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REUSA-2-3112

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/408332

APPLICANT: Real Estate USA, Inc.

CORRESPONDENT ADDRESS:

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: REUSA AND DESIGN

CORRESPONDENT'S REFERENCE/DOCKET NO: REUSA-2-3112

CORRESPONDENT EMAIL ADDRESS:

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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's Final Refusal to register the trademark RE USA REAL ETATE USA (design) for "real estate agency services" on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). The Office has reassigned this application to the undersigned trademark examining attorney.

I. FACTS

Applicant applied for registration on the Principal Register for the trademark RE USA REAL ESTATE USA (design) for "real estate agency services" on April 26, 2004. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d),

because of the likelihood of confusion with U.S. Registration No. 2569116 for the mark REAL ESTATE USA (design) for “Real Estate Agencies.”

In response, the Applicant disclaimed “REAL ESTATE USA” and submitted arguments against the refusal to register under Section 2(d) of the Trademark Act. In response to the Examining Attorney's Final Refusal on these issues dated July 1, 2005, Applicant submitted arguments against the refusal under Section 2(d) of the Trademark Act and filed this appeal on March 8, 2006.

II. ISSUE

The applicant’s mark is confusingly similar to the mark in U.S. Registration No. 2569116 such that when used with the identified services it is likely to cause confusion, to cause mistake and to deceive and should therefore be refused registration under Section 2(d) of the Trademark Act.

III. OBJECTION

The Examining Attorney objects to the applicant's inclusion of additional evidence with its appeal brief, namely, all of the Exhibits attached to the appeal brief and references to such exhibits discussed in the appeal brief. 37 C.F.R. Section 2.142 clearly states:

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

The applicant has not complied with these requirements; thus, the untimely additional evidence should not be considered a part of the record and the examining attorney will not discuss it herein.

IV. ARGUMENT

THE MARKS OF APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR AND THE SERVICES OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks and the similarity of the services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); TMEP §§1207.01 *et seq.* No other factors may be considered because no relevant evidence of anything beyond those factors is contained in the record. *See In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant and against applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); TMEP §§1207.01(d)(i); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

A. THE SERVICES ARE IDENTICAL

The applicant is providing “real estate agency services.” The registrant’s services are “Real Estate Agencies.” These services are identical. If the services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b). Therefore, in this case, the degree of similarity between applicant’s mark and registrant’s mark need not be as great as in other cases.

B. THE MARKS ARE CONFUSINGLY SIMILAR

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); TMEP §1207.01(b).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both Applicant’s and registrant’s mark. *See e.g., Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff’d* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); TMEP §§1207.01(b)(ii) and (b)(iii). Here, the applicant has

incorporated the entirety of the literal portion of the registrant's mark, "REAL ESTATE USA," into its own mark, rendering it confusingly similar to the registered mark.

The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985). REAL ESTATE USA is the dominant element of both marks. While disclaimed matter is typically less significant or less dominant when comparing marks, a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The only difference between the marks is the design element and the addition of the words "RE USA." Here, the applicant has merely shortened or abbreviated the literal element of registrant's mark "Real Estate USA." As stated in the Examining Attorney's final action, "RE USA" has the same meaning as "Real Estate USA" with respect to applicant's and registrant's real estate services. "RE" is a commonly recognized abbreviation for the words "Real Estate," and as such, "RE USA" and "Real Estate USA" have identical meanings with respect to applicant's and registrant's services. Additionally, these marks sound similar as they both begin with the "re" sound and end with the word "USA." The addition of the abbreviation only minimally distinguishes the two marks given their identical meaning.

Notwithstanding the fact that similarity in meaning may be sufficient to support a finding of likelihood of confusion, applicant argues that the fact that "RE" stands for

“Real Estate” is irrelevant since “one is already “in mind of real estate” due to the fact that the words “REAL ESTATE” already appear in the mark in addition to REUSA.” Applicant’s Appeal Brief at p. 6. Applicant goes on to argue that the Examining Attorney’s argument on this subject was improper, as it did not consider the mark as a whole. Applicant’s argument, however, only contradicts its own statements and further supports a likelihood of confusion. If, as admitted by applicant, a potential consumer is already “in the mind of real estate due to the fact that the words “REAL ESTATE” already appear in the mark,” then a consumer is all the more likely to confuse applicant’s mark with registrant’s mark, as there would be no confusion as to what the “RE” in “RE USA” meant. As such, the only literal portion of the mark not identical to registrant’s mark, “RE,” would be interpreted as “REAL ESTATE,” thus rendering the two marks synonymous in the mind of the consumer.

As previously established, similarity in meaning alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980). It is not reasonable to conclude that, given the similarity of their sound and meaning, a potential customer hearing the two marks would likely focus on the word “RE USA” and ignore or pay little attention to the other words that followed, namely, “Real Estate USA.” It is also not reasonable to conclude that a potential customer would ignore the fact that “RE USA” and “REAL ESTATE USA” have identical meanings or the fact that the entire literal portion of registrant’s mark is incorporated into applicant’s mark. Therefore, the similarity between the dominant features of the marks is sufficient enough to support the examining attorney’s finding of a likelihood of confusion.

Furthermore, applicant relies too heavily on the difference between the designs in this case to obviate a likelihood of confusion. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). When vocally requesting applicant's services or registrant's services, a consumer would not refer to applicant's design. The design mark is not always guaranteed to be exposed to the consumer. For example, when doing business over the phone, both applicant and registrant would be referred to as "Real Estate USA" or wording with identical meaning and connotation.

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b). When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). Here, the overall commercial impressions of the marks are the same. As previously established, applicant has incorporated the entirety of the literal element of

registrant's mark. Both designs are black and white. Both designs contain simple geometric figures with hard lines and no degree of shading and little or no internal detail. Both designs have the word "USA" placed at the bottom right hand corner. All of these factors render the overall impression of the marks confusingly similar.

Applicant argues that registrant's mark is essentially a weak mark. (*See* Applicant's Appeal Brief at p. 10). However, even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein. Applicant has still incorporated the entirety of the literal element of registrant's mark into its own mark.

Although the applicant's mark includes the wording "RE USA," the courts have found that the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR GOLD"); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985)

(“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”); TMEP §1207.01(b)(iii).

Ultimately, in this case, applicant has incorporated the entire literal element of registrant’s mark, “REAL ESTATE USA.” The only additional wording in applicant’s mark, “RE USA,” has the identical meaning as “REAL ESTATE USA.” The similarity in appearance, sound and meaning in this case is sufficient to support a finding of likelihood of confusion. Based on this, the overall commercial impression of the marks RE USA REAL ESTATE USA (design) and REAL ESTATE USA (design) remains the same and the marks are more than sufficiently similar under Section 2(d) of the Trademark Act to warrant a refusal.

V. CONCLUSION

For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

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