



# The Trademark Prosecution Review

2024

**Specialist Chapter: Recent USPTO  
decisions shift understanding of  
related goods and services in the  
United States**



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# Specialist Chapter: Recent USPTO decisions shift understanding of related goods and services in the United States

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## Summary

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## IN SUMMARY

This article discusses the growing trend in the United States Patent and Trademark Office (USPTO) of examiners using third-party evidence to take more expansive views of what goods and services are considered related for likelihood of confusion purposes. Practitioners will need to be mindful of this when advising clients on potential obstacles to registering their marks.

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## DISCUSSION POINTS

- Background of the USPTO's historical view on what are related goods and services
  - A review of recent decisions illustrating the closing gap between related goods
  - Strategic implications of this recent development
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## REFERENCED IN THIS ARTICLE

- *In re E I Du Pont de Nemours & Co*
  - Trademark Manual of Examining Procedure
  - *In re Salvation Nutraceuticals Inc*
  - *In re Wella Operations US, LLC*
  - *In re Caymus Vineyards*
  - *In re RS Lipman Brewing Company, LLC*
  - *In re 1729 Investments LLC*
  - *In re Appalachian Headwaters, Inc*
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## INTRODUCTION

The review of an application by the United States Patent and Trademark Office (USPTO) includes a search for prior registered or currently pending marks that are sufficiently similar to the applied-for mark such that there is a likelihood that consumers would be confused if both marks were registered.<sup>[1]</sup> In evaluating the likelihood of consumer confusion between two marks, the examining attorney uses a 13-factor test developed in *In re E I Du Pont de Nemours & Co*, known as the DuPont factors.<sup>[2]</sup> Three of the key factors are:

- the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; and
- the similarity or dissimilarity of established, likely-to-continue trade channels.

To satisfy their burden of evaluating the relatedness of the goods and services covered by a pending application and a prior-filed application or registration, examiners regularly seek out and rely on third-party registrations covering both the goods claimed in an application and those covered by an existing registration to determine whether the goods or services



are related. Examiners will also search for third-party internet evidence for the same reason, namely to see whether the same companies offer both the applicant's and the registrant's goods and services.

Under the Trademark Manual of Examining Procedure, these registrations or third-party internet results are evidence that consumers are used to seeing the applicant's and the registrant's goods and services offered by the same source, whether or not there is evidence of actual use in the same trade channels.<sup>[3]</sup> In Trademark Trial and Appeal Board (TTAB) proceedings, parties are permitted to submit third-party registrations to serve as evidence to support that goods and services are related.<sup>[4]</sup>

The increase in single companies offering an ever-growing range of goods and services, particularly in connection with broad-scale licensing programmes, coupled with the widespread availability of third-party evidence showing this wide range of offerings, only makes it more likely that an examiner will find evidence that the goods are 'related' based on third-party evidence.<sup>[5]</sup> Practitioners need to do similar searches to those an examiner might do in order to fully understand the landscape in which their client's applications exist, and better advise their client on potential obstacles to registration. Trademark clearance for registration thus has to take into account not only direct competitors, but also maybe-related goods that may be offered under the same marks – an objection that is becoming more common. This may be at odds with general brand strategy as trademarks that might face obstacles to registration may still be available for use with tolerable risk in the absence of direct competition.

### **RECENT USPTO DECISIONS HIGHLIGHT HOW GOODS MAY BE RELATED BASED ON THIRD-PARTY REGISTRATIONS**

Recently, the USPTO has found a wider range of goods and services to be related for the purposes of determining whether there is a likelihood of confusion between two marks during prosecution. This development can be seen in a number of recent ex parte decisions at the TTAB.

For example, the gap between supplements and personal care products has narrowed. In *In re Salvation Nutraceuticals Inc.*, the applicant sought to register the mark KUDO (Serial No. 97015288) for 'Gummy vitamins; Nutritional supplements in the form of gummies'. The USPTO refused registration on the basis of likelihood of confusion with the registration KUDOS (Registration No. 2363076) for 'Hair shampoo, hair conditioner, soap for hands, face and body, skin/body moisturizer, skin/body lotion, shaving preparations, body/hand cream, skin cleansing cream, and bath gels/oil'. The registrant's goods were neither ingestible nor supplements, in contrast with the gummies sought to be covered by the applicant's mark. Specifically, the examiner focused on the fact that 'vitamins and nutritional supplements are often made and sold by companies that also make and sell skincare preparations and personal care products for the hair, hands, face, and body'. In support of this reasoning, the examiner provided internet evidence that consisted of (1) internet evidence in the form of 20 examples of at least 18 companies and (2) 20 third-party use-based registrations that cover and offer both supplements and personal care products. To refute this, the applicant provided evidence that topical and consumable goods are typically separated to:

[prevent] consumers from believing that the consumable goods somehow contain similar ingredients or characteristics as the topical products, which



can contain toxins or other undesirable ingredients to consume and allows the companies to market the products with different message.<sup>[6]</sup>

In this case, the finding of relatedness turned on the examiner identifying third parties that offered both categories of goods at issue. On appeal, the Board agreed with the examiner's holding that there was a likelihood of confusion and gave applicant's evidence and argument little weight. The TTAB indicated that, in general, the applicant's type of evidence is insufficient to show that both the applicant's and the registrant's goods together are not offered under one mark.

In *In re Wella Operations US, LLC*, the Board found that goods potentially serving a similar purpose could be sufficiently related to support a refusal given the similarities between the marks. The applicant's mark was TRI-FLEX TECHNOLOGY (Serial No. 97401927) for 'nail care preparations, nail strengtheners, non-medicated nail treatment preparations for cosmetic purposes, nail polish, nail color gels, nail lacquers, none of the foregoing containing collagen'. The cited mark was COLLAGEN TRI-FLEX & Design (Registration No. 6035483) registered for 'dietary supplements for humans containing Types I, II, and III Collagen'. Despite the applicant's restriction excluding collagen, the Board agreed with the examiner's finding that the goods were 'complementary' of each other and therefore related. The Board focused on the products serving the same purpose – nail strengthening and decreasing nail breakage, whether supplements or nail polish, with or without collagen – in determining that the goods were related for likelihood of confusion purposes.<sup>[7]</sup>

The USPTO has also found that third-party evidence can bridge the traditional gap between beverages and restaurant services. Past decisions in cases involving restaurant and beverages indicated that applicants need to show 'something more' than the mere fact that the goods and services are used together to create a presumption of likelihood of confusion.<sup>[8]</sup> That 'something more' had to indicate that consumers would understand such services and goods to emanate from the same source. It could be shown through evidence of actual use of a mark for both the goods and services at issue and evidence of a large number of third-party registrations covering both the goods and services at issue. Recently, however, the Board has appeared to move away from requiring 'something more' to be proven in to find a likelihood of confusion in cases where food and beverages and restaurant and bar services are involved.

The Board concluded in a couple of recent decisions that wine and bar services are related, as are beer and restaurant services. In *In re Caymus Vineyards*, the Board held that TABLEAU (Serial No. 97040804) for wines was confusingly similar to TABLEAU (Registration No. 3381539) for 'restaurant and bar services; cocktail lounges'. In this proceeding, the applicant unsuccessfully argued that there has to be 'something more' than the mere fact that the goods and services might be used together, including taking into account marketplace considerations such that most restaurants and bars do not have private label wines. The Board agreed with the examiner, stating that the offered evidence demonstrated that 'consumers encounter wine under the same mark as restaurant services' and that 'something more' was not necessary to show relatedness given 'an inherent relationship between Registrant's bar services and cocktail lounges and Applicant's wine'. At the same time, the Board went on to say that though 'something more' was not necessary here, the extrinsic evidence presented by the examiner indeed established that 'something more' existed, demonstrating that the goods and services were related.



The Board reached a similar decision in *In re RS Lipman Brewing Company, LLC*. There, the applicant's mark was CHICKEN SCRATCH (Serial No. 90694523) for beer and the cited mark was CHICKEN SCRATCH (Registration No. 4812467) for restaurant services. The applicant argued that under the prior case law, 'something more' was needed to connect the marks, but the Board concluded that the growing popularity of the 'brewpubs' market segment within the craft beer industry suggested the goods and services are related.<sup>[9]</sup>

In direct contrast to both of these registration refusals, in *In re 1729 Investments LLC*, the TTAB found that wine and restaurant services were unrelated.<sup>[10]</sup> The applicant's mark was RAO'S (Serial No. 90694523) for wine, and the cited marks were RAO'S in standard character and stylised form for restaurant services. The TTAB reversed the registration refusal, holding that the 31 active third-party registrations submitted by the examiner were not sufficient alone to establish 'something more' for likelihood of confusion purposes. The Board also found that additional evidence submitted by the examiner of 13 wineries that have on-site restaurants bearing the same name as their wines did not demonstrate 'something more'. Instead, it found that:

the internet evidence overall does not support the Examining Attorney's position that it is common for regular restaurants to offer house-branded wine under the same name as its restaurant, or, for that matter, even wineries to offer on-site restaurants with the same name as the winery-branded wine.

'Some of the website evidence (four wineries and the Food & Wine website article excerpt) have little or no probative value as to whether the same names are used for the wines produced by the winery and the restaurant, or even as to whether an on-site restaurant is offered,' either because they did not show that the referenced establishments were restaurants, or because they did not clearly indicate whether the wine offered and the restaurant in question shared the same name. Of the remaining nine registrations, three showed restaurants using the same name as the wines produced by the winery, while four clearly showed that the wineries did not use the same names for wines and the winery restaurant, and another two indicated that the food services offered at the winery were not named at all.

While virtually similar case law was cited in arguments in both the *1789 Investments* and *Caymus Vineyards* cases, the Board reached diametrically opposed conclusions. Due to these inconsistencies, therefore, the more conservative approach is to assume that the USPTO will find food and beverage products to be related to food and beverage services, even if consumers are not likely to be confused in the real world.

In another recent decision relating to services, *In re Appalachian Headwaters, Inc*, the Board held summer camps and primary schools were related.<sup>[11]</sup> It found that evidence from six third-party websites demonstrating that educational services and summer camp services are offered by the parties was sufficient to establish that the involved services 'are offered in the same channels of trade to the same consumers and, therefore, this DuPont factor weighs in favor of finding a likelihood of confusion'.

Some additional non-precedential cases where the Board found goods and services to be related include:

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*In re C&D Brewing Ventures, Inc, Serial No. 88935220 (26 March 2024): finding soda pop and beer to be related based on 10 use-based third-party registrations and nine third-party websites;*

- *In re AVR Realty Company, LLC, Serial No. 90699970 (25 September 2023): finding houseware, baked goods, coffee beans and retail services to be related to tote bags and shirts based on the examiner's contentions that applicant's goods and services are related because it is common for the same entity to manufacture, produce or provide the relevant goods and services, in addition to evidence of seven third-party websites;*
- *In re Surf Ready Fitness, Serial No. 90548268 (21 June 2023): finding physical fitness training services to be related to clothing based on 10 use-based third-party registrations and seven third-party websites;*
- *In re Jordan Saglio, Serial No. 88593965 (31 May 2022): finding entertainment services featuring travel and sustainable living, to be related to clothing based on 30 use-based third-party registrations and seven third-party websites; and*
- *In re Zeta Tau Alpha Sorority, Serial No. 90090117 (29 August 2022): finding jewellery and clothing, to be related to mugs, cups, bottles, drinkware and tableware based on 15 use-based third-party registrations and eight third-party websites.*

These recent decisions highlight the USPTO and TTAB's view of what qualifies as related goods and services based on third-party evidence.

E-commerce and concentrated retail environments have complicated this factor even more, as goods that may initially seem unrelated are available for purchase through similar channels. While by no means a dispositive inquiry, the physical proximity of goods within a store (ie, whether or not they are likely to appear on shelves next to each other) is one factor considered in a likelihood of confusion analysis.<sup>[12]</sup> While modern consumers are aware that many unrelated goods are sold near each other in megastores such as Walmart and Target, or may appear on linked together webpages in online retail marketplaces such as Amazon, the blurring of how closely related goods need to be to each other in order to appear 'near' each other in e-commerce may make it harder to draw clear distinctions as to which goods are unrelated.

A classic example of this blurring is Amazon's expansion from an e-commerce site selling books to a platform offering every good imaginable in addition to having grocery, pharmacy and even an entertainment division that makes its own original movies and shows. Furthermore, as consumer perceptions about what range of goods and services a single business might sell and offers change, and consumers grow to recognise that one company may have a presence in a wide range of markets and industries, the conception of what is a related good and service will likely only continue to grow. Not too long ago it may have been odd to imagine, for example, nail polish and dietary supplements being sold by the same company under the same or a similar mark. Now, since several examples can be found, the USPTO may more regularly consider these goods related.

### **PRACTITIONERS NEED TO THINK LIKE EXAMINERS AND CONSIDER MORE 'RELATED GOODS'**

Given the expansive view of related goods and services, practitioners should consider adopting a similarly expansive view of related goods when advising clients, and consider



what an examiner may find, even when goods and services initially seem quite disparate. For instance, examiners will search the web to see whether it is common for one company to offer goods and services of these seemingly different types under the same mark. An examiner will also look to third-party registrations to see if there are third party registrations that cover both types of goods, even though they are not obviously aligned. The TTAB will likely accept evidence of this sort. Attorneys reviewing a search for a mark for nutritional supplement gummies might not be concerned about a similar mark for personal care products and might be surprised to find that gummy vitamins may be viewed as sufficiently related to shampoo and bath gels and oils to provide the basis for a refusal. However, by searching for marks that cover both these items, to better anticipate potential likelihood of confusion refusals, practitioners can give more accurate advice to their clients.<sup>[13]</sup>

As a practical matter, practitioners may wish to advise clients that they may receive likelihood of confusion refusals if there is sufficient evidence both in common law and based on active third-party registrations of relatedness between the respective goods and services. The more evidence an examiner is able to find to show goods and services are related, the more difficult the refusal will be to overcome.

### Endnotes

[1] <https://www.uspto.gov/trademarks/additional-guidance-and-resources/possible-grounds-refusal-mark>.

[2] In re E I Du Pont de Nemours & Co, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

[3] Trademark Manual of Examining Procedure section 1207.01(d)(iii).

[4] Trademark Trial and Appeal Board Manual of Procedure 704.03(b)(1)(B) Third-Party Registration.

[5] Despite recent United States Patent and Trademark Office (USPTO) audits and other efforts to ensure that mock-up and fake specimens do not get used to support the registration of trademarks that are not actually in use on all the claimed goods, there are still marks registered on the basis of use that cover a wide array of goods, including completely disparate goods that are not likely actually offered – even under a robust licensing programme. This means it is increasingly likely that an examiner will find multiple examples of third-party marks to support a relatedness refusal.

[6] In re Salvation Nutraceuticals Inc., Serial No. 97015288 (8 March 2024) [not precedential]; Finding gummy vitamins related to personal care products

[7] In re Wella Operations US, LLC, Serial No. 97401927 (20 February 2024) [not precedential]; finding nail strengthener not containing collagen to be related to dietary supplements containing collagen

[8] See, eg, In re St Helena Hosp, 774 F.3d at 754, 113 USPQ2d at 1087; Jacobs v Int'l Multifoods Corp, 668 F.2d 1234, 212 USPQ2d 641, 642 (CCPA 1982); In re Giovanni Food Co, Inc, 97 USPQ2d 1990, 1992 (TTAB 2011) ('relatedness of food services and food items is not to be assumed and that evidence sufficient to meet the "something more" standard is necessary') (citing In re Coors Brewing Co, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed Cir 2003)).



[\[9\]](#) In re RS Lipman Brewing Company, LLC, Serial No. 88209633 (3 May 2023) finding beer and restaurant services to be related.

[\[10\]](#) In re 1729 Investments LLC, Serial No. 90694523 (24 April 2023) [not precedential].

[\[11\]](#) In re Appalachian Headwaters, Inc, Application Serial No. 90448759 (21 March 2023): finding summer camps and primary schools to be related.

[\[12\]](#) Section 24:45. Goods or services sold or used 'under the same roof', 3 McCarthy on Trademarks and Unfair Competition Section 24:45 (5th ed).

[\[13\]](#) The new USPTO search tool includes a 'coordinated class' search parameter that can be used to find results in classes the USPTO has coded as being 'coordinated', which thus have a higher likelihood of being considered "related" by the USPTO for likelihood of confusion purposes. For example, if a practitioner is conducting a search and selects coordinated class results in Class 25, the search will return marks in classes 14, 18, 24, 35 and 42.

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