

This Opinion is Not a
Precedent of the TTAB

Mailed: May 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Daniel J. Fountenberry
v.
Life of Ease LLC
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Opposition No. 91270132

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Meghan E. Pratschler for Daniel J. Fountenberry.

Life of Ease LLC, *pro se*.

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Before Taylor, Adlin and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Life of Ease LLC seeks registration of the mark shown below for: “writing instruments; pencil cases; blank writing journals; dry erase writing boards and writing surfaces,” in International Class 16; “educational toys for teaching math principles, namely, manipulative blocks for displaying patterns and groupings; finger puppets,” in International Class 28; and “educational services, namely, conducting distance learning instruction at the pre-kindergarten, kindergarten, primary, and secondary levels; educational services, namely, providing web-based virtual learning instruction at the pre-kindergarten, kindergarten, primary, and secondary levels,” in International Class 41:



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The wording “V COTEACHER” is disclaimed with respect to the Class 41 services only.

In his notice of opposition, Opposer Daniel Fountenberry alleges prior use of COTEACHER for various educational services. Opposer also pleads ownership of a registration for COTEACHER, in standard characters, for “licensing of software in the framework of software publishing,” in International Class 45.² As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s mark. In its answer, Applicant denies the salient allegations in the notice of opposition.

¹ Application Serial No. 90189878, filed September 17, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce. The application includes this description of the mark: “The mark consists of the terms ‘V COTEACHER’ in a stylized font. The ‘V’ is large and placed behind the term ‘COTEACHER’. A series of paintbrush strokes surround the terms.”

² Registration No. 6145713, issued September 8, 2020.

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. In addition, Opposer introduced:

Notice of Reliance ("NOR") on official records and Internet printouts ("Opp. NOR"). 10 TTABVUE.³

Testimony Declaration of Opposer Daniel Fountenberry, and the exhibits thereto ("Fountenberry Dec."). 11 TTABVUE.

Applicant introduced:

NOR on third-party registrations and Internet printouts. ("App. NOR"). 12 TTABVUE.

Testimony Declaration of Sheila Barrett, Applicant's owner and manager, and the exhibits thereto ("Barrett Dec."). 13 TTABVUE.

II. Relevant Facts

Opposer is the incorporator and "first shareholder" of CalBec Technologies, Inc. ("CalBec"), a Canadian company "in the business of education publishing and software." 11 TTABVUE 2 (Fountenberry Dec. ¶¶ 3-4). Opposer has granted CalBec a license to use Opposer's mark "in connection with CalBec's services," although there

³ Citations to the record are to TTABVUE, the Board's online docketing system. Specifically, the number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

is not “a written license evidencing this arrangement.” *Id.* at 3 (Fountenberry Dec. ¶ 5).

In addition, Opposer states that he has engaged in common law use of his pleaded COTEACHER mark “for as long as I have used the Registered Mark.” Thus, Opposer alleges common law use since May 1, 2018 (the date of first use in commerce asserted in the pleaded registration) for the following educational services:

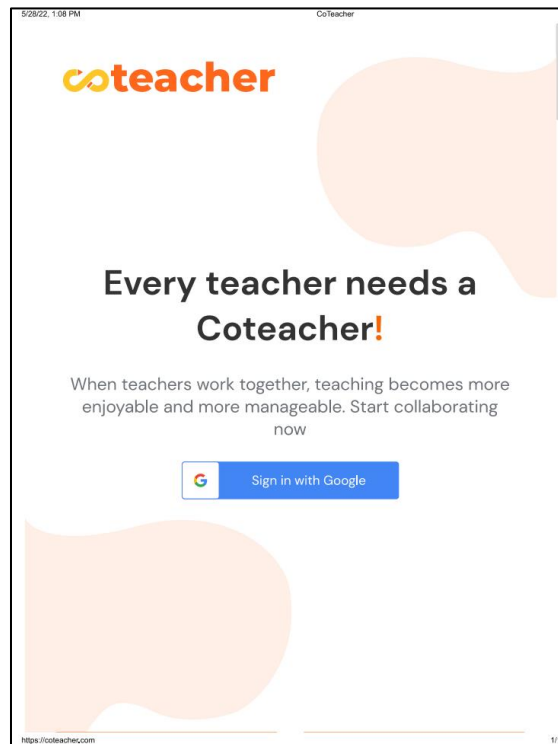
educational services, namely, developing curriculum for educators; education services, namely, mentoring in the field of education; online social networking services in the field of education; education services, namely, providing classes, seminars, workshops, tutoring, and mentoring in the field of middle and high school reform, and educational services, including conducting virtual and distance learning, virtual training of teachers, virtual coaching of teachers, and establishing virtual relationships between teachers.

Id. (Fountenberry Dec. ¶ 6). Opposer’s specific testimony about his “use” of the mark for the claimed educational services does not reveal traditional service mark use, however.

Specifically, Opposer does not claim to have rendered the educational services in which he claims common law rights. Instead, Opposer states that he “began developing the website, fundraising, hiring staff, raising capital, and finding customers to use the web-based educational software I was developing with CalBec ... before May 1, 2018.” *Id.* (Fountenberry Dec. ¶ 7). He also “began discussing the layout of the future website featuring ‘CoTeacher’ at least as early as April 8, 2018,” and “[a]t least as early as April 12, 2018” he “used ‘CoTeacher’ to sign up for business marketing tools.” *Id.* (Fountenberry Dec. ¶¶ 7-8). Similarly, Opposer “was actively

engaging with service providers” and “looking for partners and grants” at least as early as April 26, 2018, and registered the domain name “coteacher.com.” *Id.* (Fountenberry Dec. ¶¶ 9-11).

Opposer’s “CoTeacher Website went live around May or June 2019.” *Id.* at 4 (Fountenberry Dec. ¶ 12). Opposer then began promoting use of the website. *Id.* (Fountenberry Dec. ¶¶ 13-14). The site is intended as “a place for sharing instructional materials and expertise between educators ... Teachers can message other teachers, share lesson plans, provide support to one another, and integrate organizational tools.” *Id.* (Fountenberry Dec. ¶ 15). The “most current version of the CoTeacher Website” is reproduced below:



Id. at 4, 64 (Fountenberry Dec. ¶ 15 and Ex. P).

As for Applicant, it “focuses on serving students with special needs and learning gaps.” 13 TTABVUE 3 (Barrett Dec. ¶ 8). Ms. Barrett owns and manages Applicant,⁴ which “is primarily an online seller of physical goods.” 13 TTABVUE 2 (Barrett Dec. ¶ 2). Ms. Barrett created the involved mark, in which the “V” is intended to convey “Visual, Virtual and Value-Added Supplies,” and registered the “vcoteacher.com” domain name on September 16, 2020. 13 TTABVUE 3 (Barrett Dec. ¶ 6) and 10 TTABVUE 68, 72.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by

⁴ Ms. Barrett is “an experienced Special Education (SPED) teacher who worked as a co-teacher of General Education and other teachers in the K12 setting.” 13 TTABVUE 2 (Barrett Dec. ¶ 3). She wanted to “support other teachers,” and registered the “virtualcoteacher.com” domain name on March 14, 2017. *Id.* at 2, 7, 9, 13, (Barrett Dec. ¶ 3 and Exs. A-C).

registration of the mark). Here, Opposer's pleaded registration establishes that he is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. 11 TTABVUE 2 (Fountenberry Dec. ¶ 2) and 10 TTABVUE 35; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing").

IV. Priority

Because Opposer's pleaded registration is of record, and Applicant has not counterclaimed to cancel it, priority is not at issue with respect to the mark and software licensing services identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

The situation is different, however, with respect to the educational services for which Opposer alleges prior common law rights. For those services, Opposer bears the burden of establishing that he has "proprietary rights in the mark that produce a likelihood of confusion ... These proprietary rights may arise from ... prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) [internal citations omitted]; *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). Opposer must establish use prior to the September 17, 2020 filing date of Applicant's involved application. *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013) ("for

when an application or registration is of record, the party may rely on the filing date of the application for registration, *i.e.*, its constructive use date”).⁵

Here, while Opposer claims prior “use” of his pleaded mark for a variety of educational services, his evidence establishes only preparations to use the mark, such as developing and launching a website, fundraising, hiring staff, raising capital, “finding customers,” and signing up for “business marketing tools.” 11 TTABVUE 3-4 (Fountenberry Dec. ¶¶ 6-15). The problem is that these types of preparations to use a mark do not constitute actual service mark use. *Aycock Eng’g Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009) (“[A]n applicant’s preparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the marks must be actually used in conjunction with the services described in the application for the mark.”).

In fact, “[f]or service marks, the ‘use in commerce’ requirement is met when (1) a mark is ‘used or displayed in the sale or advertising of services’ and (2) either (i) the services are ‘rendered in commerce’ or (ii) the services are ‘rendered in more than one State or in the United States and a foreign country and the person rendering those services is engaged in commerce in connection with the services.’” *Id.* at 1305 (citing 15 U.S.C. § 1127). Here, Opposer has not introduced any evidence that he has

⁵ While Applicant testified that she conducted certain activities under her mark prior to her filing date, 13 TTABVUE 3-4 (Barrett Dec. ¶ 8), this testimony and Applicant’s other evidence fail to establish prior trademark or service mark “use,” for many of the reasons explained below in connection with Opposer’s evidence.

rendered the educational services in connection with which he claims to have used the COTEACHER mark.⁶

While trade name use or “use analogous to service mark use” may also be a basis for claiming priority in an *inter partes* case such as this, these potential bases for priority must be pleaded. *Cent. Garden*, 108 USPQ2d at 1142. Opposer did not plead trade name use or use analogous to service mark use, however, relying instead only on alleged actual service mark use. 1 TTABVUE 3 (Notice of Opposition ¶ 2). Nor was the issue tried by implied consent. See TRADEMARK BOARD MANUAL OF PROCEDURE (“TBMP”) § 507.03(b) (2022).⁷

⁶ While Opposer testifies to prior “use” of his mark for educational services, it is clear from his Testimony Declaration that he considers preparations to use the mark to constitute service mark “use.” Compare 11 TTABVUE 3 (Fountenberry Dec. ¶ 6) with *id.* at 3-4 (Fountenberry Dec. ¶¶ 7-15). There is no evidence of record showing that Opposer rendered educational services prior to Applicant’s filing date. In fact, while Opposer’s website may very well be the means through which Opposer offers his identified educational services, there is no evidence that Opposer has rendered those identified services to customers.

⁷ In any event, even if we were to find that Opposer pleaded trade name use or use analogous to service mark use or that the issue was tried by implied consent, the claim would fail.

Before a prior use becomes an analogous use sufficient to create proprietary rights, the [party] must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the [party’s] goods ... A showing of analogous use does not require direct proof of an association in the public mind ... Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark

Herbko, 64 USPQ2d at 1378; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881-83 (Fed. Cir. 1996). Here, there is no evidence that any of Opposer’s activities prior to Applicant’s filing date created an association in the minds of the purchasing public between COTEACHER and the services for which Opposer claims prior use. In fact, as explained below, COTEACHER is conceptually weak and widely used by third parties for educational services.

Thus, Opposer has not established prior common law use of COTEACHER as a service mark or trade name for the educational services identified in his notice of opposition. Opposer may therefore rely only on his registration rights.

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

As discussed above, Opposer has not established prior common law rights in his COTEACHER mark for educational services. We thus focus our analysis on Opposer’s pleaded registration of COTEACHER for “licensing of software in the framework of software publishing.”

A. Strength of Opposer’s Mark

We first consider the strength of Opposer’s mark, to determine the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”).

Turning first to conceptual strength, Applicant introduced a “lawinsider.com” definition stating that “Coteaching means a service delivery option with two or more professionals sharing responsibility for a group of students for some or all of the school day in order to combine their expertise to meet student needs.” 12 TTABVUE 72. Applicant also introduced a Council for Exceptional Children definition of the term which is consistent with the “lawinsider.com” definition, but more specific: “Co-teaching is a collaborative approach to instruction in which two teachers, typically a general education teacher and a special education teacher, work together to plan and then implement instruction for a class that includes students with disabilities.” *Id.* at 77. Additional evidence corroborates these definitions and reveals that the term is used by a number of third-parties. *Id.* at 83-104. *See also* 10 TTABVUE 205-225.

This evidence establishes that “COTEACHER” is conceptually weak for education-related services. But here, Opposer has not established prior rights in COTEACHER for education-related services, so this evidence is for the most part irrelevant. There is no evidence that “COTEACHER” is conceptually weak for “licensing of software in the framework of software publishing,” the only services identified in Opposer’s pleaded registration, and therefore we find that Opposer’s registered mark is not

conceptually weak, and that it is entitled to the normal scope of protection accorded registered marks.

Turning to commercial strength, Applicant argues that “[t]he word ‘co-teacher’ is used commonly in the education field.” 15 TTABVUE 7 (citing 12 TTABVUE 83-105). Again, however, education services are not relevant, because Opposer has not established prior use of his mark for education-related services. Because there is no evidence that COTEACHER is commercially weak for “licensing of software in the framework of software publishing,” Opposer’s registered mark is not commercially weak.

Opposer’s registered mark is entitled a normal scope of protection.

B. The Marks

The marks are more similar than dissimilar in “appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Indeed, the dominant element of Applicant’s mark is almost identical to Opposer’s mark.

The term V COTEACHER is the dominant element of Applicant’s mark because consumers are likely to call for Applicant’s goods and services by that term, the mark’s only literal element. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to

request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”).

This is especially true in this case, because Applicant’s design is merely a circular “series of paintbrush strokes.” The circular shape of the design is not distinctive. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1138 (TTAB 2015); *National Rural Elec. Cooperative Ass’n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1883 (TTAB 2006), *aff’d*, 214 Fed. Appx. 987 (Fed. Cir. 2007) (“The circle design is hardly particularly distinctive in trademark designs.”); *In re Anton/Bauer, Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (“common geometric shapes such as circles, ovals, triangles, diamonds and stars, when used as backgrounds for the display of word or letter marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone”). Nor do the “paintbrush strokes” in Applicant’s mark do anything but surround and highlight the term V COTEACHER.

We recognize that Applicant has disclaimed V COTEACHER with respect to its Class 41 services only. Nonetheless, in this case, where the rest of Applicant’s mark is not distinctive, we find the term V COTEACHER to be the mark’s dominant element, even when used for Applicant’s Class 41 services. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (“While both Midwestern and Nestle have disclaimed the STRIPS portion of their marks, each mark must be viewed in its entirety.”); *In re Viterra Inc.*, 671 F.2d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (“Although Viterra is correct

that the registrant disclaimed exclusive rights to the term ‘-Seed’, we previously have found that the dominant portion of a composite word and design mark is the literal portion, even where the literal portion has been disclaimed.”); *In re Shell Oil Co.*, 992 F.2d 11204, 26 USPQ2d 1687 (Fed. Cir. 1993) (“Shell’s argument that the only consideration is the ‘design form’ of the words ‘Right-A-Way’, omitting the words ‘right-a-way’ because they were disclaimed, was correctly rejected by the Board.”).

Obviously, Opposer’s mark COTEACHER and the literal and dominant element of Applicant’s mark are highly similar in how they look and sound, because they differ only in the letter “V” added to Applicant’s mark. Furthermore, the placement and nature of the letter “V” in Applicant’s mark does not significantly change the meaning conveyed or commercial impression created by the term COTEACHER in Applicant’s mark. To the contrary, the letter “V” creates the impression of a specific type of “COTEACHER,” or an attribute of the “COTEACHER.” As Applicant testifies, the “V” in V COTEACHER means “Visual, Virtual and Value-Added Supplies.” 13 TTABVUE 3 (Barrett Dec. ¶ 6). Thus, some consumers could very well assume that V COTEACHER identifies a new product or service from the source of Opposer’s COTEACHER services, or that V COTEACHER is a modified version of Opposer’s COTEACHER mark.

This factor weighs in favor of finding a likelihood of confusion.

C. The Goods and Services, and Their Channels of Trade and Classes of Consumers

As we consider the goods and services, we keep in mind that they need not be identical or even competitive in order to find a likelihood of confusion. Rather, the

question is whether the goods and services are marketed in a manner that “could give rise to the mistaken belief that [the] goods emanate from the same source.” *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

Here, however, Applicant’s goods and services and Opposer’s software licensing services are not related on the face of the respective identifications. Nor is there evidence that the parties’ goods and services are related in any way, or that they travel in the same channels of trade to the same classes of purchasers.⁸ There is therefore no reason why consumers would mistakenly believe that Opposer’s software licensing services and Applicant’s education-related goods and services emanate from the same source.

⁸ In fact, Opposer did “not feel the need to discuss Applicant’s actual goods and services in depth at this time because Applicant has filed on an Intent-to-Use basis.” 14 TTABVUE 9.

VI. Conclusion

Although the marks are more similar than dissimilar, Opposer has not shown that the goods and services are related, or that they travel in the same channels of trade to the same classes of consumers, and this failure is dispositive. Here, because the goods and services are not related, confusion is unlikely notwithstanding that the marks are similar. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”); *Local Trademarks Inc. v. The Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (“even though opposer’s services and applicant’s product are or can be marketed to the same class of customers, naming plumbing contractors, these services and goods are so different that confusion is not likely even if they are marketed under the same mark”); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669-70 (TTAB 1986) (opposition dismissed because the goods were “quite different,” notwithstanding that the marks were the same).

Decision: The opposition is dismissed.