Mailed: June 30, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re MarineMax, Inc.

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Serial No. 77731739
Serial No. 77731750
Serial No. 77731757
Serial No. 77731762

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Frank G. Long and Steven B. Powell of Greenberg Traurig LLP, for MarineMax, Inc.

Sara N. Benjamin, Trademark Examining Attorney, Law Office 110 (Chris AF Pedersen, Managing Attorney).

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Before Zervas, Ritchie, and Wolfson, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

MarineMax, Inc. ("applicant") filed applications to register the four marks listed below, each reciting the following services; "financial services, namely, providing loans for purchase or refinance; insurance brokerage services, namely, brokering of property insurance and casualty insurance for boats, recreational vehicles and other means of transportation and providing extended warranties on/for boats, recreational

vehicles and other means of transportation," in International Class 36:

1. DEALER FINANCIAL SERVICES, in standard character format[1];

2. 

[2];

3. DEALER FINANCIAL SERVICES GROUP, in standard character format[3];

4. 

[4].

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[1] Serial No. 77731739, filed May 7, 2009, claiming first use and first use in commerce on February 12, 2010, and disclaiming the exclusive right to use the term "FINANCIAL SERVICES" apart from the mark as shown. This application is for registration of the mark on the Supplemental Register.

[2] Serial No. 77731750, filed May 7, 2009, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use in commerce, and disclaiming the exclusive right to use the term "DEALER FINANCIAL SERVICES" apart from the mark as shown. This application is for registration of the mark on the Principal Register.

[3] Serial No. 77731757, filed May 7, 2009, claiming first use and first use in commerce on February 12, 2010, and disclaiming the exclusive right to use the term "FINANCIAL SERVICES GROUP" apart from the mark as shown. This application is for registration of the mark on the Supplemental Register.

[4] Serial No. 77731762, filed May 7, 2009, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use in commerce, and disclaiming the exclusive right to use the term

The Trademark Examining Attorney refused registration of applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the registered mark shown below, for "automobile financing services; financing relating to automobiles; financing services,"[5] in International Class 36, that when used on or in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive:

Upon final refusals of registration in each case, applicant filed a timely appeal. In each case, both applicant and the examining attorney filed briefs, and applicant filed a reply brief. Since these cases each concern common issues of law and fact, we see fit to consolidate them on appeal and issue one decision.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a

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"DEALER FINANCIAL SERVICES GROUP" apart from the mark as shown. This application is for registration of the mark on the Principal Register.

[5] Registration No. 3504836, issued September 23, 2008, and disclaiming the exclusive right to use the term "DEALERS FINANCE COMPANY" apart from the mark as shown.

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

The Services and Channels of Trade

Applicant's services overlap with registrant's services. Specifically, registrant's "financing services" encompass applicant's "financial services, namely, providing loans for purchase or refinance." In addition, the examining attorney made of record a definition of "financing" as "the act or process or an instance of raising or providing funds; *also:* the funds thus raised or provided."[6] Accordingly, we find the services to be overlapping and legally identical.

The examining attorney also introduced third-party registrations which suggest that the remaining services identified in the application are related to those in the cited

[6] Merriam-Webster Dictionary (2010).

registration. Copies of use-based, third-party registrations may serve to suggest that the services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Because the services described in the application and the cited registration are in-part (legally) identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz,* 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey,* 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Accordingly, these may be sold via the same channels, and indeed in the same venues, as registrant's services, and may be sold to the same customers. This is particularly true where, as here, the services are in-part (legally) identical. Applicant has not argued to the contrary. Accordingly, we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of confusion.

The Marks

We note that when the services are identical-in-part, the degree of similarity necessary to support a conclusion of likely confusion declines. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874**,** 23 USPQ2d 1698 (Fed. Cir. 1992). Also, we consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer for the goods at issue, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The mark in the cited registration contains the words "DEALERS FINANCE COMPANY," along with a simple design element, consisting of two curved lines that intersect. The marks in the applications consist of the words "DEALER FINANCIAL SERVICES," or "DEALER FINANCIAL SERVICES GROUP." For the standard character applications (Serial Nos. 77731739 and 77731757), these words could be displayed in the same, similar common block lettering appearing in registrant's mark. *See Citigroup Inc. v. Capital City Bank Group Inc.,* 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) ("If the registrant … obtains a standard character mark without claim to 'any particular font style, size or color,' the registrant is entitled to depictions of the standard character mark regardless of font, style, size, or color, not merely 'reasonable manners' of depicting its standard character mark.") Also, application Serial Nos. 77731757 and 77731762 contain a fourth, descriptive or generic word, "GROUP."

We note also that two of applicant's marks and the cited registration have design components, but we find the wording in the marks to dominate over the design components because the designs are a series of lines, and are not of any recognizable shapes, and serve to highlight the term DEALER in each mark. We note further that because DEALER is emphasized in each mark in bigger lettering, and because the remaining terms in each mark are highly descriptive or generic with limited or no source-identifying ability, DEALER, even if merely descriptive, is the

dominant term in each mark. *See In re National Data Corp.,* 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here 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."). Accordingly, with the foregoing in mind, we compare the words in these marks with those words in the mark in the cited registration.

The first terms of each are almost identical. Applicant's "DEALER" is the singular of the term "DEALERS" in the cited registration. The second word of applicant's mark, too, "FINANCIAL," is the adjective form of -- and highly similar in appearance and sound to -- the second word of the mark in the cited registration, "FINANCE." Only the third word of each mark differs, the generic "SERVICES" in applicant's mark compared to a generic "COMPANY" in the mark in the cited registration. *See In re JT Tobacconists,* 59 USPQ2d 1080, 1083 ("company" is generic). (And, for two of the applications, there is the additional, descriptive or generic term at the end, "GROUP.").

Applicant argues that the similarity of the applicant's first word "DEALER," compared with registrant's "DEALERS" is immaterial, since this is a "weak" term, used by others. (Appl's brief at 8). In support of this argument, applicant submitted twelve third-party registrations with marks beginning with the term "DEALER" or "DEALERS," in International Class 36,

as evidence that consumers will distinguish its mark from that in the cited registration, as follows:[7] DEALER EQUITY PLUS for "providing extended warranty contracts on automobiles" (Registration 3297963); DEALER 2 DEALER for "real estate advertising and marketing services for service stations and convenience stores" (Registration 3103264); DEALER PASSPORT for "financing the purchase of motor vehicles; underwriting and administering insurance agreements, service agreements, prepaid maintenance agreements, and debt cancellation agreements, all related to motor vehicles" (Registration 3009439); DEALER CENTER for "providing financial information for electronic means in the nature of credit reports to assist in obtaining credit approval and deal financing in the automobile industry" (Registration 2881038); DEALER EQUITY RE for "reinsurance underwriting services provided to captive insurance companies to protect them against the risk assumed by insuring vehicle service contracts and other automotive insurance products" (Registration 2361307); DEALER TRACK for "providing financial and credit information for the purchase of automobiles, via a global computer network" (Registration 2441682); DEALER EXPRESS SERVICE for "banking

[7] In addition to the nine "third-party" registrations listed in the text, applicant also cited three others, which are actually owned by the registrant: DEALERS FLOORPLAN COMPANY for "inventory financing services; financing relating to automobiles, financing services" (Registration 3231833), DEALERS FLOORPLAN COMPANY and design, also for "inventory financing services; financing relating to automobiles, financing services" (Registration No. 3417002); and the cited registration itself.

services" (Registration 1642989); DEALER FIRST FINANCIAL for "automotive financing" (3215417); and Dealer Resources, Inc., and design for "insurance agencies services" (Registration 1724197).

Third-party registrations may be used to show that a term has been commonly registered for its suggestive meaning. Most of these registrations have limited probative value however. Of the nine third-party registrations cited by applicant that do not belong to the registrant, only four are clearly in the same field of financing, and only one includes the overlapping word "FINANCIAL." Accordingly, we do not view these as establishing such weakness of the literal terms of the mark in the cited registration as to render it unprotectable vis-à-vis the mark that applicant seeks to register. Furthermore, if they did establish any weakness, even weak marks are entitled to protection against registration of a similar mark for in-part identical goods. *See Giant Food Inc. v. Rosso and Mastracco, Inc.*, 218 USPQ 521 (TTAB 1982). Indeed, we note that the mark in the cited registration disclaims the term "DEALERS" as do two of the applications (disclaiming "DEALER"). The other two applications, for DEALER FINANCIAL SERVICES and DEALER FINANCIAL SERVICES in standard character format, are for registration on the Supplemental Register. Our likelihood of confusion analysis is not limited to the similarity of this term, but rather is, as it must be, based on the similarity of the marks in their

entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, *supra* 73 USPQ2d at 1692.

In sum, we find the similarities of each of the marks to outweigh their dissimilarities, and this *du Pont* factor to also favor finding a likelihood of confusion for each of applicant's marks.

Consumer Sophistication

Applicant urges us to consider consumer sophistication and consumer care in selecting the services. In this regard, as with the other *du Pont* factors, we make our determination based on the parties' respective identifications of services and not based on actual use of the mark(s). *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." [citations omitted]).

We have no doubt that "financial services," including the "automobile financing services" and general "financing services"

identified in the cited registration, could be sold to the general population seeking financial services or automobile financing, which would include unsophisticated consumers who would use ordinary care in selecting such services. Applicant argues that because its customers must typically "apply to receive the services and complete an application requiring personal and financial and information," then "logically," the degree of care must be higher. (Reply brief at 5). Applicant has not indicated how care in filling out forms ameliorates any likelihood of source confusion, when the decision to use a particular financing company is made prior to filling out such forms. Also, applicant has not introduced evidence into the record to support applicant's arguments; furthermore, if it had, our conclusion would not be any different because we must consider solely the identifications of services as they are presented and they encompass those consumers who would not be sophisticated in their selection of the services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

Finally, applicant argues that the sophistication and conditions of purchasers is evidenced by a number of instances where registrations have been granted to different entities for marks similar to each other for related services in this field

indicating that "[a] notable characteristic of the financial services industry is that highly similar and even identical descriptive and weak marks are used by multiple trademark owners." (Appl's brief at 14). Applicant offered a number of examples of this pairing (including for example marks that share the common words "FIRST BANK"; "FIRST NATIONAL BANK"; and "eFinance"). We are aware, of course, that varying results can be reached depending on varying goods or services and varying marks. The evidence submitted by applicant does not show an established practice in this industry or field, and the Board is not bound by prior decisions or records. As the Federal Circuit instructs, every case must be decided on its own merits. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Accordingly, we deem this *du Pont* factor to weigh in favor of finding a likelihood of confusion for each of applicant's marks.

Conclusion

In summary, we have carefully considered all of the evidence and arguments of record relevant to the pertinent *du Pont* likelihood of confusion factors. We conclude that with in-part identical services and otherwise related services, legally identical channels of trade and purchasers, and similar marks with similar connotations, there is a likelihood of confusion among each of applicant's marks and the registered mark for the services identified therein.

Decision: The refusal to register each application is affirmed.