

This Opinion is Not a
Precedent of the TTAB

Mailed: March 6, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Namchak Foundation

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Serial No. 97150350
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Thomas Carulli of KMA Zuckert,
for Namchak Foundation.

Shakeyla Flores, Trademark Examining Attorney, Law Office 129,
Pamela Y. Willis, Managing Attorney.¹

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Before Lykos, Cohen, and Stanley, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Namchak Foundation (“Applicant”) seeks to register on the Principal Register the standard character mark COMPASSION IN ACTION for, as amended, “Religious and spiritual services, namely, providing gatherings and retreats to develop and

¹ The original Trademark Examining Attorney assigned to this case was Anastasia Mebane.

enhance the spiritual lives of individuals interested in the teachings and practices of the Namchak Tibetan Buddhist Fellowship” in International Class 30.²

Registration was refused 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 COMPASSION IN ACTION on the Principal Register for “Religious and charitable services namely providing meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces” in International Class 41 that it is likely to cause confusion or mistake or to deceive.³

Applicant has appealed the final refusal which is fully briefed. For the reasons explained below, we reverse the refusal.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists 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

² Application Serial No. 97150350, filed December 1, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging August 1, 2021 as the date of first use anywhere and in commerce.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

³ Registration No. 2715067, registered on May 13, 2003 and renewed on April 2, 2024.

by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive.

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). “Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See *In re i.am.symbolic, LLC*,

866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and the others, are discussed below.

A. The Marks

The first *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

It is undisputed that Applicant’s and Registrant’s standard character marks COMPASSION IN ACTION are identical in appearance, sound, connotation and commercial impression. As standard character marks, they “have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406,

1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). The first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

B. The Services

Under the second *DuPont* factor, we compare the services as they are identified in the involved application and cited registration. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We also keep in mind that where the marks are identical as in the case here, the degree of similarity or relatedness between services needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d at 1411).

The services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). 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 the services emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant services are used together or used by the same purchasers;

advertisements showing that the relevant services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both an applicant's services (or similar services) and the services listed in the cited registration (or similar services). *See, e.g., Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

The Examining Attorney argues that the services are highly related.⁴ The Examining Attorney did not make of record any use-based third-party registrations for the same mark covering Applicant's and Registrant's identified services to support this position. *See, e.g., In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988). Instead, the Examining Attorney submitted printouts from the websites for East Lansing Catholics;⁵ The First United Methodist Church of Northville, Michigan;⁶ Vineyard Church Ann

⁴ We reject the interpretation of the identifications that Registrant's "religious services" necessarily encompasses Applicant's more specific religious services. The prefatory language in each identification does not control. The cited registration specifically lists "providing meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces" as the identified services.

⁵ September 12, 2022 Office Action at TSDR 7-9 and 17-20 (excerpts from elcatholics.org accessed on 9/12/2022).

⁶ *Id.* at TSDR 10-16 (excerpts from fumcnorthville.org accessed on 9/12/2022).

Harbor;⁷ Lake Shore Baptist Church;⁸ Beverly United Methodist Church;⁹ and Ladle Fellowship¹⁰ purporting to show that it is common for the same entity to provide Applicant's and Registrant's services under the same mark. The Examining Attorney contends that the website evidence shows "several religious organizations that offer religious worship and gathering services in addition to charitable services such as gift giving and providing meals and/or clothing to community members in need."¹¹

The Examining Attorney bears the burden of supporting the likelihood of confusion refusal with sufficient evidence. *See In re Planprint Co.*, 229 USPQ 621, 624 (TTAB 1986) (When "the Office's burden to demonstrate that confusion is likely has not been met ..., the mark is approved for publication ..."). Here, the Examining Attorney has not satisfied this burden. Setting aside that the submission of only six religious organization websites is unconvincing for purposes of showing that Applicant's and Registrant's services are sufficiently related such that consumers expect them to emanate from the same source, the Board has carefully reviewed each website, and contrary to the Examining Attorney's assertions, none of the websites show that the same entity provides both Applicant's "providing gatherings and retreats to develop and enhance the spiritual lives of individuals interested in the teachings and practices of the Namchak Tibetan Buddhist Fellowship" and

⁷ *Id.* at TSDR 21-31 (excerpts from annarborvineyard.org accessed on 9/12/2022).

⁸ April 27, 2023 Final Office Action at TSDR 7-11 (excerpts from www.lakeshorebaptist.org accessed on 4/27/2023).

⁹ *Id.* at TSDR 12-19 (excerpts from www.beverlymethodist.org accessed on 4/27/2023).

¹⁰ *Id.* at TSDR 20-25 (excerpts from ladlefellowship.org accessed on 4/27/2023).

¹¹ Examining Attorney's Brief, 8 TTABVUE 5.

Registrant's "providing meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces" under the same mark. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because none of the website evidence of record showed that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together).

In urging the Board to find that these six third-party websites show that religious organizations commonly provide charitable services, the Examining Attorney incorrectly conflates third-party website evidence with third-party registration evidence. We may assume that third-party registrations listing services without any further specification as to type encompass more specific services. *See Country Oven*, 2019 USPQ 443903, at *9 ("Just as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, we must consider the full scope of the goods and services described in a third-party registration."). While we can expand and give full scope to any services identified in a third-party registration, the same does not hold true for third-party website evidence. The fact that websites of various religious organizations offer charitable services as well is insufficient to demonstrate that each religious organization provides "gatherings and retreats to develop and enhance the spiritual lives of individuals interested in the teachings and practices of individuals interested in the

teachings and practices of the Namchak Tibetan Buddhist Fellowship” on the one hand, and “meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces” on the other, under the same mark. There is simply no evidence of record that Applicant’s and Registrant’s identified services are provided under the same mark by the same entity.

Based on the particular record in this appeal, Applicant’s services and Registrant’s services have not been shown to be related in order for us to weigh the second *DuPont* factor in support of a finding that confusion is likely. Perhaps on a more developed record, we would find otherwise. With no evidence to support a finding of relatedness, the second *DuPont* factor weighs strongly against finding a likelihood of confusion.

C. The Established, Likely-to-Continue Trade Channels

This brings us next to “the similarity or dissimilarity of established, likely-to-continue trade channels,” the third *DuPont* factor. The Examining Attorney relies on the same evidence discussed above to find that Applicant’s and Registrant’s services are offered in the same trade channels and to the same classes of consumers. This evidence suffers from the same deficiencies noted above. The third *DuPont* factor also weighs against finding a likelihood of confusion.

D. The Purchasing Conditions

Lastly, we consider the conditions under which the services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. Where

the relevant purchasers are sophisticated or tend to exercise a high degree of care in selecting a given type of service, that may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive services may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

We liken this appeal to *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016), where the purchasing conditions mitigate against finding a likelihood of confusion because of the nature of the services in both classes. In *Primrose*, the Board applied the “least sophisticated consumer” standard, reasoning that because “choices among various senior living options are made by families and people in all walks of life, at all levels of education and income[,] [w]e must therefore presume that Opposer’s and Applicant’s services are offered to both sophisticated and unsophisticated consumers, and that their purchasing decisions . . . range from thoughtful to hasty.” 122 USPQ2d at 1039. Nonetheless, the Board found that “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily.” *Id.*

Based on their intrinsic nature, we find that prospective consumers are likely to make careful and deliberate purchasing decisions when selecting “gatherings and

retreats to develop and enhance the spiritual lives of individuals interested in the teachings and practices of the Namchak Tibetan Buddhist Fellowship” and “providing meals for indigent people, residential care for homeless men, gifts for elderly shut-ins, gifts for patients in hospitals, rest homes and infirmaries, gifts for imprisoned persons, and gift packages to members of the armed forces.” The fourth *DuPont* factor therefore weighs to some extent against finding a likelihood of confusion.

II. Weighing the *DuPont* Factors¹²

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; “explain the results of that weighing;” and “the weight [we] assigned to the relevant factors.” *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. The marks are identical meaning that the first

¹² Contrary to Applicant’s assertions, the coexistence of other religious organizations with similar named denominations (e.g., St. John’s, St. Thomas) does not implicate the seventh and eighth *DuPont* factors, “the nature and extent of any actual confusion” and “the extent of the opportunity for actual confusion.” *DuPont*, 177 USPQ at 567. Those factors pertain to evidence of coexistence and lack of actual confusion with Applicant’s and Registrant’s mark COMPASSION IN ACTION, not entirely different marks. Likewise, Applicant’s arguments presented under the twelfth *DuPont* factor “the extent of potential confusion, i.e., whether de minimis or substantial,” *DuPont*, 177 USPQ at 567, do not fall under this factor. Rather, Applicant’s assertions that “the differences in the recited services, the carefulness of the ‘purchase’ and sophistication of the ‘buyer’ when it comes to religion, and the lack of any evidenced overlap of potential ‘consumers,’” Applicant’s Brief, 4 TTABVUE 24-25, implicates the final weighing analysis of each *DuPont* factor.

DuPont factor weighs heavily in favor of finding a likelihood of confusion. However, the Examining Attorney has fallen short of showing that Applicant's services are related to any of the services in the cited registration. Thus, the second factor weighs heavily against finding a likelihood of confusion. Likewise, the third and fourth *DuPont* factors weigh against finding a likelihood of confusion. Weighing these factors, we find that the second, third, and fourth factors outweigh the first factor. The evidence of record is insufficient to show that the circumstances surrounding the offering or marketing of Applicant's and Registrant's services are such that the relevant consumers would mistakenly believe that the respective services originate from the same source, even under the same mark. We therefore conclude that confusion is unlikely between Applicant's applied-for mark and the mark in the cited registration for the identified services.

Decision: The Section 2(d) refusal is reversed.