

The Trademark Reporter®



The Law Journal of the International Trademark Association

Recognizing the “Use”-fulness of Evidence at the TTAB

Lorelei D. Ritchie

Trade Dress Protection and Its Impact on Competition: An Attempt at an Empirical Approach

Dr. Xiaoren Wang

Commentary: Clearing Up Some Confusion About Dilution: A Reply to Hal Poret

Barton Beebe, Roy Germano, Christopher Jon Sprigman, and Joel H. Steckel

INTERNATIONAL TRADEMARK ASSOCIATION

Powerful Network Powerful Brands

675 Third Avenue, New York, NY 10017-5704

Telephone: +1 (212) 642-1700

email: wknox@inta.org

OFFICERS OF THE ASSOCIATION

ZEEGER VINK.....	<i>President</i>
JOMARIE FREDERICKS.....	<i>President-Elect</i>
DANA NORTHCOTT.....	<i>Vice President</i>
ELISABETH BRADLEY.....	<i>Vice President</i>
DEBORAH HAMPTON.....	<i>Treasurer</i>
LOUIS CHAN.....	<i>Secretary</i>
ANTHONY DREYER.....	<i>Counsel</i>
ETIENNE SANZ DE ACEDO.....	<i>Chief Executive Officer</i>

The Trademark Reporter Committee

EDITORIAL BOARD

EDITOR-IN-CHIEF, CHAIR

RAFFI V. ZEROUNIAN

STAFF EDITOR-IN-CHIEF

WILLARD KNOX

Senior Editors

PAMELA CHESTEK

ANDREW GRAY

KAREN ELBURG

LESLEY GROSSBERG

VERENA VON BOMHARD

VERENA VON BOMHARD

Director of Legal Resources

LIZ HANELLIN

Senior Staff Editor

BEVERLY HARRIS

Senior Staff Editor

ELIZABETH VENTURO

Senior Legal Editor

ROSEMARY DESTEFANO

Composer

BARBARA MOTTER

Editors

TARA ALLSTUN
ABDURRAHIM AYAZ
SARA BAUER
DANIEL BERESKIN
WILLIAM BORCHARD
STEPHANIE BUNTIN
JEANNETTE CARMADELLA
JOSEPH CARRAFIELLO
TED DAVIS
MICHAEL DENNISTON
MOHAN DEWAN
TUE DO
MATTHEW EZELL
CHRISTINE FELLER
DÉSIRÉE FIELDS
MATHILDE FLORENSON
GABRIELE FOUGNER
ALEX GARENS
STUART GREEN
STACY GROSSMAN
JORDI GÜELL
WINSLOW HALL

JOHN HEINBOCKEL
BARRY HORWITZ
GANG HU
BRUCE ISAACSON
MANAVI JAIN
BARBARA JOHNSON
SAUMYA KAPOOR
INGRIDA KARINA-BERZINA
ELISABETH KASZNAR FEKETE
CHIAKI KATO
SUSAN KERI
SABRINA LARSON
SCOTT LEBSON
QIANG MA
SONAL MADAN
ILARIA MAGGIONI
MICHAEL MAIER
JAMES MCALLISTER
J. THOMAS MCCARTHY
CATHERINE MITROS
ERIC MORAN

SHANA OLSON
RICCARDO PEROTTI
LUIS HENRIQUE PORANGABA
UDAYVIR RANA
BRANDON RESS
SUSAN RUSSELL
MARTIN SCHMIDT
TOM SCOURFIELD
JENNIFER SICKLER
GIULIO ENRICO SIRONI
SCOTT SLAVICK
MEGAN SNEED
RANDY SPRINGER
DONALD THOMPSON
MINN TYAZAR TIN
KHALA TURNER
CRISTINA VALCAUAN
MARTIN VIEFHUES
JOHN L. WELCH
JASON WHITNEY
ALICJA ZALEWSKA
NANCY ZHANG

Advisory Board

MILES ALEXANDER
WILLIAM BORCHARD
LANNING BRYER
JESSICA CARDON
SANDRA EDELMAN
ANTHONY FLETCHER
ROBERT KUNSTADT

THEODORE MAX
KATHLEEN MCCARTHY
GLENN MITCHELL
JONATHAN MOSKIN
VINCENT PALLADINO
JOHN PEGRAM

ROBERT RASKOPF
PASQUALE RAZZANO
SUSAN REISS
PIER LUIGI RONCAGLIA
HOWARD SHIRE
JERRE SWANN, SR.
STEVEN WEINBERG

The views expressed in *The Trademark Reporter* (TMR) do not necessarily reflect those of the International Trademark Association (INTA). To fulfill its mission of delivering cutting-edge scholarship on trademarks, brands, and related intellectual property to its readers, the TMR sources content reflecting a diversity of viewpoints; the views expressed in any given article, commentary, or book review are those of the individual authors.

The TMR (ISSN 0041-056X) is published electronically six times a year by INTA, 675 Third Avenue, New York, NY 10017-5704 USA. INTA, the INTA logo, INTERNATIONAL TRADEMARK ASSOCIATION, POWERFUL NETWORK POWERFUL BRANDS, THE TRADEMARK REPORTER, and inta.org are trademarks, service marks, and/or registered trademarks of the International Trademark Association in the United States and certain other jurisdictions.

The Trademark Reporter®

RECOGNIZING THE “USE”-FULNESS OF EVIDENCE AT THE TTAB

*By Lorelei D. Ritchie**

Table of Contents

I.	Introduction	636
II.	Is Evidence of Marketplace Use Relevant in TTAB Proceedings?.....	636
A.	Logistics of Evidence at the TTAB	637
B.	Evidence of Marketplace Use in Non-likelihood of Confusion Cases	637
C.	Evidence of Marketplace Use in Likelihood of Confusion Cases	638
1.	Establishing Plaintiff's Rights	639
2.	Establishing the Strength (or Not) of a Mark	640
3.	Establishing the Commercial Impression of a Mark	641
4.	Establishing the Parameters of the Goods/Services, Channels of Trade, and Conditions of Sale.....	641
5.	Establishing the Reality of the Marketplace Itself via Additional <i>du Pont</i> Factors.....	642
III.	Conclusion.....	643

* Assistant Professor, Southern Illinois University School of Law, and former Administrative Trademark Judge (TTAB). With grateful appreciation for the thoughtful comments from Hon. Ellen J. Seeherman (TTAB ret.), John L. Welch, and Professor J. Thomas McCarthy. Any mistakes are my own.

I. INTRODUCTION

There has been a fair amount of confusion regarding the value of “use”-based evidence in proceedings at the Trademark Trial and Appeal Board (“TTAB” or the “Board”). In 2021, shortly after departing the TTAB for a full-time academic position, I published a law review article intended as an in-depth discussion of policy issues and concerns involving the appropriateness of use-based evidence at the TTAB.¹ While that article provided an analysis of policy initiatives and opportunities, the present article is intended to provide tips to current (or aspiring) practitioners on best practices of when to submit—and when to avoid submitting—evidence of marketplace use in TTAB proceedings. In short, this article is intended as a practical guide, based on current law and practice at the TTAB, including as the Trademark Modernization Act of 2020 takes effect.²

II. IS EVIDENCE OF MARKETPLACE USE RELEVANT IN TTAB PROCEEDINGS?

As noted, there is intense debate as to the effectiveness of use-based evidence in the trademark registration process. So, for the oft-debated question as to whether evidence of marketplace use is relevant in TTAB proceedings, the answer is yes—and no. As a lawyer, you no doubt often counsel your clients with a response we all learned to laugh (or cry) about in law school: “It depends.”

As the TTAB and U.S. Court of Appeals for the Federal Circuit (the “Federal Circuit”) have repeatedly noted, trademark rights are largely based on consumer perceptions.³ Indeed, the Federal Circuit has noted the importance of setting forth those perceptions in making your case for or against the registration of a mark. In particular, the Federal Circuit has noted that the best evidence of consumer perception is often evidence from the marketplace itself

¹ See Lorelei D. Ritchie, *What is “Likely to be Confusing” About Trademark Law: Reconsidering the Disparity Between Registration and Use*, 70 Am. U. L. Rev. 1331 (2021) (hereinafter “*Reconsidering the Disparity*”), considering more broadly the unresolved disparity between trademark use and registration, and proposing a more consistent approach by the judicial, legislative, and administrative systems. As further discussed therein, “[t]he Court of Appeals for the Federal Circuit has accused the [TTAB], which oversees most trademark registration cases, of being, ‘at times, like a cat watching the wrong rat hole’ . . . [nevertheless] the Federal Circuit has generally maintained that in most cases, marketplace realities (such as actual use) should not be taken into account in considering a refusal for likelihood of confusion.” *Id.* at 1333. This disparity is further discussed herein in Part II.C.

² Trademark Modernization Act, Pub. L. No. 116-260, §§ 221–228, 134 Stat. 1182 (2020) (hereinafter “Trademark Modernization Act of 2020”). In this regard, much of this discussion is relevant to trademark examination as well.

³ See *Royal Crown Co., Inc. v. The Coca-Cola Co.*, 892 F.3d 1358, 1370 (Fed. Cir. 2018); *In re Nett Designs Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001); *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1583 (Fed. Cir. 1988).

(e.g., via surveys, declarations, etc.).⁴ With that in mind, I will set forth the various elements that are considered by the TTAB in determining the relevance of evidence regarding marketplace use. The answer depends largely on whether or not the refusal or claim at issue involves an alleged likelihood of confusion. That said, and as further discussed below, while this is an important and often crucial factor, the inquiry does not end there.

A. Logistics of Evidence at the TTAB

The first and most important practice tip is—if you want evidence to be considered—get it in the record. It bears mentioning that no evidence is relevant or probative, or is likely to have any impact on your case, unless it is in the record.⁵ If you are a seasoned practitioner, this may seem like a basic practice pointer. It is worth considering, nevertheless, how the TTAB judges and interlocutory attorneys are evaluating your case. Since the Board rarely takes judicial notice, the judges and interlocutory attorneys will rely on you to present, in a clear and concise manner, what is relevant and necessary for their ruling.⁶ Practitioners should be consistent and thorough from the outset—setting forth the claims in the pleadings, developing the record during trial, and providing a clear roadmap in briefs.⁷

B. Evidence of Marketplace Use in Non-likelihood of Confusion Cases

As mentioned above, in discussing the role of marketplace evidence in TTAB proceedings, there is a crucial difference of analysis depending on whether the case involves an asserted likelihood of confusion. I will discuss cases involving allegations of likelihood of confusion in the next section. Practitioners should nevertheless be aware that in the many cases that involve other refusals or claims, evidence of marketplace use (or nonuse) is typically not only relevant but indeed is often essential to the outcome of the case. Consider, for example, claims or refusals

⁴ See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985) (finding it appropriate to consider evidence from “any competent source, such as consumer surveys, dictionaries, newspapers[,] and other publications.”)

⁵ The TTAB has bemoaned lack of clarity in evidence and argument. See *RxD Media, LLC v. IP Application Dev. LLC*, 125 U.S.P.Q.2d 1801, 1803 (T.T.A.B. 2018) (“Judges are not like pigs, hunting for truffles buried in briefs.”) (quoting *U.S. v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)).

⁶ Dictionary definitions are a typical exception. See *Trademark Board Manual of Procedure (TBMP)* § 704 (June 2021) for further discussion and examples; 37 CFR § 2.122(a); *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co., Inc.* 908 F.2d 1315 (Fed. Cir. 2018).

⁷ This is, of course, after such discovery and any motion practice as is relevant and helpful to your case. See generally, *TBMP* §§ 400-414 and 500-544.

involving mere descriptiveness and/or acquired distinctiveness,⁸ specimen refusals,⁹ and claims of abandonment or nonuse, all of which clearly require consideration of evidence of marketplace use (or lack thereof)—especially under the newly enacted rules of the Trademark Modernization Act of 2020.¹⁰ Thus, in the vast majority of refusals or claims other than likelihood of confusion, evidence of marketplace use may be relevant and probative—if not determinative—of your case.

C. Evidence of Marketplace Use in Likelihood of Confusion Cases

But what about an appeal or inter partes case where likelihood of confusion is alleged? Many assume that in likelihood of confusion cases, the Board will focus solely on the language of the registration or application at issue. You would not be blamed for thinking this. Certainly, enough TTAB and Federal Circuit cases have made this point, often quoting what may be referred to in shorthand as the “*Octocom* rule,” in reference to that case:¹¹

The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [as] *set forth* in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.

So, while the Board regularly gets arguments that this is unfair, keep in mind that the “*Octocom* rule” is “the rule.”¹² Keep in mind

⁸ See *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed. Cir. 2005) (requiring consideration of “all of the circumstances involving *the use* of the mark.” (Emphasis added.)). The Supreme Court has further expounded on considerations in genericness, and the importance of real-world consumer perceptions, which must also necessarily consider evidence of marketplace use. See *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304 (2020).

⁹ See 15 U.S.C. § 1051(a)(1), which requires that a use-based trademark application include among other things “such number of specimens or facsimiles of the mark *as used* as may be required by the Director.” (Emphasis added.) Of course applicants filing with an “intent to use” under Section 1(b) must also ultimately submit evidence of use in the form of a “specimen” showing how the mark is “used in commerce.” *Id.* § 1051(d). See also *In re Bose Corp.*, 546 F.2d 893, 897 (C.C.P.A. 1976) (evaluating whether the asserted mark has been “used” as a trademark.).

¹⁰ See, more specifically, Trademark Modernization Act of 2020, cited *supra* note 2.

¹¹ See *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (emphasis added). Per *Reconsidering the Disparity* at 1334, according to the Westlaw TTAB database, as of March 7, 2021, *Octocom* had been cited in at least 91 precedential TTAB cases and 16 precedential Federal Circuit cases (per *Bloomberg BNA U.S.P.Q.* cites) and in 2,787 TTAB cases overall since its issuance in 1990.

¹² While valid arguments may be made for reconsidering the disparity between trademark registration and use (see *Reconsidering the Disparity* for more specific proposals),

also that the rule is by no means absolute. Yes, evidence of marketplace use is often irrelevant to arguments in disputes involving likelihood of confusion at the TTAB. But not always. It is more nuanced than that. So, let's talk about when and how the Board is more likely to be amenable to your evidence of marketplace use in considering the likelihood of confusion *du Pont* factors.¹³

1. Establishing Plaintiff's Rights

When faced with a likelihood of confusion refusal, applicants not infrequently argue that the cited mark is “actually used” in a different or more narrow manner than that which is stated in the cited registration. The TTAB regularly admonishes that the “*Octocom* rule” bars these arguments.¹⁴ Similarly, in an opposition proceeding, a pleaded registration is deemed by operation of law to be sufficient to establish prior rights.¹⁵

That said, there are some likelihood of confusion cases where the question of prior use may, or even must, be proven—or disproven—by evidence of marketplace use. Even in an *ex parte* appeal, an applicant may ask for proceedings to be suspended while the applicant initiates a Section 18 proceeding to narrow the cited registration via evidence of the actual marketplace use.¹⁶ In an

needless to say, in any given case, judges do not particularly like to be told they are being “unfair.”

¹³ *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (describing the factors that “when of record, must be considered”). As more specifically addressed herein, the thirteen *du Pont* factors include an assessment of 1) the similarity or dissimilarity of the marks “in their entireties”; 2) the similarity or dissimilarity of the goods and/or services “as described in an application or registration or in connection with which a prior mark is used”; 3) the similarity or dissimilarity of “established, likely-to-continue trade channels”; 4) the conditions of sale; 5) any established “fame” of the asserted mark; 6) the “number and nature of similar marks in use on similar goods”; 7) the “nature and extent of any actual confusion”; 8) any evidence of “concurrent use without evidence of actual confusion”; 9) the “variety of goods on which a mark is or is not used”; 10) the “market interface between applicant and the owner of a prior mark”; 11) the “extent to which applicant has a right to exclude others from use of its mark on its goods”; 12) the “extent of potential confusion”; and a catch-all 13) “[a]ny other established fact probative of the effect of use.” *Id.*

¹⁴ See Trademark Modernization Act of 2020, cited *supra* note 2.

¹⁵ See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974). An applicant may, if otherwise legally appropriate, challenge a pleaded registration via a counterclaim to cancel the registration.

¹⁶ See Section 18 of the Trademark Act; 15 U.S.C. § 1068. Applicants not infrequently also argue that they themselves use their proposed mark in a manner different from that which is stated in the application. An application may be narrowed during prosecution, or in some instances by leave of the TTAB. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 U.S.P.Q.2d 1825, 1828 (T.T.A.B. 2013) (granting applicant's request to limit identification in order to avoid finding of likelihood of confusion). As an alternative, if an applicant's identification of goods or services is “unclear,” an examining attorney may require an appropriate amendment of the identification. See 37 C.F.R. § 2.71(a) (2008). Nevertheless, applicants must be careful to avoid a finding of nonuse, including by

opposition proceeding, where common law rights are asserted for priority and likelihood of confusion, a plaintiff's prior use must be proven, typically by submitting evidence of marketplace use.¹⁷ Moreover, in a cancellation proceeding alleging priority and likelihood of confusion, even a plaintiff that owns a trademark registration must prove its case, typically by submitting evidence of marketplace use.¹⁸

2. Establishing the Strength (or Not) of a Mark

As seasoned trademark attorneys are aware, the TTAB and the USPTO generally—per the Federal Circuit—do not consider the “strength” of the mark as a single factor, but rather as a discussion of conceptual and commercial strength embedded in the fifth and sixth *du Pont* factors.¹⁹ Regardless, the “strength” of a plaintiff's mark hinges on evidence of marketplace use, including evidence of revenue, advertising expenditures, media references, etc.—typically submitted by the plaintiff in a likelihood of confusion proceeding. The “weakness” of a plaintiff's mark similarly hinges on evidence of marketplace use, including evidence of third-party uses, dictionary definitions, etc., typically submitted by the defendant/applicant.²⁰ Since a determination of “fame”—or generally of overriding strength or weakness—is often referred to by the Federal Circuit and the TTAB as being a “dominant” factor in a likelihood of confusion analysis, evidence of marketplace use submitted by either the plaintiff or the defendant/applicant is thus not only relevant but may indeed be crucial to the ultimate finding (or not) of likelihood of confusion.²¹

writing an overly broad identification. See Trademark Modernization Act of 2020, cited *supra* note 2.

¹⁷ Indeed there is in such case no identification of goods or services for the TTAB to consider. Therefore, any alleged rights must be indicated via the evidentiary record.

¹⁸ See *Brewski Beer Co. v. Brewski Bros., Inc.*, 47 U.S.P.Q.2d 1281, 1284 (T.T.A.B. 1998).

¹⁹ The fifth *du Pont* factor considers “[t]he fame of the prior mark (sales, advertising, length of use).” The sixth *du Pont* factor considers “[t]he number and nature of similar marks in use on similar goods.” See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. As noted by Professor McCarthy, the Federal Circuit has dictated that “the strength factor plays a ‘dominant role’ in determining whether confusion is likely.” As Professor McCarthy further notes, “unlike all other courts in the nation, the Federal Circuit and the TTAB usually use the word ‘fame’ instead of ‘strength.’” J. Thomas McCarthy, *Trademark Strength and Fame: The Federal Circuit Corrects the Trademark Trial and Appeal Board*, 108 TMR 904, 905 (2018).

²⁰ See *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39 (Fed. Cir. 2015); see also *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373 (Fed. Cir. 2015).

²¹ *Id.* See also *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352 (Fed. Cir. 1992) (noting that, where present, fame plays a “dominant role” in finding a likelihood of confusion); see also *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374 (Fed. Cir. 2005).

3. Establishing the Commercial Impression of a Mark

Although you may be forgiven for assuming that identical marks are indeed “identical,” this is not necessarily the end of the inquiry.²² Since the meaning of a mark is considered in the context of the identified goods or services, the same mark used by two different parties—e.g., COACH—may have a different meaning vis à vis the applicant’s educational “coaching” services and the plaintiff’s “stagecoach”-inspired handbags.²³ In this regard, the Board may consider extrinsic evidence in determining the crucial factor of the commercial impression of a mark.²⁴

Keep in mind that the TTAB will often *not* consider evidence of marketplace use—or of other evidence, such as dictionary definitions or expert declarations—in making a determination as to the first *du Pont* factor. The Board will use its discretion in deciding whether or not to do so. Consider whether there is a good basis for an argument as to why in your case it would be helpful to the Board’s determination of the relevant consumer perceptions and be prepared to cite supporting case law.²⁵

4. Establishing the Parameters of the Goods/Services, Channels of Trade, and Conditions of Sale

As discussed above, most trademark attorneys are aware of the “*Octocom* rule,” which limits the TTAB’s analysis to the “four corners” of the application and/or registration for purpose of analyzing the second and third *du Pont* factors.²⁶ Nevertheless, while often strictly applied, the rule is not absolute. While typically limiting its analysis to the goods or services identified in an application or registration, the TTAB has indicated a willingness to consider extrinsic evidence to interpret that identification.²⁷

²² The first *du Pont* factor considers “[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.” See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

²³ *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1378 (Fed. Cir. 2012).

²⁴ While generally counseling against it, the Federal Circuit has occasionally considered evidence of marketplace use such as trade dress in its analysis of the similarity of word marks as used on the respective products. See *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669 (Fed. Cir. 1984).

²⁵ *Id.* (finding that dictionary definitions may be considered to demonstrate the commercial impression, and ultimately the strength, of a mark).

²⁶ *Octocom*, 918 F.2d at 942. See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323 (Fed. Cir. 2017). The second *du Pont* factor considers “[t]he 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”; the third *du Pont* factor considers “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

²⁷ See *In re Trackmobile, Inc.*, 15 U.S.P.Q.2d 1152, 1154 (T.T.A.B. 1990); *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1636, 1636 nn.5-6, 1638, 1638 (T.T.A.B. 2009).

Similarly, while the Federal Circuit and the TTAB may extend the “*Octocom* rule” to the consideration of the fourth *du Pont* factor, the Board may also consider extrinsic evidence that assists in clarifying the nature or sophistication of the relevant purchasers, via dictionary definitions, declarations, expert testimony, or other appropriate evidence.²⁸

5. Establishing the Reality of the Marketplace Itself via Additional *du Pont* Factors

While as noted, the “*Octocom* rule” discourages reference to evidence of marketplace use in the analysis of some of the *du Pont* factors,²⁹ other factors nevertheless specifically do rely on such evidence. For example, the seventh and eighth *du Pont* factors inquire, respectively, into “actual confusion” and the “length of time during and conditions under which there has been concurrent use” in the marketplace without any evidence of such confusion. In most cases, these factors are not at play.³⁰

The TTAB has echoed the Federal Circuit in noting that the “absence” of actual confusion is typically not particularly probative where there has been little or no occasion for such confusion to have occurred.³¹ Nevertheless, where it does exist, evidence of *actual* confusion in the marketplace can be not only probative but potentially dispositive of a *likelihood* of confusion.³² Similarly, the absence of confusion may indeed be highly probative, particularly where the parties agree that their marks have been able to—and will continue to—coexist without a likelihood of confusion.³³

Other *du Pont* factors, such as the ninth, tenth, and eleventh, are not often cited, but where relevant are very much based on

²⁸ See *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317 (Fed. Cir. 2014); *but see Edwards Lifesciences Corp. v. Vigilandz Corp.*, 94 U.S.P.Q.2d 1399, 1408-1410, 1413 (T.T.A.B. 2010). The fourth *du Pont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

²⁹ See *supra* subsections 1, 2, and 3 of this Section C.

³⁰ As a practice pointer, do not exhaust your TTAB panel by citing factors that are not relevant to your case. Doing so will only decrease your credibility while diverting attention from your core case. See Trademark Modernization Act of 2020, cited *supra* note 2; see also John L. Welch, *The Top Ten Losing TTAB Arguments*, 15 Allen’s Trademark Digest 1 (July 2001) (noting that “[c]ertainly those who offer these losing arguments are not only wasting their time and that of the Board, but they may also be damaging their credibility with the Board and injuring their clients’ causes in the process.”).

³¹ See, e.g., *In re Majestic Distilling Co.*, 315 F.3d 1311 (Fed. Cir. 2003).

³² See *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 U.S.P.Q.2d 1645, 1660 (T.T.A.B. 2010), *aff’d*, 637 F.3d 1344 (Fed. Cir. 2011); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2d 1464, 1475 (T.T.A.B. 2016).

³³ See *In re Four Seasons Hotels, Ltd.*, 987 F.2d 1565, 1567 (Fed. Cir. 1993) (noting that the agreements of parties “carry great weight.”).

evidence of actual marketplace use.³⁴ The thirteenth *du Pont* factor, which is somewhat of a “catchall” factor (literally stating “[a]ny other established fact probative of the effect of use”) may also be employed as a mechanism to submit evidence of relevant consumer perceptions, as well as to prevail upon principles of equity.³⁵

III. CONCLUSION

While it is commonly stated that evidence of marketplace use is not relevant in TTAB proceedings, the reality is that in some cases such evidence will not only be considered, but it may even be outcome-determinative. As noted herein, for the many refusals or claims apart from likelihood of confusion—including, for example, mere descriptiveness and/or acquired distinctiveness, specimen refusals, abandonment, nonuse, etc.—evidence of marketplace use is often crucial to the Board’s determination. In likelihood of confusion cases, the situation is much more nuanced.

Due to the “*Octocom* rule” discussed herein, evidence of marketplace use is less likely to be considered by the Board in likelihood of confusion cases, particularly with regard to the first through fourth *du Pont* factors. Nevertheless, as noted above, even in the consideration of those factors, there are situations where it can be helpful to the Board’s determination to include relevant evidence as to consumer perceptions of the mark, the goods/services, or the conditions of purchase.

Moreover, evidence of marketplace use may be relevant to, or even required for, the determination of other *du Pont* factors, such as commercial strength or actual confusion. Thus, where relevant and appropriate to certain claims and refusals—and even to certain elements in likelihood of confusion disputes as discussed herein—be prepared to submit helpful, credible evidence of the marketplace use that supports your case.

With the gentle reminder that, like you, your audience at the TTAB—and generally at the USPTO—are busy professionals doing their best to work within the confines of the administrative system, be judicious in your arguments, and thoughtful in your approach.

³⁴ The ninth *du Pont* factor considers “[t]he variety of goods on which a mark is or is not used”; the tenth *du Pont* factor considers possibilities of “[t]he market interface between applicant and the owner of a prior mark”; and the eleventh *du Pont* factor considers “[t]he extent to which applicant has a right to exclude others from use of its mark on its goods.” See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

³⁵ See *In re Allegiance Staffing*, 115 U.S.P.Q.2d 1319, 1323 (T.T.A.B. 2015).