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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Insurance Auto Auctions, Inc.

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Serial No. 77663407

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Amy Cohen Heller and Clay A. Tillack of Schiff Hardin for  
Insurance Auto Auctions, Inc.

William D. Jackson, Trademark Examining Attorney, Law Office 108  
(Andrew Lawrence, Managing Attorney).

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Before Quinn, Bucher and Wolfson,  
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Insurance Auto Auctions, Inc. filed, on February 4, 2009,  
an application to register the mark I-BID LIVE (in standard  
characters) ("LIVE" disclaimed) for "providing real-time online  
auction services, namely allowing potential buyers of salvage  
vehicles to bid in real time over the internet along with other  
live and internet bidders" in International Class 35. Applicant  
claims first use anywhere and first use in commerce on April 1,  
2004.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark shown below



("MOTORS" disclaimed) for "computerized on-line retail store services in the fields of automotive collectibles, memorabilia, and apparel; [and] organization of internet auctions" in International Class 35,<sup>1</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues that the marks and the services are different; that the marks target two different sets of sophisticated consumers who are able to distinguish the marks; and the marks have peacefully coexisted for seven years with no evidence of actual confusion. In urging reversal of the refusal, applicant submitted an excerpt of applicant's website.

The examining attorney maintains that the marks and the services rendered thereunder are similar. The examining

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<sup>1</sup>Registration No. 3585080, issued March 10, 2009. The registration includes the following description of the mark: "The mark is stylized with the drawing of a car departing from the letter 'D' in the word 'ibid' toward the letter 'M' of the word 'motors.'" The registration also states: "The wording 'ibid' has no meaning in a foreign language."

attorney is not persuaded by applicant's arguments based on the sophistication of purchasers or the peaceful coexistence of the marks. The examining attorney submitted third-party registrations to support his contention that the services are related.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn our attention to a comparison of the marks. In comparing the marks, we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, 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. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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.").

Where both words and a design comprise the mark (as in registrant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3

USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

In registrant's mark, the literal portion of the mark, IBID MOTORS, is the dominant portion, and is accorded greater weight over the design feature when comparing the cited mark to applicant's mark. Further, with respect to this word portion of registrant's mark, we give less weight to the highly descriptive word MOTORS that has been properly disclaimed. *In re Chatam Int'l. Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); and *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). The IBID portion, that is, the first portion of the mark, dominates registrant's mark, and this portion is most likely to be remembered and used by consumers in calling for and referring to registrant's services. Purchasers in general are inclined to focus on the first word or portion in a trademark, especially where the first word is followed by a highly descriptive term (as is the case with MOTORS). *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered"). See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692.

Applicant's mark is likewise dominated by the I-BID portion for the same reasons. The LIVE portion of the mark is highly descriptive and properly disclaimed and, thus, is less distinctive than the I-BID portion. As in the case of registrant's mark, I-BID is the first portion of applicant's mark, and is the part of the mark that is likely to be impressed upon the mind of a purchaser and remembered.

In discussing the dominant I-BID and IBID portions of the marks, we recognize that the marks ultimately must be compared in their entireties. Given the commonality of the dominant portion IBID and I-BID in each of the marks, we find IBID MOTORS and design and I-BID LIVE to be similar overall in sound and appearance. The use of a hyphen in applicant's I-BID portion does not distinguish the marks. *See Mag Instrument Inc. v. Brinkman Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (MAGNUM and MAG-NUM are essentially identical). Nor does registrant's use of lowercase font for the wording in its mark serve to distinguish the marks, especially inasmuch as applicant's mark is depicted in standard characters. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012) (a standard character mark is not limited to any particular font, size or style). *See also TMEP* § 1207.01(c)(iii) (8<sup>th</sup> ed. 2011).

As to meaning, we recognize that the addition of the word MOTORS and motor vehicle design in registrant's mark may give

the mark a somewhat more specific meaning as related to the subject of internet auction bidding. Further, we recognize that the words "I BID" are suggestive when considered in the context of online auction services. Any suggestiveness or difference in meaning, however, is insufficient to outweigh the similarities in appearance and sound.<sup>2</sup>

The similarities between the marks result in marks that engender similar overall commercial impressions. The similarity between the marks weighs in favor of a finding of likelihood of confusion.

With respect to the relatedness of the services, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the services in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions relating to the channels of trade and no

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<sup>2</sup>Applicant speculates that when encountering registrant's mark "the consumer can read the words together as 'ibid' [rather than 'I' and 'bid' separately], a term that refers to a prior source and captures the nature of the used vehicles sold by Registrant." This speculation is, to say the least, far-fetched. (Brief, p. 5).

limitations relating to the classes of purchasers, it is presumed that in scope the recitations of services encompass not only all the services of the nature and type described therein, but that the identified services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Further, it is not necessary that the respective services be identical or competitive (contrary to the gist of applicant's statement that the services are not in competition (Brief, p. 8)), or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services.

In the present case, registrant's services include "organization of internet auctions" while applicant's services are identified as "providing real-time online auction services,



namely allowing potential buyers of salvage vehicles to bid in real time over the internet along with other live and internet bidders." As identified, registrant's "organization of internet auctions" services are broadly worded, and must be presumed to encompass organization of internet auctions of all types, including real-time online auction services involving automobiles and salvage vehicles. Thus, applicant's and registrant's services, as set forth in the respective recitations of services, are very similar. As such, the services would be rendered to the same or similar classes of purchasers.

The examining attorney introduced several use-based third-party registrations, each showing a single mark registered for both types of services involved herein, that is, organization of internet auctions and on-line auction services. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed.

Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Applicant states that it operates in the salvage auto auction industry, offering total-loss, recovered-theft, fleet lease, dealer trade-in and collision damage rental vehicles. (Brief, p. 7). Applicant further asserts that registrant's internet platform allows automobile dealers to show their inventory which, according to applicant, does not include salvage vehicles. By referring to registrant's website (although not introduced as evidence), applicant appears to be attempting to limit the scope of registrant's services. Suffice it to say that applicant may not limit the scope of registrant's "organization of internet auctions" by argument or extrinsic evidence. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Applicant contends, at the very least, that registrant's broadly worded "organization of internet auction" must be "read in conjunction with and as ancillary to the other, more definite description of Registrant's services ["computerized on-line retail store services in the fields of automotive collectibles, memorabilia, and apparel"]. Thus, applicant argues that registrant's services should be read as covering only organization of internet auctions for automotive collectibles, memorabilia and apparel. (Brief, p. 9). We cannot agree.

Firstly, as pointed out by the examining attorney, registrant's recitation of services specifically appears in the Office's ID Manual. Secondly, and in any event, we have no authority to read any such restrictions or limitations into registrant's recitation of services. *In re Thor Tech Inc.*, 90 USPQ 1634, 1637-38 (TTAB 2009).

Further, to the extent that applicant's argument based on an alleged overbroad recitation of services in the cited registration constitutes a collateral attack on the registration, we agree with the examining attorney's assessment that such attack is impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods and/or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (8<sup>th</sup> ed. 2011). Accordingly, no consideration has been given to applicant's arguments in this regard.

In sum, the similarities between the services, both involving auction-type services rendered via the internet, and the similar classes of purchasers, are factors that weigh in favor of a finding of likelihood of confusion.

Applicant contends that purchasers of applicant's and registrant's services are sophisticated. Firstly, the record is devoid of any evidence to support this contention. Secondly, even assuming that consumers of applicant's and registrant's services are sophisticated when it comes to buying vehicles via auction on the internet, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and related services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."]. See also *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarities between the marks and the services sold thereunder outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks

outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. Thus, this factor is neutral.

The coexistence of applicant's mark with the registered mark for five years, with no actual confusion, is entitled to little probative value. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). See also *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). The lack of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. Moreover, the record is devoid of any evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor of the length of time during and

conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude that consumers familiar with registrant's "computerized on-line retail store services in the fields of automotive collectibles, memorabilia, and apparel; [and] organization of internet auctions" rendered under the mark IBID MOTORS and design would be likely to mistakenly believe, upon encountering applicant's similar mark I-BID LIVE for "providing real-time online auction services, namely allowing potential buyers of salvage vehicles to bid in real time over the internet along with other live and internet bidders," that the services originated from or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry*

*Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).<sup>3</sup>

**Decision:** The refusal to register is affirmed.

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<sup>3</sup> Applicant states that any doubt should be resolved in its favor because "any person who believes that he would be damaged by the registration will have an opportunity ... to oppose the registration of the mark and to present evidence," citing *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987). Applicant's reliance on this case is clearly misplaced inasmuch as the Court made the point with respect to a refusal under Section 2(e)(1). As should be apparent from the cases cited above, it is well established that any doubt in Section 2(d) likelihood of confusion refusals is resolved in favor of the prior registrant.