

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 1, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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BH Management Services, LLC

v.

Blackhorse LLC
—

Cancellation No. 92083480
—

Christopher A. Proskey and Stephanie A. Koltookian of BrownWinick Law Firm,
for BH Management Services, LLC.

Todd Wengrovsky of Law Offices of Todd Wengrovsky PLLC,
for Blackhorse LLC.

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Before Heasley, Cohen and Lavache;
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Respondent Blackhorse LLC owns a Principal Register registration for the

stylized mark  for:

Business project management services for construction projects; Real estate marketing services, namely, on-line services featuring the promotion of residential new construction, which also contains back office solutions for builders, in International Class 35; and

Construction services, namely, concrete paving, site clearing, excavation, pad preparation, grading, and asphalt paving services; Construction services, namely, installation of environmental containment systems; Construction services, namely, manhole adjusting; Construction services, namely, planning, laying out and construction of a planned residential community; Construction services, namely, planning, laying out and construction of residential and commercial communities; Construction services, namely, planning, laying out and custom construction of commercial buildings; Construction grading services; Construction project management services; Construction project management services in the field of construction of offshore oil and gas facilities; Construction project management services in the field of construction of renewable energy and energy generation equipment support structures and ancillary structures for supporting meteorological data gathering equipment; Construction project management services in the field of BUILDINGS; General construction contracting; Advisory services relating to building construction; Advisory services relating to the construction of buildings; Building construction services; Consultancy services relating to the construction of buildings; Consultation services in the field of construction of environmentally-conscious buildings; Consulting services for the construction and installation of masonry walls and structures; Consulting services for the construction of water treatment and purification plants, solid waste treatment plants and other municipal infrastructure facilities; Consulting services in the field of construction of wind energy facilities; Consulting services in the field of offshore oil and gas facility construction; Earthworks services in the nature of excavating for building construction; Housing services, namely, development of real property, namely, repair, improvement, and new construction; Housing services, namely, repair, improvement, and construction of residential real property; Inspection services in the course of construction of BUILDINGS; Plant construction, maintenance and construction project management services for businesses in the energy production and transmission sector; Self-perform construction skilled trades, namely, concrete work, carpentry and selective demolition services, in International Class 37.¹

Petitioner BH Management Services, LLC seeks cancellation of Respondent's registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the basis of a likelihood of confusion with its registrations and alleged prior common-law rights in

¹ Registration No. 6640942 was filed November 22, 2020 and issued February 8, 2022. The registration includes the following description of the mark: "The mark consists of the stylized wording 'BLACKHORSE' with a large 'B' AND 'H' with the word 'BLACKHORSE' going through the center of the letters 'B' and 'H'".

BH and BH-formative marks for a variety of services including management of real estate and construction project management services in the field of residential buildings.²

In its Answer, Respondent denied most of the salient allegations of the petition to cancel but admitted³ that it filed and registered Respondent's registration,⁴ and that Petitioner is the owner of Registration No. 3109093 for the standard character mark BH, filed May 13, 2005 and registered on June 27, 2006.⁵

The case is fully briefed. We grant the petition to cancel.

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule

² 1 TTABVUE 17-18, ¶¶ 6-15.

Citations to the record and briefs reference TTABVUE, the Board's online docket system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 WL 2853282, at *1 n.1 (TTAB 2020).

³ Respondent asserted the affirmative defenses of estoppel, waiver, and acquiescence but did not pursue or prove these defenses at trial; they are thus deemed impliedly waived. Answer, 5 TTABVUE 5 (Fourth and Fifth Affirmative Defenses); *see Keystone Consol. Indus. v. Franklin Inv. Corp.*, No. 92066927, 2024 WL 3771168, at *2 n.10 (TTAB 2024) ("Affirmative defenses that were asserted in an answer but then not pursued at trial may be deemed impliedly waived, while affirmative defenses that were never asserted may be deemed forfeited."); *Coca-Cola Co. v. Meenaxi Enters., Inc.*, No. 92063353, 2021 WL 2681898, at *1 (TTAB 2021) ("Respondent did not pursue the purported affirmative defenses at trial, and we therefore consider them waived.").

Respondent also asserted purported affirmative defenses which are not true affirmative defenses (Answer, 5 TTABVUE 5-6 (First, Second and Third Affirmative Defenses)), so we do not address them as such. *See, e.g., DeVivo v. Ortiz*, No. 91242863, 2020 WL 1227592, at *1 (TTAB 2020) (mere amplifications of the applicant's denials not considered as separate affirmative defenses); *John W. Carson Found. v. Toilets.com, Inc.*, No. 91181092, 2010 WL 1233881, at *9 (TTAB 2010) ("The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim.").

⁴ Answer, 5 TTABVUE 3, ¶¶ 1-5.

⁵ *Id.* at 11, ¶¶ 11-14. Registration No. 3109093 was filed May 13, 2005 and issued June 27, 2006.

2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's Registration. The parties also introduced additional evidence and testimony which we do not list here. Although we do not list the contents of the record, the entire record has been carefully considered, and relevant evidence is discussed throughout this opinion. *See Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (Board not obliged to expressly discuss every piece of evidence); *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1348 (Fed. Cir. 2012) ("[T]he mere fact that the Board did not recite all of the evidence it considered does not mean the evidence was not, in fact, reviewed."); *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed. Cir. 2003) ("We presume that a fact finder reviews all the evidence presented unless he explicitly expresses otherwise."); *Newhouse v. Nicholson*, 497 F.3d 1298, 1302 (Fed. Cir. 2007) ("The fact that [a particular piece of evidence] was not specifically mentioned in the Board's decision in this case is insufficient to overcome this presumption [that the Board reviewed all the evidence in the record]."); *Gonzales v. West*, 218 F.3d 1378, 1381 (Fed. Cir. 2000) ("absent specific evidence indicating otherwise, all evidence contained in the record ... must be presumed to have been reviewed by [the agency]").

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). To establish entitlement to a statutory cause of action in an opposition proceeding, an opposer must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Id.*

Petitioner's entitlement to seek cancellation of Respondent's registration on the ground of likelihood of confusion is established by its unchallenged pleaded registrations which Petitioner properly made of record by submitting copies of the registrations with its petition to cancel and status and title copies in its notices of reliance.⁶ See Trademark Rule 2.122 (d)(1) (registration of the petitioner in a petition to cancel will be received in evidence and made part of the record if the petition is accompanied by an original or photocopy of the registration or by a current copy of information from the electronic database records of the Office showing both the current status of and current title); *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, No. 91263919, 2022 WL 16646840, at *6 (TTAB 2022) (valid and subsisting pleaded registration establishes opposer's direct commercial interest in the proceeding and its belief in damage) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000)). Also, the testimony declaration of its Chief Marketing Officer, Kelly Kutach, who testified that Petitioner has used the mark BH on various real estate related services since at least 1989,⁷ is sufficient to establish that Petitioner has a real interest in this proceeding and a reasonable basis for its belief in damage. See *Monster Energy Co. v. Lo*, No. 91225050, 2023 WL 417620, at *5 (TTAB 2023) (entitlement found based on declaration of opposer's CEO attesting to opposer's use of allegedly similar pleaded mark).

⁶ 1 TTABVUE 24-41; 13-14 TTABVUE.

⁷ Kutach Decl., 12 TTABVUE 3, ¶¶ 6, 8; Exhibits 1-2, id. at 11-74, 548-88.

III. Section 2(d) Claim

A. Initial Matter

Petitioner pleads ownership of ten registrations. However, we focus our analysis



on Petitioner's registered mark ⁸ for:

“Management of real estate; real estate acquisition services; rental of apartments; land acquisition, namely, real estate brokerage services; financial valuation of real estate” in International Class 36; and

“Construction project management services in the field of residential buildings” in International Class 37; and

and Petitioner's registered standard character mark BH COMPANIES⁹ for:

“Management of real estate; real estate acquisition services; rental of apartments; land acquisition, namely, real estate brokerage services; financial valuation of real estate; real estate management services; Real estate operation services, namely, real estate agency services; Real estate sales management; real estate leasing services; real estate advisory services; Real estate investment services; commercial real estate management services; multi-family real estate management services; commercial real estate investment services; multi-family real estate investment services; real estate procurement services for others; real estate appraisal and evaluation services; financial investment in the field of real estate; providing information in the field of real estate via the Internet; providing information in the field of real estate investment via the Internet; real estate consultancy; Real estate management consultation; Real estate funds investment services; Financial management of real estate investment funds” in International Class 36; and

“Construction, maintenance, and renovation of property; Real estate development services, namely, condominium conversion services, also known

⁸ Registration No. 5803246 (the “246 registration or '246 mark”) was filed April 25, 2018 and issued July 16, 2019. The registration includes the description: “The mark consists of the letters ‘BH’ in a solid circle.”

⁹ Registration No. 5975575 (the “575 registration or '575 mark”) was filed May 23, 2019 and issued February 4, 2020. COMPANIES is disclaimed.

as, conversion of rental property to condominium property; real estate development; real estate development and construction of commercial and residential property; real estate renovation of commercial and residential property; providing information in the field of real estate development of commercial and residential property; providing information in the field of real estate construction of commercial and residential property; providing information in the field of real estate renovation of commercial and residential property; construction project management services in the field of commercial and residential real estate; General building contractor services in the field of construction, maintenance and renovation of commercial and residential property; housing services, namely, development of real property, namely, repair, renovation and new construction; real estate construction; real estate site selection; Land development services, namely, planning and laying out of commercial buildings; land development services, namely, planning and laying out of residential, commercial and mixed-use real estate” in International Class 37.

If we do not find a likelihood of confusion with respect to these marks and these services, then there would be no likelihood of confusion with the marks and services in Petitioner’s other registrations. *See Sock It To Me, Inc. v. Fan*, No. 91230554, 2020 WL 3027605, at *9 (TTAB 2020) (confining Section 2(d) analysis to most similar pleaded mark) (citing *N. Face Apparel Corp. v. Sanyang Indus. Co.*, No. 91187593, 2015 WL 6467820, at *7 (TTAB 2015)); *Max Cap. Grp.*, 2010 WL 22358 at *2.

B. Priority

“In a cancellation proceeding such as this one where both parties own registrations, priority is in issue.” *Double Coin Holdings Ltd. v. Tru Dev.*, No. 92063808, 2019 WL 4877349, *5 (TTAB 2019). “[B]ecause both parties have registrations, it is [Petitioner’s] burden to demonstrate that its use of its . . . mark[s] is prior to [Respondent’s] use of its registered mark[].” *Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, No. 91184576, 2011 WL 4090446, at *7 (TTAB 2011). Each party may rely on the filing dates of the applications that matured into their respective

registrations, or on earlier dates of proven use. *Sabhnani v. Mirage Brands, LLC*, No. 92068086, 2021 WL 6072822, *7 (TTAB 2021).

The application that matured into Respondent's registration was filed November 22, 2020 and its principal, David Alger, testifies that Respondent has used the mark "in commerce for the [identified] services since April 14, 2020."¹⁰ Petitioner's '246 registration and '575 registration both have filing and registration dates that precede Respondent's filing date, as well as Respondent's claimed date of first use and use in commerce, which Respondent does not dispute.

Petitioner's priority is established.

C. Likelihood of Confusion

Trademark Act Section 2(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 . . . and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d); *see also* *Cunningham*, 222 F.3d at 946; *Life Zone Inc. v. Middleman Grp. Inc.*, No. 91160999, 2008 WL 2781162, at *6 (TTAB 2008). To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"). The Board considers each factor for which there is evidence and argument. *Spireon, Inc. v. Flex*

¹⁰ Alger Declaration, 16 TTABVUE 4, ¶ 6.

Ltd., 71 F.4th 1355, 1362 (Fed. Cir. 2023); *In re Guild Mortg. Co.*, 912 F.3d 1376, 1380 (Fed. Cir. 2019). “The weight given to each factor depends on the circumstances of each case.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) (citation omitted); *see also Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (“Not all of the ... factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case.”) (cleaned up). Typically, the factors that compare the respective marks and the goods or services are key considerations. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976); *In re Max Cap. Grp. Ltd.*, No. 77186166, 2010 WL 22358 at *1 (TTAB 2010).

1. The Services and Trade Channels

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 476 F.2d at 1361. We compare the services as they are identified in the relevant registrations, *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012), with the identifications construed most favorably to the opposing prior user. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1337 (CCPA 1981) (citing *CTS Corp. v. Cronstoms Mfg. Inc.*, 515 F.2d 780, 782 (CCPA 1975) (the Board considered it proper to construe appellee’s description of goods in a “manner most favorable to appellant”)).

Respondent's registration identifies two separate classes of services, which we must consider separately. *See N. Face Apparel Corp. v. Sanyang Indus. Co.*, No. 91187593, 2015 WL 6467820, at *11 (TTAB 2015); ("Because each class in Applicant's multi-class application is, in effect, a separate application, we consider each class separately, and determine whether Opposer has shown a likelihood of confusion with respect to each."). Likelihood of confusion may be found as to each class in its entirety if it exists as to any service in that class. *Sabhnani*, 2021 WL 6072822, at *9 n.17 (citations omitted); *see also Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, No. 91270181, 2024 WL 1638376, at *8 n.41 (TTAB 2024) ("It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application"). In addition, the services need only be sufficiently related that a consumer would be likely to assume, upon encountering the services marketed under the marks at issue, that the services originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, No. 91158891, 2007 WL 894416, at *8 (TTAB 2007).

Petitioner argues that Respondent's services of "business project management services for construction projects; real estate marketing services, namely, on-line services featuring the promotion of residential new construction, which also contains back office solutions for builders" in Class 35 are encompassed by, overlap or are nearly identical to some of Petitioner's services, for example, "general building contractor services in the field of construction, maintenance and renovation of

commercial and residential property” in Class 37 and “real estate operation services, namely, real estate agency services; real estate sales management; ... real estate advisory services; ... commercial real estate management services; [and] multi-family real estate management services” in Class 36 as identified in some of Petitioner’s registrations.¹¹

Respondent effectively concedes the relatedness and similarity of the services because, as Petitioner notes, it “offers no arguments on the similarities of goods and services offered by the parties....”¹² See *In re Morinaga Nyugyo K.K.*, No. 86338392, 2016 WL 5219811, at *2 (TTAB 2016) (viewing applicant’s failure to address the second and third *DuPont* factors in its appeal brief as an apparent concession on those factors). Indeed, Respondent’s “business project management services for construction projects” in Class 35, on their face, are similar and related to Petitioner’s “construction project management services in the field of commercial and residential real estate” in Class 37 of the ’575 registration and “construction project management services in the field of residential buildings” in Class 37 of the ’246 registration because they all involve construction-related project management services.

As to Respondent’s Class 37 services, its broadly identified “construction project management services,” on their face, encompass Petitioner’s more narrowly identified “construction project management services in the field of real estate renovation of commercial and residential property; construction project management services in

¹¹ 20 TTABVUE 36.

¹² 22 TTABVUE 15.

the field of commercial and residential real estate” in Class 37 identified in the ’575 registration and “construction project management services in the field of residential buildings” in Class 37 of the ’246 registration and therefore, the parties’ Class 37 services are legally identical in part. *See In re St. Julian Wine Co.*, No. 87834973, 2020 WL 2788005, at *5 (TTAB 2020); *In re Info. Builders Inc.*, No. 87753964, 2020 WL 2094122, at *4 (TTAB 2020) (finding services legally identical in part where registrant’s services encompassed by applicant’s services); *In re Country Oven, Inc.*, No. 87354443, 2019 WL 6170483, at *2 (TTAB 2019) (quoting *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, No. 94002242, 2015 WL 4464550, at *17 (TTAB 2015) (where the identification of services is broad, the Board “presume[s] that the services encompass all services of the type identified”)).

While we contemplate the similarity or dissimilarity of the relevant services, we also consider the third *DuPont* factor, which concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Detroit Athletic*, 903 F.3d at 1306 (quoting *DuPont*, 476 F.2d at 1361)).

Respondent argues that “Petitioner is intentionally leaving out details as to the parties’ actual (not presumed) channels of trade”¹³ (emphasis in original). Respondent attempts to read trade channel and consumer limitations into its unrestricted identifications of services by resorting to extrinsic evidence,¹⁴ but we must rely on the

¹³ 21 TTABVUE 18.

¹⁴ *See, e.g.*, Alger Declaration, 16 TTABVUE 4, ¶¶ 12-13 (Mr. Alger testifies that Respondent advertises “on construction signs, t-shirts, hats, posters, buildings, work vehicles, community banners for donations, and local education foundations” and via social media and its website www.blakhorsect.com. *See also* Petitioner’s Notice of Reliance, Interrogatory No. 20, 11 TTABVUE 9 (Respondent responded to Petitioner’s interrogatory asking about Respondent’s

identifications alone. *See Detroit Athletic*, 903 F.3d at 1308 (“The third *DuPont* factor—like the second factor—must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world.”); *Cunningham.*, 222 F.3d at 948 (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”).

Respondent’s project management services are construction-related with no limitations or restrictions as to trade channels or class of consumers. Petitioner’s project management services are also construction-related, involving commercial and residential real estate and properties. Neither party’s relevant services contain restrictions as to the classes of consumers. Thus, Respondent’s broadly described services are presumed to move in all normal trade channels of the construction industry, including Petitioner’s more narrowly defined trade channels, i.e., commercial and residential, and the parties’ services may be rendered to the same or similar classes of consumers. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1327 (Fed. Cir. 2017) (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers....”); *Detroit Athletic*, 903 F.3d at 1308 (goods identified in registration that contains no

classes and types of customers that Respondent’s “customers are residential, commercial, and governmental.”).

restrictions on channels of trade or classes of consumers presumed to be sold in “all normal trade channels to all the normal classes of purchasers”).

These *DuPont* factors weigh in favor of finding a likelihood of confusion.

2. Strength/Weakness of Petitioner’s Mark

We consider the strength or weakness of Petitioner’s BH marks as used in connection with the relevant services because such a determination helps inform us as to their scope of protection. *See Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 WL 2188890, at *11-12 (TTAB 2022) (quoting *DuPont*, 476 F.2d at 1361). “A well-known mark enjoys an appropriately wider latitude of legal protection, for similar marks tend to be more readily confused with a mark that is already known to the public.” *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 851 (Fed. Cir. 1992) (citation omitted).

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself, and its commercial strength in the marketplace. *Spireon*, 71 F.4th at 1362-63 (“Two of the *DuPont* factors (the fifth and sixth) consider strength.”); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *see also Made in Nature*, 2022 WL 2188890, at *11-12 (quoting *DuPont*, 476 F.2d at 1361); *New Era Cap*, 2020 WL 2853282, at *12 (“[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.”) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003)). The fifth *DuPont* factor enables a petitioner to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of the fame of the prior mark (sales, advertising,

length of use). By contrast, the sixth *DuPont* factor allows a respondent to argue that confusion is less likely by adducing evidence of conceptual and commercial weakness. *Spireon*, 71 F.4th at 1362.

a) The Sixth *DuPont* Factor

We start by considering the conceptual strength of the '575 mark and '246 marks. *Spireon*, 71 F.4th at 1362. Because these marks issued on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), the marks are presumed to be inherently distinctive for the services listed in the registrations. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, No. 91118587, 2006 WL 2460188, at *21 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”).

However, the U.S. Court of Appeals for the Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different third parties for similar goods or services, that may indicate that the mark or common element has some conceptual weakness. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ . . . that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that segment

is relatively weak.”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)).

In support of its challenge to the conceptual strength of Petitioner’s BH marks,¹⁵ Respondent submits seven currently registered¹⁶ marks that include BH, the following of which are the most pertinent:

-  for a variety of services including management of real estate; real estate brokerage services in Class 36 and construction, maintenance, and renovation of real property in Class 37;¹⁷ and



- for a variety of services including real estate services, namely, real estate agency services, real estate investment services, and real estate acquisition services; real estate management; providing information relating to real estate affairs via the internet in Class 36.¹⁸

The remainder of the registrations submitted are for services that are distinguishable from Petitioner’s and Respondent’s services (e.g., architecture and interior design services, engineering services or hotel services).¹⁹ But even if we were

¹⁵ Applicant did not attempt to challenge the commercial strength of Petitioner’s marks by introducing evidence of third-party marketplace trademark uses of BH. *See Juice Generation*, 794 F.3d at 1338-39 (evidence of third-party trademark use bears on commercial strength under the sixth *DuPont* factor).

¹⁶ We note that Registration No. 4702759 at 17 TTABVUE 13 is an expired registration. A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act. *In re Inn at St. John’s, LLC*, No. 87075988, 2018 WL 2734893, at *3 (TTAB 2018).

¹⁷ 17 TTABVUE 8.

¹⁸ *Id.* at 11.

¹⁹ *See, e.g., id.* at 15-22. There is no evidence of record to support a finding that the noted services are related or similar to the relevant services identified in Respondent’s registration

to consider the other third-party registrations, we note that they all contain additional wording or designs that make them less similar to the '246 mark and '575 mark than Respondent's mark is. *See Sabhnani*, 2021 WL 6072822, at *13 (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”).

The two third-party registrations listed above are the most pertinent, but unlike Petitioner’s and Respondent’s marks, do not display BH as the dominant term in the composite mark. In both registrations, BH appears in equal or smaller size, and in the same font or color as the additional letters or terms. Further, Petitioner has

submitted a copy of a license it has regarding the **BHOM** mark.²⁰ But, even without

the license regarding **BHOM** and even if BH was a dominant element of the two third-party registrations, two registrations are insufficient to limit the scope of protection of the marks in the '246 registration and '575 registration. *See Charger Ventures*, 64 F.4th at 1383 (one third-party registration and about twenty-four third-

or Petitioner’s registrations and as such, these third-party registrations are of little probative value. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328 (Fed. Cir. 2017) (applicant did not offer evidence or adequately explain why third-party registered marks weakened the cited mark for different goods); *Omaha Steaks*, 908 F.3d at 1324-25 (Board erred in considering marks for unrelated goods); *see also Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (cleaned up).

²⁰ Kutach Rebuttal Declaration, 18 TTABVUE 2-3 at ¶¶ 3-5, 9-14. Petitioner is a member of B.Hom Student Living LLC, owner of the **BHOM** registration, and has a license to use the **BHOM** mark.

party uses of a SPARK-formative mark insufficient to limit protection); *Sabhnani*, 2021 WL 6072822, at *12 (six third-party registrations); *Inn at St. John's*, 2018 WL 2734893, at *3-4 (four third-party registrations and no third-party uses were “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in *Jack Wolfskin* and *Juice Generation*).

In sum, Respondent's evidence under this factor does not limit the scope of protection of Petitioner's '246 registration and '575 registration. The sixth *DuPont* factor is neutral.

b) Fifth *DuPont* Factor

Turning to commercial strength or fame under the fifth *DuPont* factor, “[a] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Omaha Steaks Int’l, Inc. v Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992)). Such strength rests on the extent to which “a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Joseph Phelps Vineyards Holdings, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1324-25 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)). In the context of a likelihood of confusion analysis, the commercial strength of a mark is not a binary factor. Rather, it “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *Palm Bay Imps.*, 396 F.3d at 1374-75).

Under the fifth factor, commercial strength or fame may be measured not only directly by consumer surveys or declarations but also indirectly by the volume of sales and advertising expenditures in connection with the identified goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; the general reputation of the goods or services; and social media presence. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, No. 91199352, 2014 WL 343269, at *6 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). Depending on the industry, some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose*, 293 F.3d at 1375.

“A high degree of fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use.” *The Heil Co. v. Tripleye GmbH*, No. 91277359, 2021 WL 4925901, at *19 (TTAB 2024). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark falls on the higher end of the commercial strength of fame spectrum to clearly prove it. *Id.*; *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, No. 91160856, 2007 WL 749713, at *5 (TTAB 2007) (citation omitted), *cited in Coach Servs.*, 668 F.3d at 1367.

Petitioner’s Chief Marketing Officer testifies that Petitioner “commenced use of the BH mark in connection with real estate on or about 1989²¹ throughout the U.S.;²² that it is the “21st largest multifamily owner-operator in the country,” is currently in the National Multifamily Housing Council’s Top 10 and received the Proptech Property Management Innovation Award in 2022;²³ that “from 2021 through 2023 [it] spent more than \$20,000,000 in online advertisements”;²⁴ and that it has “numerous websites to promote its properties and services” as well as using social media to promote its business.²⁵

Petitioner did not break down advertising and sales per each pleaded mark, and its evidence of awards, advertising and promotion expenditures and efforts, is provided without context, such as market share, sales or advertising figures for comparable types of services, or consumer exposure to enable us to determine the extent to which Petitioner’s efforts and expenses may indicate the well-known nature of its marks and to determine whether consumers recognize the marks. *See Omaha Steaks Int’l*, 908 F.3d at 1320 (quoting *Bose*, 293 F.3d at 1375 (“raw numbers alone in today’s world may be misleading.”)). As explained in *Omaha Steaks*, “a 30-second spot commercial shown during a Super Bowl football game may cost a vast sum, but

²¹ Kutach Declaration, 12 TTABVUE 2, ¶ 5.

²² *Id.* at 4-5, ¶ 9; *id.* at 75-310 (various business registrations or agreements with third-parties all of which involve Petitioner in various states including Texas, Arizona, Colorado, Florida, Georgia, Kansas, Missouri, Tennessee, Iowa, and Wisconsin).

²³ *Id.* at 5-6, ¶¶ 14-16.

²⁴ *Id.* at 6, ¶ 18.

²⁵ *Id.* at 6, ¶¶ 19-20; Exhibits 4-5, *id.* at 311-532 (archived copies of LIVEBH.COM, FACEBOOK.COM, INSTAGRAM.COM, and LINKEDIN.COM).

the expenditure may have little if any impact on how the public reacts to the commercial message.” *Id.* There is no context about Petitioner’s ranking as the National Multifamily Housing Council’s Top 10 or the Proptech Property Management Innovation Award, e.g., how many other companies were considered for or awarded these titles, how many companies are in the industry, or the criteria for winning the awards.

In short, we cannot accurately gauge Petitioner’s level of success without evidence regarding its market share, how its BH services rank in terms of sales in the trade, or how much consumer exposure there has been to its advertising and promotional efforts. *See id.*; *In re GJ & AM, LLC*, No. 86858003, 2021 WL 2374670, at *21 (TTAB 2021) (“Our precedents have long alerted practitioners to the fact that the absence of evidence of competitive contextual information may limit the probative value that we might otherwise accord advertising and sales numbers in the acquired distinctiveness inquiry.”). That said, Petitioner’s decades of use and on-line advertising expenditures of \$20 million from 2021-2023 is notable, even without context.

We find that, taken together, the evidence discussed above suggests some level of commercial success and brand recognition under the fifth *DuPont* factor.

c) Summary

Based on the evidence as a whole, we find Petitioner has achieved some recognition in its BH marks through advertising, use for several decades and some industry awards but based on this record we cannot say the marks are commercially strong. We find that the fifth *DuPont* factor regarding fame and commercial success of Petitioner’s BH marks in connection with real estate and property related services

weighs slightly in favor of a finding that confusion is likely. The evidence related to the sixth factor, conceptual weakness, does not limit the scope of protection of Petitioner's '246 registration and '575 registration and is neutral. Thus, we find that Petitioner's marks are entitled to the slightly more than the normal scope of protection accorded registered marks.

3. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of the marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361. Given that some of the relevant services, as identified, are legally identical, and others are closely related, “the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines.” *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 877 (Fed. Cir. 1992); *see also Bridgestone Am. Tire Operations, LLC v. Federal Corp.*, 673 F.3d 1330, 1337 (Fed. Cir. 2012).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs.*, 668 F.3d at 1368. The focus is on the recollection of the average consumer, who normally retains a general rather than a specific impression of trademarks. *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, No. 91270181, 2024 WL 1638376, at *5 (TTAB 2024) (quoting *In re i.am.symbolic, llc*, No. 85916778, 2018 WL 3993582, at *4 (TTAB 2018)).

“No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (CCPA 1974)). On the other hand, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

For ease of reference, Respondent’s mark is  and Petitioner’s relevant

marks are BH COMPANIES in standard characters and .

Marks that share arbitrary letter combinations such as BH generally have been found to be similar because it is difficult for consumers to distinguish between similar letter combinations. *See Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990) (“Because it is hard to distinguish between these letters, the mark TMM is confusing with TMS”); *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 508 (CCPA 1935) (“We think that it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words, or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely”); *B.V.D. Licensing Corp. v. Rodriguez*, No. 91157529, 2007 WL 616036, at *8 (TTAB 2007) (“Several

cases state that marks involving letter combinations are likely to be inherently difficult to remember and, therefore, consumers are more susceptible to confusion or mistake than with word marks.”) (citations omitted). “Initials, by their very nature, are abbreviations, a shortened version designed to be comprehended at a glance. If the number of letters is the same, and there is a significant overlap in the letters used, that is generally sufficient to sustain a claim of similarity.” *Continental Connector Corp. v. Continental Specialties Corp.*, 492 F.Supp. 1088, 1095-96 (D. Conn. 1979).

In comparing the parties’ marks, Respondent’s mark incorporates the entire literal portion of the ’246 mark appearing in a similar font and the dominant portion of the ’575 mark.²⁶ While there is no explicit rule that we must find marks similar where one party’s mark incorporates the entirety of the other party’s mark, the fact that it does typically increases the similarity between the two. *See, e.g., China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 1341 (Fed. Cir. 2007) (applicant’s mark CHI PLUS is similar to opposer’s mark CHI both for electric massagers); *Double Coin Holdings*, 2019 WL 4877349, at *8 (quoting *Hunter Indus.*,

²⁶ COMPANIES has been disclaimed in the ’575 mark and is therefore less significant in distinguishing the marks. *See Cunningham*, 222 F.3d at 947 (“the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.”) (quotation omitted); *In re Zuma Array Ltd.*, No. 79288888, 2022 WL 3282655, at *7 (TTAB 2022) (“Applicant ‘disclaimed exclusive rights in the term ‘Smart,’ thus conceding that ‘smart’ is merely descriptive of electronic sensor modules.”) (citing *In re Six Continents Ltd.*, No. 88430142, 2022 WL 407385, at *8 (TTAB 2022) (disclaimer of the word SUITES in mark ATWELL SUITES “is a concession that ‘Suites’ is not inherently distinctive”). Disclaimed matter that is descriptive of, or generic for, a party’s services is typically less significant or less dominant when comparing marks²⁶ and the non-source identifying nature of COMPANIES and the disclaimer thereof constitutes a rational reason for giving the term less weight in our analysis. *See Detroit Athletic*, 903 F.3d at 1305.

Inc. v. Toro Corp., No. 91203612, 2014 WL 1649332, at *11 (TTAB 2014) (“[L]ikelihood of confusion has often been found where the entirety of one mark is incorporated within another.”). Further, BH is a prominent element of Respondent’s mark. BH is displayed in the center and is the largest portion of the mark in terms of size, position and emphasis. While BLACKHORSE is also displayed in the center, superimposed over BH, it is in a smaller font, forming part of the BH letters.

There is nothing in the record to indicate what the BH letters in Petitioner’s marks stand for, or that consumers would routinely understand the BH letters to have a particular connotation. BH in Petitioner’s marks appears to be arbitrary. As asserted by Respondent,²⁷ the presence of BLACKHORSE contributes to the connotation of Respondent’s mark as a whole, and certainly lends something to Respondent’s mark that is not present in Petitioner’s marks.²⁸ Also, the presence of BLACKHORSE may reduce the visual similarities of the marks in a side-by-side comparison or help to differentiate the parties’ marks in sound when fully articulated. However, as noted, the BH letters in Respondent’s mark dominate, and any contribution of BLACKHORSE to the appearance, sound, connotation and overall commercial impression of Respondent’s mark would be outweighed by the dominant letters. See *B.V.D. Licensing Corp.*, 2007 WL 616036, at *8 (citing *Chemetron Corp. v. NRG Fuels Corp.*, No. 175309, 1968 WL 8096, at *2-3 (TTAB 1968) (Board sustained an opposition to registration of the mark NRG, with a flame design, set in a circle carrier,

²⁷ 21 TTABVUE 13-14.

²⁸ 21 TTABVUE 20 (Respondent asserts that it is using the initials of its name, BLACKHORSE).

in view of the opposer's prior registrations of NCG alone or with other design elements).

In other words, the addition of BLACKHORSE in Respondent's mark to the letters BH will not necessarily preclude likelihood of confusion. *See Charger Ventures*, 64 F.4th at 1382 (citing *Detroit Athletic*, 903 F.3d at 1304-05). If a portion of both marks is the same, then the marks may be confusingly similar notwithstanding some differences. *See, e.g., Charger Ventures*, 64 F.4th at 1382 ("an additional word or component may technically differentiate a mark but do little to alleviate confusion"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1266 (Fed. Cir. 2002) (similar commercial impression even though applicant's mark PACKARD TECHNOLOGIES, with "TECHNOLOGIES" disclaimed, does not incorporate every feature of opposer's HEWLETT PACKARD marks); *Double Coin Holdings*, 2019 WL 4877349, at *8 ("likelihood of confusion often has been found where the entirety of one mark is incorporated within another.") (quoting *Hunter Indus., Inc. v. Toro Co.*, No. 91203612, 2014 WL 1649332, at *11 (TTAB 2014)). Customers familiar with Respondent's services may mistakenly associate Petitioner's BH marks with Respondent or assume that the services have a common source, viewing Petitioner's BH marks as an abbreviated form of Respondent's BH BLACKHORSE mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 1073 (Fed. Cir. 1989); *Marshall Field & Co. v. Mrs. Fields Cookies*, No. 16572, 1992 WL 421449, at *14 (TTAB 1992) ("companies are frequently called by shortened names, such as Penney's for J.C. Penney's ... and Bloomies for

Bloomingtondale's"); *Big M. Inc. v. U.S. Shoe Corp.*, No. 349619, 1985 WL 71976, at *3 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the 'T.H.' [in T.H. MANDY] in referring to registrant's stores"). Even those consumers who notice and remember the differences in the marks, or who are knowledgeable about the source of Respondent's services, are likely to believe, in view of the overall similarities of BH, that the relevant services are somehow related.

Additionally, marks presented in standard characters, such as Petitioner's BH COMPANIES, are not limited to any particular depiction. *Cunningham.*, 222 F.3d at 950 ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); *In re Cox Enters. Inc.*, No. 76591278, 2007 WL 117511, at *5 (TTAB 2007) ("We must also consider that applicant's mark, presented in typed or standard character form, is not limited to any special form or style as displayed on its goods"). The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Viterra, Inc.*, 671 F.3d 1358, 1363 (Fed. Cir. 2012); *In re Aquitaine Wine USA, LLC*, No. 86928469, 2018 WL 1620989, at *5 (TTAB 2018). Because BH COMPANIES is registered without stylization or design, it could be displayed in all capital letters with COMPANIES superimposed over BH in a similar manner in which Respondent's mark is displayed.

Comparing the marks in their entirety, we find that there are similarities between the marks in terms of appearance, sound, connotation and commercial

impression, particularly because the marks share BH, which is the only or dominant element of Petitioner's marks and is a clearly recognizable and prominent element in Respondent's mark.²⁹ *See In re SL&E Training Stable, Inc.*, No. 78806669, 2008 WL 4107225, at *4 (TTAB 2008). On the whole, the first *DuPont* factor weighs in favor of finding a likelihood of confusion. *See Double Coin Holdings*, 2019 WL 4877349, at *9.

4. Actual Confusion

The eighth *DuPont* factor contemplates the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361.

Respondent argues, supported by the testimony of its principal David Alger, that the parties have co-existed for years but that Petitioner has shown no instances of actual confusion.³⁰ Mr. Alger testifies that “not a single customer or prospective customer has ever confused Respondent with Petitioner”³¹ even though Respondent started use in April 2020; has advertising via its social media and website that is “national in nature”;³² and “advertises on construction signs, t-shirts, hats, posters, buildings, work vehicles, community banners for donations, and local education

²⁹ Although we have pointed to the identical dominant portions of the marks, we acknowledge the fundamental rule that the marks must be considered in their entirety. *See Jack Wolfskin*, 797 F.3d at 1371; *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (CCPA 1974). We note the specific differences between the marks in their entirety, but these differences are outweighed by the similarities of the marks.

³⁰ 21 TTABVUE 19; Alger Declaration, 16 TTABVUE 5, ¶ 18.

³¹ Alger Declaration, 16 TTABVUE 5, ¶ 18.

³² *Id.* at 4, ¶ 13.

foundations”³³ with advertising and promotional expenditures of “\$10,000 to \$15,000 per year.”³⁴

Absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Respondent of its mark for a significant period of time in the same markets as those served by Petitioner and its marks. *In re Opus One, Inc.*, No. 75722593, 2001 WL 1182924, at *8-9 (TTAB 2001); *Gillette Can. Inc. v. Ranir Corp.*, No. 91082769, 1992 WL 174453, at *6 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, No. 91157982, 2007 WL 196406, at *5 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred).

When trial began in October 2023, Respondent had been using its mark for a little over three years, hardly lengthy. Respondent also provides no information about the extent of consumer exposure or scope (e.g., geographic locations) regarding its advertising efforts, and its advertising expenditures are seemingly modest. We do not know whether Respondent’s services have been promoted in the same locations as Petitioner or if there is an opportunity for consumers to encounter both Respondent and Petitioner’s services or related advertising. Even though the parties have both used their marks, there is no evidence that persuades us that the relevant consumers

³³ *Id.* at ¶ 12.

³⁴ *Id.* at ¶ 14.

have encountered both parties' relevant services. The length and coverage of the period of co-existence suggest that there has not been a meaningful opportunity for confusion to have occurred. *See Barbara's Bakery*, 2007 WL 196406, at *5; *cf. KME Ger. GmbH v. Zhejiang Hailang Co.*, No. 91267675, 2023 WL 6366806, at *21 (TTAB 2023) (“[T]he parties have only used their respective marks contemporaneously in the United States with their respective goods and services for, at most, three years (most of which occurred during the worldwide COVID pandemic.”). Moreover, the test under Section 2(d) is likelihood of confusion, rather than actual confusion. *See Weiss Assocs.*, 902 F.2d at 1549.

Based on the evidence of record, we cannot find that Respondent's use and advertising have been so substantial that the absence of actual confusion is surprising or legally significant. *See Time Warner Ent. Co. L.P. v. Jones*, No. 75352605, 2002 WL 1628168, at *11 (TTAB 2002). This factor is neutral.

5. Purchasing Care

The fourth *DuPont* factor relates to “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. Consumer sophistication, or a heightened degree of care when making a purchasing decision, may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (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 items are likely to be made with a lesser degree of care, increasing the likelihood of consumer

confusion. *Palm Bay Imps.*, 396 F.3d at 1376 (“Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.”).

Respondent argues that both parties are “in the real estate industry, dealing with expensive properties. The prospective consumer would not be in a hurry, would be highly informed, and would never confuse the [Respondent] with the Petitioner.”³⁵ consumers “use a high degree of care when making their purchasing decisions.”³⁶

However, “[b]oard precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014). For example, the parties’ relevant services involve project management services in the construction field, leaving open the possibility that customers could include individual homeowners or renters, ordinary members of the public, in need of project management of their relatively modest construction needs, e.g., home repairs. *See S.W. Mgmt., Inc. v. Ocinoled, Ltd.*, No. 94002242, 2015 WL 4464550, at *17 (TTAB 2015) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein).

³⁵ 21 TTABVUE 20.

³⁶ 27 TTABVUE 13. Respondent provides no evidence to support its contention that the customers for the parties’ services will exercise any particular level or degree of care and attorney argument is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018).

Moreover, “[c]onfusion of letter combinations is a concern even when the prospective purchasers of the goods [or services] are sophisticated purchasers.” *B.V.D. Licensing Corp.*, 2007 WL 616036, at *8 (citations omitted).

We find the fourth *DuPont* factor, the degree of purchaser care, to be neutral.

6. Respondent’s Purported Good Faith Adoption

“A party’s bad faith in adopting a mark is relevant to the thirteenth *DuPont* factor, which includes any other established fact probative of the effect of use.” *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (citing *DuPont*, 476 F.2d at 1361). Here, Respondent urges that its good faith adoption should weigh against a conclusion that confusion is likely arguing that there has been no bad faith on its part as it uses its initials of its own name, BLACKHORSE, and never imagined anyone would object to its mark.³⁷ While bad faith (i.e., intent to trade on a senior user’s goodwill) tends to show that confusion is likely, *see, e.g., Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891 (Fed. Cir. 1988), the converse is not true. Evidence that a party acted in good faith in adopting a mark has little probative value. *See, e.g., Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, No. 91197241, 2012 WL 953406, at *8 (TTAB 2012) (“Good faith adoption of a mark will not prevent a finding of likelihood of confusion.”); *Mag Instrument, Inc. v. The Brinkmann Corp.*, No. 91163534, 2010 WL 3253200, at *11 (TTAB 2010) (evidence that a party is seeking to register a mark in good faith does very little to obviate a

³⁷ 21 TTABVUE 20.

finding of a likelihood of confusion and is not a significant factor in our likelihood of confusion analysis).

This factor is neutral in our analysis.

IV. Conclusion

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; and to “explain the results of that weighing;” and “the weight [we] assigned to the relevant factors.” *Charger Ventures*, 64 F.4th at 1384. “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, 1346 (Fed. Cir. 2010).

Respondent effectively conceded the relatedness and similarity of the services and we determined that Respondent’s “business project management services for construction projects” in Class 35 are similar and related to Petitioner’s “construction project management services in the field of commercial and residential real estate” in Class 37 of the ’575 registration and “construction project management services in the field of residential buildings” in Class 37 of the ’246 registration. We found Respondent’s Class 37 services, “construction project management services” are legally identical to and encompass Petitioner’s more narrowly identified “construction project management services in the field of real estate renovation of commercial and residential property; construction project management services in the field of commercial and residential real estate” in Class 37 identified in the ’575 registration and “construction project management services in the field of residential buildings” in Class 37 of the ’246 registration. We also determined that Respondent’s services

are presumed to move in all normal trade channels of the construction industry, including Petitioner's more narrowly defined trade channels, i.e., commercial and residential, and the parties' services may be rendered to the same or similar class of consumers. Thus, the second and third *DuPont* factors weigh in favor of finding likelihood of confusion.

We found that the fifth *DuPont* factor regarding fame and commercial success of Petitioner's marks weighs, at best, slightly in favor of a finding that confusion is likely and the evidence related to the sixth factor, conceptual weakness, neutral.

As to the comparison of the marks under the first *DuPont* factor, we found that there are similarities between the marks in terms of appearance, sound, connotation and commercial impression, particularly because the marks share BH which is the only or dominant element of Petitioner's marks and is a clearly recognizable and prominent element in Respondent's mark.

As to the factors regarding instances of actual confusion, the sophistication of the consumers, and Respondent's purported good faith adoption of its mark, we found the factors to be neutral. There are no factors that weigh against likelihood of confusion.

Balancing the factors, we find that Petitioner has shown, by a preponderance of the evidence, that confusion is likely when Petitioner's and Respondent's marks are used with their relevant services.

Decision: The petition to cancel is granted as to both classes in Respondent's registration.