

This Opinion is Not a
Precedent of the TTAB

Mailed: April 23, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re James Rice-Pena
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Serial No. 98077056
—

Augusto Perera of Ser & Associates, PLLC. for James Rice-Pena.

Valerie Kaplan, Trademark Examining Attorney, Law Office 107,
Leslie Bishop, Managing Attorney.

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Before Heasley, Larkin, and Bradley,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

James Rice-Pena (“Applicant”) seeks registration on the Principal Register of the
mark shown below



for services ultimately identified as follows:

- “Restoration services in the field of water, smoke and fire damage; Restoration in the field of water, smoke and fire damage for residential [sic] and commercial properties” in International Class 37;
- “Mold remediation services; Mold remediation services using chemical and non chemical treatments, industrial vacuums, vacuums, and scrubbing machines” in International Class 40; and
- “Mold Testing” in International Class 42.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the standard-character mark WE MANAGE THE DAMAGE, registered on the Principal Register for “Building and home damage restoration services” in International Class 37,² as to be likely, when used in connection with the services identified in the three classes in the application, to cause confusion, to cause mistake, or to deceive.

¹ Application Serial No. 98077056 was filed on July 10, 2023 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claimed first use of the mark and first use of the mark in commerce at least as early as November 29, 2017 in connection with the Class 37 services and at least as early as November 29, 2012 in connection with the Class 40 and Class 42 services. Applicant describes his mark as follows: “The mark consists of a depiction of a shield having a depiction of a house with squares within, a droplet on above top right of the roof and a depiction of a flame above the top left of the roof. The words FL Cleanup below and further below the words We Can Manage Any Damage also in stylized form.” Applicant has disclaimed the exclusive right to use FLCLEANUP apart from the mark as shown.

² The cited Registration No. 3901965 issued on January 4, 2011 and has been renewed. The registrant has disclaimed the exclusive right to use DAMAGE apart from the mark as shown.

Applicant appealed when the Examining Attorney made the refusal final. The case is fully briefed.³ We affirm the refusal to register.⁴

I. Record on Appeal⁵

The record on appeal includes Applicant's specimens of use;⁶ USPTO electronic records regarding the cited registration;⁷ third-party webpages that the Examining

³ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 WL 2853282, at *1 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's appeal brief appears at 4 TTABVUE and his reply brief appears at 7 TTABVUE. The Examining Attorney's brief appears at 6 TTABVUE.

Applicant's appeal brief is single-spaced, and both of his briefs use a type size that is much smaller than the required 11-point type, in violation of Trademark Rule 2.126(a)(1), 37 C.F.R. § 2.126(a)(1). If Applicant's appeal brief were properly formatted, it would also exceed the applicable page limit. Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2). The Examining Attorney did not object to these violations, however, so we will exercise our discretion to consider Applicant's non-conforming briefs. *Cf. In re Dimarzio, Inc.*, Ser. No. 87213400, 2021 WL 5822579, at *1-2 (TTAB 2021) (sustaining examining attorney's objection to applicant's non-conforming appeal brief).

⁴ As part of an internal Board pilot program on possibly broadening acceptable forms of legal citation in Board cases, the citation form in this opinion is in a form provided in Section 101.03(a) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion cites the Westlaw legal database ("WL") and, in the initial full citation of a case, also identifies the number of the Board proceeding where it is available. The Board's decisions that have issued since 2008 are available in TTABVUE and many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading Room by entering the same information. Practitioners should also adhere to the practice set forth in TBMP § 101.03(a).

⁵ Citations in this opinion to the file history of the application are to the downloadable .pdf versions of the documents in the Trademark Status and Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO"). *See In re Seminole Tribe of Fla.*, Ser. No. 87890892, 2023 WL 3751113, at *1 n.1 (TTAB 2023).

⁶ July 10, 2023 Application at TSDR 12-57; June 18, 2024 Response to Office Action at TSDR 67-70.

⁷ March 26, 2024 Office Action at TSDR 22-23.

Attorneys claims show that entities commonly provide the services identified in the cited registration and in the application under the same mark;⁸ and dictionary definitions of the word “cleanup.”⁹

The Examining Attorney also requests that we take judicial notice of definitions from the MERRIAM-WEBSTER DICTIONARY of the words “can,” “the,” “manage,” and “damage” attached to her brief. 6 TTABVUE 6-7, 15-51. We grant the Examining Attorney’s request, *In re Omniome, Inc.*, Ser. No. 87661190, 2019 WL 7596207, at *3 n.17 (TTAB 2019), and will consider the definitions for whatever probative value they may have.

II. Analysis of Likelihood of Confusion Refusal

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). *Charger Ventures*, 64 F.4th at 1379. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

⁸ *Id.* at TSDR 24-83; July 26, 2024 Final Office Action at TSDR 8-87.

⁹ March 26, 2024 Office Action at TSDR 9-14 (dictionary.com), 15-21 (MERRIAM-WEBSTER DICTIONARY).

As Applicant acknowledges, 4 TTABVUE 2-3, “[t]wo key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characters of the goods [or services] and differences in the marks.” *DC Comics v. Cellular Nerd LLC*, Opp. No. 91246950, 2022 WL 17832492, at *10 (TTAB 2022) (internal quotations and quotation marks omitted). Applicant devotes most of his appeal brief to these factors. 4 TTABVUE 3-6, 10-12, 17-24. Applicant also discusses the third factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 476 F.2d at 1361, 4 TTABVUE 6-8, and the fourth factor, the “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361, 4 TTABVUE 8-10.¹⁰

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

“In analyzing the services, the Board ‘considers [t]he similarity or dissimilarity and nature of the . . . services as described in an application or registration.’” *In re*

¹⁰ Applicant’s appeal brief contains sections captioned “Suggestiveness/Incongruity Legal Standard” and “Suggestiveness/Incongruity Arguments,” 4 TTABVUE 12-17, which discuss Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), which prohibits the registration on the Principal Register of a mark that is merely descriptive of the involved goods or services, and which is not at issue in this appeal. Applicant concludes these sections with the internally inconsistent claim that the cited mark “is both descriptive and suggestive.” 4 TTABVUE 17. To the extent that Applicant argues that the cited registration was improperly issued because the registered mark is merely descriptive, the Examining Attorney correctly notes that “[t]he validity of a cited registration ‘cannot be challenged in an ex parte proceeding.’” 6 TTABVUE 8 (quoting *In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 WL 3915986, at *8 (TTAB 2016)). We have given no consideration to the arguments in these portions of Applicant’s appeal brief.

OSF Healthcare Sys., Ser. No. 88706809, 2023 WL 6140427, at *4 (TTAB 2023) (quoting *In re Embiid*, Ser. No. 88202890, 2021 WL 2285576, at *10 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018)). “The services need not be identical or even competitive to find a likelihood of confusion.” *Id.* (internal quotation and quotation marks omitted). “They need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [they] emanate from the same source.” *Id.* (internal quotation and quotation marks omitted).

“Because each class in Applicant’s multi-class application is, in effect, a separate application, we consider each class separately, and determine whether [the Examining Attorney] has shown a likelihood of confusion with respect to each.” *OSF Healthcare Sys.*, 2023 WL 6140427, at *4 (internal quotation and quotation marks omitted). “At the same time, the ‘Examining Attorney need not prove, and we need not find, similarity as to each [service] listed in the description of’ the multiple services in Classes 37 and 40 in the application. *Id.* at *5 (quoting *In re St. Julian Wine Co.*, Ser. No. 87834973, 2020 WL 2788005, at *5 (TTAB 2020)). “It is sufficient for finding a likelihood of confusion if relatedness is established for any [service] encompassed by the identification of [services] within a particular class in the application.” *Id.* (quoting *St. Julian Wine Co.*, 2020 WL 2788005, at *5). *See also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods [or services] are used together or used by the same purchasers; advertisements showing that the

relevant goods [or services] are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods [or services] and the goods [or services] listed in the cited registration. . . .

OSF Healthcare Sys., 2023 WL 6140427, at *4 (citations omitted). “In addition, [t]he application and registration themselves may provide evidence of the relationship between the services.” *Id.* (quoting *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at *7 (TTAB 2023)).

“[W]e must construe the services identified in the cited registration as broadly as reasonably possible ‘to include all [services] of the nature and type described therein,’” *OSF Healthcare Sys.*, 2023 WL 6140427, at *5 (quoting *In re Solid State Design Co.*, Ser. No. 87269041, 2018 WL 287909, at *6 (TTAB 2018) (internal quotation omitted)), and we “must resolve any ambiguities regarding their coverage in favor of the cited registrant ‘given the presumptions afforded the registration under Section 7(b)’ of the Trademark Act.” *Id.* (quoting *In re C.H. Hanson Co.*, Ser. No. 77983232, 2015 WL 6121759, at *5 (TTAB 2015) (citing 15 U.S.C. § 1057(b)). “[W]e must also give the services identified in the application their full scope in our analysis of the second *DuPont* factor.” *Id.* (citing *In re Country Oven, Inc.*, Ser. No. 97354442, 2019 WL 6170483, at *3 (TTAB 2019)).

1. Class 37

The cited registration's Class 37 identification of services covers “Building and home damage restoration services.” The application's Class 37 identification of services covers “Restoration services in the field of water, smoke and fire damage; Restoration in the field of water, smoke and fire damage for residential and

commercial properties.” Applicant and the Examining Attorney draw very different conclusions under the second *DuPont* factor from the language of the respective identifications.

Applicant argues that “[w]hile both FLCLEANUP WE CAN MANAGE ANY DAMAGE and WE MANAGE THE DAMAGE are involved in restoration services, the scope and nature of the services they provide are significantly different, which reduces the likelihood of confusion.” 4 TTABVUE 24. He argues that he “specializes in restoration services specifically related to water, smoke, and fire damage” and “[t]his specialization is not limited to just the physical restoration of properties but extends to residential and commercial properties.” *Id.* According to Applicant, he offers “a niche service that is not offered by the cited mark, WE MANAGE THE DAMAGE,” while the registrant “offers building and home damage restoration services” that involve “a broad and general service that does not specify the type of damage it deals with” and “could include any type of damage, from natural disasters to structural issues, which is a much wider scope than the specific types of damage that [Applicant] deals with.” *Id.*

The Examining Attorney responds that the cited registration

uses broad wording to describe the services as “Building and home damage restoration services,” which presumably encompasses all services of the type described, including the Applicant’s more narrow services of “Restoration services in the field of water, smoke and fire damage; Restoration in the field of water, smoke and fire damage for residential and commercial properties, a specific type of building/home restoration services - water, smoke and fire damage.”

6 TTABVUE 10 (citations omitted). She concludes that “Applicant’s and Registrant’s Class 37 services are legally identical.” *Id.* at 10-11 (citations omitted).

We agree with the Examining Attorney. The services broadly identified in the registration as “Building and home damage restoration services” encompass Applicant’s narrower Class 37 “Restoration services in the field of water, smoke and fire damage” and “Restoration in the field of water, smoke and fire damage for residential and commercial properties.” *See OSF Healthcare Sys.*, 2023 WL 6140427, at *8. The second *DuPont* factor strongly supports a conclusion that confusion is likely as to the Class 37 services in the application. *Id.* at *9.

With respect to the third *DuPont* factor, and the portion of the fourth *DuPont* factor regarding identification of the “buyers to whom sales are made,” *DuPont*, 476 F.2d at 1361, neither Class 37 identification contains relevant restrictions regarding the channels of trade and classes of consumers for the services. “Because the [Class 37] services described in the application and the registration are legally identical . . . we must presume that the channels of trade and classes of purchasers are the same as to those legally identical services.” *OSF Healthcare Sys.*, 2023 WL 6140427, at *9 (quoting *Monster Energy*, 2023 WL 417620, at *8 (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012))). “The third *DuPont* factor thus also strongly supports a conclusion that confusion is likely as to Class [37] in the application.” *Id.*

2. Classes 40 and 42

The Class 40 identification in the application covers “Mold remediation services; Mold remediation services using chemical and non chemical treatments, industrial

vacuums, vacuums, and scrubbing machines,” and the Class 42 identification in the application covers “Mold Testing.”

With respect to Class 40, Applicant argues that he “provides mold remediation services, which includes the use of chemical and non-chemical treatments, industrial vacuums, and scrubbing machines,” and that “[t]his is a highly specialized service that requires specific expertise and equipment, which is not mentioned in the goods [sic] and services of WE MANAGE THE DAMAGE.” 4 TTABVUE 24. With respect to Class 42, Applicant argues that he “also offers mold testing services, which is a preventative measure and a distinct service that is not provided by WE MANAGE THE DAMAGE.” *Id.*

The Examining Attorney responds that extrinsic evidence in the form of third-party webpages “establishes that the same entity commonly manufactures, produces, or provides the relevant services and markets the services under the same mark, despite the Applicant’s arguments” 6 TTABVUE 11-12 (record citations omitted). She concludes that “all the Applicant’s and the Registrant’s services are considered related for likelihood of confusion purposes.” *Id.* at 12.

Applicant’s suggestion that the Class 40 and Class 42 services identified in his application are unrelated to the Class 37 services identified in the cited registration simply because the registrant allegedly does not offer the Class 40 and Class 42 services is belied by the fact that Applicant **himself** offers all three sets of services under his mark. Applicant’s own use of his mark for all three sets of services is potent evidence that they are intrinsically related and may be provided by the same entity

under the same mark.¹¹ *See Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 941 (Fed. Cir. 1990) (on the issue of relatedness of the applicant’s “modems” and the opposer’s “computer programs,” the fact “that such goods might come from a single source is shown by [the applicant’s] original application, which indicates [the applicant] itself used the mark OCTOCOM for both modems and computer programs”); *In re HerbalScience Grp., LLC*, Ser. No. 77519313, 2010 WL 5651672, at *3 (TTAB 2010) (the applicant was found to have acknowledged the relatedness of nutritional supplements and dietary supplement drinks because those goods were originally included in its identification of goods).

As noted above, the Examining Attorney also made of record multiple third-party webpages showing that service providers in addition to Applicant offer the involved services under the same mark. We summarize below the services described on the websites:¹²

- The website at servpro.com offers “Mold Removal and Remediation” services,¹³ as well as “Water Damage” and “Fire Damage” restoration services;¹⁴

¹¹ Applicant describes his company as “a full-service property restoration company” that “handle[s] everything from initial cleanup to comprehensive site restoration.” July 10, 2023 Application at TSDR 13.

¹² “[I]n determining exactly what services are offered through the respective websites, we acknowledge that services may not be explicitly described at all, or may be described in colloquial language that does not track the technical language of acceptable identifications of goods and services in applications and registrations, including those involved here.” *OSF Healthcare Sys.*, 2023 WL 6140427, at *10.

¹³ March 26, 2024 Office Action at TSDR 29.

¹⁴ *Id.* at TSDR 36-58.

- The website at puroclean.com offers “Water Damage, Fire Damage, Biohazard and Mold Removal Services.”¹⁵ PuroClean also evaluates situations involving mold as part of its remediation services;¹⁶
- The website at restoration1.com offers “Mold Remediation & Inspection Services,”¹⁷ as well as “Flood Damage Cleanup Services” and “Fire & Smoke Damage” services;¹⁸
- The website at dryeasemoldremovalnyc.com, which describes the company as “The NYC Water Damage Removal and Cleanup Experts,”¹⁹ offers services described as “Water Damage Repair,” “Water Damage Restoration Services,” “Fire and Flood Restoration,” “Water Cleanup,” “Flooded Basement Water Damage Repair,” “Fire Damage Restoration,” and “Smoke and Water Damage Cleanup,”²⁰ as well as mold inspection and removal services,²¹ which appear to involve various types of testing for mold;
- The website at servicemasterrestore.com, which describes the company as “mold testing, removal, and restoration professionals,”²² offers “Mold Removal Service,”²³ and “Mold Remediation,”²⁴ as well as “Cleaning & Restoration Services,”²⁵ including “Fire Damage Restoration,”²⁶ and “Water Damage Service;”²⁷
- The website at gotruenorth.com offers “Mold Inspection & Testing,” “Mold Remediation,” “Water Damage Restoration,” “Fire Damage Restoration,” and “Fire & Smoke Cleanup;”²⁸ and

¹⁵ *Id.* at TSDR 59-76.

¹⁶ *Id.* at TSDR 73.

¹⁷ *Id.* at TSDR 24.

¹⁸ *Id.* at TSDR 77-83.

¹⁹ July 26, 2024 Final Office Action at TSDR 8.

²⁰ *Id.* at TSDR 16.

²¹ *Id.* at TSDR 26-32.

²² *Id.* at TSDR 34.

²³ *Id.* at TSDR 33, 49-54.

²⁴ *Id.* at TSDR 34-35

²⁵ *Id.* at TSDR 38.

²⁶ *Id.* at TSDR 38-43.

²⁷ *Id.* at TSDR 45-48.

²⁸ *Id.* at TSDR 58.

- The website at jandrrestoration.com offers “Mold Damage Services,” including “Mold infiltration assessment & remediation,”²⁹ as well as “Fire Damage Services,”³⁰ and “Smoke & Soot Damage Services.”³¹

This evidence, which Applicant never addresses, shows that remediation companies in addition to Applicant commonly offer the Class 37 services identified in the cited registration and the application in addition to the Class 40 and Class 42 services identified in the application. Accordingly, the second *DuPont* factor also supports a conclusion of a likelihood of confusion as to Classes 40 and 42 in the application.

With respect to the third *DuPont* factor and the portion of the fourth factor pertaining to identification of the “buyers to whom sales are made,” *DuPont*, 476 F.2d at 1361, Applicant argues that

the applicant’s mark is specifically targeted towards a niche market in Florida, as indicated by the ‘FL’ prefix in FLCLEANUP. This suggests that the primary channel of trade for the applicant’s services is within the state of Florida, catering to the unique needs of Florida residents who frequently face issues such as water damage due to hurricanes and other tropical storms. This geographical limitation inherently restricts the scope of the applicant’s trade channel, making it less likely to overlap with the cited mark’s trade channel. On the other hand, the cited mark, WE MANAGE THE DAMAGE, does not specify any geographical limitation. This suggests that its services could be offered nationwide or even internationally. Therefore, the channels of trade for the cited mark are likely to be broader and more diverse, encompassing a wider range of consumers and markets.

²⁹ *Id.* at TSDR 73.

³⁰ *Id.* at TSDR 78.

³¹ *Id.* at TSDR 83.

4 TTABVUE 6-7.

Applicant further argues that his

mark offers specialized services in the field of water, smoke, and fire damage restoration, as well as mold remediation. These services are typically required by homeowners and commercial property owners who have experienced a specific type of damage. The specificity of these services narrows down the applicant's target demographic to a specific subset of consumers who have experienced these specific types of damage. In contrast, the cited mark offers building and home damage restoration services, a broader category that could encompass a variety of damage types, not limited to water, smoke, fire, or mold. This suggests that the cited mark's target demographic is more general, including any homeowner or commercial property owner who has experienced any type of building damage.

Id. at 7.

Finally, Applicant argues that his Class 40 and Class 42 services “may attract customers like environmental consultants, health inspectors, and property managers concerned with indoor air quality and compliance issues,” which “results in distinct channels of trade, including partnerships with companies specializing in disaster recovery, environmental testing, and indoor air quality improvement.” *Id.* According to Applicant, the “inclusion of mold testing and remediation in Classes 40 and 42 for the applicant's mark involves technical expertise, specialized equipment, and potentially compliance with environmental regulations. These factors place the services in more professional and regulatory-driven markets, distinct from the general restoration services provided under the cited mark.” *Id.*

Applicant concludes that

the distinct geographical focus and specialized services of the applicant's mark, compared to the broader scope and general services of the cited mark, create distinct channels of trade that significantly reduce the likelihood of confusion among consumers. The applicant's mark is primarily traded within Florida and targets a specific subset of consumers who have experienced water, smoke, fire, or mold damage. In contrast, the cited mark is likely traded in a wider geographical area and targets a broader range of consumers who have experienced any type of building damage. These distinctions in the channels of trade make it unlikely that a consumer would confuse the two marks.

Id. at 8.

The Examining Attorney responds that “the geographic extent of the Applicant's and the Registrant's activities is not relevant to a likelihood of confusion determination” because the registrant owns, and Applicant seeks, a geographically unrestricted registration. 6 TTABVUE 12.

Applicant's arguments that his services are “specifically targeted towards a niche market in Florida,” 4 TTABVUE 6, are meritless. Applicant seeks a nationwide registration for services in Classes 40 and 42 that are not identified as restricted to a “niche market” or a single state, and such a registration “would give Applicant presumptive exclusive rights to nationwide use of [his] mark in association with the identified [services] under Section 7(b) of the Trademark Act.” *In re Nat'l Concessions Grp., Inc.*, Ser. No. 87168058, 2023 WL 3244416, at *8 (TTAB 2023) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 701 F.2d 1565, 1568 (Fed. Cir. 1983)). *See also Iron Balls Int'l Ltd. v. Bull Creek Brewing, LLC*, Canc. No. 92079099, 2024 WL 2884425, at *24 (TTAB 2024) (the presence of a geographically unrestricted registration and a geographically unrestricted application make the current actual

use of the involved marks irrelevant under the third *DuPont* factor) (citing *Detroit Athletic Co.*, 903 F.3d at 1308). We agree with the Examining Attorney that the current “geographical extent of the Applicant’s and the Registrant’s activities is not relevant to a likelihood of confusion determination.” 6 TTABVUE 12.

The Internet evidence discussed above shows that the identified services in Classes 40 and 42 in the application are offered by remediation companies like Applicant himself that also offer the legally identical Class 37 services, and that the classes of consumers for all of these identified services include members of the general public. The channels of trade and classes of consumers for the involved services thus overlap, and the third *DuPont* factor supports a conclusion that confusion is likely as to Classes 40 and 42 in the application.

B. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Iron Balls*, 2024 WL 2844425, at *11 (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, Opp. No. 91270181, 2024 WL 1638376, at *5 (TTAB 2024) (quotation and quotation marks omitted).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection

between the parties.” *Id.* (quoting *Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)). “The focus is on the recollection of the average purchaser, who normally ‘retains a general rather than a specific impression of marks.’” *Id.* (quoting *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 WL 3993582, at *4 (TTAB 2018)). The record evidence discussed above shows that the average purchasers of the services identified in the application include ordinary consumers who own homes.

As discussed above, the Class 37 services are legally identical and the Class 40 and Class 42 services identified in the application are related to the Class 37 services identified in the cited registration. Under these circumstances, “a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion.” *Coach Servs.*, 668 F.3d at 1368 (citations omitted).

The cited mark is WE MANAGE THE DAMAGE in standard characters. Applicant’s composite word-and-design mark is reproduced again below:



Applicant argues that there are “significant differences that distinguish the two [marks] and eliminate any likelihood of confusion.” 4 TTABVUE 4. With respect to appearance and sound, Applicant focuses on the following differences: (1) the

presence of the “unique term ‘FLCLEANUP’” in his mark, which he claims “is a significant component of [the] mark and contributes to its distinctiveness,” *id.*; (2) the differences between the cited mark WE MANAGE THE DAMAGE and the phrase **We can manage ANY damage!** in his mark, *id.*; and (3) the fact that Applicant’s mark “is far more complex and distinctive” than the cited mark because it “includes a depiction of a shield with a house, squares, a droplet, and a flame,” and word elements that are in stylized form. *Id.*

With respect to meaning, Applicant summarizes his position as follows:

The applicant’s mark, ‘FLCLEANUP WE CAN MANAGE ANY DAMAGE’, creates a commercial impression of a comprehensive, all-encompassing service that can handle any type of damage, specifically in the context of restoration services related to water, smoke, and fire damage, as well as mold remediation. The use of the term ‘FLCLEANUP’ in conjunction with ‘WE CAN MANAGE ANY DAMAGE’ suggests a Florida-based company that is capable of managing and rectifying any form of damage, whether it be from natural disasters or other incidents. The depiction of a shield with a house, a droplet, and a flame further reinforces this impression, suggesting a protective service that can handle a variety of damage types, including water, fire, and smoke damage. On the other hand, the cited mark, ‘WE MANAGE THE DAMAGE’, creates a commercial impression of a service that manages damage, but without the same level of specificity or comprehensiveness suggested by the applicant’s mark. The cited mark does not specify the type of damage it manages, nor does it suggest a particular geographic focus or a comprehensive, all-encompassing service. The absence of any visual elements in the cited mark also contributes to a more generic commercial impression.

Id. at 10-11.

The Examining Attorney responds that the “dominant portion of the applied-for mark is WE CAN MANAGE ANY DAMAGE, as the additional wording FLCLEANUP

has been disclaimed,” 6 TTABVUE 4, and argues that “Applicant fails to explain why FLCLEANUP would serve as a strong brand/source identifier, when the wording has been disclaimed and thus the Applicant admitted its descriptiveness.” *Id.* at 5. The Examining Attorney also argues that the word elements of Applicant’s mark are more significant than the design elements. *Id.*

The Examining Attorney further argues that the “dominant part of the applied-for mark WE CAN MANAGE ANY DAMAGE and the registered mark WE MANAGE THE DAMAGE, creates a highly similar commercial impression” even if there are some differences in the appearance and sound of the marks. *Id.* She rejects Applicant’s argument that the different wording in the phrases WE MANAGE THE DAMAGE and WE CAN MANAGE ANY DAMAGE has any significance regarding the meaning of the involved marks. *Id.* at 6. She concludes that

both marks convey the same idea, stimulate the same mental reaction, and have the same overall meaning of having the ability to manage, handle, and deal with damages. Despite the Applicant’s arguments, both marks convey the same idea of being able to deal or manage whatever damage by using the terms ANY DAMAGE or THE DAMAGE.

. . .

The Applicant is focused on minute differences, such as the structure of the sentences and phonetic variations when the focus should be on the overall commercial impression. In this case, as discussed above, both marks create a commercial impression of managing and/or handling a diverse variety of damages.

Id. at 7-8.

In his reply brief, Applicant argues that the Examining Attorney’s

focus on WE CAN MANAGE ANY DAMAGE, overlooks the significance and the positioning of Applicant's wording "FLCLEANUP" on their [sic] mark, which enhances the distinctiveness of the Applicant's mark. While both marks share common terms, the overall commercial impression is distinct. The applied-for mark incorporates first the unique and distinguishable element FLCLEANUP, with a logo which serves as a strong source identifier.

7 TTABVUE 3.

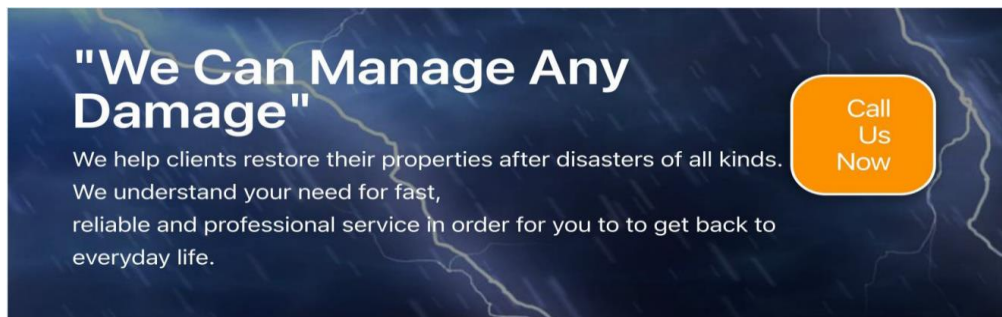
We begin by determining the dominant portion of Applicant's mark. The marks must be compared in their entireties, but "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *Detroit Athletic Co.*, 903 F.3d at 1305 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)). As discussed above, the Examining Attorney argues that the phrase "***We can manage ANY damage!***" is the dominant portion of Applicant's mark, while Applicant argues that the disclaimed compound word "FLCleanup" is the dominant portion.³²

We agree with the Examining Attorney. Although the compound word FLCLEANUP appears in Applicant's mark above the tagline "***We can manage ANY***

³² Applicant's mark also contains a design element, but "[i]n the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods [or services]." *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 WL 1620989, at *2 (TTAB 2018) (citations omitted). This general principle applies here, where the design element of Applicant's mark contains depictions of a rain drop and a flame in close proximity to a depiction of a house and thus simply identifies two sorts of property damage that Applicant claims he can manage. *See id.* at *3; *In re Ox Paperboard, LLC*, Ser. No. 87847482, 2020 WL 4530517, at *5 (TTAB 2020).

damage!,” and in a larger font than the tagline, FLCLEANUP has been disclaimed,³³ and “disclaimed or descriptive terms may be considered less significant features of the mark, even when they appear first.” *Monster Energy*, 2023 WL 417620, at *15 (citations omitted). *See also Aquitaine Wine USA*, 2018 WL 1620989, at *3 (disclaimed matter, including geographically descriptive matter, has less significance in likelihood of confusion determinations) (citations omitted). Moreover, unlike the tagline “**We can manage ANY damage!**,” which appears in bolded type punctuated by an exclamation point, what Applicant calls the “unique term ‘FLCLEANUP’,” 4 TTABVUE 4, is somewhat hard to read and understand.

In determining the dominant portion of Applicant’s mark, we may also consider how its elements are used in text. *Cf. CBS Inc. v. Morrow*, 708 F.2d 1579, 1582 & n.5 (Fed. Cir. 1983). As shown below, Applicant’s specimen emphasizes the tagline “We can manage ANY damage!” by putting it within quotation marks and encouraging prospective consumers to associate that phrase with Applicant:



³³ The word CLEANUP is highly descriptive of the restoration and mold remediation services identified in the application, and Applicant stated in the application that the abbreviation FL “appearing in the mark means or signifies or is a term of art for Florida in the relevant trade or industry or as used in connection with the goods/services listed in the application.” July 10, 2023 Application at TSDR 5.

³⁴ *Id.* at TSDR 14, 18, 41.



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Intro

"We can manage any damage."

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³⁵ *Id.* at TSDR 21, 47.

³⁶ *Id.* at TSDR 47.

³⁷ *Id.* at TSDR 23, 46.

³⁸ *Id.* at TSDR 26, 49.

We find that the tagline “***We can manage ANY damage!***” is the dominant portion of Applicant’s mark because of its nature, positioning, and readability, and we turn now to the required comparison of the marks in their entireties, giving greater weight in that comparison to Applicant’s tagline than to the compound word FLCLEANUP or the design elements in Applicant’s mark.

At the outset, we note that Applicant’s arguments that the marks are dissimilar assume a level of subtlety of consumer perception and retention that is inconsistent with our working assumption, in the absence of contrary evidence, that the average consumer “retains a general rather than specific impression of the marks,” *Embiid*, 2021 WL 2285576, at *4 (citation omitted), and the need to compare the marks “‘in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 685 (CCPA 1977)). The general impression of the cited mark WE MANAGE THE DAMAGE for “building and home damage restoration services” is likely to be simply that of managing damage. There is no evidence that when consumers with that general impression of the cited mark separately encounter Applicant’s mark, dominated by the phrase “***We can manage ANY damage!***,” and used with identical and similar services, they are likely to parse the tagline in the manner suggested by Applicant rather than simply to understand Applicant’s mark as also referring to managing damage. Such an exegesis of Applicant’s mark is particularly unlikely when purchasing the involved

services, because, as Applicant acknowledges, they “are typically required in times of distress or emergency, such as after a fire, flood, or mold infestation.” 4 TTABVue 8.

With respect to appearance, “[s]ince [the cited] mark is a standard character mark, we must consider that the . . . mark may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant’s mark” because the “rights associated with a standard character mark reside in the wording per se and not in any particular font style, size or color.” *Aquitaine Wine USA*, 2018 WL 1620989, at *5 (citing *Citigroup Inc. v. Cap. City Bank Grp.*, 637 F.3d 1344, 1352 (Fed. Cir. 2013)). *See also Viterra*, 671 F.3d at 1363. Accordingly, for purposes of our comparison of the marks in appearance, we must assume that the cited mark could be depicted in exactly the same italicized and bolded font as the tagline ***We can manage ANY damage!*** (e.g., ***We manage the damage***) and could include a combination of uppercase and lowercase letters. *Aquitaine Wine USA*, 2018 WL 1620989, at *5; *see also In re N.Y. Times Co.*, Ser. No. 90106071, 2023 WL 279414, at *1 n.2 (TTAB 2023).

We find that the cited mark WE MANAGE THE DAMAGE and Applicant’s composite mark, dominated by the tagline ***We can manage ANY damage!***, are more similar than dissimilar in appearance, particularly if we assume that the cited mark may be rendered in the same manner as the tagline in Applicant’s mark. *See Aquitaine Wine USA*, 2018 WL 1620989, at *5 (finding that the standard-character mark CHATEAU LAROQUE and the mark LAROQUE CITÉ DE CARCASSONNE and the design of a house were more similar than dissimilar in appearance).

With respect to sound, the cited mark consists of the four-word phrase “We Manage The Damage,” which would be verbalized as such. Applicant’s mark could be verbalized as “FLCLEANUP We can manage ANY damage,” but the Board has recognized “the penchant of consumers to shorten marks.” *In re Bay State Brewing Co.*, Ser. No. 85826258, 2016 WL 1045677, at *3 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 815 (CCPA 1978) (“the users of language have a universal habit of shortening full names from haste or laziness or just economy of words”) (Rich, J., concurring)). Because the “unique term ‘FLCLEANUP’,” 4 TTABVUE 4, in Applicant’s mark is unfamiliar and difficult to discern, and the tagline ***We can manage ANY damage!*** is straightforward and easy to discern, we find that it is more likely that consumers will shorten Applicant’s mark to the tagline when verbalizing the mark, especially in light of the exigent circumstances in which it is likely to be verbalized. In either event, we find that “We Manage the Damage” is more similar than dissimilar in sound to both “FLCLEANUP We can manage ANY damage!” and “We can manage ANY damage!”

Finally, with respect to meaning, the marks “convey similar connotations and commercial impressions,” *Aquitaine Wine USA*, 2018 WL 1620989, at *6, because each mark conveys the general notion of “managing” damage.³⁹ In the context of the services identified in the application, consumers with a general impression of the cited mark could readily view Applicant’s mark as a variant of the cited mark

³⁹ On this record, Applicant and the owner of the cited registration are the only entities in the relevant industry whose marks state that their owners “manage” damage.

reflecting a line extension of the registrant's services, perhaps directed in particular to consumers in the state of Florida. *See, e.g., Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, Opp. No. 91197659, 2013 WL 5407313, at *10 (TTAB 2013). We find that the marks are quite similar in meaning.

When considered in their entirety, the marks are more similar than dissimilar in appearance and sound, and quite similar in meaning. "The first *duPont* factor weighs in favor of a likelihood of confusion." *Aquitaine Wine USA*, 2018 WL 1620989, at *6.

C. Purchase Conditions and Degree of Consumer Sophistication

The fourth *DuPont* factor "concerns the 'conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing." *In re Samsung Display Co.*, Ser. No. 90502617, 2024 WL 3451873, at *7 (TTAB 2024) (quoting *DuPont*, 476 F.2d at 1361). We discuss here the second portion of the factor regarding the conditions under which sales are made.

Applicant summarizes his arguments under the fourth factor as follows:

[T]he services offered under both marks are not every day, casual purchases. They are specialized services that are typically required in times of distress or emergency, such as after a fire, flood, or mold infestation. These are not situations where a consumer is likely to make an impulsive decision based on a quick glance at a trademark. Instead, they are likely to exercise a high degree of care and deliberation in selecting a service provider. The consumer's decision-making process in such situations is likely to involve extensive research and consideration. They may seek recommendations from insurance companies, friends, or family members who have had similar experiences. They may also conduct online research to compare different service providers, read reviews, and assess the quality of

work and customer service. This level of care and deliberation significantly reduces the likelihood of confusion between the two marks. Furthermore, the nature of the services offered under both marks requires a high level of expertise and professionalism. Consumers understand this and are likely to scrutinize the qualifications, experience, and reputation of the service providers before deciding. They are unlikely to be swayed by superficial similarities between the two marks and are more likely to focus on the substantive differences in the services offered. In addition, the financial implications of these services further necessitate a high degree of care in the decision-making process. These are not low-cost, disposable goods but rather high-value services that can have significant financial implications for the consumer. This further incentivizes the consumer to exercise a high degree of care and deliberation in selecting a service provider, thereby reducing the likelihood of confusion between the two marks.

4 TTABVUE 8-9.

Applicant concludes that

the level of care that consumers exercise when choosing to purchase goods or services associated with the applicant's mark and the cited mark significantly decreases the likelihood of confusion. The nature of the services, the potential financial implications, and the need for expertise and professionalism all contribute to a high degree of care and deliberation in the consumer's decision-making process. This level of care helps to eliminate any likelihood of confusion between the two marks.

Id. at 9-10.

“Applicant’s arguments under this factor are unsupported, as there is no evidence demonstrating how purchasing decisions are made,” *Samsung Display*, 2024 WL 3451873, at *10, such as a declaration from Applicant. He instead relies solely on argument of counsel, which is “no substitute for evidence.” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (internal quotation

omitted)). The record shows that the involved services are purchased by both businesses and ordinary homeowners, frequently under circumstances that do not permit “a high degree of care and deliberation in the consumer’s decision-making process,” 4 TTABVUE 9, because, as Applicant acknowledges, the involved services “are typically required in times of distress or emergency, such as after a fire, flood, or mold infestation.” *Id.* at 8.

Applicant’s specimen of use, which is directed to businesses, states that “[w]hen disaster strikes, you need professional restoration services to get back up again quickly so your business continues without delay!” and that his services are “available 24/7 365 days per year to help make sure your business can get back up on its feet again in no time at all!”⁴⁰ The websites of third-party restoration companies discussed above similarly offer some sort of 24/7 or emergency services to their customers.⁴¹ It is self-evident that when the involved services are purchased “in times of distress or emergency,” 4 TTABVUE 8, there is little or no opportunity to engage in “extensive research and consideration,” to “seek recommendations from insurance companies, friends, or family members who have had similar experiences,” or to “conduct online research to compare different service providers, read reviews, and assess the quality of work and customer service,” *id.*, as hypothesized by Applicant. As the Examining Attorney correctly notes, we must consider the degree of care likely to be exercised by

⁴⁰ July 10, 2023 Application at TSDR 12-13.

⁴¹ March 26, 2024 Office Action at TSDR 36, 43-45, 52-53 (ServPro), 60, 62-63, 65-66, 71, 75 (PuroClean), 77, 81-82 (Restoration 1); July 26, 2024 Final Office Action at TSDR 10, 19 (Dry Ease), 34, 36, 42, 47, 50, 52 (Service Master), 60, 63, 67, 70 (True North Restoration), 73, 78, 83 (J&R Restoration).

the least sophisticated potential purchaser of the involved services, *Samsung Display*, 2024 WL 3451873, at *9 (citing *Stone Lion Cap. Partners, LP v. Lion Cap. LLC*, 746 F.3d 1317, 1325 (Fed. Cir. 2014)), and we find that the least sophisticated potential purchaser of the involved services is unlikely to exercise anything more than ordinary care in purchasing them. The portion of the fourth *DuPont* factor regarding the degree of purchaser care is neutral in our analysis of the likelihood of confusion.

D. Summary

The key first and second *DuPont* factors, the third factor, and the portion of the fourth factor regarding identification of the purchasers of the involved services, all support a conclusion that confusion is likely with respect to all three classes in the application, while the portion of the fourth *DuPont* factor regarding the degree of purchaser care is neutral. The marks are similar, the Class 37 services in the application are identical to their counterparts in the cited registration and the Class 40 and Class 42 services in the application are similar to the services identified in the cited registration, and the services are sold in overlapping channels of trade to overlapping consumers. We conclude that a consumer with a general impression of the cited mark WE MANAGE THE DAMAGE for “Building and home damage restoration services” who separately encounters Applicant’s composite mark, which is dominated by the tagline ***We can manage ANY damage!*** and is used for the same or similar services, is likely to believe mistakenly that the involved services have the same source.

Decision: The refusal to register is affirmed as to all three classes in the application.