST EGG Mark is inherently distinctive and has attained significant commercial strength. The respective goods and services of the parties are identical and offered in the same channels of trade to the very same class of consumers who exercise a low degree of care in their purchasing decisions. The NEST EGG and NEST marks at issue are highly similar in sound, appearance, connotation and overall commercial impression. Applicant filed the Application in bad faith.

Balancing the pertinent *DuPont* factors discussed above, Opposer respectfully submits that the Board must determine that confusion is likely.

**VII. CONCLUSION**

For all the foregoing reasons, Opposer respectfully requests that the present Opposition be sustained, judgment be entered in its favor and registration to Applicant denied.

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**CERTIFICATE OF SERVICE**

It is hereby certified that a copy of the foregoing "Opposer's Opening Trial Brief" has been served *via* electronic mail on Applicant's Attorneys, IDRIS MOTIWALA, ESQ., LAW OFFICE OF IDRIS MOTIWALA, 10900 Research BLVD. STE. 160C-84, Austin, Texas 78759, [idris@motiwala.law](mailto:idris@motiwala.law), this 23<sup>rd</sup> day of February 2023.

\_\_\_\_\_  
/s/ Relani Belous

Relani Belous