

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# How to Determine Likelihood of Confusion during Examination of an Application

Elizabeth J. Winter

Interlocutory Attorney, Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office

May 20, 2024

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# What is likelihood of confusion?

- The statutory legal standard for likelihood of confusion under federal law for trademark registration in the United States is set forth in the Lanham Act or Trademark Act of 1946, often referred to as the “Trademark Act.”
- 15 United States Code (U.S.C.) Section 1051 *et seq.*
- The specific section of the Trademark Act that governs likelihood of confusion is Section 2(d) (15 U.S.C. 1052(d)), which states, in part:  

“No trademark...shall be refused registration on the principal register ... 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 Analysis

- When determining whether there is a likelihood of confusion between two marks, 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**.

# Factors considered in determining likelihood of confusion

- Degree to which the marks are similar in appearance, sound, connotation, or commercial impression
- Similarity, if any, between the goods/services associated with each mark
- Similarity, if any, between the trade channels in which the goods/services are bought and sold
- Whether buyers of the goods/services typically make their purchases on impulse or after careful reflection

# More factors

- The fame, if any, of the prior mark
- How many, if any, similar marks are used on or in connection with similar goods/services
- The nature and extent of actual confusion, if any
- If there has not been actual confusion, the length of time, and the conditions under which, confusion was avoided
- Whether the mark is used on a variety of goods/services
- The nature and extent, if any, of interaction between the two parties
- The extent to which the party applying to register the mark is entitled to prevent others from using the mark
- The extent of potential confusion
- Any other established fact probative of the effect of use

# Determining whether two marks are confusingly similar

- The main two *DuPont* factors considered are whether:
  - the marks are identical or similar;
  - the goods and/or services associated with the marks are identical or related.

# 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.



# Comparison of the goods/services

- Once it is determined that the respective marks are the same or similar, the office must consider the **relationship between the goods/services** to determine whether a likelihood of confusion exists.
  - Are the goods and/or services **identical**?
  - If not identical, are they **closely related**?

# Is there a likelihood of confusion?

- **Example 1:**
  - Applicant: BULLET for bicycle parts
  - Registrant: BULLIT for bicycles and bicycle frames
- **Example 2:** 
  - Applicant: SEYCOS for watches
  - Registrant: SEIKO for watches and clocks

# Is there a likelihood of confusion?

- Example 3:

- Applicant: CHANTICO for agave sweetener

- Registrant:  for condiment, namely, pepper sauce

# Is there a likelihood of confusion?

- **Example 4:**

- Applicant: DEAD BIRD BREWING COMPANY  
for beer

- Applicant:  for beer

- Registrant: DEADBIRD for wine

# Is there a likelihood of confusion?

- **Example 5:**
  - Applicant: BONEYARD BREW sauces
  - Registrant: BONE YARD restaurant and bar services, take-out restaurant services, catering services

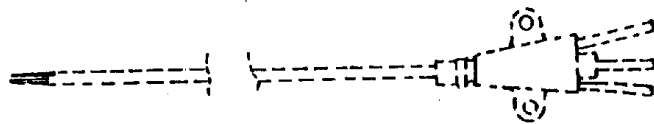
# Is there a likelihood of confusion?

- **Example 6:**

- Applicant: The color teal for rib-reinforced medical guiding sheaths



- Registrant: The color blue for catheters



# Tips for Applicants

- **Call the assigned Examining Attorney**
  - Misconception: examining attorneys are **not** incentivized to refuse applications.
  - Call early about refusal or requirement in Office Action.
  - Educate on characteristics of industry for goods/services.
  - Possible resolution of requirement by phone and Examiner's Amendment
  - Informal communications are made part of the record.
- **Call Trademark Assistance Center**
  - To get general information on application status
  - +1 571-272-9250 or 800-786-9199, or TrademarkAssistanceCenter@uspto.gov

תודה  
Dankie Gracias  
Спасибо شکرًا  
Merci Takk  
Köszönjük Terima kasih  
Grazie Dziękujemy Děkojame  
Ďakujeme Vielen Dank Paldies  
Kiitos Täname teid 谢谢  
**Thank You** Tak  
感謝您 Obrigado Teşekkür Ederiz  
Σας ευχαριστούμε 감사합니다  
ขอบคุณ  
Bedankt Děkujeme vám  
ありがとうございます  
Tack

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