

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Real Estate USA, Inc.

Attorney Docket No. REUSA231122

Serial No.: 78/408,332

Trademark Attorney: Tonia M. Fisher

Filed: April 26, 2004

Law Office: 113

Mark: REUSA AND DESIGN

**APPELLANT'S APPEAL BRIEF**

Seattle, Washington

March 6, 2006

**TO THE COMMISSIONER FOR TRADEMARKS:**

TABLE OF CONTENTS

I. INTRODUCTION .....	3
II. JURISDICTION .....	4
III. BACKGROUND—PROCEDURAL HISTORY .....	4
IV. ISSUE ON APPEAL.....	6
V. ARGUMENT .....	6
A. There Is No Factual Support For The Examiner's Conclusion That Confusion In The Marketplace Would Be Likely Were Appellant's Mark Passed To Registration.....	7
B. The Design Elements Of Appellant's Mark Create A Stronger Commercial Impression Than The Literal Words REAL ESTATE USA.....	9
VI. CONCLUSION.....	12



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TABLE OF AUTHORITIES

	<u>Page</u>
FEDERAL CASES	
<i>In re Appetito Provisions Co.</i> , 3 U.S.P.Q. 2d 1553 (T.T.A.B. 1987) .....	11, 12
<i>Daddy's Junkie Music Stores, Inc. v. Big Daddy's Family Music Center</i> , 109 F.3d 275 (6th Cir. 1997).....	11
<i>In re E. I. DuPont de Nemours &amp; Co.</i> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) .....	6, 7
<i>Little Caesar, Ent., Inc. v. Pizza Caesar, Inc.</i> , 834 F.2d 568 (6th Cir. 1981).....	11, 12

FEDERAL STATUTES

15 U.S.C. § 1052(d) .....	3, 4, 5
15 U.S.C. § 1070.....	4
37 C.F.R. § 2.141 .....	4
37 C.F.R. § 2.142 .....	4

MISCELLANEOUS

3 J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> , § 23.15(1).....	11
--	----

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I. INTRODUCTION

This is an appeal from the final refusal to register the mark of the above-identified application. In the Office Action mailed July 1, 2005, the refusal to register Appellant's design mark,



was made final on the basis that the mark, when applied to Appellant's real estate agency services, so resembled the mark of U.S. Trademark Registration No. 2,569,116,



when used in connection with similar services, as to be likely to cause confusion, mistake, or to deceive in violation on Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

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## II. JURISDICTION

The jurisdiction of the Trademark Trial and Appeal Board is invoked under the provisions of 15 U.S.C. § 1070 and 37 C.F.R. §§ 2.141 and 2.142.

## III. BACKGROUND—PROCEDURAL HISTORY

The present application to register Appellant's mark REUSA AND DESIGN, was filed in the United States Patent and Trademark Office on April 26, 2004. In a first Office Action, mailed November 24, 2004, registration on the Principal Register was refused under Trademark Act § 2(d), 15 U.S.C. § 1052(d) because, in the Examiner's view, the Appellant's mark, when used on or in connection with Appellant's real estate agency services, so resembled the mark of U.S. Trademark Registration No. 2,569,116 for real estate agencies, as to be likely to cause confusion, mistake, or to deceive. The Examiner also required that Appellant disclaim the descriptive wording "Real Estate USA" because:

...it merely describes the nature of the services provided, namely real estate agency services provided in the United States of America. The wording USA is merely geographically descriptive of the location of where the Applicant's services are provided.

On May 23, 2005, Appellant responded by entering the required disclaimer of the words Real Estate USA, and argued that the rejection over prior Registration No. 2,569,166 was improper in view of the substantial visual and phonetic differences between Appellant's mark and the prior registered mark.

In particular, Appellant pointed out that the terms "Real Estate" and "USA" had been separately disclaimed in the prior registration and further, that the mark of the prior registration was described as "(a) half star with 'USA' next to it and a stripe above the star with 'Real Estate' above the stripe." In comparison, Appellant's mark is described as comprising the outline of a

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house with a five-pointed star cut out of its middle portion and the five-pointed star cutout disposed below the house between the letters "E" and "U" of the word "REUSA". Curving banners reminiscent of the stripes of the United States flag extend outwardly from the house to the right and finally, the disclaimed descriptive words "Real Estate USA" are positioned below the entire design. Appellant argued that the only similarity between the marks lay in their use of the descriptive and disclaimed term "Real Estate USA" and that in view of the differences between the marks, the commercial impression of Appellant's mark was very different from the commercial impression of the prior Registration No. 2,569,166. Appellant further pointed out that the term "real estate" could not be a source identifier for real estate agency services.

On July 1, 2005, in a second Office Action, the Examiner issued a Final Refusal of Appellant's mark, again under Section 2(d), based on prior Registration No. 2,569,116. In support of the Final Refusal, the Examiner argued that it was the literal portions of the prior registration which should be viewed as the dominant and most significant features of the mark relying on the fact that both the prior registration and Appellant's mark included the descriptive terms "Real Estate" and "USA", but ignoring the fact that the dominate word portion of Appellant's mark is the word "REUSA" and also ignoring the near total differences in the design portions of the marks.

The Examiner referenced the [www.acronymfinder.com](http://www.acronymfinder.com) Web site as evidence that the initials "re" stand for "real estate". A copy of the Web site results upon which the Examiner relied is attached hereafter as Exhibit A. As will be noted, the Web site shows that the initials "re" may have many meanings including "reference", "regarding", "reinforced", "reply", and, no less than fifty-three others. In conclusion, the Examiner restated her view that the marks were similar in sound, appearance and meaning and created the same commercial impression.

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Appellant responded to the Final Rejection on December 14, 2005, correcting an informality noted by the Examiner in the Appellant's drawing and also, pointing out that the only similarity between prior Registration No. 2,569,116 and Appellant's mark lay in the fact that they both included the descriptive and disclaimed terms "Real Estate" and "USA", and arguing that while the literal portions of a mark may generally be considered dominant, this is not the case where the literal portion of the prior registration is merely descriptive. Since the term "real estate" cannot be a source identifier for real estate agency services, the substantial design differences between the marks and, the Appellant's inclusion of the word "REUSA" in Appellant's mark should not be ignored as the Examiner has done, and when properly considered, there is no likelihood of confusion arising.

Appellant filed its Notice of Appeal on December 30, 2005.

#### IV. ISSUE ON APPEAL

The issue on this Appeal is whether Appellant's distinctive design mark, which includes the word "REUSA", as well as the descriptive terms "REAL ESTATE" and "USA", is likely to be confused with the different design mark of Registration No. 2,569,116 when used in connection with like services, simply because it also includes the words "real estate" and "USA".

In support of the present Appeal, Appellant relies on the argument set forth below and the arguments made in the previously filed responses.

#### V. ARGUMENT

This is a case where the Trademark Examiner has accurately cited tried and true principals of trademark law and then totally misapplied them to the facts of this case to conclude that the commercial impression of Appellant's mark and the prior registered mark are so similar as to cause confusion in the marketplace. The Examiner correctly cites *In re E. I. DuPont de*

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*Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), as setting forth the principal factors to be considered in determining the existence of likelihood of confusion but then fails to properly apply the *DuPont* factors to the realities of the real estate marketplace.

A. There Is No Factual Support For The Examiner's Conclusion That Confusion In The Marketplace Would Be Likely Were Appellant's Mark Passed To Registration.

Analysis of the Final Refusal of July 1, 2005, shows it to be a broad statement of legal principals interlaced with a few unsupported conclusory statements dealing with the facts of the present case. The only relevant statements bearing on the facts of this case are as follows:

The literal portions of both marks are nearly identical in appearance, sound and meaning. Accordingly, the slight difference in the design elements does not obviate the similarity between the marks in this case. Final Refusal, page 3, paragraph 1.

Likewise, although the Applicant's mark contains the additional wording RE USA. The Registrant's mark also contains the wording USA and the RE puts one in mind of 'REAL ESTATE'. The phrase 'RE' is not only the first two letters of the wording REAL, but also the initials of the two words REAL ESTATE. Moreover, please see the attached printout from the [www.acronymfinder.com](http://www.acronymfinder.com) Web site demonstrating that RE stands for REAL ESTATE. Thus, the marks create the same commercial impression. Final Refusal, page 3, paragraph 2.

In the instant case, the similarities between the marks are so numerous and great as to create an [sic] likelihood of confusion among consumers. The literal portion of the marks are nearly identical, and the marks share the identical wording "REAL ESTATE USA". Moreover, both marks contain some variation of a star design. Coupled with the fact that both the Applicant and the Registrant provide identical services and the marks contain identical wording, a likelihood of confusion with the marks exists. The marks are similar in sound, appearance and meaning creating the same commercial impression. The services are identical and therefore share the same channels of trade. Final Refusal, page 4, paragraph 1.

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Other than these statements, the Final Refusal is a mere mouthing of legal principals supported by numerous citations to cases, which, on their facts, are not in point. Analyzing the basis for the Final Refusal, the Examiner first states "the literal portions of both marks are nearly identical in appearance, sound and meaning." This is simply not true. The cited registration includes the words REAL ESTATE and USA separated by a horizontal line. The literal portion of Appellant's mark includes the word REUSA in print which is at least three times as large as the words REAL ESTATE USA positioned below. Even this simple comparison shows that the literal portions of both marks are not "nearly identical in appearance, sound and meaning". Bolstering this point is the fact that Appellant's mark also includes the literal design of a house which coupled with the word REUSA create the dominate commercial impression of Appellant's mark. Still further, a five pointed star is cut out of the house design and cleverly positioned between the letters E and U of REUSA. Finally, Appellant's mark includes curving banners reminiscent of the stripes of the United States flag extending outwardly from the house to the right. There is simply no support for the Examiner's conclusion that these two marks are "nearly identical in appearance". Likewise, Appellant's mark, if pronounced, would include the word "REUSA", a sound which has absolutely no counterpart in the cited registration.

The Examiner's next conclusory statement is that the initials RE "puts one in mind of 'real estate'". Appellant submits this is irrelevant to the issue of the commercial impression of Applicant's mark since one is already "in mind of real estate" due to the fact that the words "REAL ESTATE" actually appear in the mark in addition to REUSA. The Examiner's analysis is based on an improper dissection of the various elements of Appellant's mark rather than a proper consideration of the mark as a whole. A consumer encountering Appellant's mark is not going to separately analyze each of the many components of the mark. What they will be struck by is the uniqueness of the design and the large printed word REUSA. Further, as mentioned above, the

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fact that the acronymfinder.com Web site mentions real estate as one meaning out of fifty-eight meanings for the initials "re" is hardly compelling evidence of what meaning a consumer would take away upon viewing Appellant's mark.

Turning to the Examiner's ultimate conclusory statement that "the similarities between the marks are so numerous and great as to create an [sic] likelihood of confusion among consumers", Appellant submits that, in point of fact, it is the differences -- not the similarities -- between the marks which are so numerous and great that no likelihood of confusion among consumers exists. The literal portion of the marks are not "nearly identical" as stated by the Examiner. The Examiner is correct that the marks share the identical wording "REAL ESTATE USA", even if arranged in different formats, but as will be set forth hereafter, this alone cannot support a finding of likelihood of confusion.

**B. The Design Elements Of Appellant's Mark Create A Stronger Commercial Impression Than The Literal Words REAL ESTATE USA.**

Setting aside the existence of REUSA in Appellant's mark, which in and of itself supports a finding of no likelihood of confusion, the design elements of Applicant's mark are totally different from the design elements of the cited registration. Appellant's mark includes a house design. The cited registration does not. Appellant's mark includes curving banners extending from the house design. The cited registration includes a straight horizontal line bisecting the mark. Appellant's mark includes a five pointed star cut out of the house design and cleverly transported to a position between the letters E and U of the word REUSA. The cited registration includes what appears to be a half star. In point of fact, the only similarity between the Appellant's mark and the prior cited registration is that they both include the words REAL ESTATE USA.

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Submitted herewith as Exhibit B are the first pages of two searches carried out in the TESS database for the words "real estate" and "USA". The search for the words "real estate" turned up no less than 1,182 active records. The search for "USA" turned up no less than 3,610 active records. Appellant submits that neither the term Real Estate nor the term USA can possibly act as source identifiers in the real estate market in view of their widespread use. The term "real estate" is, to put it bluntly, used by everyone in the real estate business and thus, the Examiner's conclusion that Appellant's mere use of the term "Real Estate" in its design mark created the same commercial impression in the real estate marketplace as the prior registration, simply has no basis in reality.

Attached hereafter as Exhibit C are the first two pages of a Google search for the words "Real Estate USA" setting forth the first ten "hits" of no less than 39,500,000. Appellant submits that the Examiner's conclusion that Appellant's use of REAL ESTATE USA in its mark could possibly cause confusion with a prior totally different-looking registration where the only similarity is the use of the same totally descriptive phrase is clearly erroneous. In the real estate marketplace, the terms Real Estate and Real Estate USA, are so commonly used that consumers do not use these terms to identify an agency. In reality, real estate agencies typically choose distinctive words such as, "REUSA", "REMAX", or "NATIONWIDE", or distinctive designs or colors to allow the consumer to identify their services and distinguish them from those of others. The distinctive designs and words are used on signs and in advertising to allow consumers to quickly recognize and identify the agency. The words "real estate" cannot possibly perform this function, and consumers are not confused by the fact that different agencies all use the words "real estate".

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In the Final Refusal, the Examiner argues that the literal portions of marks are generally considered to be the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ 2d 1553 (T.T.A.B. 1987). However, examination of the case law reveals that the Examiner has overstated the law. The addition of a design element can obviate the similarity between marks, particularly where the only similarities are highly descriptive words. Experience tells us this must be the case.

In determining similarity of marks, the general rule is that the marks must be viewed in their entirety, focusing on their individual features. *Daddy's Junkie Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 283 (6th Cir. 1997). See also *Little Caesar, Ent., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1981) (emphasis on the "prominent feature of a mark and not on its totality violates the rule against comparing component parts of 'dissected' marks;" 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23.15(1)(a) ("the overall impression created by a mark from the ordinary shopper's cursory observation in the marketplace. . . will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighted analysis and legal briefs").

The T.T.A.B. has modified this rule by stating that "although marks must be compared in their entireties, where they are used on goods and services offered to the general public, emphasis must also be placed on the recollection of the average purchaser, who normally retains a general rather than specific impression of them. *In re Appetito Provisions Co.*, 3 U.S.P.Q. 2d 1553, 1554 (T.T.A.B. 1987). The Board in *In re Appetito Provisions Co.* stated that "if one of the marks comprises both a word and design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services". *Id.* (*emphasis added*). However,

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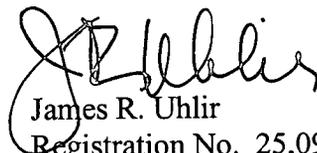
this is not, as the Examiner suggests, an absolute rule. The Board in *In re Appetito Provisions Co.* implies that other factors must be considered, stating: "In evaluating the similarities of marks, a particular feature or portion of a mark *can thus be accorded greater weight if it would make an impression upon purchasers that would be remembered and relied upon to identify the goods or services.*" *Id.* (emphasis added). The Examiner's conclusion that the literal portions are the dominant and most significant features of the marks in issue appears to be an overstatement of the law and is particularly inapplicable in the real estate market where the words "real estate" would not be used by the public to differentiate one agency from another.

#### VI. CONCLUSION

For the foregoing reasons, Appellant submits that its mark REUSA AND DESIGN is not likely to be confused with the previously registered mark REAL ESTATE USA AND DESIGN when both are used in the real estate market. Accordingly, Appellant respectfully requests that the rejection in the present application by the Trademark Attorney be reversed and the application be allowed.

Respectfully submitted,

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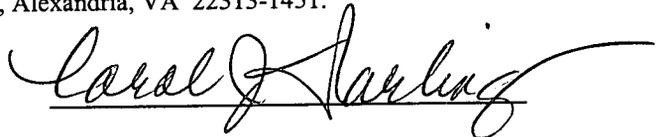


James R. Uhlir  
Registration No. 25,096  
Attorneys for Appellant

I hereby certify that this Appellant's Appeal Brief is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P. O. Box 1451, Alexandria, VA 22313-1451.

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Rank	Acronym	Meaning
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*****	RE	Regarding
*****	RE	Real Estate
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*****	RE	Reunion
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Rank	Acronym	Meaning
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*****	RE	Re-Examination
*****	RE	Reunion Island (ISO country code, top level domain)
*****	RE	Right End
*****	RE	Return Exchange
*****	RE	Risk Exposure
*****	RE	Reynolds Number (inertia force/viscous force)
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*****	<a href="#">RE</a>	Radium Emanation
*****	<a href="#">RE</a>	Relationship Episode
*****	<a href="#">RE</a>	Registered Electrologist
****	<a href="#">RE</a>	Radiation Element
****	<a href="#">RE</a>	Remedial Engineering
****	<a href="#">RE</a>	Regionalexpreß (German train)
****	<a href="#">RE</a>	Radio Enclosure
****	<a href="#">RE</a>	Recycle Acid
****	<a href="#">RE</a>	Receive Element
***	<a href="#">RE</a>	Directorate for Readiness
***	<a href="#">RE</a>	Royal Society of Etchers & Engravers
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Serial No. 78/408,332 - Appellant's Appeal Brief

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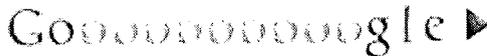
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