

## A Few Recommendations for the Office and Those Practicing Before the Office

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I began my legal career as an examining attorney at the USPTO and have been in private practice since 2005. In that time I have come to realize there are some strategies on which practitioners and the Office have very divergent views. Below I offer practitioners three recommendations to consider when preparing responses to Office Actions, followed by two recommendations for the Office to consider to improve examination.

### **Recommendation 1 for Practitioners: Consider Conceding What Must Be Conceded**

Some practitioners have an aversion to conceding anything in a response to an Office Action, but in my view a failure to concede what reasonably must be conceded detracts from the credibility of a response. During a panel discussion in 1997, now-retired Board member T. Jeffrey Quinn said:

Avoid dubious assertions. Every case, like it or not, has its weaknesses, and denying those weaknesses is an ineffective tactic. If you have a likelihood of confusion case and the case involves similar-but-not-identical marks and you have different goods, a bull-headed insistence that the marks are totally dissimilar is frankly annoying to the TTAB. . . .

I think it is important to avoid the dubious assertions. It is best to acknowledge the weaknesses in your case. Admit frankly when there is some similarity in the marks, but then proceed to your strongest argument. In the example I just gave you, the goods are different, so I think that is what you have to hammer on.

Admitting a weakness in a case makes the strong points of your case more compelling. In owning up to the weaknesses, you show you have made a fair assessment of the record. We all know that briefs and oral hearings are not necessarily the most objective exercises, but a frank admission tells me that you have looked at the evidence and you have made a fair assessment. I think it gives you credibility on the close points in a case. If you are believable and you have conceded some of the weak points, the close points are more believable, and it adds credibility to the entire package that you present to the TTAB.

David W. Ehrlich, Richard A. Friedman, Donna L. Mirman, and T. Jeffrey Quinn, *Trademark Prosecution in the Patent and Trademark Office and Litigation in the Trademark Trial and Appeal Board*, 8 Fordham Intell. Prop. Media & Ent. L.J. 451, 469-70 (1997).

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That is also good advice for counsel responding to an Office Action. When I was an examining attorney, I for one found the most persuasive responses to be those that conceded what was necessary while focusing on the most reasonable arguments in the applicant's favor. In private practice, I have even sometimes gone out of my way to concede a minor point while stressing a stronger argument in the applicant's favor. Examining attorneys see the same misplaced arguments day in and day out, so it is refreshing when counsel demonstrates some sense of realism.

**Recommendation 2 for Practitioners: Consider Omitting that Argument that the Applicant's Goods or Registrant's Goods Are in Reality Narrower than Identified**

The basic idea here is that if, say, the goods in an applicant's application and a cited registration are both identified as "furniture," counsel might present evidence that in reality the applicant's goods are expensive, hand-crafted desks whereas the registrant's goods are ordinary tie racks, and therefore the goods are not related under the second *DuPont* factor. But there are dozens of precedential decisions going back decades clearly holding that the relevant analysis looks to the goods as identified in the application and cited registration, and not what they may be in the real world. This was described as "settled law" more than forty years ago:

When assessing likelihood of confusion in cases such as this, the Board must base its determinations on goods as they are described in applications for registration and in registrations cited adversely to such applications. This, as the Examining Attorney has pointed out, is settled law.

*In re Pellerin Milnor Corp.*, 221 U.S.P.Q. 558, 559 (T.T.A.B. 1983).

So why do even experienced practitioners persist in making this argument to examining attorneys? In speaking to people over the years, the argument appears rooted in a hope that real-world facts might "sway" an examining attorney. But considering that the argument is asking an examining attorney to disregard longstanding precedent of which they are all well aware, in my view the chances of "swaying" an examining attorney are near zero. Conversely, the chances are high that an examining attorney seeing this argument will think to himself or herself, "Counsel is either ignorant of this basic principle or, worse, counsel is willing to advance an argument despite knowing it's legally untenable." In either event, I suspect the examining attorney is likely to take less seriously the other arguments in the response.

Practitioners would do well to remember that examining attorneys (and the Board) see the same untenable arguments *all the time*, and it can be frustrating:

In innumerable cases, the Board hears arguments about how the parties' *actual* goods, services, customers, trade channels, and conditions of sale are narrower or different from the goods and services identified in the applications and registrations. But as stated in equally innumerable decisions of our primary reviewing court, we may consider any such restrictions only if they are included in the identification of goods or services.

*In re FCA US, LLC*, 126 U.S.P.Q.2d 1214, 1217 n.18 (T.T.A.B. 2018), *aff'd*, 778 F. App'x 962 (Fed. Cir. 2019). Put yourself in the shoes of the examining attorney: how would you evaluate a response that makes the same bad argument you must shoot down every day?

**Recommendation 3 for Practitioners: Consider Whether It Is Really Worthwhile to Make the “Consistency” Argument**

Many practitioners look at how a term, ABC, has been treated in third-party registrations and will argue to an examining attorney that because ABC has been registered by others on the Principal Register without resort to Section 2(f) or a disclaimer, the examining attorney should act consistently by treating ABC in the same manner in the applicant's mark. There is nothing improper in making this argument. However, while it is intuitive and logical, it is my opinion that in the vast majority of situations the cost of locating, summarizing, and properly making of record such third-party registrations greatly outweighs their persuasive value.

This goes against what many practitioners have been taught and some may instinctively recoil from this suggestion, but the reality is that this “consistency” argument is given little weight by examining attorneys. One of the more frequently cited cases in this area is *Nett Designs*:

Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that [applicant] submitted to the examiner . . .

*In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001). In practice, the consistency argument rarely if ever carries the day and is often dismissed with a form paragraph or other citation to the many cases addressing the issue. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009) (“Even if all of the third-party registrations [referenced by applicant] should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant's marks.”); *In re Styleclick.com Inc.*, 58 U.S.P.Q.2d 1523, 1526 (T.T.A.B. 2001) (“These [third-party] registrations offer little help in making a determination of the merits in this appeal. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether *applicant's mark* is merely descriptive.”).

The consistency argument will likely fall on deaf ears even where the inconsistency is with the applicant's own prior registrations:

[W]e acknowledge, as Applicant has pointed out, that its prior registrations “have registered in the past without disclaimers.” While we recognize that “consistency

is highly desirable,” consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.

*In re Am. Furniture Warehouse CO*, 126 U.S.P.Q.2d 1400, 1407 (T.T.A.B. 2018) (citations and footnote omitted).<sup>2</sup>

I happen to agree with the following comment the Board made some time ago to the effect that applicants should focus on application of the law to the facts of record:

The fact that a few third-party registrations have been allowed over a long period of time hardly establishes current Office policy. There may very well be as many or more abandoned applications wherein registration was refused on similar records. The Board’s responsibility is to focus on the record at hand. We do not think it a useful exercise for applicants and examining attorneys to spend inordinate resources combing through large numbers of registration or abandoned application files when application of the law to the record at hand should suffice.

*In re First Draft, Inc.*, 76 U.S.P.Q.2d 1183, 1188 n.10 (T.T.A.B. 2005). Barring exceptional circumstances, I suggest focusing on the examining attorney’s stated rationale for the refusal/requirement as well as any evidence provided, and not waste time delving into third-party registrations. If the applicant’s mark is extremely important, then it might be worth exploring and relying on third-party registrations if they strongly tilt in the applicant’s favor, but I submit that in most cases the juice is just not worth the squeeze.

**Recommendation 1 for the Office: Consider Expanding on TMEP § 1207.01(a)(vi)  
Regarding Evidence of Relatedness and Improving Training on this Issue**

It appears the Office has made a decision to have examining attorneys switch from third-party registrations to third-party websites as the primary means to support a relatedness finding under the second *DuPont* factor. The go-to form paragraph is:

The attached Internet evidence, consisting of \_\_\_\_\_, establishes that the same entity commonly manufactures, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark. Thus, applicant’s and registrant’s goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92

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<sup>2</sup> An exception is that the Office may not require a disclaimer on a ground foreclosed by incontestability. *See In re The Am. Sail Training Ass’n*, 230 U.S.P.Q. 879, 880 (T.T.A.B. 1986) (“we think the requirement by the Office to disclaim ‘TALL SHIPS’ as an unregistrable component of the mark ‘RETURN OF THE TALL SHIPS’ constitutes a collateral attack on the registered mark which is impermissible”); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985). Another exception, possibly, is where inconsistent examination is truly egregious. *See In re The Random Acts of Kindness Found.*, Serial Nos. 87245967, 87245971, 87245973, and 87245975 (T.T.A.B. February 15, 2019) (non-precedential). On a very peculiar set of facts, the Board in *Random Acts* reversed a refusal because “[t]o find otherwise would result in inconsistent examination.” *Id.* at \*17.

USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Most examining attorneys identify three websites in the blank above and attach printouts to the Office Action. To their credit, some examining attorneys include more than three but three appears to be the norm.

The problem is that this short form paragraph obscures multiple issues that directly bear on whether such websites are relevant and, if so, their probative value. Some of the potential problems with third-party websites are discussed below, and I would say that most of the evidence I see attached to Office Actions suffers from one or more of these defects.

1. Do the third-party websites actually show both applicant's identified goods and registrant's identified goods?

As a starting point for evaluating third-party website evidence, “we must determine the nature of the [goods and] services that are offered, and decide whether they fall within the full scope of the language in the involved identifications.” *In re OSF Healthcare Sys.*, 2023 U.S.P.Q.2d 1089, \*8 (T.T.A.B. 2023). In *OSF*, the Board faulted the examining attorney because she “effectively broadened and generalized [the applicant's Class 44] identification of services and submitted evidence addressed to the broader identification, not the actual one.” *Id.* at \*10. After reviewing the examining attorney's six websites, the Board found that “the record contains, at most, one relevant third-party website . . . as support for the Examining Attorney's argument that Applicant's Class 44 services commonly emanate from the same source as either of the services identified in the cited registration.” *Id.* at \*11. *See also In re Princeton Tectonics, Inc.*, 95 U.S.P.Q.2d 1509, 1511 (T.T.A.B. 2010) (“Turning to the website evidence, we likewise find the evidence not probative of the relatedness of personal headlamps and electric lighting fixtures. Here also, the evidence generally . . . fails to identify the particular types of goods at issue here . . .”).

Usually at least one of the three websites relied upon in an Office Action does not show both sets of goods, and it is not unusual for all three to fail to do so.

2. If the third-party websites show both applicant's goods and registrant's goods, do the websites show the goods sold “under the same mark” as the form paragraph asserts?

Based on my experience, they often do not. Having said that, Federal Circuit precedent seems quite clear that the fact that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002). *See also Naterra Int'l, Inc. v. Bensalem*, \_\_ F.4th \_\_, \_\_, 2024 U.S.P.Q.2d 293, at \*3 (Fed. Cir. 2024) (“testimony that third-party companies sell both types of goods is pertinent to the relatedness of the goods”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1328 (Fed. Cir. 2000) (“evidence that several large companies produce and sell both pet and human food . . . seems extremely pertinent” to the relatedness inquiry).

So the fact that third parties manufacture and sell both types of goods, albeit under different marks, is relevant to the relatedness inquiry. But how relevant? It stands to reason that if a third party is manufacturing and selling both sets of goods under the same mark, that should be *more* probative of relatedness than the same party's offering of both sets of goods under different marks. The Board appeared to allude to this distinction in a case where one party's goods were "ice cream" and the other party's goods were "pharmaceutical preparations for use as an expectorant." Analyzing the second *DuPont* factor, the Board observed that "the record is devoid of any evidence that a single entity produces both ice cream and a pharmaceutical, *let alone under the same mark.*" *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2d 1464, 1471 (T.T.A.B. 2016) (emphasis added). Indeed, in some cases the Board has declined to consider an examining attorney's website evidence showing a third party offering both sets of goods but under different marks. *See, e.g., In re Masco Canada Ltd.*, Serial No. 88619996, at \*7 (T.T.A.B. August 4, 2021) (non-precedential) (declining to consider two websites where the relevant goods were "offered for sale under different marks on different webpages"); *In re Lonely Hearts Club Ltd.*, Serial Nos. 79174419 and 79176727, at \*4 n.8 (T.T.A.B. November 15, 2017) (non-precedential) ("We have not considered, for this purpose, the web pages attached to the Office Action of October 6, 2016, because those web pages do not show (or it is not clear that they show) that the different goods are offered under the same mark. Rather, they show websites that offer both types of goods, but they are goods of various different brands.").

3. If the third-party websites show both applicant's goods and registrant's goods sold under the same mark, is it a house mark?

Marks that are used or registered in connection with a wide variety of goods are entitled to little or no probative value. *See, e.g., In re HerbalScience Group LLC*, 96 U.S.P.Q.2d 1321, 1323 n.3 (T.T.A.B. 2010) ("Some of the registrations made of record by the examining attorney have little or no probative value because, for example, they are for house marks..."). As the Board stated in another case with respect to third-party websites:

Third-party registrations in the nature of house marks used for a wide variety of items are of little value by themselves to show that the various goods for which they are registered are all related. Similarly, here where the website evidence shows house marks used on a wide variety of goods, it is not so probative of this factor.

*In re Marko Schuhfabrik GmbH*, Serial No. 79040612, at \*9 (T.T.A.B. December 23, 2009) (non-precedential).

4. If the third-party websites show both applicant's goods and registrant's goods sold under different marks, does the website sell a wide variety of goods?

Another common problem with third-party website evidence attached to Office Actions is that it may show both sets of goods but they are offered by mass retailers. "It has long been held that the mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for a finding that the goods are

related.” *Morgan Creek Prods., Inc. v. Foria Int’l, Inc.*, 91 U.S.P.Q.2d 1134, 1142 (T.T.A.B. 2009). See also *In re Princeton Tectonics, Inc.*, 95 U.S.P.Q.2d 1509, 1511 (T.T.A.B. 2010) (“Turning to the website evidence, we likewise find the evidence not probative of the relatedness of personal headlamps and electric lighting fixtures. Here also, the evidence . . . is from sources which sell a broad range of varied and unrelated goods online.”).

In another case the Board applied this principle to online retailers:

The Examining Attorney’s use evidence does not support the relatedness of Applicant’s drinking vessels and insulated containers and Registrants’ clothing and stationery goods. The Board has long recognized that “[n]ot everything that is sold by a large retail establishment selling a plethora of otherwise unrelated goods is necessarily connected, within the meaning of § 2(d) of the Act, to every other product that happens to be displayed or offered under the same roof,” and that principle applies with equal force to online retailers. The mere fact that some of the goods identified in the application and registration are available through common online channels of trade in which a host of other goods are also sold does not show that the identified goods are related.

*In re Sérgio Tsugumiti Kobayashi*, Serial No. 88073552, at \*11 (T.T.A.B. November 3, 2020) (non-precedential; citation omitted).

On the other hand, evidence showing the two sets of goods offered by the same *specialty* retailers may be sufficient to establish relatedness. See, e.g., *In re Ox Paperboard, LLC*, 2020 U.S.P.Q.2d 10878, at \*6 (T.T.A.B. 2020) (“This evidence is not from ‘big box’ retail stores or online retailers selling a wide variety of goods, but rather from specialty retailers. This targeted type of retailing is narrower in scope, and the fact that more targeted sellers offer goods of both the Registrant and the Applicant tells us that the goods are related.”).

5. How many third-party websites are attached to the Office Action?

As stated above, the Office’s form paragraph asserts that the third-party website evidence establishes that the same entity “commonly” provides the relevant goods, and that typically Office Actions rely on three websites. However, three websites do not appear sufficient to show what *commonly* occurs:

Ultimately, only three webpages support the Examining Attorney’s position that Applicant’s goods and Registrant’s [goods] are related. . . . These limited submissions are not enough, by themselves, to establish that the goods identified in the application on the one hand, and in the cited registrations, on the other, would be perceived by consumers as emanating from a single source.

*In re Masco Canada Ltd.*, Serial No. 88619996, at \*7 (T.T.A.B. August 4, 2021) (non-precedential). See also *In re Pfanner Schutzbekleidung GmbH*, Serial No. 79247130, at \*12 (T.T.A.B. August 5, 2021) (non-precedential) (“three examples of entities selling both

[applicant’s] protective sporting gear and [registrant’s] underwear or loungewear is not sufficient to prove protective clothing and protective sporting gear are related to underwear or loungewear.”).

6. Do the third-party websites show products that are a company’s core product line or merely promotional items?

The Board may accord third-party websites little or no probative value if they show goods offered by a company as promotional or collateral goods, as opposed to that party’s core product line:

We accord lesser probative value to the evidence from the Stihl website (stihl.com) because Stihl advertises its t-shirts as promotional items (“Perfect to show you are a STIHL fan”) rather than as a core product line. It is common knowledge that many companies across many fields promote their goods and services through the sale or distribution of promotional items such as t-shirts, mugs, hats, etc.

*In re Pfanner Schutzbekleidung GmbH*, Serial No. 79247130, at \*10 n.10 (T.T.A.B. August 5, 2021) (non-precedential; citation to record omitted). Likewise, in another case the Board observed:

A number of the well-known designers listed by the Examining Attorney (i.e., Kate Spade, Brooks Brothers, Lilly Pulitzer, Louis Vuitton, and Ralph Lauren) are known for their clothing, designer bags, accessories and the like. The fact that they may also provide various miscellaneous items, such as water bottles or other knick-knacks, does not make them related to the company’s primary goods. Indeed, there is no evidence of record showing that consumers would be aware that these companies provide such goods without actually searching for them.

*In re Sérgio Tsugumiti Kobayashi*, Serial No. 88073552, at \*11-12 (T.T.A.B. November 3, 2020) (non-precedential).

The discussion above is not intended to be the definitive treatment of third-party website evidence. Rather, the point is that the form paragraph employed by the Office obscures a number of critical considerations and the two general paragraphs in T.M.E.P. § 1207.01(a)(vi) do not, in my view, do justice to this important issue that is a major point of contention in many likelihood-of-confusion refusals. I therefore submit that both examining attorneys and applicants would benefit if the Office were to flesh out its views in that TMEP section and implement additional training on this issue.

**Recommendation 2 for the Office: Consider Reviewing and Revising the Form Paragraphs**

Consider the hypothetical paragraph below that an applicant might include in a response. I made up this paragraph but it is a type of argument I recall seeing frequently as an examining attorney:



The addition of a term to a registered mark is sufficient to render the marks dissimilar under the first *DuPont* factor, thereby precluding a likelihood of confusion. See *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (C.C.P.A. 1973) (no likelihood of confusion between SILK and SILK ‘N SATIN); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970) (no likelihood of confusion between PEAK and PEAK PERIOD); *In re White Rock Distilleries, Inc.*, 92 U.S.P.Q.2d 1282 (T.T.A.B. 2009) (no likelihood of confusion between VOLTA and TERZA VOLTA & Design); *Knight Textile Corp. v. Jones Inv. Co.*, 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005) (no likelihood of confusion between ESSENTIALS and NORTON MCNAUGHTON ESSENTIALS).

Everyone will immediately see the flaw in this paragraph: the four cited decisions were based on whatever facts were of record in those cases and the results in no way support the proposition for which they are cited.

Now consider the following form paragraph, which the Office currently uses and has in one incarnation or another been using for decades:

Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (holding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Here, too, the four cited decisions – *Wella*, *Coca-Cola*, *Double Coin*, and *Mr. Recipe* – do not support the proposition for which they are cited, and in fact the form paragraph obliterates the nuance found in *Wella*:

When one incorporates the entire *arbitrary* mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element *will not necessarily preclude* a likelihood of confusion.

*Wella*, 558 F.2d at 1022 (emphasis added). The court’s decision in *Coca-Cola* was similarly nuanced:

When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive

element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion.

*Coca-Cola*, 526 F.2d at 557. The Board's decision in *Double Coin* also did not purport to lay down or apply any categorical rule:

While there is no explicit rule that the marks are automatically similar because [respondent's] junior mark, ROAD WARRIOR, contains [petitioner's] entire mark WARRIOR, "[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another."

*Double Coin*, 2019 U.S.P.Q.2d at \*6-7 (citation omitted). The Board did observe that a likelihood of confusion has "often" been found where one mark incorporates another, but it specifically disclaimed the existence of any rule and went on to explain why the two marks at issue in that case were similar (finding ROAD to be "weak as a source identifier in connection with tires," *id.* at \*7). And finally, *Mr. Recipe* did not purport to adopt or apply a categorical rule:

[W]hile there is no explicit rule that we find marks to be similar where Applicant's mark [JAWS DEVOUR YOUR HUNGER] contains in part the whole of the mark [JAWS] in the cited registration, the fact that the cited registered mark is incorporated in full in Applicant's mark increases the similarity between the two because, in this case, the addition of the phrase "Devour Your Hunger" calls to mind the shark from the JAWS movies.

*Mr. Recipe*, 118 U.S.P.Q.2d at 1090 (emphasis added).

In other words, it is always a question of fact whether two marks – one incorporating the other – are similar or dissimilar under the first *DuPont* factor, and there is no rule of law that "[i]ncorporating the entirety of one mark within another does not obviate the similarity between the compared marks." See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1344 (Fed. Cir. 2004) (citation omitted) (noting its precedent shows "the determination is highly fact-specific" and has "even 'illustrate[d] the fact-dependency' of determining whether non-identical marks are sufficiently similar by listing cases falling on both sides."); *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (comparing two marks under the first *DuPont* factor is a "fact-specific inquiry"). As the Board stated in another case:

[W]e recognize that the whole of applicant's mark is encompassed within the cited registration and that is a consideration which will often bespeak likelihood of confusion. However, a number of factors must be examined in Section 2(d) evaluations and such a result does not necessarily follow where, as here, descriptive, highly suggestive or frequently used common elements are present.

*In re August Storck KG*, 218 U.S.P.Q. 823, 826 (T.T.A.B. 1983). See also J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:41 (5th ed., December 2023) ("there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark.").

The observation in the Board's case law that likelihood of confusion is often found where one mark incorporates another has regrettably transmogrified into the form paragraph's assertion of a non-existent rule that "[i]ncorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d)." Certainly the fact that one mark incorporates another may, depending on the circumstances, be highly relevant in comparing the marks under the first *DuPont* factor, but it is always a fact-specific inquiry. I hope the Office will consider revising this form paragraph and perhaps undertake an audit to address other questionable form paragraphs.