This Opinion is Not a Precedent of the TTAB

Oral Hearing: January 28, 2025 Mailed: July 25, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

O&M Halyard, Inc.
v.
Guidepoint Global, LLC

Cancellation Nos. 92077680 (parent) and 92078922

Andrea E. Bates and Kurt Schuettinger of Bates & Bates LLC
for O&M Halyard, Inc.

William W. Stroever, Elizabeth Carbone, and Mia Ritota of Cole Schotz P.C.,
for Guidepoint Global, LLC

Before Heasley, Dunn[1] and Bradley,
Administrative Trademark Judges.

Opinion by Bradley, Administrative Trademark Judge:

Guidepoint Global, LLC ("Respondent") owns Registration No. 6285787 for the mark QSIGHT, in standard characters,[2] and Registration No. 6231233 for the mark

[1] Judge Coggins sat on the panel at the oral argument. He has since retired, and Judge Dunn has been substituted for him on this decision. The change in composition of the panel does not necessitate a rehearing of the oral argument. *See In re Bose Corp.*, 772 F.2d 866, 869 (Fed. Cir. 1985).

[2] Application Serial No. 88610815, filed on September 10, 2019, matured into Registration No. 6285787, issued March 9, 2021, claiming January 2, 2018 as its date of first use and date of first use in commerce for both classes.

GUIDEPOINT QSIGHT, in standard characters,[3] both registered on the Principal Register for:

- Information in business matters and business consulting and information services; compiling and providing business industry data and analytics for market research purposes in International Class 35; and
- Providing a website and digital file-sharing services featuring technology that enables subscribers to receive updates of business industry market data and market trends via the website and the digital files in International Class 42.

O&M Halyard, Inc. ("Petitioner") filed Cancellation No. 92077680 seeking cancellation of Respondent's Registration No. 6285787 for the mark QSIGHT on July 27, 2021, and Cancellation No. 92078922 seeking cancellation of Respondent's Registration No. 6231233 for the mark GUIDEPOINT QSIGHT on January 27, 2022. The Board consolidated the two cancellation proceedings, which involve the same parties and related marks.[4] Under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), Petitioner alleges priority and a likelihood of confusion with its previously used and registered QSIGHT marks.[5]

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[3] Application Serial No. 88610888, filed on September 10, 2019, matured into Registration No. 6231233, issued December 29, 2020, claiming January 2, 2018 as its date of first use and date of first use in commerce for both classes.

[4] 25 TTABVUE 4.

Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Unless otherwise indicated, the TTABVUE citations in this opinion are to Cancellation No. 92077680, the parent case of these consolidated proceedings, and are to the redacted publicly accessible versions of materials.

[5] 1 TTABVUE 6-8. The cover sheet for the petition in Cancellation No. 92078922 also listed dilution by blurring as a ground for cancellation. 1 TTABVUE 2. However, the petition itself

Petitioner asserts ownership of the following four registrations and two applications:[6]

Registrations

- QSIGHT in standard characters for "clinical inventory management services" in International Class 35;[7]
- QSIGHT in standard characters for "computer services, namely, providing web-based non-downloadable software for clinical inventory management" in International Class 42;[8]
- QSIGHT RFID in standard characters (with "RFID" disclaimed) for "inventory management in the field of healthcare" in International Class 35, and "computer services, namely, providing web-based non-downloadable software for RFID inventory management" in International Class 42;[9] and
- QSIGHT KANBAN in standard characters (with "KANBAN" disclaimed) for "clinical inventory management services" in International Class 35.[10]

Applications

- QSIGHT DNA in standard characters (with "DNA" disclaimed) for "business consulting services in the field of data analytics and predictive analytics" in International Class 35;[11] and

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did not raise this claim, so the Board does not consider it. *See Rise Above Fitness LLC v. Rise Above Performance Training*, Can. No. 92065837, 2019 TTAB LEXIS 147, at *4 n.2 (TTAB 2019) ("The mere mention of a ground on the ESTTA coversheet is insufficient to allege the ground.").

[6] On July 27, 2021 when the original petition was filed, Petitioner pleaded two registrations (both for QSIGHT) and four pending applications (QSIGHT DNA, QSIGHT RFID, QSIGHT SMART SCAN, QSIGHT KANBAN). As listed above, the applications for QSIGHT RFID and QSIGHT KANBAN subsequently issued as registrations during the pendency of this proceeding respectively on November 7, 2023 and January 2, 2024. 53 TTABVUE 67, 74.

[7] Registration No. 5739878, registered on April 30, 2019.

[8] Registration No. 6357539, registered on May 18, 2021.

[9] Registration No. 7213585, registered on November 7, 2023.

[10] Registration No. 7262805, registered on January 2, 2024.

[11] Application Serial No. 88912543, filed on May 12, 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.

- QSIGHT SMART SCAN in standard characters (with "SCAN" disclaimed) for "clinical inventory management services" in International Class 35, and "computer services, namely, providing web-based non-downloadable software for clinical inventory management" in International Class 42.[12]

Petitioner also asserts common law rights in "marks that include the word element 'QSIGHT'" since at least as early as 2002.[13]

In its operative Answer, Respondent denied Petitioner's salient allegations, and did not assert any affirmative defenses.[14] On September 30, 2022, the Board granted in part Respondent's motion to amend its answer to add a counterclaim to cancel Petitioner's Registration Nos. 5739878 and 6357539 based on non-ownership, or in the alternative, abandonment due to naked licensing.[15] In its Answer to the counterclaim, Petitioner denied the salient allegations, and did not assert any affirmative defenses.[16]

For ease of identifying the parties, Petitioner/Counter-Defendant and Respondent/Counter-Plaintiff will be referred to as Petitioner and Respondent, respectively.

[12] Application Serial No. 90065110, filed on July 21, 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. On May 15, 2025, the USPTO granted Respondent's fifth request for an extension of time to file a statement of use.

[13] 1 TTABVUE 6-7.

[14] 12 TTABVUE 9-10.

[15] 25 TTABVUE 4-11; 12 TTABVUE 10-12. In the same order, the Board denied Respondent's motion to assert the counterclaim against Petitioner's pending applications. 25 TTABVUE 6. Respondent did not seek to amend the counterclaim when two of the applications (Application Serial Nos. 88912575 and 90849975) later issued as registrations.

[16] 28 TTABVUE.

The case is fully briefed, and the parties participated in an oral hearing. For the reasons set forth below, we grant Respondent's counterclaim based on non-ownership, and deny Petitioner's petitions to cancel both of Respondent's registrations.

I. Preliminary Matters

A. Registrations Subject to Respondent's Counterclaim

In the statement of issues in its trial brief Respondent lists its newly issued Registration Nos. 7213585 and 7262805 as subject to its counterclaim.[17] Under Trademark Rule 2.111, 37 C.F.R. § 2.111, Respondent must pay a fee to institute a counterclaim against a registration. Given that Respondent did not move to amend its answer to add the two new registrations to its counterclaim, and as such has not paid the required fees, we give no consideration to the purported counterclaim against Registration Nos. 7213585 and 7262805.[18] *See Hornblower & Weeks, Inc. v. Hornblower & Weeks*, Inc., Opp. No. 91110043, 2001 TTAB LEXIS 562, at *4-5 (TTAB 2001) (denying applicant's request to cancel opposer's registration where applicant "did not move for leave to amend its answer to assert a counterclaim and did not file

[17] 87 TTABVUE 12. Respondent's first identified issue states, "Whether U.S. Registration Nos. 5,739,878 (QSIGHT), 6,357,539 (QSIGHT), 7,213,585 (QSIGHT RFID), and 7,262,805 (QSIGHT KANBAN) should be cancelled on the grounds that OMH is not the actual owner of the trademark of the trademark rights reflected in those registrations."

[18] The Board previously advised Respondent in connection with its May 3, 2022 motion to amend its answer that a counterclaim to cancel would not be considered where "the required fee has not been paid." Can. No. 92078922, 10 TTABVUE. On May 11, 2022, Respondent "submitted payment of the fee for the cancellation of two registrations of $1,200," specifically, "pleaded Registration Nos. 5,739,878 and 6,357,539." Can. No. 92078922, 11 TTABVUE 3. Respondent did not submit any further fees.

the fee for a counterclaim"). Accordingly, we limit Respondent's counterclaim to Petitioner's Registration Nos. 5739878 and 6357539.[19]

B. Respondent's Objection to Petitioner's Trial Brief

Respondent requests that the Board strike the entirety of Petitioner's main trial brief for exceeding the limit of 55 pages in Trademark Rule 2.128(b).[20] Petitioner's trial brief is 69 pages, including two appendices that together total 24 pages.[21] Petitioner asserts that Respondent's request is baseless because its appendices "merely provide permissible and helpful reference materials to aid the Board in assessing the evidence and determining the outcome of this case."[22]

Trademark Rule 2.128(b) allows evidentiary objections to be raised and argued in an appendix to the trial brief which is not counted as part of the page limitation. However, a party may not use an appendix to present arguments on the substantive claims, or to otherwise circumvent the page limit. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, Can. No. 92050879, 2013 TTAB LEXIS 347, at *8 (TTAB 2013) (denying motion to strike brief where appendix was "devoted solely to asserting and arguing respondent's evidentiary objections as opposed to any of the substantive claims before us"). *See also* TRADEMARK TRIAL AND APPEAL BOARD

[19] This does not change the outcome of the case given that we find herein on Petitioner's likelihood of confusion claim, that Petitioner failed to establish priority for Registration Nos. 7213585 and 7262805.

[20] 87 TTABVUE 10-11, 65-66.

[21] 85 TTABVUE.

[22] 89 TTABVUE 19-20.

MANUAL OF PROCEDURE (TBMP) § 801.03 (2025) ("appendices to a brief may not be used to avoid the page limitation").

Here, Petitioner improperly used its appendices to present arguments regarding the substantive claims. The body of its brief merely points to the appendices for evidence demonstrating that the trade channels are similar without any discussion or argument regarding that evidence, or any citation thereto.[23] The appendices present arguments regarding the probative value of the evidence and how it supports Petitioner's claims. For example, Appendix A arranges evidence of third-party registrations to "show[] overlap" between consumers of the parties' respective services including "hospitals, medical device manufacturers, pharmaceutical development companies, investors and financial data."[24] And Appendix B excerpts materials from website screenshots interspersed with arguments regarding what the evidence allegedly supports.[25] Additionally, Petitioner's response that its appendices were meant "to aid the Board in assessing the evidence" confirms that its appendices are improper in presenting arguments on the substantive claims.[26]

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[23] 85 TTABVUE 41.

[24] 85 TTABVUE 50-55.

[25] 85 TTABVUE 56-72. The Appendix states that it contains a "summary of third-party websites" that "[s]how[s] they offer services for same overlapping goods and industries at issue in this Cancellation/Opposition." *Id.* At 57. Petitioner presents arguments on the various third-party websites such as that ZS "help[s] with all aspects of supply chain" and "also offer data analytics to these industries," and that "[t]here are 22 various different links on McKinsey's website related the various financial and advisory services they offer to all aspects of the healthcare systems." *Id.* At 58, 68.

[26] 89 TTABVUE 19. Petitioner's reliance on *Harjo v. Pro-Football, Inc.*, Can. No. 92021069, 1998 TTAB LEXIS 7 (TTAB 1998) is misplaced. *See* 89 TTABVUE 20. There, the Board found that the appendices containing evidentiary and testimonial objections were permissible and

Accordingly, we grant Respondent's request in part, and strike the appendices from Petitioner trial brief. We will consider only the body of Petitioner's trial brief (i.e., 85 TTABVUE 1-48).

II. Trial Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), the files of Respondent's subject registrations and Petitioner's two registrations subject to the counterclaim. In addition, the parties both submitted testimony, notices of reliance, and exhibits.[27] We have carefully considered the entire record, and relevant evidence is discussed throughout this opinion. *See Quiktrip W., Inc. v. Weigel Stores, Inc.,* 984 F.3d 1031, 1036 (Fed. Cir. 2021) (Board not obliged to expressly discuss every piece of evidence); *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1348 (Fed. Cir. 2012) ("[T]he mere fact that the Board did not recite all of the evidence it considered does not mean the evidence was not, in fact, reviewed.").

Respondent submitted an appendix of evidentiary objections.[28] Petitioner responded to Respondent's objections, but did not raise any evidentiary objections of its own.[29] In analyzing the evidence, we have kept in mind Respondent's objections

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did not count against the page limit for briefs. *Harjo*, 1998 TTAB LEXIS 7, at *10-11. Those appendices of evidentiary objections were what the Board deemed a "useful reference," and it did not otherwise state that parties may submit evidence summaries or other discussion on substantive claims in an appendix.

[27] Petitioner's trial brief lists the evidence filed by each party in the case (85 TTABVUE 7-19), and Respondent agrees that Petitioner accurately described the evidence submitted in the case. 87 TTABVUE 11.

[28] 87 TTABVUE 55-66. *See also* 93 TTABVUE 17-26 (Respondent's reply brief with arguments in support of its evidentiary objections).

[29] 89 TTABVUE.

and Petitioner's response, and accorded testimony and evidence whatever probative value it merits. As necessary and appropriate, we will point out any limitations in the evidence and where we have not considered evidence. *See RxD Media, LLC v. IP Application Dev. LLC,* Opp. No. 91207333, 2018 TTAB LEXIS 37, at *10 (TTAB 2018).

The parties designated portions of the record as confidential under the Board's Standard Protective Order and filed the unredacted versions under seal. We will discuss all relevant evidence designated as confidential in general terms in this opinion, if necessary and appropriate. However, to the extent that either party improperly designated testimony and evidence as confidential, the Board is not bound by such designation. Trademark Rule 2.116(g) ("Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."). We will treat as confidential only testimony and evidence that is truly confidential, so that we may discuss the pertinent evidence of record and the parties and a reviewing court will know the basis of the Board's decision. *See Major League Baseball Players Ass'n v. Chisena*, Opp. No. 91240180, 2023 TTAB LEXIS 117, at *4 n.8 (TTAB 2023). We remind the parties that "only the particular exhibits or deposition transcript pages of the testimony affidavit, declaration or deposition that disclose confidential information should be filed under seal."[30] TBMP § 703.01(p). *See also* Trademark Rule 2.27(e). Additionally, in all

[30] When filing their confidential trial submissions, both parties included both the public and confidential portions in their filings under seal, as well as separately filing redacted public versions. This necessitates further comparison of duplicative filings and increases the size of the record and the burden on the Board.

confidential submissions, "parties are strongly encouraged to enclose confidential information in brackets to better mark the specific information to be kept confidential" which will facilitate comparison between the public and confidential versions as the Board prepares a final decision. TBMP § 703.01(p).

III. The Parties

Third-party Owens & Minor, Inc. ("O&M, Inc.") is a Fortune 500 global healthcare solutions company.[31] Petitioner O&M Halyard, Inc. is a subsidiary of O&M, Inc., and is a medical product company specializing in manufacturing and selling medical equipment and providing other services in the healthcare industry.[32] Third-party Owens & Minor Distribution, Inc. ("O&M Distribution") also is a subsidiary of O&M, Inc. and a sister company of Petitioner.[33]

Respondent Guidepoint, LLC provides expert network services and related data products to its customers in various industries.[34]

IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes proceeding. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298,

[31] 53 TTABVUE 2 ¶ 3; 54 TTABVUE 2 ¶ 2.

[32] 53 TTABVUE 2 ¶¶ 3-4; 54 TTABVUE 2 ¶¶ 1-3.

[33] Petitioner, relying on a link to documents filed with the SEC, asserts that O&M Distribution is a subsidiary of O&M, Inc. 91 TTABVUE 7. Respondent objected that Petitioner did not follow the requirements to make the information properly of record. 93 TTABVUE 8. However, Petitioner confirmed at the hearing that O&M Distribution is a sister company of Petitioner (i.e., that both Petitioner and O&M Distribution are subsidiaries of O&M, Inc.) and Respondent did not object. *See also* 54 TTABVUE 2 ¶¶ 1-2 (O&M Inc. "owns numerous healthcare-related subsidiaries").

[34] 73 TTABVUE 2-3 ¶¶ 3-5.

1304-05 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373-74 (Fed. Cir. 2020) (*citing Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 (2014)). A plaintiff establishes its entitlement to a statutory cause of action by demonstrating (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 978 F.3d at 1305-06; *Mars Generation, Inc. v. Carson*, Opp. No. 91224726, 2021 TTAB LEXIS 386, at *8 (TTAB 2021).

Here, Petitioner established its entitlement to seek cancellation of Respondent's marks by making of record the registrations and applications pleaded in its petition which form the basis for a plausible Section 2(d) likelihood of confusion claim.[35] *See Look Cycle Int'l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Can. No. 92079409, 2024 TTAB LEXIS 289, at *8 (TTAB 2024) ("Petitioner's pleaded registrations that support a plausible likelihood of confusion claim" established entitlement); *Fuji Med. Instruments Mfg. Co. v. Am. Crocodile Int'l Grp., Inc.*, Can. No. 92062760, 2021 TTAB LEXIS 270, at *14-15 (TTAB 2021) (evidence of petitioner's pending application "is sufficient to establish [p]etitioner's entitlement to bring a cancellation proceeding"). *See also Lipton Indus. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (CCPA 1982) ("We regard the desire for a registration with its attendant statutory advantages as a legitimate commercial interest.").

[35] 53 TTABVUE 50-77 (containing copies of registration certificates and TSDR printouts listing Petitioner as the owner and showing current status of the pleaded registrations); 53 TTABVUE 78-97 (containing copies of applications and TSDR printouts listing Petitioner as the owner and showing current status of the pleaded applications).

Respondent asserts that Petitioner "has not established that it is the owner of any rights that would give it a real interest in this proceeding" and cites evidence underlying its non-ownership counterclaim in support.[36] However, as explained above, Respondent's counterclaim was not asserted against Petitioner's Registration Nos. 7213585 or 7262805, or Petitioner's pending applications.[37] These registrations and applications are sufficient to establish Petitioner's entitlement to a statutory cause of action.

Respondent is entitled to seek cancellation of Petitioner's Registration Nos. 5739878 and 6357539 "by virtue of being the defendant in this cancellation proceeding." *Robinson v. Hot Grabba Leaf, LLC*, Can. No. 92060394, 2019 TTAB LEXIS 96, at *16 (TTAB 2019).

V. Respondent's Counterclaim

We begin our analysis with Respondent's counterclaim, since it will affect which of Petitioner's registrations may serve as a basis for Petitioner's likelihood of confusion claim. *See Robinson*, 2019 TTAB LEXIS 96, at *16-17 (addressing counterclaim first where it was "potentially dispositive of the case" in determining whether "[p]etitioner's asserted registrations will be cancelled and are unenforceable against [r]espondent"). Respondent seeks to cancel Petitioner's Registration Nos. 5739878 and 6357539 for the mark QSIGHT on the ground that Petitioner "is not the owner of any of the trademark rights underlying those registrations and, in the

[36] 87 TTABVUE 27.

[37] *See* 25 TTABVUE 6, 11.

alternative, that even if [Petitioner] is found to be the owner of those trademark rights, [Petitioner] abandoned those rights through uncontrolled, naked licensing."[38]

Under Trademark Act Section 1(a)(1), 15 U.S.C. § 1051(a)(1), only "[t]he owner of a trademark used in commerce may request registration of its trademark . . .." Accordingly, for use-based trademark applications, like the ones underlying Petitioner's registrations here, only the owner of the trademarks may file the applications seeking registration. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319 n.6 (CCPA 1976) ("One must be the owner of a mark before it can be registered.") *CBC Mortg. Agency v. TMRR, LLC*, Can. No. 92076723, 2022 TTAB LEXIS 295, at *21 (TTAB 2022) ("Only the owner of the mark may file an application to register it.") (citation omitted). "[R]egistration by one who did not own the mark at the time of filing renders the underlying application void *ab initio*." *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 1027 (Fed. Cir. 2017); *Great Seats, Ltd. v. Great Seats, Inc.*, Can. No. 92032524, 2007 TTAB LEXIS 68, at *12 (TTAB 2007) ("In a use-based application . . . if the entity filing the application is not the owner of the mark as of the filing date, the application is void ab initio"). *See also* Trademark Rule 2.71(d) ("An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.").

Petitioner's Registration Nos. 5739878 and 6357539 are registered on the Principal Register and are therefore entitled to the *prima facie* presumptions of the validity of the registrations and Petitioner's ownership of the registered mark

[38] 87 TTABVUE 19.

QSIGHT. 15 U.S.C. § 1057(b); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 146 (Fed. Cir. 2021) ("mark registered on the Principal Register is presumed to be valid"). "Due to this presumption of validity, the burden of persuasion in a cancellation proceeding rests on the party seeking to cancel the registration. A party seeking to cancel a registration must overcome the registration[s'] presumption of validity by a preponderance of the evidence." *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1356 (Fed. Cir. 2009); *CBC Mortg. Agency*, 2022 TTAB LEXIS 295, at *23-24 (party seeking cancellation "bears the burden of proving by a preponderance of the evidence that [r]espondent]does not own the . . . [m]ark"). Accordingly, to prevail on its non-ownership counterclaim, Respondent must establish by a preponderance of the evidence that Petitioner was not the owner of the applications underlying Registration Nos. 5739878 and 6357539 at the time Petitioner filed the applications with the USPTO.

A. Chain of Title for the QSIGHT Mark

The testimony and evidence of record establishes the following chain of title for trademark rights in QSIGHT in relation to clinical inventory management services and web-based non-downloadable software for clinical inventory management:

- **2002**: 5nQ, Inc., a third party, created QSIGHT as an inventory management platform for use in healthcare facilities including hospitals;[39]

[39] 53 TTABVUE 3 ¶¶ 6-7, 9 (Wayback Machine screenshot of 5nq.com stating: "QSight℠ Is Web-based Inventory management, for hospital departments"), 10 (Wayback Machine screenshot of 5nq.com stating: "QSight™ Hosted Inventory Management"); 54 TTABVUE 3 ¶ 7. *See also* 52 TTABVUE 20 (Exhibit B, Asset Purchase Agreement stating in relevant part: "Internet-based platform known as 'QSight', . . . facilitates centralized inventory management among multiple manufacturers and multiple purchasers of healthcare

- **March 15, 2004**: 5nQ, Inc. sells the QSIGHT platform including the associated assets, contracts, software and intellectual property (including the mark QSIGHT) to O&M Distribution [sister company to Petitioner O&M Halyard];[40]

- **March 15, 2004 – present**: O&M Distribution uses the mark QSIGHT and directly manages the QSIGHT business.[41] For example, in the sample QSIGHT Services Agreement provided by Petitioner:
    - the contracting parties are "Owens & Minor Distribution, Inc." (shortened in the agreement to "O&M") and "Customer;"[42]
    - "QSight" is defined to mean "[O&M Distribution's] proprietary QSIGHT® web-based inventory management system;"[43]
    - The agreement additionally states "[O&M Distribution] is the sole owner of or otherwise has all necessary Intellectual Property Rights

products"). Petitioner designated the entire Exhibit B as confidential, but this description of QSIGHT contains information similar to that in the public record.

[40] 52 TTABVUE 12, 20, 24 (defining "intellectual property"), 27-28, 35-36, 63, 80 (Exhibit B Asset Purchase Agreement between 5nQ, Inc. and Owens & Minor Distribution, Inc.) (confidential); 53 TTABVUE 3 ¶ 9. Ms. Lyle's declaration states that the Asset Purchase Agreement reflects a sale of the QSight brand between "5nQ and O&M", and she defines O&M to mean O&M, Inc. and Petitioner. However, this testimony is contradicted by the agreement itself reflecting that 5nQ sold QSight to O&M Distribution. Additionally, other evidence shows that Petitioner did not yet exist at the time of the sale. *See* 95 TTABVUE 50 Response to Int. No. 36.

[41] *See, e.g.*, 54 TTABVUE 8 ¶ 36; 55 TTABVUE 161-186 (Exhibit G containing a representative sample of a QSight customer service contract) (confidential); 65 TTABVUE 2-3, 7-64 (containing other agreements produced by Petitioner during discovery which Petitioner stipulated were authentic) (confidential). Petitioner designated the entirety of all the agreements as confidential, but we do not treat the portions of the contract addressing the identity of the contracting O&M entity or ownership of QSight as confidential because Petitioner has discussed ownership in its public filings.

While Ms. Lyle's declaration states that after acquisition in 2004 "the QSight brand was managed directly by O&M [which she defines as O&M, Inc. and Petitioner]" (53 TTABVUE 3 § 10), this statement is contradicted by other evidence in the record and we do not consider it probative. Specifically, Petitioner did not exist until thirteen years later, O&M Inc., did not acquire any rights from 5nQ, and O&M Distribution, which did acquire the rights, is listed as the sole provider of the services in contracts. The record does not support a finding that either O&M, Inc. or Petitioner could "manage[]" the QSIGHT brand. *See* 95 TTABVUE 50 Response to Int. No. 36; 52 TTABVUE 20 (confidential).

[42] 55 TTABVUE 163.

[43] 55 TTABVUE 163 § 1.12.

(including any applicable third-party rights) in the Services [defined to include QSIGHT] . . . to grant the rights set forth herein;"[44] and

- "[O&M Distribution] retains all ownership, right, title, and interest in and to QSight IP, and all copyright, trade secret, patent and related intellectual property rights."[45]

Other agreements in the record covering use of the QSIGHT platform and software similarly identify O&M Distribution (or a division thereof) as the contracting party[46] and recognize O&M Distribution as the owner of QSIGHT and the associated intellectual property:

- "Agreement relates to the use . . . of OMSolutions's [an operating unit of O&M Distribution] Web-based platform, which facilitates centralized inventory management among multiple manufacturers and multiple purchasers of healthcare products (the 'QSight Application');"[47]
- "[T]he QSight Application, as well as all derivative works, error corrections, enhancements, upgrades, new releases and new versions thereof, are and shall continue to be solely owned by OMSolutions [an operating unit of O&M Distribution]";[48]
- "OMSolutions [an operating unit of O&M Distribution] represents and warrants . . . that it has the right to enter into this Agreement and that it possesses the ownership and intellectual property rights in and to the QSight Application necessary to offer the services offered to [Customer] hereunder";[49]
- "'QSight' and 'QSight Program' means [O&M Distribution's] proprietary QSIGHT℠ web-based inventory management system";[50]
- "[O&M Distribution] retains all ownership, right, title, and interest in and to the Platform, the QSight Program, Content and related

[44] 55 TTABVUE 166 § 6.3(e); *see also* 55 TTABVUE 163 § 1.15.

[45] 55 TTABVUE 168 § 8.1.

[46] 65 TTABVUE 8 (agreement entered into by "OMSolutions, an operating unit of Owens & Minor Distribution, Inc."), 29 ("QSight℠ Services Agreement" entered into by "Owens & Minor Distribution Inc."), 37 ("QSight Services Agreement" entered into by "Owens & Minor Distribution, Inc."), 58 ("QSight® Services Agreement" entered into by "Owens & Minor Distribution Inc.").

[47] 65 TTABVUE 8.

[48] 65 TTABVUE 11 § 4.1 ("Title").

[49] 65 TTABVUE 12 § 6.2 ("Title").

[50] 65 TTABVUE 29 § 1.6, 58 § 1.6.

Documentation, and all copyright, trade secret, patent and other intellectual property rights contained therein"[51]

- "'Software' means O&M [Distribution]'s QSight software that facilitates centralized inventory management";[52] and
- "O&M [Distribution] shall provide the following: (i) access to the Platform . . . to allow Users to use the QSight Program and Platform"[53]

- **November 14, 2017**: Petitioner was formed as a legal entity;[54]
- **October 19, 2018**: Petitioner purports to grant an exclusive license to the mark QSIGHT to O&M Distribution and O&M, Inc.;[55]
- **October 19, 2018**: Petitioner files Application Serial No. 88161998 for the mark QSIGHT covering "clinical inventory management services" which matured into Registration No. 5739878;[56] and
- **May 14, 2020**: Petitioner files Application Serial No. 88916269 for the mark QSIGHT covering "Computer services, namely, providing web-based non-downloadable software for clinical inventory management" which matured into Registration No. 6357539.[57]

As the above timeline demonstrates, after O&M Distribution acquired rights to the mark QSIGHT from 5nQ, there is a dearth of proof showing that O&M Distribution transferred any rights to the mark QSIGHT to Petitioner. The October

[51] 65 TTABVUE 30 § 4.2 ("Title to Intellectual Property"), 60 § 4.2 ("Title to Intellectual Property").

[52] 6 TTABVUE 37 § 1.6.

[53] 65 TTABVUE 58 § 2.1.

[54] 95 TTABVUE 50 Response to Int. No. 36. In response to the interrogatory, "[i]dentify the date on which O&M Halyard, Inc. was formed as a legal entity," Petitioner responded, "November 14, 2017".

[55] 53 TTABVUE 5 ¶¶ 15-16; 52 TTABVUE 186-188 (Exhibit J containing the license agreement) (confidential). Petitioner designated the entire license agreement in Exhibit J as confidential, but the identification of the licensing parties is not confidential and is identified elsewhere in public filings.

[56] 53 TTABVUE 51, 53.

[57] 53 TTABVUE 58, 60-61.

19, 2018 license agreement states that, "Licensor [Petitioner] was previously assigned all right title and interest in and to the QSIGHT mark(s) from Licensee [defined as O&M, Inc. and O&M Distribution]."[58] But this statement is vague and not sufficient on its own to prove a transfer of rights. Petitioner confirmed in its interrogatory responses that the license agreement is the only written agreement between Petitioner and O&M Distribution "that involve the transfer of rights in any QSIGHT Formative Marks."[59]

"An assignment in writing . . . is not necessary to pass common law rights to trademarks." *Gaylord Bros. v. Strobel Prods. Co.*, 1963 TTAB LEXIS 155, at *7 (TTAB 1963). Petitioner may prove the existence of an assignment "by clear and uncontradicted testimony by a person or persons in a position to have knowledge of the transactions affecting said [trademark] designations." *Sun Valley Co. v. Sun Valley Mfg. Co.*, 1970 TTAB LEXIS 236, at *19 (TTAB 1970); *Diebold, Inc. v. Multra-*

[58] 52 TTABVUE 87; 91 TTABVUE 8. Petitioner redacted this statement in its briefing asserting it is confidential, but we do not consider this statement pertaining to the ownership of the trademark at issue to be confidential. Additionally, we only consider the first license appearing in Exhibit J (at 52 TTABVUE 186-188) because the second license is not signed by O&M Distribution. *See* 52 TTABVUE 189. Even if we had considered this second license it would not change the result as the second license also does not provide evidence of a transfer of rights in OSIGHT from O&M Distribution to Petitioner.

[59] The interrogatories defined the term "QSIGHT Formative Marks" to "mean and refer to all federal, state, and common law trademarks owned by [Petitioner] that incorporate the term 'Qsight' somewhere in the overall trademark, including but not limited to the trademarks QSIGHT, QSIGHT DNA, QSIGHT RFID, QSIGHT SMART SCAN, and QSIGHT KANBAN" [i.e., all the trademarks at issue in this proceeding]. 95 TTABVUE 44. Interrogatory No. 38 requested Petitioner to "[i]dentify each written agreement to which O&M Halyard, Inc. and Owens & Minor Distribution, Inc. are parties that involve the transfer of rights in any QSIGHT Formative Marks." 95 TTABVUE 50. Petitioner responded, "Petitioner refers to Bates No. 002758-002760," which are the Bates numbers for the license agreement. *Id.*; *see also* 52 TTABVUE 187-189 (confidential).

Guard, Inc., 1975 TTAB LEXIS 170, at *15 (TTAB 1975) ("The acquisition of such [trademark] rights may be established by oral testimony and if such oral testimony is clear and uncontradictory testimony it may be accepted to prove the assignment.").

However, here, there is no testimony regarding the assignment of the mark QSIGHT, much less "clear and uncontradictory" testimony, nor is there any documentary or other evidence showing that the mark QSIGHT was assigned to Petitioner. Specifically, Ms. Lyle, who is currently Vice President of Industry Associations of O&M, Inc., and who has worked at O&M Inc. since 1987, testified that after the acquisition from 5nQ in 2004, she "oversaw the QSight brand for a number of years" and became "intimately familiar with the QSight business and the trademarks associated with QSight that are at issue in this proceeding."[60] Her testimony does not address and is silent regarding any assignment or transfer of rights in the mark QSIGHT from O&M Distribution to Petitioner. She merely asserts that Petitioner currently "owns the QSight brand and trademarks" and vaguely refers to "predecessors-in-interest" without identifying who they are or providing any explanation of how, when, or from whom Petitioner allegedly acquired the rights in the "QSight brand and trademarks".[61] Petitioner's other witness, Ms. McNally, is currently Vice President of Products and Healthcare Services East of O&M, Inc., and has been working at O&M, Inc. since 1999.[62] She testified that she has "been working

[60] 53 TTABVUE 2 ¶ 1, 3 ¶¶ 8, 10, 12.

[61] 53 TTABVUE 3-5 ¶¶ 5, 13, 14, 18.

[62] 54 TTABVUE 2 ¶ 1.

with QSight since at least 2018."[63] Similarly, her testimony does not address and is silent regarding any assignment or transfer of rights in the mark QSIGHT from O&M Distribution to Petitioner. She also merely asserts that Petitioner currently "owns the QSight brand and trademarks."[64] Ms. McNally identifies 5nQ, the creator of QSIGHT, as a "predecessor-in-interest" to Petitioner, but offers no explanation as to how any rights transferred from 5nQ to Petitioner when Petitioner did not yet exist until more than ten years after 5nQ sold QSIGHT to O&M Distribution in March 2004.[65] Ms. McNally's only reference to O&M Distribution in her testimony is to Petitioner's alleged licensing of QSIGHT to O&M Distribution; but again, the testimony is silent as to how Petitioner ever acquired any rights to license.[66] There simply is insufficient evidence in the record that the rights in the mark QSIGHT were ever transferred from O&M Distribution to Petitioner. *See Great Seats*, 2007 TTAB LEXIS 68, at *23.[67]

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[63] 54 TTABVUE 3 ¶ 6.

[64] 54 TTABVUE 2 ¶ 4.

[65] 54 TTABVUE 3 ¶ 7; 52 TTABVUE 20 (Exhibit B, Asset Purchase Agreement dated March 15, 2004 between O&M Distribution (the "buyer") and 5nQ (the "seller")); 95 TTABVUE 50 Response to Int. No. 36 (Petitioner was formed as a legal entity on November 14, 2017).

[66] 54 TTABVUE 2 ¶ 4.

[67] In *Great Seats*, the respondent's principal, Mr. Matta, formed a corporation, the '410 corporation for his ticket brokerage business which used the mark GREAT SEATS. *Id.* at 6-7. Subsequently, Mr. Matta decided he wanted to test out using Great Seats as the name of his company, and he formed a new second corporation, the '660 corporation. *Id.* at 8-9. The original '410 corporation continued all use and advertising of the mark GREAT SEATS, and there was no transfer of rights from the first '410 corporation to the new '660 corporation, nor any evidence of control by the '660 corporation over the '410 corporation's use of the mark. *Id.* at 9-10. However, subsequently, the trademark application for the mark GREAT SEATS was filed with the new '660 corporation as the applicant. *Id.* The Board similarly determined there that since there "was no transfer of rights in the mark from the '410 corporation to the

B. Petitioner Does Not Use the Mark QSIGHT

The record also lacks evidence that Petitioner is using the mark QSIGHT in a way that would establish its ownership of the mark. *See Lyons*, 859 F.3d at 1027 ("It is axiomatic in trademark law that ownership of a mark is predicated on priority of use in commerce."); *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993) ("Trademark ownership results only from use, not from registration."). As discussed above, the evidence of record demonstrates that it is O&M Distribution, not Petitioner, that has used the mark QSIGHT--entering contracts and providing the services of the QSIGHT platform and software. Petitioner's witnesses, Mses. Lyle and McNally, both testify that Petitioner "uses its QSight brand and trademarks in commerce" "[b]y and through [Petitioner's] licensees [O&M, Inc. and O&M Distribution]."[68] Accordingly, Petitioner argues that through the license it can rely on O&M Distribution's use to establish ownership, and that it "licensed back to O&M Distribution (and O&M Minor, Inc.) the right to continue to use the QSight mark as it has been doing from 2004-2018."[69]

The chain of title discussed above, however, demonstrates that as of the date of the purported license agreement, Petitioner did not own any proven rights in the mark QSIGHT to license because Petitioner failed to prove that O&M Distribution had assigned rights in the mark to Petitioner. In the absence of the first step, an

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new '660 corporation prior to the application filing date . . . [it] was the '410 corporation, not the [new] '660 corporation, that was the owner of the mark as of the filing date." *Id.* at 23.

[68] 53 TTABVUE 2 ¶ 5; 54 TTABVUE 2 ¶ 4.

[69] 91 TTABVUE 7-10.

assignment from O&M Distribution of the mark QSIGHT along with its goodwill to Petitioner, Petitioner could not "license back" to O&M Distribution rights that it never owned in the mark QSIGHT. *See Visa, U.S.A., Inc. v. Birmingham Tr. Nat'l Bank*, 696 F.2d 1371, 1376-77 (Fed. Cir. 1982) (recognizing the "well-settled commercial practice" of an assignment and license back that "should be handled by an assignment of the mark and good will, followed by license back to the assignor of the mark") (citation omitted). *See also* 2 *McCarthy on Trademarks and Unfair Competition* § 18:8 (5th ed. 2025) ("An assignor's desire to retain some rights to continue to use the mark should be handled by an assignment of the mark and good will, followed by a license back to the assignor of the mark."). As such, the purported license is invalid, O&M's Distribution is not a licensee of Petitioner, and O&M's Distribution's use of the mark QSIGHT does not inure to Petitioner.

C. Petitioner and O&M Distribution are not Related Companies

Petitioner also argues that it may rely on O&M Distribution's use of the mark QSIGHT because they are related companies under Trademark Act Section 5, 15 U.S.C. § 1055. While Petitioner's argument is not entirely clear, it appears to be asserting that Petitioner and O&M Distribution are related because they are sister companies (i.e., they are both subsidiaries of O&M, Inc.).[70]

Section 5 of the Trademark Act provides that:

> Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant

[70] 91 TTABVUE 6-8. Petitioner also argues that O&M Distribution is a related company because it is Petitioner's licensee, but as discussed, the license agreement is invalid.

> for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

A "related company" is "any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used." 15 U.S.C. § 1127. "The essence of related-company use is the control exercised over the nature and quality of the goods or services on or in connection with which the mark is used." *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, Can. No. 92057394, 2016 TTAB LEXIS 100, at *31, 34-35 (TTAB 2016) (corporation did not meet definition of related company where record lacked evidence of requisite control). The nature of the control inherent in a parent-subsidiary relationship generally suffices to establish use by related companies. *In re Pharmacia, Inc.*, Ser. No. 73523579, 1987 TTAB LEXIS 93, at *5-6 (TTAB 1987) (The "related company" doctrine "specifically is indicated to be applicable to ownership issues vis-a-vis parent and subsidiary corporations. The reason for this is the control over the nature and quality of the goods that naturally flows from the parent subsidiary relationship.").[71]

However, such control "is absent in the case of sister corporations" such that "the mere fact that two sister companies are both controlled by a third company [does not] mean[] that use by one of the sister companies automatically inures to the benefit of the other sister." *Id.* at *6. *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE

[71] Petitioner does not argue, and there is no evidence in the record that Petitioner and O&M Distribution have a parent-subsidiary relationship. *See* 91 TTABVUE 6-8; 93 TTABVUE 7.

(TMEP) § 1201.03(d) and cases cited therein ("The fact that two sister corporations are controlled by a single parent corporation does not mean that they are related companies."). Rather, for the use to inure, the sister company that is the trademark applicant (here Petitioner) "must show that as of the . . . application filing date, the applicant . . . controlled [O&M Distribution's] use of the mark with respect to the nature and quality of the services rendered under the mark [QSIGHT]". *Great Seats*, 2007 TTAB LEXIS 68, at *27, 30-33 (holding trademark applicant was not the owner of the mark where the record was devoid of evidence that it controlled its sister corporation's use of the mark).

Here, the only evidence Petitioner provides regarding any control it asserts over O&M's Distribution's use of the mark QSIGHT is the license agreement signed on the same day that Petitioner filed its first application for the mark QSIGHT.[72] Since we have already determined the license agreement is invalid, it does not suffice to establish any control by Petitioner over O&M Distribution.[73] Petitioner's witnesses

[72] 52 TTABVUE 187 (confidential); 53 TTABVUE 53. The lack of evidence of control is further demonstrated by Petitioner's contradictory interrogatory responses on control claiming both that Petitioner and O&M Distribution controlled the use of QSIGHT. Specifically, when asked to "[d]escribe in detail each way in which Owens & Minor Distribution, Inc. controls the use by O&M Halyard, Inc. of the QSIGHT Formative Marks," Petitioner responded that "Owens & Minor Distribution, Inc. controls the QSIGHT Formative Marks via its license agreement with O&M Halyard, Inc. [i.e., Petitioner]." 95 TTABVUE 51 (Response to Int. No. 39). But then Petitioner also responded to another interrogatory that "[Petitioner] controls the use by Owens & Minor Distribution, Inc. of the QSIGHT Formative Marks via its license agreement with Owens & Minor Distribution, Inc." 95 TTABVUE 51 (Response to Int. No. 40).

[73] Petitioner notes that "Nicholas J. Pace as EVP, General Counsel & Corporate Secretary for all three entities executed the 2018 Exclusive License Agreement on behalf of the companies." 91 TTABVUE 9. But such overlap in corporate officers is insufficient to establish that companies are related. *See In re Raven Marine, Inc.*, Ser. No. 73139236, 1983 TTAB LEXIS

do not provide testimony sufficient to establish control by Petitioner over O&M Distribution's use of the mark QSIGHT.[74] Accordingly, O&M Distribution is not a related company, and Petitioner may not rely on O&M Distribution's use to establish ownership of the mark QSIGHT.

D. Conclusion on Respondent's Non-Ownership Counterclaim

Respondent has thus established by a preponderance of the evidence, that on the filing date of the applications underlying Petitioner's Registration Nos. 5739878 and 6357539, Petitioner did not own the mark QSIGHT, and as such Petitioner's underlying applications are void *ab initio* and the resulting registrations are invalid. *See Wonderbread 5 v. Gilles*, Can. No. 92052150, 2015 TTAB LEXIS 261, at *38-39 (TTAB 2015) (granting cancellation where underlying application was void ab initio and resulting registration was invalid because party was not the owner of the mark at the time it filed the application). Accordingly, we grant Respondent's counterclaim to cancel Registration Nos. 5739878 and 6357539 on the basis of non-ownership, and do not reach the alternative basis of naked licensing.

142, at *3 (TTAB 1983) ("corporations do not become 'related companies' under the Trademark Act merely by virtue of having the same stockholders, directors or officers, or by virtue of occupying the same premises"); *Great Seats*, 2007 TTAB LEXIS 68, at *28 ("[I]t is settled that these points of commonality [i.e., the same president, controlling shareholder and premises] between two corporations do not suffice to make the corporations related companies under Trademark Act Section 5.").

[74] *See* 53 TTABVUE; 54 TTABVUE.

VI. Petitioner's Likelihood of Confusion Claim

In view of our grant of the counterclaim, we turn to Petitioner's likelihood of confusion claim based on its pleaded common law rights in "marks that include the word element 'QSIGHT'", and the remaining pleaded registrations and applications:

- Registration No. 7213585 for the mark QSIGHT RFID in standard characters (with "RFID" disclaimed) for "inventory management in the field of healthcare" in International Class 35, and "computer services, namely, providing web-based non-downloadable software for RFID inventory management" in International Class 42; and
- Registration No. 7262805 for the mark QSIGHT KANBAN in standard characters (with "KANBAN" disclaimed) for "clinical inventory management services" in International Class 35.
- Application Serial No. 88912543 for the mark QSIGHT DNA in standard characters (with "DNA" disclaimed) for "business consulting services in the field of data analytics and predictive analytics" in International Class 35; and
- Application Serial No. 90065110 for the mark QSIGHT SMART SCAN in standard characters (with "SCAN" disclaimed) for "clinical inventory management services" in International Class 35, and "computer services, namely, providing web-based non-downloadable software for clinical inventory management" in International Class 42.

A. Priority

"In a cancellation proceeding such as this one where both parties own registrations, priority is in issue." *Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 TTAB LEXIS 347, at *13 (TTAB 2019) (citation omitted). Petitioner must prove that it "has a proprietary interest in [its] mark[s] . . . and that interest was obtained prior to either the filing date of [Respondent's] application[s] for registration or [Respondent's] date of first use." *Top Tobacco, L.P. v. N. Atl. Operating Co.*, Can. No. 92043186, 2011 TTAB LEXIS 367, at *15-16 (TTAB 2011).

1. Petitioner Cannot Rely on Family of Marks or Zone of Expansion to Establish Priority

Petitioner does not explicitly state in its briefs that it is relying on a family of marks to prove priority, but it does allege in its petitions for cancellation that it "has adopted and used since at least as early as 2002, a number of marks that include word element 'QSIGHT' ('Petitioner's Marks') exclusively for and in the connection with the promotion, advertising and sale of inventory management and computer services."[75] However, as we previously informed Petitioner, the allegations in its petitions were insufficient to plead a family of marks.[76] *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991) ("Simply using a series of similar marks does not of itself establish the existence of a family."). Petitioner never amended its petitions to assert a family of marks, and does not otherwise establish the requirements necessary to prove it owns a family of marks. Accordingly, we agree with Respondent that Petitioner may not rely on a family of marks to establish priority.[77]

In its reply brief, Petitioner responds that "[Respondent's] argument that [Petitioner] failed to demonstrate its QSIGHT marks are a family of marks misses the point" and asserts for the first time that under the "natural zone of expansion" "as the superior right holder, [Petitioner] (not [Respondent]), is entitled to expand its

[75] 1 TTABVUE 6 ¶¶ 2-3; Can. No. 92078922, 1 TTABVUE 7 ¶¶ 2-3. Petitioner also asserts in its briefs that its Registration No. 5739878, with the earliest constructive use date, provides priority as to all of its registrations, but we have granted Respondent's counterclaim to cancel this registration. *See* 85 TTABVUE 31; 91 TTABVUE 15.

[76] 45 TTABVUE 7 n.14.

[77] 87 TTABVUE 28, 33.

use and portfolio."[78] However, since Petitioner waited until its reply brief to raise this issue, it constitutes improper rebuttal argument, and we will not consider it. *See Rocket Trademarks Pty Ltd. v. Phard S.P.A.,* Opp. No. 91172486, 2011 TTAB LEXIS 39, at *37 (TTAB 2011) citing TBMP § 801.03 (plaintiff's reply brief "must be confined to rebutting the defendant's main brief"). *See* also *United States v. Ford Motor Co.,* 463 F.3d 1267, 1276 (Fed. Cir. 2006) ("Arguments raised for the first time in a reply brief are not properly before this court."); *Cross Med. Prods. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1320 n.3 (Fed. Cir. 2005) (court will not consider "new arguments raised for the first time in [a] reply brief"). In any event, Petitioner also does not even attempt to address the factors we consider to evaluate whether a zone of natural expansion exists. *See Mason Eng'g & Designing Corp. v. Mateson Chem. Corp.*, 91066845, 1985 TTAB LEXIS 114, at *20-21 (TTAB 1985).

2. Petitioner Cannot Establish Priority

Since Petitioner cannot rely on a family or marks or the zone of natural expansion, we determine priority based on each of Petitioner's individual pleaded marks that are the subject of its registrations and applications. *Truescents LLC v. Ride Skin Care, LLC*, Opp. No. 91158556, 2006 TTAB LEXIS 477, at *9 (TTAB 2006) (where "opposer has not established ownership of a family of GENUINE marks . . . Section 2(d) priority and likelihood of confusion analyses . . . shall be based separately on each of opposer's pleaded marks"); *Nike, Inc. v. WNBA Enters., LLC*, Opp. No. 91160755, 2007 TTAB LEXIS 39, at *17 (TTAB 2007) (where opposer failed to establish a family

[78] 91 TTABVUE 19.

of marks likelihood of confusion determined "based on the individual marks that are the subject of opposer's registrations and/or for which opposer has established prior use").

"Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), a party may rely upon the filing date of the application underlying its registration for purposes of priority as its constructive use date."[79] *Look Cycle*, 2024 TTAB LEXIS 289, at *9; *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, Opp. No. 91188816, 2013 TTAB LEXIS 439, at *13 (TTAB 2013) ("[W]hen 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. The result is that either party in this case may rely on the filing date of its various applications -- without further proof -- to establish priority."). Petitioner and Respondent may also establish priority "through testimony or business records establishing the first use of the[ir] [services]" in connection with their respective marks. *Cent. Garden*, 2013 TTAB LEXIS 439, at *13.

As an initial matter, Petitioner is incorrect that "[Petitioner] Halyard is the leader in the clubhouse with evidence of prior use because its registration has a first [use] date of December 31, 2002 (Reg. No. 5739878)."[80] "The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the

[79] For its two pending applications, Petitioner can also rely on the application filing dates contingent on the applications proceeding to registration. *See Cent. Garden*, 2013 TTAB LEXIS 439, at *12 ("[A]n applicant may still rely on constructive use in a Board proceeding. If the applicant would only prevail based on an unperfected constructive use date, the Board will issue a decision contingent on registration and allow the application in question to go forward.").

[80] 91 TTABVUE 15; 85 TTABVUE 31 (citing the first use date of December 31, 2002 from its Registration No. 5739878 as evidence of Petitioner's priority).

applicant or registrant; a date of use of a mark must be established by competent evidence." Trademark Rule 2.122(b)(2). *See also Life Zone Inc. v. Middleman Group, Inc.*, Opp. No. 91160999, 2008 TTAB LEXIS 37, at *20 (TTAB 2008) ("opposer's recitation of dates of use in its application does not constitute evidence of opposer's use or priority"). Accordingly, Petitioner must prove with evidence that Petitioner itself (or that a predecessor in interest to which it can trace an unbroken chain of title) has used the mark QSIGHT prior to Respondent's priority date.

We begin with the constructive use dates from the application filing dates for the parties' registrations and applications in the record which are listed in the chart below in chronological order:[81]

Registrant/ Applicant	**Reg. No./ App. No.**	**Mark**	**Application Filing Date**
Respondent	Reg. No. 6285787	QSIGHT	September 10, 2019
Respondent	Reg. No. 6231233	GUIDEPOINT QSIGHT	September 10, 2019
Petitioner	App. No. 88912543	QSIGHT DNA	May 12, 2020
Petitioner	Reg. No. 7213585	QSIGHT RFID	May 12, 2020
Petitioner	App. No. 90065110	QSIGHT SMART SCAN	July 21, 2020
Petitioner	Reg. No. 7262805	QSIGHT KANBAN	July 27, 2021

As demonstrated above, Respondent's registrations have an earlier constructive use date than Petitioner's remaining registrations and applications. In addition, contrary to Petitioner's assertion,[82] Respondent's witness Mr. Haines consistently testified in both his deposition and his trial testimony that Respondent's first use of

[81] 53 TTABVUE 53; 64 TTABVUE 6, 13; 53 TTABVUE 84, 67, 60, 94, 74.

[82] 91 TTABVUE 16.

the mark QSIGHT was in January 2018. His trial testimony adds that Respondent sent "branded information products" to "[o]ne of its earliest customers."[83] Such consistent and uncontradicted testimony is sufficient to establish Respondent's January 2018 first use date. *See DeVivo v. Ortiz*, Opp. No. 91242863, 2020 TTAB LEXIS 15, at *8 (TTAB 2020) ("testimony of a single witness may be adequate to establish priority [of use]").

We have examined the record to see if Petitioner proved an earlier date of use for any of these marks than Respondent's January 2018 priority date. The record evidence demonstrates the following:

- **QSIGHT DNA**: Petitioner provides general testimony regarding the services allegedly offered under the mark, but does not tie this information to any time frame or specific dates of use.[84] Additionally, Petitioner filed the application for QSIGHT DNA based on an intent-to-use, the application is currently suspended, Petitioner has not yet filed a statement of use,[85] and Petitioner admitted that it "ha[s] not yet sold, offered, or provided any goods or services under the QSIGHT DNA trademark";[86]

[83] 73 TTABVUE 6 ¶ 18.

[84] *See* 54 TTABVUE 8 ¶ 41 ("The QSIGHT DNA mark refers to the data and analytics component of the QSIGHT platform. . . . This mark refers to all of the aforementioned data and research components of the QSight brand as well as O&M's future offerings in QSight analytics."); *see also* 85 TTABVUE 24. Petitioner does offer testimony that "QSIGHT . . . has been offering predictive analytics as early as September 2019", which is the one of the services covered by the application for the mark QSIGHT DNA. 53 TTABVUE 3 ¶ 8, 84. But the testimony only refers to "QSIGHT" and makes no reference to QSIGHT DNA.

[85] 53 TTABVUE 79-86.

[86] 94 TTABVUE 70 (Response to RFA No. 13). Petitioner also admitted that it "has not rendered 'business consulting services in the field of data analytics and predictive analytics' in commerce under the QSIGHT DNA trademark." *Id.* (Response to RFA No. 6.) Petitioner designated these responses confidential, but they do not contain confidential information. *See* Trademark Rule 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

- **QSIGHT RFID**: Petitioner did provide some limited evidence of sales materials using the mark QSIGHT RFID.[87] However, the evidence is not probative because there is no indication that such materials were used by Petitioner (rather than another O&M entity),[88] and there is no testimony demonstrating when the sales materials were actually used in commerce (i.e., distributed to customers), or when the services were rendered in commerce.[89] The limited testimony regarding the mark QSIGHT RFID also does not provide any information regarding dates of use;[90]

- **QSIGHT SMART SCAN**: Petitioner provides one general statement regarding this mark stating, "[t]he QSIGHT SMART SCAN mark refers to the handheld, barcode scanning method of inventory management offered by QSight."[91] This statement makes no reference to any timeframe or date of use. Petitioner's intent-to-use application for this mark is still pending with the most recent action being the USPTO's grant of a fifth extension of time to file a statement of use;[92] and

- **QSIGHT KANBAN**: Petitioner similarly provides only limited general testimony about the use of this mark that does not reference any time frame or date of use.[93] Additionally, the only use of mark QSIGHT KANBAN in the record that could be prior to its July 27, 2021 constructive

[87] 54 TTABVUE 6 ¶ 24, 38-39, 78-79.

[88] The internal date appearing on one brochure is July 15, 2016 which predates the formation of Petitioner on November 14, 2017. 54 TTABVUE 38; 95 TTABVUE 50 (Response to Int. No. 36). The other brochure contains a number string which could be a reference to a date of September 23, 2019, which is after Petitioner was formed. 54 TTABVUE 79. However, the brochure contains no reference to Petitioner, only references "Owens & Minor," and the accompanying testimony does not provide any information on the company using the sales material. *See* 54 TTABVUE 78-79 and 54 TTABVUE 6 ¶ 24.

[89] As noted previously, the dates on these sales material appear to be internal dates, i.e., there is no indication (such as a url) that the material was made available on a website. *See* 54 TTABVUE 38-39, 79. Rather the dates appear to be some type of internal creation date or other internal marking. The accompanying testimony for the exhibit states only that it contains a "representative sample of sales and marketing materials used to promote QSIGHT and the goods and services offered under the QSIGHT Marks." 54 TTABVUE 6 ¶ 24. The testimony lacks any reference to a time frame of use.

[90] 54 TTABVUE 8 ¶ 38; *see also* 85 TTABVUE 23-24.

[91] 54 TTABVUE 8 ¶ 39; *see also* 85 TTABVUE 24.

[92] 53 TTABVUE 94; May 15, 2025 Notice of Approval of Extension Request for Application Serial No. 90065110.

[93] 54 TTABVUE 8 ¶ 40 ("The QSIGHT KANBAN mark refers to the QSight module, QSight Kanban, that uses two-bin solution to simplify inventory management of consumable products such as tubing, syringes, needles, adhesives, and more."); *see also* 85 TTABVUE 24.

first use date is the same sales material found deficient for the mark QSIGHT RFID.

Accordingly, Petitioner cannot establish priority as to its marks QSIGHT DNA, QSIGHT RFID, QSIGHT SMART SCAN, and QSIGHT KANBAN and its Section 2(d) claim as to those marks must fail. *See Truescents*, 2006 TTAB LEXIS 477, at *12.[94]

However, for the sake of completeness we will consider whether, if Petitioner proved ownership and priority in QSIGHT for the "clinical inventory management services" covered in Registration No. 5739878, it could establish a likelihood of confusion.

B. Likelihood of Confusion

To prevail on its Section 2(d) claim, Petitioner must show by a preponderance of the evidence that Respondent's use of its marks QSIGHT and GUIDEPOINT QSIGHT in connection with the services identified in its registrations is likely to cause confusion, mistake, or deception as to the source or sponsorship of Petitioner's QSIGHT services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951 (Fed. Cir. 2000)). (Petitioner "had the burden of proving by a preponderance of the evidence that there was a likelihood of confusion between the two marks."); *Look Cycle*, 2024 TTAB LEXIS 289, at *8.

[94] We do not rely on the Guidepoint email in Ex. J to the Haines deposition (46 TTABVUE 352 (confidential)) in analyzing Petitioner's priority, and sustain Respondent's objection thereto. *See* 90 TTABVUE 15 (confidential); 87 TTABVUE 62-63. The statements in the email are inadmissible hearsay, and the email also does not identify any O&M entity, merely includes a link to a search on Google, and as such is not evidence of any use by Petitioner of the mark QSIGHT. *See Philanthropist.com, Inc. v. General Conference Corp. of Seventh-Day Adventists*, Can. No. 92065178, 2021 TTAB LEXIS 205, at *21 (TTAB 2021) (sustaining objection where "e-mail exchange do[es] comprise multiple levels of hearsay statements made by several out-of-court declarants"). *See also* 46 TTABVUE 196:3-16 (confidential).

Our determination under Section 2(d) of the Trademark Act involves an analysis of all of the probative evidence of record that is relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont* factors"); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 1371 (Fed. Cir. 2005). We must consider "each *DuPont* factor for which there is evidence and argument." *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (citing *In re Guild Mortg. Co.*, 912 F.3d 1376, 1380 (Fed. Cir. 2019)). "Not all of the *DuPont* factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case." *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (internal quotation marks omitted).

1. Strength of Petitioner's Mark

Before we compare the parties' marks, we consider the strength, including any fame, of Petitioner's claimed mark QSIGHT, as that may affect its scope of protection. Analysis of the fifth and sixth *DuPont* factors determines the strength of a mark. *Spireon*, 71 F.4th at 1362 ("Two of the *DuPont* factors (the fifth and sixth) consider strength."). Under the fifth *DuPont* factor, Petitioner may expand the scope of protection for its mark by providing evidence of the "fame of the prior mark (sales, advertising, length of use)," *DuPont*, 476 F.2d at 1361. And under the sixth *DuPont* factor, Respondent may narrow the scope of protection for Petitioner's mark by submitting evidence of the "number and nature of similar marks in use on similar goods." *Id. See also Monster Energy Co. v. Chun Hua Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *26 (TTAB 2023). "[T]he strength of a mark is not a binary factor"

and "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015) (internal citations omitted). "The weaker [a petitioner's] mark, the closer [a respondent's] mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Id*. at 1338 (internal citations omitted).

In evaluating the strength of a mark, we consider both its conceptual strength, based on the nature of the mark itself, and if there is probative evidence in the record, its commercial strength based on marketplace recognition of the mark. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength … and its marketplace strength …".); *New Era*, 2020 TTAB LEXIS 199, at *28-29 (considering "inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength").

Petitioner contends that its mark QSIGHT is inherently distinctive, strong and entitled to wider protection.[95] Petitioner makes a passing reference to the fifth *DuPont* factor,[96] but does not present any arguments on commercial strength or fame, and as such we only address conceptual strength. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("issues adverted to in a perfunctory manner, unaccompanied by some effort at developed argumentation, are deemed waived") (citation omitted); *In re Embiid*, Ser. No. 88202890, 2021 TTAB

[95] 85 TTABVUE 32-34; 91 TTABVUE 18-19.

[96] 85 TTABVUE 33; 91 TTABVUE 17.

LEXIS 168, at *11 (TTAB 2021) ("Because there is no argument or record evidence directed to these factors, we have not considered them in our analysis of the likelihood of confusion.").

In analyzing conceptual strength, we evaluate where Petitioner's mark QSIGHT falls along the "range of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful." *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1339 (Fed. Cir. 2004). We agree with Petitioner that its mark QSIGHT is inherently distinctive (meaning it is at least suggestive), "as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act."[97] *New Era*, 2020 TTAB LEXIS 199, at *29. *See also Chippendales*, 622 F.3d at 1351 ("marks that are arbitrary, fanciful, or suggestive are inherently distinctive"). However, Petitioner does not provide any further argument or identify any evidence in support of where on the spectrum of inherently distinctive marks its mark falls, or otherwise establish that its mark is "entitled to wider protection."[98] Accordingly, we accord Petitioner's mark QSIGHT "the normal scope of protection to which inherently distinctive marks are entitled." *Bell's Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 TTAB LEXIS 452, at *20 (TTAB 2017).

[97] 85 TTABVUE 33; 91 TTABVUE 18.

[98] As explained in *Nautilus Grp.*, relied on by Petitioner (at 85 TTABVUE 33), the conceptual strength of inherently distinctive marks varies: "arbitrary or fanciful marks . . . are typically strong," and "suggestive marks are presumptively weak, but can be strengthened by achieving actual marketplace recognition." *Nautilus Grp.*, 372 F.3d at 1340. As noted previously, Petitioner did not present any argument regarding the marketplace recognition, also known as the commercial strength, of its mark.

Respondent contends that third party registrations weaken the conceptual strength of Petitioner's mark QSIGHT.[99] Evidence of third-party registrations may bear on the conceptual strength of Petitioner's mark. "Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Juice Generation*, 794 F.3d at 1339 (citation omitted). "[E]xtensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established." *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.,* 797 F.3d 1363, 1373-74 (*quoting Juice Generation*, 794 F.3d at 1339). However, such third-party registrations and uses must be "similar marks in use on similar goods." *Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (citations omitted); *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 TTAB LEXIS 437, at *47 (TTAB 2017) ("third-party registration evidence . . . may bear on conceptual weakness if a term is commonly registered for similar goods or services").

Respondent submitted three third-party registrations it asserts cover "similar marks" for "similar services" to Petitioner's mark QSIGHT.[100] We find that two of the

[99] 87 TTABVUE 49-50.

[100] 87 TTABVUE 49-50 (citing 64 TTABVUE 20-32). Given that we find that the goods and services in these third-party registrations are too dissimilar to be probative we do not address Petitioner's proffered evidence of the alleged lack of use of the third-party marks, or

third-party registrations are not probative because they cover goods that are distinctly different from Petitioner's clinical inventory management services. Specifically, Registration No. 5157715 covers "scientific apparatus, namely, spectrometers and parts and fittings therefor"[101] and Registration No. 5870514 covers "weapons, namely, guns and ammunition; fowling pieces; sights, other than telescopic sights, for firearms; non-telescopic gun sights for firearms."[102] The last third-party registration covers software, but in a distinctly different field than Petitioner, namely security and video surveillance, and accordingly is not similar enough to weaken the conceptual strength of Petitioner's mark.[103] *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 251, at *29 (TTAB 2022) ("third-party registrations of NATURE or MADE marks that [a]pplicant submitted for products other than [o]pposer's identified goods have little or no probative value in showing the conceptual weakness of the terms NATURE or MADE in [o]pposer's marks").

Accordingly, given Petitioner's lack of argument on the fifth *DuPont* factor we find it neutral. Respondent's evidence of three third party registrations for non-similar goods and services does not affect the normal scope of protection we accord

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Respondent's objection thereto, 85 TTABVUE 34 (citing 83 TTABVUE 1-4); 91 TTABVUE 19; 87 TTABVUE 60, except to note that Petitioner's evidence only addressed one of the three third-party registrations. *See* 83 TTABVUE 1-4 (addressing only Registration No. 5870514).

[101] 64 TTABVUE 20.

[102] 64 TTABVUE 32.

[103] 64 TTABVUE 26-27. For example, Registration No. 7245183 covers "cloud-based software for reducing security video false alarms, monitoring video surveillance, security surveillance, visual identification, video analytics, motion detection, reviewing and analyzing surveillance footage, security cameras and security alarms."

Petitioner's inherently distinctive mark, and we find the sixth *DuPont* factor is also neutral.

2. Similarity of the Marks

We now turn to the analysis of "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps.*, 396 F.3d at 1371 (*citing DuPont*, 476 F.2d at 1361). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Look Cycle*, 2024 TTAB LEXIS 289, at *19 (*quoting In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018). [S]imilarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014). "It is well-established that it is improper to dissect a mark, and that marks must be viewed in their entireties." *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed Cir. 2012); *Juice Generation*, 794 F.3d at 1341 (*citing DuPont*, 476 F.2d at 1361) ("It is the mark in its 'entiret[y]' that must be assessed.).

We agree with Petitioner that its mark QSIGHT is identical in appearance, sound, and connotation to Respondent's mark QSIGHT in Registration No. 6285787, and as such this factor weighs heavily in favor of likelihood of confusion.[104] *See Tiger Lily,* 35 F.4th at 1362 (where "the marks are identical . . . this factor weighs heavily in favor of a likelihood of confusion"). However, we also agree with Respondent that the similarity of the marks is not dispositive in this case given our findings on the other

[104] 85 TTABVUE 34-35.

DuPont factors discussed herein.[105] *See Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004) ("Although the marks are identical, the differences in the products as well as the weakness of [opposer's] mark lead us to dismiss [the] [o]pposition."); *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, Opp. No. 91184576, 2011 TTAB LEXIS 259, at *34 (TTAB 2011) ("Essentially plaintiff would have us find confusion simply because of the similarity of the marks. But this is not a sufficient basis for doing so."; dismissing opposition based on dissimilarity of the services and sophistication of consumers); *In re OSF Healthcare Sys.,* Ser. No. 88706809, 2023 TTAB LEXIS 353, at *42-43 (TTAB 2023) (where evidence of record was insufficient to show that applicant's Class 44 and Class 45 services were related to the registrant's services "we conclude that confusion is unlikely as to the services in those classes notwithstanding the identity of the marks").

With respect to Respondent's mark GUIDEPOINT QSIGHT, Petitioner argues that the addition of "Guidepoint" does not eliminate confusion "because QSIGHT is still the dominate [sic] portion of the mark."[106] However, Petitioner provides no reason for why QSIGHT is dominant beyond the circular argument that "[i]f 'guidepoint' was the dominate [sic] portion of the Guidepoint QSight mark, then there would have been no need for Guidepoint to obtain and register the separate QSight

[105] 87 TTABVUE 48-49.

[106] 85 TTABVUE 34-35; 91 TTABVUE 17-18. Petitioner's arguments on this factor in its opening brief and reply brief are nearly identical. We remind Petitioner that the purpose of a reply brief is to rebut defendant's arguments, and should not merely repeat or reargue plaintiff's case in chief. *See* TBMP § 801.03.

registration."[107] The cases Petitioner cites do not support that QSIGHT is the dominant part of the mark GUIDEPOINT QSIGHT.[108] Here, as the first word in the mark GUIDEPOINT may be considered dominant. *Palm Bay Imps.*, 396 F.3d at 1372 ("VEUVE" "constitutes 'the dominant feature'" in VEUVE CLICQUOT "as the first word in the mark and the first word to appear on the label"). However, Respondent also identifies GUIDEPOINT as its house mark,[109] and generally the addition of a house mark to another mark does not avoid confusion. *See Nike*, 2007 TTAB LEXIS 39, at *42 ("It has been held that the addition of a trade name or house mark or other such matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion."). Here, we find that both the compound word GUIDEPOINT and the word QSIGHT[110] are fanciful because they are coined, non-dictionary words that have no meaning or significance as applied to Respondent's business consulting, market

[107] 85 TTABVUE 35; 91 TTABVUE 18.

[108] *See* 85 TTABVUE 34-35. *Hainline v. Vanity Fair, Inc.*, 301 F. App'x 949, 953 (Fed. Cir. 2008) ("dominant feature" was "the first word in each of the marks"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1266 (Fed. Cir. 2002) ("the word 'Packard' is the dominant and distinguishing element of PACKARD TECHNOLOGIES" because the word "technologies" was descriptive); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1322 (Fed. Cir. 2014) (LION was dominant in the mark STONE LION CAPITAL because adjective STONE was descriptive or suggestive); *In re Chatam Int'l*, 380 F.3d 1340, 1342-43 (Fed. Cir. 2004) (GASPAR dominant part of JOSE GASPAR GOLD because JOSE "simply reinforces the impression" of a name and GOLD is descriptive in "denot[ing] a premium quality"; GASPAR'S dominant in GASPAR'S ALE because ALE is generic in "simply delineat[ing] a class of goods").

[109] 87 TTABVUE 49.

[110] Guidepoint's Managing Director Mr. Haines testifies that "[t]he 'QSIGHT' element of Guidepoint's Marks is a portmanteau of 'quantitative' and 'insight.'" 73 TTABVUE 3 ¶ 6. However, he does not point to any evidence of record where Respondent promotes such meaning and there is no evidence that consumers will understand such meaning from the mark alone.

research and associated website and digital file-sharing services. *See Nautilus Grp.*, 372 F.3d at 1340 ("[a] fanciful mark is a non-dictionary word concocted by the trademark holder for its product"). Accordingly, we find that neither term is dominant in Respondent's mark.

Considering Respondent's mark GUIDEPOINT QSIGHT in its entirety, there are some differences in sight, sound, and connotation with Petitioner's mark QSIGHT, but the presence of the identical arbitrary word QSIGHT in both marks does make them similar. Overall, taking into account that similarity is a matter of degree, and that Petitioner's mark QSIGHT is entitled only to a normal scope of protection, we find that this factor weighs in Petitioner's favor, but not strongly, for Respondent's mark GUIDEPOINT QSIGHT. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003) ("not[ing] that similarity is not a binary factor but is a matter of degree [and] [b]ecause there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer").

3. Similarity or Dissimilarity of the Services

We next assess the "similarity or dissimilarity and nature of the goods or services." *DuPont*, 476 F.2d at 1361. We must base our analysis on parties' services as set forth in their registrations. *See M2 Software, Inc. v. M2 Communs., Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006). Under this factor we "consider[] whether the consuming public may perceive the respective goods and services of the parties as related enough to cause confusion about the source or origin of the goods and services." *Naterra Int'l,*

Inc. v. Bensalem, 92 F.4th 1113, 1117 (Fed. Cir. 2024) (citation omitted). In analyzing whether the parties' services are related evidence we may consider includes:

> news articles or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; or copies of use-based registrations of the same mark for both the applicant's services and the goods listed in the cited registration.

In re Country Oven, Inc., Ser. No. 87354443, 2019 TTAB LEXIS 381, at *5 (TTAB 2019).

In our analysis, we consider each of the two classes in Respondent's registrations separately because "[e]ach international class stands on its own, for all practical purposes like a separate application, and we must make determinations for each separate class." *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, Opp. No. 91118482, 2011 TTAB LEXIS 280, at *2 n.1 (TTAB 2011). Petitioner may establish likelihood of confusion as to an entire class of Respondent's identified services by showing the relatedness of its own services to any item within that class. *Bertini v. Apple Inc.*, 63 F.4th 1373, 1379 (Fed. Cir. 2023) (*citing Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981)).

Petitioner's services for which it has established priority as identified in its Registration for the mark QSIGHT are "clinical inventory management services." We accordingly compare these services to Respondent's services identified in its registrations below.

a. International Class 35

Respondent's services in International Class 35 as identified in its registrations[111] are "[i]nformation in business matters and business consulting and information services; compiling and providing business industry data and analytics for market research purposes." Petitioner offers no evidence that its clinical inventory management services are related to Respondent's Class 35 services and only offers the conclusory statement:

> There is simply no way that [Petitioner's] clinical inventory management services is not a subset of the broader [Respondent] description of "compiling and providing industry data and analytics for market research purposes" and/or the extremely broad description "information in business matters and business consulting and information services."[112]

Respondent argues that "[w]ith respect to [Respondent's] services in class 35 . . ., [Petitioner] makes no legal arguments as to relatedness and has submitted no evidence of relatedness."[113] Respondent also asserts that its Class 35 services are "broad and non-specific enough" that we should consider "extrinsic evidence showing that the description [of services] has a specific meaning to members of the trade."[114]

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[111] As discussed previously, both Respondent's Registration No. 6285787 for the mark QSIGHT, and Registration No. 6231233 for the mark GUIDEPOINT QSIGHT cover identical services in International Classes 35 and 42.

[112] 85 TTABVUE 37.

[113] 87 TTABVUE 36; *see also* 87 TTABVUE 33-34.

[114] 87 TTABVUE 34-36 (*citing In re Trackmobile Inc.*, Ser. No. 73715890, 1990 TTAB LEXIS 20 (TTAB 1990) and *Edwards Lifesciences Corp. v. VigiLanz Corp.*, Opp. No. 91154210, 2010 TTAB LEXIS 84, at 37-40 (TTAB 2010)). In *Edwards Lifesciences*, 2010 TTAB LEXIS 84, at 1, 39, the Board considered extrinsic evidence because "the goods [we]re of a technical nature", specifically, "near real-time computer monitoring system comprised of a software

Taking Respondent's latter argument first, we do not find that Respondent's Class 35 services are of such a nature that extrinsic evidence should be considered here. As we previously explained regarding *Trackmobile* (on which Respondent relies):

> *Trackmobile* does not stand for the proposition that when the goods or services identified in the cited registration are described broadly, the Board may or should consider extrinsic evidence as to the nature of the registrant's actual goods or services when making its likelihood of confusion determination. . .. [W]hen the Board considered the applicant's extrinsic evidence regarding the registrant's goods in *Trackmobile*, it was not because the registrant's goods were identified broadly in the registration, but because the Board was uncertain as to what the goods identified in the registration were. That is, the Board did not consider the extrinsic evidence in order to determine the nature of the registrant's particular 'light railway motor tractors,' but rather to determine what 'light railway motor tractors' were, in general.

In re Cont'l Graphics Corp., Ser. No. 75033628 1999 TTAB LEXIS 500, at *6-8 (TTAB 1999) ("no extrinsic evidence is necessary in order to educate the Board as to what 'printing services' are; the term, although broad, is neither vague nor uncertain"). Similarly, "[t]his is not a case where the term[s] in [Respondent's] identification of [services] [are] so vague that we need extrinsic evidence to determine if the term has a specific meaning in the trade." *In re RSI Sys., LLC*, Ser. No. 78848532, 2008 TTAB LEXIS 64, at *11 (TTAB 2008).

Turning to Respondent's other argument, we agree that Petitioner has failed to submit any legal argument or evidence regarding the relatedness of its clinical

application and database that anticipates and detects possible adverse drug events, and alerts healthcare providers to adverse drug events." Accordingly, it was "entirely appropriate to consider extrinsic evidence to determine the specific meaning of the description of goods." *Id.* at 39.

inventory management services to Respondent's Class 35 services.[115] Accordingly, we consider the plain meaning of Petitioner's services based on the identification alone. "Clinical" means "involving or relating to the direct medical treatment or testing of patients."[116] "Inventory" means "a supply or stock of something."[117] Accordingly, the plain meaning of Petitioner's clinical inventory management services is that they are services used in the medical field to ensure that healthcare facilities have a sufficient supply or stock of medical supplies to provide medical treatment or testing to patients. Petitioner's statements regarding the nature of clinical inventory management services confirms they are used by healthcare facilities and healthcare workers to provide medical care for patients. Representative examples include:

- "QSight™ was developed especially for healthcare departments where having the right medical-surgical supplies is critical to effective care – areas such as cardiac-cath labs, interventional radiology, the O.R. It helps automate the manual tasks that consume too much staff time – counting, tracking, ordering, and searching.";[118]
- "With QSight, clinicians simply scan products out of inventory once they are used in a procedure and automatically link it to the patient's EMR.

[115] Petitioner did submit third-party registrations and screenshots from third-party websites, but does not cite or rely upon them in its arguments regarding the parties' services. *See* 77-80 TTABVUE; 85 TTABVUE 35-39; 91 TTABVUE 20-21. Additionally, pursuant to our discussion *infra* Section VI.B.4.a we have excluded these materials from consideration as improper rebuttal evidence.

[116] COLLINS DICTIONARY (https://www.collinsdictionary.com/dictionary/english/clinical), accessed July 2, 2025. *See Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, Opp. No. 91229632, 2019 TTAB LEXIS 137, at *11 n.34 (TTAB 2019) ("The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format.").

[117] COLLINS DICTIONARY (https://www.collinsdictionary.com/dictionary/english/inventory) accessed July 2, 2025.

[118] 54 TTABVUE 30. *See also* 55 TTABVUE 93, 98, 104-08 (confidential) (Exhibit D containing sample customer training materials including screenshots from the QSIGHT clinical inventory management system); 54 TTABVUE 6 ¶ 26.

> QSight will even alert clinicians before they use a recalled product in a procedure. . . . Ultimately, this means more efficient workflows for clinicians and more time focusing on patients.";[119]

- "QSight state-of-the-art solutions connect people, products, and processes to help streamline clinical workflows, increase inventory accuracy, improve patient safety, and reduce waste. . . . Ultimately, we partner with you to provide the technology solutions that help you ensure your clinicians have what they need, when and where they need it, in order to take care of patients.";[120]

- "QSight offers a large assortment of features . . . to help make the clinician's job easier."[121]

In some cases, relatedness can be found based on the descriptions in the parties' registrations without resort to additional evidence. *See Hewlett-Packard*, 281 F.3d at 1268 (finding relatedness based on opposer's and applicant's descriptions including "'data and information processing' description in the ITU application is very similar to [opposer's] registrations covering consulting services, whether for data processing or for data processing products"). However, this is not a case where the descriptions of the services in the registrations demonstrate any clear relationship between the parties' services such that the identification of the services alone is sufficient to establish the relatedness of the services. *Cf Pierce-Arrow Soc'y v. Spintek Filtration*, Inc., Opp. No. 91224343, 2019 TTAB LEXIS 388, at *38 (TTAB 2019) ("identifications themselves establish[ed] the necessary relationship" where the relationship between "a product and a service featuring the same product" was "clear" namely "[a]pplicant's

[119] 54 TTABVUE 17.

[120] 54 TTABVUE 34.

[121] 55 TTABVUE 93. Although Petitioner asserted that the entire Exhibit D to Ms. McNally's declaration is confidential, this statement is similar to other statements in publicly filed documents so we do not treat it as confidential.

automobiles and [o]pposer's membership services involving the same-branded automobiles are 'clearly' related').

We recognize that where a party "identifies its services broadly, we must presume that the services encompass all services of the type identified." *Southwestern Mgmt. v. Ocinomled, Ltd.*, Con. No. 94002242, 2015 TTAB LEXIS 176, at *60-61 (TTAB 2015). However, we do not find that Respondent's services are so broad here that they encompass Petitioner's services, particularly where Petitioner relies solely on the identification of goods.[122] Specifically, we find that Respondent's "information in business matters and business consulting and information services" do not encompass Petitioner's "clinical inventory management services," considering the record demonstrates the nature of Petitioner's services are directed to medical treatment or testing of patients. Similarly, Respondent's "compiling and providing business industry data and analytics for market research purposes" are even further removed from and do not encompass Petitioner's services. Respondent's services in Class 35 on their face do not contain any connection to medical care, and reading them so broadly to encompass Petitioner's distinctly different service would be

[122] Petitioner asserts that its argument that Respondent's services "engulf" its clinical inventory management services is "almost identical" to that accepted in *OSF Healthcare Sys.* 91 TTABVUE 20. However, in that case both the applicant's and the cited registrant's services on their face contained a healthcare component such that the identifications themselves established relatedness. *OSF Healthcare Sys.*, 2023 TTAB LEXIS 353, at *15. Specifically, the Board found there that "the identification of the 'consulting services in the field of patient relationship management for healthcare workers' in the cited registration is broad enough to include providing those [business consulting] services 'for the purpose of having [healthcare workers] act within a coordinated ecosystem to provide services in the field of community health, mental health, physical health and wellness'" as identified in the applicant's application. *Id.* at *20.

divorced from reality. *See In re Chippendales USA, Inc.*, Ser. No. 78666598, 2009 TTAB LEXIS 131, at *29 (TTAB 2009) (disregarding proffered evidence of inherent distinctiveness where "[o]n a superficial level the analysis elevates the adult entertainment service involved here to a status which is not congruent with reality").

Bottom line, for the Class 35 services, Petitioner "failed to show the necessary connection that would cause the consumers of these . . . services to believe that they emanate from a single source if they were offered under similar marks." *Calypso Tech.*, 2011 TTAB LEXIS 259, at *28-29. Accordingly, the dissimilarity of the Class 35 services weighs strongly against a likelihood of confusion. *See Giersch v. Scripps Networks, Inc.*, Can. No. 92045576, 2009 TTAB LEXIS 72, at *24 (TTAB 2009) (finding "despite the high similarity between the marks" that the "second *du Pont* factor weighs strongly in favor of finding no likelihood of confusion" where "[p]etitioner has submitted no third-party registrations, Internet advertisements, or other evidence to show that [its] services . . . are in any way related to [respondent's services]"); *North Face Apparel Corp. v. Sanyang Indus. Co.*, Opp. No. 91187593, 2015 TTAB LEXIS 328, at *39 (TTAB 2015) ("Opposer has not explained how any of these goods are related to any of the goods on which [o]pposer . . . has registered its S-design mark, nor is there any evidence from which we could conclude that the goods are related.).

b. International Class 42

Respondent's services in International Class 42, as identified in its registrations, are "providing a website and digital file-sharing services featuring technology that enables subscribers to receive updates of business industry market data and market

trends via the website and the digital files." Petitioner argues that its clinical inventory management services are related to these Class 42 services because "the notable thing that [Respondent] is providing its customers—updates on business industry market data and market trends—is just a broader description of providing inventory data and market trends related to inventory data/management to clients."[123] Petitioner also asserts its services are related to Respondent's Class 42 services because "both companies offer web-based healthcare related services"[124] and both "provide services to clients that use data from within the healthcare sector."[125]

Respondent argues that Petitioner "improperly tries to rely on broad, generalized categories and to skew its own services to show relatedness" instead of "the traditional types of evidence that might show the services are commonly sold by the same source or commonly used by the same customers, or any other indicia of relatedness."[126] Respondent also argues that it is inaccurate to say that Petitioner "provides a 'data-related' service" and that Petitioner "has provided no evidence of any kind that its inventory management services have ever been modified or could ever be modified in order to provide broad market trend information, market research, or broad market data"[127]

[123] 85 TTABVUE 38.

[124] 85 TTABVUE 38.

[125] 85 TTABVUE 39.

[126] 87 TTABVUE 37.

[127] 87 TTABVUE 39.

We agree with Respondent that Petitioner offers very little evidence regarding relatedness and relies on mischaracterizations of its services in an attempt to broaden their scope to demonstrate relatedness to Respondent's services in Class 42. Petitioner claims that its services are a subset of Respondent's Class 42 services because it "provid[es] inventory data and market trends related to inventory data/management to clients."[128] Yet, it is clear from Ms. McNally's testimony and the nature of Petitioner's clinical inventory management services that it tracks the usage of supplies used to provide medical treatment - it does not encompass any market trends or analysis related thereto. Specifically, Ms. McNally testifies that Petitioner's services are "used in the procedural areas of healthcare facilities" to track items such as stents, orthopedic implants, guide wires, and catheters by "lot, serial, and expiration date."[129] The data tracked in Petitioner's services is specific to the healthcare system, its supplies and its patients, and not part of any broader analysis of the market.[130] Petitioner's marketing confirms this in advertising its services: "Point, scan, and control your inventory with #QSight, our industry-leading

[128] 85 TTABVUE 38.

[129] 54 TTABVUE 4 ¶ 11; *see also* 54 TTABVUE 21 ("[A]ll your team needs is a web-connected device and a barcode scanner to capture data. . . . [A] single scan matches a product to one of over 600,000 unique SKUs, providing descriptions, lot numbers, expiration dates and more."), 24 (screenshot of "products" page from Petitioner's OSIGHT showing inventory data), 30 ("With QSight™ Clinical Inventory Control, you'll know how much you have. How much you need to order. Where it went. What it's costing. And how to charge for more of it.")

[130] 54 TTABVUE 4-5 ¶¶ 11-13; *see also* 54 TTABVUE 20 (advertising to "[s]tart with a department and grow at your own pace across your entire health system"), 38 ("Your ultimate goal is to ensure products are always where you need them. You need to be able to align demand with proper inventory levels."); 67 TTABVUE 17: 2-11 (confidential).

#inventorymanagement solution."[131] Petitioner points to a statement in an email that it asserts acknowledges that "both companies offer web-based healthcare related services,"[132] but that statement is hearsay and may not be relied upon for the truth of the matter asserted, does not clearly identify who it is referencing, and does not contain any such acknowledgment regarding Respondent's services.[133] Petitioner also relies on a screenshot from its predecessor's website identifying it as a "web-based inventory management company" to demonstrate similarity to Respondent's services of "providing a website" to deliver its business industry market data and market trends. But the mere fact that both companies' services include a web-based offering is insufficient to establish relatedness. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (the Internet "is a ubiquitous information-transmitting medium"); *Hewlett-Packard Dev. Co., L.P. v. Vudu, Inc.*, Opp. No. 91185393, 2009 TTAB LEXIS 649, at *11 (TTAB 2009) ("countless products and services can be found on the Internet and . . . this is not sufficient to show the absence of a genuine issue as to the relatedness of the goods and services").[134] We agree with Respondent that Petitioner's argument "seeks to take too many jumps without proofs, especially in

[131] 54 TTABVUE 92.

[132] 85 TTABVUE 38.

[133] 46 TTABVUE 352 (Exhibit J) (confidential); 46 TTABVUE 196:3-16 (confidential). *See also supra* n.94.

[134] Petitioner also relies upon a September 1, 2004 internal memo attached to the Rebuttal Declaration of Ms. McNally ("Rebuttal McNally Declaration"), but it appears to cite this only to support its priority, and not the relatedness of the services. 85 TTABVUE 39 (citing 81 TTABVUE 265-266 (Exhibit E) (confidential)). Either way, this internal memo does not provide any information about Petitioner's services as it merely discusses fee schedules and we have excluded this rebuttal declaration and the accompanying exhibits as improper rebuttal evidence as discussed *infra* Section VI.B.4.a.

view of the breadth it claims for its registration." *Pharmacia Inc. v. Asahi Med. Co.*, Opp. No. 91064311, 1984 TTAB LEXIS 175, at *4 (TTAB 1984).

Petitioner's argument that the services are related because they both offer services in and/or use data from the healthcare sector suffers from the same evidentiary deficiencies and overbreadth mischaracterizations. The only evidence Petitioner cites in support is some limited testimony from Mr. Haines that its services providing business industry market data and market trends uses data from the healthcare industry and that Mr. Haines attended some conferences focused in the healthcare industry.[135] But "a finding that the [services] are similar is not based on whether a general term or overarching relationship can be found to encompass them both." *Edwards Lifesciences*, 2010 TTAB LEXIS 84, at *37-38 (fact that parties' goods were "both used in the medical field, specifically in hospitals, *albeit* in different places within those hospitals, and they are both used to monitor aspects of patient care" insufficient to establish relatedness); *Calypso Tech.*, 2011 TTAB LEXIS 259, at *27 ("in order to find that goods and services are related, there must be more of a connection than that a single term, in this case 'financial field,' may be used to generally describe them"). Accordingly, it is not enough to show relatedness where "[t]he most that can be said is that [the parties'] services are both in the medical field." *In re N.A.D., Inc.*, 754 F.2d 996, 999 (Fed. Cir. 1985) (reversing refusal to register); *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716 (Fed.

[135] 85 TTABVUE 39 (citing 46 TTABVUE 172:22-175:5, 111:16-22 (confidential).) Note, we corrected the citations to the deposition testimony to reflect the pages numbers in TTABVUE rather than the deposition transcript.

Cir. 1992) ("it is error to deny registration simply because applicant sells some of its goods in some of the same fields [including the 'medical' field] in which opposer provides its services"). Nor is the fact that both parties use healthcare data, albeit distinctly different types of healthcare data, sufficient to establish relatedness, as every business utilizes data in some fashion. *See Elec. Data Sys. Corp. v. EDAS Micro Corp.*, Opp. No. 91077705, 1992 TTAB LEXIS 4, at *10-11 (TTAB 1992) ("declin[ing] to interpret the concept of related goods so broadly" in rejecting the opposer's argument "that the parties' products are related because each party provides software programs which process data").

Ultimately, Petitioner's limited evidence does not establish a degree of relationship between the services to support a likelihood of confusion. "There is no evidence of record showing that [the parties'] services are related in such a manner that they could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source." *Vital Pharms., Inc. v. Kronholm*, Opp. No. 91181806, 2011 TTAB LEXIS 207, at *14-15 (TTAB 2011) (dismissing opposition despite the fact that the parties' marks were identical where "evidence of record does not make a prima facie case for opposer").

4. Trade Channels and Classes of Customers

We next examine similarity or dissimilarity of the trade channels in which the parties' goods are sold and the classes of purchasers to whom the parties' services are marketed. *DuPont*, 476 F.2d at 1361; *Coach Servs.*, 668 F.3d at 1370-71. We must base our analysis on the identifications in Petitioner's and Respondent's registrations. *Stone Lion*, 746 F.3d at 1323; *In re Detroit Ath. Co.*, 903 F.3d 1297, 1308

(Fed. Cir. 2018) (factor "must be evaluated with an eye toward the channels specified in the application and registration"). By their nature, Petitioner's clinical inventory management services are limited to trade channels directed to medical facilities with inventories of medical supplies used in the provision of medical care. For Respondent's services, there are no limitations as to channels of trade or classes of purchasers in the parties' identifications of services, we must presume that the services "travel in all normal channels and to all prospective purchasers for the relevant [services]." *Coach Servs.*, 668 F.3d at 1370.

a. Evidentiary Objections to Rebuttal Evidence and Testimony

Before we analyze the parties' trade channels, we consider Respondent's objections to certain evidence that Petitioner submitted during its rebuttal testimony period and seeks to use in support of its argument that the trade channels are related. Respondent asserts that Petitioner's Fifth, Sixth and Seventh Notices of Reliance (and the documents attached thereto) as well as the Rebuttal McNally Declaration (and the accompanying exhibits) are improper rebuttal and should be stricken or given no weight.[136] Petitioner responds that Respondent's objections are untimely procedural objections to the descriptions in Petitioner's notices of reliance that Respondent waived, and that the evidence is all proper rebuttal to the testimony of Respondent's Mr. Haines.[137]

[136] 87 TTABVUE 55-60. While Petitioner does not use the Rebuttal McNally Declaration in support of its arguments on trade channels, Respondent's basis for its objection is the same as those asserted against the notices of reliance so we address it here.

[137] 89 TTABVUE 6-10.

"Rebuttal evidence is supposed to be limited to that which is responsive to the adversary's evidence: . . . [it] must accomplish the function of rebuttal; to explain, repel, counteract, or disprove the evidence of the adverse party." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081-82 (Fed. Cir. 2015) (citation omitted). Accordingly, during Petitioner's rebuttal testimony period it was appropriate for it to "introduce evidence and testimony to deny, explain or discredit facts and witnesses adduced by [Respondent,] [but] [e]vidence is improper rebuttal . . . where it relates to a witness and facts that might appropriately have been introduced during the [Petitioner's] case-in-chief." *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, Opp. No. 91234244, 2022 TTAB LEXIS 91, at *10-11 (TTAB 2022). Specifically, Petitioner may not use the rebuttal testimony period to merely "add[] to its proofs made as part of its case in chief." *United States Playing Card Co. v. Harbro, LLC*, Opp. No. 91162078, 2006 TTAB LEXIS 484, at *9 (TTAB 2006).

We initially find that Respondent's objections regarding improper rebuttal evidence are substantive and as such were timely asserted in its brief and have not been waived. *See Genesco Inc. v. Martz*, Opp. No. 91121296, 2003 TTAB LEXIS 123, at *11 (TTAB 2003) ("substantive objections (e.g., improper rebuttal, hearsay) . . . should be raised in the objecting party's brief on the case"); TBMP § 707.02(c) (substantive objections to notices of reliance include "that evidence offered under the notice constitutes hearsay or improper rebuttal"). Petitioner's claim that Respondent's use of language from its notice of reliance coversheets in support of its objections makes Respondent's objections procedural is unavailing. Respondent is not

objecting to the language itself (e.g., not claiming that the notices of reliance do not identify the relevance of the evidence or properly associate it with the issues in the case). *See* Trademark Rule 2.122(g); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, Opp. No. 91219477, 2017 TTAB LEXIS 335, at *4 (TTAB 2017) (procedural objections for notices of reliance include "insufficient description of the relevance of the documents and insufficient explanation of their association with particular facts relevant to particular claims and defenses"). Instead, Respondent used Petitioner's explanation in the notice of reliance coversheets to demonstrate how Petitioner's proffered evidence constituted improper rebuttal which is a substantive objection.

Petitioner's Fifth Notice of Reliance contains screenshots from Respondent's website, LinkedIn pages, and X posts which Petitioner uses in support of the similarity of the parties' trade channels and customers to argue that Respondent "markets to healthcare companies," "offers insights into the healthcare market to healthcare companies on its website," "posts content on its LinkedIn page relating to the healthcare industry," and "posts content on its LinkedIn related to the healthcare industry, including purchasing analysis and hospital budgeting analysis."[138] Petitioner asserts that it "provided this evidence to clarify and explain the extent to which [Respondent] targets the medical industry despite Haines' attempt to downplay it."[139] Yet, as Petitioner recognizes, Mr. Haines in his declaration testifies that Respondent "has created data product offerings that focus on various industries,

[138] 76 TTABVUE; 85 TTABVUE 26-28; 91 TTABVUE 22-24.

[139] 89 TTABVUE 9.

including healthcare" and that its customers include companies "selling products into the healthcare industry, such as pharmaceutical companies and medical device manufacturing companies."[140] As such, Petitioner's proffered evidence does not rebut Mr. Haines, but rather improperly attempts to bolster its case-in-chief regarding the alleged similarities in trade channels and customers. *See Carefirst of Md., Inc. v. FirstHealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 TTAB LEXIS 600, at *15-17 (TTAB 2005) (excluding notices of reliance regarding "facts that might appropriately have been introduced during the party's case-in-chief").

Petitioner's Sixth and Seventh Notices of Reliance contain, respectively, screenshots from third-party websites and copies of third-party registrations that it asserts demonstrates that the trade channels are similar by showing "companies that provide data analytics and/or inventory management to hospitals and doctors also provide those services to institutional investors, pharmaceutical companies, medical device manufacturing companies, and consulting firms."[141] Petitioner argues that this evidence rebuts Mr. Haines' representation that there is no overlap in the parties' customers or trade channels.[142] However, the mere fact that Respondent denies that the trade channels and customers are similar does not open the door for Petitioner to supplement its case-in-chief with evidence regarding the alleged similarity. *See Life Zone*, 2008 TTAB LEXIS 37, at *16 ("A plaintiff may not present its case-in-chief in

[140] 73 TTABVUE 3-4 ¶¶ 7-8.

[141] 77-80 TTABVUE; 85 TTABVUE 41; 91 TTABVUE 24-25. We have already excluded the appendices that discuss this evidence for exceeding the page limit on briefs in Trademark Rule 2.128(b). *See supra* Section I.B.

[142] 89 TTABVUE 9-10.

rebuttal merely because the defendant denies that the plaintiff has made its case during its case-in-chief."). Indeed, beyond the parties' identifications of services in their registrations and some limited deposition testimony of Mr. Haines, the only evidence that Petitioner relies on regarding the similarity of trade channels and customers is what it submitted on rebuttal.[143] Petitioner's evidence does not respond to or "explain, repel, counteract, or disprove" any specific evidence or statements submitted by Respondent and is improper rebuttal. *See Wet Seal, Inc. v. FD Mgmt.*, Opp. No. 91157022, 2007 TTAB LEXIS 21, at *4 (TTAB 2007) (excluding third-party registrations submitted to show relatedness of the parties' goods as improper rebuttal because "burden is on opposer, in the first instance, to come forward during its own testimony period with proof of the essential elements of its claim, one element of which is the relatedness of the parties' goods").

Similarly, the Rebuttal McNally Declaration and the accompanying exhibits consist of information that Petitioner should have submitted during its case-in-chief. Indeed, the Rebuttal McNally Declaration covers the same topics as the original McNally Declaration including Petitioner's customers, market, attendance at trade shows, pricing of services, marketing and promotional activities, website screenshots, social media screenshots, information regarding first use and continuous use of its mark and even includes similar statements and exhibits.[144] *See Life Zone*, 2008 TTAB

[143] 85 TTABVUE 40-41; 91 TTABVUE 21-25 (including material submitted from the rebuttal Fifth Notice of Reliance discussed above).

[144] 54 TTABVUE 3-9 ¶¶ 9, 19, 22, 24-25, 27-29, 34, 43 (original McNally Declaration); 82 TTABVUE 2-3 ¶¶ 3-13 (Rebuttal McNally Declaration). Both the original and rebuttal

LEXIS 37, at *14 ("[I]t was incumbent upon opposer to come forward with admissible evidence of these matters during its case-in-chief" including "the goods and services on or in connection with which it uses its mark, its channels of trade, its classes of customers, and any other information necessary to prevail."). Petitioner confirms that the testimony and evidence are improper rebuttal when it asserts that this information responds to Respondent's Mr. Haines' assertions that the parties' customers and trade channels do not overlap, and also uses this information in support of arguments in its briefing regarding priority and the conditions of purchase.[145] *See Illyrian Imp.*, 2022 TTAB LEXIS 91, at *11 (not considering "rebuttal testimony declaration . . . with respect to any testimony that we consider properly to be part of [o]pposer's case-in-chief (e.g., first use of the marks at issue)"). As explained previously, Respondent's denial of an element of Petitioner's case does not mean that Petitioner can supplement with materials it should have submitted with its case-in-chief. *See Automedx, Inc. v. Artivent Corp.*, Opp. No. 91182429, 2010 TTAB LEXIS 343, at *3 (TTAB 2010) ("Evidence which should constitute part of an opposer's case

McNally declaration attach screenshots of Petitioner's website, sample sales and marketing material, and social media screenshots. 54 TTABVUE 11-15 (Ex. A website screenshots), 16-80 (Ex. B marketing materials), 87-104 (Ex. E social media); 82 TTABVUE 7-49 (Ex. B marketing materials), 50-150 (Ex. C website screenshots), 151-263 (Ex. D social media). *See Std. Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, Opp. No. 91116242, 2006 TTAB LEXIS 9, at *8 (TTAB 2006) (excluding as improper rebuttal evidence that "is of precisely the same type and has been submitted for the same purpose as the evidence submitted by opposer in support of its main case").

[145] 89 TTABVUE 10; 85 TTABVUE 32, 39; 91 TTABVUE 26. Petitioner also asserts that the Rebuttal McNally Declaration addresses the counterclaim of abandonment, but all it contains is the bare denial, "O&M has not abandoned any of its QSight Marks. Furthermore, O&M has no intention to abandon any of its QSight Marks." 89 TTABVUE 10; 82 TTABVUE 3 ¶ 8. This adds nothing to the record given that Petitioner already denied the allegations regarding abandonment in its Answer. 12 TTABVUE 12 ¶¶ 12-13; 28 TTABVUE 4 ¶¶ 12-13.

in chief, but which is made of record during the rebuttal period, is not considered when the applicant objects.").

Accordingly, we grant Respondent's request to strike Petitioners Fifth, Sixth, and Seventh Notices of Reliance as well as the Rebuttal McNally Declaration and exhibits, and give these materials no consideration.[146]

b. Parties' Arguments and Analysis

Petitioner argues that Respondent offers services in the healthcare industry and that both parties' services "use data to provide insight to entities that service health care professionals."[147] Petitioner also appears to rely on the presumption of overlapping trade channels and customers applied when the services are identical.[148]

Respondent argues that Petitioner "provided no evidence and made no argument that the parties sell to the same class of customers, or advertise in the same places or through the same methods, or sell their services through the same methods."[149] Respondent asserts that the evidence demonstrates that the parties' "do not market or sell their services to the same individuals, the same companies, or even in the same general field," and that "hav[ing] some connection to the medical industry" is not enough to establish the requisite relatedness.[150]

[146] 76-82 TTABVUE.

[147] 84 TTABVUE 40 (confidential); 85 TTABVUE 40-41.

[148] 91 TTABVUE 21.

[149] 87 TTABVUE 41.

[150] 87 TTABVUE 41, 44.

Petitioner is correct that we analyze the trade channels based on the parties' identification of services,[151] but Petitioner does not identify in its argument what it considers the normal channels of trade and prospective purchasers are for its clinical inventory management services beyond the healthcare industry and healthcare professionals.[152] As discussed with the parties' services, the mere fact that both Petitioner and Respondent operate in the broad healthcare field alone is insufficient to find the parties' trade channels similar. As the Federal Circuit explained:

> The tenuous connection between applicant's and opposer's trade channels becomes clearer when one considers the uses of their respective marks within the medical field. Opposer supplies data processing services for medical insurers, whereas applicant sells batteries and power supplies to makers of medical equipment such as bedside alert systems and crib monitors.

Elec. Design, 954 F.2d at 717. Similarly, here, Petitioner supplies services that monitor the available inventory of medical supplies in individual healthcare departments and facilities for use in providing medical treatment while Respondent offers aggregated industry data, market analysis, and business consulting about various healthcare topics to corporate entities and institutional investors. The services on their face do not establish any overlap in trade channels. *See Edwards*

[151] To the extent Petitioner argues that we cannot consider anything in the analysis of trade channel but the identification of services in the parties' registrations, this is incorrect. *See* 91 TTABVUE 22 ("Precedent is clear the Board must simply look at the registration, not extrinsic evidence."). While parties may not use extrinsic evidence to narrow their trade channels, we may consider extrinsic evidence to determine what the trade channels and purchasers are for the identified services. *See Coach Servs.*, 668 F.3d at 1370-71 (considering evidence of where the goods were sold and advertised and what types of customers the parties targeted).

[152] *See* 85 TTABVUE 39-41; 91 TTABVUE 21-22.

Lifesciences, 2010 TTAB LEXIS 84, at *43 (even where both products were used in hospitals no overlap in trade channels found where "[t]here is no testimony or evidence demonstrating that the two products would be bought and/or used together by the same personnel in the hospital").

The evidence shows that clinical inventory management services are offered to and utilized by those that have a medical supply inventory to manage, namely hospitals, surgery centers, and other acute care healthcare facilities.[153] While Petitioner states that it "does not bar other types of customers and its data may be useful to other types of business or individuals,"[154] it does not identify what other types of business or individuals and such speculation does not provide a basis to find the trade channels similar: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Elec. Design*, 954 F.2d at 717.[155]

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[153] 85 TTABVUE 22 (citing 54 TTABVUE 5 ¶ 19); 67 TTABVUE 26:19-21 (confidential); 54 TTABVUE 30 ("QSight™ was developed especially for healthcare departments where having the right medical-surgical supplies is critical to effective care – areas such as cardiac-cath labs, interventional radiology, the O.R."); *See also* 62 TTABVUE 26 containing Petitioner's response to Int. No. 14 that: "Petitioner states that hospitals, clinics, and other healthcare providers are the intended market for clinical inventory management services . . . ." While Petitioner marked this response confidential, we do not treat it as such because Petitioner has publicly filed the same information.

[154] 85 TTABVUE 22 (citing 54 TTABVUE 5 ¶ 19).

[155] We again reject Petitioner's attempt to rely on an email containing an inadmissible hearsay statement about something that may be "confusing" about an unidentified company by an individual that was never deposed in this proceeding. 84 TTABVUE 40-41 (confidential); 85 TTABVUE 40-41 (confidential); 91 TTABVUE 22; 46 TTABVUE 352 (confidential). *See supra* n.94. Even putting aside the hearsay issue, nothing about the email establishes the relatedness of the parties' trade channels.

In contrast, Respondent's aggregated industry data, market analysis, and business consulting services are offered to and utilized by institutional investors such as asset managers and corporate customers including those selling products in the healthcare industry such as professional-grade skincare companies, pharmaceutical companies and medical device manufacturing companies.[156] Respondent does not have any customers that are "hospitals, surgery centers, acute care healthcare facilities, or physicians," and does not "direct any of its marketing for any of its QSIGHT services to these entities."[157] And Petitioner does not identify any way in which hospitals, surgery centers, or acute care healthcare facilities would utilize the type of services offered by Respondent.

To the extent that Petitioner is attempting to rely on the legal presumption that "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers," its attempt is unavailing. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (citation omitted). The presumption applies only where the parties' services are identical or legally identical, and here we have found that parties' services are dissimilar. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (because "the marks cover identical goods . . . this presumption attaches"); *Embarcadero Techs., Inc. v. RStudio, Inc.*, Opp. No. 91193335, 2013 TTAB LEXIS 6, at *52 (TTAB 2013) ("because opposer's goods are not the same as applicant's goods and services, as identified in its

[156] 73 TTABVUE 4 ¶ 8.

[157] 73 TTABVUE 5 ¶ 13.

amended descriptions, we cannot presume these trade channels and classes of purchasers to necessarily be the same"). Where, as here, the services are **not** identical, we may presume only that they travel in whatever trade channels are normal for each type of service. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1361 (Fed. Cir. 2000) ("When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade").

Overall, Petitioner has not established, and the evidence of record does not support, that the parties' services travel in similar trade channels, or that there is overlap in customers of the parties' services. Accordingly, we find that this factor weighs against a likelihood of confusion.

5. Consumers' Sophistication and Purchasing Conditions

The fourth *DuPont* factor considers the "conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing." *DuPont*, 476 F.2d at 1361. "Purchaser sophistication may tend to minimize likelihood of confusion." *Palm Bay Imps.*, 396 F.3d at 1376. We must base our decision on "the least sophisticated potential purchasers." *Stone Lion*, 746 F.3d at 1325. However, "[i]n making purchasing decisions regarding 'expensive' goods, the reasonably prudent person standard is elevated to the standard of the 'discriminating purchaser.'" *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990). Additionally, "[t]here is always less likelihood of confusion where [services] are expensive and purchased after careful consideration." *Elec. Design*, 954 F.2d at 718.

Petitioner argues that buying conditions support a likelihood of confusion because Respondent's services "encompass[] a large class of potential customers" and "could be offered to anyone with money looking to gain business insight or analytics and are not limited to institutional investors, pharmaceutical companies, medical device manufacturing companies, consulting firms, hedge funds, and investment companies."[158] Relying on *Stone Lion*, 746 F.3d at 1325, Petitioner argues that we must consider the "least sophisticated potential purchasers", which here it asserts is an "Average Joe Investor."[159] Respondent counters that purchasing conditions weigh heavily against confusion because "[e]ach party sells expensive services to sophisticated and discerning professional customers after an extended sales period."[160]

We first consider the sophistication of the buyers and conditions of purchase for Petitioner's services. Both the nature of the services and the evidence of record demonstrate that Petitioner's customers are hospitals, surgery centers, and other acute care healthcare facilities that need clinical inventory management, all of which are sophisticated entities.[161] The individuals at the healthcare facilities that purchase

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[158] 85 TTABVUE 41-42.

[159] 91 TTABVUE 25.

[160] 87 TTABVUE 45.

[161] 54 TTABVUE 5 ¶ 19; Petitioner's reliance on *In re I-Coat Co., LLC*, Ser. No. 86802467, 2018 TTAB LEXIS 171, at *31-32 (TTAB 2018) is misplaced. *See* 85 TTABVUE 43; 91 TTABVUE 26. The Board in that case specifically found that the record lacked evidence on sophistication. *I-Coat Co.*, 2018 TTAB LEXIS 171, at *31 ("Beyond inferences we can draw from the goods themselves, there is nothing in the record that would give us additional insight as to the possible sophistication of consumers of corrective lenses, ski and sport goggles, and sunglasses.").

Petitioner's services are usually at the managerial or executive level, all sophisticated individuals.[162] *See Elec. Design*, 954 F.2d at 718 ("record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation"). Additionally, the evidence of record demonstrates that the purchasing process for clinical inventory management services is "attenuated and lengthy," which lessens confusion. *See Edwards Lifesciences*, 2010 TTAB LEXIS 84, at *41-42. Petitioner's process begins with sales representatives identifying the appropriate contact within the healthcare facility, then offering demonstrations of the system; and then the nature of the clinical inventory management services requires collecting information about the healthcare facility, the applicable departments, and their systems.[163] The next step is for Petitioner to bring in one of its technology specialists to fully identify all of the aspects of what a potential customer needs and so that the clinical inventory management system can "[i]ntegrate[] with all major hospital systems."[164] To engage the services, the customer needs to negotiate and sign a detailed service agreement to set up its subscription and then has the option to tailor its subscription.[165] Petitioner's services

[162] 67 TTABVUE 39:9-19 (confidential).

[163] 67 TTABVUE 32:22-34:2 (confidential). Petitioner designated the entire deposition transcript confidential, but the cited testimony contains information similar to that in the public record regarding Petitioner's sales process.

[164] 67 TTABVUE 34:3-36:2 (confidential); 54 TTABVUE 14. *See also* 54 TTABVUE 25 ("Our dedicated team of technology experts understands the full spectrum of hospital protocols.").

[165] 54 TTABVUE 7 ¶ 33. The representative sample of Petitioner's QSight customer's service contract (designed as confidential) that Petitioner submitted as evidence spans 25 pages. 55 TTABVUE 161-186.

are then implemented by Petitioner scanning all the inventory in the healthcare facility.[166]

Turning to the sophistication of the buyers and conditions of purchase for Respondent's services, we bear in mind that we have already determined that the parties' customers do not overlap. The evidence of record demonstrates that at least some of Respondent's customers are sophisticated, including institutional investors such as asset managers and hedge funds, as well as corporate customers such as professional-grade skincare companies, pharmaceutical companies and medical device manufacturing companies.[167] *See Elec. Design*, 954 F.2d at 718 ("potential or actual purchasers -- are nevertheless mostly different and in any event are sophisticated enough that the likelihood of confusion remains remote"). Respondent's services are offered to these sophisticated entities pursuant to a negotiated agreement.[168] The sales process "can range from taking several months to taking several years" and the "sales team will typically run through multiple demos with prospective customers, demonstrating the scope of the business intelligence data and address specific data points prospective customers may be interested in."[169] *See*

[166] 54 TTABVUE 95-97.

[167] 73 TTABVUE 4 ¶ 8; 48 TTABVUE 39 (Response to Int. No. 63); 72 TTABVUE 56 (confidential).

[168] 73 TTABVUE 6-7 ¶ 20.

[169] 73 TTABVUE 6-7 ¶ 20. The evidence also shows that Respondent's services require a "close working relationship" with customers and prospective customers including "gathering customer requirements, internally developing data sets and structure, testing the data solutions internally and with customers, delivering those solutions, and then incorporating customer feedback into those solutions on an ongoing basis." 73 TTABVUE 4-5 ¶ 11; *see also* 72 TTABVUE 53 (confidential).

Edwards Lifesciences, 2010 TTAB LEXIS 84, at *52 (sales cycles ranging from three months to 18 months supported that confusion was unlikely). The customers encompassed by Respondent's identification of services may also include less sophisticated individuals and a less involved purchasing process, but a "conclusion of likelihood of confusion is unwarranted even as to these purchasers because there is no evidence of overlap with purchasers of [Petitioner's] services." *Elec. Design*, 954 F.2d at 719.[170]

Moreover, both parties' services are expensive and "one would expect that all of the purchasers would exercise a high degree of care when making their purchasing decision." *Edwards Lifesciences,* 2010 TTAB LEXIS 84, at *51-52 (finding parties' products expensive where opposer's had "a list price of $ 14,000" and applicant's "involve[d] a one-time $47,000 installation fee in addition to a yearly license which for a 150-bed hospital would be about $ 46,000 per year"). Here, Respondent's customers typically pay between thousands to six figures per year for the services, and Petitioner's services involve a one-time implementation fee in the thousands and subscription fees that annually range from thousands to tens of thousands.[171] The

[170] In contrast, in *Stone Lion*, 746 F.3d at 1323-1324, the parties' services were legally identical so it was presumed that the customers were the same and both parties' customers could include "ordinary consumer seeking investment services" such that the sophistication factor weighed in favor of the opposer. Similarly, Petitioner's reliance on *In re Marshfield Consulting LLC*, Ser. No. 88099557, 2020 TTAB LEXIS 238, at *13-18 (TTAB 2020) (at 91 TTABVUE 25) is unavailing as it too involved legally identical services. Further, while Petitioner asserts that this decision is "board precedent," it is a non-precedential decision that is not binding on the Board. *See Int'l Dairy Foods Ass'n v. Interprofession Du Gruyere*, Opp. No. 9123242, 2020 TTAB LEXIS 268, at *70 (TTAB 2020) ("citation to non-precedential decisions is not encouraged and such decisions are not binding on the Board"); TBMP § 101.03 ("a decision or order designated as not precedential is not binding upon the Board").

[171] 72 TTABVUE 7 ¶ 22 (confidential); 55 TTABVUE 8 ¶ 34 (confidential).

expense of such services demonstrates that even ordinary consumers will be discriminating and exercise a high degree of care. *See Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at *29 (TTAB 2016) ("given the nature of the services and the high costs associated therewith, the conditions of sale favor a finding of no likelihood of confusion"); *Embarcadero Techs.*, 2013 TTAB LEXIS 6, at *53 (fact that opposer's software "is not found in retail stores leads us to conclude that opposer's products are not inexpensive and require considerable forethought prior to purchase").

Accordingly, given the lack of overlap in the parties' customers, the sophisticated customers and lengthy and involved purchasing process for Petitioner's services and for some of Respondent's customers, as well as the expense of both parties' services we find that this *DuPont* factor weighs against a likelihood of confusion.

6. The Presence or Absence of Actual Confusion

Under the seventh *DuPont* factor we examine the "nature and extent of any actual confusion," and under the eighth *DuPont* factor we consider the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *DuPont*, 476 F.2d at 1361. "Under the eighth *DuPont* factor, we look at actual market conditions, to the extent there is evidence of such conditions of record." *Keystone Consol. Indus. v. Franklin Inv. Corp.*, Can. No. 92066927, 2024 TTAB LEXIS 290, at *76 (TTAB 2024).

Respondent argues that there has been no actual consumer confusion in this case citing testimony from both parties' witnesses regarding the lack of instances of actual

confusion,[172] and further noting that Petitioner has not presented "testimony from any customer or any individual who was purportedly confused between the two brands."[173] Respondent also argues that "[t]he parties in this case have coexisted since 2018 without any evidence of actual confusion, which supports a finding that confusion is not likely."[174] Petitioner does not directly respond to these arguments,[175] but separately asserts that screenshots from a third-party website Zoominfo.com is "one example of consumer confusion between the parties' QSIGHT Marks" in its arguments regarding the *DuPont* factor on the extent of potential confusion.[176]

We first consider the Zoominfo.com screenshots.[177] The screenshots from third-party Zoominfo.com display a business profile for what appears to be Petitioner's QSIGHT. On the third page, the Zoominfo.com profile lists a link and a short excerpt from an article that appears to be about Respondent's QSIGHT. Respondent argues "the printout is not authenticated" and "there is no other evidence regarding what ZoomInfo is, how it generates its website content, whether the information is generated by a human or computer program, or any indicia of authenticity or

[172] 73 TTABVUE 7 ¶ 23; 67 TTABVUE 42:22-43:12 (confidential). *See also* 46 TTABVUE 188:5-12 (confidential).

[173] 87 TTABVUE 50.

[174] 87 TTABVUE 50-51.

[175] *See* 91 TTABVUE 17-27.

[176] 85 TTABVUE 45-47.

[177] 46 TTABVUE 346-350 (confidential). Petitioner filed the zoominfo.com screenshots as confidential, but we do not treat them as such since it is a public website, and Petitioner further included excerpts from the exhibit in the public version of its brief.

reliability that would make it admissible as evidence."[178] Petitioner responds that the Zoominfo.com screenshot "include[s] the date the webpage was accessed and the URL where the webpage was accessed" and that Respondent's Mr. Haines acknowledges this and "otherwise authenticates and discusses th[is] document[] in his deposition as both a fact witness and as [Respondent's] corporate representative."[179]

We agree with Petitioner that the Zoominfo.com screenshot has the required date and URL and as such is self-authenticating and admissible.[180] *See Hangzhou Mengku Tech. Co. v. Shanghai Zhenglang Tech. Co.*, Opp. No. 91272143, 2024 TTAB LEXIS 575, at *9 (TTAB 2024). However, we agree with Respondent that we do not have testimony from a competent witness about Zoominfo.com. As Respondent's witness, Mr. Haines, testified at his deposition he is "not familiar with this website, its collection methodology, its comprehensiveness and error rate."[181] In view of this lack of background information, the screenshot has low probative value.

Additionally, the mere fact that information allegedly about both parties appeared on the same third-party Zoominfo.com profile is not evidence of actual confusion. *See Toys "R" Us, Inc. v. Lamps R Us*, Opp. No. 91062749, 1983 TTAB LEXIS 229, at *22

[178] 87 TTABVUE 61.

[179] 89 TTABVUE 13.

[180] 46 TTABVUE 346-350.

[181] 46 TTABVUE 185:21-186:3 (confidential); *see also* 46 TTABVUE 181:4-185:8, 186:14-187:5 (confidential). Although Respondent designated the entire Haines deposition transcript confidential, we do not consider this testimony about a public website to be confidential. Respondent also provided other screenshots from Zoominfo.com, including one which on its face states that Petitioner is in "Apparel & Accessories Retail" and that similar companies include "K-Town Automotive", clearly inaccurate information, which lessens the evidentiary value of the Zoominfo.com screenshots Petitioner is attempting to use. 69 TTABVUE 44; *see also* 87 TTABVUE 50-51.

(TTAB 1983) ("The fact that questions have been raised as to the possible relationship between firms is not by itself evidence of actual confusion of their marks."). We have no evidentiary basis to determine how this information appeared on a third-party website, and if the information appeared merely as a result of use of key words or an algorithm, this does not demonstrate confusion on the part of any customer or potential customer.

With regard to the eighth *DuPont* factor, "[t]he absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [Respondent] of its mark for a significant period of time in the same markets as those served by [Petitioner] under its marks." *Citigroup Inc. v. Capital City Bank Grp., Inc.*, Opp. No. 91177415, 2010 TTAB LEXIS 40, at *50 (TTAB 2010). "In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred." *Made in Nature*, 2022 TTAB LEXIS 251, at *71. Here, looking at the parties' actual activities in the marketplace the parties use different trade channels and have different customers such that there hasn't "been a reasonable opportunity for confusion to have occurred." *Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at *62-63 (TTAB 2021) (noting "the different channels of trade actually used by the parties" in finding the eighth *DuPont* factor neutral); *Made in Nature*, 2022 TTAB LEXIS 251, at *71 (absence of confusion not meaningful where record shows the parties were not competitors and "do not trade in the same 'space'").

Accordingly, we find the seventh and eighth *DuPont* factors are neutral in our likelihood of confusion analysis.

7. Extent of Potential Confusion

We consider "[t]he extent of potential confusion, i.e., whether de minimis or substantial" under the twelfth *DuPont* factor. *DuPont*, 476 F.2d at 1361. Petitioner asserts that "the marks, the services offered, and the channels of trade are either identical or so similar between [its] QSIGHT Marks and [Respondent's] QSIGHT Marks that a substantial likelihood of confusion exists between the marks."[182] Petitioner's arguments "essentially repeat arguments under the other *DuPont* factors" and we have already determined that despite the similarity of the marks, Petitioner has not provided evidence establishing that the services, trade channels, or purchasers are similar. *Heil Co. v. Tripleye GmbH*, Opp. No. 91277359, 2024 TTAB LEXIS 494, at *94 (TTAB 2024). Additionally, Petitioner's customers and some of Respondent's customers are sophisticated and exercise a high level of care in the lengthy and involved purchasing process for the parties' expensive goods, which limits the extent of potential confusion. Accordingly, we find the extent of potential confusion is de minimis. *Calypso Tech.*, 2011 TTAB LEXIS 259, at *37 ("because of the limited number of overlapping potential purchasers of the parties' goods and services, and their sophistication, the extent of potential confusion is de minimis").

[182] 85 TTABVUE 45. Petitioner also asserts that a screenshot from a third-party website Zoominfo.com is an example of confusion and supports that the potential for confusion is substantial. 85 TTABVUE 45-47. However, we have already determined under the discussion *supra* Section VI.B.6 that this screenshot is not evidence of actual confusion.

8. Good or Bad Faith of Respondent

We consider a party's alleged bad faith in adopting a mark under the thirteenth *DuPont* factor, which includes "any other established fact probative of the effect of use." *See QuikTrip*, 984 F.3d at 1036 (*quoting DuPont*, 476 F.2d at 1361). "An inference of bad faith requires something more than mere knowledge of a prior similar mark. It requires an intent to confuse." *Id.* (citations omitted); *Keystone Consol.*, 2024 TTAB LEXIS 290, at *82 ("A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy.").

Petitioner's sole evidence in support of its argument that Respondent adopted its mark in bad faith is the same confidential email containing a vague statement about a Google search showing something that was "confusing" that we previously determined is inadmissible hearsay.[183] Petitioner is attempting to use the statement for the truth of the matter asserted, i.e., that something allegedly was "confusing."[184] We agree with Respondent that since Petitioner never deposed the individual that made the statement we do not know why the individual made the statement or what the lay person meant in its reference to "confusing."[185] *See Dan Foam ApS v. Sleep*

[183] 84 TTABVUE 43-45 (confidential); 46 TTABVUE 352 (confidential); *see supra* n.94 regarding the hearsay discussion. Petitioner failed to establish that the statement it relies upon in the email is an admission of a party opponent. *See* 89 TTABVUE 17-18; 93 TTABVUE 23-24. Petitioner argues that the deposition testimony of Mr. Haines establishes that the statement is not hearsay, but the statement Petitioner seeks to use was not made by Mr. Haines, but by another employee. And Mr. Haines' testimony does not establish that the statement made by Mr. Smith in the email qualifies as an admission of a party opponent.

[184] 85 TTABVUE 43-44; 84 TTABVUE 43-44 (confidential); 46 TTABVUE 352 (confidential).

[185] 87 TTABVUE 52, 63

Innovations, Inc., Can. No. 92054201, 2013 TTAB LEXIS 222, at *14 (TTAB 2013) ("documents are of little probative value in the absence of testimony from the customers themselves as to whether they were confused and, if so, what caused their confusion"); *Made in Nature*, 2022 TTAB LEXIS 251, at *26 ("a lay witness, may not understand the legal meaning of descriptiveness in trademark law").

Even if we did consider the hearsay statements in the email, the most they establish is knowledge or awareness of Petitioner's mark QSIGHT, which does not constitute bad faith. Moreover, as previously discussed, even finding such awareness requires us to draw inferences not clear from the face of the email, since Petitioner is not identified by name and the email merely includes an inactive link to a search on Google.[186] *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967 (Fed. Cir. 2007) ("Search engine results . . . may be insufficient to determine . . . the relevance of the search results to registration considerations."); *In re Future Ads LLC*, Ser. No. 85134539, 2012 TTAB LEXIS 283, at *4 n.3 (TTAB 2012) ("Board will not utilize a link or reference to a website's internet address to access the site to consider whatever content may appear therein").

Accordingly, Petitioner has not provided evidence of bad faith by Respondent, and we find this factor neutral. *See Monster Energy*, 2023 TTAB LEXIS 14, at *70 (finding factor neutral since "good faith adoption typically does not aid a[] [respondent] attempting to establish no likelihood of confusion").

[186] 46 TTABVUE 352 (confidential); 46 TTABVUE 196:3-16 (confidential), 196:18-25 (confidential) (testimony demonstrating that the link in the email is dead).

C. Conclusion on Petitioner's Likelihood of Confusion Claim

After reviewing the evidence of record, and the parties' arguments relating thereto, we find that confusion is not likely. Even though the marks are similar, which weighs heavily in favor of confusion, the other factors demonstrating confusion is not likely outweigh the similarity of the marks. Specifically, Petitioner failed to establish that the parties' services, trade channels or customers are similar and the evidence of record demonstrates that Petitioner's customers and some of Respondent's customers are sophisticated and exercise a high level of care in the lengthy and involved purchasing process for the parties' expensive goods, all of which weighs strongly against a likelihood of confusion. Moreover, these findings demonstrate that the extent of potential confusion is de minimis. The remaining factors discussed by the parties are neutral.

In view thereof, we find that Petitioner has failed to prove by a preponderance of the evidence that Respondent's marks will be likely to be confused with Petitioner's mark.

Decision: We grant Respondent's counterclaim for cancellation of Petitioner's Registration Nos. 5739878 and 6357539 on the basis of non-ownership. Registration Nos. 5739878 and 6357539 will be cancelled in due course. We deny Petitioner's petitions to cancel Respondent's Registration Nos. 6285787 and 6231233 on the basis of priority and likelihood of confusion.