



By Tal Grinblat

Confusing Trademarks: The Next Course of Action

ONE OF THE MOST COMMON objections raised by the U.S. Patent & Trademark Office (PTO) in reviewing applications is the likelihood of confusion with third party registrations and earlier filed applications. An applicant that receives an objection claiming that the mark is confusingly similar to another party's trademark has several options.

Standard for Likelihood of Confusion

15 U.S.C. §1052 provides in pertinent part that:

No trademark by which the goods of the applicant may be

distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. . .

In evaluating a trademark application for "registrability," the PTO

reviews existing registrations and previously filed pending applications to identify possible conflicts. The applicable question in conducting the review is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods or services they identify emanate from the same source.¹

The options available to try to overcome refusals based on the likelihood of confusion are varied. These include presenting arguments why the marks are different or the goods or services are different; seeking consent for the use and registration of



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your mark from the owner of the cited registration/earlier filed application; and initiating a concurrent use proceeding (if the facts support that option).

Addressing the Examiner's Objection by Argument

One of the tools available for practitioners to try to overcome an examiner's refusal that another mark is confusingly similar to your own is by argument. The Trademark Office will take the following list of non-exhaustive determinants, the so-called "Dupont Factors," into account:²

- ***The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*** The more marks are different visually, aurally and in other fashions, the less likely consumer confusion would arise. The basic principle in determining confusion between marks is that marks must be compared in their entireties (not dissected into parts) and must be considered in connection with the particular goods or services for which they are used and not in the abstract.
- ***The relatedness of the goods or services as described in the application and cited registration(s)/earlier filed application(s).*** The more the parties' goods or services are different in terms of function, use or other aspect, the likelihood of consumer confusion is reduced.
- ***The similarity or dissimilarity of the parties' trade channels,*** i.e., how the goods or services are sold, whether one parties' goods are specialized, etc.
- ***The sophistication of the consumer.*** The more sophisticated the consumer of a particular product or service, the

less likely consumer confusion will arise.

- ***The types of goods sold,*** i.e., whether impulse or careful sophisticated purchasing. The more expensive an item, ordinarily, the more a consumer is likely to investigate the product, therefore lessening the risk of consumer confusion.
- ***The number and nature of similar marks in use on similar goods,*** i.e., if a number of similar marks already exist for similar goods or services, the more likely consumers would assess other aspects of the mark to differentiate source; while any one factor may be sufficient to overcome the refusal, ordinarily, the more factors an applicant can show, the better the chance of overcoming the refusal.³

Obtaining the Cited Mark Owner's Consent

A second option to try to overcome an examiner's refusal to register a mark based on consumer confusion is seeking consent of the owner of the cited registration or earlier filed application for the use and registration of your mark.

A consent agreement may take a number of different forms and arise under a variety of circumstances. These can include entering into a formal agreement with the cited registrant/applicant, whereby the parties agree on certain usage restrictions (i.e., font, stylization, logo usage, use with other words), agreeing on limits on how the products and services are sold, specifying channels of trade by which each party's products or services will be sold or advertised, agreements to cooperate in the event of any confusion, and other manners.⁴

While there is no per se rule that a consent, whatever its terms, will always tip the balance to finding

no likelihood of confusion, consent agreements are given great weight because the PTO takes the position that the parties closest to the matter can best assess the marketplace. Further, the Office's position is that its own personnel should not substitute their own judgment concerning the likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion.^{5 6}

While consent agreements receive great deference, "naked consent" agreements—agreements that contain little more than a prior registrant's consent to registration of an applied-for mark and possibly a mere statement that source confusion is believed to be unlikely—are typically considered to be less persuasive than agreements that detail the particular reasons why the relevant parties believe no likelihood of confusion exists and specify the arrangements undertaken by the parties to avoid confusing the public.^{7 8}

Initiating Concurrent Use Proceedings

Another option sometimes available to a party receiving a refusal based on likelihood of confusion arises when the party applying to register their mark has used their mark for a period of time which precedes the registration date of the cited registrant. The process, called concurrent use proceedings, allows an applicant to apply to register their mark usually based on geographic limitation.

The statutory framework contains a proviso under which an eligible applicant may request issuance of a registration based on rights acquired by concurrent use of its mark, either with the owner of a registration or application for a conflicting mark or with a common-law user of a conflicting mark.⁹

In a concurrent use application, the applicant normally requests a geographically-restricted registration and identifies in its application one or more parties who concededly have rights in the mark in other geographical areas.¹⁰ These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration.

There are two bases upon which a concurrent use registration may be issued. First, a determination by the Trademark Trial and Appeal Board that the applicant is entitled to a concurrent registration. Or second, a final determination by a court on the concurrent rights of the relevant parties to use the same or similar marks in commerce.¹¹


An applicant is eligible to request a registration subject to concurrent use if it meets one or more of the following criteria: the owner of the registration consents to the grant of a concurrent use registration to the applicant; the concurrent use request is sought pursuant to a court decree determining the rights of the concurrent user; or the applicant's date of use of its mark is before the filing date of the other pending application or existing registration.¹² The applicant has the burden of proving that it is entitled to a concurrent use registration.¹³

Therefore, in circumstances when a client has used their mark before the filing date of another trademark, the concurrent use option is a viable and potentially potent option to obtain a registration even if the identical mark for the identical goods or services has been used in another part of the country. The end result is that both parties obtain rights to their respective marks in their respective geographies.

Final Options

Several options exist when receiving

a refusal that a mark is confusingly similar to another previously filed application or existing registration. These can vary from explaining to the examiner why the marks, goods or services associated with each party's marks are different, why the channels of trade vary; why seeking and obtaining consent from the owner of the mark would block your trademark; or how initiating concurrent use proceedings if the client's own use predates the filing date of the other party's application or registration.

In short, it's critical to know the full landscape of available options that can be instrumental in crafting a suitable strategy to counter an examiner's refusal and successfully reach the goal of obtaining a registration for the client's mark. 

¹ *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship.")

² *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The U.S. Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion.

³ *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate).

⁴ *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985).

⁵ *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993).

⁶ Trademark Office Manual of Examining Procedures, §1207.01(d)(viii) (2017).

⁷ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A. 1973) (noting that "[i]n considering agreements, a naked 'consent' may carry little weight," but "[t]he weight to be given more detailed agreements . . . should be substantial).

⁸ *In re Donnay Int'l, S.A.*, 31 USPQ2d 1953, 1956 (TTAB 1994) ([T]he more information the parties place in a consent agreement explaining why the parties believe confusion is unlikely, the more the PTO assumes the consent is based on a reasoned assessment of the marketplace, and consequently the more weight the consent will be accorded.)

⁹ §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

¹⁰ 15 U.S.C. §1051(a)(3)(D).

¹¹ 15 U.S.C. §1052(d); 37 C.F.R. §2.99(h).

¹² 15 U.S.C. §1052(d); 37 C.F.R. §2.99(e).

¹³ *America's Best Franchising, Inc. v. Abbott*, 106 USPQ2d 1540, 1548 (TTAB 2013) (quoting *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 883 (TTAB 1985)).