



Examination of Marks for Likelihood of Confusion

U.S. Patent and Trademark Office



What is likelihood of confusion?

- The law that governs trademark registration in the United States is the Lanham Act.
- Section 2(d) of the Lanham Act:
 - No trademark...shall be refused registration...unless it...so resembles a mark registered in the Patent and Trademark Office...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.”



Likelihood of confusion

- When determining whether there is a likelihood of confusion between two marks, United States Patent and Trademark (USPTO) examiners use a number of factors originally set out in U.S. court decision, *In re Du Pont de Nemours & Co.* 476 F.2d 1357 (C.C.P.A. 1973).
- These factors are called the **DuPont factors**.



Likelihood of confusion: The DuPont factors

- Similarity of the **marks** in:
 - Appearance
 - Sound
 - Connotation
 - Commercial impression
- Similarity, if any, between the **goods/services** associated with each mark
- Similarity, if any, between the **trade channels** in which the goods are bought and sold

Determining whether two marks are confusingly similar



- USPTO considers two primary factors when considering if a likelihood of confusion exists:
 - If the **marks** are **identical** or **similar**; and
 - If the **goods and/or services** associated with the marks are **identical** or **related**



Relatedness of goods and/or services

- The question is **not** whether consumers will believe that goods and/or services are similar, but whether they will believe that the goods or services **originate from the same source**.
- Goods do not have to be identical or even competitive, just **related**.
 - Example: Pasta and tomato sauce



Comparison of the marks

- Are the marks **identical**?
- If the marks are not identical, are they **similar**?
 - Do they have the same **sound, appearance, or meaning**?
 - Similarity in any **one** factor (sound, appearance, or meaning) is sufficient to find a likelihood of confusion; similarity in all of these elements weighs heavily in favor of a likelihood of confusion.

Similarity of the marks: Word marks



- Marks with **multiple words**:
 - If one or both of the marks in question is made up of multiple words, the determination of whether the two marks are similar depends on whether:
 - One of the terms is dominant; and
 - If so, whether the dominant term is the term that is common to each of the marks; e.g., PRECISE PRICING versus PRECISE LIFE

Similarity of the marks: Marks comprised solely of designs



- Marks with **designs only and no text**:
 - If both of the marks in question are made up of only designs, the determination of whether the two marks are similar depends on the overall commercial impression conveyed by such marks, not on specific differences.

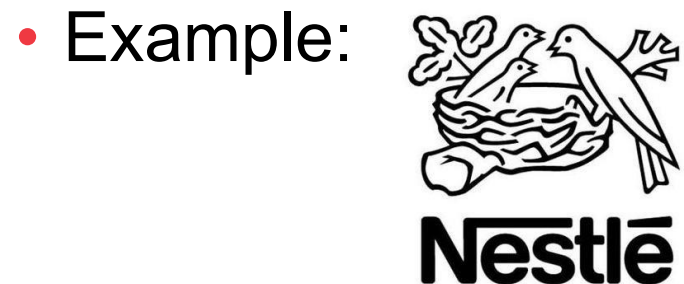
Similarity of the marks: Composite marks



- Marks with **words and designs**:
 - If one or both of the marks in question is made up of words and designs, the determination of whether the two marks are similar depends on whether:
 - One of the features is dominant; and
 - If so, whether the dominant feature is common to each of the marks
 - Greater weight is often given to this dominant feature

Comparison of composite marks

- Comparing marks comprised of both **words and designs**:
 - Generally, in determining whether two marks are similar, USPTO examiners accord more weight to the word element of the mark, because purchasers typically refer to products or services by the word rather than the image.





Comparison of the marks

- Examining attorneys must consider marks as a whole, but can weigh individual components.
- There is nothing improper in stating that . . . 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. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)

Comparison of the marks: Meaning



- Are the marks similar in *meaning*?
- Consider:
 - Similarity in meaning or connotation may be sufficient to find a likelihood of confusion because average purchasers retain only a general, rather than specific, impression of trademarks.

Additional considerations: Balancing Test

- The *more similar* the marks, the *less related* the goods and/or services need to be to find a likelihood of confusion.
- The *less similar* the marks, the *more related* the goods and/or services need to be to find a likelihood of confusion.

Case example



for "legal services"

vs.

CREATIVITY LAW

for "legal services for the enforcement, licensing, use, establishment and maintenance of intellectual property rights"

Case example



**BATTLE
FITNESS**

vs.

**BODY
BATTLE
FITNESS**

for “personal fitness training, physical fitness and physical exercise instruction, fitness, and exercise classes”

for “personal fitness training services”

Case example



Condiment, namely, pepper sauce

vs.

CHANTICO

Agave sweetener



Beer

vs.

DEADBIRD

Wine



Thank you
Questions?



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