

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: January 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Halo Trademarks Limited*

*v.*

*Halo2Cloud, LLC*  
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Opposition No. 91220193  
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William J. Seiter of Seiter Legal Studio  
for Halo Trademarks Limited.

Wm. Tucker Griffith and Mallory S. Hein of McCormick Paulding & Huber LLP  
for Halo2Cloud, LLC.

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Before Wellington, Lykos and Gorowitz,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 5, 2014, Halo2Cloud, LLC (“Applicant”) filed an application to register on the Principal Register the mark **POWERED BY HALO** in standard characters for “Handbags, shoulder bags, duffel bags, tote bags, briefcases, purses, pocketbooks, clutches, wallets, backpacks, luggage and suitcases; Handbags, shoulder bags, duffel bags, tote bags, briefcases, purses, pocketbooks, clutches, wallets, backpacks, luggage

and suitcases with embedded portable power chargers and portable battery chargers, and accessories therefor, namely, power supply cables, connector cables, and adapters for charging and connecting with consumer electronic devices, namely power supply adapters, electric adapters, plug adapters, and interchangeable adapter tips for use with power supply and connector cables” in International Class 18.<sup>1</sup> The application was filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

Halo Trademarks Limited (“Opposer”) opposes the registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s previously used HALO marks. In the notice of opposition, Opposer pleaded ownership of Application Serial No. 77963092 for the mark **HALO** in standard characters and Application Serial No. 77963111 for the composite mark displayed below,<sup>2</sup>



both filed on March 19, 2010 as intent-to-use under Section 1(b) of the Trademark Act on the Principal Register for various goods and services, including “Leather and

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<sup>1</sup> Application Serial No. 86271358. As originally filed the application also included goods in International Classes 9 and 11 which were not the subject of the instant opposition. On November 3, 2016, the Board granted as conceded Applicant’s uncontested motion to divide the application; the goods identified in unopposed International Classes 9 and 11 have been transferred to a newly created “child” application.

<sup>2</sup> The description of the composite mark is as follows: “The mark consists of the wording “HALO” within a rectangle background adjoined to a smaller rectangle having a triangular design above and below the smaller rectangle.” Color is not claimed as a feature.

imitations of leather and goods made of these materials and not included in other classes, namely all purpose carrying bags, key fobs, leather cases for holding wine bottles, briefcases, portfolios; suit carriers; trunks and travelling bags; bags for carrying sports equipment and clothing, bags for holding computers, holdalls; wallets and purses; handbags; travelling sets, namely make-up bags sold empty, toiletry bags sold empty; valises; walking sticks” in International Class 18.<sup>3</sup> Notice of Opposition ¶ 1; 1 TTABVUE 4-5.<sup>4</sup>

In its answer, Applicant denied the salient allegations in the notice of opposition except for admitting that it “made no use of its mark in Application Serial No. 86/271,358 on or before January 2010” and that “Applicant made no use of its mark in Application Serial No. 86/271,358 on or before March 19, 2010, the filing date of each of Opposer’s marks.” Applicant’s Answer ¶¶ 5 and 6; 4 TTABVUE 3. Applicant also asserted various defenses,<sup>5</sup> including that “[a]s a result of Applicant’s continuous

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<sup>3</sup> The remaining goods and services listed in both applications are “Furniture; mirrors; beds; chairs; bedsteads; benches; non-metal bins; cabinets; chests for toys, chests of drawers; coat stands; containers, namely non-metal containers for storage and transport; wood and plastic crates; cupboards; deckchairs; desks; draftsman’s tables; dressing tables; footstools; shelves and shelving; mattresses; office furniture; pillows; sideboards; sofas; statues of wood; statuettes of wood, wax, plaster or plastic; stools; table tops; tables; non-metal trestles for supporting tables; serving trolleys; work benches” in International Class 20 and “Retail store services in the field of home furnishings” in International Class 35.

<sup>4</sup> Citations to the record are by entry and page number to TTABVUE, the Board online docketing information and file database. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

<sup>5</sup> In addition to other affirmative defenses, Applicant also asserted the affirmative defense of failure to state a claim upon which relief may be granted. Insofar as Applicant neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d*, 565 F. App’x. 900 (Fed. Cir. 2014) (mem.).

use of several similar marks encompassing the term “HALO,” Applicant’s Halo House mark has developed significant goodwill among the consuming public and consumer acceptance of the goods and services offered by Applicant in conjunction with the applied for Mark and similar marks used by Applicant.” Answer - “Affirmative Defenses” ¶ 4; 4 TTABVUE 3.

The case is now fully briefed.

I. *The Record*

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), Applicant’s application file. In addition, the parties introduced the following:

A. *Opposer’s Evidence*

Opposer did not take any testimony. Rather, Opposer submitted a notice of reliance on the following:

- Printouts of Opposer’s pending Application Serial Nos. 77963092 and 77963111 from the USPTO Trademark Electronic Search System (“TESS”) database;
- Opposer’s First Set of Interrogatories and Applicant’s Responses thereto; and
- Dictionary definitions of the words “powered” and its root form “power”, as well as dictionary definitions of “by” and “halo.”

B. *Applicant’s Evidence*

Applicant likewise took no testimony, but submitted a notice of reliance on the following documents:

- Printouts of trademark registrations and pending applications owned by Applicant either consisting of or incorporating the term HALO (i.e. HALO2CLOUD.COM, GLOW HALO, HALO TAKE

CHARGE) from the USPTO Trademark Status and Document Retrieval (“TSDR”) database;

- Applicant’s First Set of Interrogatories and Opposer’s Responses thereto;
- Opposer’s admissions in its responses to Applicant’s First Set of Requests for Admission; and
- Articles from printed publications discussing Applicant’s HALO branded products such as O, The Oprah Magazine; Good HouseKeeping as well as online articles and website excerpts such as CNN Money and QVC.

## II. *Standing*

Standing is a threshold issue that must be proved in every inter partes case.<sup>6</sup> *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing ... must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *See Empresa Cubana del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A

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<sup>6</sup> Opposer correctly notes that Applicant has not challenged Opposer’s standing to bring the instant opposition; nonetheless, as plaintiff, Opposer must still prove its standing.

“real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

Opposer has made of record the TESS printouts of its pleaded pending applications. The arguable similarities of Opposer’s and Applicant’s applied-for marks and the identical nature of the goods in part which are evident from face of the TESS printouts of Opposer’s applications suffice to show that Opposer possesses a real interest in this case beyond that of a mere intermeddler and a reasonable basis for its belief of damage. *See, e.g., Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1548 (TTAB 2011). Accordingly, Opposer has established its standing.

### III. Section 2(d) Claim

We will now consider Opposer’s Section 2(d) claim, focusing on both applied-for Opposer’s standard character mark **HALO** and composite mark



for the goods identified therein.

#### A. Priority

To prevail on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must first prove that it owns “a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States ... and not abandoned...” Trademark Act Section 2, 15 U.S.C. § 1052.<sup>7</sup> Typically, in the

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<sup>7</sup> Applicant has not contested Opposer’s priority; nonetheless, as a critical element to Opposer’s Section 2(d) claim, it must be proven by Opposer as plaintiff in this case by a preponderance of the evidence.

absence of a registration, a plaintiff will establish its prior proprietary rights in a mark through testimony and documentary evidence showing actual use or use analogous to trademark use. See Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Here, however, Opposer seeks to rely on the constructive date of use of its previously filed trademark applications.<sup>8</sup>

Opposer may rely on the filing date of its intent-to-use application to establish constructive use of its mark on that date under the provisions set forth in Section 7(c) of the Trademark Act. See *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1845 n.7 (TTAB 1995). See also *Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d at 1548. As the TESS printouts of Opposer's pleaded applications show, their filing date of March 19, 2010 precedes the May 5, 2014 filing date of Applicant's application.

A caveat to this principle is that any judgment entered in favor of Opposer based on such constructive use is contingent upon the ultimate issuance of a registration. *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d at 1845 n.7 ("Section 7(c) provides that any judgment entered in favor of a party relying on constructive use —

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<sup>8</sup> Opposer also points to Applicant's admissions in its answer noted above and certain interrogatory responses and argues they establish Opposer's priority. Applicant's Answer ¶¶ 5 and 6; 4 TTABVUE 3; Applicant's Responses to Opposer's Interrogatory Nos. 6-9 submitted with Opposer's Notice of Reliance; 10 TTABVUE 29-31. The admissions and responses, standing alone, are insufficient to establish Opposer's priority.

whether that party is in the position of plaintiff or defendant in a Board proceeding — is contingent upon the ultimate issuance of a registration to that party.”). *See also Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d at 1548. Thus, even if Opposer can demonstrate a likelihood of confusion, it cannot prevent the issuance of a registration to Applicant on this ground until one of its own applications is registered, thereby perfecting its priority. *See id.*

B. *Likelihood of Confusion*

With this in mind, we now consider the issue of likelihood of confusion based on Opposer’s applications which have been pleaded and properly made of record, and which establish Opposer’s priority contingent ultimately upon registration. Opposer, as plaintiff in this proceeding, also bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the du Pont factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164, 64 USPQ2d 1375,

1380 (Fed. Cir. 2002) (citation omitted). These factors and the other relevant *du Pont* factors are discussed below.<sup>9</sup>

1. *The goods*

At the outset, we compare the parties' respective goods as they are identified in the applications at issue. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (goods as identified in involved application and registration compared); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also, Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Here, the involved application and Opposer's applications involve goods that are legally identical, at least in part. This is because Applicant's broadly worded "Handbags, ... briefcases ..." necessarily encompass Opposer's more narrowly identified "Leather and imitations of leather and goods made of these materials and not included in other classes, namely ... briefcases, ... handbags...". *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). In view thereof, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

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<sup>9</sup> In connection with the issue of likelihood of confusion, Applicant devotes much of its appeal brief to discussing the commercial success and media recognition of its HALO formative marks in connection with its consumer electronic products. Applicant's efforts in this regard are misguided inasmuch as the fame of a *plaintiff's* mark, not defendant's mark, is a factor in the *du Pont* analysis. *See du Pont*, 177 USPQ at 567.

2. *The established, likely-to-continue channels of trade and classes of consumers*

Because the goods are in part legally identical, and neither Opposer's applications nor Applicant's application contains any limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same for those identical goods. *See Stone Lion*, 110 USPQ2d at 1161 (goods as identified in involved application and registration compared); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). As such, the third *du Pont* factor – the similarity or dissimilarity of established, likely to continue trade channels – also favors a finding of likelihood of confusion.

3. *The similarity of the marks in their entirety as to appearance, sound, connotation and commercial impression*

We now turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression (*Palm Bay*, 73 USPQ2d at 1691, quoting *du Pont*, 177 USPQ at 577), keeping in mind that because Opposer's and Applicant's goods are in

part legally identical, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)). In this case, the average purchaser is the relevant consumer.

Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entirety. *Id.* See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, 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 a consideration of the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1161.

In comparing Applicant's standard character mark **POWERED BY HALO** with Opposer's standard character mark **HALO** and composite mark



we observe that both parties' marks are comprised, either in whole or in part, of the arbitrary word "halo." "When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion." *Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 188 USPQ 105, 106 (CCPA 1975). With regard to Applicant's mark **POWERED BY HALO**, the word "halo" constitutes the dominant element of the mark. The initial phrase "powered by" does little to detract from the dominance of the word "halo" but instead reinforces its prominence. "Powered" when used as a transitive verb with an object is defined as to "[s]upply (a device) with mechanical or electrical energy." Oxford Dictionary American English ([www.oxforddictionaries.com](http://www.oxforddictionaries.com)) submitted under Opposer's Notice of Reliance; 10 TTABVUE 59. The preposition "by" is defined as "through the agency or instrumentality of." Merriam Webster Dictionary ([www.merriam-webster.com](http://www.merriam-webster.com)) submitted under Opposer's Notice of Reliance; 10 TTABVUE 77. And "halo" is defined as "1 : a circle of light appearing to surround the sun or moon and resulting from refraction or reflection of light by ice particles in the atmosphere; 2 : something resembling a halo as a ....c : differentiated zone surrounding a central zone or object."

Merriam Webster Dictionary ([www.merriam-webster.com](http://www.merriam-webster.com)) submitted under Opposer's Notice of Reliance; 10 TTABVUE 93. In this context, despite the fact that the phrase "powered by" appears first, prospective consumers are likely to perceive the arbitrary term "halo" in **POWERED BY HALO** as the house mark of Opposer's HALO brand name. As such, the standard character marks, while slightly different in appearance and sound, are highly similar in connotation and commercial impression.

As to the graphics in Opposer's composite mark, we find that the common design element consisting of a rectangle upon which the word "halo" is superimposed fails to mitigate the similar sound, appearance, connotation and commercial impression of the marks. It is an often-recited principle that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See, e.g., Viterra*, 101 USPQ2d at 1911; *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). The remaining graphic appears to be a stylized electrical plug; its presence is also subordinate to the literal element "halo." Even if consumers were to place more emphasis on the stylized electrical plug, this enhances, not diminishes, the similarities with Applicant's mark

**POWERED BY HALO** since the phrase “powered by” could have the connotation of providing electricity.

We therefore find that the involved marks are similar in sound, appearance, connotation and commercial impression. In view of the forgoing, the first *du Pont* factor also favors a finding that confusion is likely.<sup>10</sup>

#### 4. *Balancing the du Pont factors*

We have carefully considered all evidence of record and Applicant’s arguments, even if not specifically discussed herein, as they pertain to the relevant *du Pont* factors. We treat as neutral any *du Pont* factors for which there is no evidence or argument of record.

In the present case, each of the *du Pont* factors discussed above favors a finding of likelihood of confusion. In view of the similarities in Opposer’s and Applicant’s marks, when used to identify goods that are legally identical in part in overlapping trade channels, prospective consumers are likely to mistakenly believe that the goods originate with or are somehow associated with the same entity. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)

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<sup>10</sup> Applicant relies on the doctrine of judicial estoppel in connection with the prosecution of Opposer’s application for the mark composite mark, citing to statements made by Opposer in office action responses. None of this is in the record; as noted above, only the TESS printout of the application has been made of record. And even if it were in the record, to the extent that Opposer took a contrary position, Opposer’s actions are “merely illuminative of shade and tone in the total picture confronting the decision maker” and cannot serve as an admission against interest or substitute for the Board in reaching its own ultimate conclusion on the record before us in this case. *See Interstate Brands, Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). *See also Stabilisierungsfonds fur Wein v. Zimmermann-Graeff KG*, 209 USPQ 434, 436 (TTAB 1980).

(likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and registration).

Accordingly, we find that Opposer has proved a likelihood of confusion under its Section 2(d) claim by a preponderance of the evidence.

**Decision:** The opposition is sustained, *contingent* upon the issuance of registration(s) of Opposer's Application Serial No. 77963092 and/or Application Serial No. 77963111. The time of filing an appeal or for commencing a civil action or for requesting reconsideration will run from the date of the present decision. *See* Trademark Act Section 21(a)(2), 15 U.S.C. § 1071(a)(2); Trademark Act Section 21(b)(1), 15 U.S.C. § 1071(b)(1); Trademark Rules 2.129 and 2.145. When either of Opposer's marks has registered or both of its applications become abandoned, Opposer should promptly inform the Board, so that appropriate action may be taken to terminate this proceeding.